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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Biotab Nutraceuticals, Inc.		
Entity	Corporation	Citizenship	California
Address	301 N. Lake Avenue, 6th Floor Pasadena, CA 91101 UNITED STATES		

Attorney information	Jay Stein Finestone & Richter 1875 Century Park East, Suite 1500 Los Angeles, CA 90067 UNITED STATES jstein@frlawcorp.com Phone:(310)575-0800		
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Registration Subject to Cancellation

Registration No	4028829	Registration date	09/20/2011
Registrant	Almuntasser "Alex" Hbaidu 5560 61st Street Commerce, CA 90040 UNITED STATES		

Goods/Services Subject to Cancellation

Class 005. First Use: 2011/02/22 First Use In Commerce: 2011/02/22 All goods and services in the class are cancelled, namely: Herbal male enhancement capsules; Herbal supplements
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Grounds for Cancellation

Deceptiveness	Trademark Act section 2(a)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3401265	Application Date	07/18/2007
Registration Date	03/25/2008	Foreign Priority Date	NONE
Word Mark	EXTENZE		

Design Mark	<h1>ExtenZe</h1>
Description of Mark	NONE
Goods/Services	Class 005. First use: First Use: 1999/11/01 First Use In Commerce: 1999/11/01 Vitamin supplements

Attachments	77232418#TMSN.jpeg (1 page)(bytes) Statement In Support of Cancellation.pdf (5 pages)(1687470 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jay Stein/
Name	Jay Stein
Date	08/24/2012

UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

Re: “XTNZN”

Registration Number: 4028829

Serial Number: 85253793

Defendant: Almntasser “Alex” Hbaidu

Plaintiff/Prior Registrant: Biotab Nutraceuticals, Inc.

Plaintiff/Prior Registrant’s Registered Mark: “EXTENZE” – Registration No. 3401265

STATEMENT IN SUPPORT OF CANCELLATION OF REGISTRATION OF “XTNZN”

I.

THE PRIOR REGISTRATION

Plaintiff Biotab Nutraceuticals, Inc., a California corporation, (“Biotab”) is a manufacturer and marketer of nutraceutical products (also sometimes referred to as “dietary supplements” or “vitamin supplements”), including being the originator of dietary supplements designed to enhance both male and female sexual satisfaction, which are marketed under the brand name, “ExtenZe.” Biotab is the Registrant of the trademark, “EXTENZE,”® registered in the Principle Register under Registration Number 3401265 in connection with Class 005 goods identified as vitamin supplements. In particular, Registrant’s application depicts in its attached specimen the packaging for “ExtenZe™ Maximum Strength Male Enhancement.”

As was attested to in Biotab’s Trademark Application, Biotab’s “EXTENZE”® products have been used in commerce since November 1, 1999. Moreover, for years, Biotab has advertised heavily in broadcast, print media, and the internet, and its products are sold in retail stores worldwide, such that Plaintiff’s trademark is a “famous mark.

Notwithstanding Biotab’s prior registration of the “EXTENZE”® trademark for dietary supplements, its use of the “ExtenZe”® name in commerce for nearly 13 years, and the strength of Biotab’s “EXTENZE”® mark by virtue of its massive marketing campaigns and national-chain retail sales, Defendant Almntasser “Alex” Hbaidu sought and obtained registration of the trademark, “XTNZN,” for male enhancement dietary supplements, attesting in his Trademark Application that the earliest use in commerce of that mark was February 22, 2011.

Biotab seeks cancellation of the “XTNZN” registration.

II.

**DEFENDANT’S MARK IS LIKELY TO CAUSE CONFUSION WITH PLAINTIFF’S
PRIOR REGISTERED MARK AS TO THE SOURCE OF THE GOODS.**

Section 2(d) of the Trademark Act (15 USC §1052(d)) precludes the registration of any mark “which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in conjunction with the goods of the Defendant, to cause confusion, or to cause mistake, or to deceive.”

In re E.I. du Pont de Nemours & Co., 476 F2d 1357, 1361 (1973) established that the criteria for testing the likelihood of confusion under Section 2(d) of the Act includes the following most relevant factors here:

(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. [See also, Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772, 396 F3d 1369, 1371];

(2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;

(3) The similarity or dissimilarity of established, likely-to-continue trade channels;

(4) The fame of the prior mark.

A. Defendant’s Word Mark is Nearly Identical to Plaintiff’s Prior-registered Mark.

Defendant’s “XTNZN” mark is hardly distinguishable from Plaintiff’s prior registered mark, “EXTENZE.”® The elimination of the vowels in Plaintiff’s Extenze® mark and the mere insertion of one letter onto the ending of the mark, “EXTENZE,”® do not sufficiently distinguish Defendant’s mark from Plaintiff’s prior registered mark. The words look and sound substantially similar and they share the same connotation – the “extension” of something.

Plaintiff contends that the commercial impression of consumers is likely to be one of inability to distinguish the source of goods as being from Plaintiff or Defendant, given that removing the vowels from Plaintiff’s mark does not change the sound or meaning of the mark.

In Weiss Associates, Inc. v. HRL Associates, Inc., 902 F 2d 1546, 1547 (Fed. Cir. 1990), the Court held that changing the final letter of even a three-letter registered mark covering similar goods “so resemble each other that confusion was likely.” See also, In re Pix of America, Inc. 225 USPQ 691 (TTAB 1985), “Newports” likely to be confused with “Newport;” In re Curtice-Burns, Inc., 231 USPQ 990 (TTAB 1986), “McKenzie’s” likely to be confused with “McKenzie;” In re Pellerin Milnor Corp., 221 USPQ 558 (TTAB 1983), “Miltron” likely to be confused with “Miltronics;” In re BASF A.G., 189 USPQ 424 (TTAB 1975), “Lutexal” likely to be confused with “Lutex.”

As is the standard regarding similarity of marks established by du Pont, *supra*, the two marks need not be compared side-by-side, but rather, the test is whether the two marks are similar enough that there is a likelihood of confusion by consumers as to the source of the goods. In so doing, the impression of the average consumer is to be gauged, although acknowledging that the consumer typically retains only a general impression of the mark. Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975). Moreover, when the goods are identical, as is the case here, discussed below, “the degree of similarity necessary to support a conclusion of likely confusion declines.” Century 21 Real Estate Corp. v. Century Life of America, 970 F 2d 874, 877 (Fed. Cir. 1992).

If the dominant portion of each mark is the same, then confusion is more likely, despite other differences in the mark. Palm Bay Imports, *supra*. Plaintiff submits that this concept is even more acute when comparing single-word marks or when comparing marks containing overlapping primary words.

B. Defendant’s Goods Are Seemingly Identical to Plaintiff’s Prior-Registered Goods

For there to be a likelihood of confusion of the source of the goods, the Defendant’s goods or services need only be “related” in nature, not identical. Safety-Kleen Corp. v. Dresser Industries, Inc., 518 F2d 1399, 1404 (USCCPA 1975), involving parts washers versus hand tools. The respective goods need only be sufficiently related that consumers are likely to encounter them in the same channels of trade and, thereby, be confused as to the origin of the goods. On-line Careline, Inc. v. America Online, Inc., 229 F3d 1080 (Fed. Cir. 2000).

As detailed in Plaintiff’s prior registration, Plaintiff enjoys the registration on the Principal Register of the mark, “**EXTENZE**”® for use with Class 005 goods, some of which goods being identified in Plaintiff’s trademark application as supplements for “male enhancement.”

Defendant seeks registration of a nearly identical word mark for what are identical goods (i.e., male enhancement supplements) offered to the general public in the same channel of trade.

Given the identical description of the goods in Defendant’s application as those included in Plaintiff’s application for its prior registered mark, and given Defendant’s express comparison of its goods to those of Plaintiff, there need be no further inquiry into the similarity of the goods. The goods are identical.

C. Defendants Goods Are Sold in the Same Channels of Trade as Are Plaintiff’s Goods.

Plaintiffs’ goods are consumer goods sold to the general public. So are Defendant’s goods, apparently including through websites and other retail venues. Consumers can shop via the internet or even by telephone in response to an advertisement and encounter both Plaintiff’s goods and Defendant’s goods.

D. Plaintiff's Prior Mark is a Famous Mark.

The EXTENZE® brand is the best selling male enhancement dietary supplement in the world. EXTENZE® goods have been in commerce for nearly thirteen years. There have been massive advertising campaigns throughout the years in promoting the brand, including on television, radio, in print media and on the internet. In addition to small retail and convenience stores, EXTENZE® is sold in such national and international retail stores as Walmart, Walgreens, CVS, GNC Nutrition, etc. There is now widespread name recognition of “EXTENZE”® amongst the general consuming public and the trademark, ExtenZe®, is widely recognized amongst consumers as being associated with male enhancement dietary supplements. As a result, Biotab's mark qualifies as a “famous mark” as that term is used in trademark law.

In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1361 (1973) set forth the legal principle that the fame of the prior registered mark is a factor to be considered in analyzing the likelihood of confusion. The rationale is that, because a famous mark is more likely to be remembered in the public mind and associated with those goods, the prior, stronger mark is entitled to broader protection. Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772, 396 F.3d 1369, 1374, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); Bose Corp. v. QSC Audio Prods. Inc., 293 F.3d 1367, 1371-76, 63 USPQ2d 1303, 1305-09 (Fed. Cir. 2002); Recot, 214 F.3d at 1327, 54 USPQ2d at 1897; Kenner Parker Toys Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 353, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Moreover, “[a]s the fame of a mark increases, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines.” Starbucks U.S. Brands, LLC v. Ruben, 78 USPQ2d 1741, 1750 (TTAB 2006).

E. The Likelihood of Confusion is Great.

In the instant matter, Defendant's mark looks, sounds, and has the same commercial connotation as Plaintiffs' prior registered marks. Defendant's described goods are not just related, but are substantially identical to the goods relating to Plaintiff's prior registered marks. And, Defendant's described goods are sold in the same channels of trade to the same consumers.

Moreover, Plaintiff enjoys the rights conferred by its trademark's priority in registration (and its mark's much earlier use in commerce). Therefore, if there is any doubt as to the likelihood of confusion, such doubt must be resolved in favor of the prior registrant. In re Shell oil Co., 992 F.2d 1204 (Fed. Cir. 1993). In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 464-5 (Fed. Cir. 1988).

III.

AS DEFENDANT'S MARK INFRINGES UPON PLAINTIFF'S MARK AND HARMS PLAINTIFF, DEFENDANT'S MARK REGISTRATION MUST BE CANCELLED.

Plaintiff Biotab Nutraceuticals, Inc. is the registered owner of a prior mark, EXTENZE.® EXTENZE® is a famous mark, associated in the minds of consumers with the type of dietary supplement goods as bear the EXTENZE® brand. Defendant's “XTNZN” mark is nearly identical to Plaintiff's EXTENZE® mark, in appearance, sound and connotation.

Defendant now sells to retailers and to the general public the very same goods described in Plaintiff's registration, being male enhancement dietary supplements. Therefore, if Defendant is allowed to market the same or similar goods to the same consumers in the same channels of trade with a barely distinguishable name, it would both dilute Plaintiff's prior registered trademark and would undoubtedly result in confusion as to the source of the goods, thereby interfering with Plaintiff's commercial advantage and goodwill.

Given the harm to be suffered by Plaintiff if Defendant's mark is registered, it is respectfully requested that Defendant's registration be cancelled.