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

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| Proceeding | 92074504 |
| Party | Plaintiff<br>Hyper Ice, Inc. |
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**UNITED STATES PATENT AND TRADEMARK OFFICE**
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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| **Serial No.:** | 88/670,960 |
| **Registration No.:** | 6,068,295 |
| **Filed:** | October 28, 2019 |
| **Registered:** | June 2, 2020 |
| **Registrant:** | Theravolt |
| **Mark:** |  |
| **International Class:** | 10 |



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| Hyper Ice, Inc. | ) | |
| | ) | Cancellation No. 92074504 |
| Petitioner, | ) | |
| Theravolt, | ) | |
| Registrant. | ) | |

**PETITIONER'S REPLY IN SUPPORT OF ITS MOTION TO STRIKE OR DEEM ADMITTED SECTIONS OF REGISTRANT'S ANSWER**

Petitioner Hyper Ice, Inc. ("Petitioner") respectfully files this Reply in Support of its Motion to Strike or Deem Admitted Sections of Registrant's Answer in order to *correct* the inaccuracies in Registrant Theravolt's Opposition to the Motion to Strike or Deem Admitted Sections of Registrant's Answer [TTABVUE 16] ("Opposition").

This reply is founded on the following arguments:

(1) Registrant Theravolt's ("Registrant") Opposition fails to respond to the substance of Petitioner's Motion to Strike or Deem Admitted Sections of Registrant's Answer [TTABVUE 14] ("Motion to Strike");

(2) Registrant *did* rely on its self-created, falsified photographs of Petitioner's massage product, the Hypervolt ("Hypervolt photographs"), to show commercial use of Registrant's THERAVOLT mark;

(3) Registrant's refusal to respond to the purported allegations of law in Petitioner's Amended Complaint [TTABVUE 6, Exhibit A] ("Petition") should be stricken; and

(4) Registrant's response to paragraph 20 is nonsensical.

## I. REGISTRANT'S OPPOSITION IS NONRESPONSIVE

Registrant's Opposition fails to address the crux of Petitioner's underlying Motion to Strike—e.g. whether Registrant properly answered the specific, straightforward allegations contained in Paragraphs 15, 16, 18, 19-22, and 24 ("Subject Paragraphs") of the underlying Petition. Section 506.01 of the Trademark Trial and Appeals Board Manual Procedure ("TBMP") states that motions to strike are a means to remove "redundant, immaterial, impertinent, or scandalous matter[s]" from a pleading and to enforce the primary purpose of pleadings of giving "fair notice of the claims or defenses asserted." TBMP § 506.01; Fed. R. Civ. P. 12(f). As such, the focus of a motion to strike is whether the subject pleading provides sufficient notice and meets the federal pleading standards, *not* whether the merits of the allegations are tenable.

Pursuant to these principles, Petitioner's Motion to Strike delineated the averments in each of the Subject Paragraphs that went unanswered, including the affirmative steps Registrant took to falsify the Hypervolt photographs. *See* Motion to Strike at pp. 7-11. Registrant's Opposition, however, entirely overlooked the issue of whether its responses fairly met the substance of the allegations identified in the Motion to Strike. Instead, in a self-serving reshaping of the issue, it stated "the fundamental question raised by Petitioner's cancellation proceeding (and indirectly by Petitioner's instant motion)" is whether a text box containing the word "TheraVolt" and an "Add to Cart" button ("Textbox") "adequately supports trademark use." Opposition at p. 2. This is patently false. And based on this incorrect premise, Registrant needlessly analyzed whether photographs are a mandatory requirement for a specimen of use in this instance, raising issues that are not currently before the Board. *Id.* at pp. 2-4. The sole focus of the Motion to Strike was Registrant's pleading deficiencies, not the merits of its anticipated defense.

Accordingly, Registrant improperly used its Opposition as a means to seek a merits-based judgment and failed to substantively respond to the Motion to Strike.

## II. REGISTRANT DID RELY ON THE FALSIFIED PHOTOGRAPHS IN ITS SPECIMEN OF USE

Even if Registrant's Opposition was responsive, its rationalization that the falsified photographs were not germane to its registration application is incorrect. First, Registrant's specimen of use consists of two pages, only one of which exhibited the Textbox. [TTABVUE 6] at p. 41, 44-45. The first page of the specimen contains *only* the Hypervolt photographs; the second page shows the Textbox *and* a Hypervolt photograph. *Id.* at 44-45. Accordingly, Registrant's revisionist argument that it did not rely on these photographs in its specimen of use is *patently* false.

Additionally, the Textbox, by itself, fails to satisfy the requirement for a specimen of use of the *applied-for* mark. Registrant's reliance on the *In re Sones* case is inapposite. Opposition at p. 3. The issue here is not whether the Textbox constitutes a specimen of commercial use in light of the "Add to Cart" button. The issue is whether the Textbox depicts the applied-for mark. The Textbox does <u>not</u> depict that mark. The Trademark Rules mandate that a trademark specimen "show the mark as actually used in commerce on or in connection with the goods or services identified." C.F.R. § 2.56(a). A mark is deemed to be used in commerce when "it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto…and the goods are sold or transported in commerce." 15 U.S.C. §1127. Also, in an application for registration of a trademark, "the drawing of the mark must be a *substantially exact* representation of the mark a*s used on or in connection with the goods and/or services*." C.F.R. § 2.51(b) (Emphasis added.) The "substantially exact" standard requires a high degree of similarity between the mark as actually used and the mark as it appears in the application. Although some variance is permitted, the standard is higher, for instance, than the "material alteration" standard used when considering the acceptability amendments to the drawing in an application. *In re Yale Sportswear Corp.*, 88 USPQ2d 1121, 1123 n. 4 (TTAB 2008).

Here, Registrant sought to register a design mark consisting "of a completely shaded lightning bolt that is interrupted in the middle by the wording THERAVOLT written in an uppercase font." [TTABVUE 6] at p. 41. Registrant's drawing of the mark contains the following illustration:


*Id.* at 43. As such, the Registrant's specimen of use must show commercial use of the mark that is described in its application and that is a "substantially exact" representation of the above drawing The Textbox, however, merely contains the word "TheraVolt" in a different font and style than the applied-for mark and omitting the lightning bolt. *Id.* at 45. Thus, the Textbox, without the modified photographs, does not show commercial use of the applied-for mark, and is not a "substantially exact" representation of the mark in Registrant's drawing. Further, Registrant conveniently fails to mention the falsified photograph of the Hypervolt, displaying the applied-for mark, on page 2, next to the Textbox in its specimen of use. *See id.* Given that the falsified photographs of the Hypervolt are the *only* portions of Registrant's specimen of use that display the applied-for mark, Registrant *indubitably* relied on them in order to evidence use in commerce.

## III. REGISTRANT'S REFUSAL TO RESPOND TO ALLEGATIONS OF LAW SHOULD BE STRICKEN

Registrant also fails to justify its inaccurate response that "Petitioner's allegations of law do not require an admission or denial." [TTABVUE 13] ("Answer"), ¶¶ 15, 16, 18, 19, 21, 22 and 24. Registrant improperly relies on cases which merely state that the court is not required to accept as true legal conclusions in a complaint *for purposes of a motion to dismiss*; they shed no light on a defendant's obligation to admit or deny all factual averments in a complaint. Opposition at p. 5; *see Ashcroft v. Iqbal*, 556 U.S. 662, 678; *NSM Res. Corp. v. Microsoft Corp.*, 2014 TTAB LEXIS 399, *6-7, 113 U.S.P.Q.2D (BNA) 1029, 1032 (TTAB Nov. 25, 2014). As established in Petitioner's Motion to Strike,

Registrant is simply incorrect in contending that it could respond to conclusions of law by asserting that no response is necessary. Motion to Strike at pp. 3-4.

Registrant's Opposition also falsely asserts that "Petitioner creates the mis-impression that Registrant's paragraphs 15, 16, 18, 19, 21, 22, and 24 of [the Answer] only allege: 'Petitioner's allegations of law do not require an admission or denial.'" Opposition at p. 5. Petitioner acknowledged each of the remaining portions of Registrant's answers and provided an in-depth analysis as to why they were improper and should be stricken: First, Registrant's denial of reliance on the falsified photographs is not only nonresponsive, it is also blatantly false. *See, supra*, Part II; Motion to Strike at pp. 4-7. Also, as established in Part II.C. of its Motion to Strike, Petitioner explains how Registrant's remaining admissions or denials either fail to specifically admit or deny *all* of the allegations or are meaningless, qualified admissions or denials that should be rendered admitted. *See* Motion to Strike at pp. 7-12[1]. As such, Registrant cannot salvage its refusal to respond to any legal conclusions by relying on its irrelevant, partial and/or improperly qualified admissions or denials.

Finally, Registrant failed to identify which, if any, of the allegations in the Subject Paragraphs were legal conclusions. This deficiency, coupled with numerous unanswered factual averments, fails to give Petitioner notice of which specific allegations are being admitted or denied. Such conduct violates the primary purpose of pleadings, which is "to give fair notice of the claims or defenses asserted," and should, therefore, be stricken pursuant to TBMP § 506.01. TBMP § 506.01. To the extent the Board chooses to grant Registrant leave to amend its deficient answers, Registrant should be ordered to specifically deny *each* averment, legal or factual, with unequivocal admissions or denials and its responses should fairly meet the substance of allegations denied. *See* TBMP §§ 311.02(a); Fed. R. Civ. P. 8(b)(2), (3).

[1] For the sake of brevity, Petitioner does not repeat the same analysis here, but incorporates the arguments made therein by reference.

## IV. REGISTRANT'S ANSWER TO PARAGRAPH 20 IS UNINTELLIGIBLE

Registrant's Opposition further revealed deficiencies in its answer to paragraph 20. In this paragraph, Petitioner stated, "other than in the doctored photograph created by THERAVOLT, the HYPERVOLT never displayed the THERAVOLT mark." Answer, ¶ 20. Along with its false denial of reliance on the doctored photographs in its specimen of use, Registrant denied "that *Petitioner* never used Registrant's THERAVOLT registered mark to sell *Petitioner's* massage product." *Id.* (Emphasis added.) A straightforward reading of this statement indicates that, according to Registrant, Hyper Ice (the Petitioner) used the THERAVOLT mark to sell the Hypervolt. In its Opposition, however, Registrant relies on this inexplicable statement to show that *Registrant* sold its *Theravolt* products prior to filing its trademark application for its THERAVOLT mark. Opposition at p. 3. The referenced denial, however, does not discuss Registrant's selling of Registrant's product; it references Petitioner's selling of Petitioner's product. While neither interpretation is responsive or accurate, this further illustrates that even Registrant cannot make sense of its response to paragraph 20. For this reason, it should be stricken and the allegations of paragraph 20 should be admitted.

## V. CONCLUSION

Based on the foregoing, Registrant's Opposition further supports Petitioner's Motion to Strike. First, the Opposition constitutes further evidence of Registrant's evasive tactics as it fails to substantively respond to the Motion to Strike and, instead, argues the merits of Petitioner's claims. Secondly, even Registrant's merits-based argument that the Hypervolt photographs were not essential to its specimen of use fails as a matter of law. The only portions of the specimen of use that display the applied-for mark are the *photographs*, not the Textbox. It follows, therefore, that the photographs are the *only* images Registrant could have relied upon in obtaining registration of its mark. Additionally, Registrant blatantly misrepresented that its refusal to respond to any legal conclusions in the Petition are justified by Registrant's inclusion of additional irrelevant, partial and/or qualified admissions and denials. As established in the Motion to Strike (and completely ignored by Registrant), such responses can neither

salvage the improper refusal to respond to legal conclusions nor satisfy Rule 8's pleading requirements. Finally, the Opposition further illustrates the absurd nature of Registrant's answers since Registrant misinterprets its own response to paragraph 20. Accordingly, the Board should strike the non-responsive statements identified in its Motion to Strike [TTABVUE 14] and deem admitted all unanswered allegations in paragraphs 15, 16, 18, 19, 20-22, and 24 of the Amended Petition.

Respectfully submitted,
Hyper Ice, Inc.

Dated: February 16, 2021

By /s/ *Jonathan Pink*

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**PROOF OF SERVICE**

I, Jonathan S. Pink, do hereby certify that on February 16, 2021, the foregoing PETITIONER'S REPLY IN SUPPORT OF ITS MOTION TO STRIKE OR DEEM ADMITTED SECTIONS OF REGISTRANT'S ANSWER was served upon the following counsel by E-Mail:

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