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

Proceeding	91238589
Party	Defendant Health Care Fitness Integrations, LLC
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Attachments	Response to Motion to Strike.pdf(60346 bytes)

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

AMERICAN COUNCIL ON EXERCISE,	§	
Opposer,	§	
	§	
v.	§	**OPPOSITION No. 91238589**
	§	
HEALTH CARE FITNESS	§	**Ser. No. 87/064,536**
INTEGRATION, LLC,	§	**MEDICAL EXERCISE TRAINERS**
Applicant/Defendant.	§	
	§	**Pub. for Opp. Date: June 27, 2017**

APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO STRIKE

In line with the standard below, Applicant responds to Opposer's Motion to Strike ("Motion"), and respectfully submits that its defenses provide fair notice and have at least some bearing, as do Exhibits 1-4, upon the issues under litigation, and that this Board should deny the Motion or grant leave to amend the live answer.

I. Standard

The Board may, upon motion or by its own initiative, order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. See Fed. R. Civ. P. 12(f). Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *See*, *e.g.*, Ohio State University v. Ohio University, 51 U.S.P.Q 2d 1289, 1293 (TTAB 1999); and Harsco Corp. v. Electrical Sciences Inc., 9 U.S.P.Q 2d 1570 (TTAB 1988). Inasmuch as the primary purpose of pleadings under the Federal Rules of Civil Procedure is to give fair notice of the claims or defenses asserted, the Board may decline to

strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *See*, *e.g.*, Order of Sons of Italy in America v. Profumi Fratelli Nostra AG, 36 U.S.P.Q.2d 1221, 1223 (TTAB 1995) (amplification of applicant's denial of opposer's claims not stricken). Further, a defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. *See*, generally, Wright & Miller, 5C Fed. Prac. & Proc. Civ.3d § 1381 (2008).

II. Applicant's Paragraph 63 Complies with the Rules – Failure to Use as a Trademark

At paragraph 63 and as required, Applicant provides Opposer with fair notice in support of its defense of "failure to function as a trademark." Specifically, Applicant pleaded:

> Failure to Use as a Trademark – In line with arguments proffered by Opposer, as alleged infringer in Michael Jones v. American Council on Exercise that was resolved by confidential settlement, Opposer has not used ACE MEDICAL EXERCISE SPECIALIST as a trademark but merely as a title for a course and/or certification despite ACE MEDICAL EXERCISE SPECIALIST being the subject of Opposer's pending, use-based, trademark application having serial no. 87/549,195. Exhibit 1, p. 10; Exhibit 2; Exhibit 3, p. 37. Additionally and alternatively, Opposer's one-page specimen in serial no. 87/549,195 shows that Opposer uses ACE® in combination with MEDICAL EXERCISE SPECIALIST to indicate that ACE is the mark and not ACE MEDICAL EXERCISE SPECIALIST. Exhibit 2; Exhibit 3, pp. 37.

Despite Opposer concluding otherwise, Applicant has provided significant details, facts, and supportive evidence to support its defense of Opposer's failure to use ACE MEDICAL EXERCISE SPECIALIST as a trademark even if particularity were required under Fed. R. Civ. P. 9. Instead of addressing the pleaded failure to use ACE MEDICAL EXERCISE SPECIALIST as a trademark defense, Opposer elects to rename this defense, apply non-applicable rules, and feign confusion. Because Applicant has sufficiently pleaded failure to use ACE MEDICAL EXERCISE

SPECIALIST as a trademark defense, which, as legally required, has at least some bearing upon the issues under litigation, *e.g.*, Opposer's ability to rely on its alleged use of ACE MEDICAL EXERCISE SPECIALIST to subordinate or otherwise negate Applicant's rights, and Opposer has fair notice of this defense as the law also requires, then the Board should not strike this defense because it is not redundant, immaterial, impertinent or scandalous.

III. Applicant's Paragraph 64 Complies with the Rules – Non-Ownership

At paragraph 64 and as required, Applicant provides Opposer with fair notice in support of its defense of "non-ownership." Specifically, Applicant pleaded:

> Non-ownership – Opposer does not own trademark rights in MEDICAL EXERCISE SPECIALIST as evidenced by the confidentially settled lawsuit of Michael Jones v. American Council on Exercise, where Jones sued Opposer for trademark infringement for Opposer's use of MEDICAL EXERCISE SPECIALIST beginning around August 2015, wherein MEDICAL EXERCISE SPECIALIST is or was a mark used by Jones for one to two decades' prior. Exhibit 1; Exhibit 3.

Similar to the previous discussion, Applicant has provided significant details, facts, and supportive evidence to support its defense of Opposer's non-ownership of MEDICAL EXERCISE SPECIALIST as a trademark even if particularity were required under Fed. R. Civ. P. 9. Instead of addressing the pleaded non-ownership of MEDICAL EXERCISE SPECIALIST trademark defense, Opposer again renames the defense, applies non-applicable rules, and feigns confusion. As Opposer knows, and seemingly hide behind a confidential settlement, Michael Jones used MEDICAL EXERCISE SPECIALIST as a trademark more than a decade prior to Opposer's alleged use of MEDICAL EXERCISE SPECIALIST as a trademark, which Applicant contests, whereupon Opposer relies on common law rights in MEDICAL EXERCISE SPECIALIST in its claim of alleged likelihood of confusion against Applicant's mark under application. Notice of

Opposition, Dkt. Entry No. 1, paragraphs 8, 26-36. Because Applicant has sufficiently pleaded non-ownership of MEDICAL EXERCISE SPECIALIST as a trademark defense, which has at least some bearing upon the issues under litigation, *e.g.*, Opposer's ability to rely on its alleged common law trademark rights in MEDICAL EXERCISE SPECIALIST, when no rights may exist, to subordinate or otherwise negate Applicant's superior rights, and Opposer has fair notice of this defense as the law requires, then the Board should not strike this defense because it is not redundant, immaterial, impertinent or scandalous.

IV. Applicant's Paragraph 65 Complies with the Rules – Estoppel

At paragraph 65 and as required, Applicant provides Opposer with fair notice in support of its equitable estoppel defense. Specifically, Applicant pleaded:

> Estoppel – In its responses to requests for admissions that were not designated "Confidential" or "Attorney's Eyes Only" in the case of Michael Jones v. American Council on Exercise, Opposer stated that it could not locate any materials in which it used the term "Medical Exercise Specialist" prior to August 2015. Exhibit 4.

Despite Opposer concluding otherwise, Applicant has provided significant details, facts, and supportive evidence to support its equitable estoppel defense of Opposer's failure to use MEDICAL EXERCISE SPECIALIST prior to August 2015 even if particularity were required under Fed. R. Civ. P. 9. Fed. R. Civ. P. 8(b)(1). Applicant acknowledges the Board's discussion of equitable defenses in its order (Dkt. No. 11) and the TBMP § 311.02(b), which states:

> Equitable defenses may not be available against certain grounds for opposition or cancellation or under certain circumstances. For example, the availability of laches and acquiescence is severely limited in opposition and cancellation proceedings. In Board opposition proceedings, these defenses start to run from the time of knowledge of the application for registration (that is, from the time the mark is published for opposition), not from the time of knowledge of use. In Board cancellation proceedings, these defenses start to run from the date of registration,

> in the absence of actual knowledge before the close of the opposition period. Moreover, for public policy reasons, the defenses of laches and acquiescence may not be available against claims such as genericness, descriptiveness, fraud, abandonment and functionality, and further, may not apply in a case of likelihood of confusion if it is determined in the case that confusion is inevitable.

However, the foregoing excerpt's discussion concern about delay in bringing action is not why Applicant pleaded its estoppel defense, which may be considered and is possibly why the law does not exclude equitable defenses in oppositions. 15 U.S.C. § 1069; Fed. R. Civ, P. 8(c). Here, it is clear that Applicant's pleaded estoppel defense prevents a party, such as Opposer, from taking legal action that is inconsistent with that party's previous words, claims, or conduct. Essentially, equitable estoppel prevents a party, such as Opposer, from going back on its word as truth before tribunals is always relevant. In this instance, the pleaded defense clearly provides fair notice that what Opposer said in multiple admissions about its use of the term "Medical Exercise Specialist" in a previous case may be used as a defense in this case about its use of the term "Medical Exercise Specialist." To further support that defense, Applicant provided the name of that case and a copy of Opposer's admissions that were requested in that case. Without any actual or claimed prejudice to Opposer caused by amending the answer, Applicant has refined its pleaded equitable estoppel defense under Fed. R. Civ, P. 8(c) and/or as permitted by the Board's liberally granted leave, including its order's footnote 8, to prevent Opposer from inconsistently claiming that it failed to use the term "Medical Exercise Specialist" prior to August 2015. Because Applicant has sufficiently pleaded the estoppel defense as it relates to Opposer's prior admissions regarding its failure to use the term "Medical Exercise Specialist" prior to August 2015, a defense has at least some bearing upon the issues under litigation, *e.g.*, Opposer's ability to rely on its alleged use of MEDICAL EXERCISE SPECIALIST to subordinate or otherwise negate Applicant's rights, and Opposer has fair notice of this defense as the law requires, then the Board should not strike this defense because it is not redundant, immaterial, impertinent or scandalous.

V. Applicant's Documents are Relevant.

Applicant respectfully submits that the Board should deny Opposer's motion to strike Exhibits 1-4 because, contrary to Opposer's sole reason, Exhibits 1-4 *are* relevant to the pleadings and Defendant's pleaded defenses in that they have at least some bearing upon the issues under litigation as just shown in this response.

CONCLUSION

Based on the foregoing, Applicant respectfully requests that the Board deny Opposer Motion to Strike in its entirety, or for any portion(s) that the Board is want to grant, then to grant leave to Applicant to amend such portion(s), whereby there is no prejudice resulting therefrom, or, if factual issues remain, then the defense(s) should be determined on the merits. Staton v. N. State Acceptance, LLC, No. 1:13-CV-277, 2013 WL 3910153, at *2 (M.D.N.C. July 29, 2013) (citing Moore v. Prudential Ins. Co. of Am., 166 F. Supp. 215, 217 (M.D.N.C. 1958)) (courts generally require the party moving to strike a defense to make a showing that he or she would be prejudiced if the defense is not stricken.); *See*, *e.g.*, Order of Sons of Italy in America v. Profumi Fratelli Nostra AG, 36 U.S.P.Q.2d 1221, 1223 (TTAB 1995); *See*, generally, Wright & Miller, 5C Fed. Prac. & Proc. Civ.3d § 1381 (2008).

Respectfully submitted,

Dated: October 2, 2018

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CERTIFICATE OF TRANSMISSION

This is to certify that a true and correct copy of the foregoing **APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO STRIKE** was transmitted, via ESTTA, to the Trademark Trial and Appeal Board, on the date of signing below:

Dated: October 2, 2018

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO STRIKE** was served via email on Opposer at:

Mark Reichenthal: markr@branfman.com

Dated: October 2, 2018

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