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Filing date: **12/02/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|------------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------|
| Proceeding | 91213092 |
| Party | Defendant Chaban Wellness LLC |
| Correspondence Address | MICHAEL C. CESARANO, JAMES A. GALE, ALEJ FELDMAN GALE, P. A. 2 S BISCAYNE BLVD MIAMI, FL 33131-1806 UNITED STATES Trademarks@FeldmanGale.com |
| Submission | Answer and Counterclaim |
| Filer's Name | Michael C. Cesarano |
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| Signature | /Michael C. Cesarano/ |
| Date | 12/02/2013 |
| Attachments | Opposition No 91213092.pdf(51257 bytes) |

Registration Subject to the filing

| | | | |
|-----------------|---------------------------------------------------------------------|-------------------|------------|
| Registration No | 3967892 | Registration date | 05/24/2011 |
| Registrant | Matthias Rath 1260 Memorex Drive Santa Clara, CA 95050 DEX | | |

Goods/Services Subject to the filing

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|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Class 005. First Use: 2011/01/20 First Use In Commerce: 2011/01/20 All goods and services in the class are requested, namely: Nutritional supplements; dietary supplements; vitamins and mineral supplements |
| Class 016. First Use: 2011/01/20 First Use In Commerce: 2011/01/20 All goods and services in the class are requested, namely: Newspapers in the field of healthcare, nutritional supplements, dietary supplements, vitamin and mineral supplements; educational materials, namely, newspapers in the field of healthcare, nutritional supplements, dietary supplements, vitamin and mineral supplements |
| Class 041. First Use: 2011/01/20 First Use In Commerce: 2011/01/20 All goods and services in the class are requested, namely: Educational services, namely, conducting instruction in the form of classes, seminars, workshops, and conducting continuing education courses in the field of healthcare and nutritional supplements, and distributing course material in connection therewith |
| Class 044. First Use: 2011/01/01 First Use In Commerce: 2011/01/01 All goods and services in the class are requested, namely: Providing health information, namely, information in the field of healthcare and nutritional supplements, dietary supplements, vitamin and mineral supplements |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

*In re U.S. Trademark Application Serial No. 85/769860 for
YES YOU CAN!, International Class 5; filed November 2, 2012.*

DR. MATTHIAS RATH,

Opposition No.: 91213092

Opposer,

v.

CHABAN WELLNESS LLC

Applicant.

_____ /

**APPLICANT’S ANSWER, AFFIRMATIVE DEFENSES,
AND COUNTERCLAIM TO THE NOTICE OF OPPOSITION**

Applicant, CHABAN WELLNESS LLC, hereby respectfully answers and sets forth its affirmative defenses to Opposer’s, DR. MATTHIAS RATH’s, Notice of Opposition (“Opposition”) and states as follows:

1. Applicant admits that it is a Florida limited liability company and is domiciled in the State of Florida, having an office in Coral Gables, Florida.
2. Applicant admits that on or about November 2, 2012, it caused to be filed an application with the United States Patent and Trademark Office (“USPTO”), having a Serial No. 85/769860 (“the ‘860 Application”), for the standard character trademark YES YOU CAN! for use in connection with goods in International Class 5, including “Nutraceuticals for use as a dietary supplement; protein supplement shakes and drink mixes.”
3. Applicant is without sufficient knowledge as to the allegations in Paragraph 3 of the Opposition and, therefore, denies same.

4. Applicant is without sufficient knowledge as to the allegations in Paragraph 4 of the Opposition and, therefore, denies same.

5. Applicant admits that the Opposer has not expressly authorized Applicant to use or apply to register the mark shown in the '860 Application. However, Applicant denies that any such authorization was required, and Applicant denies all remaining allegations in Paragraph 5 of the Opposition.

6. Applicant denies the allegations in Paragraph 6 of the Opposition.

7. Applicant denies the allegations in Paragraph 7 of the Opposition.

8. Applicant denies any and all allegations in the Opposition that have not been responded to or specifically admitted.

9. WHEREFORE, Applicant denies that the Opposer is entitled to the relief he requests through his Prayer for Relief.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

Fraud Upon United States Patent and Trademark Office regarding Registration No. 2,863,920.

Upon information and belief, the Opposer committed fraud upon the USPTO with regard to obtaining and/or maintaining its Registration No. 2,863,920 and Registration No. 3,967,892 through knowing misrepresentations as to the use (or lack thereof) of the purported YOU CAN! mark. Upon information and belief, Opposer has never used the YOU CAN! and/or YOU CAN marks in a trademark sense and/or beyond mere token use, or if Opposer made any trademark use was made, it was made no earlier than January 20, 2011.

SECOND AFFIRMATIVE DEFENSE

Fraud Upon United States Patent and Trademark Office regarding Registration No. 3,967,892.

Upon information and belief, the Opposer committed fraud upon the USPTO with regard to obtaining and/or maintaining its Registration No. 3,967,892 through knowing misrepresentations as to the purported YOU CAN mark. The registered under Registration No. 3,967,892 is, in all material respects and commercial impression, the same as the mark registered under Registration No. 2,863,920. Accordingly, Registration No. 3,967,892 is an improper duplication of the same mark registered under the earlier Registration No. 2,863,920.

THIRD AFFIRMATIVE DEFENSE

Abandonment.

Upon information and belief, the Opposer made no use of the mark YOU CAN! in connection with any goods or services from the date of issuance of Registration No. 2,863,920 for more than five consecutive years and until at least the end of the six-month grace period for filing its Affidavit under Section 8 of the Lanham Act. Upon information and belief, with regard to Registration No. 2,863,920, the Opposer filed his Affidavit on the last day of the grace period under Section 8 of the Lanham Act, January 20, 2011, using an improper specimen of use and for the improper purpose of reserving an otherwise invalid trademark upon the Principal Register. However, due to the Opposer's failure to use the YOU CAN! mark within a reasonable time following registration, that mark had become and is abandoned for purposes of Section 45 of the Trademark Act.

FOURTH AFFIRMATIVE DEFENSE

Opposer Lacks a Protectable Trademark Due to Naked Licensing.

Even if the Opposer had at one time possessed valid trademark registrations under Registration No. 2,863,920 and Registration No. 3,967,892, upon information and belief, the Opposer has involuntarily abandoned and/or lost its trademark rights with respect to those marks through uncontrolled licensing (“naked licensing”) of its alleged trademarks—*i.e.*, through the failure to exercise control over its licensees’ use of the alleged trademark.

FIFTH AFFIRMATIVE DEFENSE

Improper Specimens of Use.

Upon information and belief, the Opposer knowingly filed improper specimens of use as to some or all of the goods and/or services associated with the YOU CAN! and YOU CAN trademark registrations and, therefore, knowingly mislead the United States Patent and Trademark Office into issuing and/or allowing the Opposer to maintain Registration No. 2,863,920 and Registration No. 3,967,892 upon the Principal Register.

SIXTH AFFIRMATIVE DEFENSE

Unclean Hands.

Upon information and belief, the Opposer committed fraud upon the USPTO with regard to obtaining and/or maintaining its Registration No. 2,863,920 and Registration No. 3,967,892 and, therefore, is coming into this proceeding with unclean hands in so far as it is asserting and attempting to enforce rights it does not actually possess.

SEVENTH AFFIRMATIVE DEFENSE

Unlawful Use in Commerce.

Upon information and belief, the Opposer is using the marks associated with Registration No. 2,863,920 and Registration No. 3,967,892 in violation of the Food, Drug, and Cosmetic Act which renders use of the marks unlawful and, thus, the Opposer cannot support and/or enforce its rights as trademark owner and senior user in such marks.

EIGHTH AFFIRMATIVE DEFENSE

Unlawful Use in Commerce / Unclean Hands.

Upon information and belief, the Opposer is using the marks associated with Registration No. 2,863,920 and Registration No. 3,967,892 to mislead consumers into believing that the goods being sold in connection with the YOU CAN! and YOU CAN marks emanate from or are developed by a physician licensed to practice medicine in the United States, when in actuality they do not emanate from such a source. Therefore, the Opposer is using the asserted marks unlawfully and is coming into this proceeding with unclean hands.

Finally, Applicant intends to rely upon any other affirmative defense that it may discover during this proceeding and, therefore, hereby reserves its right to amend these Affirmative Defenses.

WHEREFORE, having fully answered the Opposition, Applicant requests that a decision be entered against the Opposer and in favor of the Applicant, dismissing this Opposition with prejudice, granting registration upon the Principal Register to Applicant's YES YOU CAN! trademark having Serial No. 85/769860, and granting such other and further relief as may be deemed proper.

COUNTERCLAIM

Applicant, CHABAN WELLNESS LLC, hereby counterclaims against Opposer MATTHIAS RATH (“Rath”), to cancel the Opposer’s pleaded Registration No. 3,967,892, pursuant to Trademark Rule 2.106(b)(2)(i). In support of the counterclaim, Applicant alleges the following grounds:

1. Upon information and belief, the Opposer committed fraud upon the USPTO with regard to obtaining and/or maintaining its Registration No. 3,967,892 through knowing misrepresentations as to material facts with the intention that the United States Patent and Trademark Office act in reliance thereupon. The USPTO has acted in reasonable reliance upon the Opposer’s misrepresentations as to material fact and, thereby, has allowed Registration No. 3,967,892 to be issued and maintained upon the Principal Register to the damage of the Applicant and the consuming public.

2. Upon information and belief, the Opposer has never used the YOU CAN mark in a trademark sense and/or beyond mere token use.

3. Upon information and belief, the YOU CAN mark registered under Registration No. 3,967,892 is, in all material respects and commercial impression, the same as the mark registered under the earlier Registration No. 2,863,920.

4. Upon information and belief, the Opposer knowingly filed improper specimens of use as to some or all of the goods and/or services associated with the YOU CAN trademark registration and, therefore, knowingly misled the United States Patent and Trademark Office into issuing and/or allowing the Opposer to maintain Registration No. 3,967,892 upon the Principal Register.

5. Even if the Opposer had at one time possessed valid trademark registration under Registration No. 3,967,892, upon information and belief, the Opposer involuntarily abandoned and/or lost its trademark rights with respect to those marks through uncontrolled licensing (“naked licensing”) of its alleged trademarks—*i.e.*, through the failure to exercise control over its licensees’ use of the alleged trademark.

6. Additionally, upon information and belief, the Opposer appears to be using the mark associated with Registration No. 3,967,892 in violation of the Food, Drug, and Cosmetic Act which renders use of the marks unlawful and, thus, the Opposer cannot support and/or enforce its rights as trademark owner and senior user in such marks.

7. Finally, upon information and belief, the Opposer is using and advertising the mark associated with Registration Registration No. 3,967,892 in a manner that is likely to mislead consumers into believing that the goods being sold in connection with the YOU CAN mark emanate from or are developed by a physician licensed to practice medicine in the United States, when in actuality the Opposer, RATH, is not a physician licensed to practice medicine in the United States.

WHEREFORE, Applicant prays that RATH’s trademark No. 3,967,892 be cancelled from the United States Patent and Trademark Office’s register of trademarks and RATH’s Oppositions to the Applicant’s trademark applications Serial Nos. 85/769860, 85/769864, and 85/769870 be dismissed with prejudice.

Dated: December 2, 2013

Respectfully submitted,

/s/ Michael C. Cesarano

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CERTIFICATE OF MAIL AND CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on December 2, 2013, this document is being electronically filed via the Electronic System for Trademark Trial and Appeals. I also hereby certify that a true copy of the foregoing document was served on counsel for the Opposer by delivering the same via electronic mail (e-mail) to jblattner@dickinsonwright.com; apelker@dickinsonwright.com, and by also delivering it via first class U.S. mail, postage prepaid, to: John C. Blattner, DICKINSON WRIGHT PLLC, 350 S. Main Street, Suite 300, Ann Arbor, Michigan 48104.

/s Barbara Pichs-Reyes
Barbara Pichs-Reyes