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

Proceeding	91219888
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

4Life Trademarks, LLC

Opposer,

v.

Senuvo LLC

Applicant.

Opposition No. 91219888

Serial No. 86127647

For the mark: SENUVO

Published for Opposition:
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**Opposer’s Motion Pursuant to Fed. R. Civ. P. 12(b)(6) to Dismiss Applicant’s
Counterclaim and Petition for Partial Cancellation for Failure to State a Claim**

Pursuant to Rule 12(b)(6), FED. R. CIV. P., Opposer 4Life Trademarks, LLC (“Opposer”), hereby moves to dismiss the partial cancellation counterclaim and petition (“Counterclaim”) brought by Applicant, Senuvo LLC (“Applicant”), for failure to state a claim on which relief can be granted. Applicant’s Counterclaim is an improper attempt to partially cancel Opposer’s registration of 4LIFE TRANSFER FACTOR RENUVO® (Reg. No. 4489645) (the “Registration”) by adding unduly restrictive and unnecessary language to the Registration’s identification of goods. Currently, the Registration covers “dietary and nutritional supplements; vitamin, mineral and herbal supplements.” Applicant attempts to avoid a finding of likely confusion by petitioning for partial cancellation of the Registration and adding the phrase “targeted for supporting healthy aging and daily stress management” to the end of the Registration’s identification of goods.

There is no plausible basis for Applicant’s Counterclaim, which makes only conclusory allegations and is unsupported by any valid factual or legal grounds. Specifically, Applicant’s proposed amendment to Opposer’s Registration (i) would do nothing to alleviate the likelihood of confusion; (ii) focuses narrowly on only two characteristics of Opposer’s supplements and would exclude other meaningful characteristics of the goods presently and appropriately covered by the registration; and (iii) is of “dubious commercial significance” and has been asserted “more for tactical reasons than substantive ones,” contrary to the standards set forth in governing case law. *Eurostar Inc. v. “Euro-Star” Reitmoden GmbH & Co.*, 34 U.S.P.Q.2d 1266, 1270 (TTAB 1994). “Allowing this kind of issue to be tried forces [Opposer] to spend time and money to defend [its] registration and requires [the Board] to decide the breadth or scope of a description

of goods or services in the abstract, unrelated to any determination of likelihood of confusion.” *Id.* at 1270-71. This motion is supported by the parties’ pleadings and the following memorandum of points and authorities.

Memorandum of Points and Authorities

I. Legal Background

To survive a motion to dismiss, Applicant’s counterclaim “must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face.” *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925 (TTAB 2014) (quoting *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009)). Further, Applicant “must allege well-pleaded factual matter and more than threadbare recitals of the elements of a cause of action, supported by mere conclusory statements.” *Id.* (quoting *Iqbal*, 556 U.S. at 678; citing *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)) (internal punctuation and quotation marks omitted). Applicant’s Counterclaim is completely implausible and contains nothing but threadbare recitals of a Section 18 partial cancellation claim.

In its *Eurostar* decision, the Board set forth the two elements of a claim for partial cancellation under Section 18, 15 U.S.C. § 1068. Specifically, to establish such a claim, Applicant must “plead and prove that (i) the entry of a proposed restriction to the goods or services in [Opposer’s Registration] will avoid a finding of likelihood of confusion; and (ii) [Opposer] is not using its mark on those goods or services that will be effectively excluded from the application or registration if the proposed restriction is entered.” *Eurostar*, 34 U.S.P.Q.2d at 1270 (granting motion to dismiss for failure to state a claim and finding that the proposed amendment to the registration was “unduly restrictive”); *see also* TBMP § 313.01 (“The counterclaimant must allege [i] that the partial cancellation will avoid a likelihood of confusion and [ii] that registrant does not use the mark on those goods or services for which deletion is being sought.”). As set forth below, Applicant’s Counterclaim fails *on its face* as to both prongs of the *Eurostar* test.

II. Applicant’s Proposed Restriction Would Not Avoid a Likelihood of Confusion.

Applicant’s Counterclaim is based on a proposed restriction to Opposer’s Registration, which is implausible on its face. Even if the Board were to accept Applicant’s proposed restriction, that would do nothing to eliminate the likelihood of confusion because there would still be a direct overlap of the goods listed in Applicant’s Application and the goods listed in Opposer’s Registration as amended in the manner proposed by Applicant.

The Board in *Eurostar* declared that it would “not exercise [its] authority under Section 18 to permit an action to restrict [a] registration where such a restriction is divorced from the question of likelihood of confusion.” *Id.* The Board also held that it would no longer “permit[] registrations to be attacked simply on the grounds that the statements of goods and services are overbroad.” *Id.* at 1271. Such a practice is “at odds with the Patent and Trademark Office practice of encouraging applicants to set forth their descriptions of goods in relatively broad terms.” *Id.*; see also TMEP § 1402.06(a) (indicating that “examining attorneys should not require or suggest unduly restrictive identifications”). Thus, the Board will not allow such a restriction “in the absence of a pleading and proof that a finding of likelihood of confusion can be avoided by such a restriction.” *Eurostar*, 34 U.S.P.Q.2d at 1270. The purpose of the requirement that an applicant plead and prove that the proposed “restriction will **avoid** a finding of likelihood of confusion [is] to ensure that the restriction is ‘commercially significant’ and that scarce judicial resources are being devoted to useful purposes.” *nVzn Development Corp. v. Quanta Corp.*, Canc. No. 23,582, 1996 TTAB LEXIS 477, *9 (TTAB Aug. 28, 1996) (emphasis in original).

In this case, Applicant seeks to partially cancel and to restrict Opposer’s Registration so that it covers only those dietary and nutritional supplements that are “targeted for supporting healthy aging and daily stress management.” In other words, Applicant seeks to restrict Opposer’s registration so that it references only two specific benefits (among many applicable ones, as outlined below) why consumers would use Opposer’s relevant supplements—(a) healthy aging and (b) stress management.¹ At the same time, the Class 5 goods listed in Applicant’s opposed Application contain no such restrictions and are instead phrased with broad and general health reasons, applicable to a wide range of products, as to why consumers would use Applicant’s relevant supplement products—namely, “for promoting general health,” “for nutritional purposes,” and “for therapeutic purposes.”²

¹ Although outside the evidentiary scope of this Motion, Opposer notes in passing that Applicant’s website claims that Applicant’s supplements are targeted toward stress management. Specifically, as of the date of this motion, Applicant’s own website claims that its supplement products, among other things, “help[] to reduce stress,” “minimize stress,” “reduce occasional stress levels,” and “ease the symptoms of stress.” See www.senuvo.com/products2.html. The fact that Applicant’s proposed “restriction” encompasses health benefits specifically referenced in Applicant’s own marketing demonstrates that Applicant’s counterclaim was asserted in bad faith.

² The following are the Class 5 goods listed in Applicant’s Application: “Dietary beverage supplements for human consumption in liquid and dry mix form **for therapeutic**

It is transparent that Applicant intends to limit Opposer’s registration artificially without legal justification for doing so, while maintaining a broad description of goods in Applicant’s own application. The illogic of Applicant’s proposed amendment is shown by the fact that Applicant’s broad description would still overlap with the unjustifiably narrow goods description that Applicant wants the Board to impose on Opposer’s Registration. This belies why any amendment such as that sought by Applicant would inevitably fail here—the products are so closely related in nature that any appropriate descriptions of the respective products would always continue to have some material overlap.

Applicant makes the conclusory and threadbare allegation that the proposed restriction to Opposer’s Registration “would eliminate any alleged likelihood of confusion between the parties’ marks.” Counterclaim ¶ 76. That allegation is not even plausible on its face. Even if the Board were to accept Applicant’s proposed restriction to Opposer’s Registration, there would still be a direct overlap of the parties’ listed goods. Specifically, even if Opposer’s Registration were narrowed to cover only supplements that are “targeted for supporting healthy aging and daily stress management” (in reality they cover much more than that), such a limitation still would be encompassed within Applicant’s “general health,” “nutritional,” and “therapeutic” purposes. And the products would still both be supplements directed to the same kind of consumers and generally for health, nutritional and/or therapeutic purposes. Thus, the proposed restriction would do nothing to alleviate the likelihood of confusion.

Importantly, Applicant fails to allege that its own products do not provide the benefits referenced in the proposed restriction. (Of course, Applicant’s own marketing materials would belie such an allegation. *See supra* note 1.) As a result, Applicant does not plead and could not establish that the proposed restriction would somehow accurately distinguish the parties’ goods and thereby avoid a likelihood of confusion in the marketplace.

The Board has repeatedly held that an applicant cannot avoid a finding of likelihood of confusion by narrowing the applicant’s listed goods as compared to a registrant’s goods that are broadly identified. TMEP § 1207.01(a)(iii) (“[I]f the cited registration has a broad identification of goods or services, an applicant does not avoid likelihood of confusion merely by more narrowly

purposes; Dietary supplement beverage for promoting general health and for nutritional purposes; Dietary supplemental drinks in the nature of vitamin and mineral beverages; Nutritionally fortified beverages; Soy protein for use as a nutritional supplement in various powdered and ready-to-drink beverages; Vitamin fortified beverages” (emphasis added).

identifying its related goods.”) (citing cases). The flipside is also true: confusion is still likely “where an applicant identifies its goods or services so broadly that the identification encompasses the goods or services identified in the registration.” *Id.*

Here, Applicant is even more brazen: Applicant is attempting to partially cancel Opposer’s Registration by limiting its identification of goods to narrow categories of “aging” and “stress,” even while Applicant attempts to claim broad rights in an identification that contains no such restrictions and that covers broad categories such as “general health purposes.” Applicant’s effort is both unsupported in the law and improper. Because Applicant’s proposed restriction *on its face* would not avoid a likelihood of confusion, Applicant’s counterclaim should be dismissed on that basis alone.

III. Applicant’s Restriction Excludes Goods with which Opposer Uses Its Mark.

Even if Applicant’s proposed restriction could avoid a likelihood of confusion (it cannot), Applicant’s Counterclaim still fails to state a claim. To establish a claim for partial cancellation to restrict Opposer’s Registration, in addition to avoiding a likelihood of confusion, Applicant also must plead and prove that Opposer “is not using its mark on those goods ... that will be effectively excluded from the ... registration if the proposed restriction is entered.” *Eurostar*, 34 U.S.P.Q.2d at 1270. In other words, Applicant must establish that the goods Opposer is offering under the registered mark include only those goods referenced in the identification as amended, to the exclusion of all other goods. *See Micro Nutrient LLC v. Thompson*, Canc. No. 92047584 (TTAB Feb. 24, 2009) (rejecting Section 18 petition seeking to amend identification from “health care” to “audio therapy services” because nothing suggested that the registrant was “solely engaged in ‘audio therapy services’ to the exclusion of other services in the field of health care).

Here, Applicant does not even attempt to allege (nor can it prove) that Applicant’s proposed restriction would avoid excluding goods (or characteristics of goods) that Opposer offers and sells under its registered mark. Even if Applicant had made such an allegation, it too would be implausible on its face. Applicant’s proposed restriction clearly excludes characteristics of goods that Opposer offers and sells under its registered mark. Once again, Applicant’s proposed restriction references only two benefits associated with Opposer’s relevant supplements—namely, healthy aging and stress management. Applicant does not allege that Opposer’s supplements offered under its registered mark have only these benefits, or that they are targeted only to healthy aging and stress management, to the exclusion of all other benefits. Indeed, as Applicant was well aware through a review of the Notice of Opposition, Opposer indicates that supplements offered

under its registered mark are formulated to support the following: mental acuity, sexual vitality, energy, mood, metabolism as well as total body recovery. *See* Notice of Opposition ¶ 39.

Applicant arbitrarily selected some benefits of Opposer's product, while ignoring others, for the proposed restriction, in order to try to pigeon hole Opposer's product into a category that Applicant may claim it does not specifically focus on in marketing of its own products. Of course, Applicant's attempted distinction is in fact contrary to Applicant's own marketing efforts. *See supra* note 1. Applicant's proposed restriction also is cynical because the overall benefits of Opposer's product are similar to and in key ways overlap with things that Applicant claims that its products provide. *See* Notice of Opposition ¶ 39.

Applicant just as easily could have selected for its amendment various other benefits of Opposer's product. However, any alternative proposed restrictions also would have been equally improper and for naught here because Applicant already has admitted the existing overlap. Specifically, Applicant's admissions establish that (1) these products are both of the same basic type, dietary and nutritional supplements (Applicant's Answer ¶ 8); (2) they are both being marketed in the same manner, through direct marketing (*id.* ¶ 36); and (3) they are both intended to provide some of the same benefits (e.g. healthy immune system) (*id.* ¶ 36). Any restriction here aimed at narrowing the description of either Applicant's goods or Opposer's goods would merely create a distinction without a difference in terms of likelihood of confusion and would be futile. Because Applicant's proposed restriction would necessarily exclude goods (or at least characteristics of goods) that are and should be covered by Opposer's Registration, Applicant's Counterclaim fails to state a claim and should be dismissed on that basis.

Applicant admits that it offers and sells dietary and nutritional supplements, including weight management products. Answer ¶ 8. Similar to Opposer, Applicant admits that its products support a healthy immune system. *Id.* ¶ 36. Applicant also admits that it markets and sells its products using a direct sales or MLM platform, *see id.* ¶ 38, which is very similar or identical to how Opposer offers and sells its products. Thus, where Applicant already has admitted overlap of the products and the channels of trade, allowing Applicant to try to come up with another commercially insignificant (or non-existence) distinction would be futile.

IV. Applicant's Restriction Is Unworkably Narrow and Commercially Insignificant.

Perhaps most significantly, Applicant's proposed restriction lacks any meaningful commercial significance and is unduly restrictive on its face. The Board in *Eurostar* warned against

asserting partial cancellation claims based on proposed restrictions that were of “dubious commercial significance” and that are “made more for tactical reasons than substantive ones.” *Eurostar*, 34 U.S.P.Q.2d at 1270. The Board also held that Section 18 cannot be used “to restrict applications and registrations to unworkably narrow descriptions of goods and services.” *Id.* at 1271. Here, it is apparent from the face of Applicant’s Counterclaim that Applicant’s proposed restriction is unworkably narrow and has been asserted more for tactical reasons than substantive reasons.

The Board in *Eurostar* held that allowing an applicant to attack a registration by narrowing its coverage to certain specific characteristics of the goods or their methods of sale would have disastrous effects. Quoting the respondent in that case, the Board in *Eurostar* stated:

Does this mean that a registration covering “dress shirts,” for example, can be restricted under Section 18 to “dress shirts sold only in men’s clothing stores”; or that “gold watches” can be restricted to “gold watches sold only by fine jewelers”? If all of these are possibilities, then every time an applicant is rejected by an examiner based on an existing registration, it can petition the Board to narrow a registration to the absolutely specific items and methods of sale that a registrant has made to date. Not only would this overwhelm the Board with petitions for partial cancellation, but it would make most registrations subject to challenge because there always will be some way to specifically describe exactly how a registrant is using its mark.

Id. at 1270. The Board held that “[a]llowing this kind of issue to be tried forces registrants needlessly to spend time and money to defend their registrations and requires us to decide the breadth or scope of a description of goods or services in the abstract, unrelated to any determination of likelihood of confusion.” *Id.* at 1270-71. As a result, the Board rejected an attempt to impose “unduly restrictive” description and granted the respondent’s motion to dismiss. *Id.* at 1271-1273.

The concurring opinion in *Eurostar* by Judge Simms also used identical language, as quoted above. *Id.* at 1274 (Simms, J., concurring). He further stated that a registrant cannot be subject to a claim for partial cancellation simply “because it may not have used its mark on all conceivable goods encompassed within a description (in connection with, say, all types of ‘men’s shirts’) or in all of the channels of trade possible for those goods.” *Id.* at 1273 n.2. Judge Simms also gave examples of proposed restrictions that should be rejected on their face, and which are directly relevant to this case: (1) an applicant for COCA-COLA for fruit drinks seeking to partially cancel the registration for COCA-COLA® by amending the description of goods to “carbonated cola beverages and syrups not containing fruit juices of fruit flavoring; (2) an amendment from “sauces” to “tomato sauces”; (3) an amendment from “board games” to “real estate board games”; and, most relevant, (4) **an amendment from “vitamin tablets” to**

“**vitamin C tablets.**” *Id.* at 1274-75. In other words, an Applicant cannot attack a registration simply by pointing to one or two particular features of the goods at issue.

Likewise, in this case, Opposer cannot be subject to a claim for partial cancellation based on an attempt to narrow Opposer’s Registration by describing certain specific characteristics (e.g. two benefits) of Opposer’s products. Nor can Opposer’s Registration be deemed overly broad simply because it does not describe with particularity each and every one of the characteristics of the supplements offered under Opposer’s registered mark or each of the channels of trade in which those supplements are marketed and sold. In order to maintain Opposer’s registration rights, the Lanham act does not require Opposer to use its registered mark on every conceivable form of supplement, which provides every imaginable benefit, and which is offered and sold in every possible channel of trade. Applicant’s proposed restriction (and any other restriction that Applicant might propose) violates the very purpose of Section 18, which is to allow the Board to make only commercially significant restrictions that would actually avoid a likelihood of confusion.

One can imagine the results that might occur if Applicant’s proposed restriction were accepted. For example, could Opposer’s Registration be restricted to include only those dietary and nutritional supplements that “are formulated to support total body recovery, mental acuity, sexual vitality, energy, mood, and metabolism” (all benefits of the supplements sold under Opposer’s registered mark). Even if a registration intentionally had such a narrow description, it would not mean that an application for an otherwise confusingly similar mark also for dietary supplements could be distinguished merely because its goods description did not list precisely the same benefits. The proposed restriction is clearly improper.

V. Leave to Amend the Counterclaim Would Be Futile.

Finally, although the Board generally allows a claimant an opportunity to amend a defective pleading, in this case, such an amendment would be futile. *See* TBMP § 503.03 (“[I]n appropriate cases, that is, where justice does not require that leave to amend be given, the Board, in its discretion, may refuse to allow an opportunity, or a further opportunity, for amendment.”); *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151, 154 (TTAB 1983) (“Although it is the general practice of the Board to allow a party an opportunity to correct a defective pleading, in the instant case leave to amend the pleading would serve no useful purpose”), *aff’d*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). In this case, allowing Applicant an opportunity to amend its counterclaim would serve no useful purpose and would only delay these proceedings.

Applicant's Answer already admits that there is overlap of the products and channels of trade. Specifically, Applicant admits that it offers and sells dietary and nutritional supplements, including weight management products. Applicant's Answer ¶ 8. Similar to Opposer, Applicant admits that its products support a healthy immune system. *Id.* ¶ 36. Applicant also admits that it markets and sells its products using a direct sales or MLM platform, *see id.* ¶ 38, which is very similar to how Opposer offers and sells its products. Thus, where Applicant already has admitted overlap of the products and the channels of trade, allowing Applicant to try to come up with another commercially insignificant (or non-existence) distinction would be futile. There is no material distinction here between the products being sold under the registered mark, and those being sold by Applicant under the applied for mark. Significantly as to the attempted faux distinction sought by the amendment to Opposer's goods, **Applicant does not allege, and could not allege, that its own products do not attempt to provide (i) either of the benefits covered by the proposed amendment; or (ii) any other benefit of Opposer's supplements offered and sold under the registered mark.** This alone demonstrates that any amendment would be a waste of time.

Leave to amend also would be futile because Applicant could not prevail on a Section 18 partial cancellation claim as a matter of law. *See Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 (TTAB 1998) (holding that an amendment would be futile because opposers could not prevail on claim as a matter of law). As set forth above, any proposed restriction to narrow the scope of Opposer's registration in the manner contemplated by Applicant (or any variation thereof) is contrary to the standards set forth in *Eurostar*. Applicant simply is not entitled to selectively pick certain features of Opposer's products and tack those ones onto the goods in Opposer's registration. The attempt is artificial and transparently misleading and is virtually the definition of a distinction without a difference.

Finally, Applicant should not be given another opportunity to craft and plead another proposed restriction when the first proposed restriction was asserted in bad faith. *See NSM Resources Corp. and Huck Doll LLC v. Microsoft Corp.*, 113 USPQ2d 1029 (TTAB 2013) (refusing leave to amend and granting motion for sanctions as a result of bad faith petition to cancel). Applicant is well aware that its proposed restrictions to Opposer's Registration include benefits that Applicant itself claims as being benefits of Applicant's own supplements (i.e. stress management). *See supra*, note 1. Thus, Applicant's Counterclaim is merely an attempt to harass Opposer and waste judicial resources. Allowing Applicant to assert such claims would "encourage the use of TTAB

inter parties proceedings to harass the owners of existing (and, perhaps, long-held) registrations.” *Eurostar*, 34 U.S.P.Q.2d at 1270. “Such proceedings would force [Opposer] to spend time and money unnecessarily in defending [the Registration] with descriptions of goods which this Office had found perfectly acceptable. *Id.* at 1275 (Simms, J., concurring).

VI. Conclusion

Based on the foregoing, Applicant’s Counterclaim should be dismissed with prejudice, and Applicant should not be granted leave to re-file an amended Counterclaim.

Respectfully submitted this 25th day of March, 2015.

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I hereby certify that this Motion to Dismiss for Failure to State a Claim is being filed electronically with the United States Trademark Trial and Appeal board 37 C.F.R. §2.119.

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