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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
Correspondence Address	MAUREEN BEACOM GORMAN MARSHALL GERSTEIN & BORUN 233 S WACKER DR STE 6300 CHICAGO, IL 60606 UNITED STATES mgorman@marshallip.com, kking@marshallip.com, cbeaker@marshallip.com
Submission	Answer to Counterclaim
Filer's Name	Maureen Beacom Gorman
Filer's e-mail	mgorman@marshallip.com, kking@marshallip.com, jgriffith@marshallip.com
Signature	/mbgorman/
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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 ANSWER TO COUNTERCLAIM**

The Opposer and Counterclaim Respondent, Universal Protein Supplements Corporation (“Opposer”), hereby answers the counterclaim of Fitness Publications, Inc. (hereinafter “Applicant”):<sup>1</sup>

14. Fitness Publications believes it is being damaged and will continue to be damaged by the maintenance of U.S. Registration No. 4,483,690 on the Principal Register.

**ANSWER:** Opposer is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 14 concerning Applicant’s beliefs, and therefore denies the same. Opposer denies that Applicant is being damaged or will continue to be damaged by the maintenance of U.S. Registration No. 4,483,690 on the Principal Register (“Reg. ‘690”).

15. Universal Nutrition has relied upon U.S. Registration No. 4,483,690 as a basis for opposing registration of the Fitness Silhouette Mark on the grounds of priority and likelihood of confusion under Section 2(d) of the Trademark Act.

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<sup>1</sup> Paragraphs 1-13 of Applicant’s Answer to the First Amended Notice of Opposition and Applicant’s Cancellation Counterclaim relate to Applicant’s Answer. Accordingly, Opposer’s answer to Applicant’s counterclaim begins with paragraph 14.

**ANSWER:** Opposer admits the allegations contained within paragraph 15. To the extent paragraph 15 suggests that Reg. '690 is the only basis for Opposer's opposition, Opposer denies the allegation.

16. Fitness Publications hereby petitions to cancel U.S. Registration No. 4,483,690, and, as grounds for cancellation, alleges as follows:

**ANSWER:** Opposer admits that Applicant petitions to cancel Reg. '690. Opposer denies that the grounds set forth by Applicant in its counterclaim have any merit.

### **FITNESS PUBLICATIONS' FAMOUS "ARNOLD" NAMES AND MARKS**

17. Arnold Schwarzenegger is a world famous actor, former governor of California, businessman, and former professional bodybuilder.

**ANSWER:** Opposer admits that Schwarzenegger is a world famous actor, former governor of California, and former professional bodybuilder. Opposer is without knowledge or information sufficient to form a belief as to the truth of the remainder of the allegations in paragraph 17, and therefore denies the same.

18. Schwarzenegger began weight training as a teenager, and won his first title in 1965. In 1967, at age 20, he first won the "Mr. Universe" title; he went on to win the "Mr. Universe" competition four more times. Schwarzenegger also held the title of "Mr. Olympia" seven times, most recently in 1980. The 1977 film Pumping Iron documents the story of Schwarzenegger's preparation for the "Mr. Olympia" contest. A 25th anniversary edition of the film was released in 2003.

**ANSWER:** Opposer is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 18, and therefore denies the same. Opposer further denies that the allegations in paragraph 18 have any relevance to Applicant's counterclaim

because Opposer's mark does not depict Schwarzenegger and because Applicant lacks standing to assert rights in Schwarzenegger's name and likeness generally.

19. Schwarzenegger is a published authority on the subject of bodybuilding. His books include:

- *Arnold: The Education of a Bodybuilder (Simon & Schuster, 1977);*
- *Arnold's Bodyshaping for Women (Simon & Schuster, 1979);*
- *Arnold's Bodybuilding for Men (Simon & Schuster, 1981);*
- *The Encyclopedia of Modern Bodybuilding (Simon & Schuster, 1985);*
- *Arnold's Fitness for Kids (Doubleday, 1993); and*
- *The New Encyclopedia of Modern Bodybuilding : The Bible of Bodybuilding (Simon & Schuster, 1988).*

**ANSWER:** Opposer is without knowledge or information sufficient to form a belief as to the truth of the remainder of the allegations in paragraph 19, and therefore denies the same. Opposer further denies that the allegations in paragraph 19 have any relevance to Applicant's counterclaim because Opposer's mark does not depict Schwarzenegger and because Applicant lacks standing to assert rights in Schwarzenegger's name and likeness generally.

20. Schwarzenegger's name and image are iconic in the sport of bodybuilding. Since 1989, Schwarzenegger's legacy has been commemorated annually in the "Arnold Classic" bodybuilding competition. He has been depicted on the cover of more than 1,000 magazines, many of which were associated with bodybuilding, sports, and fitness. In the early 1990s, Schwarzenegger was featured in a weekly fitness Q&A column in USA Weekend entitled "Ask Arnold" which reached 33.5 million readers. He has made hundreds of film and television appearances as himself. He has also released videos in the fields of bodybuilding and fitness,

including "Shape Up With Arnold", which was released in 1983. For many years, Schwarzenegger wrote a monthly column for Muscle & Fitness and Flex, and he is currently serving as executive editor of both publications.

**ANSWER:** Opposer is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 20, and therefore denies the same. Opposer further denies that the allegations in paragraph 20 have any relevance to Applicant's counterclaim because Opposer's mark does not depict Schwarzenegger and because Applicant lacks standing to assert rights in Schwarzenegger's name and likeness generally.

21. The name and the likeness of Schwarzenegger (including without limitation the following likenesses) are famous with respect to bodybuilding.



**ANSWER:** Opposer denies the allegations contained in paragraph 21. Opposer further denies that the allegations in paragraph 21 have any relevance to Applicant's counterclaim because Opposer's mark does not depict Schwarzenegger. Opposer further states that the allegations of paragraph 21 are irrelevant to the extent they suggest they assert rights in marks other than the Schwarzenegger Image Registrations and the Schwarzenegger Image Applications because Applicant lacks standing to assert rights in Schwarzenegger's name and likeness generally.

22. Schwarzenegger's name and likeness have been famous with respect to bodybuilding since prior to the filing date of Universal Nutrition's application to register the

mark depicted in the UN Registration, as well as prior to the date of first use of that mark claimed by Universal Nutrition in its application to register the UN Registration.

**ANSWER:** Opposer denies the allegations contained in paragraph 22. Opposer further denies that the allegations in paragraph 22 have any relevance to Applicant's counterclaim because Opposer's mark does not depict Schwarzenegger and because Applicant lacks standing to assert rights in Schwarzenegger's name and likeness generally.

23. Since retiring from the sport of bodybuilding, Schwarzenegger has achieved celebrity as a film and television actor, and as the Governor of California from 2003 until 2010.

**ANSWER:** Opposer admits the allegations contained in paragraph 23. Opposer denies that the allegations in paragraph 23 have any relevance to Applicant's counterclaim because Opposer's mark does not depict Schwarzenegger and because Applicant lacks standing to assert rights in Schwarzenegger's name and likeness generally.

24. Schwarzenegger is a recognized authority in the areas of fitness and nutrition. The Arnold Fitness Expo — held during the annual Arnold Sports Festival — features over 800 exhibition booths showcasing the latest in sports equipment, apparel, and nutrition as well as a stage that hosts unique, non-stop competitions, and entertainment.

**ANSWER:** Opposer is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 24, and therefore denies the same. Opposer further denies that the allegations in paragraph 24 have any relevance to Applicant's counterclaim because Opposer's mark does not depict Schwarzenegger and because Applicant lacks standing to assert rights in Schwarzenegger's name and likeness generally.

25. With the consent of Schwarzenegger, Fitness Publications has obtained federal trademark protection for Schwarzenegger's name and likeness and it is the owner of the

following federal trademark registrations, among others (the "Schwarzenegger Image Registrations"):

Mark	Registration Date	Reg. No.	Goods/Services
	4/20/2004	2833705	Clothing and headwear, namely, t-shirts, shirts
THE ARNOLD SCHWARZENEGGER CLASSIC	12/19/1989	1572499	Entertainment services in the nature of weightlifting and body building competitions
ARNOLD CLASSIC	2/13/2007	3208453	Entertainment services in the nature of fitness and bodybuilding competitions
ARNOLD SPORTS FESTIVAL	1/2/2007	3192055	Entertainment in the nature of demonstrations of athletic skills

**ANSWER:** Opposer admits that based on the online records of the U.S. Trademark Office, Fitness Publications is the owner of the aforementioned trademark registrations. Opposer denies that the good and services listed for Reg. No. 2833705 are accurate because according to the records of the U.S. Trademark Office “headwear” has been stricken from the registration and the goods and services read: “Clothing, namely, t-shirts, shirts.” Opposer is without knowledge or information sufficient to form a belief as to the truth of the remainder of the allegations in paragraph 25, and therefore denies the same. Opposer further denies that the allegations in paragraph 25 have any relevance to Applicant’s counterclaim because Opposer’s mark does not depict Schwarzenegger..

26. With the consent of Schwarzenegger, Fitness Publications has also applied for federal trademark protection of Schwarzenegger's name and likeness, including the pending

applications listed below (the "Schwarzenegger Image Applications") (collectively, with the Schwarzenegger Image Registrations, the "Schwarzenegger Image Marks"):

<b>Mark</b>	<b>Filing Date</b>	<b>Serial No.</b>	<b>Goods/Service</b>
	8/1/2013	86026728	Dietary and nutritional supplements.
ARNOLD	1/6/15	86496501	Dietary and nutritional supplements
ARNOLD SCHWARZENEGGER	8/1/2013	86026727	Dietary and nutritional supplements.
ARNOLD SCHWARZENEGGER MUSCLE BAR	7/18/2014	86340887	Nutritional supplements, namely, high-protein bars.
ARNOLD SCHWARZENEGGER BLUEPRINT	2/18/2014	86197124	Dietary and nutritional supplements; Educational services, namely, conducting classes and programs in the field of fitness and nutrition; physical education; physical fitness education and training; providing information in the field of fitness and nutrition; Dietary and nutritional guidance; providing information about dietary supplements and nutrition
ARNOLD SCHWARZENEGGER BLUEPRINT TO CUT	2/18/2014	86197131	Dietary and nutritional supplements; Educational services, namely, conducting classes and programs in the field of fitness and nutrition; physical education; physical fitness education and training; providing information in the field of fitness and nutrition; Dietary and nutritional guidance; providing information about dietary supplements and nutrition

ARNOLD SCHWARZENEGGER BLUEPRINT TO MASS	2/18/2014	86197133	Dietary and nutritional supplements; Educational services, namely, conducting classes and programs in the field of fitness and nutrition; physical education; physical fitness education and training; providing information in the field of fitness and nutrition; Dietary and nutritional guidance; providing information about dietary supplements and nutrition
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**ANSWER:** Opposer admits that based on the online records of the U.S. Trademark Office, Fitness Publications has filed the aforementioned trademark applications. Opposer denies that the recitation of goods and services for Ser. No. 86197124 is accurate because according to the records of the U.S. Trademark Office the recitation reads: “Dietary and nutritional supplements for human consumption; Educational services, namely, conducting classes and programs in the field of fitness and nutrition; physical education; physical fitness education and physical fitness training services; Providing information in the field of nutrition; dietary and nutritional guidance; providing information about dietary supplements and nutrition.” Opposer further denies that the recitation of goods and services for Ser. Nos. 86197131 or 86197133 are accurate because according to the records of the U.S. Trademark Office the recitation for each application reads: “Dietary and nutritional supplements; Educational services, namely, conducting classes and programs in the field of fitness and nutrition; physical education; physical fitness education and physical fitness training services; Providing information in the field of nutrition; dietary and nutritional guidance; providing information about dietary supplements and nutrition.” Opposer is without knowledge or information sufficient to form a belief as to the truth of the remainder of the allegations in paragraph 21, and therefore denies the

same. Opposer further denies that the allegations in paragraph 26 have any relevance to Applicant's counterclaim because Opposer's mark does not depict Schwarzenegger.

27. Fitness Publications has used some of the Arnold Marks in commerce in the United States in connection with the goods and services listed in the registration certificates since prior to the filing date of Universal Nutrition's application to register the mark depicted in the UN Registration, as well as prior to the first use date claimed by Universal Nutrition in the mark depicted in the UN Registration.

**ANSWER:** Opposer is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 27, and therefore denies the same. Opposer further denies that the Arnold Marks referenced in paragraph 27 have any relevance to Applicant's counterclaim because Opposer's mark does not depict Schwarzenegger.

### **UNIVERSAL NUTRITION'S BODYBUILDER DESIGN**

28. Universal Nutrition's mark which is the subject of the UN Registration depicts the silhouette of a flexing male bodybuilder.

**ANSWER:** Opposer admits the allegations contained in paragraph 28.

29. On its website at [www.universalusa.com](http://www.universalusa.com), Universal Nutrition describes its brand as the "one name that is on the lips of serious and dedicated bodybuilders intent on sculpting and chiseling that perfect physique." The goods and services in Universal Nutrition's registration are all related to bodybuilding and marketed and advertised specifically to the bodybuilding community.

**ANSWER:** Opposer admits that on its website at [www.universalusa.com](http://www.universalusa.com), Opposer describes its brand as the "one name that is on the lips of serious and dedicated bodybuilders

intent on sculpting and chiseling that perfect physique." Opposer denies the remaining allegations contained within paragraph 29.

30. Neither Arnold Schwarzenegger nor Fitness Publications is connected with the activities performed by Universal Nutrition under the mark depicted in the UN Registration. Neither Arnold Schwarzenegger nor Fitness Publications has authorized or consented to registration of the mark in the UN Registration.

**ANSWER:** Opposer admits that neither Schwarzenegger nor Fitness Publications is connected with the activities performed by Universal Nutrition under the mark depicted in the UN Registration. Opposer further admits that neither Schwarzenegger nor Fitness Publications has authorized or consented to registration of the mark in the UN Registration. Opposer denies the implication that such authorization or consent is necessary.

### **MERELY DESCRIPTIVE**

#### **(TRADEMARK ACT SECTION 2(E)(1))**

31. Whereas the Fitness Silhouette Mark depicts the likeness of the famous bodybuilder Arnold Schwarzenegger, the mark in the UN Registration merely depicts a generic bodybuilder silhouette.

**ANSWER:** Opposer denies the allegations contained in paragraph 31.

32. Upon information and belief, it is relatively common in the marketplace to use the image or design of a bodybuilder in connection with goods and/or services targeting the bodybuilding community.

**ANSWER:** Opposer denies the allegations contained in paragraph 32.

33. As used on and in connection with the offering of goods and services intended for use by bodybuilders, the mark in the UN Registration is merely descriptive.

**ANSWER:** Opposer denies the allegations contained in paragraph 33.

## **FAILURE TO FUNCTION AS A MARK**

### **(TRADEMARK ACT SECTION 1)**

34. The mark depicted in the UN Registration does not function as a trademark for the goods and services listed in the registration, but is merely ornamental or informational as applied to Universal Nutrition's goods and services.

**ANSWER:** Opposer denies the allegations contained in paragraph 34.

35. Upon information and belief, Universal was not using the bodybuilder design as a mark as of the filing date of its application to register the mark with the U.S. Patent & Trademark Office.

**ANSWER:** Opposer denies the allegations contained in paragraph 35.

36. Upon information and belief, Universal was not using the bodybuilder design as a mark as of the date of first use claimed by Universal in its application to register the mark with the U.S. Patent & Trademark Office.

**ANSWER:** Opposer denies the allegations contained in paragraph 36.

37. Upon information and belief, consumers are not likely to view Universal Nutrition's bodybuilder design as signifying the source or origin of the goods or services in connection with which it is used.

**ANSWER:** Opposer denies the allegations contained in paragraph 37.

## **FALSE SUGGESTION OF A CONNECTION**

### **(TRADEMARK ACT SECTION 2(A))**

38. Arnold Schwarzenegger's likeness and identity was famous prior to both the January 8, 2013 filing date of the application for federal registration of Universal Nutrition's bodybuilder design and the 1998 date of first use in commerce claimed by Universal Nutrition in its application.

**ANSWER:** Opposer denies the allegations contained in paragraph 38. Opposer further states that the allegations contained in paragraph 38 are irrelevant to Applicant's counterclaim.

39. Universal Nutrition claims in its First Amended Notice of Opposition filed on March 24, 2015 and its Notice of Opposition filed on December 29, 2014 that the mark in its UN Registration and the Fitness Silhouette Mark are likely to be confused by the public. If this contention were accurate, then such confusion would be likely only because Universal Nutrition's mark is a close approximation of Schwarzenegger's likeness and/or identity. Schwarzenegger's fame and reputation is such that, when a mark approximating his likeness and identity is used without his authorization or consent on Universal Nutrition's bodybuilding-related goods or services, a connection with Schwarzenegger and/or Fitness Publications would be presumed.

**ANSWER:** Opposer admits that the mark in its UN Registration and the Fitness Silhouette Mark are likely to be confused by the public for use with Universal's products and services. Opposer further admits that it alleges that fact in its First Amended Notice of Opposition filed on March 24, 2015, and its Notice of Opposition filed on December 29, 2014. Opposer denies the remaining allegations contained in paragraph 39.

40. Upon information and belief, if the allegations of Universal Nutrition are true, then Universal Nutrition's selection of the mark depicted in U.S. Reg. No. 4,483,690 was intended to and/or does create a false association with Schwarzenegger.

**ANSWER:** Opposer admits that the allegations of Universal Nutrition related to a likelihood of confusion between the parties' marks in its First Amended Notice of Opposition

and Notice of Opposition are true. Opposer denies the remaining allegations contained in paragraph 40.

### **AFFIRMATIVE DEFENSES**

#### **FAILURE TO STATE A CLAIM UPON WHICH RELIEF MAY BE GRANTED**

1. Applicant's counterclaim based on Section 2(a) fails to state a claim because the statement that "Universal Nutrition's mark is a close approximation of Schwarzenegger's likeness and/or identity" is without any factual basis and therefore Applicant's counterclaim under Section 2(a) does not state a plausible claim for relief.

2. Applicant's counterclaim based on Section 2(e)(1) fails to state a claim for genericness upon which relief may be granted.

3. Applicant's counterclaim based on Section 2(e)(1) fails to state a claim for merely descriptiveness upon which relief may be granted.

#### **STANDING**

4. Applicant lacks standing to assert its claim under Section 2(a). Applicant's false suggestion claim does not cite and is not based upon any purported rights it may hold in the Schwarzenegger Image Registrations and the Schwarzenegger Image Applications. Rather, Applicant's claim under Section 2(a) is grounded in an assertion of rights in Schwarzenegger's likeness and identity generally. Schwarzenegger is a third party to this proceeding. Applicant has pled no facts sufficient to establish its right or capacity to assert any interest to Schwarzenegger's likeness or identity beyond the Schwarzenegger Image Registrations and the Schwarzenegger Image Applications, as to which Schwarzenegger has allegedly given his consent. Accordingly, Applicant lacks standing to assert its claim that Opposer's mark causes a false suggestion of a connection between Opposer and Schwarzenegger.

## SECONDARY MEANING

5. Applicant's counterclaim based upon Section 2(e)(1) must be denied since the Bodybuilder Design Mark has had secondary meaning for the pertinent goods and services at all times relevant to the claims at issue.

### 2(A) CLAIM BARRED BY ESTOPPEL BY LACHES

6. Universal Nutrition has used the Bodybuilder Design Mark on nutritional supplements for human consumption; clothing, namely, hats, caps, bottoms, tops, shorts, pants, shirts, sweat shirts, sweat pants, sweat shorts, sweat jackets; and on-line retail store services featuring health and diet-related products (the "Universal Nutrition's Goods and Services") in commerce in the United States since at least as early as 1998.

7. Application No. 85817659 for the Bodybuilder Design Mark was published for opposition on December 3, 2013.

8. Neither Applicant nor Schwarzenegger opposed Application No. 85817659.

9. Registration No. 4483690 for the Bodybuilder Design Mark issued February 18, 2014.

10. The February 18, 2014 registration date provided Applicant and Schwarzenegger on that date with at least constructive notice of Universal Nutrition's claim of ownership of the Bodybuilder Design Mark, as used in the United States, on Universal Nutrition's Goods and Services listed in Registration No. 4483690.

11. The Bodybuilder Design Mark is incorporated in the UNIVERSAL and Design Mark displayed below:



12. Universal Nutrition has used the UNIVERSAL and Design Mark on supplements, namely, dietary food supplements, dietary supplements, food supplements, herbal supplements, meal replacement and dietary supplement drink mixes, mineral nutritional supplements, mineral supplements, nutritional supplements, powdered nutritional supplement drink mix, vitamin and mineral supplements, vitamin supplements, meal replacement bars (the “Universal Nutrition Supplements”) in commerce in the United States since at least as early as 1998.

13. The application that matured into the registration of UNIVERSAL and Design Mark, Application No. 77165046, was published for opposition on October 21, 2008.

14. Neither Applicant nor Schwarzenegger opposed Application No. 77165046.

15. The UNIVERSAL and Design Mark registration (Registration No. 3555885) issued January 6, 2009.

16. The January 6, 2009 registration date provided Applicant and Schwarzenegger on that date with at least constructive notice of Universal Nutrition's claim of ownership of the subject mark, as used in the United States on Universal Nutrition Supplements as listed in Registration No. 3555885.

17. Neither Applicant nor Schwarzenegger has ever petitioned to cancel Registration No. 3555885 and Applicant had constructive notice thereof.

18. Applicant did not petition to cancel Registration No. 4483690 until on or about May 27, 2015, more than one year after the Application No. 85817659 was published for

opposition and the subject registration issued, and more than six years after Applicant had constructive notice of Universal Nutrition's claims in the design through the prior registration of the UNIVERSAL and Design Mark incorporating an identical design element.

19. The extended delay by Applicant in asserting the claim set forth in the Counterclaim is unreasonable.

20. During the period in which Applicant delayed challenging Registration No. 3555885 and Registration No. 4483690, Universal Nutrition invested in and built up substantial goodwill in the Bodybuilder Design Mark for supplements and related goods and services in the United States.

21. If the Counterclaim is granted, Universal Nutrition, because of its longstanding investment in, and its acquisition of goodwill in, the Bodybuilder Design Mark for supplements and related goods and services in the United States, will be severely prejudiced by Applicant's delay in bringing its claim, incurring economic prejudice and other detriment, including the possible forfeiture of such goodwill.

22. Thus, the doctrine of estoppel by laches bars Applicant's 2(a) claim in this proceeding.

2(A) CLAIM BARRED BY THE MOREHOUSE DEFENSE

23. Universal Nutrition has used the Bodybuilder Design Mark on nutritional supplements for human consumption; clothing, namely, hats, caps, bottoms, tops, shorts, pants, shirts, sweat shirts, sweat pants, sweat shorts, sweat jackets; and on-line retail store services featuring health and diet-related products (the "Universal Goods and Services") in commerce in the United States since at least as early as 1998.

24. Application No. 85817659 for the Bodybuilder Design Mark was published for opposition on December 3, 2013.

25. Neither Applicant nor Schwarzenegger opposed Application No. 85817659.

26. Registration No. 4483690 for the Bodybuilder Design Mark issued February 18, 2014.

27. The February 18, 2014 registration date provided Applicant and Schwarzenegger on that date with at least constructive notice of Universal Nutrition's claim of ownership of the Bodybuilder Design Mark, as used in the United States on Universal Nutrition's Goods and Services listed in Registration No. 4483690.

28. The Bodybuilder Design Mark is incorporated in the UNIVERSAL and Design Mark displayed below:



29. Universal Nutrition has used the UNIVERSAL and Design Mark on supplements, namely, dietary food supplements, dietary supplements, food supplements, herbal supplements, meal replacement and dietary supplement drink mixes, mineral nutritional supplements, mineral supplements, nutritional supplements, powdered nutritional supplement drink mix, vitamin and mineral supplements, vitamin supplements, meal replacement bars (the "Universal Nutrition Supplements") in commerce in the United States since at least as early as 1998.

30. The application that matured as the registration of UNIVERSAL and Design Mark, Application No. 77165046, was published for opposition on October 21, 2008.

31. Neither Applicant nor Schwarzenegger opposed Application No. 77165046.

32. The UNIVERSAL and Design Mark registration (Registration No. 3555885) issued January 6, 2009.

33. The January 6, 2009 registration date provided Applicant and Schwarzenegger on that date with at least constructive notice of Universal Nutrition's claim of ownership of the subject mark, as used in the United States on Universal Nutrition Supplements as listed in Registration No. 3555885.

34. Neither Applicant nor Schwarzenegger has ever petitioned to cancel Registration No. 3555885 and Applicant had constructive notice thereof.

35. Applicant did not petition to cancel Registration No. 4483690 until on or about May 27, 2015, more than one year after the Application No. 85817659 was published for opposition and the subject registration issued, and more than six years after Applicant had constructive notice of Universal Nutrition's claims in the design through the prior registration of the UNIVERSAL and Design Mark incorporating an identical design element.

36. The extended delay by Applicant in asserting the claim set forth in the Counterclaim is unreasonable.

37. During the period in which Applicant delayed challenging Registration No. 3555885 and Registration No. 4483690, Universal Nutrition invested in and built up substantial goodwill in the Bodybuilder Design Mark for supplements and related goods and services in the United States.

38. If the Counterclaim is granted, Universal Nutrition, because of its longstanding investment in, and its acquisition of goodwill in, the Bodybuilder Design Mark for supplements and related goods and services in the United States, will be severely prejudiced by the delay in

bringing Applicant's claim, incurring economic prejudice and other detriment, including the possible forfeiture of such goodwill.

39. Thus, the *Morehouse* Defense bars Applicant's 2(a) claim in this proceeding.

ESTOPPEL BY SCHWARZENEGGER'S ACQUIESCENCE

40. Applicant alleges that it registered and filed applications for registration for its marks based upon the consent of Schwarzenegger.

41. Applicant alleges that Schwarzenegger is the editor of Muscle & Fitness and Flex magazines.

42. Universal Nutrition advertises with, and is therefore a customer of Muscle & Fitness and Flex magazines, and Universal Nutrition has been doing business with those magazines for nearly two decades.

43. Muscle & Fitness and Flex magazines have regularly published Universal Nutrition advertisements which prominently feature the Bodybuilder Design Mark and the UNIVERSAL and Design mark for nearly two decades. Therefore, Schwarzenegger impliedly consented to Universal Nutrition's use and registration of its marks.

COUNTERCLAIMS SHOULD BE DISMISSED UNDER RULES 12(B) AND 19(A)

44. The Board cannot accord complete relief to Universal Nutrition on its defense to Applicant's Counterclaims, since Applicant failed to join Schwarzenegger, purported licensor to Applicant, who acquiesced to Universal Nutrition's use of the mark at issue for more than two decades, in violation of Rule 19(a)(1)(A).

45. Applicant failed to join Schwarzenegger as a party leaving Universal Nutrition with a substantial risk of incurring double, multiple, or otherwise inconsistent obligations in violation of Rule 19(a)(1)(B)(ii).

46. Applicant failed to join Schwarzenegger as a party to the Counterclaim's false suggestion of origin claim. Schwarzenegger claims an interest relating to the subject of the action and is so situated that disposing of the action in Schwarzenegger's absence impairs and impedes Universal Nutrition's ability to protect its interests in violation of Rule 19(a)(1)(B)(i).

47. Therefore, Applicant's Counterclaims, specifically the Counterclaim's false suggestion of origin claim, must be dismissed under FRCP Rule 12(b)(7) and 19(a).

WHEREFORE, Universal Nutrition respectfully requests that Applicant's Counterclaims be denied and for such further relief as this Honorable Board deems appropriate.

Respectfully submitted,

Universal Protein Supplements Corporation  
d/b/a Universal Nutrition

Dated: November 25, 2015

/mbgorman/  
Maureen Beacom Gorman  
James E. Griffith  
MARSHALL, GERSTEIN & BORUN LLP  
6300 Willis Tower  
233 South Wacker Drive  
Chicago, Illinois 60606  
(312) 474-6300

Attorneys for Universal Protein Supplements  
Corporation d/b/a Universal Nutrition

**CERTIFICATE OF SERVICE**

I certify that OPPOSER'S ANSWER TO COUNTERCLAIM 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: November 25, 2015

/James E. Griffith  
James E. Griffith