UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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January 31, 2019

Opposition No. 91238589

American Council on Exercise

v.

Health Care Fitness Integrations, LLC

Katie W. McKnight,
Interlocutory Attorney:

On July 26, 2018, the Board granted Opposer's motion to strike paragraph five of Applicant's answer and Applicant's affirmative defenses of failure to state a claim, lack of standing, fraud, estoppel, acquiescence, waiver, laches and unclean hands, but granted Applicant leave to amend its answer.[1] Applicant timely served its amended answer on August 23, 2018.[2]

Now before the Board is Opposer's motion (filed September 12, 2018) to strike certain affirmative defenses and exhibits in Applicant's amended answer. Opposer's motion is fully briefed.[3]

[1] 11 TTABVUE.

[2] 12 TTABVUE.

[3] The Board gives no consideration to Applicant's surreply brief (filed October 23, 2018). Trademark Rule 2.127(a).

By way of its motion, Opposer seeks to strike Exhibits 1-4 to Applicant's amended answer in addition to the following affirmative defenses:

(63) 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. 87/459,195 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.

(64) 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.

(65) 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.

Opposer argues, *inter alia*, that Applicant's affirmative defenses set forth in paragraphs 63 through 65 effectively re-argue Applicant's bald pleading of estoppel set forth in its original answer, which was stricken by the Board's July 26, 2018 order.[4] In response, Applicant contends that it has provided significant details, facts

[4] 11 TTABVUE 6-8.

and evidence to support the subject affirmative defenses in its amended answer, thereby giving Opposer fair notice of its defenses.[5]

Pursuant to Fed. R. Civ. P. 12(f), the Board may strike from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. *See also* Trademark Rule 2.116 and TBMP § 506.01 (2018). However, motions to strike are not favored, and matter will not be stricken unless such matter clearly has no bearing upon the issues in the case. *See Harsco Corp. v. Elec. Sciences, Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988); *Leon Shaffer Golnick Advert., Inc. v. William G. Pendill Mktg. Co., Inc.*, 177 USPQ 401, 402 (TTAB 1973); Charles A. Wright, Arthur R. Miller et al., 5C Federal Practice and Procedure: Civil 2d § 1380 (Apr. 2018) (hereinafter "Wright & Miller"); TBMP § 506.01.

The primary purpose of the pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. *See McDonnell Douglas Corp. v. Nat'l Data Corp.*, 228 USPQ 45, 47 (TTAB 1985); TBMP § 309.03(a)(2). Thus, the Board, in its discretion, 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. Applicant's affirmative defenses set forth in paragraphs 63 through 65 of its amended answer are not actual affirmative defenses, but amplifications of Applicant's denials, and provide fuller notice of how Applicant intends to defend this opposition. *See Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999). In particular, the allegations which Opposer seeks to have

[5] 14 TTABVUE 3-4.

stricken bear directly on Opposer's alleged rights in its ACE MEDICAL EXERCISE SPECIALIST and MEDICAL EXERCISE SPECIALIST marks which Opposer asserts in support of its likelihood of confusion claim.

With regard to Exhibits 1-4 attached to Applicant's amended answer, Applicant is advised that an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached, and will not be considered by the Board unless properly submitted at trial or on motion for summary judgment. Trademark Rule 2.122(c).

In view of the foregoing, Opposer's motion to strike is **denied**.

Schedule

Proceedings are **resumed**. Discovery, disclosure and trial dates are reset as follows:

Deadline for Discovery Conference	**February 25, 2019**
Discovery Opens	**February 25, 2019**
Initial Disclosures Due	**March 27, 2019**
Expert Disclosures Due	**July 25, 2019**
Discovery Closes	**August 24, 2019**
Plaintiff's Pretrial Disclosures Due	**October 8, 2019**
Plaintiff's 30-day Trial Period Ends	**November 22, 2019**
Defendant's Pretrial Disclosures Due	**December 7, 2019**
Defendant's 30-day Trial Period Ends	**January 21, 2020**
Plaintiff's Rebuttal Disclosures Due	**February 5, 2020**
Plaintiff's 15-day Rebuttal Period Ends	**March 6, 2020**
BRIEFS ARE DUE AS FOLLOWS:	
Plaintiff's Main Brief Due	**May 5, 2020**
Defendant's Main Brief Due	**June 4, 2020**
Plaintiff's Reply Brief Due	**June 19, 2020**

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony

periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).