

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

In the matter of Application No. 85/901,669
 Notice of Allowance Issued: October 29, 2013
 For the trademark: FIRST START

GERBER PRODUCTS COMPANY,)	
)	
Petitioner,)	
)	
v.)	Cancellation No.: Pending
)	
PBM NUTRITIONALS, LLC,)	
)	
Applicant.)	

PETITION FOR CANCELLATION

Petitioner, Gerber Products Company (“Gerber” or “Petitioner”), hereby petitions the Trademark Trial and Appeal Board (“TTAB”) to cancel U.S. Application Number 85/901,669 for the mark FIRST START for use in connection with “*infant formula*” (“Respondent’s Mark” or “FIRST START”), which is owned by PBM Nutritionals, LLC (“Respondent”) and the related Notice of Allowance that was issued on October 29, 2013, on the basis that Respondent’s Mark was improperly allowed in light of Petitioner’s prior rights in the GOOD START mark (U.S. Reg. No. 1,666,415) that is registered for identical goods (*i.e.*, “*infant formula*”) (the “GOOD START Mark”). Respondent filed its application for Respondent’s Mark on an intent-to-use basis, and this application was allowed on October 29, 2013. If Respondent’s Mark is permitted to register, Petitioner will be irreparably damaged as Respondent’s registration for and use of Respondent’s Mark is likely to and will cause consumer confusion as to the source, affiliation and/or sponsorship of Respondent’s products, and is likely to and will dilute the distinctiveness of the GOOD START Mark.

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Accordingly, Petitioner seeks to cancel U.S. Application Number 85/901,669 and the related Notice of Allowance pursuant to Section 13(a) of the Trademark Act of 1946, as amended (the “Lanham Act”), 15 U.S.C. § 1064, and the TTAB’s inherent authority to reverse prior decisions. *See Macktal v. Chao*, 286 F.3d 822, 825-26 (5th Cir. 2002) (stating that agencies have the inherent authority to “reconsider” prior decisions); *The Last Best Beef, LLC v. Dudas*, 506 F.3d 333, 340 (4th Cir. 2007) (reversing district court’s holding that the USPTO did not have the authority to cancel pending trademark applications and Notices of Allowance).

The Parties and the Respondent’s Mark

1. Gerber is a corporation organized under the laws of Michigan, with its principal place of business located at 12 Vreeland Rd., Florham Park, New Jersey 07932-0697, USA. Gerber is the exclusive licensee in the United States of the GOOD START Mark owned by its affiliate company, Societe des Produits Nestlé S.A. (“Nestlé”).
2. Nestlé is the world’s leading nutrition, health and wellness company with many internationally recognized brands, including maternal and infant nutrition products. Nestlé is the owner of several federal registrations for the GOOD START trademark, including U.S. Registration No. 1,666,415 claiming “*infant formula*,” which has been registered since 1991, and U.S. Registration No. 3,646,181 claiming “*sterile bottled water; drinking water with glucose*,” which has been registered since 2009. Through its affiliates, Nestlé has developed a high degree of fame in its GOOD START brand through the use of the GOOD START mark in commerce since as early as 1990.
3. Gerber is the leading infant and child nutrition company in the United States, with numerous nationally recognized brands, including the brand GOOD START, which has become widely associated with its line of infant formulas.

4. Upon information and belief, Respondent is a corporation organized under the laws of Delaware, with its principal place of business at 204 North Main Street, Gordonsville, Virginia 22942.

5. Respondent applied to register the FIRST START Mark on April 11, 2013 on an intent-to-use basis in connection with “*infant formula*.” The prosecution history for Respondent’s Mark indicates that there was no Office Action issued in response to this application, and no prior applications or registrations were cited against Respondent’s Mark during prosecution despite the existence of Petitioner’s GOOD START Mark, which is registered for the exact same goods (*i.e.*, infant formula). A Notice of Allowance was issued for Respondent’s Mark on October 29, 2013 and, accordingly, upon Respondent’s submission of a Statement of Use, it is expected that Respondent’s Mark will pass to registration in due course.

6. Given Petitioner’s rights in the highly similar GOOD START Mark for identical goods and the fact that the GOOD START Mark was not cited against Respondent’s FIRST START Mark during prosecution, Petitioner believes that the Notice of Allowance was issued in error.

7. Petitioner will be irreparably damaged if Respondent’s Mark is permitted to register. Indeed, Respondent’s registration for and use of Respondent’s FIRST START Mark is likely to and will cause consumer confusion as to the source, affiliation and/or sponsorship of Respondent’s products, which are identical to the products offered by Petitioner under the GOOD START Mark, and is likely to and will dilute the distinctiveness of the GOOD START trademark.

8. Accordingly, Petitioner requests that the Board exercise its inherent power to reconsider prior decisions and correct errors by cancelling U.S. Application Number 85/901,669

and cancelling the related Notice of Allowance. *See Macktal*, 286 F.3d at 825-26 (stating that agencies have the inherent authority to “reconsider” prior decisions); *The Last Best Beef, LLC*, 506 F.3d at 340 (“[T]he USPTO’s authority [to cancel or suspend the trademark registrations, applications, and Notices of Allowance] need not derive from [statutory authority]. The authority comes from the USPTO’s inherent discretion to correct its own errors and to manage its own docket.”).

Likelihood of Confusion with Petitioners’ GOOD START Mark
(Section 2(d), 15 U.S.C. § 1052(d))

9. Petitioner repeats and re-alleges each and every allegation set forth in Paragraphs 1-9.

10. Petitioner’s GOOD START Mark is highly similar in sight, sound, spelling, connotation and commercial impression to Respondent’s FIRST START Mark.

11. Other than Respondent’s FIRST START application, Petitioner’s GOOD START Mark and related marks are the only U.S. trademark registrations for infant formula using the word “START” which act as a brand name for products. Respondent’s FIRST START Mark is therefore especially confusing since Petitioner’s GOOD START Marks are currently the only “START” registrations in this field of products.

12. The similarities between Petitioner’s GOOD START Mark and the Respondent’s FIRST START Mark are particularly pronounced given the identical nature of the goods claimed in the application for the Respondent’s Mark (*i.e.*, “*infant formula*”) as compared to the goods claimed in connection with the GOOD START Mark (*i.e.*, also “*infant formula*”), both in International Class 05.

13. Because Respondent’s goods are identical to Petitioner’s goods, its consumers and channels of trade are also identical.

14. Respondent adopted its highly similar mark for identical goods many years after Petitioner established national use and promotion of the GOOD START Mark for its goods. Accordingly, on information and belief, Respondent modeled its trademark filing after the branding strategy established by Petitioner for the GOOD START Mark.

15. Respondent's adoption of a highly similar trademark in connection with identical goods duplicates the GOOD START Mark and Petitioner's branding strategy. As a result, Respondent's mark will inevitably lead consumers to mistakenly believe that Petitioner is the source of Respondent's goods and that Respondent is affiliated with, endorsed by, or sponsored by Petitioner, all in violation of Petitioner's rights in the GOOD START Mark.

16. For the foregoing reasons, Petitioners believe and allege that it will be damaged by the registration of the Respondent's Mark and that the Notice of Allowance and application for the Respondent's Mark (Serial No. 85/901,669) should be cancelled.

Likelihood of Confusion with Petitioners' Common Law Rights
(Section 2(d), 15 U.S.C. § 1052(d))

17. Petitioner repeats and re-alleges each and every allegation set forth in Paragraphs 1-16.

18. As the exclusive licensee of the GOOD START Mark, Petitioner actively uses the GOOD START Mark in connection with its infant formula products. Based on Gerber's widespread and continuous use of the GOOD START Mark in U.S. commerce, the GOOD START Mark clearly and unmistakably indicates to consumers that Gerber is the source of such goods. Accordingly, Gerber owns strong common law trademark rights in the GOOD START Mark, and Gerber has not abandoned these common law rights.

19. Gerber's rights in the GOOD START Mark were established well prior to the filing date of Respondent's Mark, which is stated as April 11, 2013. Gerber therefore has priority based on its prior and subsisting use of the GOOD START Mark.

20. Respondent's Mark is highly similar to the GOOD START Mark in that it is predominated by the term "START" and is a composite mark that only includes one additional commonly used word (*i.e.*, FIRST). The GOOD START Mark similarly includes the term "START" and is a composite mark that only includes one additional commonly used word (*i.e.*, GOOD). Consequently, the respective marks are highly similar in sight, sound and commercial impression.

21. The highly similar nature of the GOOD START Mark and Respondent's Mark in sight, sound and commercial impression is particularly pronounced given the identical nature of the goods claimed in the application for the Respondent's Mark.

22. As a result, the goods and services, the relevant consumers and the channels of trade of the senior GOOD START Mark and Respondent's FIRST START Mark are identical.

23. Respondent adopted the FIRST START Mark years after Gerber established use and promotion of the GOOD START Mark and presumably after encountering the GOOD START Mark in the marketplace. Consequently, on information and belief, Respondent modeled its trademark filings after the branding strategy established by Gerber for the GOOD START Mark.

24. Respondent's junior use of a highly similar trademark for identical goods overlaps and duplicates the GOOD START Mark and Gerber's branding strategy. Such use will inevitably lead consumers to mistakenly believe that Gerber is the source of Respondent's goods

and that Respondent is affiliated with, endorsed by or sponsored by Gerber, all in violation of Gerber's rights in the GOOD START Mark.

25. For the foregoing reasons, Petitioner believes and alleges that it is being and will be damaged by the registration of Respondent's Mark (Serial No. 85/901,669), and accordingly, the application for Respondent's Mark and the Notice of Allowance that was issued in connection therewith should be cancelled.

Trademark Dilution by Blurring (Section 43(c), 15 U.S.C. § 1125(c))

26. Petitioner repeats and re-alleges each and every allegation set forth in Paragraphs 1-25.

27. Respondent has applied to register a mark that is highly similar to the GOOD START Mark, which Petitioner has used, or which has been used by a predecessor in interest in U.S. commerce for at least 20 years.

28. The GOOD START Mark has acquired distinctiveness through a long period of continuous and prominent use and readily identifies Petitioner as the source of the goods and services that Petitioner provides.

29. The GOOD START Mark is famous due to the duration, extent and geographical reach of Petitioner's advertising, publicity and long-standing use. Indeed, the GOOD START Mark is well-known and has a high degree of recognition amongst the consuming public in the United States.

30. The GOOD START Mark became famous before Respondent's first use of Respondent's Mark. Indeed, the application for Respondent's Mark was filed on an intent-to-use basis, and it is a showing of use that is currently preventing Respondent's Mark from achieving

registered status. On information and belief, Respondent has not yet begun use of Respondent's Mark.

31. On information and belief, Respondent was aware of the GOOD START Mark when it applied to register Respondent's Mark.

32. Respondent's application to register Respondent's FIRST START Mark and Respondent's use of this mark will impair the distinctiveness of the GOOD START Mark and will cause irreparable injury to Petitioner's business and reputation.

33. Petitioner will be damaged if Respondent's Mark is permitted to register, because such registration will support and assist Respondent in the diluting use of Respondent's Mark and will give color of rights to Respondent, all in violation of Petitioner's superior statutory and common law rights in the GOOD START Mark to the detriment and harm of Petitioner.

34. Accordingly, because Respondent's use of Respondent's Mark is likely to cause trademark dilution by blurring, the application for Respondent's Mark and Notice of Allowance that was issued in connection therewith should be cancelled pursuant to 15 U.S.C. § 1125(c).

35. WHEREFORE, Petitioner respectfully request that application Serial No. 85/901,669 and the Notice of Allowance that was issued for this application be cancelled due to a likelihood of confusion and dilution and that judgment in this present cancellation be entered in favor of Petitioner and against Respondent, with prejudice.

Dated: April 23, 2014

Respectfully submitted,

SOCIÉTÉ DES PRODUITS NESTLÉ S.A and
GERBER PRODUCTS COMPANY

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CERTIFICATE OF SERVICE

I, A. John P. Mancini, hereby certify that on April 23, 2014, I caused true and correct copies of the foregoing document entitled PETITION FOR CANCELLATION to be served upon the following, via first class mail, postage prepaid:

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and

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/s/ A. John P. Mancini
A. John P. Mancini

FEES DUE

Attorneys for Petitioner hereby authorize the filing fee for this Cancellation Action to be deducted from Mayer Brown's Deposit Account in the amount of \$300. Confidential Deposit Account information is as follows:

ID: 130019

PIN: 

Attorneys for Petitioner hereby request that the foregoing Deposit Account information be removed or redacted prior to any public filing of this document.