

ESTTA Tracking number: **ESTTA449868**

Filing date: **01/06/2012**

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

Proceeding	92054868
Party	Defendant Zuffa, LLC
Correspondence Address	ZUFFA LLC ATTENTION LEGAL DEPARTMENT, 2960 W SAHARA AVENUE LAS VEGAS, NV 89102 UNITED STATES
Submission	Answer
Filer's Name	Michael N. Feder
Filer's e-mail	TRADEMARKS@GORDONSILVER.COM
Signature	/Michael N. Feder/
Date	01/06/2012
Attachments	Answer to Notice of Cancellation.pdf (8 pages)(19155 bytes)

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

UFC ULTIMATE FITNESS CENTER, LLC

Petitioner,

v.

Zuffa, LLC

Registrant.

Mark: UFC GYM
Reg. No. 3,999,175
Cancellation No. 92054868

**ZUFFA'S ANSWER TO PETITIONER'S PETITION TO CANCEL AND
AFFIRMATIVE DEFENSES**

Registrant Zuffa, LLC (“Zuffa”), a Nevada limited liability company with its principal place of business at 2960 W. Sahara Avenue, Las Vegas, Nevada 89102, by its attorneys, hereby answers Petitioner's Petition to Cancel as follows, with the following numbered Paragraphs corresponding to the numbered Paragraphs of the Petition to Cancel under the same headings used:

1. Zuffa is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1 and therefore denies the same.

2. Zuffa is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 2 and therefore denies the same.

3. Zuffa admits the allegations of Paragraph 3.

4. Zuffa denies the allegation in Paragraph 4 that the trademark application for U.S. Trademark Registration No. 3,999,175 was filed on December 15, 2008. Zuffa admits the remaining allegations of Paragraph 4. In addition, Zuffa is the owner of at

least 27 active trademark registrations and applications for UFC including, for example, U.S. Registration Nos. 2645312, 2941044, 3539015, 3600393, 3624854, 3647555, 3650245, 3674078, 3723920, 3841790, 3949117 and 3975659 ("Zuffa's UFC Marks" or "the UFC Marks") and at least 96 active trademark registrations and applications for UFC formative marks including, for example, U.S. Registration Nos. 3229582 (UFC ON DEMAND), 3483987 (UFC WIRED), 3710071 (UFC VAULT), 3715276 (UFC UNLEASHED), 3792513 (UFC POKER), 3796872 (UFC PRIMETIME), 3801084 (UFC POKER ROOM), 3890366 (UFC FAN EXPO), 3914854 (UFC ULTIMATE 100 GREATEST FIGHTS) and 4032298 (UFC KNOCKOUT HOLD 'EM) ("Zuffa's UFC Formative Marks" or "the UFC Formative Marks").

5. Zuffa admits that the USPTO issued a Non-Final Office Action dated on or about December 23, 2010, but said document is a document of independent legal significance, and Zuffa denies any and all allegations inconsistent therewith. Zuffa denies all remaining allegations.

6. Zuffa admits that the USPTO issued Suspension Notices dated February 4, 2011 and April 14, 2011, however both notices are documents of independent legal significance, and Zuffa denies any and all allegations inconsistent therewith. Zuffa denies all remaining allegations.

7. Zuffa admits the allegations of Paragraph 7.

8. The allegations asserted in Paragraph 8 assert a conclusion of law to which no response is required. To the extent a response is deemed required, said allegations are denied.

PETITIONER'S PRIORITY OF USE

9. Zuffa repeats its responses to the allegations of the preceding Paragraphs as if fully set forth herein.

10. Zuffa is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 10 and therefore denies the same.

11. Zuffa is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 11 and therefore denies the same.

12. Zuffa is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 12 and therefore denies the same.

13. Zuffa admits that it owns federally filed trademarks. Zuffa denies all remaining allegations. By way of further response, U.S. Registration No. 3,999,175, Zuffa's UFC Marks and UFC Formative Marks are famous, and relate back to as early as 1993, and Petitioner is wrongfully, improperly and intentionally attempting to trade off Zuffa's goodwill.

14. Zuffa's trademark registration for UFC GYM in International Class 041 is a document of independent legal significance, and Zuffa denies any and all allegations inconsistent therewith.

15. Certain allegations asserted in Paragraph 15 assert a conclusion of law to which no response is required. To the extent a response is deemed required, said allegations are denied. Zuffa denies the remaining allegations of Paragraph 15.

FALSE CONNECTION WITH PETITIONER

16. Zuffa repeats its responses to the allegations of the preceding Paragraphs as if fully set forth herein.

17. Zuffa denies the allegations of Paragraph 17.

18. Zuffa only admits that it is the registrant of the domain name www.ufcgym.com. Zuffa denies the remaining allegations of Paragraph 18.

19. Denied. By way of further response, the allegations asserted in Paragraph 19 assert a conclusion of law to which no response is required. To the extent a response is deemed required, said allegations are denied.

20. Denied. By way of further response, the allegations asserted in Paragraph 20 assert a conclusion of law to which no response is required. To the extent a response is deemed required, said allegations are denied.

21. Denied. By way of further response, the allegations asserted in Paragraph 21 assert a conclusion of law to which no response is required. To the extent a response is deemed required, said allegations are denied.

FRAUD BY REGISTRANT

22. Zuffa repeats its responses to the allegations of the preceding Paragraphs as if fully set forth herein.

23. Denied. By way of further response, the allegations asserted in Paragraph 23 assert a conclusion of law to which no response is required. To the extent a response is deemed required, said allegations are denied.

24. Zuffa denies the allegations of Paragraph 24.

25. Zuffa denies the allegations of Paragraph 25.

HARM TO PETITIONER

26. Zuffa repeats its responses to the allegations of the preceding Paragraphs as if fully set forth herein.

27. Denied. By way of further response, the allegations asserted in Paragraph 27 assert a conclusion of law to which no response is required. To the extent a response is deemed required, said allegations are denied.

28. Denied. By way of further response, the allegations asserted in Paragraph 28 assert a conclusion of law to which no response is required. To the extent a response is deemed required, said allegations are denied.

FIRST AFFIRMATIVE DEFENSE
(Failure to State a Claim upon which Relief can be Granted)

The Petition fails to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE
(Likelihood of Confusion)

The Petitioner's use of the UFC ULTIMATE FITNESS CENTER THE GYM THAT FITS YOUR LIFE! mark creates a likelihood of confusion under the Trademark Act § 2(d) with Zuffa's U.S. Registration No. 3,999,175 for UFC GYM, as well as Zuffa's UFC Marks and Zuffa's UFC Formative Marks.

THIRD AFFIRMATIVE DEFENSE
(Lack of Standing)

The Petitioner lacks standing because it is not currently damaged and will not be damaged in the future by Zuffa's U.S. Registration No. 3,999,175 for UFC GYM. Petitioner's allegations in support of its belief of damage do not have a reasonable basis in fact and are not anything more than a mere subjective belief.

FOURTH AFFIRMATIVE DEFENSE
(Reverse Confusion)

The Petitioner's use of the UFC ULTIMATE FITNESS CENTER THE GYM THAT FITS YOUR LIFE! mark creates the impression that Petitioner is the source of the Zuffa's services, which it is not.

///

///

**FIFTH AFFIRMATIVE DEFENSE
(Dilution)**

The Petitioner's use of the UFC ULTIMATE FITNESS CENTER THE GYM THAT FITS YOUR LIFE! mark dilutes the distinctiveness of Zuffa's U.S. Registration No. 3,999,175 for UFC GYM, as well as Zuffa's UFC Marks and Zuffa's UFC Formative Marks.

**SIXTH AFFIRMATIVE DEFENSE
(Identical Terms)**

The Petitioner's UFC ULTIMATE FITNESS CENTER THE GYM THAT FITS YOUR LIFE! mark shares the identical letters "UFC" with Zuffa's U.S. Registration No. 3,999,175 for UFC GYM, as well as Zuffa's UFC Marks and Zuffa's UFC Formative Marks.

**SEVENTH AFFIRMATIVE DEFENSE
(Superior Rights)**

Zuffa has used its UFC Marks and UFC Formative Marks since at least as early as 1993.

**EIGHTH AFFIRMATIVE DEFENSE
(Fraud not alleged with Particularity)**

Petitioner has failed to allege its fraud claims with the requisite particularity.

**NINTH AFFIRMATIVE DEFENSE
(Famous Marks)**

Petitioner's UFC ULTIMATE FITNESS CENTER THE GYM THAT FITS YOUR LIFE! mark is improperly benefitting from the fame associated with Zuffa's U.S. Registration No. 3,999,175, Zuffa's UFC Marks and Zuffa's UFC Formative Marks.

**TENTH AFFIRMATIVE DEFENSE
(Misappropriation of Goodwill)**

Petitioner's use of the UFC ULTIMATE FITNESS CENTER THE GYM THAT FITS YOUR LIFE! mark is misappropriating the goodwill associated with Zuffa's U.S. Registration 3,999,175, Zuffa's UFC Marks and Zuffa's UFC Formative Marks, thus improperly taking

advantage of Zuffa's substantial investment of time, effort, and money in creating the goodwill associated therewith.

WHEREFORE, Zuffa prays that the Board deny Petitioner's prayer to cancel Zuffa's Registration No. 3,999,175.

Dated: January 6, 2012

Respectfully submitted,

GORDON SILVER

/Michael N. Feder/

Michael N. Feder, Esq.

Jennifer K. Craft, Esq.

Ronald C. Gorsché, Esq.

3960 Howard Hughes Parkway, Ninth Floor

Las Vegas, Nevada 89169

trademarks@gordonsilver.com

(702) 796-5555 (phone)

(702) 369-2666 (fax)

