

ESTTA Tracking number: **ESTTA1114766**

Filing date: **02/16/2021**

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

Proceeding	91250143
Party	Plaintiff Theragun, LLC
Correspondence Address	ROD S BERMAN JEFFER MANGELS BUTLER & MITCHELL LLP 1900 AVENUE OF THE STARS 7TH FLOOR LOS ANGELES, CA 90067 UNITED STATES Primary Email: trademarkdocket@jmbm.com 310-203-8080
Submission	Opposition/Response to Motion
Filer's Name	Jessica Bromall Sparkman
Filer's email	jzb@jmbm.com, kp2@jmbm.com
Signature	/s/ Jessica Bromall Sparkman
Date	02/16/2021
Attachments	Opp to Motion to Strike_ Theragun v. Theragen.pdf(678626 bytes )

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

\_\_\_\_\_  
THERAGUN, LLC,  
  
                  Opposer,  
  
          v.  
  
THERAGEN, INC.,  
  
                  Applicant.

Opposition No. 91/250,143  
  
Appl. Serial Nos.: 88/369,252; 88/369,266  
  
Mark: THERAGEN  
  
Published for Opposition: July 3, 2019  
  
Atty. Ref. No.: 76840-9019

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**THERAGUN’S OPPOSITION TO THERAGEN’S MOTION TO STRIKE**

**I.     INTRODUCTION**

Opposer Theragun, Inc. (“Opposer” or “Theragun”), through its undersigned counsel, hereby submits its opposition to the Motion to Strike Theragun’s rebuttal evidence filed by applicant Theragen, Inc. (“Theragen” or “Applicant”). First, the challenged witnesses, as well as the topics of their testimony, were properly disclosed in Theragun’s Rebuttal Disclosures, a copy of which is attached hereto as Exhibit A. And, even if the disclosure were inadequate (and it was not), Theragen’s objection on that ground was waived by its failure to raise the objection until the filing of its brief. Second, the challenged evidence was submitted specifically in response to and for the purposes of rebutting evidence submitted by Theragen. Theragun’s Motion to Strike should be denied.

**II.    RELEVANT FACTS**

Theragun did not originally intend to submit witness testimony. However, upon receipt of Theragen’s evidence, it became apparent that Theragun should submit witness testimony in rebuttal. The evidence submitted by Theragen suggested that Theragen’s strategy at trial would

include: (1) reliance on testimony about the limitations and specific nature of its intended goods, none of which limitations and specifications appear in Theragen’s applications, to support an argument that the parties’ goods were unrelated; and (2) reliance on third-party registrations, absent evidence of third-party use, to support an argument that THERAGUN is weak mark.<sup>1</sup>

Prior to Theragen’s submission of its evidence, Theragun did not predict that Theragen would rely on evidence of the type submitted, nor could it have been expected to; the positions taken by Theragen are contrary to well-settled law.<sup>2</sup> Theragun determined that it should submit declarations to rebut this unexpected evidence. Theragun then served Pretrial Disclosures identifying Dr. Jason Wersland and Kevin Tsao, and describing their anticipated testimony.<sup>3</sup> Thereafter, Theragun filed and served the Rebuttal Declaration of Dr. Jason Wersland (“Wersland Decl.”) and the Confidential Rebuttal Declaration of Kevin Tsao (“Tsao Decl.”) on November 2, 2020.<sup>4</sup>

Dr. Wersland’s testimony is specifically directed to contradicting Mr. McAuliffe’s testimony, including his suggestion that the applied-for goods are available only by prescription and only through prescribing physicians.<sup>5</sup> Mr. Tsao’s declaration is specifically directed to Theragen’s evidence and arguments regarding what consumers are exposed to in the marketplace.<sup>6</sup> Theragen did not seek to cross-examine these witnesses as it was entitled to pursuant to 37 C.F.R.

---

<sup>1</sup> Applicant’s Notice of Reliance filed on September 16, 2020 (“Applicant’s NOR”), Exhs. 1-66 (11 TTABVUE 20-210); Declaration of J. Chris McAuliffe filed on September 16, 2020 (“McAuliffe Decl.”) (12 TTABVUE).

<sup>2</sup> See, e.g., *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 73 U.S.P.Q.2d 1689, 1693, 396 F.3d 1369 (Fed. Cir. 2005) (well-settled that “[t]he probative value of third-party trademarks depends entirely upon their usage”); *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 16 U.S.P.Q.2d 1783, 1787, 918 F.2d 937 (Fed. Cir. 1990) (“authority is legion” that an opposition “must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed”). See also Theragun’s Reply Brief, Sections II.A.1 and II.B, and particular n. 2, 11 (23 TTABVUE 8-10, 13-14).

<sup>3</sup> See Exhibit A hereto.

<sup>4</sup> 14 TTABVUE; 15 TTABVUE; 16 TTABVUE.

<sup>5</sup> Wersland Decl., ¶ 8-12 (14 TTABVUE 3-4).

<sup>6</sup> Tsao Decl. (16 TTABVUE).

2.123(c).<sup>7</sup> Theragen, in fact, took no action in response to the Wersland and Tsao declarations for nearly three months, until the filing of its main brief on January 29, 2021.

### **III. MOTION TO STRIKE SHOULD BE DENIED**

#### **A. Theragen Waived Any Objection for Lack of Disclosure by its Delay**

Objections that “testimony has been presented by affidavit or declaration, but was not covered by an earlier pretrial disclosure, the remedy for any adverse party is the *prompt* filing of a motion to strike. . . . Failure to assert an objection in a timely manner may result in the objection being waived.” Trademark Board Manual of Procedure (“TBMP”) § 707.03(b)(3) (emphasis added).

Here, Theragen did not file a *prompt* motion to strike. Instead, it waited for months before asserting any objection, raising an objection only at the time of filing its main brief.<sup>8</sup> Notably, in *Undeclared, Inc. v. Williams*, on which Theragen relies, unlike here the challenged witnesses were not identified in rebuttal disclosures and the objection was raised less than two weeks after the challenged declarations were submitted. Opp. No. 92058609, 13-14 (T.T.A.B. March 27, 2020). In contrast, here, the witnesses were properly disclosed in Theragen’s Pretrial Disclosures and no objection was raised for months. Theragen’s failure to raise an objection before the filing of its main brief waives the objection. *See WeaponX Performance Products Ltd. v. Weapon X Motorsports, Inc.*, 126 U.S.P.Q.2d 1034, 1037 (T.T.A.B. 2018) (denying objection to testimony declarations raised in trial brief where objector had notice via disclosures about witnesses and the subject matter of their anticipated testimony, the testimony declarations were timely served, and objector had opportunity to cross-examine the witnesses and chose not to).

---

<sup>7</sup> 37 C.F.R. § 2.123(c) (“When a party elects to take oral cross-examination of an affiant or declarant, the notice of such election must be served on the adverse party and a copy filed with the Board within 20 days from the date of service of the affidavit or declaration and completed within 30 days from the date of service of the notice of election. . . . When such election has been made but cannot be completed within that testimony period, the Board, after the close of that testimony period, shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the oral cross-examination(s).”).

<sup>8</sup> 19 TTABVUE; 20 TTABVUE.

Theragen does not claim that it has been in any way prejudiced by the submission of the challenged declarations. Theragen conducted no written discovery. It took no discovery depositions. It did not seek to cross-examine Dr. Wersland or Mr. Tsao, although it had the opportunity to do so. Theragen has not sought to present evidence to counter Theragen's rebuttal declarations. Theragen does not claim that it would have pursued or prepared its case differently had the witnesses been disclosed prior to Theragen's rebuttal disclosures.

Here, the witnesses were properly disclosed in Rebuttal Disclosures. They were not disclosed previously because the necessity of the testimony did not become apparent until receipt of the unexpected evidence introduced by Theragen, and any failure to disclose or delay in disclosure was harmless and did not result in prejudice to Theragen. The motion to strike for lack of disclosure should be denied.

**B. Wersland and Tsao Declarations Are Proper Rebuttal Evidence**

Proper rebuttal evidence is evidence that responds to the adversary's evidence, *e.g.*, "to explain, repel, counteract, or disprove the evidence of the adverse party." *Belden Inc. v. Berk-Tek LLC*, 116 U.S.P.Q.2d 1869, 1883, 805 F.3d 1064 (Fed. Cir. 2015) (quoting Victor Gold, 28 Fed. Prac. & Proc. Evid. § 6164 (2d ed. 2015)). Both the Wersland and Tsao Declarations respond to evidence presented by Theragen.

As noted above, Theragen introduced evidence during its testimony period describing the limitations and specific nature of its intended goods, none of which limitations and specifications appear in Theragen's applications.<sup>9</sup> Mr. McAuliffe suggested, *inter alia*, that Theragen's electrostimulatory devices would only be available by prescription and that its target consumers were limited to doctors, physical therapists, and licensed medical professionals.<sup>10</sup> Mr. McAuliffe

---

<sup>9</sup> See generally McAuliffe Decl. (12 TTABVUE) and in particular, McAuliffe Decl., ¶¶ 8-17 (12 TTABVUE 3-5).

<sup>10</sup> *Id.*, ¶ 15-17 (12 TTABVUE 4).

then sought to differentiate its products from Theragun products by noting that Theragun products are available over the counter.<sup>11</sup>

In fact, however, as Dr. Wersland testified, notwithstanding Mr. McAuliffe's information about Theragen's particular goods, electrostimulatory devices are available without a prescription and, like Theragun's massage devices, can be sold over the counter through normal channels of trade and used by doctors, physical therapists, and trainers, as well as by individuals.<sup>12</sup> Further, in direct response to Mr. McAuliffe's testimony regarding the limitations of Theragen's goods and the consumers for the same, Dr. Wersland testified, that both parties' goods are generally used for the same purposes, by the same consumers, and that often both goods are employed as part of a single treatment or therapy plan.<sup>13</sup> Dr. Wersland's testimony responded directly to assertions made by Mr. McAuliffe in his declaration and is proper rebuttal evidence.

Similarly, the Tsao Decl. responds directly to evidence submitted with Theragen's Notice of Reliance.<sup>14</sup> As anticipated, Theragen argued (contrary to settled law), that third-party applications and registrations submitted under its notice of reliance were evidence of what consumers had been exposed to in the marketplace.<sup>15</sup> The Tsao Decl. responds directly to this evidence by providing evidence of what consumers are *actually* exposed to in the market – namely, extensive advertising and marketing of THERAGUN-branded products.<sup>16</sup>

Both the Tsao and Wersland Declarations are proper rebuttal evidence and the motion to strike them as improper rebuttal disclosure should be denied.

---

<sup>11</sup> *Id.*, ¶ 18 (12 TTABVUE 5).

<sup>12</sup> Wersland Decl., ¶¶ 9-11 (14 TTABVUE 4).

<sup>13</sup> *Id.* at ¶¶ 9-12 (14 TTABVUE 4).

<sup>14</sup> Applicant's NOR, Exhs. 1-66 (11 TTABVUE 20-210).

<sup>15</sup> Applicant's Brief, p. 7, 15 (TTABVUE 12, 20).

<sup>16</sup> Tsao Decl., ¶¶ 2-7 (16 TTABVUE 2-3).

**IV. CONCLUSION**

Dr. Wersland and Mr. Tsao were properly disclosed in Theragun's Rebuttal Disclosures and their testimony responds directly to evidence submitted by Theragen. Theragen does not claim to have been prejudiced by the submission of this evidence. The Motion to Strike should be denied.

Respectfully submitted,

Dated: February 16, 2021

/s/ Jessica Bromall Sparkman  
Rod S. Berman, Esq.  
Jessica Bromall Sparkman, Esq.  
Attorney for Opposer Theragun, Inc.  
Jeffer Mangels Butler & Mitchell LLP  
1900 Avenue of the Stars, Seventh Floor  
Los Angeles, CA 90067-5010  
Telephone: (310) 203-8080  
Fax: (310) 203-0567  
**E-mail: trademarkdocket@jmbm.com**

# **EXHIBIT A**

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

\_\_\_\_\_  
THERAGUN, LLC,  
  
                    Opposer,  
  
          v.  
  
THERAGEN, INC.,  
  
                    Applicant.

Opposition No. 91/250,143  
  
Appl. Serial Nos.: 88/369,252; 88/369,266  
  
Mark: THERAGEN  
  
Published for Opposition: July 3, 2019  
  
Atty. Ref. No.: 76840-9019

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**OPPOSER'S REBUTTAL DISCLOSURES**

Opposer Theragun, LLC ("Opposer"), by and through its undersigned counsel, hereby sets forth its rebuttal disclosures ("Disclosures") pursuant to Federal Rule of Civil Procedure 26(a) and 37 C.F.R. § 2.121. These Disclosures are based on information currently available to Opposer and its counsel.

Opposer may submit testimony from Dr. Jason Wersland and Kevin Tsao during its rebuttal period.

Dr. Wersland, Founder and Chief Wellness Officer at Opposer, may be contacted through Opposer's counsel. He may provide testimony regarding the nature of the parties' goods and how the parties' goods are related. Documents relating to the nature of the parties' goods and the relationship between the same may be introduced during Dr. Wersland's testimony.

Mr. Tsao, Sr. Vice-President of Digital at Opposer, may be contacted through Opposer's counsel. He may provide testimony regarding the advertising and promotion of Opposer's Marks and the goods sold thereunder, as well as Opposer's sales of such goods. Documents evidencing

such advertising and promotion, including, without limitation, representative advertisements and other promotional material, documents evidencing the volume and amount of sales, and documents evidencing the advertising expenditures may be introduced during Mr. Tsao's testimony.

Opposer reserves the right to rely on witnesses, documents, and other information that may come to its or its counsel's attention through further discovery and trial preparation. Opposer also reserves the right to modify or supplement these disclosures as discovery proceeds.

Respectfully submitted,

Dated: October 6, 2020

/s/ Jessica Bromall Sparkman  
Rod S. Berman, Esq.  
Jessica Bromall Sparkman, Esq.  
Remi Salter, Esq.  
JEFFER MANGLES BUTLER & MITCHELL LLP  
1900 Avenue of the Stars, Seventh Floor  
Los Angeles, CA 90067  
Telephone: (310) 203-8080  
Facsimile: (30) 203-0567  
E-mail: trademarkdocket@jmbm.com  
Attorneys for Opposer Theragun, LLC

**CERTIFICATE OF SERVICE**

I hereby certify that on October 6, 2020 a true and correct copy of the foregoing **OPPOSER'S REBUTTALS DISCLOSURES** is being served, via email, addressed to Applicant's attorney of record as follows:

Lynn E. Rzonca  
Ballard Spahr LLP  
1735 Market Street, 51<sup>st</sup> Floor  
Philadelphia, PA 19103-7599  
Email: tmdocketing@ballardspahr.com, rzoncal@ballardspahr.com

/s/ Kerene Palmer \_\_\_\_\_  
Kerene Palmer

**CERTIFICATE OF SERVICE**

It is hereby certified that on **February 16, 2021**, a copy of the foregoing THERAGUN'S OPPOSITION TO THERAGEN'S MOTION TO STRIKE has been sent via email to Applicant's counsel of record as follows:

Lynn E. Rzonca  
BALLARD SPAHR LLP  
1735 Market Street 51<sup>st</sup> Floor  
Philadelphia, PA 19103-7599  
Email: [tmdocketing@ballardspahr.com](mailto:tmdocketing@ballardspahr.com); [rzoncal@ballardspahr.com](mailto:rzoncal@ballardspahr.com)

/s/ Kerene Palmer  
Kerene Palmer