ESTTA Tracking number: **ESTTA1375219**
Filing date: **08/05/2024**

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

Proceeding no.	91276058
Party	Defendant CPR, LLC
Correspondence address	JOSEPH F. SOUTHRON FOUR RIVERS LAW FIRM 400 N. ASHLEY DRIVE, SUITE 1720 TAMPA, FL 33602 UNITED STATES Primary email: joe@fourriverslaw.com Secondary email(s): eservice@fourriverslaw.com 813-773-5105
Submission	Brief on Merits for Defendant
Filer's name	Joseph F. Southron
Filer's email	joe@fourriverslaw.com, eservice@fourriverslaw.com
Signature	/Joseph F. Southron/
Date	08/05/2024
Attachments	Applicant CPR LLC Brief.pdf(252818 bytes)

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

In the matter of Application Serial No. 97/016,512
Published: March 08, 2022

CPR Certification, LLC, Proceeding No. 91276058

Opposer,

v.

CPR, LLC,

Applicant.

_____/

APPLICANT CPR, LLC'S BRIEF

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CPR, LLC ("Applicant"), by and through the undersigned counsel of record, and pursuant to 37 CFR § 2.128, hereby submits this Brief and respectfully requests that the Trademark Trial and Appeal Board dismiss Opposer, CPR Certification, LLC's ("Opposer") Opposition with prejudice, and in support thereof states as follows:

DESCRIPTION OF THE RECORD

Pursuant to 37 CFR § 2.128(b), Applicant identifies the evidence of record in this opposition proceeding, which consists of the following:

1. Applicant's Application No. 97016512;
2. Opposer's Notice of Opposition, hereinafter the "Opposition" (1 TTABVUE);
3. Applicant's Answer (14 TTABVUE);
4. Opposer's Notices of Reliance (19 TTABVUE; 20 TTABVUE), which include:
    a. The Deposition of CPR, LLC's Federal Rule of Civil Procedure 30(b)(6) designee, Mr. Douglas Joos, hereinafter "Applicant's Corp. Rep. Depo." (19 TTABVUE 18-155);
    b. The Deposition of Mr. Douglas Joos, hereinafter "Depo. of Mr. Joos" (19 TTABVUE 156-190);
    c. Applicant's discovery responses (19 TTABVUE 191-258);
    d. TSDR status page and file history printouts for Applicant's and Opposer's marks (19 TTABVUE 259-347, 20 TTABVUE 123-154);
    e. Printouts of filings from the State of Florida Department of State Division of Corporations website related to Applicant and Opposer (19 TTABVUE 348-358, 417-419);
    f. USPTO publication (19 TTABVUE 359-416);
    g. Printouts of websites bearing Applicant's Mark (19 TTABVUE 420-581, 20 TTABVUE 17-95); and
    h. Census data (20 TTABVUE 95-122).
5. Opposer's Testimonial Declaration of Mr. Sami Halabi, as Corporate Representative of CPR Certification, LLC, hereinafter "Opposer's Corp. Rep. Decl." (21 TTABVUE);

6. Opposer's Testimonial Declaration of Ms. Laura Ahammer (22 TTABVUE);

7. Opposer's Testimonial Declaration of Mr. Sami Halabi, hereinafter "Decl. of Mr. Halabi" (23 TTABVUE);

8. Applicant's Notices of Reliance (25 TTABVUE; 32 TTABVUE), which include:

    a. The Deposition of Mr. Sami Halabi, hereinafter "Depo. of Mr. Halabi" (32 TTABVUE 7-70;

    b. The Deposition of CPR Certification LLC's Federal Rule of Civil Procedure 30(b)(6) designee, Mr. Sami Halabi, hereinafter "Opposer's Corp. Rep. Depo." (32 TTABVUE 71-108);

    c. Counter-designations of the Deposition of CPR, LLC's Federal Rule of Civil Procedure 30(b)(6) designee, Mr. Douglas Joos (32 TTABVUE 109-128);

    d. Counter-designations of the Deposition of Mr. Douglas Joos (32 TTABVUE 129-137);

    e. Opposer's discovery responses (25 TTABVUE 12-43);

    f. TSDR status page and file history printouts for Applicant's and Opposer's marks (25 TTABVUE 44-223);

    g. Printouts of filings from the State of Florida Department of State Division of Corporations website related to Applicant and Opposer (25 TTABVUE 224-254); and

    h. Printouts of websites bearing Applicant's Mark and Opposer's Mark (25 TTABVUE 255-266).

9. Applicant's Testimonial Declaration of Mr. Douglas K. Joos as Corporate Representative of CPR, LLC, hereinafter "Applicant's Corp. Rep. Decl." (26 TTABVUE 1-21);

10. Applicant's Testimonial Declaration of Mr. Douglas K. Joos, hereinafter "Decl. of Mr. Joos" (26 TTABVUE 22-46);

11. Applicant's Testimonial Declaration of Mr. Richard Bussey, hereinafter "Decl. of Mr. Bussey" (26 TTABVUE 47-49);

12. Opposer's Rebuttal Notice of Reliance (30 TTABVUE); and

13. Opposer's Main Brief, hereinafter "Opposer's Brief" (33 TTABVUE).

STATEMENT OF THE ISSUE

The sole issue that remains after the Trademark Trial and Appeal Board (the "TTAB" or "Board") ruled on Applicant's Motion to Dismiss is whether Applicant owns nationwide exclusive rights in Applicant's Mark. 1 TTABVUE 15. The TTAB construed Opposer's claim as "one that Applicant cannot lawfully use the applied-for mark and is not entitled to unrestricted registration, rather than lack of ownership." 11 TTABVUE 12. The Opposer requests the TTAB to make a preposterous ruling, namely, that Applicant has no rights whatsoever under the Lanham Act and should be entirely barred from federal trademark protection. For reasons stated herein, the TTAB should decline this invitation.

RECITATION OF FACTS

Given the narrow scope of the sole issue before the Board, Applicant submits a brief recitation of those facts relevant to the issue of this Opposition. Douglas K. Joos, Jr. is the sole officer, director, manager, and executive of Applicant. 26 TTABVUE 2. Sami Halabi is the Founder, Chief Executive Officer, and Authorized Member of Opposer, CPR Certification, LLC ("Opposer"). 23 TTABVUE 2. Both companies are involved in the CPR training industry. *See, e.g.,* Opposer's Corp. Rep. Decl. ¶ 3, 21 TTABVUE 3; Applicant's Corp. Rep. Decl. ¶ 2, 26 TTABVUE 2. Mr. Joos and Mr. Halabi are former business partners who, prior to the formation of their respective companies, operated Fit Industries, LLC ("Fit" or the "Company") as Members and equal partners. 26 TTABVUE 3. Fit, also involved in the CPR training industry, was formed in 2017 after Mr. Joos and Mr. Halabi had been working together for two years. *See generally*, Decl. of Mr. Halabi, 23 TTABVUE 3-4; Decl. of Mr. Joos, 26 TTABVUE 22-24. From late 2015, Fit operated under the below logo ("Fit's Logo" or "Applicant's Mark"):

Decl. of Mr. Halabi, 23 TTABVUE 4; Decl. of Mr. Joos, 26 TTABVUE 23.

Due to disagreements between Mr. Joos and Mr. Halabi, the parties decided to dissolve Fit, and thereafter negotiated the Dissolution Agreement. Decl. of Mr. Halabi, 23 TTABVUE 5; Decl. of Mr. Joos, 26 TTABVUE 25; *see also* 26 TTABVUE 10-21 (hereinafter, the "Dissolution Agreement"). The Dissolution Agreement, the effective date of which was February 8, 2021, dissolved the Company and, among other things, divided the Company's assets between Mr. Joos and Mr. Halabi. *See* Dissolution Agreement, 26 TTABVUE 10-21. For example, the Dissolution Agreement divided the Company's operating and non-operating domain names equally between Mr. Joos and Mr. Halabi. Dissolution Agreement Schedule 3, 26 TTABVUE 20. Furthermore, the Dissolution Agreement assigned Fit's Logo to Mr. Joos pursuant to Paragraph 7, which states in pertinent part: "The Members agree that the Company's current logo as seen on the websites currently operated by Fit shall become the sole and exclusive property of Joos." Dissolution Agreement ¶ 7, 26 TTABVUE 15.

The Dissolution Agreement also contained provisions governing the parties' post-dissolution obligations. Paragraph 5 of the Dissolution Agreement (the "Restrictive Covenant") contains parameters governing the parties' competitive activities in certain geographic areas for a period of one (1) year and prohibits the parties from engaging in certain competitive activities in those geographic areas. Dissolution Agreement ¶ 5, 26 TTABVUE 11-12. The Restrictive Covenant therefore expired on or around February 8, 2022. Dissolution Agreement ¶ 5, 26 TTABVUE 11; *see also* Decl. of Mr. Halabi ¶ 37, 23 TTABVUE 8. The Restrictive Covenant states in pertinent part:

> The Members acknowledge and agree that each of them has a legitimate business interest in protecting the active Distributed Websites they receive through this Agreement, and that reasonable protection includes a restriction on the other Member's engaging in Prohibited Activities (as defined below) within the geographic area of the market served by the business operated under each Distributed Website. The geographic area in which competition is prohibited includes the county in which the domain name city for each Distributed Website is located (the "Restricted Territory"). [. . .] The Members hereby agree that they will not, in any Restricted Territory, during the twelve (12) month period following the Effective Date of this Agreement ("Restricted Period") engage in, be associated with, employed by, perform services for or have any type of ownership interest in, directly or indirectly, a business in any manner similar to, or in competition with, the Company's business of providing training and certification for CPR, First Aid, and Bloodborne Pathogen ("Fit's Business Services"), or other acts of competition which include, (i) the pursuit of customers through the use of websites or by any other means where such customers are solicited for any Fit's Business Services in the other Member's Restricted Territory, and (ii) setting up training sites in the other Member's Restricted Territory (collectively "Prohibited Activities"). Prohibited Activities do not include the ownership of domain names that are not in active use. For sake of clarity, this Agreement does not prohibit either Member from selling CPR training as part of a more expansive training program such as Certified Nurse Assistant in the other Member's Restricted Territory, and does not prohibit either Member from conducting online CPR training. Halabi and Joos agree that they will not advertise for online training for any of Fit's Business Services in the other Member's Restricted Territory.

Dissolution Agreement ¶ 5, 26 TTABVUE 11. Furthermore, the Dissolution Agreement contains a clause prohibiting either party from disparaging the other (the "Non-Disparagement Clause"); the Non-Disparagement Clause states in pertinent part:

> The Members agree that they shall not disparage, report, and/or demean one another, and/or the other's owners, officers, directors, members, instructors, agents, industry governing boards/memberships (e.g., AHA) or employees in any manner whatsoever, to include but not limited to speech, writings, online platforms, negative SEO, emails, postings to social media, blogs, and websites. This prohibition includes, but is not limited to, disparaging and/or demeaning comments regarding the other Member and the other Member's respective business and/or financial operations.

Dissolution Agreement ¶ 11, 26 TTABVUE 15.

After Fit was dissolved, Mr. Joos and Mr. Halabi each began operating their separate businesses. *See generally*, Decl. of Mr. Halabi, 23 TTABVUE 7; Decl. of Mr. Joos, 26 TTABVUE 27. Mr. Joos, who was granted ownership in Fit's Logo, thereafter assigned Fit's Logo to Applicant, the company through which he operates his businesses. Applicant's Corp. Rep. Decl. ¶¶ 8, 14, 26 TTABVUE 4-5; Decl. of Mr. Joos ¶¶ 20, 32, 41, 26 TTABVUE 27, 30, 32.

On September 8, 2021, Applicant applied to federally register Applicant's Mark as a word plus design mark on the basis of use in commerce under Section 1(a) of the Trademark Act. Applicant's Application No. 97016512, 25 TTABVUE 193. The applied-for mark is reproduced below:

Id.

Applicant's Mark was published for opposition on March 8, 2022. *Id.* Opposer brought its Opposition on May 9, 2022. 1 TTABVUE. Opposer claimed three grounds for opposition:

1. Lack of ownership in that "Applicant is not and was not at the time of the filing of its application the rightful owner" of Applicant's Mark because Opposer alleged Applicant did not own nationwide exclusive rights in Applicant's Mark. 1 TTABVUE 13-15.
2. Fraud in Applicant's Declaration. *Id.* at 16-19.
3. Fraud in the claim of priority. *Id.* at 19-21.

Applicant filed a motion to dismiss the opposition on July 13, 2022 ("Applicant's Motion"). 7 TTABVUE. The Board granted Applicant's Motion as to both fraud claims. 11 TTABVUE 13-21. The Board, construing the Opposition in the light most favorable to Opposer, construed Opposer's lack of ownership claim "as one that Applicant cannot lawfully use the applied-for mark and is not entitled to an unrestricted registration, rather than lack of ownership." *Id.* at 12. The Board interpreted Opposer's lack of ownership claim as follows:

> [T]he gravamen of Opposer's lack of ownership claim is that Applicant did not have the exclusive right to use the applied-for mark in commerce on the filing date of the application because the Dissolution Agreement between Opposer and Joos, whom Opposer alleges is the principal of (or otherwise connected to) Applicant, prohibits use of the applied-for mark in certain geographic areas for one year inclusive of the filing date of the application.

Id. The Board therefore denied Applicant's Motion as to the first grounds for opposition. *Id.* at 13.

Applicant and Opposer proceeded through discovery in these proceedings. Applicant learned for the first time in discovery, through the testimony of a whistleblower, that Mr. Halabi and Opposer have engaged in conduct in breach of the Non-Disparagement Clause on multiple occasions—the whistleblower provided declaration testimony on behalf of Applicant. *See* Decl. of Mr. Bussey, 26 TTABVUE 47-49. The whistleblower testified that Mr. Halabi made "disparaging, negative, and violent comments about Mr. Joos, his business, and his operations on a regular basis." Decl. of Mr. Bussey ¶ 12, 26 TTABVUE 48. According to the whistleblower, Mr. Joos was portrayed as a villain and an enemy of Opposer. *Id.* Furthermore, the whistleblower testified that Mr. Halabi instructed Opposer's staff to "leave false negative Google reviews on Mr. Joos's websites." Decl. of Mr. Bussey ¶ 15, 26 TTABVUE 49.

ARGUMENT

The only issue in this opposition proceeding is whether Applicant has the exclusive and unrestricted right to use the applied-for mark in commerce. Whether Applicant has the exclusive right to use the applied-for mark in commerce is the only articulated basis for the Opposer's First Ground for Opposition, the sole remaining basis for the opposition after the TTAB dismissed the Opposer's second and third grounds for opposition. *See* 11 TTABVUE.

As set forth in detail below, Applicant has and always had the exclusive right to use Applicant's Mark in commerce nationwide, in every state in the United States. Applicant's exclusive rights in and to Applicant's Mark were not limited by the operation of the Restrictive Covenant, which for a period of one year restricted Applicant's ability to engage in certain defined activities in eleven (11) counties in the entire country, but did not prohibit use in commerce in those counties or anywhere else within the United States.

Opposer's Opposition, which argues that Applicant cannot lawfully use Applicant's Mark because Applicant does not have exclusive nationwide rights to Applicant's Mark, should be dismissed with prejudice. To the extent Opposer asserts claims and arguments not pled in the Opposition, such claims cannot be asserted or considered by the Board. TBMP § 801.01 ("A party may not assert a new claim or affirmative defense in its brief that has not been properly pleaded."). For example, to the extent Opposer asserts that Applicant's Application is *void ab initio* for a purported failure of use of Applicant's Mark in connection with all claimed services, Opposer makes this argument for the first time in Opposer's Brief. Opposer's Brief at 41, 33 TTABVUE 42. This claim was not pled in Opposer's Opposition, the parties did not engage in discovery on the issue, and Opposer fails to cite to any record evidence contradicting the averments in Applicant's Application as to use of Applicant's Mark in commerce in connection with the services claimed. Finally, Opposer should be estopped from attempting to enforce the expired Restrictive Covenant against Applicant due to its own breaches of the Dissolution Agreement upon which it relies to bring this opposition.

I. The Restrictive Covenant does not impact Applicant's exclusive ownership of Applicant's Mark.

Opposer spends considerable time arguing that Applicant did not have the exclusive right to use Applicant's Mark due to restrictions in the Dissolution Agreement. Opposer's Brief at 25-28, 33 TTABVUE 26-29. Opposer even argues that the Dissolution Agreement *prohibits* Applicant's use of Applicant's Mark. Opposer's Brief at 26, 33 TTABVUE 27 ("The Dissolution Agreement Prohibits Use of the Applied-For Mark"). Opposer also argues that the Restrictive Covenant in the Dissolution Agreement somehow limits Applicant's exclusive right to Applicant's Mark. *Id.* ("Applicant did not have exclusive right to use nationwide Applicant's

Mark under the valid Dissolution Agreement at any point from the date of Applicant's first use through the date of filing Applicant's Application.").

However, at no point does Opposer acknowledge that the plain language of the Dissolution Agreement specifically transferred exclusive ownership rights in Applicant's Mark to Mr. Joos, who thereafter validly assigned his rights to Applicant. Despite the plain language of the Dissolution Agreement, which contains limited restrictions only on specifically defined activities that the parties to the Dissolution Agreement may engage in for a period of one year, Opposer contends that this language somehow operates as a limit on Applicant's exclusive right to and ownership of Applicant's Mark and should indefinitely block Applicant's rights to federal trademark protection.

The Dissolution Agreement is governed by the laws of the State of Florida. Dissolution Agreement ¶ 19, 26 TTABVUE 17. Under Florida contract law, a court must give effect to the plain meaning of a contract. *Volusia County v. Aberdeen at Ormond Beach*, 760 So. 2d 126, 132 (Fla. 2000) ("It is axiomatic that when construing a document, courts should give effect to the plain meaning of its terms"). Where contractual terms are clear and unambiguous, the plain language controls: "where the terms of a contract are clear and unambiguous, the parties' intent must be gleaned from the four corners of the document, and in such a situation, the language itself is the best evidence of the parties' intent, and its plain meaning controls." *Command Sec. Corp. v. Moffa*, 84 So. 3d 1097, 1101 (Fla. Dist. Ct. App. 4th Dist. 2012) (citing *Crawford v. Barker*, 64 So. 3d 1246, 1255 (Fla. 2011)).

Pursuant to Paragraph 7 of the Dissolution Agreement, Mr. Halabi and Mr. Joos agreed that Fit's Logo would become the "sole and exclusive property" of Mr. Joos. Dissolution Agreement ¶ 7, 26 TTABVUE 15. Applicant's Mark is the logo to which Mr. Joos was given sole

and exclusive property pursuant to that provision. Applicant's Corp. Rep. Decl. ¶ 14, 26 TTABVUE 5; *see also* Decl. of Mr. Halabi ¶ 25, 23 TTABVUE 6; Opposer's Brief at 29, 33 TTABVUE 30. Mr. Joos validly assigned the mark to Applicant. Decl. of Mr. Joos ¶¶ 20, 32, 41, 26 TTABVUE 27, 30, 32; Applicant's Corp. Rep. Decl. ¶¶ 8, 14, 26 TTABVUE 4-5. On multiple occasions, Opposer argues that Applicant did not have the exclusive right to use its own mark due to restrictions in the Dissolution Agreement. *See, e.g.,* Opposer's Brief at 25, 33 TTABVUE 26. However, Opposer does not and cannot cite to any provision of the Dissolution Agreement that restricted Mr. Joos's sole and exclusive ownership of Applicant's Mark.

Mr. Halabi is a party to the Dissolution Agreement and the principal of Opposer. *See generally*, Opposer's Corp. Rep. Decl., 21 TTABVUE 2, 5; Decl. of Mr. Halabi, 23 TTABVUE 2, 12. Mr. Halabi acknowledged and admitted that he could not use Applicant's Mark anywhere:

> Q. Okay. I'll rephrase it. The dissolution agreement said that you can't use that logo anywhere including in the territories you were given for 12 months. Correct?
> A. The dissolution said I couldn't use this logo anywhere including my territories. Yeah.

Depo. of Mr. Halabi at 47:11-16, 32 TTABVUE 37.

Mr. Halabi also admitted that Mr. Joos, pursuant to the Dissolution Agreement, could stop Mr. Halabi from using Applicant's Mark even in Mr. Halabi's own territories, as such an action would constitute a breach of contract. Depo. of Mr. Halabi at 46:15-48:15, 32 TTABVUE 36-38. It is clear that the parties to the Dissolution Agreement were under no illusions as to the exclusive ownership of Applicant's Mark.

To the extent Opposer attempts to argue the interpretation of the Dissolution Agreement to its own benefit, the Dissolution Agreement must be interpreted by the Board according to its "plain meaning." *Novamedix Ltd. v. NDM Acquisition Corp.*, 166 F.3d 1177, 49 USPQ2d 1613, 1616 (Fed. Cir. 1999) (internal citations omitted); *see also Duramax Marine, LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780, 1790 (TTAB 2006) (an agreement must "be discerned

within its four corners, and not by reference to what might satisfy the purposes of one of the parties." (citing *United States v. Armour & Co.*, 402 U.S. 673, 681-82 (1971))). The Dissolution Agreement plainly grants Mr. Joos "sole and exclusive" ownership of Fit's Logo. Dissolution Agreement ¶ 7, 26 TTABVUE 15. Nothing in the Restrictive Covenant or any other provision of the Dissolution Agreement limits this grant of ownership of and rights in Applicant's Mark.

II. The Restrictive Covenant does not prohibit use of Applicant's Mark in commerce in the restricted territories or federal registration of a trademark during the restricted period.

Opposer conflates the meaning of use in commerce and the act of application for a federal trademark with the activities restricted by the Restrictive Covenant of the Dissolution Agreement. Opposer also argues for the first time that Applicant's Application is *void ab initio* for Applicant's purported failure to use Applicant's Mark in commerce in connection with all services claimed in Applicant's Application. *See* Opposer's Brief at 41-46, 33 TTABVUE 42-47.

A. The Restrictive Covenant does not prohibit use in commerce of any mark.

Opposer states that "Applicant filed Applicant's Application during the Restricted Period with no additional averments related to geographical limitations, restrictions, or other concurrent use." Opposer's Brief at 19, 33 TTABVUE 20. To begin with, there was no concurrent use of Applicant's Mark as the Dissolution Agreement granted Mr. Joos sole and exclusive ownership of Applicant's Mark. Dissolution Agreement ¶ 7, 26 TTABVUE 15. As Mr. Halabi acknowledged, he had no right to use Applicant's Mark anywhere, including in his own territories. Depo. of Mr. Halabi at 47:11-16, 32 TTABVUE 37. Opposer, being subject to the terms of the Dissolution Agreement, had no such right either. Opposer's Corp. Rep. Decl. ¶ 9, 21 TTABVUE 5. Opposer's extensive citations to case law on concurrent use agreements and reliance thereon is therefore irrelevant and inapplicable to the facts of this proceeding.

Opposer goes on to argue that the Restrictive Covenant completely limited "the majority" of Applicant's applied-for services by operation of the Restrictive Covenant. Opposer's Brief at 19, 33 TTABVUE 20. Opposer calls the geographic limitations imposed by the Restrictive Covenant "significant." Opposer's Brief at 40, 33 TTABVUE 41. What Opposer fails to acknowledge is that the Restrictive Covenant in fact only operates to limit four specifically defined activities in only eleven counties across the entire United States. *See* Dissolution Agreement ¶ 5, 26 TTABVUE 11. Even with the Restrictive Covenant, both Applicant and Opposer were nonetheless entitled to engage in other competitive activities, including using their respective marks in commerce, without restrictions in every single state in the United States. Applicant's Corp. Rep. Depo. at 45:13-46:4, 19 TTABVUE 54-55.

Opposer also fails to acknowledge that none of the applied-for services were wholly restricted by the geographic and temporal restrictions of the Restrictive Covenant. *Id.* The Restrictive Covenant did not prohibit use of Applicant's Mark or any mark in commerce, as is evidenced by the fact that the Restrictive Covenant specifically permits certain commercial activities within the restricted territories during the restricted period:

> Prohibited Activities do not include the ownership of domain names that are not in active use. For the sake of clarity, this Agreement does not prohibit either member from selling CPR training as part of a more expansive training program such as Certified Nurse Assistant in the other Member's Restricted Territory, and does not prohibit either Member from conducting online CPR training.

Dissolution Agreement ¶ 5, 26 TTABVUE 11. Use of a mark in commerce, as defined by 15 U.S.C. § 1127, in connection with services means the use or display of the mark "in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States [. . .]." 15 U.S. Code § 1127.

The plain language of the Restrictive Covenant does not prohibit use in commerce as defined by the Trademark Act. Applicant could use Applicant's Mark in commerce anywhere in

the United States, including in the Restricted Territories in connection with online CPR training and/or an expansive training program as permitted by the Dissolution Agreement. Dissolution Agreement ¶ 5, 26 TTABVUE 11. The Restrictive Covenant does not even mention use of Fit's Logo or use of any mark in commerce by either party, or any restrictions thereon. Opposer's heavy reliance on case law interpreting consent agreements and/or settlement agreements relating to restrictions on uses of trademarks or concurrent uses of trademark by multiple users is deceptive.

B. Opposer fails to show that Applicant's Application is Void Ab Initio.

Opposer's *void ab initio* argument, made for the very first time in Opposer's Brief, fails at the outset not only because it is improperly asserted as a new claim never previously pled in these proceedings, but also because Opposer fails to cite to record evidence proving non-use of Applicant's claimed services.

Opposer claims that the evidence of record is "devoid" of proof of use of the services claimed in Applicant's Application. Opposer's Brief at 44, 33 TTABVUE 34. However, Opposer either forgets or disregards that Applicant's Application was submitted with an affidavit of use of Applicant's Mark in commerce in connection with all services claimed in the application, as well as with specimens showing use of the mark in connection with all services claimed. *See* Applicant's Application No. 97016512, 25 TTABVUE 193-223. An examiner examined Applicant's Application, including all specimens submitted, and Applicant's Application was published for Opposition. Opposer does not cite record evidence proving Applicant's Application was incorrect regarding use of Applicant's Mark in connection with the services claimed at the time of filing.

Opposer's Brief grossly misstates the record evidence in suggesting that Applicant does not and has never offered online CPR training services, and moreover contradicts its own citations to the record of testimony plainly stating that Applicant *does* offer online CPR training. Opposer's Brief at 43, 33 TTABVUE 44 (citing Applicant's Corp. Rep. Depo. at 41:1-25, 19 TTABVUE 50). Applicant does offer and has always offered online training as a component of its services. Applicant's Corp. Rep. Depo. at 40:8-12, 41:1-25, 19 TTABVUE 49-50. Opposer makes a big deal of the fact that Applicant does not offer online-only training services. Opposer's Brief at 43, 33 TTABVUE 44. Applicant need not offer online-only services as such a service was not a claimed service in Applicant's Application. *See* Applicant's Application No. 97016512, 25 TTABVUE 193-223.

Opposer fails to otherwise support any assertion that Applicant was not offering any of the claimed services *at the date of filing*, the only time frame that would be relevant to Opposer's argument. Opposer not only relies on inapplicable case law to claim it has shifted the burden of proof of use in commerce to Applicant, but has nonetheless failed to shift such burden of proof.

In any event however, Opposer's arguments regarding alleged failure to use Applicant's Mark in commerce in association with every claimed service cannot now be asserted for the first time and should not be considered by the TTAB as the claim was not pled or even alluded to in the Opposition. TBMP § 801.01 ("A party may not assert a new claim or affirmative defense in its brief that has not been properly pleaded.").

C. Application for federal registration of a mark is not otherwise barred by the Restrictive Covenant.

The act of applying for a use-based federal trademark registration is not otherwise restricted or prohibited by the Restrictive Covenant. Mr. Halabi admitted that the act of applying for registration of Applicant's Mark does not conflict with the plain language of Paragraph 5 of

the Dissolution Agreement, the Restrictive Covenant upon which Opposer bases its entire opposition. Depo. of Mr. Halabi at 67:21-75:19, 32 TTABVUE 56-64. Paragraph 5 prohibits the parties from engaging in a limited number of defined competitive activities in the other party's territories as set forth in Schedule 3 for a period of twelve months. Dissolution Agreement ¶ 5, 26 TTABVUE 11. Paragraph 5 prohibits certain activities within the restricted territories for the restricted period on the one hand, and on the other hand specifically allows other competitive activities, including "selling CPR training as part of a more expansive training program such as Certified Nurse Assistant" even in the other party's restricted territories. *Id.* Paragraph 5 further allows either party to conduct online CPR training in the other party's restricted territories. *Id.* Finally, Paragraph 5 specifically states that ownership of inactive domain names is not a prohibited activity. *Id.*

Nothing contained in the plain language of Paragraph 5 operates as a limitation on Mr. Joos's ownership of Applicant's Mark. Nothing contained in the plain language of Paragraph 5 states that filing for a trademark registration of Applicant's Mark falls within the scope of the Prohibited Activities. Mr. Halabi acknowledged that registration of Applicant's Mark plainly did not fall within the scope of the Prohibited Activities as defined in Paragraph 5 of the Dissolution Agreement. Depo. of Mr. Halabi at 67:21-75:19, 32 TTABVUE 56-64.

D. Even if the TTAB agrees that Applicant could not lawfully use the applied-for mark and was not entitled to an unrestricted registration due to the Restrictive Covenant, the proper remedy is to amend the Application with an exclusion modifier rather than sustaining an opposition to registration.

If the TTAB is inclined to agree with Opposer that the one-year period restricting certain competitive activities in eleven counties set forth in the Restrictive Covenant means that Applicant could not lawfully use Applicant's Mark and was therefore not entitled to unrestricted registration at the time of filing, the proper remedy would be to allow an amendment to

Applicant's Application. The Restrictive Covenant lasted for one (1) year and had already expired by the time Opposer filed its Opposition. Applicant in good faith filed its Application believing that, as the sole and exclusive owner of Applicant's Mark, it was entitled to federal trademark registration and protection. Applicant did not and does not believe that the Restrictive Covenant in any way operated as a limit on Applicant's ownership in Applicant's Mark.

However, in the event the Board finds that Applicant is not entitled to registration in the absence of an exclusion modifier disclaiming services restricted by the Restrictive Covenant in the eleven counties during the one-year restricted period, the Board should allow Applicant time to file a motion to amend the Application to conform with the Board's finding. Such remedy is specifically allowed under 37 CFR § 2.133(b), which states that if the Board finds during an *inter partes* proceeding that an application "is not entitled to registration in the absence of a specified restriction to the application or registration, the Board will allow the party time in which to file a motion that the application or registration be amended to conform to the findings of the Board[.]" 37 CFR § 2.133(b).

III. Fit's Logo was validly assigned through the Dissolution Agreement.

It is unclear what the relevance of Opposer's argument regarding the validity of the assignment of Fit's Logo to Mr. Joos has to do with the basis of opposition as it argues that due to invalid transfer, Applicant's first use date occurred during the time the Restrictive Covenant was in place. However, as the TTAB pointed out in its ruling on Applicant's Motion, in a use-based application,"'the first use date is not material to the Office's decision to approve a mark for publication.'" 11 TTABVUE 20 (citing *Hiraga v. Arena*, 90 USPQ2d 1102, 1107 (TTAB 2009)); *see also Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 630 (TTAB 1986) ("a misstatement of a date of first use in commerce is not fraudulent nor is it

otherwise fatal to the securing of a valid registration provided that there has been use of the mark in commerce prior to the filing date of the [use-based application]").

Nonetheless, Fit's Logo was validly assigned to Mr. Joos pursuant to the Dissolution Agreement. Fit was in business up until the dissolution and Fit's Logo was in use at all times prior to the dissolution, and was in use at all times after assignment to Mr. Joos. Opposer's argument that Paragraph 7 of the Dissolution Agreement relates to copyright is backwards and incorrect. Fit's Logo is plainly referred to as a logo in the Dissolution Agreement. It is well-known that logos are typically not copyrightable and trademark law exists specifically to protect logos not otherwise protectible under copyright. The Dissolution Agreement also contains language referring to likelihood of confusion. *See* Dissolution Agreement ¶ 8, 26 TTABVUE 15. Opposer further misplaces its reliance on case law to support the conclusion that the goodwill of Fit's Logo was somehow abandoned when Fit dissolved. Opposer even neglects the meaning assigned by the Trademark Act for when a mark is deemed abandoned, which includes:

> When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

15 U.S. Code § 1127.

Furthermore, the absence of the words "goodwill" in the Dissolution Agreement does not bear on whether the goodwill of Fit's Logo was validly assigned to Mr. Joos. Courts have in fact universally held that a mere recitation of a transfer of goodwill does not necessarily transfer goodwill of a mark. *See, e.g., Money Store v. Harriscorp Fin., Inc.*, 689 F.2d 666, 670 (7th Cir. 1982). Courts therefore look to whether an assignee uses the assigned mark in connection with substantially similar goods and/or services. *See, e.g., Marshak v. Green*, 746 F.2d 927, 930 (2d

Cir. 1984); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 266 (5th Cir. 1999) ("[T]he transfer of goodwill requires only that the [goods] be sufficiently similar . . . ." (quoting *Visa, U.S.A., Inc. v. Birmingham Tr. Nat. Bank*, 696 F.2d 1371, 1376 (Fed. Cir. 1982))); *see also Int'l Cosmetics Exch., Inc. v. Gapardis Health & Beauty, Inc.*, 303 F.3d 1246 (11th Cir. 2002) (finding that an "assignment was not in gross" when the assignee continued to use the mark on "the very goods which created [the mark's] reputation").

Fit offered classes, seminars, workshops, and other educational services in the fields of health, cardiovascular health, cardiopulmonary resuscitation (CPR), Automated External Defibrillator (AED), first aid, and Bloodborne Pathogens, all under Fit's Logo. Dissolution Agreement ¶ 5, 26 TTABVUE 11; *see also* Decl. of Mr. Joos ¶ 8, 26 TTABVUE 23.

Mr. Joos validly assigned his rights in Applicant's Mark to Applicant. Decl. of Mr. Joos ¶¶ 20, 32, 41, 26 TTABVUE 27, 30, 32; Applicant's Corp. Rep. Decl. ¶¶ 8, 14, 26 TTABVUE 4-5. Applicant continues to use Fit's Logo in connection with services substantially similar to Fit's services, including without limitation CPR and First Aid training and educational services, including CPR certification services, through live and hybrid classes. Applicant's Corp. Rep. Decl. ¶ 2, 26 TTABVUE 2; *see also* Applicant's Application No. 97016512, 25 TTABVUE 193.

Despite Opposer's confusion as to the owner of Applicant's Mark, Opposer does not argue that, nor is there is no record evidence to suggest, Mr. Joos's assignment of Applicant's Mark to Applicant was invalid. Fit's Logo continues to be used by Applicant in connection with the same, if not services substantially similar to those that Fit offered when it was in business. Fit's Logo and its associated goodwill was validly assigned to Mr. Joos, who intended to and does protect and uphold the goodwill of the brand created by Fit. Decl. of Mr. Joos ¶¶ 19-20, 26 TTABVUE 27.

IV. Opposer should be estopped from opposing the registration of Applicant's Mark.

Opposer's sole basis of opposition is premised upon the Dissolution Agreement entered into by and between Mr. Joos and Mr. Halabi. Opposer's opposition is a manner of enforcement of the Dissolution Agreement; however, Opposer's own prior breaches of the Dissolution Agreement should foreclose it from sustaining an opposition on the basis of the Dissolution Agreement.

Not only did Mr. Halabi and Opposer fail to comply with the notice and cure provision of the Dissolution Agreement by notifying Mr. Joos and Applicant of their purported belief that Applicant's Application was not in compliance with the Dissolution Agreement, but Applicant learned through discovery in these proceedings that Opposer, through its principal Mr. Halabi, materially breached the Dissolution Agreement by, among other acts, making numerous disparaging and moreover disturbing statements about Mr. Joos and Applicant.

Florida law, which governs construction and indeed enforceability of the Dissolution Agreement against the parties, would not enforce the Dissolution Agreement against Mr. Joos due to Mr. Halabi's prior material breaches. While it is not within the Board's jurisdiction to enforce contracts between parties, the Board routinely considers whether an agreement between parties would constitute an independent basis for sustaining an opposition. *Kimberly-Clark Corp. v. Fort Howard Paper Co.*, 772 F.2d 860, 227 USPQ 36, 37 (Fed. Cir. 1985). The Board may therefore "consider the agreement, its construction or its validity if necessary to decide" the issues in an opposition, "including the issue of estoppel." *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 647 (Fed. Cir. 1983).

Opposer attempts to argue that Applicant's record evidence of Mr. Halabi and Opposer's prior breaches of the Dissolution Agreement are irrelevant, purportedly because it is not within the Board's purview to enforce contracts between parties. Opposer's Brief at Appendix I, 33

TTABVUE 56-62. However, Opposer's Brief itself in effect begs the Board to enforce the Dissolution Agreement by wielding the expired Restrictive Covenant against Applicant. Opposer's Brief states:

> Further, it begs the question of why parties set the restriction in the Dissolution Agreement at all if it will not be upheld. If the Dissolution Agreement states each party is not allowed to enter the Restricted Territories, then a trademark application seeking unrestricted registration should not be allowed to register.

Opposer's Brief at 48, 33 TTABVUE 49.

Opposer attempts to sweep its principal's actions in breach of the Dissolution Agreement under the rug. Before even reaching Mr. Halabi's breaches of the Dissolution Agreement, however, Opposer should be estopped from sustaining an opposition against Applicant's Mark for failure to comply with the Dissolution Agreement's notice and cure provision.

The Dissolution Agreement contains a notice and cure provision pursuant to which the parties agreed to give written notice regarding any of "the obligations and prohibitions in [the Dissolution] Agreement and for any other matter arising out of or connect to" the Dissolution Agreement, and fifteen (15) days' opportunity to cure. Dissolution Agreement ¶ 12, 26 TTABVUE 16.

Where a contract plainly provides for notice and opportunity to cure, Florida courts will not hold a party liable for alleged breach when they were not afforded notice and/or opportunity to cure by the party claiming breach. *E.g., Magnum Constr. Mgmt. Corp. v. City of Miami Beach*, 209 So. 3d 51 (Fla. Dist. Ct. App. 3d Dist. 2016) (finding a contractor not liable for construction defects because the City did not provide opportunity to cure as required by the contract and stating "a party who, by his own acts, prevents performance of a contract provision cannot take advantage of his own wrong." (citing *N. Am. Van Lines v. Collyer*, 616 So. 2d 177, 179 (Fla. Dist. Ct. App. 5th Dist. 1993)); *see also Srgc v. Billy Casper Golf*, 2019 U.S. Dist. LEXIS

241715, at *19 (M.D. Fla. 2019) (stating that under Florida law "a party that fails to provide contractually required notice and chance to cure generally is not entitled to judgment in its favor.").

As Opposer's Brief suggests, the sole basis for and validity of Opposer's grounds for opposition rests on the interpretation of the Restrictive Covenant in the Dissolution Agreement. Opposer's Brief at 14, 33 TTABVUE 15. Opposer's dispute with Applicant seeking registration of its Mark, and indeed its entire basis for opposition, falls squarely within the scope of the Dissolution Agreement's notice and cure provision. Despite this, there is no evidence on the record indicating that Mr. Halabi ever provided Mr. Joos written notice or opportunity to cure any alleged breaches of the Dissolution Agreement prior to initiating these opposition proceedings.

By operation of Florida law, Opposer cannot reap the benefits of enforcing the Dissolution Agreement when it has not provided Mr. Joos and Applicant with notice regarding Mr. Joos's obligations or prohibitions under the Dissolution Agreement in relation to Applicant's Application, or any opportunity to cure any alleged issues with Applicant's Application prior to initiation of this Opposition.

Furthermore, by operation of Florida law, Opposer cannot reap the benefits of enforcing the Dissolution Agreement when it fails to comply with the terms of the very same contract. As previously stated, Mr. Joos and Applicant learned through a discovery deposition that Mr. Halabi and Opposer egregiously breached the Non-Disparagement Clause on multiple occasions by, for example, making "disparaging, negative, and violent comments about Mr. Joos, his business, and his operations on a regular basis" and furthermore instructing staff to "leave false negative Google reviews on Mr. Joos's websites." Decl. of Mr. Bussey ¶¶ 12-15, 26 TTABVUE 48-49.

Pursuant to Florida law, which governs the Dissolution Agreement, "[a] party is not entitled to enjoin the breach of a contract by another, unless he himself has performed what the contract requires of him so far as possible; if he himself is in default or has given cause for nonperformance by defendant, he has no standing in equity." *Benemerito & Flores, P.A. v. Roche*, 751 So. 2d 91, 93 (Fla. Dist. Ct. App. 4th Dist. 1999) (internal citations omitted); *see also In re Thomas*, 51 B.R. 653, 656 (Bankr. M.D. Fla. 1985) ("Having committed the first breach, the general rule is that a material breach of the Agreement allows the non-breaching party to treat the breach as a discharge of his contract liability." (citing *Troup v. Heacock*, 367 So.2d 691 (Fla. Dist. Ct. App. 1st Dist. 1979))).

In equity, Opposer should not be entitled to use these opposition proceedings to enforce the Restrictive Covenant against Applicant when it and its principal, Mr. Halabi, committed the first breach(es) of the Dissolution Agreement. Applicant, in good faith, applied for federal trademark protection for Applicant's Mark; such Application was not even published for opposition until after the expiration of the Restrictive Covenant. Opposer pursued this opposition proceeding despite the expiration of the Restrictive Covenant and despite the fact that no evidence exists to suggest that Mr. Joos or Applicant has in any way ever breached the Restrictive Covenant or any other provision of the Dissolution Agreement since it went into effect.

SUMMARY AND CONCLUSION

By operation of the Dissolution Agreement, sole and exclusive ownership of Fit's Logo was granted and validly assigned to Mr. Joos. Mr. Joos validly assigned his rights and interests in the Fit Logo to Applicant, and Applicant obtained the same exclusive ownership of Applicant's Mark. The Dissolution Agreement does not and did not at any time limit Applicant's exclusive

nationwide rights in Applicant's Mark. The Dissolution Agreement does not and did not prohibit Applicant's use of Applicant's Mark in commerce. The Dissolution Agreement does not and did not ever limit or prohibit the right to seek federal trademark protection.

Opposer's assertion that the Application is *void ab initio* due to alleged non-use is without merit and cannot be asserted as it was not pled in the Opposition. Finally, Opposer should be estopped from opposing Applicant's Application due to its own prior material breaches of the Dissolution Agreement upon which it bases its Opposition. For these reasons, Opposer's Opposition should be dismissed with prejudice.

In the event Board is inclined to find that, due to the Dissolution Agreement, Applicant is not entitled to registration in the absence of a restriction to the application reflecting the terms of the Dissolution Agreement, the Board should allow Applicant to file a motion to amend its Application to conform with the Board's findings pursuant to 37 CFR § 2.133(b).

Dated: August 5, 2024.

Respectfully Submitted,

/s/ Joseph F. Southron
Joseph F. Southron Esq.
Florida Bar Number: 122109
400 N. Ashley Drive, Suite 1720
Tampa, Florida 33602
Tel.: 813.773.5105
Fax. 813.773.5103
Primary: joe@fourriverslaw.co
Secondary:eservice@fourriverslaw.com
Attorney for Applicant

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this 5th day of August, 2024, a true and correct copy of the foregoing APPLICANT CPR, LLC'S BRIEF has been served in its entirety by electronic mail to all parties and counsel of record.

CERTIFICATE OF TRANSMITTAL

I HEREBY CERTIFY that on this 5th day of August, 2024, a true and correct copy of the foregoing APPLICANT CPR, LLC'S BRIEF is being filed electronically with the Trademark Trial and Appeal Board of the United States Patent and Trademark Office via ESTTA.

FOUR RIVERS LAW FIRM

/s/ Joseph F. Southron
Joseph F. Southron
Fla Bar No. 122109
For the Firm

APPENDIX OF EVIDENTIARY OBJECTIONS

Pursuant 37 CFR § 2.128(b) and TBMP §§ 707.01, 707.02, 707.03, and 801.03, Applicant respectfully submits the following evidentiary objections to the below-identified evidence and/or testimony submitted by Opposer during its Trial Period:

Evidence	Summary	Basis for Objection
Opposer's Testimonial Declaration of Ms. Laura Ahammer, 22 TTABVUE.	Testimony of COO of Opposer regarding Opposer's purported activities to ensure compliance with the Restrictive Covenant during the Restricted Period	Relevance. Fed. R. Evid. 401, 402. Opposer's purported compliance with the Restrictive Covenant is irrelevant to the issue of whether Applicant can lawfully use Applicant's Mark and is entitled to unrestricted registration of its Mark.
Exhibit H to Opposer's Notice of Reliance, 19 TTABVUE 259-324.	TSDR status page and file history printouts for a word mark previously filed and abandoned by Applicant	Relevance. Fed. R. Evid. 401, 402. An abandoned wordmark application previously filed by Applicant is irrelevant to Applicant's present Application, this opposition proceeding, and the issue of whether Applicant can lawfully use and is entitled to unrestricted registration of its design Mark.
Exhibit I to Opposer's Notice of Reliance, 19 TTABVUE 325-347	Application and TSDR status page printouts for Opposer's Mark	Relevance. Fed. R. Evid. 401, 402. Opposer's design mark application, still pending before the USPTO and not yet published for opposition, is irrelevant to the issue of whether Applicant can lawfully use and is entitled to unrestricted registration of its Mark.

Exhibit M to Opposer's Notice of Reliance, 19 TTABVUE 359-416	USPTO Economic Working Paper No. 2018-02 from the Office of the Chief Economist, U.S. Patent and Trademark Office, An Anatomy of U.S. Firms Seeking Trademark Registration	Relevance. Fed. R. Evid. 401, 402. Economic research regarding trademark activity has no relevance to the issue of whether Applicant can lawfully use and is entitled to unrestricted registration of its Mark in light of the Restrictive Covenant.
Exhibit P to Opposer's Notice of Reliance, 20 TTABVUE 95-122.	Census data pages for twenty-two U.S. counties	Relevance. Fed. R. Evid. 401, 402. Census data for twenty-two counties, whether or not the counties divided among Mr. Joos and Mr. Halabi pursuant to the Dissolution Agreement, is irrelevant to the issue of whether Applicant can lawfully use and is entitled to unrestricted registration of its Mark in light of the Restrictive Covenant.