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Filing date: **05/02/2015**

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

Proceeding	92061019
Party	Defendant UFC Ultimate Fitness Center, LLC
Correspondence Address	ULTIMATE FITNESS CENTER LLC 1380 3RD AVE CHULA VISTA, CA 91911 UNITED STATES ufccv@cox.net
Submission	Motion to Suspend for Civil Action
Filer's Name	Matthew J. Faust
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Signature	/s MJFaust /
Date	05/02/2015
Attachments	TTAB019 [M Cons Susp][Mov][1].pdf(2732128 bytes )







this proceeding. Additionally, because the proceedings are all interrelated, the Board should consolidate them. Accordingly, the Board should grant this Motion.

### **FACTUAL AND PROCEDURAL BACKGROUND**

On October 20, 2011, Ultimate initiated cancellation proceedings under T.T.A.B. Proceeding No. 92054704 (hereinafter the “‘704 Proceeding”) to cancel Zuffa’s conflicting marks. [‘704 Doc. 1.] Shortly thereafter, Ultimate filed a second proceeding, No. 92054868 (hereinafter the “‘868 Proceeding”), which was consolidated by the Board, acting *sua sponte*, into the ‘704 Proceeding. [‘868 Doc. 6.] While the cancellation proceedings were pending, Zuffa initiated proceedings in the District of Nevada and the ‘704 Proceeding was suspended. [‘704 Doc. 90.] The suspension in the ‘704 Proceeding was extended after the Nevada court dismissed the case and Ultimate refiled its own civil case in the federal district court for the Southern District of California under case number 14-cv-2870-DMS-JMA (hereinafter, the “California Case”). [‘704 Doc. 96.]

Then, on 10 March 2015, Zuffa filed an answer and counterclaim in the California Case, (Faust Decl. Ex. A), along with four additional cancellation proceedings in this tribunal. Those proceedings, including this proceeding, were assigned Proceeding Numbers 92061013, 92061019, 92061038, and 92061064. A brief comparison of the petitions filed in these show that they are identical to the counterclaim Zuffa filed in the California Case in that they all seek cancellation of Ulimatte’s various registrations, alleging that Ultimate only obtained the registrations after making material misrepresentations to the examining attorney. For ease of comparison, the information has been summarized below:

<b>Proceeding No.</b>	<b>Serial / Registration No. of Subject Mark</b>	<b>Paragraph in Counterclaim</b>
92061013	86140667 / 4608679	¶ 150, <i>et seq</i>
92061019	86139383 / 4600344	¶ 102, <i>et seq</i>
92061038	86140607 / 4600347	¶ 115, <i>et seq</i>
92061064	85709994 / 4445286	¶ 63, <i>et seq</i>

As explained below, this proceeding should be suspended because California Case will have a bearing on the resolution of this proceeding. Additionally, these proceedings are all related to the original ‘704 Proceeding and should be consolidated.

### **ARGUMENT**

#### **I. THE BOARD SHOULD SUSPEND THE SUBJECT PROCEEDINGS PENDING THE RESOLUTION OF THE CALIFORNIA CASE.**

The Board should suspend this proceeding until the disposition of the California Case. Pursuant to 37 C.F.R. § 2.117, “[w]henver it shall come to the attention of the [Board] that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other proceeding.” Section 510.02 of the T.B.M.P. further explains this rule, stating that “the decision of the federal district court is often binding upon the Board, while the decision of the Board is not binding upon the Court.” As highlighted in the table above, each of Zuffa’s new proceedings and its counterclaim seek identical relief upon the exact same alleged facts. Thus, the determination of the California Case will have a bearing on each of Zuffa’s new proceedings, including this one. *See*, T.B.M.P § 510.02. Accordingly, the Board should suspend this proceeding.

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**II. THE BOARD SHOULD CONSOLIDATED THE SUBJECT PROCEEDINGS UNDER THE ‘704 PARENT CASE.**

The Board should consolidate this proceeding with the ‘704 Proceeding. Pursuant to Rule 42 of the F.R.C.P., a court may consolidate multiple proceedings if they “involve a common question of law or fact.” This rule was also incorporated into the T.B.M.P. under section 511, which provides that the Board will consider “the saving in time, effort, and expense, which may be gained from consolidation, against any prejudice or inconvenience that may be caused thereby.” The Board should exercise its discretion to consolidate the proceedings in this case because involve common issues of law and fact. First, the parties in all of the proceedings are identical. Second, the facts surrounding the proceedings are similar. While it is true that the proceedings focus on different marks, many common issues will arise. For instance, the crux of each of the petitions is whether it is Zuffa or Ultimate that is the senior user of the subject mark, and whether the use of the marks overlaps. In the ‘704 Proceeding, Ultimate contends that it was the first to use the subject marks and that Zuffa made materially misrepresented its status as the senior user when it registered for its marks. In Zuffa’s new proceedings, including this proceeding, Zuffa alleges that Ultimate made material misrepresentations in obtaining its marks regarding its status as the senior user of the marks. Indeed, the fundamental overlap between these petitions is exposed by a comparison of the parties’ claims against each other in the California Case. (*Compare*, ‘704 Doc. No. 96, *with* Faust Decl. Ex. A.) Thus, it will be more efficient to resolve each of these issues concurrently with the original petition filed by Ultimate. Accordingly, the Board should consolidate the proceedings, including this proceeding, with the ‘704 Proceedings.

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# Exhibit A

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*Attorneys for Zuffa, LLC*

15  
16 **UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA**

17 UFC ULTIMATE FITNESS CENTER,  
18 LLC, a California limited liability  
19 company

20 Plaintiff,

21 vs.

22 ZUFFA, LLC a Nevada limited liability  
23 company,

24 Defendant.  
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CASE NO. 14CV2870 DMS JMA

**ANSWER AND COUNTERCLAIM  
TO PLAINTIFF'S COMPLAINT**

Judge: Hon. Dana M. Sabraw

**JURY TRIAL DEMANDED**

1 ZUFFA, LLC a Nevada limited liability  
2 company,

3 Counterclaimant,

4 vs.

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6 UFC ULTIMATE FITNESS CENTER,  
7 LLC, a California limited liability  
8 company,

9 Counterdefendant.

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1 Zuffa, LLC (“UFC”),<sup>1</sup> by and through its counsel at the law firms of Gordon  
2 Silver and Caldarelli Hejmanowski Page & Leer LLP, hereby responds to the  
3 allegations contained in the Complaint filed by the Plaintiff UFC Ultimate Fitness  
4 Center, LLC (“Plaintiff”) as follows:<sup>2</sup>

5 1. In Answering Paragraph 1 of the Complaint, UFC denies the  
6 allegations contained therein.

7 2. In Answering Paragraph 2 of the Complaint, UFC denies the  
8 allegations contained therein.

9 3. In Answering Paragraph 3 of the Complaint, UFC denies the  
10 allegations contained therein.

11 **JURISDICTION AND VENUE**

12 4. In Answering Paragraph 4 of the Complaint, UFC states that the  
13 allegations contained in this paragraph assert a conclusion of law to which no  
14 response is required. To the extent a response is deemed required, UFC denies the  
15 allegations.

16 5. In Answering Paragraph 5 of the Complaint, UFC states that the  
17 allegations contained in this paragraph assert a conclusion of law to which no  
18 response is required. To the extent a response is deemed required, UFC denies the  
19 allegations.

20 6. In Answering Paragraph 6 of the Complaint, UFC states that the  
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22 <sup>1</sup> Plaintiff refers to itself in its Complaint as “UFC” in an effort to confuse this  
23 Court and further misappropriate Zuffa’s UFC® brand. Plaintiff did not even  
24 create its corporate entity containing “UFC” until 2011—nearly fifteen (15) years  
25 after it opened its doors as “Ultimate Fitness Center” and following the refusal of  
its trademark application. Prior to that point it was a sole proprietorship owned by  
26 Robert Hueso. Since Zuffa is the UFC, it will be referred to herein as UFC.

27 <sup>2</sup> To the extent any allegation contained in Plaintiff’s Complaint has not been  
28 specifically admitted herein, it is hereby denied. UFC further denies any  
allegations that may be implied by or inferred from the headings contained in  
Plaintiff’s Complaint.

1 allegations contained in this paragraph assert a conclusion of law to which no  
2 response is required. To the extent a response is deemed required, UFC denies the  
3 allegations.

4 7. In Answering Paragraph 7 of the Complaint, UFC states that the  
5 allegations contained in this paragraph assert a conclusion of law to which no  
6 response is required. To the extent a response is deemed required, UFC denies the  
7 allegations.

### 8 **THE PARTIES**

9 8. In Answering Paragraph 8 of the Complaint, UFC admits Plaintiff  
10 is local gym based in Chula Vista, but denies the remaining allegations contained  
11 therein.<sup>3</sup>

12 9. In Answering Paragraph 9 of the Complaint, UFC admits it is a  
13 limited liability company formed under the laws of the State of Nevada, but denies  
14 the remaining allegations contained therein.

15 10. In Answering Paragraph 10 of the Complaint, UFC lacks  
16 knowledge or information sufficient to form a belief as to the truth or veracity of  
17 the allegations asserted in this paragraph of the Complaint and, therefore, denies  
18 the allegations.

19 11. In Answering Paragraph 11 of the Complaint, UFC denies the  
20 allegations contained therein.

### 21 **FACTS COMMON TO ALL CAUSES OF ACTION**

#### 22 **I. The Parties**

##### 23 **A. UFC Ultimate Fitness Center, LLC**

24 12. In Answering Paragraph 12 of the Complaint, UFC admits that  
25 Plaintiff operates a gym in Chula Vista, California, but denies the remaining

26 <sup>3</sup> UFC denies Plaintiff's use of "UFC" to identify itself and hereby repeats, re-  
27 alleges and incorporates by reference this denial in UFC's answers to Paragraphs 1  
28 through 99, as well as the allegations contained in the Counterclaim below, as  
though fully set forth herein.

1 allegations contained therein.

2 13. In Answering Paragraph 13 of the Complaint, UFC admits Plaintiff  
3 owns the URL [www.ultimatefitnesscenterchulavista.com](http://www.ultimatefitnesscenterchulavista.com), has advertised Plaintiff's  
4 gym under the name "Ultimate Fitness Center," and that Plaintiff has unlawfully  
5 advertised Plaintiff's gym under the names "UFC" and "UFC ULTIMATE  
6 FITNESS CENTER." UFC lacks knowledge or information sufficient to form a  
7 belief as to the truth or veracity of the remaining allegations asserted in this  
8 paragraph and, therefore, denies the allegations.

9 14. In Answering Paragraph 14 of the Complaint, UFC denies the  
10 allegations contained therein.

11 15. In Answering Paragraph 15 of the Complaint, UFC admits Plaintiff  
12 is listed as the registrant of a federal trademark registration, bearing Registration  
13 Number 4600344, but denies the remaining allegations contained therein.

14 16. In Answering Paragraph 16 of the Complaint, UFC admits Plaintiff  
15 is listed as the applicant of a federal trademark application bearing Serial Number  
16 85,126,538, but denies the remaining allegations contained therein.

17 17. In Answering Paragraph 17 of the Complaint, UFC admits the  
18 application bearing Serial No. 85,126,538 has received several office actions based  
19 on a likelihood of confusion with UFC's registered marks, but denies the  
20 remaining allegations contained therein.

21 **B. Zuffa, LLC**

22 18. In Answering Paragraph 18 of the Complaint, UFC admits it owns  
23 and operates the Ultimate Fighting Championship, also known as UFC, but denies  
24 the remaining allegations contained therein.

25 19. In Answering Paragraph 19 of the Complaint, UFC admits it owns  
26 trademark registrations for the marks UFC (Reg. Nos. 3723920; 3723920), UFC  
27 GYM (Reg. Nos. 4168373; 3999175; 4106124; and 4147712), but denies the  
28 remaining allegations contained therein.

1           20.     In Answering Paragraph 20 of the Complaint, UFC admits it owns  
2 pending applications for the marks UFC GYM (Ser. Nos. 85288367; 85288361;  
3 85288344; 85288337), UFC TRAINER (Ser. No. 85262581), UFC PERSONAL  
4 TRAINER ULTIMATE TRAINER SYSTEM (Ser. Nos. 85246423; 85246150),  
5 UFC TRAINER PERSONAL THE ULTIMATE FITNESS SYSTEM (Ser. No.  
6 85294702), and UFC PERSONAL TRAINER (Ser. No. 85246131), but denies the  
7 remaining allegations contained therein.

8           21.     In Answering Paragraph 21 of the Complaint, UFC admits its  
9 applications for the marks UFC GYM (Ser. Nos. 85288367; 85288361; 85288344;  
10 85288337), UFC TRAINER (Ser. No. 85262581), UFC PERSONAL TRAINER  
11 ULTIMATE TRAINER SYSTEM (Ser. Nos. 85246423; 85246150), UFC  
12 TRAINER PERSONAL THE ULTIMATE FITNESS SYSTEM (Ser. No.  
13 85294702), and UFC PERSONAL TRAINER (Ser. No. 85246131) are suspended,  
14 but denies the remaining allegations contained therein.

15           22.     In Answering Paragraph 22 of the Complaint, UFC states that no  
16 response is required. To the extent a response is deemed required, UFC denies the  
17 allegations contained therein.

18 **III. The Defendant's Infringing Actions**

19           23.     In Answering Paragraph 23 of the Complaint, UFC denies the  
20 allegations contained therein.

21           24.     In Answering Paragraph 24 of the Complaint, UFC denies the  
22 allegations contained therein.

23           25.     In Answering Paragraph 25 of the Complaint, UFC denies the  
24 allegations contained therein.

25           26.     In Answering Paragraph 26 of the Complaint, UFC lacks  
26 knowledge or information sufficient to form a belief as to the truth or veracity of  
27 the allegations asserted in this paragraph of the Complaint and, therefore, denies  
28 the allegations contained therein.

1           27.     In Answering Paragraph 27 of the Complaint, UFC denies the  
2 allegations contained therein.

3 **IV.   The TTAB Proceedings**

4           28.     In Answering Paragraph 28 of the Complaint, UFC admits Plaintiff  
5 filed cancellation proceedings, but denies the remaining allegations contained  
6 therein.

7           29.     In Answering Paragraph 29 of the Complaint, UFC denies the  
8 allegations contained therein.

9 **V.    The Nevada District Court Matter and Appeal**

10          30.     In Answering Paragraph 30 of the Complaint, UFC denies the  
11 allegations contained therein.

12          31.     In Answering Paragraph 31 of the Complaint, UFC admits only  
13 that UFC filed a motion to dismiss the claim pursuant to F.R.C.P. 12(b)(2). UFC  
14 denies all remaining allegations contained therein.

15          32.     In Answering Paragraph 32 of the Complaint, UFC admits only  
16 that the District Court dismissed the Nevada Proceedings. UFC denies all  
17 remaining allegations contained therein.

18          33.     In Answering Paragraph 33 of the Complaint, UFC admits only  
19 that it filed a notice of appeal of the District Court decision with the Court of  
20 Appeals for the Ninth Circuit (Case Number 14-16724). UFC denies all remaining  
21 allegations contained therein.

22          34.     In Answering Paragraph 34 of the Complaint, UFC denies the  
23 allegations contained therein.

24          35.     In Answering Paragraph 35 of the Complaint, UFC denies the  
25 allegations contained therein.

26 **FIRST CAUSE OF ACTION**

27 (Federal Trademark Infringement – 15 U.S.C. §§ 1114, *et seq.*)

28          36.     In Answering Paragraph 36 of the Complaint, UFC hereby repeats,

1 re-alleges and incorporates by references the answers to Paragraphs 1-35, as well  
2 as the allegations contained in the Counterclaim below, as though fully set forth  
3 herein.

4 37. In Answering Paragraph 37 of the Complaint, UFC denies the  
5 allegations contained therein.

6 38. In Answering Paragraph 38 of the Complaint, UFC denies the  
7 allegations contained therein.

8 39. In Answering Paragraph 39 of the Complaint, UFC denies the  
9 allegations contained therein.

10 40. In Answering Paragraph 40 of the Complaint, UFC denies the  
11 allegations contained therein.

12 41. In Answering Paragraph 41 of the Complaint, UFC denies the  
13 allegations contained therein.

14 42. In Answering Paragraph 42 of the Complaint, UFC denies the  
15 allegations contained therein.

16 **SECOND CAUSE OF ACTION**

17 (Federal Unfair Competition:

18 False Designation of Origin, Passing Off, and False Advertising)

19 43. In Answering Paragraph 43 of the Complaint, UFC hereby repeats,  
20 re-alleges and incorporates by reference the answers to Paragraphs 1 through 42, as  
21 well as the allegations contained in the Counterclaim below, as though fully set  
22 forth herein.

23 44. In Answering Paragraph 44 of the Complaint, UFC denies the  
24 allegations contained therein.

25 45. In Answering Paragraph 45 of the Complaint, UFC denies the  
26 allegations contained therein.

27 46. In Answering Paragraph 46 of the Complaint UFC denies the  
28 allegations contained therein.





1 allegations contained therein.

2 69. In Answering Paragraph 69 of the Complaint, UFC denies the  
3 allegations contained therein.

4 70. In Answering Paragraph 70 of the Complaint, UFC denies the  
5 allegations contained therein.

6 **SIXTH CAUSE OF ACTION**

7 Declaratory Judgment (No Infringement)

8 71. In Answering Paragraph 71 of the Complaint UFC hereby repeats,  
9 re-alleges and incorporates by reference the answers to Paragraphs 1 through 70, as  
10 well as the allegations contained in the Counterclaim below, as though fully set  
11 forth herein.

12 72. In Answering Paragraph 72, UFC admits the allegations contained  
13 therein.

14 73. In Answering Paragraph 73 of the Complaint, UFC denies the  
15 allegations contained therein.

16 74. In Answering Paragraph 74 of the Complaint, UFC denies the  
17 allegations contained therein.

18 75. In Answering Paragraph 75 of the Complaint, UFC denies the  
19 allegations contained therein.

20 76. In Answering Paragraph 76 of the Complaint, UFC denies the  
21 allegations contained therein.

22 77. In Answering Paragraph 77 of the Complaint, UFC denies the  
23 allegations contained therein.

24 78. In Answering Paragraph 78 of the Complaint, UFC denies the  
25 allegations contained therein.

26 79. In Answering Paragraph 79 of the Complaint, UFC states no  
27 response is required. To the extent a response is deemed required, UFC denies the  
28 allegations.



1 well as the allegations contained in the Counterclaim below, as though fully set  
2 forth herein.

3 89. In Answering Paragraph 89, UFC lacks knowledge or information  
4 sufficient to form a belief as to the truth or veracity of the allegations and,  
5 therefore, denies the allegations contained therein.

6 90. In Answering Paragraph 90 of the Complaint, and as set forth more  
7 fully in UFC's Counterclaim, UFC admits only that Plaintiff's "UFC" and "UFC  
8 ULTIMATE FITNESS CENTER" marks are confusingly similar to Zuffa's UFC®  
9 Marks (as defined below), but denies the remaining allegations contained therein.

10 91. In Answering Paragraph 91 of the Complaint, UFC denies the  
11 allegations contained therein.

12 92. In Answering Paragraph 92 of the Complaint, UFC states the  
13 allegations in this paragraph assert a conclusion of law to which no response is  
14 required. To the extent a response is deemed required, UFC denies the allegations  
15 contained therein.

16 93. In Answering Paragraph 93 of the Complaint, UFC denies the  
17 allegations contained therein.<sup>4</sup>

18 **AFFIRMATIVE DEFENSES**

19 UFC asserts the following as affirmative defenses to the Complaint and the  
20 claims asserted therein, and UFC specifically incorporates into these Affirmative  
21 Defenses its responses to the preceding paragraphs of the Complaint and the  
22 allegations contained in its Counterclaim set forth below.

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24  
25 <sup>4</sup> Paragraph 94 (Jury Demand) and Paragraphs 95-99 (Prayer) set forth in the  
26 Complaint do not require any substantive response. However, to the extent a  
27 response is deemed required, Zuffa denies that Plaintiff is entitled to any of the  
28 relief set forth in the Prayer and, to the extent necessary, denies any allegations  
contained therein. Zuffa also acknowledges that pursuant to FRCP 38, Plaintiff  
can request a jury trial on all issues that may be tried to a jury.

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**FIRST AFFIRMATIVE DEFENSE**

The Complaint fails to state any claims against UFC upon which relief can be granted.

**SECOND AFFIRMATIVE DEFENSE**

Plaintiff does not have standing to bring the claims it asserts.

**THIRD AFFIRMATIVE DEFENSE**

Plaintiff's claims are barred, in whole or in part, by the doctrines of estoppel, waiver or laches.

**FOURTH AFFIRMATIVE DEFENSE**

Plaintiff's claims are barred, in whole or in part, by the applicable statutes of limitation or repose.

**FIFTH AFFIRMATIVE DEFENSE**

Plaintiff is not entitled to any of the relief sought in the Complaint.

**SIXTH AFFIRMATIVE DEFENSE**

Plaintiff's claims are barred, in whole or in part, by the doctrine of unclean hands.

**SEVENTH AFFIRMATIVE DEFENSE**

Plaintiff failed and refused to take reasonable or adequate steps to mitigate, alter, reduce or otherwise diminish the alleged damages, if any, claimed by Plaintiff.

**EIGHTH AFFIRMATIVE DEFENSE**

Plaintiff has not been damaged in any manner by UFC.

**NINTH AFFIRMATIVE DEFENSE**

Plaintiff has not suffered any recoverable damages.

**TENTH AFFIRMATIVE DEFENSE**

Plaintiff's registered trademarks are unenforceable due to fraud on the USPTO by Plaintiff's fraudulent statements, representations, and admissions during the prosecution of the applications that matured into Plaintiff's trademark

1 registrations.

2 **ELEVENTH AFFIRMATIVE DEFENSE**

3 Plaintiff's trademarks are not a protectable trademark because they lack  
4 secondary meaning and are not protectable trademarks because Plaintiff cannot  
5 show that the primary significance of Plaintiff's trademarks in the minds of the  
6 consuming public identify Plaintiff as a source of Plaintiff's goods and services.

7 **TWELFTH AFFIRMATIVE DEFENSE**

8 Plaintiff's claims are barred, in whole or in part, because the trademark  
9 registrations asserted in the Complaint are invalid, unenforceable, and subject to  
10 cancellation due to inequitable and/or fraudulent conduct in their procurement.

11 **THIRTEENTH AFFIRMATIVE DEFENSE**

12 Plaintiff has not used its alleged trademarks in commerce as defined by the  
13 Trademark Act, 15 U.S.C. § 1127.

14 **FOURTEENTH AFFIRMATIVE DEFENSE**

15 Plaintiff's trademarks are weak, generic and have not obtained the level of  
16 distinctiveness sufficient to obtain relief under the Lanham Act or other applicable  
17 state and federal laws.

18 **FIFTEENTH AFFIRMATIVE DEFENSE**

19 UFC has not and does not infringe any valid trademark of Plaintiff.

20 **SIXTEENTH AFFIRMATIVE DEFENSE**

21 UFC is the senior user of the UFC® Marks.

22 **SEVENTEENTH AFFIRMATIVE DEFENSE**

23 Plaintiff's ULTIMATE FITNESS CENTER trademark exists within a  
24 crowded field of similar trademarks, such that Plaintiff's trademark has a narrow  
25 scope of protection and minor differences in the appearance of trademarks are  
26 sufficient to avoid confusion in the minds of consumers.

27 **EIGHTEENTH AFFIRMATIVE DEFENSE**

28 Pursuant to Rule 8 of the Federal Rules of Civil Procedure, all possible

1 affirmative defenses may not have been alleged herein insofar as sufficient facts  
2 were not available after reasonable inquiry upon the filing of this Answer, and  
3 therefore, UFC reserves the right to amend this Answer to allege additional  
4 affirmative defenses if subsequent investigation warrants.

5 WHEREFORE, UFC prays as follows, with respect to the Complaint:

6 1. That Plaintiff's Complaint be dismissed with prejudice and that  
7 Plaintiff takes nothing thereby;

8 2. For a judgment to be entered in favor of UFC and against Plaintiff as  
9 to the Complaint and all claims asserted therein;

10 3. For an award of reasonable attorneys' fees and costs of suit herein;  
11 and

12 4. For such other and further relief as the Court deems just and proper.

13 **COUNTERCLAIM**

14 Counterclaimant UFC, LLC ("UFC") hereby submits its Counterclaim  
15 against UFC Ultimate Fitness Center, LLC ("Counterdefendant") and alleges as  
16 follows.<sup>5</sup>

17 **NATURE OF THE CASE**

18 1. This trademark infringement action arises out of  
19 Counterdefendant's unlawful adoption of UFC's famous UFC® trademarks in  
20 Counterdefendant's business name and in numerous trademarks, despite being  
21 well-aware of UFC's rights in UFC's distinctive and famous UFC® trademarks.

22 2. Counterdefendant adopted its alleged UFC marks with the intent to  
23 create a false association with UFC and to trade-off on the substantial goodwill and  
24 reputation of UFC's well-established, famous UFC® trademarks.

25 3. Counterdefendant's conduct has infringed on UFC's intellectual  
26 property rights and diluted the strength of its famous UFC®.

27 \_\_\_\_\_  
28 <sup>5</sup> UFC specifically incorporates into its Counterclaims its responses and affirmative  
defenses to the Complaint by reference as though fully set forth herein.



1 jurisdiction in this district.

2 **FACTUAL ALLEGATIONS**

3 **I. UFC’s Use and Ownership of the UFC® Marks**

4 12. UFC owns the Ultimate Fighting Championship® (“UFC®”) brand, founded in 1993, and is the world’s leading promoter of mixed martial arts  
5 (“MMA”) competitions and events.

6 13. UFC’s UFC® brand includes hundreds of trademarks, including  
7 ULTIMATE FIGHTING CHAMPIONSHIP®, UFC®, THE ULTIMATE  
8 FIGHTER®, ULTIMATE FIGHTING®, and a plurality of other marks featuring  
9 the “Ultimate Fighting Championship” and/or “UFC” terms (the “UFC® Marks”).

10 14. The UFC® Marks include, among others, the UFC® word mark  
11 (i.e., the letters UFC by themselves) and UFC’s famous stylized version of its  
12 UFC® mark comprised of the letters UFC, either in white or fully shaded, and  
13 featuring a broken letter “F.”  
14



19 15. This stylized version of UFC’s UFC® mark represents UFC’s  
20 core brand and is its primary and most valuable trademark.

21 16. UFC’s business relating to the UFC® Marks and brand (the  
22 “UFC® Business”) includes, but is not limited to:

23 a. Sports entertainment services, including organizing, promoting  
24 and staging mixed martial arts sports and entertainment events in the U.S.  
25 and internationally, including numbered events (with “UFC 184” being  
26 the most recently numbered UFC® brand event in 2015), all of which are  
27 directly affiliated with and are promoted using the UFC® Marks;

28 b. Television entertainment (via pay-per-view, free-to-air  
television, and video-on demand), watched by a U.S. and international  
audience, including the UFC® brand events and television programs;

1 c. UFC® brand merchandise and related services, including  
2 clothing, sporting goods, fitness training equipment, health club services,  
3 providing exercise facilities and fitness services; and

4 d. The UFC Gym®, offering health club services, providing  
5 exercise facilities and fitness services and instruction.

6 17. Since its inception in 1993, the UFC® Business has reportedly  
7 been one of the fastest growing sports enterprises in world history, and UFC has  
8 spent an extraordinary amount of time, resources and money – over Thirty-Five  
9 Million Dollars in 2012 alone - to advertise and promote its UFC® Marks and  
10 brand.

11 18. These promotional efforts (which include print, television, radio,  
12 and online ads, as well as the [www.ufc.com](http://www.ufc.com) website that attracts more than six  
13 million visitors monthly) have resulted in the UFC® Marks and brand being  
14 available to more than five hundred million households worldwide, via broadcast  
15 to over 100 countries/territories in 20 different languages.

16 19. UFC has expanded its famous UFC® brand and use of the UFC®  
17 Marks into several related fields, for various goods and services, including the  
18 subject of the current proceedings, namely MMA-inspired health club facilities  
19 and fitness instruction services, as well as sporting goods and MMA training  
20 products.

21 20. In addition to the natural expansion of UFC's famous UFC®  
22 Marks into related health club goods and services, giving UFC a priority date of  
23 1993, UFC put the world on notice of its exclusive rights in the UFC® Marks and  
24 its intent to use UFC® for health club related goods and services by filing several  
25 applications with the USPTO on June 19, 2006.

26 21. The following is a representative sample of UFC's trademark  
27 registrations for health clubs, fitness instruction services, clothing, and related  
28 goods and services, including several registrations that are incontestable pursuant  
15 U.S.C. § 1065:

1 a. **UFC** (Reg. No. 2645312): Filed on February 26, 2001 and  
2 registered November 5, 2002 in Classes 25 and 41 for “Clothing and  
3 wearing apparel, namely, warm-up suits, sweatshirts, sweatpants; tee-  
4 shirts; polo shirts; golf shirts; sports shirts; tank tops...” with a first use  
5 date of September 1993 (**Incontestable**).

6 b. **UFC & Design** (Reg. No. 2706754): Filed on May 1, 2002 and  
7 registered April 15, 2003 in Classes 9, 16, 18, 25, 28, and 41 for “tee-  
8 shirts; muscle shirts; sports shirts; tank tops...” with a first date of use of  
9 May 2001.

10 c. **UFC** (Reg. No. 3723920): Filed on June 19, 2006 and  
11 registered December 8, 2009 in Classes 28 and 41 for “weight lifting  
12 gloves; martial arts equipment, namely, bag gloves, shin guards, punch  
13 mitts, pads, namely, kick pads, target pads and shin pads; focus mitts,  
14 mouth guards, free standing bags,” with a first use date of August 27,  
15 2007; and “providing health club services, namely, providing fitness and  
16 exercise facilities,” with a first date of use on February 21, 2009.

17 d. **UFC** (Reg. No. 3975659): Filed on June 19, 2006 and  
18 registered June 7, 2011 in Class 28 for “exercise and fitness equipment  
19 and accessories, namely, ankle and wrist weights; jump ropes; kicking  
20 shields, head guards, groin cups, karate target pads, body shields, thai  
21 pads, namely, kick pads, pads and shin pads; sparring vests, ankle and  
22 hand wraps, jump ropes,” with a first date of use on April 30, 2009.

23 e. **UFC** (Reg. No. 3600393): Filed on June 19, 2006 and  
24 registered March 31, 2009 in Class 35 for “energy sports drinks” with a  
25 first date of use on March 30, 2006 (**Incontestable**).

26 f. **UFC** (Reg. No. 3624854): Filed on June 19, 2006 and  
27 registered May 19, 2009 in Classes 5 and 28 for “nutritional supplements  
28 and vitamins; nutritional supplement drinks in the form of liquid and  
powdered drinks and drink mixes...” with a first use date of October 30,  
2008; and “personal exercise mats,” with a first date of use on October  
22, 2008.

g. **UFC** (Reg. No. 3841790): Filed on March 31, 2010 and  
registered August 31, 2010 in Class 41 for “On-line electronic  
newsletters delivered by email in the field of current events, news and  
information featuring sports, mixed martial arts and entertainment;

1 Providing on-line newsletters in the field of current events, news and  
2 information featuring sports, mixed martial arts and entertainment” with  
3 a first date of use on December 1, 2005.

4 h. **UFC GYM** (Reg. No. 4168373): Filed on December 10, 2008  
5 and registered July 3, 2012 in Classes 25, 28, and 35 for “Sweatshirts;  
6 hooded sweatshirts; tee-shirts; sports shirts; muscle shirts; tank tops;  
7 shorts..,” “Boxing and martial arts equipment, namely, martial arts  
8 gloves, wrestling gloves, boxing gloves, striking bag gloves, competition  
9 gloves, grappling gloves, knuckle guards; Boxing and martial arts  
10 equipment, namely, kicking shields, kick boxing shin guards, kick boxing  
11 head guards, female chest protectors, punch mitts, pads, namely, kick  
12 boxing kick pads, target pads and shin pads; thai pads, namely, kick pads,  
13 target pads and shin pads for kick boxing...,” and “Online retail store  
14 services featuring fitness related clothing, sportswear, mixed martial arts  
15 gear and accessories” with a first date of use on December 1, 2009.

16 i. **UFC GYM** (Reg. No. 3999175): Filed on December 10, 2008  
17 and registered July 19, 2011 in Classes 41 and 44 for “providing health  
18 club services, namely providing fitness and exercise facilities; instruction  
19 services, namely, instruction in the field of health and physical  
20 fitness...,” with a first use date of December 1, 2009; and “providing  
21 information in the field of health,” with a first date of use on December 1,  
22 2009.

23 j. **UFC GYM** (Reg. No. 4106124): Filed on December 10, 2008  
24 and registered February 28, 2012 in Class 18 for “Sports bags, travel  
25 bags, duffel bags, gym bags, backpacks” with a first date of use on  
26 November 1, 2009.

27 k. **UFC GYM & design** (Reg. No. 4147712): Filed on April 6,  
28 2011 and registered May 22, 2012 in Class 24 for “towels” with a first  
date of use on November 1, 2009.

1 l. **UFC GYM TRAIN DIFFERENT** (Reg. No. 4284976): Filed  
on December 20, 2011 and registered on February 5, 2013 in Class 41 for  
“Health club services, namely, providing fitness, personal training and  
exercise facilities; providing instruction in the fields of fitness, personal  
training exercise and mixed martial arts; providing instructional programs  
in the fields of fitness, personal training, exercise and mixed martial arts;  
providing information in the fields of fitness, personal training, exercise

1 and mixed martial arts via a global computer network” with a first date of  
2 use on August 1, 2011.

3 22. In February 2009, inaugural memberships to the initial UFC  
4 GYM® were offered for sale to the public.

5 23. The first UFC GYM® facility opened in Concord, California in or  
6 around December 1, 2009.

7 24. Since that time, one hundred twenty-five (125) UFC GYM®  
8 locations have opened in twenty-seven (27) states in the U.S., and one (1) location  
9 in Sydney, Australia, with the expectation of opening an additional ninety (90)  
10 locations by the end of 2015.

11 25. Each of the UFC GYM® facilities, along with all of UFC’s  
12 related products and services, is clearly branded with the UFC® trademark – the  
13 same mark that has been in use since 1993 and has gained incredible amounts of  
14 notoriety, not only among MMA and fitness/training enthusiasts, but among the  
15 general consuming public as a whole.

16 26. UFC has made commercial use of the UFC® and UFC GYM®  
17 marks for health club facilities and fitness/health instruction and education  
18 services since February 2009, if not sooner.

19 27. UFC also has a gym located in Las Vegas, Nevada, used in  
20 conjunction with the popular “The Ultimate Fighter” reality television series,  
21 which started its first season on January 17, 2005 and is presently in its twenty-  
22 first (21<sup>st</sup>) season.

23 28. UFC’s health club facilities, training, and fitness instruction  
24 services are within the natural zone of expansion of the goods and services  
25 associated with UFC’s famous UFC® Marks, with enforceable rights dating back  
26 to 1993.

27 29. UFC is the senior user of the UFC® and UFC GYM® marks for  
28 health club facilities, fitness instruction services, and clothing, and

1 Counterdefendant's use of the Infringing Marks is unlawful and subjects  
2 Counterdefendant to significant liability.

3 **II. Counterdefendant's Appropriation and Attempted Registration of**  
4 **UFC's Trademarks**

5 30. UFC is informed and believes, and thereupon alleges, that in or  
6 about May 1996, Counterdefendant opened a health club located at 1380 Third  
7 Avenue, Chula Vista, California 91911, branded solely as the "Ultimate Fitness  
8 Center."

9 31. Counterdefendant's owner, Mr. Robert Hueso, submitted sworn  
10 testimony to the TTAB describing himself as "a big fan" of UFC's UFC®  
11 business and that he became aware of UFC's use of UFC® for health club  
12 services at least as early as 2010.

13 32. This "2010" admission is important, as it solidifies  
14 Counterdefendant's knowledge that UFC, and its UFC® brand, were actively  
15 engaged in the health club and fitness instruction industries.

16 33. UFC is informed and believes and thereupon alleges that  
17 sometime in 2010 after becoming aware of UFC's rights in UFC's UFC® Marks,  
18 Counterdefendant adopted and began using UFC, UFC ULTIMATE FITNESS  
19 CENTER THE GYM THAT FITS YOUR LIFE!, THE ORIGINAL UFC GYM,  
20 and ULTIMATE FITNESS CENTER GYM THE ORIGINAL SINCE 1996  
21 (collectively, "Infringing Marks") in an attempt to create a false association with  
22 UFC and confuse the public, and to trade off on the fame and goodwill associated  
23 with UFC's UFC® Marks.

24 34. UFC is informed and believes, and thereupon alleges, it was not  
25 until on or about June 2, 2011, that Counterdefendant formed the business entity,  
26 "UFC Ultimate Fitness Center, LLC," filed with the California Secretary of State,  
27 identifying its address as being located at 1380 Third Avenue, Chula Vista,  
28 California 91911.

1           35.     UFC is informed and believes, and thereupon alleges, that  
2 presently Counterdefendant only operates out of this single Chula Vista,  
3 California location.

4           36.     UFC is informed and believes and thereupon alleges, that prior to  
5 June 2, 2011, Counterdefendant was a sole proprietorship owned by Rob Hueso.

6           37.     UFC is informed and believes, and thereupon alleges, that Rob  
7 Hueso formally adopted the name “UFC Ultimate Fitness Center, LLC”, which  
8 adds the term “UFC,” on or about June 2, 2011, following the UPSPO’s first  
9 refusal of his trademark application for UFC ULTIMATE FITNESS CENTER  
10 THE CENTER THAT FITS YOUR LIFE! Mark.

11           38.     UFC is informed and believes and thereupon alleges, that  
12 Counterdefendant formally adopted the name “UFC Ultimate Fitness Center,  
13 LLC,” nearly fifteen (15) years after it opened its doors as “Ultimate Fitness  
14 Center,” to create a false association with UFC and confuse the consuming public,  
15 and to trade-off on the fame and goodwill associated with UFC’s UFC® Marks.

16           39.     UFC is informed and believes, and thereupon alleges, that  
17 Counterdefendant owns the domain name <ultimatefitnesscenterchulavista.com>  
18 (the “Counterdefendant’s Domain Name”).

19           40.     According to the publically-available WHOIS information,  
20 Counterdefendant’s Domain Name was not registered until on or about August 10,  
21 2010.

22           41.     UFC is informed and believes, and thereupon alleges, that shortly  
23 after August 10, 2010, the [www.ultimatefitnesscenterchulavista.com](http://www.ultimatefitnesscenterchulavista.com) website  
24 (“Counterdefendant’s Website”) went live and began hosting content.

25           42.     UFC is informed and believes, and thereupon alleges that, prior to  
26 September 4, 2010, the Counterdefendant’s Website promoted  
27 Counterdefendant’s services only as the “ULTIMATE FITNESS CENTER THE  
28 GYM THAT FITS YOUR LIFE!,” with no reference to the term “UFC” or use of

1 the Infringing Marks.

2 43. UFC is informed and believes, and thereupon alleges that by  
3 September 4, 2010, Counterdefendant’s Website adopted the added term “UFC”,  
4 adding “UFC” to its slogan “ULTIMATE FITNESS CENTER THE GYM THAT  
5 FITS YOUR LIFE” and using a stylized version of the letters “UFC” alone—in a  
6 font that is strikingly similar to UFC’s UFC® mark, as shown below.

7 Counterdefendant’s Infringing Use

UFC’s UFC® Mark

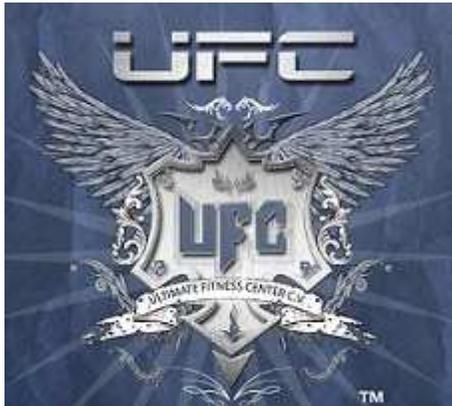


11 44. UFC is informed and believes and thereupon alleges that the  
12 Counterdefendant’s Website currently displays and promotes the Infringing Marks  
13 and prominently features a stylized version of the “UFC” term that is virtually  
14 identical to UFC’s UFC® Mark.

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1 45. UFC is informed and believes, and thereupon alleges that  
2 Counterdefendant is uses the Infringing Marks, as shown below, on  
3 Counterdefendant’s Website, in social media, at his Chula Vista facility, and on t-  
4 shirts.



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19 46. UFC is informed and believes, and thereupon alleges that,  
20 Counterdefendant also is designing and selling promotional items, such as t-shirts,  
21 hats, and other accessories, bearing the Infringing Marks.

22 47. UFC is informed and believes and thereupon alleges that  
23 Counterdefendant is actively promoting its services using the Infringing Marks in  
24 an attempt to create a false association with UFC and confuse the consuming  
25 public, and to trade off on the fame and goodwill associated with UFC’s UFC®  
26 Marks.

27 **A. Counterdefendant’s Pending U.S. Trademark Registrations**

28 48. UFC is informed and believes and thereupon alleges that on

1 September 10, 2010, Counterdefendant filed an application with the United States  
2 Patent and Trademark Office (“USPTO”) to register the Infringing Mark UFC  
3 ULTIMATE FITNESS CENTER THE GYM THAT FITS YOUR LIFE! in  
4 International Class 41 for “health club services, namely, providing instruction and  
5 equipment in the field of physical fitness, exercise, boxing, kick boxing and mixed  
6 martial arts,” U.S. Serial No. 85126538 (the “Pending Application”).

7 49. The USPTO has issued refusals to approve the Pending  
8 Application and register the Infringing Mark UFC ULTIMATE FITNESS  
9 CENTER THE GYM THAT FITS YOUR LIFE! on December 23, 2010 and  
10 again on October 3, 2012 based primarily on a likelihood of confusion with UFC’s  
11 prior registrations for UFC® (Registration No. 3723920) in Class 41 for  
12 “providing health club services, namely, providing fitness and exercise facilities”  
13 and UFC GYM® (Registration No. 3999175) in Class 41 for “providing health  
14 club services, namely, providing fitness and exercise facilities....”

15 50. On October 20, 2011, Counterdefendant filed its first Petition for  
16 Cancellation with the USPTO Trademark Trial and Appeal Board (the “TTAB”)  
17 against UFC’s registered UFC® mark (Registration No. 3723920), Cancellation  
18 No. 92054704.

19 51. On November 29, 2011, Counterdefendant filed another Petition  
20 for Cancellation against UFC’s registered UFC GYM® mark (Registration No.  
21 3999175), Cancellation No. 92054868.

22 52. The TTAB subsequently consolidated the two proceedings into  
23 Cancellation No. 9205470 (the “Pending Cancellation Proceedings”).

24 53. The Pending Cancellation Proceedings are still active and have  
25 not yet been decided by the TTAB.

26 54. Counterdefendant’s use of the Infringing Marks have already  
27 infringed upon and damaged UFC’s trademark rights.

28 55. Despite Counterdefendant’s contrary claims, Counterdefendant’s

1 use of the Infringing Marks, and any alleged trademark rights developed therein,  
2 did not arise until well after UFC’s filing and enforceable priority date of July 19,  
3 2006 for its UFC® and UFC GYM® trademarks.

4 56. Further, since UFC’s health club facilities, training, fitness  
5 instruction services, and clothing and apparel are within the natural zone of  
6 expansion of the goods and services associated with UFC’s famous UFC® Marks,  
7 UFC’s enforceable rights date back to 1993.

8 57. As the senior user, UFC is entitled to enforce its established  
9 trademark rights against the Infringing Marks and to enjoin Counterdefendant’s  
10 use and seek all appropriate damages and other relief.

11 58. Counterdefendant is liable for its unlawful conduct because it has  
12 continued to use the Infringing Marks knowing that UFC would be damaged by  
13 such use.

14 59. UFC has been damaged by Counterdefendant’s use of the  
15 Infringing Marks, and will continue to be damaged until such time as  
16 Counterdefendant’s use of the Infringing Marks permanently ceases.

17 **B. Counterdefendant’s U.S. Trademark Registrations Procured by**  
18 **Fraud on the USPTO**

19 60. UFC is informed and believes and thereupon alleges that  
20 Counterdefendant procured the following U.S. trademark registrations fraudulently  
21 and as such, are subject to cancellation:

22 a. **ULTIMATE FITNESS CENTER GYM THE ORIGINAL**  
23 **SINCE 1996** (Reg. No. 4445286) in International Class 41 for  
24 “[p]roviding general fitness and mixed martial arts facilities that require  
25 memberships and are focused in the fields of general fitness, exercise, and  
26 mixed martial arts;”

27 b. **ULTIMATE FITNESS CENTER GYM THE ORIGINAL**  
28 **SINCE 1996 (and Design)** (Reg. No. 4600347) in International Class 25  
for “[a]thletic apparel, namely, shirts, pants, jackets, footwear, hats and

1 caps, athletic uniforms;”

2 c. **ULTIMATE FITNESS CENTER GYM THE ORIGINAL**  
3 **SINCE 1996 (and Design)** (Reg. No. 4600344) in International Class 41  
4 for “[p]roviding fitness and exercise facilities;” and

5 d. **ULTIMATE FITNESS CENTER COACH** (Reg. No.  
6 4608679) in International Class 41 for “[p]roviding a website featuring  
7 online sports training and training advice and the recording of training  
8 workouts;”

9 (collectively, “Fraudulent Registrations”).

10 61. UFC is informed and believes and thereupon alleges that  
11 Counterdefendant fraudulently procured the Fraudulent Registrations by: (1)  
12 making material misrepresentations of fact to the USPTO in its applications for the  
13 Fraudulent Registrations; (2) which Counterdefendant knew were false; and (3)  
14 Counterdefendant’s misrepresentations were made with the intent to deceive the  
15 USPTO.

16 62. UFC is informed and believes and thereupon alleges that  
17 Counterdefendant committed fraud in procuring the Fraudulent Registrations.

18 63. UFC believes it has and will continue to be damaged by the  
19 continued registration of the Fraudulent Registrations because the parties have  
20 been in an ongoing trademark dispute since 2011 before the TTAB and in civil  
21 actions before the United States District Court for the District of Nevada, the Ninth  
22 Circuit Court of Appeals, and before this Court, wherein Counterdefendant relies  
23 on its U.S. registration(s) in support of its position.

24 **1. *Fraudulent Registration No. 4445286***

25 64. Counterdefendant fraudulently procured Registration No. 4445286  
26 for the mark **ULTIMATE FITNESS CENTER GYM THE ORIGINAL SINCE**  
27 **1996** (the “‘286 Mark”) by making: (1) material misrepresentations of fact to the  
28 USPTO in connection with its application; (2) which Counterdefendant knew were

1 false; and (3) Counterdefendant's misrepresentations were made with the intent to  
2 deceive the USPTO.

3 65. UFC is informed and believes and thereupon alleges that  
4 Counterdefendant committed fraud in procuring its registration for the '286 Mark.

5 66. UFC is informed and believes and thereupon alleges that  
6 Counterdefendant provided the USPTO with a false first use date, which it knew to  
7 be false and/or misleading with the willful intent to deceive the USPTO for  
8 purposes of obtaining registration for the '286 Mark.

9 67. UFC is informed and believes and thereupon alleges that  
10 Counterdefendant created a computer-generated fake specimen of use that did not  
11 exist at the time it filed its application, and still does not exist to this day, with the  
12 willful intent to deceive the USPTO for purposes of obtaining registration for the  
13 '286 Mark.

14 68. UFC is informed and believes and thereupon alleges  
15 Counterdefendant fraudulently obtained registration of the '286 Mark because  
16 Counterdefendant had not used the '286 Mark in commerce, as defined by the  
17 Trademark Act, on the date indicated in the application.

18 69. UFC is informed and believes and thereupon alleges that  
19 Counterdefendant's false and/or misleading statements were material because  
20 absent such misrepresentations, the USPTO would not have issued the registration  
21 for the '286 Mark.

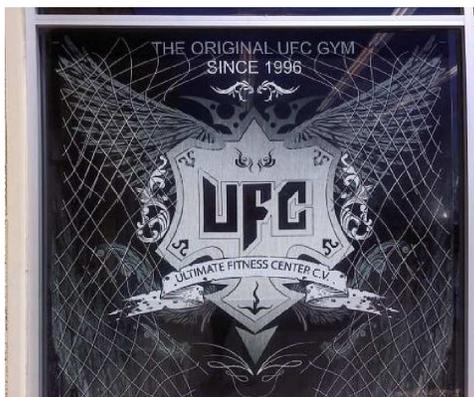
22 70. On or about August 22, 2012, Counterdefendant filed a trademark  
23 application for the '286 Mark for the identified services in International Class 41;  
24 the application was assigned Serial No. 85709994.

25 71. On or about August 27, 2013, over a year after filing its application  
26 for the '286 Mark, Counterdefendant submitted two specimens of use, namely, (1)  
27 a photograph of the front window of its fitness gym located in Chula Vista,  
28 California, and (2) an individual wearing a t-shirt bearing the Registered Mark

1 (collectively, “First ‘286 Specimens”).

2 72. In support of the First ‘286 Specimens, Rob Hueso, owner and  
3 manager of Counterdefendant, declared under penalty of perjury that the First ‘286  
4 Specimens were in use at least as early as the filing date of the application—  
5 August 22, 2012.

6 73. The First ‘286 Specimen of the front window display submitted on  
7 August 27, 2013 depicts a window decal bearing the terms THE ORIGINAL UFC  
8 GYM SINCE 1996 UFC ULTIMATE FITNESS CENTER C.V., as shown below.



16 74. The USPTO issued an Office Action on September 17, 2013  
17 against Counterdefendant’s application for the ‘286 Mark because the specimens  
18 did not show the mark as applied-for.

19 75. In response to the September 17, 2013 Office Action, that same  
20 day, Counterdefendant submitted a substitute specimen, which contained a new  
21 image of the same front window but displayed an entirely different window decal  
22 (as shown below) (“False ‘286 Window Specimen”).



1           76.     UFC is informed and believes and thereupon alleges that the False  
2 ‘286 Window Specimen does not, and never did actually exist.

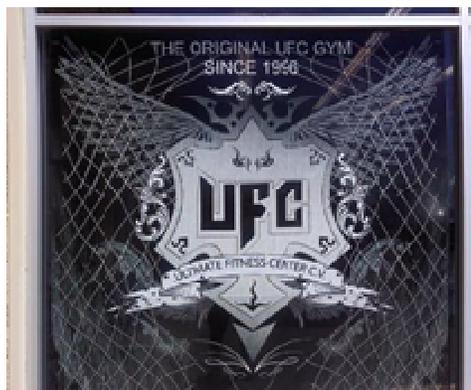
3           77.     UFC is informed and believes and thereupon alleges that the False  
4 ‘286 Window Specimen is a computer generated alteration of Counterdefendant’s  
5 real storefront.

6           78.     UFC is informed and believes and thereupon alleges that the ‘286  
7 was manufactured using computer software and/or by superimposing the False  
8 ‘286 Window Mark onto an image of the front window of Counterdefendant’s  
9 facility in Chula Vista, California.

10          79.     In furtherance of preparing this Answer and Counterclaim, on or  
11 about January 26, 2015, UFC engaged an investigator to visit Counterdefendant’s  
12 fitness gym located at 1380 3rd Ave., Chula Vista, California.

13          80.     The investigator photographed the location, including  
14 Counterdefendant’s front window, which is the subject of the False ‘286 Window  
15 Specimen of the front store window.

16          81.     Based upon the investigator’s report, as of January 26, 2015, the  
17 front window of Counterdefendant’s facility in Chula Vista still bore the original  
18 window decal submitted by Counterdefendant in its First ‘286 Specimen as shown  
19 below.



27           First ‘286 Specimen

28           January 26, 2015

82.     UFC is informed and believes and thereupon alleges that as of the

1 date of this filing, Counterdefendant's store front window still bears the window  
2 decal shown below.



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11 83. UFC is informed and believes and thereupon alleges that  
12 Counterdefendant's front store window never bore the decal shown below.



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20 84. Based on the foregoing, UFC is informed and believes and  
21 thereupon alleges that Counterdefendant created the False '286 Specimen with  
22 knowledge that the False '286 Window Specimen did not exist and submitted the  
23 False '286 Window Specimen to the USPTO with the intent to deceive the  
24 USPTO.

25 85. UFC is informed and believes and thereupon alleges that because  
26 Counterdefendant manufactured the False '286 Window Specimen using computer  
27 software and/or otherwise superimposing the '286 Mark onto the store front  
28 window and filed it with the USPTO, Counterdefendant knew the Declaration

1 submitted on September 17, 2010 under the penalty of perjury in support of the  
2 False '286 Window Specimen, contained false, material, misrepresentations to the  
3 USPTO.

4 86. The September 17, 2013 Declaration signed by Rob Hueso, under  
5 penalty of perjury, contains the precise language “[t]he substitute (or new, if  
6 appropriate) specimen(s) was/were in use in commerce at least as early as the filing  
7 date of the application...”

8 87. UFC is informed and believes and thereupon alleges that Rob  
9 Hueso, as owner and manager of Counterdefendant, understood the unambiguous  
10 language of the September 17, 2013 Declaration, wherein he falsely declared under  
11 penalty of perjury the False '286 Window Specimen was in use in commerce at  
12 least as early as August 22, 2012.

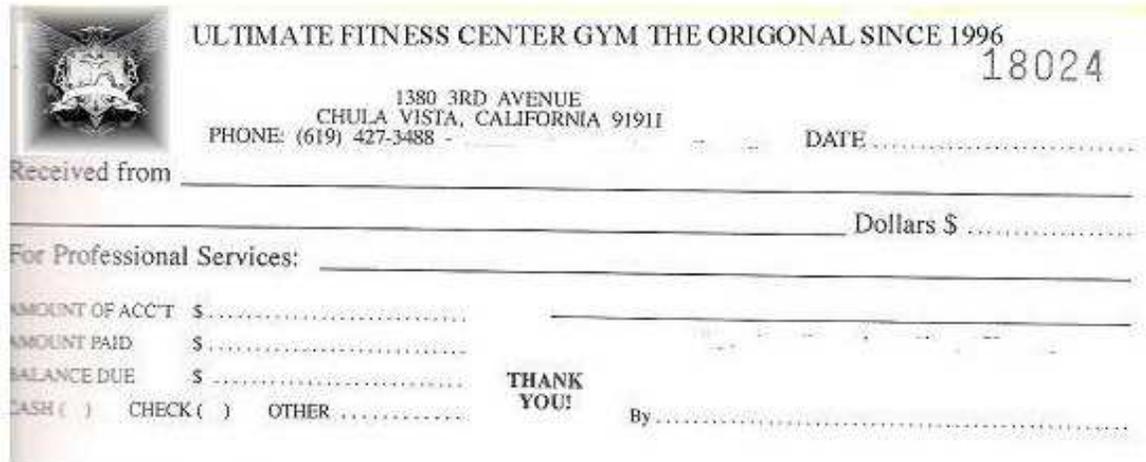
13 88. Based on the foregoing, UFC is informed and believes and  
14 thereupon alleges that Counterdefendant created and submitted the False '286  
15 Window Specimen with the intent to deceive the USPTO.

16 89. In light of Counterdefendant’s pattern of deceptive behavior in  
17 manufacturing false specimens of use and providing false dates of first use, UFC is  
18 informed and believes and thereupon alleges that Counterdefendant’s subsequent  
19 specimens submitted in support of its application for the '286 Mark were also  
20 manufactured to deceive the USPTO.

21 90. On or about October 14, 2013, in response to an Office Action  
22 issued that same day denying the False '286 Window Specimen because the  
23 wording “THE ORIGINAL SINCE 1996” was not contiguous with ULTIMATE  
24 FITNESS CENTER GYM in the False '286 Window Specimen, Counterdefendant  
25 submitted substitute specimens consisting of a receipt book, a promotional pass  
26 and a brochure.

27 91. UFC is informed and believes and thereupon alleges that the  
28 October 14, 2013 specimen of the receipt book did not exist at the time

1 Counterdefendant filed its application, but rather was a computer-generated fake  
 2 specimen, shown below (“Fake ‘286 Receipt Specimen”).”



11 92. Notably, the image in the upper right-hand corner appears to be  
 12 superimposed on top of the image of the Fake ‘286 Receipt Specimen.

13 93. The Fake ‘286 Receipt Specimen bears the mark ULTIMATE  
 14 FITNESS CENTER GYM THE ORIGINAL SINCE 1996; the term ORIGINAL  
 15 is misspelled as ORIGONAL.

16 94. The text of the terms ULTIMATE FITNESS CENTER GYM THE  
 17 ORIGINAL SINCE 1996 on the Fake ‘286 Receipt Specimen is awkwardly  
 18 placed at the very top of the receipt, with a large space between ULTIMATE  
 19 FITNESS CENTER GYM THE ORIGONAL SINCE 1996 and  
 20 Counterdefendant’s business address below.

21 95. UFC is informed and believes and thereupon alleges that  
 22 Counterdefendant hastily created and submitted the misspelled False ‘286 Receipt  
 23 Specimen on the same day and in response to the USPTO’s refusal of the Fake  
 24 ‘286 Window Specimen.

25 96. UFC is informed and believes and thereupon alleges that  
 26 Counterdefendant created and submitted the False ‘286 Receipt Specimen with  
 27 knowledge that the False ‘286 Receipt Specimen did not exist and submitted it to  
 28 the USPTO with the intent to deceive.

1           97.     Based on the foregoing, UFC is informed and believes and  
2 thereupon alleges that the False ‘286 Receipt Specimen was manufactured by  
3 Counterdefendant on or about October 14, 2013 to show and misrepresent the use  
4 of the ‘286 Mark.

5           98.     In support of the October 14, 2013 specimens, Rob Hueso, on  
6 behalf of Counterdefendant, declared under penalty of perjury that “[t]he substitute  
7 (or new, if appropriate) specimen(s) was/were in use in commerce at least as early  
8 as the filing date of the application...”

9           99.     UFC is informed and believes and thereupon alleges that Rob  
10 Hueso, as owner and manager of Counterdefendant, understood the unambiguous  
11 language of the October 14, 2013 Declaration, wherein he declared under penalty  
12 of perjury that the False ‘286 Receipt Specimen was in use in commerce at least as  
13 early as August 22, 2012.

14           100.    UFC is informed and believes and thereupon alleges that  
15 Counterdefendant’s promotional pass and brochure specimens submitted on  
16 October 14, 2013 are unacceptable printer’s proofs or mock-up brochures and as  
17 such, could not support registration of the ‘286 Mark. *See* TMEP § 1301.04.

18           101.    Based on the foregoing, UFC is informed and believes and  
19 thereupon alleges the application that resulted in Registration No. 4445286  
20 constituted a fraud on the USPTO and Counterdefendant’s registration for the ‘286  
21 Mark should be cancelled in its entirety.

22                   **2.     Fraudulent Registration No. 4600344**

23           102.    Counterdefendant fraudulently procured Registration No. 4600344  
24 for the mark ULTIMATE FITNESS CENTER GYM THE ORIGINAL SINCE  
25 1996 (and Design) (“‘344 Mark”) by making: (1) material misrepresentations of  
26 fact to the United States Patent and Trademark Office (“USPTO”) in connection  
27 with its application; (2) which Counterdefendant knew were false; and (3)  
28 Counterdefendant’s misrepresentations were made with the intent to deceive the

1 USPTO.

2 103. UFC is informed and believes and thereupon alleges that  
3 Counterdefendant committed fraud in procuring its registration for the '344 Mark.

4 104. UFC is informed and believes and thereupon alleges that  
5 Counterdefendant provided the USPTO with a false first use date for the '344  
6 Mark, which it knew to be false and/or misleading with the willful intent to deceive  
7 the USPTO for purposes of obtaining a registration.

8 105. UFC is informed and believes and thereupon alleges that  
9 Counterdefendant used a computer-generated fake specimen of use that did not  
10 exist at the time it filed its application, and still does not exist to this day, with the  
11 willful intent to deceive the USPTO for purposes of obtaining a registration.

12 106. UFC is informed and believes and thereupon alleges that  
13 Counterdefendant's false and/or misleading statements were material because  
14 absent such misrepresentations, the USPTO would not have issued the registration  
15 for the '344 Mark.

16 107. On or about December 10, 2013, Counterdefendant filed a  
17 trademark application for the '344 Mark based on Counterdefendant's alleged use  
18 of the '344 Mark in connection with the identified services in International Class  
19 41; the application was assigned Serial No. 86139383.

20 108. In its application, Counterdefendant claimed a first use date of at  
21 least as early as June 20, 1996.

22 109. On or about December 10, 2013, Counterdefendant simultaneously  
23 submitted in conjunction with its application a specimen of use, namely, an exact  
24 copy of Counterdefendant's the False '286 Window Specimen.

25 110. In support of the False '286 Window Specimen in the '344 Mark  
26 application, Counterdefendant submitted a Declaration under penalty of perjury  
27 stating that all statements made in the '344 Mark application were believed to be  
28 true.

1           111. UFC is informed and believes and thereupon alleges that  
2 Counterdefendant’s Declaration made under penalty of perjury in support of the  
3 specimen filed in conjunction with its application for the ‘344 Mark was false and  
4 was knowingly made with the intent to commit fraud upon the USPTO.

5           112. Counterdefendant filed the False ‘286 Specimen to support its  
6 application for the ‘344 Mark on December 10, 2013—only seven days after its  
7 ‘286 Mark proceeded to registration on December 3, 2013.

8           113. UFC is informed and believes and thereupon alleges that once  
9 Counterdefendant had confirmation its deceptive behavior of submitting a fake  
10 specimen was persuasive upon the USPTO, it proceeded to use the same False  
11 ‘286 Specimen as support for fraudulently obtaining a registration for the ‘344  
12 Mark.

13           114. Based on the foregoing, UFC is informed and believes and  
14 thereupon alleges the application that resulted in Registration No. 4600344  
15 constituted a fraud on the USPTO and Counterdefendant’s ‘344 Mark registration  
16 should be cancelled in its entirety.

17                           **3.     *Fraudulent Registration No. 4600347***

18           115. Counterdefendant fraudulently procured Registration No. 4600347  
19 for the mark ULTIMATE FITNESS CENTER THE ORIGINAL SINCE 1996 (and  
20 Design) (“‘347 Mark”) by making: (1) material misrepresentations of fact to the  
21 United States Patent and Trademark Office (“USPTO”) in connection with its  
22 application; (2) which Counterdefendant knew were false; and (3)  
23 Counterdefendant’s misrepresentations were made with the intent to deceive the  
24 USPTO.

25           116. UFC is informed and believes and thereupon alleges that  
26 Counterdefendant committed fraud in procuring its registration for the ‘347 Mark.

27           117. UFC is informed and believes and thereupon alleges that  
28 Counterdefendant provided the USPTO with a false first use date for the ‘347

1 Mark, which it knew to be false and/or misleading with the willful intent to deceive  
2 the USPTO for purposes of obtaining a registration.

3 118. UFC is informed and believes and thereupon alleges that  
4 Counterdefendant created computer-generated fake specimens of use that did not  
5 exist at the time it filed its application for the '347 Mark, and still do not exist to  
6 this day, with the willful intent to deceive the USPTO for purposes of obtaining a  
7 registration.

8 119. UFC is informed and believes and thereupon alleges  
9 Counterdefendant fraudulently obtained registration of the '347 Mark because  
10 Counterdefendant had not used the mark in commerce (as defined by the  
11 Trademark Act) on the date indicated in the application.

12 120. UFC is informed and believes and thereupon alleges that  
13 Counterdefendant's false and/or misleading statements, made under penalty of  
14 perjury, were material because absent such misrepresentations, the USPTO would  
15 not have issued the registration for the '347 Mark.

16 121. On or about December 11, 2013, Counterdefendant filed a use-  
17 based trademark application for the '347 Mark in International Class 25; the  
18 application was assigned Serial No. 86140607.

19 122. In its application, Counterdefendant claimed a first use date of at  
20 least as early as June 20, 1996.

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1           123. On or about December 11, 2013, Counterdefendant simultaneously  
2 submitted in conjunction with its application three specimens of use, namely, a  
3 photograph of a man allegedly wearing a t-shirt bearing the '347 Mark and an  
4 image of a price tag and clothing tag, which allegedly bearing the '347 Mark, as  
5 shown below.



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24           124. On March 13, 2014, the USPTO issued an Office Action refusing  
25 Counterdefendant's specimens for the '347 Mark because they were illegible.

26           125. UFC is informed and believes that the December 11, 2013  
27 specimens do not and never did exist.

28           126. In response to the Office Action, on April 8, 2014

1 Counterdefendant submitted substitute specimens consisting of images of t-shirts  
2 allegedly bearing the '347 Mark, shown below (collectively, "False '347  
3 Specimens").



21 127. In support of the False '347 Specimens, Rob Hueso, on behalf of  
22 Counterdefendant, submitted a Declaration under penalty of perjury stating that the  
23 False '347 Specimens were in use at least as early as the filing date of the  
24 application—December 11, 2013.

25 128. UFC is informed and believes and thereupon alleges that  
26 Counterdefendant's Declaration made under penalty of perjury in support of the  
27 False '347 Specimens was material, false, and was knowingly made with the intent  
28 to commit fraud on the USPTO.

1           129. Specifically, UFC is informed and believes and thereupon alleges  
2 the False '347 Specimens are computer generated frauds.

3           130. UFC is informed and believes and thereupon alleges that the False  
4 '347 Specimens were manufactured using computer software and/or by  
5 superimposing the '347 Mark onto an image of t-shirts.

6           131. As seen in each of the False '347 Specimens below, the  
7 background area of the '347 Mark does not match the color of the shirts.



1           132. As seen in each of the False '347 Specimens, the '347 Mark is  
2 crookedly placed on the t-shirts and does not bear the same folds as the cloth of the  
3 t-shirts on the individual or on hangers.

4           133. As seen in the False '347 Specimen depicting a t-shirt worn by an  
5 individual, the fold in the cloth is visible *behind* the digitally superimposed image  
6 of the '347 Mark. Said differently, the image of the '347 Mark does not fold  
7 where it should with the t-shirt if the t-shirt actually bore the '347 Mark. Rather,  
8 the image of the '347 Mark is merely superimposed on the t-shirt via a computer.

9           134. Moreover, the '347 Mark does not appear on all the t-shirts,  
10 notably, the teal t-shirt in the False '347 Specimen does not contain the mark.



25           135. In furtherance of preparing this Answer and Counterclaim, on or  
26 about January 26, 2015, UFC engaged an investigator to visit Counterdefendant's  
27 fitness gym located at 1380 3rd Ave., Chula Vista, California.

28           136. The investigator photographed Counterdefendant's location,

1 including the front display window and retail area.

2 137. Based upon the investigator's report, UFC is informed and believes  
3 and thereupon alleges that on January 26, 2015, no shirts bearing the '347 Mark  
4 were on sale at Counterdefendant's fitness center

5 138. Based upon the investigator's report, UFC is informed and believes  
6 and thereupon alleges that on January 26, 2015, the only t-shirts on display at  
7 Counterdefendant's fitness center bore a different mark, namely, an infringing  
8 UFC design mark, as shown below.



17 139. The investigator also purchased a t-shirt from Counterdefendant  
18 for \$15, shown below.



26 140. UFC is informed and believes and thereupon alleges that  
27 Counterdefendant created the False '347 Specimens on or about April 8, 2014 to  
28 show use of the '347 Mark, which subsequently registered on September 9, 2014.

1           141. UFC is informed and believes and thereupon alleges that, because  
2 Counterdefendant created the False ‘347 Specimens and filed them with the  
3 USPTO on April 8, 2014, almost four months after the filing of its application,  
4 Counterdefendant knew at that time Rob Hueso’s Declaration signed under penalty  
5 of perjury, contained false, material, misrepresentations to the USPTO.

6           142. The April 8, 2014 Declaration signed by Rob Hueso under penalty  
7 of perjury contains the precise language “[t]he substitute (or new, if appropriate)  
8 specimen(s) was/were in use in commerce at least as early as the filing date of the  
9 application...”

10           143. UFC is informed and believes and thereupon alleges that Mr.  
11 Hueso, as owner and manager of Counterdefendant, understood the unambiguous  
12 language of the April 8, 2014 Declaration, wherein he falsely declared under  
13 penalty of perjury that the False ‘347 Specimens were in use in commerce at least  
14 as early as December 11, 2013.

15           144. Based on the foregoing, UFC is informed and believes and  
16 thereupon alleges that Counterdefendant created and submitted the False ‘347  
17 Specimens with the knowledge that the False ‘347 Specimens were fabricated.

18           145. Based on the foregoing, UFC is informed and believes and  
19 thereupon alleges that Counterdefendant created and submitted the False ‘347  
20 Specimens with the intent to deceive the USPTO.

21           146. Based on the foregoing, UFC is informed and believes and  
22 thereupon alleges that the misrepresentations made by Counterdefendant, i.e.,  
23 falsifying specimens, are material, given that without an acceptable specimen, a  
24 registration for the ‘347 Mark would not have issued.

25           147. Furthermore, because Counterdefendant manufactured the False  
26 ‘347 Specimens after the application was initially filed and no other acceptable  
27 specimens were filed or have been found, UFC is informed and believes and  
28 thereupon alleges that in Counterdefendant’s Declaration to the USPTO, wherein

1 Rob Hueso states under penalty of perjury that the '347 Mark was first used in  
2 commerce at least as early as June 20, 1996, is also false and material, that  
3 Counterdefendant knew this date of first use was false, and submitted it with the  
4 intent to deceive.

5 148. UFC is informed and believes and thereupon alleges that  
6 Counterdefendant would not have received Registration No. 4600347 identifying a  
7 date of first use of at least as early as June 20, 1996, for the goods identified  
8 therein but for the willful, false, material misrepresentations in the Declarations  
9 and False Specimens submitted to the USPTO under the penalty of perjury

10 149. Based on the foregoing, UFC is informed and believes and  
11 thereupon alleges the application that resulted in Registration No. 4600347  
12 constituted a fraud on the USPTO and Counterdefendant's registration for the '347  
13 Mark should be cancelled in its entirety.

14 **4. *Fraudulent Registration No. 4608679***

15 150. Counterdefendant fraudulently procured Registration No. 4608679  
16 for the mark ULTIMATE FITNESS COACH ("679 Mark") by making: (1)  
17 material misrepresentations of fact to the United States Patent and Trademark  
18 Office ("USPTO") in connection with its application; (2) which Counterdefendant  
19 knew were false; and (3) Counterdefendant's misrepresentations were made with  
20 the intent to deceive the USPTO.

21 151. UFC is informed and believes and thereupon alleges that  
22 Counterdefendant committed fraud in procuring its registration for the '679 Mark.

23 152. UFC is informed and believes and thereupon alleges that  
24 Counterdefendant provided the USPTO with a false first use date for the '679  
25 Mark, which it knew to be false and/or misleading, with the willful intent to  
26 deceive the USPTO for purposes of obtaining a registration.

27 153. UFC is informed and believes and thereupon alleges that  
28 Counterdefendant created a fake specimen of use in support of its registration for

1 the '679 Mark that did not exist at the time it filed its application, with the willful  
2 intent to deceive the USPTO for purposes of obtaining a registration.

3 154. UFC is informed and believes and thereupon alleges  
4 Counterdefendant fraudulently obtained registration of the '679 Mark because  
5 Counterdefendant had not used the '679 Mark in commerce (as defined by the  
6 Trademark Act) on the date indicated in the application.

7 155. UFC is informed and believes and thereupon alleges that  
8 Counterdefendant's false and/or misleading statements were material because  
9 absent such misrepresentations, the USPTO would not have issued the registration  
10 for the '679 Mark.

11 156. On or about December 11, 2013, Counterdefendant filed a  
12 trademark application for the '679 in International Class 41; the application was  
13 assigned Serial No. 86140667.

14 157. In its application, Counterdefendant claimed a first use date of at  
15 least as early as January 10, 2005.

16 158. On or about December 11, 2013, Counterdefendant simultaneously  
17 submitted in conjunction with its application a specimen of use, namely, an image  
18 of Counterdefendant's website located at [ultimatefitnesscenter.blogspot.com](http://ultimatefitnesscenter.blogspot.com)  
19 showing online coaching options ("First '679 Specimen").

20 159. The First '679 Specimen not contain the '679 Mark as applied for.

21 160. The date of the screen capture of the First '679 Specimen  
22 displayed in the lower right hand corner of the image is December 11, 2013, the  
23 same day Counterdefendant filed its application, as shown below.

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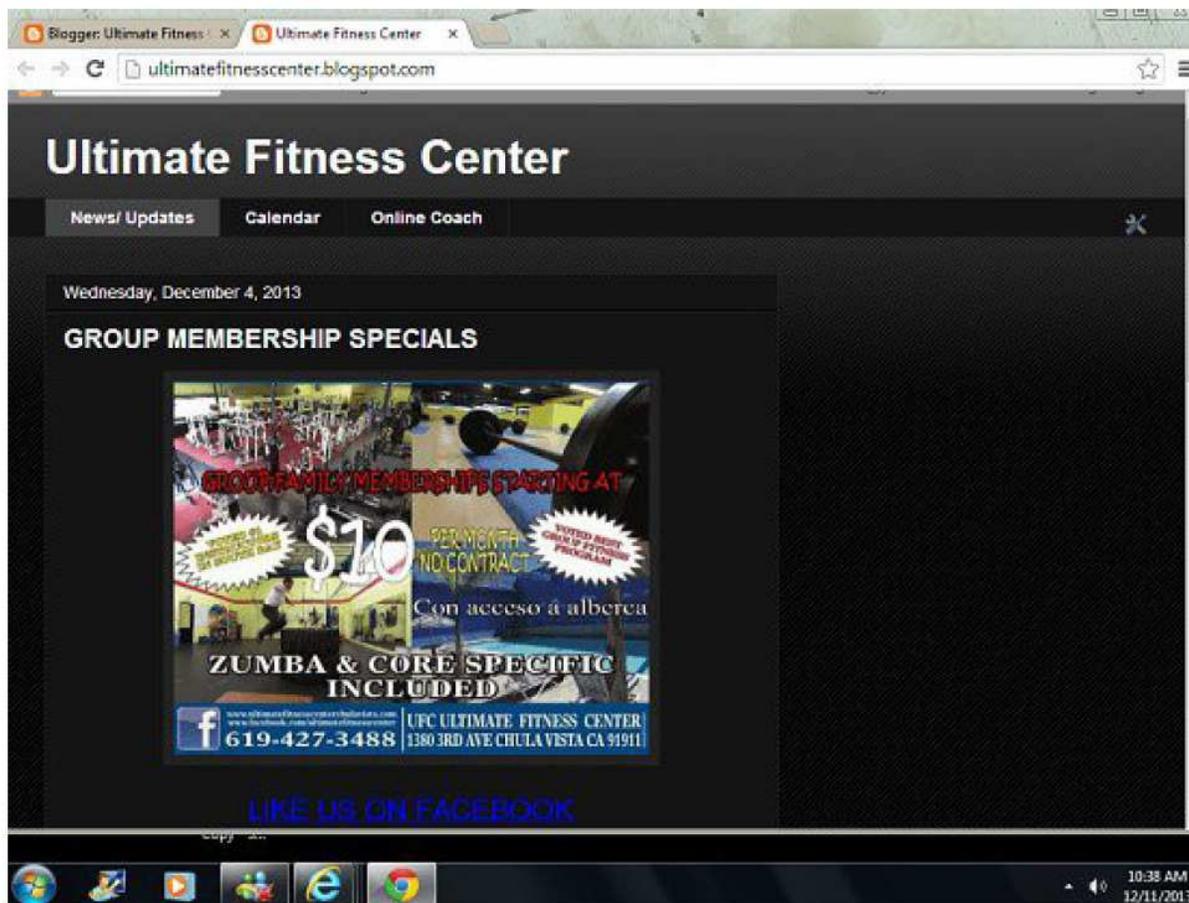
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Screen Capture 12/11/13

161. In support of the First ‘679 Specimen, Counterdefendant submitted a Declaration under penalty of perjury stating that all statements in the application made of Counterdefendant’s own knowledge were true.

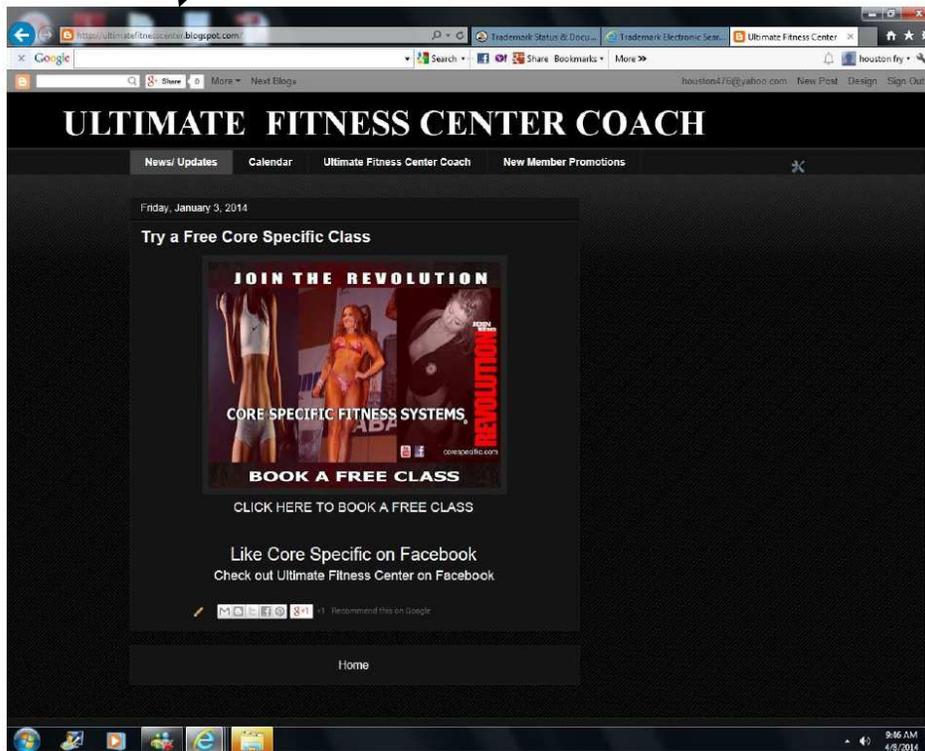
162. On March 13, 2014, the USPTO issued an Office Action refusing registration of the ‘679 Mark because the First ‘679 Specimen did not show the applied-for mark in use in commerce.

163. In response to the March 13, 2014 Office Action, on April 8, 2014, Counterdefendant submitted unverified substitute specimens consisting of: (1) an image of its website located at [ultimatefitnesscenter.blogspot.com](http://ultimatefitnesscenter.blogspot.com) depicting use of the applied-for mark (“False ‘ 679 Specimen”); (2) an alleged brochure depicting use of the applied-for mark; and (3) an alleged brochure featuring the applied-for

1 mark.

2 164. Notably, the False '679 Specimen is an image of  
3 Counterdefendant's webpage located at the exact same website address as the First  
4 '679 specimen, namely, [ultimatefitnesscenter.blogspot.com](http://ultimatefitnesscenter.blogspot.com); however, the screen  
5 capture is dated April 8, 2014.

6 Same website address as First '679 Specimen



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20 Screen capture 4/8/14

21 165. In other words, the *exact same website*,  
22 [ultimatefitnesscenter.blogspot.com](http://ultimatefitnesscenter.blogspot.com), did not contain the '679 Mark on December  
23 11, 2013 in the First '679 Specimen, but allegedly bore the '679 Mark on April 8,  
24 2014 in the False '679 Specimen.

25 166. Additionally, in the False '679 Specimen, a new tab appears on the  
26 website titled "Ultimate Fitness Center Coach," which did not appear in the First  
27 '679 Specimen.

28 167. UFC is informed and believes and thereupon alleges that

1 Counterdefendant's specimens themselves demonstrate the False '679 Specimen  
2 did not exist on December 11, 2013.

3 168. UFC is informed and believes and thereupon alleges that because  
4 the False '679 Specimen did not exist on December 11, 2013, it could not be in use  
5 in commerce at the time Counterdefendant filed its application.

6 169. Thus, UFC is informed and believes and thereupon alleges that  
7 Counterdefendant added the '679 Mark to its website  
8 ultimatefitnesscenter.blogspot.com after its First '679 Specimen was rejected, and  
9 thereby created the False '679 Specimen.

10 170. UFC is informed and believes and thereupon alleges that the False  
11 '679 Specimen was manufactured by Counterdefendant sometime between  
12 December 11, 2013 and April 8, 2014 to show use of the '679 Mark and overcome  
13 the USPTO's refusal.

14 171. The '679 Mark subsequently registered on September 23, 2014.

15 172. UFC is informed and believes and thereupon alleges that  
16 Counterdefendant's other two specimens submitted in conjunction with the False  
17 '679 Specimen are unacceptable printer's proofs or mock-up brochures and as  
18 such, could not support registration of the '679 Mark. *See* TMEP § 1301.04.

19 173. On May 6, 2014, Rob Hueso submitted a Declaration, under  
20 penalty of perjury, verifying the False '679 Specimen, which contains the precise  
21 language "[t]he substitute (or new, if appropriate) specimen(s) was/were in use in  
22 commerce at least as early as the filing date of the application..."

23 174. UFC is informed and believes and thereupon alleges that Rob  
24 Hueso understood the unambiguous language of the May 6, 2014 Declaration,  
25 wherein he falsely declared under penalty of perjury that the False '679 Specimen  
26 was in use in commerce at least as early as December 11, 2013.

27 175. Based on the foregoing, UFC is informed and believes and  
28 thereupon alleges that Counterdefendant created and submitted the False '679

1 Specimen with the intent to deceive the USPTO.

2 176. UFC is informed and believes and thereupon alleges that the  
3 misrepresentations made by Counterdefendant, i.e., falsifying specimens, are  
4 material, given that without an acceptable specimen, a registration for the '679  
5 Mark would not have issued.

6 177. Furthermore, because Counterdefendant manufactured the False  
7 '679 Specimen after the application was initially filed and no other acceptable  
8 specimens were filed or have been found, UFC is informed and believes and  
9 thereupon alleges that in Counterdefendant's Declaration to the USPTO, wherein  
10 Rob Hueso states under penalty of perjury that the '679 Mark was first used in  
11 commerce at least as early as January 10, 2005, is also false and material, that  
12 Counterdefendant knew this date of first use was false, and submitted it with the  
13 intent to deceive.

14 178. UFC is informed and believes and thereupon alleges that  
15 Counterdefendant would not have received Registration No. 4608679 identifying a  
16 date of first use of at least as early as January 10, 2005, for the services identified  
17 therein but for the willful, false, material misrepresentations in the Declarations  
18 and false specimens submitted to the USPTO under the penalty of perjury.

19 179. In light of Counterdefendant's pattern of deceptive behavior in  
20 manufacturing false specimens of use and providing false dates of first use, UFC is  
21 informed and believes and thereupon alleges that Counterdefendant's other  
22 specimens submitted in support of its application for the '679 Mark were also  
23 created to deceive the USPTO.

24 180. Based on the foregoing, UFC is informed and believes and  
25 thereupon alleges the application that resulted in Registration No. 4608679  
26 constituted a fraud on the USPTO and Counterdefendant's registration for the '679  
27 Mark should be cancelled in its entirety.

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1                   **5. Counterdefendant Made Fraudulent False Statements of Use**  
2                   **in Commerce**

3           181. UFC is informed and believes and thereupon alleges that  
4 Counterdefendant is not using the ‘286, ‘344, ‘347 and ‘679 Marks “in commerce”  
5 as defined in the Trademark Act; rather, if Counterdefendant is using the marks at  
6 all, Counterdefendant’s use is limited to *intrastate* commerce within the state of  
7 California and the San Diego area.

8           182. UFC is informed and believes and thereupon alleges  
9 Counterdefendant knowingly made false, material, misrepresentations of fact that  
10 the ‘286, ‘344, ‘347 and ‘679 Marks have been used in commerce in connection  
11 with the goods/services identified in the respective registrations, with the willful  
12 intent to deceive the USPTO for the purposes of obtaining the Fraudulent  
13 Registrations.

14           183. To establish “use in commerce” under the Trademark Act,  
15 Counterdefendant must be offering goods/services in commerce between more  
16 than one state or U.S. territory, or in commerce between the U.S. and another  
17 country. *See* 15 U.S.C. § 1127.

18           184. UFC is informed and believes and thereupon alleges that the  
19 Declarations, signed by Rob Hueso under penalty of perjury, supporting use in the  
20 applications for the ‘286, ‘344, ‘347 and ‘679 Marks contained false, material,  
21 misrepresentations to the USPTO.

22           185. Specifically, in its applications, Rob Hueso, under penalty of  
23 perjury, declared on behalf of Counterdefendant that the ‘286, ‘344, ‘347 and ‘679  
24 Marks were used “in commerce.”

25           186. Moreover, Rob Hueso declares under penalty of perjury in each of  
26 the Declarations that “all statements made of [its] own knowledge are true; and that  
27 all statements made on information and belief are believed to be true.”

28           187. UFC is informed and believes and thereupon alleges that

1 Counterdefendant knew it was not using the ‘286, ‘344, ‘347 and ‘679 Marks in  
2 commerce as of the filing dates of Counterdefendant’s applications that matured  
3 into registrations for the ‘286, ‘344, ‘347 and ‘679 Marks.

4 188. UFC is informed and believes and thereupon alleges that  
5 Counterdefendant operates and offers its services out of a single location located in  
6 Chula Vista, California.

7 189. In the Nevada Case, to support Counterdefendant’s motion for  
8 dismissal based on a lack of personal jurisdiction, Mr. Hueso submitted a  
9 declaration under penalty of perjury stating:

10 Any and all marketing for [Counterdefendant] was only  
11 directed at and published in the greater San Diego area.

12 Because [Counterdefendant] is only located in San  
13 Diego, [Counterdefendant] has not intentionally directed  
14 any communications at Nevada residents to obtain their  
15 business.

16 [Counterdefendant] also maintains a website at the URL  
17 [www.ultimatefitnesscenter.chulavista.com](http://www.ultimatefitnesscenter.chulavista.com). Although the  
18 website is viewable on the Internet, it only lists  
19 California contact information has [sic] how to find  
20 [Counterdefendant’s] location.

21 190. Moreover, in Counterdefendant’s Appellee Brief filed before the  
22 Ninth Circuit Court of Appeals on February 27, 2015, Counterdefendant states it  
23 “operates a single gym in Chula Vista, California” and “only advertises in the  
24 greater San Diego area.”

25 191. Counterdefendant further emphasizes in its Appellee Brief that its  
26 website is “passive in nature and identifies its only address at 1380 Third Avenue,  
27 Chula Vista, California 91911.”

28 192. Based, at minimum, on Counterdefendant’s own statements that it  
has a single location that directs all of its marketing exclusively within the state of  
California, UFC is informed and believes and thereupon alleges that

1 Counterdefendant's declarations made under penalty of perjury to the USPTO that  
2 the '286, '344, '347 and '679 Marks are used "in commerce" were material  
3 misrepresentations of fact, which Counterdefendant knew to be false and  
4 misleading, and were made with the intent to deceive the USPTO.

5 193. UFC is informed and believes and thereupon alleges that  
6 Counterdefendant's false statements made under penalty of perjury that  
7 Counterdefendant has used the '286, '344, '347 and '679 Marks "in commerce"  
8 were material misrepresentations because Counterdefendant's use, if any, is limited  
9 to *intrastate* commerce and as such, the USPTO would not have issued the  
10 registrations for the '286, '344, '347 and '679 Marks.

11 194. Based on the foregoing, UFC is informed and believes and  
12 thereupon alleges the applications that resulted in the Fraudulent Registrations  
13 constituted a fraud on the USPTO.

14 195. Based on the foregoing, on March 9, 2015, UFC filed four  
15 Petitions to Cancel the Fraudulent Registrations with the TTAB and seeks a  
16 declaratory order cancelling the Fraudulent Registrations from this Court.

17 **COUNT I**  
18 **(Federal Trademark Infringement**  
19 **Pursuant to 15 U.S.C. §§ 1114 and 1125(a))**

20 196. UFC incorporates the allegations set forth in each of the preceding  
21 paragraphs of the Counterclaim as if fully set forth herein.

22 197. Counterdefendant's Infringing Marks use the term UFC in  
23 commerce, which is a trademark belonging to UFC.

24 198. Counterdefendant's use in commerce of UFC's UFC® Marks,  
25 including the UFC® name and mark for its health club and fitness instruction  
26 services and associated products, including but not limited to t-shirts, constitutes a  
27 reproduction, copying, counterfeiting, and colorable imitation of UFC's  
28 trademarks in a manner that is likely to cause confusion or mistake or is likely to

1 deceive consumers.

2 199. By using the UFC® Marks, including the UFC® name and mark,  
3 with the knowledge that UFC owns and has used, and continues to use, its  
4 trademarks, including the UFC® name and mark, across the United States and  
5 around the world, Counterdefendant has intended to cause confusion, cause  
6 mistake, or deceive consumers.

7 200. Counterdefendant is using a mark that is the same and/or  
8 confusingly similar to the UFC® Marks, including the UFC® name and mark, in  
9 connection with the sale, offering for sale, or advertising of a service and/or goods  
10 in a manner that is likely to cause confusion of mistake, or to deceive customers as  
11 to an affiliation, connection, or association with UFC and/or the UFC®, or as to  
12 the origin, sponsorship, or approval of Counterdefendant's services or commercial  
13 activity by UFC.

14 201. Counterdefendant's use of the UFC® Marks, including the UFC®  
15 name and mark, has created a likelihood of confusion among consumers who may  
16 falsely believe that Counterdefendant's health club and fitness instruction services  
17 and goods originate from, or are affiliated with, or are sponsored or endorsed by  
18 UFC and/or the UFC®, when in fact, they are not..

19 202. UFC is informed and believes, and thereupon alleges that,  
20 Counterdefendant's use of UFC's mark(s) and/or a mark(s) confusingly similar to  
21 the UFC® Marks, including the UFC® name and mark, was intentionally and  
22 willfully done with the knowledge that UFC owns and has used, and continues to  
23 use, its trademarks.

24 203. As a direct and proximate result of Counterdefendant's  
25 infringement, UFC has suffered, and will continue to suffer, unless  
26 Counterdefendant is restrained, monetary damages and irreparable injury to its  
27 business, reputation, and goodwill.

28 204. As a direct and proximate result of Counterdefendant's

1 infringement, UFC has been compelled to retain counsel to enforce its trademark  
2 rights and prosecute this action.

3  
4 **COUNT II**  
5 **(Federal Unfair Competition, False Designation of Origin, and**  
6 **False Advertising Pursuant to 15 U.S.C. § 1125(a))**

7 205. UFC incorporates the allegations set forth in each of the preceding  
8 paragraphs of the Counterclaim as if fully set forth herein.

9 206. Counterdefendant's use in commerce of a mark that is the same  
10 and/or confusingly similar to the UFC® Marks, including the UFC® name and  
11 mark, in connection with Counterdefendant's health club and fitness instruction  
12 services, and on t-shirts, constitutes a false designation of origin and/or false or  
13 misleading description or representation of fact, which is likely to cause  
14 confusion, cause mistake, or deceive as to affiliation, connection, or association  
15 with UFC, or as to the origin, sponsorship, or approval of Counterdefendant's  
16 services or commercial activities by UFC.

17 207. Counterdefendant's use in commerce of UFC's mark(s) and or a  
18 mark(s) confusingly similar to the UFC® Marks, including the UFC® name and  
19 mark, with the knowledge that UFC owns and has used, and continues to use, its  
20 trademarks constitutes intentional conduct by Counterdefendant to make false  
21 designations of origin and false descriptions about Counterdefendant's services  
22 and commercial activities.

23 208. As a direct and proximate result of Counterdefendant's unfair  
24 competition, UFC has suffered, and will continue to suffer, unless  
25 Counterdefendant is restrained, monetary damages and irreparable injury to its  
26 business, reputation, and goodwill.

27 209. As a direct and proximate result of Counterdefendant's  
28 infringement, UFC has been compelled to retain counsel to enforce its trademark  
rights and prosecute this action.

**COUNT III**  
**(Trademark Dilution under the Federal Anti-Dilution Act,  
15 U.S.C. § 1125(c))**

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4           210. UFC incorporates the allegations set forth in each of the preceding  
5 paragraphs of the Counterclaim as if fully set forth herein.

6           211. UFC's trademarks are inherently distinctive. Through its  
7 adoption and consistent and extensive use, UFC's trademarks have acquired  
8 fame.

9           212. Counterdefendant began using a mark(s) that is the same and/or  
10 nearly identical to the UFC® Marks, including the UFC® name and mark, which  
11 has and will cause dilution of the distinctive quality of UFC's trademarks by  
12 tarnishing the name and mark, and will otherwise cause irreparable injury to  
13 UFC's business, reputation, and goodwill.

14           213. Counterdefendant's health club and fitness instruction services  
15 and infringing goods tarnish the reputation of the UFC® Marks by, inter alia,  
16 making an unauthorized and false connection between Counterdefendant's goods  
17 and services and the UFC® Marks, including the UFC® name and mark.

18           214. Any implied connection between the UFC® and  
19 Counterdefendant's services is detrimental to UFC's business, and UFC has  
20 devoted substantial resources over the years to establish its own MMA-related  
21 sports and entertainment services and health club and fitness instruction services,  
22 and UFC's goods.

23           215. UFC is informed and believes, and thereupon alleges, that  
24 Counterdefendant's use of UFC's mark(s) and or a mark(s) confusingly similar to  
25 the UFC® Marks, including the UFC® name and mark, was willful in nature, in  
26 that Counterdefendant willfully intended to trade off the reputation of UFC  
27 and/or the UFC® and cause dilution of the UFC® Marks, including the UFC®  
28 name and mark.



1 irreparable damage, for which UFC has no adequate remedy at law.

2 **COUNT V**  
3 **(California Common Law Trademark Infringement)**

4 223. UFC incorporates the allegations set forth in each of the preceding  
5 paragraphs of the Counterclaim as if fully set forth herein.

6 224. By virtue of having used and continuing to use the UFC® Marks,  
7 including the UFC® name and mark, UFC has acquired common law trademark  
8 rights in the UFC® Marks, including the UFC® name and mark.

9 225. Counterdefendant's use of a mark(s) that is the same and/or  
10 confusingly similar to the UFC® Marks, including the UFC® name and mark,  
11 infringes UFC's common law rights in its UFC® name and mark, and is likely to  
12 cause confusion, mistake, or deception among consumers, who will believe that  
13 Counterdefendant's health club and fitness instruction services and goods  
14 originate from, or are affiliated with, or are endorsed by UFC and/or the UFC®,  
15 when in fact, they are not.

16 226. As a direct and proximate result of Counterdefendant's  
17 infringement of UFC's common law trademark rights under California and other  
18 common law, UFC has suffered, and will continue to suffer, monetary damages  
19 and irreparable injury to its business, reputation, and goodwill.

20 227. As a direct and proximate result of Counterdefendant's  
21 infringement, UFC has been compelled to retain counsel to enforce its trademark  
22 rights and prosecute this action.

23 228. UFC seeks all damages to which it is entitled to for  
24 Counterdefendant's infringement in an amount to be determined by the Court.

25 229. UFC seeks injunctive relief to prevent the irreparable harm  
26 Counterdefendant's infringement has caused and would continue to cause if not  
27 enjoined.

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1 promotion, offer for sale, and/or sale of Counterdefendant's goods and services  
2 using UFC's UFC® Marks has injured the business reputation of UFC and/or is  
3 likely to dilute the distinctive value of UFC's UFC® Marks in violation of  
4 Section 14247 of the California Business and Professions Code.

5 238. UFC has no adequate remedy at law.

6 239. Injury to UFC and dilution of UFC's trademarks will continue, all  
7 to UFC's irreparable harm, unless Counterdefendant is enjoined by this Court.

8 240. UFC is therefore entitled to injunctive relief, compensatory and  
9 punitive damages, reasonable attorneys' fees and costs.

10  
11 **COUNT VIII**  
12 **(Cancellation of the Fraudulent Registrations**  
13 **Pursuant to 15 U.S.C. § 1119)**

14 241. UFC incorporates the allegations set forth in each of the preceding  
15 paragraphs of the Counterclaim as if fully set forth herein.

16 242. Counterdefendant's allegations of infringement against UFC are  
17 based on the assumption that its registrations for the '286, '344, '347 and/or '679  
18 Marks are valid and enforceable, and that Counterdefendant has the authority to  
19 enforce the '286, '344, '347 and/or '679 Marks in the United States.

20 243. Counterdefendant filed the applications for the '286, '344, '347  
21 and '679 Marks in the United States based on its purported use of the '286, '344,  
22 '347 and '679 Marks in commerce in the United States for all the goods and  
23 services identified in its U.S. applications for the Fraudulent Registrations.

24 244. UFC is informed and believes and thereupon alleges that  
25 Counterdefendant manufactured fake specimens of use and provided false  
26 declarations under penalty of perjury in connection with its applications for the  
27 '286, '344, '347 and '679 Marks.

28 245. As a result, UFC believes that fraudulent conduct was perpetrated  
by Counterdefendant during the procurement of the Fraudulent Registrations for

1 the '286, '344, '347 and '679 Marks.

2 246. Accordingly, an actual case or controversy exists between UFC  
3 and the Counterdefendant regarding whether the Fraudulent Registrations should  
4 be cancelled due to fraudulent Counterdefendant's fraudulent conduct.

5 247. UFC respectfully submits that this Court declare the Fraudulent  
6 Cancellations void due to Counterdefendant's fraudulent conduct.

7 **JURY DEMAND**

8 Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, UFC  
9 requests a jury trial of all issues that may be tried to a jury in this action.

10 **PRAYER FOR RELIEF**

11 WHEREFORE, UFC on its Defenses, Affirmative Defenses and  
12 Counterclaims, UFC prays for relief as follows:

13 A. Entry of an order requiring that Counterdefendant and its officers,  
14 agents, servants, employees, owners and representatives, and all other persons,  
15 firms or corporations in active concert or participation with them, be enjoined and  
16 restrained from using the Infringing Marks or any derivation thereof that includes  
17 any marks that are confusingly similar to any of UFC's UFC® Marks, in  
18 connection with any goods or services, in any manner, including but not limited to  
19 health club facilities and fitness instruction services;

20 B. For an Order compelling Counterdefendant to discontinue use of the  
21 "UFC Ultimate Fitness Center, LLC" entity name, and/or to cease all uses of the  
22 "UFC" term and any similar variations thereof, including in the use of  
23 Counterdefendant's business name;

24 C. That Counterdefendant take nothing by way of Counterdefendant's  
25 Complaint and that all claims against UFC are dismissed with prejudice;

26 D. A declaration that the registrations for the Fraudulent Registrations be  
27 cancelled due to fraud;

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1 E. For injunctive relief for UFC's unfair competition under California  
2 Business and Professions Code § 17200 *et seq.* and/or the California Common  
3 Law;

4 F. For injunctive relief for UFC's dilution claim under California  
5 Business and Professions Code § 14247 pursuant to Code § 14250.

6 G. For three times Counterdefendant's profits resulting from its violation  
7 of California Business and Professions Code § 14247 and treble damages pursuant  
8 to Code § 14250.

9 H. For an award of Counterdefendant's profits stemming from its  
10 unlawful conduct in an amount to be ascertained at trial;

11 I. For an award of corrective advertising in an amount to be ascertained  
12 at trial;

13 J. For treble damages pursuant to the Lanham Act;

14 K. For prejudgment interest;

15 L. For an award of damages caused by Counterdefendant's unlawful  
16 conduct in an amount to be ascertained at trial;

17 M. For punitive damages for Counterdefendant's unfair competition  
18 under California common law;

19 N. For attorney's fees awarded to UFC;

20 O. For costs of suit and counterclaims incurred by UFC herein; and

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P. For such other and further relief as this Court may deem just and proper.

Dated: March 10, 2015 Respectfully submitted,

CALDARELLI HEJMANOWSKI PAGE & LEER LLP

By: /s Ben West

BEN WEST  
CA Bar No. 251018  
GORDON SILVER  
MICHAEL N. FEDER  
NV Bar No. 7332 (*pro hac vice* application forthcoming)  
JOHN L. KRIEGER  
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*Attorneys for Defendant/Counterclaimant  
Zuffa, LLC*

<b>UNITED STATES DISTRICT COURT SOUTHERN DISTRICT OF CALIFORNIA</b>		<b>COURT USE ONLY</b>
TITLE OF CASE (ABBREVIATED) UFC Ultimate Fitness Center, LLC v. Zuffa, LLC		
ATTORNEY OR PARTY WITHOUT ATTORNEY (NAME AND ADDRESS): Ben West (SBN 251018)  Tel.: (858) 720-8080 Caldarelli Hejmanowski Page & Leer LLP Fax: (858) 720-6680 12340 El Camino Real, Suite 430 San Diego, CA 92130		
ATTORNEYS FOR: Defendant Zuffa, LLC	HEARING DATE – TIME	CASE NUMBER: 14-cv-2870-DMS (JMA)

### PROOF OF SERVICE

At the time of service I was over 18 years of age and not a party to this action. My business address is Caldarelli Hejmanowski Page & Leer LLP, 12340 El Camino Real, Suite 430, San Diego, California 92130.

On March 10, 2015, I caused the following documents to be served:

#### ANSWER AND COUNTERCLAIM TO PLAINTIFF'S COMPLAINT

- By Electronic Filing:** I am familiar with the United States District Court, Southern District of California's practice for collecting and processing electronic filings. Under that practice, documents are electronically filed with the court. The court's CM/ECF system will generate a Notice of Electronic Filing (NEF) to the filing party, the assigned judge, and any registered users in the case. The NEF will constitute service of the document. Registration as a CM/ECF user constitutes consent to electronic service through the court's transmission facilities. Under said practice, the CM/ECF users were served.

I declare under penalty of perjury under the laws of the State of California that the above is true and correct. Executed on March 10, 2015, at San Diego, California.

*/s Ben West*

\_\_\_\_\_  
Ben West



has been duly served by depositing such copy with the U.S. Postal Service, in an envelope addressed to:

Michael N. Feder  
Gordon Silver  
3960 Howard Hughes Pkwy.  
Ninth Floor  
Las Vegas, NV 89169

Dated: 2 May 2015

/s/ Matthew J. Faust

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Matthew J. Faust