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

Proceeding	91213092
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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,

Opposer,

v.

Opposition No.: 91213092

CHABAN WELLNESS LLC,

Applicant.

_____ /

**OPPOSER’S MOTION TO DISMISS APPLICANT’S COUNTERCLAIM AND TO
DISMISS OR STRIKE APPLICANT’S AFFIRMATIVE DEFENSES PURSUANT TO
FED. R. CIV. P. 12(b)(1), 12(b)(6), and 12(f)**

Opposer moves to dismiss Applicant’s Counterclaim for failure to state a claim on which relief can be granted pursuant to Fed. R. Civ. P. 12(b)(6) and/or for lack of subject matter jurisdiction pursuant to Fed. R. Civ. P. 12(b)(1). All of the numbered paragraphs of Applicant’s Counterclaim fall short of the pleading requirements set forth in the Federal Rules as interpreted by the Supreme Court of United States. Some also rest on subject matter over which this Board has no jurisdiction.

Opposer also moves to strike or dismiss Applicant’s Affirmative Defenses. Many of the allegations in the Affirmative Defenses are merely redundant of Opposer’s Counterclaim and should therefore be stricken pursuant to Fed. R. Civ. P. 12(f). Insofar as they are not merely redundant of Opposer’s Counterclaim, the Affirmative Defenses should be dismissed for failure to state a claim on which relief can be granted pursuant to Fed. R. Civ. P. 12(b)(6) and/or for lack of subject jurisdiction pursuant to Fed. R. Civ. P. 12(b)(1).

A. BACKGROUND

Opposer has filed oppositions to Applicant’s applications for YES YOU CAN! in International Class 5 (Ser. No. 85/769,860; Opp. No. 91213092 [“the ‘092 Opposition”]), International Class 41 (Ser. No. 85/769,864; Opp. No. 91213090 [“the ‘090 Opposition”]), and International Class 44 (Ser. No. 85/769,870; Opp. No. 91213088 [“the ‘088 Opposition”]). In each opposition, Opposer asserted two registrations, namely, Reg. No. 2,863,920 (“the ‘920 Registration”) and Reg. No. 3,967,892 (“the ‘892 Registration”). Applicant’s affirmative defenses are identical in all three proceedings and pertain to both of Opposer’s asserted registrations. In its answer in this proceeding, the ‘092 Opposition, Applicant included a counterclaim for the cancellation of Opposer’s ‘892 Registration only.

B. APPLICANT’S COUNTERCLAIM SHOULD BE DISMISSED

1. The Legal Standards

In order to survive a motion to dismiss under Rule 12(b)(6), a pleading must set forth “enough facts to state a claim to relief that is plausible on its face.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). Although for purposes of a motion to dismiss a court must take all factual allegations in the complaint as true, it is “not bound to accept as true a legal conclusion couched as a factual allegation.” *Papasan v. Allain*, 478 U.S. 265, 286 (1986); see also *Twombly*, 550 U.S. at 555. A pleading offering only “labels and conclusions” or “formulaic recitation of the elements of a cause of action will not do.” *Twombly*, 550 U.S. at 555.

The Federal Rules provide a heightened standard for pleading fraud. FED. R. CIV. P. 9(b) (When alleging fraud, “a party must state with particularity the circumstances constituting fraud”); see also 37 C.F.R. § 2.106(b)(1) (“When pleading special matters, the Federal Rules of Civil Procedure shall be followed”). Pleadings of fraud based merely on “information and belief,” where there is no allegation of “specific facts upon which the belief is reasonably

based,' are insufficient.” *Asian and Western Classics B.V. v. Selkow*, 92 U.S.P.Q.2d 1478, 1479 (T.T.A.B. 2009); see also *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1328 (Fed. Cir. 2009) (“the pleading must identify the specific who, what, when, where, and how of the material misrepresentation or omission committed before the PTO”).

A motion pursuant to Rule 12(b)(1) challenges the tribunal’s jurisdiction over the subject matter of a claim. The Trademark Trial and Appeal Board (“T.T.A.B.”) has jurisdiction to determine only the right to register a mark. T.B.M.P. § 102.01. It has no authority to determine the right to use a mark. *Id.* Further, the T.T.A.B.’s jurisdiction does not extend to determinations of whether a party has engaged in unfair competition, false advertising, or criminal or civil wrongdoings. *Richard Gregg Mfg. Co., Inc. v. La Maur, Inc.*, 166 U.S.P.Q. 568, 569 (T.T.A.B. 1970) (“The Board . . . is not concerned with matters of unfair competition and/or unfair trademark practices, the only concern being whether a party is entitled to register its mark for its goods”); see also *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 U.S.P.Q.2d 1212, 1216 (T.T.A.B. 2006) (“the Board's jurisdiction is limited to determining whether trademark registrations should issue or whether registrations should be maintained; it does not have authority to determine whether a party has engaged in criminal or civil wrongdoings”), *aff'd unpub'd*, 240 Fed. Appx. 865 (Fed. Cir. July 11, 2007), *cert. den'd*, 552 U.S. 1109 (2008).

2. Applicant’s Counterclaim Should be Dismissed

Applicant’s Counterclaim fails to meet the legal standard for pleadings set forth above. In each numbered paragraph, Applicant fails to allege sufficient facts, and at most merely recites the elements of a cause of action. In several instances, Applicant alleges that Opposer committed fraud upon the USPTO, but never provides facts sufficient to support such claims under the heightened pleading standard of Fed. R. Civ. P. 9. Additionally, paragraphs 6 and 7 of

Applicant's Counterclaim attempts to state claims that are outside the subject matter jurisdiction of the T.T.A.B.

The following provides the full text of the numbered paragraphs in Applicant's Counterclaim followed by a discussion of each paragraph's deficiencies.

Counterclaim Paragraph 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.

Applicant fails to support this allegation with "the specific who, what, when, where, and how" of the alleged misrepresentation by, or the intent of, Opposer. See *Exergen Corp.*, 575 F.3d at 1328. Rather, Applicant merely recites the elements of fraud. Such formulaic recitation fails to meet the pleading standard required by Rule 9 and is insufficient to survive a motion to dismiss under Rule 12(b)(6). See *Twombly*, 550 U.S. at 555; see also *Exergen Corp.*, 575 F.3d at 1328.

Counterclaim Paragraph 2:

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

Applicant's allegation appears to be a short-hand reference to the statutory definition of "use in commerce." See 15 U.S.C. § 1127. Applicant alleges no facts supporting its allegation of Opposer's non-use nor does it allege facts in support of the assertion that Opposer's use was merely "token use," which is merely a legal conclusion couched as a factual allegation. See *Papasan v. Allain*, 478 U.S. at 286. Given this lack of factual support, paragraph 2 should be dismissed pursuant to Rule 12(b)(6).

Counterclaim Paragraph 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.

Applicant appears to be invoking the U.S. Patent and Trademark Office's policy of refusing to register two marks that would result in "exact duplicates." T.M.E.P. § 703 ("If two applications on the same register would result in registrations that are *exact duplicates*, the USPTO will permit only one application to mature into registration, and will refuse registration in the other application") (emphasis added); see also 37 C.F.R. § 2.48. Even assuming, arguendo, that the referenced policy can provide grounds for cancellation, Applicant does not plead that the two marks are "exact duplicates."¹ Rather, Applicant merely asserts that the marks are the same "in all material respects and commercial impression." Thus, this affirmative defense should be stricken pursuant to Rule 12(b)(6).

Counterclaim Paragraph 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.

This allegation essentially is one of fraud and thus requires particularity concerning the circumstances constituting the fraud. Fed. R. Civ. P. 9(b); Exergen Corp., 575 F.3d at 1328 ("the pleading must identify the specific who, what, when, where, and how of the material misrepresentation or omission committed before the PTO"). Applicant's allegation falls far short of the requisite specificity. For example, it does not even identify the specimens that are allegedly improper, let alone state *why* they are improper. Thus, this paragraph should be

¹ The Board may take judicial notice of the fact that Opposer's '920 and '892 Registrations are *not* identical. The '920 Registration is for the stylized wording YOU CAN! (*You can!*), while the '892 Registration is for YOU CAN in standard characters (and with no exclamation point).

dismissed pursuant to Rule 12(b)(6) for failure to meet the pleading standard for fraud required by Rule 9.

Counterclaim Paragraph 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.

Applicant provides only a formulaic recitation of the elements of a claim for cancellation due to uncontrolled licensing, without alleging any specific facts. For example, Applicant fails to identify a single licensee of Opposer, let alone allege any facts with respect to how Opposer has failed to exercise control over any such alleged licensee. Given Applicant’s failure to allege specific facts in support of this claim, this paragraph should be dismissed pursuant to Rule 12(b)(6). See *Twombly*, 550 U.S. at 555.

Counterclaim Paragraph 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.

This paragraph does not even succeed in making an allegation: it merely observes that Opposer “appears to be” using its mark in some improper way. Nor does it provide any facts as to how the Food, Drug, and Cosmetic Act governs *use of a trademark*. In any event, determining whether a party has violated the Food, Drug and Cosmetic Act clearly lies outside the scope of the T.T.A.B.’s jurisdiction. See T.B.M.P. § 102.01; see also *McDermott*, 81 U.S.P.Q.2d at 1216. Accordingly, this paragraph should be dismissed pursuant to Rule 12(b)(1) for lack of subject matter jurisdiction.

Counterclaim Paragraph 7:

Finally, upon information and belief, the Opposer is using and advertising the mark associated with Registration Registration [sic] 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.

This paragraph appears to attempt to allege some form of unfair competition and/or false advertising. But such issues are outside the purview of the T.T.A.B. See *Richard Gregg Mfg. Co., Inc.*, 166 U.S.P.Q. at 569 (“The Board . . . is not concerned with matters of unfair competition and/or unfair trademark practices, the only concern being whether a party is entitled to register its mark for its goods”). Similarly, to the extent that Applicant’s claim may attempt to allege unspecified criminal or civil wrongdoing, such claims also are outside the scope of the T.T.A.B.’s jurisdiction. *McDermott*, 81 U.S.P.Q.2d at 1216. Thus, pursuant to Rule 12(b)(1), paragraph 7 should be dismissed for lack of subject matter jurisdiction.

C. APPLICANT’S AFFIRMATIVE DEFENSES

Several of Applicant’s affirmative defenses are redundant of the allegations contained in Applicant’s Counterclaim. An affirmative defense that is merely redundant of a counterclaim should be stricken. Fed. R. Civ. P. 12(f) (“The court may strike from a pleading . . . any redundant . . . matter”); see also T.B.M.P. § 311.02(b) (“When a defense is raised by way of a counterclaim, it should not also be pleaded as an affirmative defense, because the pleading of it as an affirmative defense is unnecessary and redundant”); *Space Base Inc. v. Stadis Corp.*, 17 U.S.P.Q.2d 1216, 1220 (T.T.A.B. 1990) (Applicant’s “affirmative defenses are stricken as redundant” of Applicant’s counterclaim). Moreover, to the extent that Applicant’s affirmative defenses contain defenses or claims not included within the Counterclaim, the same are defective and should be dismissed pursuant to Rule 12(b)(6) and/or Rule 12(b)(1).

The following provides the full text of Applicant's affirmative defenses followed by a discussion of the deficiencies of each:

FIRST Affirmative Defense:

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.

As to Opposer's '892 Registration, the affirmative defense is redundant of the allegations contained paragraphs 1 and 2 of Applicant's Counterclaim. Accordingly, this affirmative defense should be stricken pursuant to Rule 12(f) with respect to the '892 Registration. To the extent that this First Affirmative Defense contains new allegations concerning the '920 Registration, it should be dismissed pursuant to Rule 12(b)(6) for failure to meet the pleading standard. For example, Applicant fails to support this allegation with "the specific who, what, when, where, and how" of the alleged misrepresentation by, or the intent of, Opposer. See *Exergen Corp.*, 575 F.3d at 1328. Moreover, Applicant alleges no facts supporting its allegation of Opposer's non-use nor does Applicant offer any indication as to why Opposer's use amounts to mere "token use."

SECOND Affirmative Defense:

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.

To the extent that this affirmative defense alleges fraud, Applicant has failed to provide any factual basis for the allegation. Accordingly, as to the issue of fraud, this affirmative defense

should be dismissed pursuant to Rule 12(b)(6). See *Asian and Western Classics B.V.*, 92 U.S.P.Q.2d at 1479 (Pleadings of fraud based merely on “information and belief,” where there is no allegation of “‘specific facts upon which the belief is reasonably based,’ are insufficient”).

The remaining allegations in this affirmative defense are redundant of paragraph 3 of Applicant’s Counterclaim and thus should be stricken pursuant to Rule 12(f), as well as dismissed pursuant to Rule 12(b)(6) as previously discussed.

THIRD Affirmative Defense:

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.

Applicant alleges that Opposer made no use of its YOU CAN! mark (the ‘920 Registration) for more than five consecutive years and claims on this basis that Opposer has abandoned its mark. But a proper allegation of abandonment requires facts sufficient to support *both* non-use of the mark by the owner *and* intent by the owner not to resume use. See 15 U.S.C. § 1127 (“A mark shall be deemed to be ‘abandoned’ . . . (1) When its use has been discontinued *with intent not to resume* such use”) (emphasis added); see also *Cumulus Media v. Clear Channel Commc’ns*, 304 F.3d 1167, 1173 (11th Cir. 2002) (“Under the Lanham Act, a protectable mark or name is considered abandoned if “its use has been discontinued *with intent not to resume such use*”) (emphasis added).

Here, Applicant fails to allege any facts concerning Opposer’s intent. Applicant bases its claim of abandonment on a bald allegation that Opposer did not use its mark for five years and

that it did not file a Declaration of Use with the USPTO until “the end of the six-month grace period for filing its Affidavit under Section 8 of the Lanham Act.” Opposer’s ‘920 registration was obtained under Section 44 of the Lanham Act and thus Opposer had no affirmative duty to allege use until the end of the Section 8 Declaration filing period. *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 U.S.P.Q. 909 (T.T.A.B. 1984); see also T.M.E.P. § 1009. The most that may be said of Applicant’s allegation concerning five years of non-use is that this might create a *presumption* of abandonment. See J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition (4th ed.) § 17:19. This presumption, however, was definitively rebutted by the Opposer’s timely Section 8 filing. Given Applicant’s failure to allege facts sufficient to support the necessary elements of a claim of abandonment, this affirmative should be dismissed pursuant to Rule 12(b)(6).

Applicant further alleges that Opposer committed fraud by “using an improper specimen of use.” An allegation of fraud requires particularity concerning the circumstances constituting the fraud. Fed. R. Civ. P. 9(b); *Exergen Corp.*, 575 F.3d at 1328 (“the pleading must identify the specific who, what, when, where, and how of the material misrepresentation or omission committed before the PTO”). Applicant’s allegation falls far short of the requisite specificity. For example, it does not even identify which specimens are allegedly improper, let alone *why* they are improper. Thus, as to the allegation of fraud, this affirmative defense should be dismissed pursuant to Rule 12(b)(6) for failure to meet the pleading standard for fraud required by Rule 9.

FOURTH Affirmative Defense:

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.

As to the ‘892 Registration, this affirmative defense is redundant of paragraph 5 of Applicant’s counterclaim. Given this redundancy, Applicant’s Fourth Affirmative Defense should be stricken pursuant to Rule 12(f) to the extent it implicates Opposer’s ‘892 Registration.

This affirmative defense, however, further alleges that Opposer has abandoned its ‘920 Registration through uncontrolled licensing. Here, Applicant provides only a formulaic recitation of the elements of a claim for cancellation due to uncontrolled licensing, and fails to allege any facts concerning Opposer’s licensing of its ‘920 Registration. Accordingly, Applicant’s Fourth Affirmative Defense, to the extent it implicates the ‘920 Registration, should be dismissed for failure to state a claim pursuant to Rule 12(b)(6).

FIFTH Affirmative Defense:

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.

With respect to the ‘892 Registration, this affirmative defense is redundant of paragraph 4 of Applicant’s Counterclaim. Thus, as to the ‘892 Registration, this affirmative defense should be stricken as redundant pursuant to Rule 12(f).

This affirmative defense, however, also alleges that Opposer knowingly filed improper specimens of use thereby misleading the US PTO in maintaining its ‘920 Registration. An allegation of fraud requires particularity concerning the circumstances constituting the fraud. Fed. R. Civ. P. 9(b); *Exergen Corp.*, 575 F.3d at 1328 (“the pleading must identify the specific who, what, when, where, and how of the material misrepresentation or omission committed before the PTO”). Applicant bases its claim on the mere assertion that Opposer’s specimens are

improper as to “*some or all of the goods and/or services,*” but fails to identify the specimens that are allegedly improper, let alone state *why* they are improper. Given this lack of factual support, Applicant’s Fifth Affirmative Defense, as it relates to the ‘920 Registration, should be dismissed pursuant to Rule 12(b)(6).

SIXTH Affirmative Defense:

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.

Applicant fails to allege any specific facts concerning the alleged fraud committed by Opposer, and the invocation of “unclean hands” is merely a legal conclusion couched as a factual allegation. Accordingly, this affirmative defense should be dismissed pursuant to Rule 12(b)(6). See *Asian and Western Classics B.V.*, 92 U.S.P.Q.2d at 1479 (Pleadings of fraud based merely on “information and belief,” where there is no allegation of “‘specific facts upon which the belief is reasonably based,’ are insufficient”). Moreover, to the extent that Applicant bases this affirmative defense on the allegations contained in its counterclaim, this affirmative defense should be stricken as redundant pursuant to Rule 12(f).

SEVENTH Affirmative Defense:

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.

As it relates to the ‘892 Registration, Applicant’s Seventh Affirmative Defense is redundant of paragraph 6 of its Counterclaim and thus should be stricken pursuant to Rule 12(f).

This affirmative defense, however, further alleges that Opposer is using its ‘920 Registration in violation of the Food, Drug, and Cosmetic Act. It suffers from the same fatal defects already discussed with respect to paragraph 6 of the counterclaim. Chief among these is

the fact that the T.T.A.B. does not have jurisdiction to determine whether a party has violated the Food, Drug and Cosmetic Act. See T.B.M.P. § 102.01; see also *McDermott*, 81 U.S.P.Q.2d at 1216 (“the Board's jurisdiction is limited to determining whether trademark registrations should issue or whether registrations should be maintained; it does not have authority to determine whether a party has engaged in criminal or civil wrongdoings”). Accordingly, as to the ‘920 Registration, Applicant’s Seventh Affirmative Defense should be dismissed pursuant to Rule 12(b)(1).

EIGHTH Affirmative Defense:

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.

As it relates to the ‘892 Registration, this affirmative defense is duplicative of paragraph 7 of Applicant’s Counterclaim, and thus should be stricken pursuant to Rule 12(f).

As to the ‘920 Registration, determining whether a party has used a mark to engage in unfair competition or false advertising is outside the purview of the T.T.A.B. See *Richard Gregg Mfg. Co., Inc.*, 166 U.S.P.Q. at 569 (“The Board . . . is not concerned with matters of unfair competition and/or unfair trademark practices, the only concern being whether a party is entitled to register its mark for its goods”). Additionally, to the extent that this affirmative defense alleges criminal or civil wrongdoing, such claims also are outside the scope of the T.T.A.B.’s jurisdiction. *McDermott*, 81 U.S.P.Q.2d at 1216 (“the Board's jurisdiction is limited to determining whether trademark registrations should issue or whether registrations should be maintained; it does not have authority to determine whether a party has engaged in criminal or

civil wrongdoings”). Thus, as it relates to the ‘920 Registration, Applicant’s Eighth Affirmative Defense should be dismissed pursuant to Rule 12(b)(1) for lack of subject matter jurisdiction.

D. SUMMARY

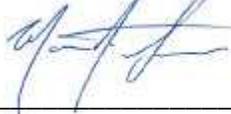
The following chart summarizes the various bases on which Applicant’s counterclaim paragraphs and affirmative defenses should be dismissed.

Pleading	12(b)(6) Failure to State a Claim on Which Relief May be Granted	12(b)(1) Lack of Subject Matter Jurisdiction	12(f) Redundancy
Counterclaim Paragraph 1	x		
Counterclaim Paragraph 2	x		
Counterclaim Paragraph 3	x		
Counterclaim Paragraph 4	x		
Counterclaim Paragraph 5	x		
Counterclaim Paragraph 6	x	x	
Counterclaim Paragraph 7	x	x	
First Affirmative Defense	x		x
Second Affirmative Defense	x		x
Third Affirmative Defense	x		
Fourth Affirmative Defense	x		x
Fifth Affirmative Defense	x		x
Sixth Affirmative Defense	x		x
Seventh Affirmative Defense	x	x	x
Eighth Affirmative Defense	x	x	x

CONCLUSION

In view of the foregoing, Opposer respectfully requests that Applicant's Counterclaim be dismissed for failure to state a claim on which relief can be granted pursuant to Fed. R. Civ. P. 12(b)(6) and/or for lack of subject jurisdiction pursuant to Fed. R. Civ. P. 12(b)(1). Opposer further requests that Applicant's Affirmative Defenses be stricken pursuant to Fed. R. Civ. P. 12(f) to the extent that they are merely redundant of Opposer's Counterclaim. Insofar as they are not merely redundant of Opposer's Counterclaim, Opposer requests that the Affirmative Defenses be dismissed for failure to state a claim on which relief can be granted pursuant to Fed. R. Civ. P. 12(b)(6) and/or for lack of subject matter jurisdiction pursuant to Fed. R. Civ. P. 12(b)(1).

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January 21, 2014

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on January 21, 2014, a true copy of this document was served on counsel for the Applicant by delivering the same via First Class U.S. Mail, postage prepaid, to: Michael C. Cesarano, FELDMAN GALE, P.A., 2 South Biscayne Blvd., 30th Floor, Miami, Florida 33131.

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January 21, 2014

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