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

Proceeding	91221888
Party	Defendant Mad Maverick, LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SALUS Haus Dr. med. Otto Greither Nachf. GmbH & Co. KG Opposer, v. Mad Maverick, LLC Applicant	Opposition Nos.: 91221888 91221418 (Parent) 91222545 Serial No. 86/368,933
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**APPLICANT’S AMENDED ANSWER TO NOTICE OF OPPOSITION AND
COUNTERCLAIMS**

Applicant, Mad Maverick, LLC (hereinafter “Mad Maverick” or “Applicant”), through its undersigned counsel, hereby submits its Answer, Affirmative Defenses, and Counterclaims to the Notice of Opposition filed on May 12, 2015 by Salus Haus Dr. med Otto Greither Nachf. GmbH & Co. KG (hereinafter “Salus Haus” or “Opposer”), for the registration of SALUS, Serial No. 86/368,933 filed August 18, 2014.

1. Applicant does not have information that would allow it to respond to this allegation and therefore denies it on that basis.
2. Applicant does not have information that would allow it to respond to this allegation and therefore denies it on that basis.
3. Applicant does not have information that would allow it to respond to this allegation and therefore denies it on that basis.
4. Applicant admits that Opposer is listed as the owner of the listed registration number which corresponds to the listed mark and goods but denies that the

registration is valid, subsisting, in full force and effect and incontestable for all goods as asserted by Opposer. Applicant further denies that Salus Haus's registration is attached as Exhibit A.

5. Applicant does not have information that would allow it to respond to this allegation and therefore denies it on that basis.

6. Applicant does not have information that would allow it to respond to this allegation and therefore denies it on that basis.

7. Applicant admits the listed mark corresponds to the listed application number filed by Opposer for the listed goods and services. Applicant does not have information that would allow it to respond to all the other allegations in this paragraph and therefore denies them on that basis.

8. Applicant does not have information that would allow it to respond to this allegation and therefore denies it on that basis.

9. Admitted.

10. Admitted to the extent that the filing date and first use date are the dates listed in Applicant's 86/368,933 Application. Applicant does not have information that would allow it to respond to all the other allegations in this paragraph and therefore denies them on that basis.

11. Admitted to the extent that the Opposer's SALUS mark and Applicant's SALUS mark are the same word. Denied to the extent that the allegations impute any legal conclusions to the likelihood of confusion determination.

12. Admitted with respect to Opposer's 1,740,638 Registration listing a first use date that is earlier than the listed first use in Applicant's 86/368,933 application. Denied as to all other facts and legal conclusions.

13. Denied.

14. Denied to the extent that all goods listed in Applicant's 86/368,933 application are similar to all goods listed in Opposer's 79/115,624 application. Admitted to the extent that one or more of the goods listed in Applicant's 86/368,933 application are the same goods listed in Opposer's 79/115,624 application. Denied in all other respects not specifically admitted.

15. Denied.

16. Admitted to the extent that Opposer has not given Applicant explicit permission to use Opposer's SALUS mark. Denied to the extent permission is needed or required for Applicant to lawfully use its own marks.

17. Denied.

Applicant denies that any harm has come to Opposer and denies that Opposer is entitled to any relief. Applicant specifically denies any statements not specifically admitted herein.

AFFIRMATIVE DEFENSES AND COUNTERCLAIMS

For its affirmative defenses and counterclaims, Applicant sets forth the following:

LACHES

1. Opposer's claims are barred by the doctrine of laches.
2. Opposer had at least constructive knowledge of Applicant's prior U.S. Reg. Nos. 3,362,991 and 3,370,114 for the same mark SALUS, for identical goods as listed in the present application, since at least January, 2008.
3. Despite this knowledge, Opposer failed to notify Applicant that Opposer believed its rights were being violated, despite its obligations to do so.
4. Opposer's unreasonable delay in bringing an action against Applicant or notifying Applicant

of its purported violation of Opposer's rights has materially prejudiced Applicant and bars Opposer's claims under the doctrine of laches.

ESTOPPEL

5. Applicant reasserts and incorporates by reference paragraphs 1-4.
6. Opposer's claims are barred by the doctrine of equitable estoppel.
7. Opposer's silence and inaction regarding Applicant's use of the SALUS mark since 2005 has led Applicant to reasonably infer that Opposer will not assert any alleged rights against Applicant.
8. Applicant has relied upon Opposer's silence and inaction.
9. Due to Applicant's reliance, Applicant will be materially prejudiced if Opposer's delayed assertion of such alleged rights is permitted.

ACQUIESCENCE

10. Applicant reasserts and incorporates by reference paragraphs 1-9.
11. Opposer's claims are barred by the doctrine of acquiescence.
12. On May 6, 2013, during prosecution of Opposer's 79/115,624 application, Opposer actively represented that Opposer's use of the SALUS mark is not likely to be confused with Applicant's use of the SALUS mark.
13. The nearly two-year delay between Opposer's representation that the marks are not likely to be confused and Opposer's assertion that Applicant's SALUS mark is now likely to be confused with Opposer's SALUS mark is not excusable.
14. Applicant reasonably relied upon Applicant's representation and therefore Opposer's delay has caused Applicant undue prejudice.

PRIOR REGISTRATIONS (*MOREHOUSE* DEFENSE)

15. Applicant reasserts and incorporates by reference paragraphs 1-14.
16. Applicant had previously registered the identical mark SALUS for the same goods in U.S. Reg. Nos. 3,370,114 and 3,362,991.
17. No added damage to the Opposer will result from the newly requested SALUS registration.
18. As such, Opposer's claims are barred under the equitable prior registration (*Morehouse*) defense.

PRIORITY

19. Applicant reasserts and incorporates by reference paragraphs 1-18.
20. Since 2005, Applicant has been using the SALUS mark for: Antiperspirants and deodorants for personal use; Aromatic body care products, namely, body lotion, shower gel, cuticle cream, shampoo, conditioner, non-medicated lip balm, soap, body polish, body and foot scrub and non-medicated foot cream; Aromatic oils for the bath; Astringents for cosmetic purposes; Bar soap; Bath and shower gels and salts not for medical purposes; Bath bombs; Bath fizzies; Bath foam; Bath gel; Bath herbs; Bath oils and bath salts; Bath soaps in liquid, solid or gel form; Beauty creams; Beauty soap; Blush; Body and beauty care cosmetics; Body butter; Body cream; Body cream soap; Body glitter; Body lotion; Body lotions; Body milk; Body oil; Body powder; Body sprays; Bubble bath; Colognes, perfumes and cosmetics; Cosmetic massage creams; Cosmetic suntan lotions; Cosmetics and make-up; Cosmetics in general, including perfumes; Cream soaps; Essential oils; Essential oils for aromatherapy use; Essential oils for use in the manufacture of scented products; Face and body beauty creams; Face and body creams; Facial cleansers; Foot scrubs; Foundation; Fragrances and perfumery; Fragrances for personal use; Hair shampoos and conditioners;

Hair sprays and hair gels; Hand scrubs; Lip balm; Lip gloss; Liquid soaps for hands, face and body; Lotions for face and body care; Make-up for the face and body; Massage creams; Massage lotions; Massage oil; Nail polish; Nail polish remover; Non-medicated foot soaks; Oils for perfumes and scents; Perfume oils for the manufacture of cosmetic preparations; Perfumes, aftershaves and colognes; Pumice stones for personal use; Scented body spray; Shaving cream; Shaving soap; Skin and body topical lotions, creams and oils for cosmetic use; Soaps for body care; and Sun block.

21. Opposer has not used the SALUS mark for “Medicines for the treatment of aiding sleep and promoting digestion, sanitary preparations for medical use, dietetic products adapted for medical use, namely, dietetic supplement beverages for aiding sleep and promoting digestion and dietetic foods, namely, dietary food supplements containing vitamins, herbal extracts and/or floral extracts, minerals, iron, yeast, fruits and tonics; medicinal teas, namely, medicinal herbal teas; dietetic products, namely, plant and fruit juices and vegetable juices adapted for medical use; medicinal confectionery, namely, herbal sweets, vitamin tablets, compressed vitamin and mineral tablets for chewing and mineral compressed tablets; medicinal concentrates for baths, medicinal non-alcoholic and alcoholic beverages made with plant extracts and herbs, medicinal liniments, namely, aromatic pine alcohol; medicated bath preparations; therapeutic medicated preparations for the bath, said goods excluding products for treating skin disorders or for use in dermatology,” as listed in Opposer’s 79/115,624 intent-to-use trademark application.
22. Since Applicant has been using the SALUS mark for goods similar to Opposer’s goods listed in the 79/115,624 application since 2005, Applicant has priority over Opposer for these goods.

**RESTRICTION OF SERVICES IN THE ALTERNATIVE
UNDER TRADEMARK ACT § 18**

23. Applicant reasserts and incorporates by reference paragraphs 1-22.
24. Applicant is entitled to registration of the SALUS mark for the identification of goods that were published for opposition.
25. If Applicant is not found to be entitled to registration for the goods included in the publication for opposition, Applicant is at least entitled to registration for the following identification of goods:

Antiperspirants and deodorants for personal use; Aromatic body care products, namely, body lotion, shower gel, cuticle cream, shampoo, conditioner, non-medicated lip balm, soap, body polish, body and foot scrub and non-medicated foot cream; Aromatic oils for the bath; Astringents for cosmetic purposes; Bar soap; Bath and shower gels and salts not for medical purposes; Bath bombs; Bath fizzies; Bath foam; Bath gel; Bath herbs; Bath oils and bath salts; Bath soaps in liquid, solid or gel form; Beauty creams; Beauty soap; Blush; Body and beauty care cosmetics; Body butter; Body cream; Body cream soap; Body glitter; Body lotion; Body lotions; Body milk; Body oil; Body powder; Body sprays; Bubble bath; Colognes, perfumes and cosmetics; Cosmetic massage creams; Cosmetic suntan lotions; Cosmetics and make-up; Cosmetics in general, including perfumes; Cream soaps; Essential oils; Essential oils for aromatherapy use; Essential oils for use in the manufacture of scented products; Face and body beauty creams; Face and body creams; Facial cleansers; Foot scrubs; Foundation; Fragrances and

perfumery; Fragrances for personal use; Hair shampoos and conditioners; Hair sprays and hair gels; Hand scrubs; Lip balm; Lip gloss; Liquid soaps for hands, face and body; Lotions for face and body care; Make-up for the face and body; Massage creams; Massage lotions; Massage oil; Nail polish; Nail polish remover; Non-medicated foot soaks; Oils for perfumes and scents; Perfume oils for the manufacture of cosmetic preparations; Perfumes, aftershaves and colognes; Pumice stones for personal use; Scented body spray; Shaving cream; Shaving soap; Skin and body topical lotions, creams and oils for cosmetic use; Soaps for body care; Sun block, *except for: dietary supplements and dietetic foods and beverages; namely, tonics, plant and herb extracts in liquid form; tea.*

26. If Applicant is not found to be entitled to registration for the goods included in the publication for opposition, Applicant submits that entering the above restriction will avoid a likelihood of confusion and requests the Board dismiss the pending opposition and enter the above restriction to the Applicant's 86/368,933 application under Section 18.

ABSENCE OF LIKELIHOOD OF CONFUSION

27. Applicant reasserts and incorporates by reference paragraphs 1-26.

28. Applicant asserts that there is no likelihood of confusion between Applicant's mark and Opposer's mark because, for example, the goods of Applicant and Opposer are unrelated and marketed through different channels of trade, there are numerous similar marks for use on similar goods, there is no evidence of actual confusion despite the lengthy opportunity for confusion to arise in the marketplace, and Opposer's use of the mark is on a limited variety of goods.

JUDICIAL ESTOPPEL

29. Applicant reasserts and incorporates by reference paragraphs 1-28.
30. During prosecution of U.S. Application Serial No. 79/115,624 for the mark SALUS, the application was initially refused registration under Trademark Action Section 2(d) as likely to be confused with U.S. Reg. Nos. 3,362,991 and 3,370,114. Opposer overcame this rejection by amending the goods and services asserting that the '624 mark was not likely to be confused with the '991 and '114 registrations. Opposer further represented that Opposer's U.S. Reg. Nos. 1,740,638 and 1,568,679 are for marks identical or nearly identical to the '624 mark and cover goods identical to or substantially identical to the goods covered by the '624 mark.
31. Based on these representations, the '624 mark refusal under Trademark Action Section 2(d) based on U.S. Reg. Nos. 3,362,991 and 3,370,114 was removed and the '624 mark proceeded to publication.
32. Opposer obtained a benefit from their prior representations.
33. Opposer is judicially estopped from asserting that the '624 mark and U.S. Reg. Nos. 1,740,638 and 1,568,679 are likely to be confused with Applicant's '933 mark.

COUNTERCLAIM FOR RESTRICTION OF GOODS IN THE 1,740,638

REGISTRATION UNDER TRADEMARK ACT § 18

34. Applicant reasserts and incorporates by reference paragraphs 1-33.
35. Opposer's description of goods in the 1,740,638 registration is overly broad and Applicant requests restriction of the 1,740,638 goods to the following:

dietary supplements and dietetic foods and beverages; namely, tonics,
plant and herb extracts in liquid form; tea; *except for: Antiperspirants and*

deodorants for personal use; Aromatic body care products, namely, body lotion, shower gel, cuticle cream, shampoo, conditioner, non-medicated lip balm, soap, body polish, body and foot scrub and non-medicated foot cream; Aromatic oils for the bath; Astringents for cosmetic purposes; Bar soap; Bath and shower gels and salts not for medical purposes; Bath bombs; Bath fizzies; Bath foam; Bath gel; Bath herbs; Bath oils and bath salts; Bath soaps in liquid, solid or gel form; Beauty creams; Beauty soap; Blush; Body and beauty care cosmetics; Body butter; Body cream; Body cream soap; Body glitter; Body lotion; Body lotions; Body milk; Body oil; Body powder; Body sprays; Bubble bath; Colognes, perfumes and cosmetics; Cosmetic massage creams; Cosmetic suntan lotions; Cosmetics and make-up; Cosmetics in general, including perfumes; Cream soaps; Essential oils; Essential oils for aromatherapy use; Essential oils for use in the manufacture of scented products; Face and body beauty creams; Face and body creams; Facial cleansers; Foot scrubs; Foundation; Fragrances and perfumery; Fragrances for personal use; Hair shampoos and conditioners; Hair sprays and hair gels; Hand scrubs; Lip balm; Lip gloss; Liquid soaps for hands, face and body; Lotions for face and body care; Make-up for the face and body; Massage creams; Massage lotions; Massage oil; Nail polish; Nail polish remover; Non-medicated foot soaks; Oils for perfumes and scents; Perfume oils for the manufacture of cosmetic preparations; Perfumes, aftershaves and colognes; Pumice stones for personal use; Scented body spray; Shaving cream; Shaving soap; Skin and body topical lotions, creams and oils for cosmetic use; Soaps

for body care; Sun block

36. Upon information and belief, and as is evidenced by Opposer's specimen submissions in the 1,740,638 registration, Opposer is only using, and has only ever used, the SALUS mark for herb extracts in liquid form and tea. Upon information and belief, Opposer is not currently using and has never used the SALUS mark in the United States on the goods that are being effectively excluded by the proposed restriction.

37. Excluding the goods listed in Applicant's 86/368,933 application publication from Opposer's Reg. No. 1,740,638 is commercially significant and significantly changes the nature and character of Opposer's goods and the channels of trade associated with Opposer's registered goods such that a likelihood of confusion with Applicant's 86/396,175 Application will be avoided.

38.

WHEREFORE, Applicant respectfully requests that the Amended Notice of Opposition be dismissed with prejudice.

Respectfully submitted this 19th day of February, 2016.

MAD MAVERICK, LLC

/Shane Percival/

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ATTORNEY FOR APPLICANT

Date: February 19, 2016

CERTIFICATE OF SERVICE

I hereby certify that on the 19th day of February, 2016, a true and correct copy of the foregoing Answer to the Notice of Opposition has been served by US First Class Mail postage prepaid to the following address:

Cynthia Lee
Thomas Horstemeyer
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/Shane Percival/
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