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

Proceeding	91219959
Party	Plaintiff Universal Protein Supplements Corporation dba Universal Nutrition
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Universal Protein Supplements Corporation,

Opposer,

v.

Fitness Publications, Inc.,

Applicant.

Serial No. 86/026,728

Opposition No. 91219959



Mark:

OPPOSER’S MOTION TO STRIKE & SUSPEND PROCEEDINGS

Pursuant to Fed. R. Civ. P. 12(f) and Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 506, Universal Protein Supplements Corporation (“Universal”), through its counsel, Marshall, Gerstein & Borun LLP, hereby moves to strike Applicant Fitness Publications, Inc.’s (“Applicant”) affirmative defenses contained in its answer to Universal’s First Amended Notice of Opposition (“Answer”) and certain allegations set forth in its counterclaim for cancellation, both of which were filed on May 27, 2015 (“Affirmative Defense(s)” and “Counterclaim,” respectively). In support of its motion, Universal states as follows:

I. INTRODUCTION

Applicant filed its Answer to Universal’s First Amended Notice of Opposition on May 27, 2015, along with its Counterclaim to cancel Universal’s U.S. Registration No. 4,483,690 for its bodybuilder design (the “Bodybuilder Design”). For its Counterclaim, Applicant alleged the following grounds: mere descriptiveness; failure to function as a mark; and false suggestion of a connection. In support, Applicant provided allegations regarding certain registrations, applications, and other statements relating to Applicant’s rights in marks consisting of or incorporating the term ARNOLD or Arnold Schwarzenegger’s name. Universal submits that

these allegations are immaterial and irrelevant to the issues in this proceeding, namely, whether there is a likelihood of confusion between Universal's Bodybuilder Design and the design shown in Serial No. 86/026,728 (the "Opposed Mark").

Further, Applicant's Affirmative Defenses include the following: an allegation that the Opposed Mark is inherently distinctive and consumers are likely to associate the design with Mr. Schwarzenegger; a statement incorporating all of the allegations included in Applicant's Counterclaim; and a statement reserving Applicant's right to raise additional affirmative defenses in the future. These Affirmative Defenses are insufficient, redundant, and fail to provide fair notice of Applicant's defenses.

Universal therefore respectfully requests that Applicant's Affirmative Defenses and Counterclaim allegations concerning its rights in the term ARNOLD and Mr. Schwarzenegger's name be stricken.

II. ARGUMENT

a. Applicant's Counterclaim allegations relating to its rights in the "ARNOLD" marks and Mr. Schwarzenegger's name are immaterial and irrelevant.

Applicant's Counterclaim allegations concerning its purported rights in marks consisting of or incorporating the term ARNOLD and Mr. Schwarzenegger's name are immaterial and irrelevant to the issues in this proceeding. The TBMP states that "the Board may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter." TBMP § 506.01.

Here, Universal alleged a likelihood of confusion between the Opposed Mark and Universal's Bodybuilder Design. (Notice of Opposition, ¶¶ 6-10.) In response, Applicant alleged, in part, the following registrations and applications in its Counterclaim, none of which include the Opposed Mark or a similar design.

- THE ARNOLD SCHWARZENEGGER CLASSIC, Reg. No. 1,572,499;
- ARNOLD CLASSIC, Reg. No. 3,208,453;
- ARNOLD SPORTS FESTIVAL, Reg. No. 3,192,055;
- ARNOLD, Serial No. 86/496,501;
- ARNOLD SCHWARZENEGGER, Serial No. 86/026,727;
- ARNOLD SCHWARZENEGGER MUSCLE BAR, Serial No. 86/340,887;
- ARNOLD SCHWARZENEGGER BLUEPRINT, Serial No. 86/197,124;
- ARNOLD SCHWARZENEGGER BLUEPRINT TO CUT, Serial No. 86/197,131; and
- ARNOLD SCHWARZENEGGER BLUEPRINT TO MASS, Serial No. 86/197,133.

(Counterclaim, ¶¶ 25 & 26.) Applicant also references rights in Mr. Schwarzenegger’s name in Paragraphs 21, 22, 25, and 26 of the Counterclaim. (*Id.* at ¶¶ 21-22, 25-26.)

Applicant’s allegations pertaining to its purported rights in the “ARNOLD” marks and the references to Mr. Schwarzenegger’s name should be stricken for several reasons. First, Universal did not plead a likelihood of confusion claim based on its rights in the term ARNOLD or a similar term, and none of the pleaded registrations, applications, or references to rights in Mr. Schwarzenegger’s name relate to a bodybuilder design. Consequently, Applicant’s allegations do not have any relevance whatsoever to the issues in this case, namely, whether there is a likelihood of confusion between the Opposed Mark and Universal’s Bodybuilder Design.

Second, rather than provide a fuller understanding of the issues in this case, Applicant’s allegations unnecessarily complicate the issues in this proceeding by incorporating registrations, applications, and references that have no bearing whatsoever on the question of likelihood of confusion between two *design* marks. *See* TBMP § 506.01 (“[T]he Board, in its discretion, may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for the claim or defense.”).

Third, if Applicant’s allegations are allowed, it will greatly prejudice Universal by expanding the scope of issues in the proceeding, thereby increasing the costs of discovery. *See*

id.; *Canadian St. Regis Band of Mohawk Indians ex. rel. Francis v. New York*, 278 F. Supp. 2d 313, 325 (S.D.N.Y. 2003) (stating that prejudice requirement would be satisfied and the motion to strike would be granted where inclusion of the defense would result in increased time and expense, including extensive and burdensome discovery) (citing *S.E.C. v. Toomey*, 866 F. Supp. 719, 722 (S.D.N.Y. 1992)).

Accordingly, Applicant's allegations concerning its purported rights in the "ARNOLD" marks and Mr. Schwarzenegger's name should be stricken.

b. Applicant's Affirmative Defenses are insufficient, redundant, and fail to provide fair notice of Applicant's defenses.

Applicant's Affirmative Defenses included the following allegations or statements: (1) an allegation that the Opposed Mark is inherently distinctive and consumers are likely to associate the mark with Arnold Schwarzenegger; (2) a statement incorporating all of the allegations included in Applicant's Counterclaims; and (3) a statement reserving Applicant's right to raise additional affirmative defenses in the future. As set forth below, Applicant's Affirmative Defenses are insufficient, redundant, and fail to provide fair notice of Applicant's defenses.

i. Applicant's "inherently distinctive" argument is insufficiently pled.

Applicant first alleges that the Opposed Mark is an actual likeness of Arnold Schwarzenegger, the Opposed Mark is inherently distinctive, and consumers are likely to associate the Opposed Mark with Arnold Schwarzenegger. (Answer, ¶ 11.) However, Applicant's broad allegation that the Opposed Mark is inherently distinctive fails to clarify in relation to what goods and/or services the mark is inherently distinctive. "The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted," and "[t]he elements of a defense should be stated simply, concisely, and directly." TBMP §§ 311.02(b) and 506.01. Applicant's broad allegation does not provide fair

notice of the factual basis for its defense to the extent that it does not clarify in relation to what goods and/or services the Opposed Mark is distinctive; therefore, the defense should be stricken.

- ii. Applicant's defense repeating the allegations contained in Applicant's Counterclaim is redundant.

Second, Applicant merely repeats the allegations contained in its Counterclaim. (Answer, ¶ 12.) Section 506.01 of the TBMP states that allegations that are repetitive may be stricken from a pleading. Moreover, where an affirmative defense is identical to or alleges the same facts that form the basis for the counterclaim, the defense should be stricken. *See Cont'l Gummi-Werke Ag v. Cont'l Seal Corp.*, 222 U.S.P.Q. 822 (TTAB 1984) (affirmative defense stricken where affirmative defense and counterclaim were identical); *W.R. Grace & Co. v. Arizona Feeds*, 195 U.S.P.Q. 670 (Comm'r 1977) (affirmative defenses stricken as redundant because the same allegations were repeated and formed the basis for the counterclaim).

Applicant's Affirmative Defense in this case states: "Fitness Publications incorporates the allegations of the counter-claims referenced below." (Answer ¶ 12.) This Affirmative Defense repeats the allegations and the grounds that form the basis for Applicant's Counterclaim. Because Applicant's Affirmative Defense is identical to and merely repeats the allegations contained in Applicant's Counterclaim, it should be stricken.

- iii. Applicant's "reservation of defenses" defense does not provide fair notice to Universal.

Third, Applicant alleged the following: "Fitness Publications hereby reserves the right to amend its answer to raise additional affirmative defenses as they become available or apparent..." (Answer ¶ 13.) The TTAB has previously held that this type of "reservation of defenses" defense is improper because it fails to provide a plaintiff with fair notice of the pleaded defenses. *See Fushu Daiko Inc. v. Moraes*, Opposition No. 91201377, pp. 12-13 (TTAB July 2, 2012) ("A defendant cannot reserve unidentified defenses since it does not provide a plaintiff fair

notice of such defenses.”); *The Solomon-Page Group LLC, et al. v. Clinical Res. Network*, Opposition No. 91195692, p. 10 (TTAB March 12, 2012) (striking unidentified defenses because it does not provide plaintiff with a fair notice of such defenses). As a result, Applicant’s “reservation of defenses” defense should be stricken.

III. CONCLUSION

For the reasons set forth above, Universal respectfully requests that the Board strike Applicant’s Counterclaim allegations concerning registrations, applications, and other statements relating to its purported rights in the “ARNOLD” marks or Mr. Schwarzenegger’s name and all of Applicant’s Affirmative Defenses. Universal also requests that the Board suspend the proceedings pending consideration of Universal’s present motion, and the deadlines for the initial discovery conference and all subsequent dates be reset accordingly.

Respectfully submitted,

Universal Protein Supplements Corporation

Dated: June 24, 2015

/Craig Beaker/
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CERTIFICATE OF SERVICE

I certify that OPPOSER'S MOTION TO STRIKE & SUSPEND PROCEEDINGS was served on Fitness Publications, Inc. by mailing a copy by first class mail, postage prepaid, to its attorney of record, David W. Grace, Loeb & Loeb LLP, 10100 Santa Monica Boulevard, Suite 2200, Los Angeles, California 90067-4120.

Dated: June 24, 2015

/Craig Beaker/
Craig A. Beaker