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Filing date: **07/09/2014**

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

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|------------------------|--|
| Proceeding | 91216629 |
| Party | Defendant TheraPearl, LLC |
| Correspondence Address | MATTHEW A. PEQUIGNOT PEQUIGNOT + MYERS 90 N COAST HIGHWAY 101 STE 315 ENCINITAS, CA 92024-3359 mpequignot@pmiplaw.com;uspto@pmiplaw.co |
| Submission | Answer |
| Filer's Name | Matthew A. Pequignot |
| Filer's e-mail | mpequignot@pmiplaw.com, swoodson@pmiplaw.com, paralegal@pmiplaw.com |
| Signature | /Matthew A. Pequignot/ |
| Date | 07/09/2014 |
| Attachments | Answer to Opposition FILED 070914.pdf(62212 bytes) Exhibit 1 FINAL.pdf(101740 bytes) Exhibit 2 FINAL.pdf(13807 bytes) |

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

RAPID AID CORP.,

Opposer,

v.

THERAPEARL, LLC,

Applicant.

In the matter of:

Serial No. 86/099,781

For the mark: RAPID AID

Opposition No. 91216629

DEFENDANT'S ANSWER TO NOTICE OF OPPOSITION

In response to the Notice of Opposition filed by Opposer RAPID AID CORP. (hereinafter "Opposer") on May 20, 2013, Defendant THERAPEARL, LLC (hereinafter "Defendant") hereby responds as follows:

1. Defendant admits in part and denies in part the matters asserted or inferred in Paragraph 1 of the Notice of Opposition. Defendant admits that Opposer is a Canadian entity that has an address at 4120A Sladeview Crescent, Mississauga, Ontario L5L 5Z3. However, Opposer has, in litigation documents filed prior to this Opposition proceeding, identified itself as "Rapid Aid Ltd.," a Federally Incorporated Company, and Defendant has accepted this identification as true. Defendant is without sufficient information and/or knowledge to form a belief as to whether a "Federally Incorporated Company" is legally the same in Canada as a "Canadian Corporation," or whether Opposer has reorganized as a corporation, and therefore denies the same.

2. Defendant admits that Opposer claims that it is *the* “number one manufacturer of hot/cold therapy products worldwide” as well as “the largest private label manufacturer of hot/cold therapy products.” Defendant admits that it has accepted Opposer’s statements and representations as true.

3. Defendant denies the matters asserted and inferred in Paragraph 3 of the Notice of Opposition. Upon information and belief, Opposer’s business in the United States has been primarily limited to private label sales where the words RAPID AID are not used on the commercialized products. Any non-private label use by Opposer of the words RAPID AID, of which the Defendant is aware, has been unlawful and fraudulent. Defendant denies knowledge of the specific relationship of Rapid Aid Ltd. to Rapid Aid Corp. and denies that any lawful transfer of trademark rights, if any exist or existed, has been made between such entities.

4. Defendant admits in part and denies in part the matters asserted or inferred in Paragraph 4 of the Notice of Opposition. Defendant admits that a photograph depicting something of unknown provenance is attached as Exhibit A to the Notice of Opposition. Defendant is without sufficient information and/or knowledge to form a belief as to the truth of the remaining matters asserted or inferred in Paragraph 4 of the Notice of Opposition and therefore denies same.

5. Defendant admits in part and denies in part the matters asserted or inferred in Paragraph 5 of the Notice of Opposition. Pursuant to USPTO records, Defendant admits that an application for the mark RAPID AID, Serial No. 86/268,328 (the ‘328 application) appears to have been filed by Opposer on May 1, 2014 in International Class 10 for “Pain relieving products, namely, hot and cold gel packs and compresses”. Notwithstanding anything stated herein, Defendant is without sufficient information and/or knowledge to form a belief as to the accuracy of USPTO records or the accuracy of Opposer’s ownership and therefore denies same.

6. Defendant admits in part and denies in part the matters asserted or inferred in Paragraph 6 of the Notice of Opposition. Pursuant to USPTO records, Defendant admits that an application for the mark RAPID AID, Serial No. 86/268,358 (the '358 application) appears to have been filed by Opposer on May 1, 2014 in International Class 35 for "Operation of a business relating to the manufacturing, distributing and selling pain relieving products, namely, hot and cold gel packs and compresses". Notwithstanding anything stated herein, Defendant is without sufficient information and/or knowledge to form a belief as to the accuracy of USPTO records or the accuracy of Opposer's ownership and therefore denies same.

7. Defendant admits in part and denies in part the matters asserted or inferred in Paragraph 7 of the Notice of Opposition. Opposer's business in the United States has been primarily limited to private label sales where the words RAPID AID are not used on the commercialized products manufactured by Opposer. Therefore, Defendant denies that Opposer "has expended significant amounts of time, efforts and expense since then developing its product line, promoting the sale of its products, and encouraging the public and trade to recognize its products under the RAPID AID mark[.]" Upon information and belief, Defendant denies that Opposer existed as the corporation identified in Paragraphs 1 of the Notice of Opposition in 1978 and 1999, respectively. Defendant is without sufficient information and/or knowledge to form a belief as to the truth of the remaining matters asserted or inferred in Paragraph 7 of the Notice of Opposition and therefore denies same.

8. Defendant admits in part and denies in part the matters asserted and inferred in Paragraph 8 of the Notice of Opposition. Defendant admits that its RAPID AID mark is identical in appearance and sound to Opposer's applied-for RAPID AID mark. However, Defendant denies that the connotation and commercial impression are the same, because the goods being identified

in connection with Defendant's applied-for mark are different than those being identified in connection with Opposer's applied-for mark, and the mark as applied to Defendant's goods will result in a unique connotation and commercial impression. Defendant admits that its application for the RAPID AID mark is preexisting and predates Opposer's pending applications for trademark.

9. Defendant admits in part and denies in part the matters asserted in Paragraph 9 of the Notice of Opposition. Defendant admits that the goods identified in its application are "heatable and freezable bead filled therapeutic packs", and Defendant admits that Opposer's products are hot/cold therapy products. Defendant denies the remaining matters asserted and inferred in Paragraph 9 of the Notice of Opposition.

10. Defendant is without sufficient information and/or knowledge to ascertain the likelihood of rejection of Opposer's pending federal trademark applications by the Trademark Office, which is an independent government entity which makes registrability decisions autonomously. Defendant denies that Opposer's RAPID AID mark was preexisting. Furthermore, Defendant denies that Opposer will be damaged if Defendant's application for the mark RAPID AID matures to registration. Opposer's fraudulent use of the registration symbol ® alongside the words RAPID AID in connection with its hot/cold therapy products (Exhibit 1, attached hereto), by itself, constitutes grounds for a refusal to register Opposer's recently filed '328 and '358 applications for the RAPID AID mark.

11. To the extent Opposer's factual allegations are understood, Defendant denies the matters asserted and inferred in Paragraph 11 of the Notice of Opposition.

12. Defendant denies the matters asserted and inferred in Paragraph 12 of the Notice of Opposition.

13. Defendant denies the matters asserted and inferred in Paragraph 13 of the Notice of Opposition.

14. Defendant admits in part and denies in part the matters asserted in Paragraph 14 of the Notice of Opposition. Defendant admits that it had knowledge of Opposer's intentional abandonment of U.S. Application Serial Numbers 75/738,552 (filed on June 28, 1999 and abandoned on January 2, 2001) and 76/500,474 (filed on March 18, 2003 and abandoned on March 9, 2004). Additionally, Defendant admits that it had knowledge, prior to filing its trademark application for the RAPID AID mark, of Opposer's fraudulent use of the registration symbol ® alongside the words RAPID AID in connection with certain products. (Exhibit 1, attached hereto.) Defendant denies the remaining matters asserted and inferred in Paragraph 14 of the Notice of Opposition.

15. Defendant admits that it filed, through its attorney Mr. Matthew A. Pequignot, U.S. Application Serial No. 86/099,781 for registration of the mark RAPID AID for heatable and freezable bead filled therapeutic packs. As part of the application, Mr. Pequignot did execute the declaration quoted, verbatim, in Paragraph 15 of the Notice of Opposition. At the time of filing its application for the RAPID AID mark, Defendant and its counsel, Mr. Pequignot, were aware that: a) Opposer had previously abandoned U.S. Application Serial Nos. 75/738,552 (for the mark RAPID AID) and 76/500,474 (for the mark RAPID AID MAKES IT BETTER); b) the primary business of the Opposer was limited to private label sales; and c) when Opposer had used the words RAPID AID with non-private label sales, it did so fraudulently by knowingly and willfully using the registration symbol ® in connection with the words "RAPID AID," despite the fact that Opposer knew that the mark had never been registered. Defendant's application was

also filed with the belief that Defendant's goods are unlikely to be confused with Opposer's goods.

16. Defendant admits in part and denies in part the matters asserted in Paragraph 16 of the Notice of Opposition. Defendant knew that Opposer had, in the past, intentionally abandoned United States trademark applications for marks containing the words "RAPID AID." Defendant knew that Opposer had used the RAPID AID mark in a fraudulent manner by knowingly and willfully using the registration symbol ® in connection with the words "RAPID AID" despite the fact that Opposer knew that the mark was never registered in the United States. Defendant knew that its goods are unlikely to be confused with Opposer's goods. Defendant denies that Opposer engaged in non-fraudulent use of the RAPID AID mark in United States commerce. Defendant denies that the declaration was not true and denies the remaining matters asserted and inferred in Paragraph 16 of the Notice of Opposition.

17. Defendant admits in part and denies in part the matters asserted in Paragraph 17 of the Notice of Opposition. Defendant admits that Mr. Pequignot filed a Complaint in the U.S. District Court for the District of Maryland on September 23, 2013 (Case 1:13-cv-02792-CCB), one month prior to the filing date of Defendant's application for federal registration of the RAPID AID trademark. Defendant admits that allegations in said Complaint, include the following statement:

Defendant Rapid Aid Ltd. is a Federally Incorporated Company in Canada that has its principal place of business at 4120A Sladeview Crescent, Mississauga, Ontario L5L 5Z3. Rapid Aid is the self-described "number one manufacturer of hot/cold therapy products worldwide" and is, according to its own claims, "the largest private label manufacturer of hot/cold therapy products." Rapid Aid sells its hot/cold therapy products in drugstores throughout Canada and the United States, including drugstores in the State of Maryland. As part of its commercial operations, Rapid Aid operates a business and/or distribution office at 250 Cooper Ave., Suite 102, Tonawanda, NY 14150.
(emphasis added)

Defendant admits that a copy of the Complaint was submitted with the Notice of Opposition as Exhibit B. Defendant denies that the Complaint alleges or acknowledges that Opposer engaged in lawful prior use, or any other use, of the RAPID AID mark. To the contrary, the Complaint filed by Mr. Pequignot specifically alleges that Opposer is a private label manufacturer (i.e., a manufacturer which places other companies' trademarks on products manufactured by Opposer).

18. Defendant admits in part and denies in part the matters asserted in Paragraph 18 of the Notice of Opposition. Defendant admits that Mr. Pequignot filed a Complaint in the U.S. District Court for the District of Maryland on September 23, 2013 (Case 1:13-cv-02792-CCB), one month prior to the filing date of Defendant's application for federal registration of the RAPID AID trademark. Defendant admits that allegations in said Complaint, include the following statement:

Defendant Rapid Aid Ltd. is a Federally Incorporated Company in Canada that has its principal place of business at 4120A Sladeview Crescent, Mississauga, Ontario L5L 5Z3. Rapid Aid is the self-described "number one manufacturer of hot/cold therapy products worldwide" and is, according to its own claims, "the largest private label manufacturer of hot/cold therapy products." Rapid Aid sells its hot/cold therapy products in drugstores throughout Canada and the United States, including drugstores in the State of Maryland. As part of its commercial operations, Rapid Aid operates a business and/or distribution office at 250 Cooper Ave., Suite 102, Tonawanda, NY 14150.
(emphasis added)

Defendant admits that a copy of the Complaint was submitted with the Notice of Opposition as Exhibit B. Defendant denies that the Complaint alleges or acknowledges that Opposer engaged in lawful prior use, or any other use, of the RAPID AID mark. To the contrary, the Complaint filed by Mr. Pequignot specifically alleges that Opposer is a private label manufacturer (i.e., a manufacturer which places other companies' trademarks on products manufactured by Opposer). Defendant admits that it had knowledge of Opposer's previous intentional abandonment of U.S. Application Serial Numbers 75/738,552 (filed on June 28, 1999 and abandoned on January 2,

2001) and 76/500,474 (filed on March 18, 2003 and abandoned on March 9, 2004). Additionally, Defendant admits that it had knowledge, prior to filing its application for federal registration of the RAPID AID trademark, of Opposer's fraudulent use of the registration symbol ® alongside the words RAPID AID in connection with certain products. (Exhibit 1, attached hereto.) Defendant denies the remaining matters asserted and inferred in Paragraph 18 of the Notice of Opposition.

19. Defendant denies the matters asserted in Paragraph 19 of the Notice of Opposition.

20. Defendant denies the matters asserted in Paragraph 20 of the Notice of Opposition.

21. Defendant denies the matters asserted in Paragraph 21 of the Notice of Opposition.

22. Defendant denies the matters asserted in Paragraph 22 of the Notice of Opposition.

23. Paragraph 23 of the Notice of Opposition states the Opposer's beliefs. Defendant is not in a position and does not have sufficient information to admit or deny Opposer's state of mind, but to the extent possible, denies the matters asserted in Paragraph 23 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

In further answer to the Notice of Opposition, Defendant asserts that:

1. The Notice of Opposition fails to state a claim upon which relief can be granted.
2. Defendant had, at the time of executing and filing its application for the RAPID AID trademark, a bona fide intention to use the RAPID AID mark, in good faith, in connection with the sale of its heatable and freezable bead filled therapeutic packs.
3. The statements set forth in the October 23, 2013 Declaration signed by Mr. Matthew Pequignot, on behalf of Defendant, and submitted in connection with the filing of U.S.

Application Serial No. 86/099,781, on behalf of Defendant, were known and/or believed to be true, as stated in the Declaration.

4. The registration and any corresponding use of Defendant's mark will not mistakenly cause Defendant's goods to be thought, by relevant consumers, to originate or derive from the same source as Opposer's goods or services, nor will such use be thought, by such consumers, to be a use by Opposer or with Opposer's authorization or approval.

5. Defendant's mark, when used on or in connection with Defendant's goods or in association with its services, is not likely to cause confusion, or to cause mistake, as to the source or sponsorship or association of Defendant's goods, such as with or by Opposer.

6. Purchasers of Defendant's and Opposer's goods are sufficiently sophisticated and/or are expected and/or are believed to exercise such reasonable care in purchasing Defendant's and/or Opposer's goods such that confusion, deception, or mistake as to the source or sponsorship or association of Defendant's goods, such as with or by Opposer, will be avoided.

7. Opposer is and has been aware that abandoned applications for federal trademark registrations do not confer federal trademark rights and do not permit marking with the registration symbol ®, when no registered trademark corresponding to the registration symbol ® exists.

8. Opposer intentionally abandoned U.S. Application Serial No. 75/738,552 (the '552 application) filed on June 28, 1999 for registration of the trademark RAPID AID for "custom manufacture of hot packs, cold packs, gel packs, and ultrasound gel for others."

9. Opposer knowingly abandoned the '552 application for registration of the trademark RAPID AID.

10. Opposer intentionally abandoned U.S. Application Serial No. 76/500,474 (the '474 application), filed on March 18, 2003 for registration of the trademark RAPID AID MAKES IT BETTER for "operation of a business manufacturing, distributing, and selling therapeutic hot and cold packs, gel packs."

11. Opposer knowingly abandoned the '474 application for registration of the trademark RAPID AID MAKES IT BETTER.

12. Opposer's '552 application and '474 application both listed the following individual at the following address as counsel for Opposer:

DAVID J. PILO
BARRISTER & SOLICITOR
88 DUNN STREET, SUITE 301
OAKVILLE, ONTARIO
CANADA L6J 3C7

13. According to routine practice and procedure at the USPTO, when an application is abandoned, a Notice of Abandonment is sent to the counsel of record. For example, when the '474 application for registration of the trademark RAPID AID MAKES IT BETTER was abandoned, a notice of the abandonment dated May 3, 2004 was mailed to Opposer's counsel, David J. Pilo, at or near the time of abandonment. (Exhibit 2, attached.)

14. Although Opposer could have revived the '552 application for the RAPID AID mark or the '474 application for the RAPID AID MAKES IT BETTER mark, or re-applied for the registration, Opposer did not revive or re-file its application for registration of the RAPID AID mark, until after Defendant filed its U.S. Application Serial Number 86/099,781 for the mark RAPID AID.

15. Despite having knowledge of the abandonment of its '552 application, Opposer has fraudulently misused the registration symbol ® after the application's abandonment, and despite the fact that such trademark was never federally registered.

16. Consumers and trade members who view the registration symbol ® markings are likely to believe that Opposer has obtained federal registrations for the mark RAPID AID.

17. Consumers and trade members who view the registration symbol ® markings are likely to believe that Opposer has enforceable federal legal rights to exclude them from using the RAPID AID mark in commerce throughout the United States.

18. Opposer knowingly and willfully used the registration symbol ® in connection with the words "RAPID AID" in an attempt to deceive or mislead consumers and parties in the trade into believing the words "RAPID AID" were registered, and/or knowing or believing that consumers or others in the trade would believe that the mark was registered.

19. Opposer's fraudulent misuse of the registration symbol ® constitutes unclean hands therefore precluding Opposer from asserting any lawful right, prior or otherwise, to use the mark RAPID AID.

20. Opposer's fraudulent misuse of the registration symbol ® constitutes unclean hands so as to bar registration of the RAPID AID mark by Opposer.

21. Opposer's abandonment of the '474 and '552 applications relinquished the RAPID AID mark to the public domain, to the extent that Opposer had any rights in the RAPID AID mark prior to abandonment.

22. Opposer's abandonment of the '474 and '552 applications placed the public on notice that the RAPID AID mark was free to be acquired and/or registered by a bona fide, good faith user of the mark.

23. Opposer's private label manufacturing of temperature therapy products, including hot/cold therapy products, where such products are marked or packaged with the trademarks of other entities, has failed to and continues to fail to provide Opposer with any trademark or Lanham Act right pertaining to the RAPID AID mark.

RELIEF REQUESTED

WHEREFORE, Defendant respectfully requests that this opposition proceeding be dismissed, with prejudice.

RESPECTFULLY SUBMITTED,

Dated: July 9, 2014

By: /s/ Matthew A. Pequignot
MATTHEW A. PEQUIGNOT (P43851)
Pequignot + Myers LLC
90 North Coast Highway 101
Suite 315
Encinitas, CA 92024
Phone: 202-328-1200
Facsimile: 202-328-2219
mpequignot@pmiplaw.com

Attorney for Defendant THERAPEARL, LLC

CERTIFICATE OF SERVICE

I hereby certify that, on this date, a true and correct copy of the foregoing
DEFENDANT’S ANSWER TO NOTICE OF OPPOSITION has been served via email and first
class mail on Opposer’s attorney of record as follows:

RICHARD W. HOFFMAN, Esq.
Reising Ethington PC
755 West Big Beaver Road, Suite 1850
PO Box 4390
Troy, Michigan 48099- 4390
Email: hoffmann@reising.com

Date: July 9, 2014

/s/ Matthew A. Pequignot
Matthew A. Pequignot
Pequignot + Myers
90 North Coast Highway 101
Suite 315
Encinitas, CA 92024
Phone: 202-328-1200
Facsimile: 202-328-2219
mpequignot@pmiplaw.com

EXHIBIT 1
ANSWER, Opposition No. 91216629
Rapid Aid Corp. v. TherPearl, LLC

Opposer's Fraudulent Use of the Registration Symbol

...as trias sin supervisión es peligroso.
Manténgala fuera del alcance de los niños.

Treating the Worlds' Bumps & Bruises...

RAPID 
AID.

...Makes it Better!"



Mississauga, ON L5L 5Z3. RAPID RELIEF® is a
registered trademark of RAPID AID Corp. Made in
Chicago, IL. Rapid Aid Hot and Cold Therapy
Products Co., Ltd. A wholly owned Rapid Aid Company
www.rapidaid.com

EXHIBIT 2
ANSWER, Opposition No. 91216629
Rapid Aid Corp. v. TherPearl, LLC

Notice of Abandonment of Trademark Application

Commissioner for Trademarks
2900 Crystal Drive
Arlington , VA 22202-3514
www.uspto.gov

May 03, 2004

NOTICE OF ABANDONMENT

TM110

DAVID J. PILO
BARRISTER & SOLICITOR
88 DUNN STREET, SUITE 301
OAKVILLE, ONTARIO
CANADA L6J 3C7

ATTORNEY
REFERENCE
NUMBER:
23179

SERIAL NUMBER: 76/500474
MARK: RAPID AID MAKES IT BETTER
APPLICANT: RAPID AID LTD.

THE ABOVE IDENTIFIED TRADEMARK APPLICATION WAS ABANDONED ON 03/09/2004 FOR THE FOLLOWING REASON:

NO RESPONSE TO THE OFFICE ACTION MAILED ON 09/08/2003 WAS RECEIVED IN THE UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO) WITHIN THE SIX-MONTH RESPONSE PERIOD. (15 U.S.C. 1062(b); TRADEMARK RULE 2.65(a)).

YOU CAN REQUEST REINSTATEMENT OF THE APPLICATION FOR NO FEE IF:

- * YOU HAVE PROOF THAT YOUR RESPONSE WAS RECEIVED IN THE USPTO ON OR BEFORE THE DUE DATE - SUCH AS A POSTCARD WITH A USPTO MAILROOM DATE STAMP; OR,
- * YOU MAILED OR FAXED THE RESPONSE ON OR BEFORE THE DUE DATE WITH A CERTIFICATE OF MAILING OR FACSIMILE TRANSMISSION, IN ACCORDANCE WITH USPTO RULE 2.197, 37 CFR SEC. 2.197.

YOU MUST SUBMIT A COPY OF THE PREVIOUSLY SUBMITTED TIMELY RESPONSE WITHIN 2 MONTHS OF THE DATE PRINTED AT THE TOP OF THIS NOTICE ALONG WITH ONE OF THE TYPES OF PROOF SET OUT ABOVE. YOU MAY FAX THIS INFORMATION TO (703) 746-3000.

IF YOU DO NOT HAVE THE PROOF NECESSARY FOR REINSTATEMENT, YOU CAN REQUEST REVIVAL OF THE APPLICATION, UNDER USPTO RULE 2.66, 37 CFR SEC. 2.66, BY:

- * FILING A "PETITION TO REVIVE" **WITHIN 2 MONTHS** OF THE DATE PRINTED AT THE TOP OF THIS NOTICE, INDICATING THAT THE REASON FOR THE DELAY IN RESPONDING BY THE DUE DATE WAS "UNINTENTIONAL";
- * PAYING THE PETITION FEE OF \$100, MADE PAYABLE TO THE COMMISSIONER OF TRADEMARKS; AND
- * INCLUDING A COPY OF THE RESPONSE TO THE OFFICE ACTION (IF YOU DID RECEIVE THE OFFICE ACTION - OTHERWISE, INCLUDE A STATEMENT THAT YOU DID NOT RECEIVE THE OFFICE ACTION.)

FOR FURTHER INFORMATION CALL (703) 308-9000