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

Proceeding	91184700
Party	Plaintiff NBTY, Inc.
Correspondence Address	Scott B. Fisher Jaspan Schlesinger Hoffman LLP 300 Garden City Plaza Garden City, NY 11530 UNITED STATES SFisher@jaspanllp.com
Submission	Motion to Suspend for Settlement Discussions
Filer's Name	Scott B. Fisher
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Signature	/SBF/
Date	06/02/2009
Attachments	NBTYPhytoTechConsentMotSuspendExtend(060209).pdf (18 pages)(377728 bytes)

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

NBTY, Inc.,	X	
	:	
Opposer,	:	
	:	
vs.	:	Opposition Nos.: 91/184,700
	:	91/184,702
Phyto Tech Corp.,	:	91/184,703
	:	
Applicant.	:	
	X	

**CONSENT MOTION TO SUSPEND AND EXTEND AND RE-SET DISCOVERY
AND TRIAL TESTIMONY PERIODS**

Opposer, NBTY, Inc. (“Opposer” or “NBTY”), with the consent of applicant, Phyto Tech Corp. (“Applicant” or “Phyto Tech”), respectfully submits this motion, pursuant to 37 C.F.R. §§ 2.117(c), 2.120(a) and 2.121(a), TBMP §§ 509 and 510 (2d Ed., Rev. March 2004) and Fed. R. Civ. P. 6(b)(1)(A), for an order suspending proceedings for at least a fourteen (14) day period pending settlement and extending and re-setting the discovery and trial testimony periods in this matter accordingly. It is respectfully submitted that good cause exists for the relief requested herein, in that the parties have negotiated the terms of a settlement of this matter; that several versions of the proposed settlement agreement have been exchanged between the parties; that the parties are currently working on final language in the proposed settlement agreement to memorialize their agreement; and it is anticipated that the settlement agreement will be finalized and executed in the near future.

PROCEDURAL HISTORY

The facts and circumstances showing good cause for the relief requested herein are set forth at length in the accompanying Declaration of Scott B. Fisher (“Fisher Decl.”), to which the

Trademark Trial and Appeal Board (the “Board”) is respectfully referred. A summary of the salient points follows below.

NBTY is the owner, by recorded assignment, of all right, title and interest in U.S. Registration No. 1,813,366, registered on December 28, 1993, on the Principal Register for the mark GOOD 'N NATURAL (the “GOOD 'N NATURAL Mark”) for vitamins and nutritional supplements, in International Class 005. Affidavits under Sections 8 (15 U.S.C. § 1058), 9 (15 U.S.C. § 1059) and 15 (15 U.S.C. § 1065) of the Trademark Act were filed, accepted and acknowledged by the United States Patent and Trademark Office (“USPTO”).

On June 18, 2008, NBTY filed Notices of Opposition seeking to oppose the registration of Applicant’s GOOD 'N SWEET marks, United States Serial Application Nos. 77/427,750, 77/367,538, and 77/375,600, on the grounds that such marks are confusingly similar in appearance, sound, spelling, connotation and commercial impression to NBTY’s GOOD 'N NATURAL Mark, and that the use and registration of Applicant’s marks will dilute the distinctive quality of the GOOD 'N NATURAL Mark.

In response to the Notices of Opposition filed by NBTY, counsel for NBTY and Applicant commenced a dialogue in an effort to amicably resolve the three opposition proceedings. Based on the progress of those discussions, in or about July 2008, Applicant filed preliminary amendments with the USPTO and the Board seeking to amend its mark from “GOOD 'N SWEET” to “GOOD & SWEET” in each of its three separate trademark applications.

On or about September 15, 2008, the undersigned counsel for NBTY advised the Board that NBTY had not yet then agreed to consent to the proposed amendment but that NBTY was expected to do so once the parties were able to agree to terms of settlement of the three

opposition proceedings. By Order, dated September 19, 2008 (*see* TTABVUE Prosecution History No. 6), the Board consolidated the three opposition proceedings, with Opposition No. 91,184,700 treated as the “parent” case; suspended proceedings for three (3) months (until December 20, 2008); and re-set the discovery and testimony periods accordingly in the consolidated opposition proceeding.

Thereafter, the parties continued settlement discussions and reached a settlement in principle subject to the acceptance of a mutually satisfactory settlement agreement. In furtherance of the settlement, on or about December 1, 2008, the parties submitted Consent Agreements in each of the three separate trademark applications filed by Applicant, whereby NBTY consented to the proposed amendment of Applicant’s marks from “GOOD ‘N SWEET” to “GOOD & SWEET” (collectively, all three applications, as amended, are referred to herein as “Applicant’s Marks”).

As the parties were making progress on settlement discussions, on or about December 22, 2008, the parties filed a consent motion to suspend proceedings for sixty (60) days pending settlement. *See* TTABVUE Prosecution History No. 8. By Order, dated December 22, 2008, the Board granted the consent motion and suspended proceedings until February 20, 2009. *Id.* at No. 9.

On January 10, 2009, the Board approved the proposed amendments to Applicant’s Marks, subject to Applicant submitting a new drawing for each application showing the modified marks within twenty (20) days thereof. *See* TTABVUE Prosecution History No. 10. In response to the Board’s Order, on or about January 13, 2009, Applicant submitted the modified drawings of its GOOD & SWEET mark.

On February 12, 2009, the Board issued an Order (*see* TTABVUE Prosecution History

No. 12) approving and entering the amendments to Applicant's Marks. In addition, the Board gave NBTY thirty (30) days to file a withdrawal of the opposition proceedings if the acceptance of the amendments resolved the dispute between the parties.

On or about March 17, 2009, the undersigned counsel for NBTY notified the Board that although the parties were continuing to negotiate in good faith, they needed additional time to finalize their agreement and requested, with the consent of counsel for Applicant, that proceedings be suspended for another fourteen (14) days. *See* TTABVUE Prosecution History No. 13. On May 5, 2009, the Board issued an Order (a copy of which is attached as Exhibit "A" to the Fisher Declaration) suspending proceedings until June 1, 2009, and finding that any further requests for extensions or suspension must set forth a written report on the progress of settlement talks to establish good cause therefor.

Over the last several months, several versions of the proposed Settlement and Coexistence Agreement ("Agreement") have been exchanged between the parties and counsel, with agreement reached in each version as to key settlement terms. Currently, there remains one outstanding issue in the language of the Agreement (relating to the scope of the use of the GOOD & SWEET marks and any limitation thereto) which the parties are diligently working to resolve. The most recent version of the Agreement was exchanged on June 1, 2009, in an effort to resolve the last remaining issue. It is anticipated that the Agreement should be finalized in the immediate future and executed shortly thereafter.

ARGUMENT

GOOD CAUSE EXISTS TO SUSPEND PROCEEDINGS AND TO EXTEND AND RE-SET THE DISCOVERY AND TRIAL TESTIMONY PERIODS

The parties respectfully submit that good cause exists warranting the relief requested herein.

The Board has held that, “[o]rdinarily, the Board is liberal in granting extensions of time before the period to act has elapsed, as long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused.” American Vitamin Products, Inc. v. Dow Brands, Inc., 22 U.S.P.Q.2d 1313, 1992 TTAB LEXIS 10 *8 (TTAB 1992).

Under the Board’s Order, dated May 5, 2009, discovery is not set to close until August 18, 2009. In its May 5, 2009 Order, the Board held that, “[f]urther requests for extensions or suspension must be accompanied by a written report on the progress of their settlement talks, to establish good cause therefor.” *See* Fisher Decl., Exhibit “A”, p. 2. The Board further held that the written report must include “a recitation of issues that have been resolved, issues that remain to be resolved, and a FIRM timetable for resolution.” *Id.* (emphasis in original).

It is respectfully submitted that the “written report” requested by the Board showing good cause is set forth above in the Procedural History section and in the accompanying Fisher Declaration, to which the Board is respectfully referred. As discussed therein, the parties have had extensive settlement discussions which have culminated in a settlement in principle. The parties have been diligently working on drafting mutually acceptable language in the Agreement incorporating the agreed-upon terms of the settlement. The parties’ good faith in moving towards an amicable resolution of these consolidated matters is evidenced by the amendments to Applicant’s Marks which were consented to by NBTY. The parties have had some disagreement

over certain terms to be included in the Agreement, which has caused some delay in the completion of the Agreement. However, there currently remains essentially one outstanding issue in the Agreement which concerns the scope of the use of Applicant's Marks and any limitation thereto. However, on June 1, 2009, the parties exchanged the latest version of the Agreement containing language for eliminating the outstanding issue. As such, the parties believe that that remaining issue will be amicably resolved in the immediate future with acceptable language in the Agreement, and that the Agreement will be executed shortly thereafter.

It is respectfully submitted that the parties have shown good cause warranting the requested suspension and concurrent extension and re-setting of time requested herein. In addition, while several extensions have already been requested on consent, it is respectfully submitted that the privilege of extensions has not been abused by the parties herein and that the parties are diligently attempting to resolve all outstanding issues in each of the consolidated matters. The parties have constructively used the prior suspensions and extensions of time to reach a settlement in principle and are nearing completion of the Agreement incorporating the terms of settlement.

CONCLUSION

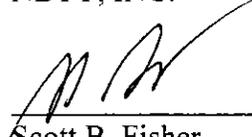
Based on the foregoing, it is respectfully requested that the Board grant the instant consent motion and suspend proceedings for at least fourteen (14) days and extend and re-set the discovery and trial testimony periods accordingly.

Dated: Garden City, New York
June 2, 2009

Respectfully submitted,

NBTY, INC.

By:



Scott B. Fisher
Jaspan Schlesinger LLP
300 Garden City Plaza
Garden City, New York 11530
(516) 746-8000

*Attorneys for Opposer,
NBTY, Inc.*

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

-----X		
NBTY, Inc.,	:	
	:	
Opposer,	:	
	:	
vs.	:	Opposition Nos.: 91/184,700
	:	91/184,702
Phyto Tech Corp.,	:	91/184,703
	:	
Applicant.	:	
-----X		

**DECLARATION IN SUPPORT OF CONSENT MOTION TO SUSPEND AND
TO EXTEND AND RE-SET DISCOVERY AND TRIAL TESTIMONY PERIODS**

SCOTT B. FISHER, an attorney duly admitted to practice law before the United States Supreme Court; the United States Courts of Appeal for the Federal, Second and Fourth Circuits; the United States District Courts for the Southern and Eastern Districts of New York and the Districts of New Jersey, Maryland and the District of Columbia; and before the Courts of the States of New York, New Jersey, Maryland, Virginia and the District of Columbia, declares, pursuant to 28 U.S.C. § 1746, the following to be true under the penalties of perjury:

1. I am a partner with the law firm of Jaspan Schlesinger LLP, attorneys for opposer, NBTY, Inc. (“Opposer” or “NBTY”), in the above-captioned opposition proceedings which have been consolidated by the Trademark Trial and Appeal Board (the “Board”). As such, I am familiar with the facts and circumstances in this matter, based upon a review of the material maintained by this law firm, as well as material publicly available, except where stated upon information and belief.

2. This Declaration is submitted in support of the parties’ consent motion, pursuant to 37 C.F.R. §§ 2.117(c), 2.120(a) and 2.121(a), TBMP §§ 509 and 510 (2d Ed., Rev. March

2004), and Fed. R. Civ. P. 6(b)(1)(A), for an order suspending proceedings for at least a fourteen (14) day period pending settlement and extending and re-setting the discovery and trial testimony periods in this matter accordingly. Counsel for applicant, Phyto Tech Corp. (“Applicant” or “Phyto Tech”), consents to the relief requested herein. The legal basis supporting the relief requested is set forth in the accompanying consent motion, to which the Board is respectfully referred. The purpose of this Declaration is to provide the Board with the procedural history of this matter, including the status of settlement discussions establishing good cause for the relief requested, and to reference and incorporate any relevant document for consideration of the instant motion.

3. NBTY is the owner, by recorded assignment, of all right, title and interest in U.S. Registration No. 1,813,366, registered on December 28, 1993, on the Principal Register for the mark GOOD 'N NATURAL (the “GOOD 'N NATURAL Mark”), for vitamins and nutritional supplements, in International Class 005. Affidavits under Sections 8 (15 U.S.C. § 1058), 9 (15 U.S.C. § 1059) and 15 (15 U.S.C. § 1065) of the Trademark Act were filed, accepted and acknowledged.

4. On June 18, 2008, NBTY filed Notices of Opposition opposing the registration of Applicant’s GOOD 'N SWEET marks, U.S. Serial Application Nos. 77/427,750, 77/367,538, and 77/375,600 (collectively, as amended, referred to as “Applicant’s Marks”), alleging that such marks are confusingly similar in appearance, sound, spelling, connotation and commercial impression to Opposer’s GOOD 'N NATURAL Mark, and that the use and registration of Applicant’s Marks will dilute the distinctive quality of the GOOD 'N NATURAL Mark.

5. In response to the Notices of Opposition filed by NBTY, counsel for NBTY and Applicant commenced a dialogue in an effort to amicably resolve the three opposition

proceedings. Based on the progress of those discussions, in or about July 2008, Applicant filed preliminary amendments with the United States Patent and Trademark Office and the Board seeking to amend its mark from “GOOD 'N SWEET” to “GOOD & SWEET” in each of its three separate trademark applications.

6. On or about September 15, 2008, the undersigned counsel for NBTY advised the Board that NBTY had not yet agreed to consent to the proposed amendments but that NBTY was expected to do so once the parties were able to agree to terms of settlement of the three opposition proceedings. By Order, dated September 19, 2008 (*see* TTABVUE Prosecution History No. 6), the Board consolidated the three opposition proceedings, with Opposition No. 91,184,700 treated as the “parent” case; suspended proceedings for three (3) months (until December 20, 2008); and re-set the discovery and testimony periods accordingly.

7. Thereafter, the parties continued settlement discussions and reached a settlement in principle subject to the acceptance of a mutually satisfactory settlement agreement. In furtherance of the settlement, on or about December 1, 2008, the parties submitted Consent Agreements in each of the three separate applications filed by Applicant, whereby NBTY consented to the proposed amendment of Applicant’s marks from “GOOD 'N SWEET” to “GOOD & SWEET”.

8. As the parties were making progress on settlement discussions, on or about December 22, 2008, the parties filed a consent motion to suspend proceedings for sixty (60) days pending settlement. *See* TTABVUE Prosecution History No. 8. By Order, dated December 22, 2008, the Board granted the consent motion and suspended proceedings until February 20, 2009. *Id.* at No. 9.

9. On January 10, 2009, the Board approved the proposed amendments to Applicant's Marks, subject to Applicant submitting a new drawing for each application showing the modified marks within twenty (20) days thereof. *See* TTABVUE Prosecution History No. 10. In response to the Board's Order, on or about January 13, 2009, Applicant submitted the modified drawings of its GOOD & SWEET mark.

10. On February 12, 2009, the Board issued an Order (*see* TTABVUE Prosecution History No. 12) approving and entering the amendments to Applicant's Marks. In addition, the Board gave NBTY thirty (30) days to file a withdrawal of the opposition proceedings if the acceptance of the amendments resolved the dispute between the parties.

11. On or about March 17, 2009, the undersigned counsel for NBTY notified the Board that although the parties were continuing to negotiate in good faith, they needed additional time to finalize their agreement and requested, with the consent of counsel for Applicant, that proceedings be suspended for another fourteen (14) days. *See* TTABVUE Prosecution History No. 13. On May 5, 2009, the Board issued an Order (a copy of which is attached hereto as Exhibit "A") suspending proceedings until June 1, 2009, and finding that any further requests for extensions or suspension must set forth a written report on the progress of settlement talks to establish good cause therefor.

12. In accordance with the Board's May 5, 2009 Order, this Declaration is intended as the written report establishing good cause for the relief requested herein. Over the last several months, several versions of the proposed Settlement and Coexistence Agreement ("Agreement") have been exchanged between the parties and counsel, with agreement reached in each version as to key settlement terms. Currently, there remains essentially one outstanding issue in the language of the Agreement (relating to the scope of the use of Applicant's Marks and any

limitations thereto) which the parties are diligently working to resolve. It is anticipated that the Agreement should be finalized in the immediate future and executed shortly thereafter.

13. The parties have had extensive settlement discussions which have culminated in a settlement in principle. The parties have been diligently working on drafting mutually acceptable language in the Agreement incorporating the agreed-upon terms of the settlement. The parties' good faith in moving towards an amicable resolution of these consolidated matters is evidenced by the amendments to Applicant's Marks which were consented to by NBTY. The parties have had some disagreement over certain terms to be included in the Agreement, which has caused some delay in the completion of the Agreement. However, there currently remains essentially one outstanding issue in the Agreement which concerns the scope of the use of Applicant's Marks and any limitation thereto. However, on June 1, 2009, the parties exchanged the latest version of the Agreement containing language for eliminating the outstanding issue. As such, the parties believe that that remaining issue will be amicably resolved in the immediate future with acceptable language in the Agreement, and that the Agreement will be executed shortly thereafter.

14. It is respectfully submitted that the parties have shown good cause warranting the requested suspension and concurrent extension and re-setting of time requested herein. In addition, while several extensions have already been requested on consent, it is respectfully submitted that the privilege of extensions has not been abused by the parties herein and that the parties are diligently attempting to resolve all outstanding issues in each of the consolidated matters. The parties have constructively used the prior suspensions and extensions of time to reach a settlement in principle and are nearing completion of the Agreement incorporating the terms of settlement.

WHEREFORE, it is respectfully submitted that good cause exists for the relief requested herein. As such, it is respectfully requested that the Board grant the consent motion and suspend proceedings for at least fourteen (14) days and extend and re-set the discovery and trial testimony periods accordingly.

I declare under the penalties of perjury that the foregoing is true and accurate.

Dated: Garden City, New York
June 2, 2009

Respectfully submitted,

NBTY, INC.

By:



Scott B. Fisher
Jaspan Schlesinger LLP
300 Garden City Plaza
Garden City, New York 11530
(516) 746-8000

*Attorneys for Opposer,
NBTY, Inc.*

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **CONSENT MOTION TO SUSPEND AND TO EXTEND AND RE-SET DISCOVERY AND TRIAL TESTIMONY PERIODS AND DECLARATION IN SUPPORT OF CONSENT MOTION** were served on the Attorneys for Applicant, Phyto Tech Corp., by electronic mail and by mailing a copy thereof, via U.S. First Class Mail, in a properly addressed, postage prepaid wrapper, addressed to Robert N. Behle, Jr., Esq., Foley Bezek Behle & Curtis, LLP, 575 Anton Boulevard, Suite 710, Costa Mesa, California 92626, on June 2, 2009.



SCOTT B. FISHER

EXHIBIT “A”

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

vw

Mailed: May 5, 2009

Opposition Nos. 91184700
91184702
91184703

NBTY, Inc.

v.

Phyto Tech Corp.

Frances S. Wolfson, Interlocutory Attorney:

Opposer's consented motion (filed March 17, 2009) to suspend proceedings to allow the parties to complete a proposed Settlement and Coexistence Agreement prior to advising the Board whether it wishes to withdraw the opposition in light of the amendments made to applicant's marks is granted.¹

Accordingly, proceedings herein are suspended until June 1, 2009, subject to the right of either party to request resumption at any time. See Trademark Rule 2.117(c).

¹The Board notes that opposer's motion does not indicate proof of service upon applicant as required by Trademark Rule 2.119. In order to expedite matters, a copy of opposer's motion is forwarded to applicant with its copy of the instant order, but strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.

In the event that there is no word from either party concerning the progress of their negotiations, upon conclusion of the suspension period, proceedings shall resume on **June 2, 2009** without further notice or order from the Board, upon the schedule set out below. Further requests for extensions or suspension must be accompanied by a written report on the progress of their settlement talks, to establish good cause therefor.

This report must include: a recitation of issues that have been resolved, issues that remain to be resolved, and a FIRM timetable for resolution. Absent such a report, any future motion to extend or suspend may not be approved, even though agreed to by the parties.

Expert Disclosures Due	7/19/09
Discovery Closes	8/18/09
Plaintiff's Pretrial Disclosures Due	10/2/09
Plaintiff's 30-day Trial Period Ends	11/16/09
Defendant's Pretrial Disclosures Due	12/1/09
Defendant's 30-day Trial Period Ends	1/15/10
Plaintiff's Rebuttal Disclosures Due	1/30/10
Plaintiff's 15-day Rebuttal Period Ends	3/1/10

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

If, during the suspension period, either of the parties or their attorneys should have a change of address, the Board should be so informed.