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

Proceeding	86081774
Applicant	Vitamin Shoppe Procurement Sevices, Inc.
Applied for Mark	CARB SHREDDER
Correspondence Address	TODD BRAVERMAN PEARL COHEN ZEDEK LATZER BARATZ LLP 1500 BROADWAY, 12TH FLOOR NEW YORK, NY 10036-4068 UNITED STATES tm-uspto@pearlcohen.com
Submission	Applicants Request for Remand and Amendment
Attachments	Motion to Suspend Ex Parte Appeal and Remand to Examining Attorney - Carb Shredder.pdf(78193 bytes ) Mutual Trademark Consent and Coexistence Agreement - CARB SHREDDER - Final Executed.pdf(196684 bytes )
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Date	05/07/2015

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

In re Vitamin Shoppe Procurement Services, Inc.

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Applicant: Vitamin Shoppe Procurement Services, Inc.)	Examining Attorney:
Serial No.: 86081774 )	Anthony M. Rinker
Filed: October 3, 2013 )	Law Office 102
Mark: CARB SHREDDER )	Date: May 7, 2015
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United States Patent & Trademark Office  
Trademark Trial & Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**MOTION TO SUSPEND *EX PARTE* APPEAL AND  
REMAND TO EXAMINING ATTORNEY  
PURSUANT TO 37 CFR § 2.142(d)**

Applicant, Vitamin Shoppe Procurement Services, Inc., filed an *ex parte* appeal to the Trademark Trial & Appeal Board (“TTAB”) on February 2, 2015 appealing the refusal to register the mark CARB SHREDDER, U.S. Application Serial No. 86081774 for “vitamin, mineral, dietary and nutritional supplements for weight loss,” in International Class 05.

Applicant also filed a Request for Reconsideration of the refusal under Section 2(d) on February 2, 2015 based upon U.S. Registration No. 4414832, for the mark SHREDDER for “dietary supplements,” in International Class 05, owned by Total Body Nutrition, LLC.

The Examining Attorney denied the Request for Reconsideration on March 4, 2015 and the TTAB issued an order dated March 9, 2015 resuming proceedings and allowing Applicant until sixty days from March 9, 2015 in which to file its brief.

Applicant and Total Body Nutrition, LLC entered into a Mutual Trademark Consent and Coexistence Agreement, effect as of March 15, 2015, but executed on May 7, 2015, whereby Total Body Nutrition, LLC consented to the use and registration by Applicant of Applicant's mark CARB SHREDDER, U.S. Application Serial No. 86081774. Attached, please find a copy of the Mutual Trademark Consent and Coexistence Agreement executed by Applicant and Total Body Nutrition, LLC.

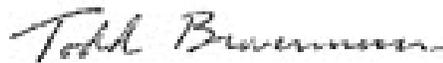
Based upon Applicant and Total Body Nutrition, LLC executing a Mutual Trademark Consent and Coexistence Agreement relating to Applicant's use and registration of the mark CARB SHREDDER, Applicant hereby moves the TTAB, pursuant to 37 CFR § 2.142(d), to suspend the *ex parte* appeal and remand U.S. Application Serial No. 86081774 to the Examining Attorney for further examination and withdrawal of the Section 2(d) refusal based upon the parties agreeing to consent to each other's' respective marks and co-exist without creating a likelihood of confusion. As indicated in TBMP Section 1207.02, consent agreements offered in response to a refusal to register under Trademark Act § 2(d), 15 U.S.C. § 1052(d), are inherently difficult and time-consuming to obtain, and may be highly persuasive of registrability. Accordingly, Applicant requests that the Examining Attorney reconsider and withdraw the likelihood of confusion refusal under Section 2(d), 15 U.S.C. § 1052(d).

Applicant's request for suspension and remand is made upon good cause due to such evidence not being available prior to Applicant filing the Notice of *ex parte* Appeal on February 2, 2015. Applicant, upon the Examining Attorney's denial of Applicant's Request for Reconsideration, contacted prior Registrant, Total Body Nutrition, LLC, in order to discuss a mutual consent and coexistence agreement of the CARB SHREDDER mark based upon Applicant's prior use in

commerce. After negotiations between the parties, the parties finalized and executed the Mutual Trademark Consent and Coexistence Agreement on May 7, 2015.

The foregoing request is not being filed for the purpose of mere delay of proceedings, and favorable consideration of this request is respectfully solicited.

Respectfully submitted,



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Todd Braverman  
Counsel for Applicant  
Pearl Cohen Zedek Latzer Baratz LLP  
1500 Broadway, 12<sup>th</sup> Floor  
New York, NY 10036  
(646) 878-0820

Dated: May 7, 2015

## MUTUAL TRADEMARK CONSENT AND COEXISTENCE AGREEMENT

This **MUTUAL TRADEMARK COEXISTENCE AND CONSENT AGREEMENT** ("Agreement"), effective as of March 15, 2015 ("Effective Date") is made by and between Vitamin Shoppe Procurement Services, Inc., a Delaware corporation with a place of business at 2101 91st Street, North Bergen, NJ New Jersey 07047 (herein after "Vitamin Shoppe") and Total Body Nutrition, LLC, a New York limited liability company located at 11 Meade Avenue, Bethpage, NY 11714 (herein after "TBN"). Vitamin Shoppe and TBN may be individually referred to herein as "Party" or collectively as "Parties."

**WHEREAS**, Vitamin Shoppe owns the mark CARB SHREDDER, U.S. Application Serial No. 86081774, for "vitamin, mineral, dietary and nutritional supplements for weight loss," in International Class 05;

**WHEREAS**, TBN owns U.S. Registration No. 4414832 for the mark SHREDDER, for "dietary supplements," in International Class 05;

**WHEREAS**, Vitamin Shoppe filed U.S. Application Serial No. 86081774 for the mark CARB SHREDDER on October 3, 2013 and commenced use of the mark in commerce at least as early as July 2, 2007;

**WHEREAS**, TBN commenced use of the mark in commerce at least as early as April 1, 2012 and filed a U.S. trademark application for the mark SHREDDER on March 8, 2013;

**WHEREAS**, the United States Patent & Trademark Office refused registration of the mark CARB SHREDDER, U.S. Application Serial No. 86081774, based upon the mark creating a likelihood of confusion with U.S. Registration No. 4414832 for the mark SHREDDER under Section 2(d) of the Lanham Act;

**WHEREAS**, Vitamin Shoppe filed a Request for Reconsideration to the USPTO requesting withdrawal of the likelihood of confusion refusal under Section 2(d) and a Notice of Appeal to the Trademark Trial & Appeal Board ("TTAB") reserving Vitamin Shoppe's right to appeal the decision of the USPTO;

**WHEREAS**, the USPTO denied the Request for Reconsideration of the Final Refusal and the TTAB gave Vitamin Shoppe until May 8, 2015 to file an ex parte Appeal to the refusal to register under Section 2(d);

**WHEREAS**, the parties wish to set forth guidelines that would address the simultaneous use and registration of the CARB SHREDDER and SHREDDER marks and any perceived likelihood of consumer confusion between the respective marks, both now and in the future; and

**WHEREAS**, the Parties have compared their respective marks and goods and services and have agreed that confusion as to source of origin is unlikely.

**NOW, THEREFORE**, for good and valuable consideration, it is agreed as follows:

1. The Parties agree that there is no likelihood of confusion or conflict between Vitamin Shoppes' use and registration of CARB SHREDDER and TBNs use and registration of the SHREDDER mark, when in simultaneous use in connection with the respective goods and services of the Parties, as described above.

2. TBN consents to the adoption, use and registration by Vitamin Shoppe of the CARB SHREDDER Mark, and consents to the adoption, use and registration of marks by Vitamin Shoppe incorporating SHREDDER with additional words.

3. Vitamin Shoppe consents to the continued use and registration by TBN of the SHREDDER Mark.

4. ~~TBN agrees not to use, expand its use or register the SHREDDER to other marks incorporating SHREDDER with additional words.~~ AS

5. Vitamin Shoppe and TBN agree to cooperate with each other so as to eliminate any confusion that may develop in the future as a result of the concurrent use of the above-described trademarks.

6. VITAMIN SHOPPE and TBN agree that in the unlikely event that an instance of actual confusion is brought to the attention of either VITAMIN SHOPPE or TBN, the Party who learns of such confusion will immediately inform the other, or a designated agent of the other, so that necessary measures can be taken to insure that further instances of confusion will not occur.

7. In the event that either Party abandons its respective trademarks, the other Party shall have the right to terminate this Agreement by providing the abandoning Party with written notice of its intent to terminate the Agreement. However, such written notice shall not have the effect of termination if the abandoning Party responds in writing within thirty days and demonstrates that the mark of said Party has not been abandoned.

8. Subject to each Party's compliance with the provisions hereof, the Parties agree that they shall not, now or in the future, challenge or attempt to cancel, or assist others in challenging or attempting to cancel each other's rights to their respective marks or any similar iterations thereof and any future applications or registrations therefor.

9. The Parties agree that this Agreement and any documents to be executed pursuant thereto, together constitute the complete statement of all the arrangements among the Parties with respect to their subject matter, and may not be amended, altered, modified or otherwise changed in any respect except in writing signed by all Parties.

10. If any terms of this agreement are held to be unlawful by a court of competent jurisdiction, such a finding shall in no way affect the remaining obligations of the Parties hereunder.

11. The Parties acknowledge that they are acting on behalf of, and that this Agreement shall bind and benefit, the Parties and their respective successors, assigns, parents, subsidiaries, affiliates and licensees and all others acting by, through, or with them, or under their direction or in privity with them.

12. The Parties represent and warrant that they have the capacity and right to enter into this Agreement.

13. Nothing in this Agreement is intended to be or shall be construed as a license or other permission from either Party to the other Party to use the Party's trademarks and each Party owns and retains all right, title and interest in and to each Party's respective trademarks and all intellectual property and proprietary rights associated with any of the marks identified herein. Each Party shall take, at the other Party's expense, such action (including execution of affidavits or other documents) as the other Party may reasonably request to effect, perfect or confirm such other Party's ownership interests and other rights as set forth above in this Section.

14. The failure of a Party to insist upon strict adherence to any term of this Agreement on any occasion will not be considered a waiver or deprive or limit that party of the right thereafter to insist upon strict adherence to that term in the particular instance or that term or any other term of this Agreement in any instance. Any waiver must be in writing.

15. The Parties have entered into this Agreement as independent contractors only, and nothing contained in this Agreement places or shall be construed to place the Parties in the relationship of legal representation, employer-employee, partners, joint venturers, or agency, and neither Party will have the power or authority to obligate or bind the other Party in any manner.

16. This Agreement may be executed in any number of counterparts with the same effect as if the signatures were upon the same instrument. The receipt and exchange of such counterparts by fax or portable document format (.pdf) will be considered sufficient for the purposes of execution hereunder, and such counterparts taken together shall constitute one Agreement. Execution of a faxed or .pdf copy will have the same force and effect as execution of an original, and a .pdf or faxed signature will be deemed an original and valid signature. Each individual executing this Agreement on behalf of any party represents and warrants that he or she has the right, power, and authority to execute this Agreement on behalf of; and to bind, such party.

17. This Agreement shall be worldwide in scope and shall remain in force and effect as long as both parties, or their successors or assigns are using, or have a bona fide intent to use, their respective marks.

18. The restrictions and obligations of this Agreement shall be construed in accordance with and shall be governed by the laws of the State of New York without recourse or regard to New York conflicts of laws principles.

**IN WITNESS WHEREOF** the Parties have executed this Mutual Trademark Consent and Coexistence Agreement as of the date and year first written above.

**VITAMIN SHOPPE PROCUREMENT SERVICES, INC.**

5/7/15  
Date

  
By: Jean Friedman  
Title: General Counsel

**TOTAL BODY NUTRITION, LLC**

05/06/15  
Date

  
By: M. ISLAM  
Title: CEO