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Filing date: **06/14/2013**

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

Proceeding	92057122
Party	Plaintiff Neways, Inc.
Correspondence Address	MATTHEW A BARLOW WORKMAN NYDEGGER 1000 EAGLE GATE TOWER, 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111 UNITED STATES mbarlow@wnlaw.com, tvuksinick@wnlaw.com, jstringham@wnlaw.com
Submission	Other Motions/Papers
Filer's Name	Robyn L. Phillips
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Signature	/Robyn L. Phillips/
Date	06/14/2013
Attachments	14564 127 1_Motion to Amend Proof of Service with Declaration.pdf(446987 bytes)

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

In the matter of Trademark Registration No. 3,448,249

Mark: **NEW-WHEY**

Registered: June 17, 2008

-and-

Trademark Registration No. 4,214,663

For the Mark: **NEW WHEY NUTRITION**

Registered: September 25, 2012

-and-

Trademark Registration No. 4,172,454



For the Mark: **New Whey**
Nutrition

Registered: July 10, 2012

NEWAYS, INC.,

Petitioner,

v.

NEW WHEY NUTRITION, LLC, f/k/a
TOPSPIN-IDS ACQUISITION, LLC

Registrant.

Cancellation No. 92057122

**PETITIONER NEWAYS, INC.'S
MOTION TO AMEND PROOF
OF SERVICE OF PETITION
TO CANCEL**

MOTION

Petitioner NEWAYS, Inc. ("Petitioner"), by and through its counsel of record, hereby moves the Trademark Trial and Appeal Board ("TTAB") for an order that Petitioner has complied with 37 CFR § 2.111(a) and amending the proof of service of the Petition to Cancel in this matter.

MEMORANDUM

I. Introduction.

Petitioner filed a Petition to Cancel in this proceeding with the Trademark Trial and Appeal Board (“the Board”) on April 25, 2013, and served a copy of the petition on Respondent’s counsel. At that time, Petitioner and Registrant Topspin-Ids Acquisition, LLC, the former name of Registrant New Whey Nutrition, LLC were already involved in an Opposition proceeding (Opposition No. 91201238) before this Board. [Declaration of Thomas R. Vuksinick in Support of Petitioner Neways, Inc.’s Motion to Amend Proof of Service of Petition to Cancel (“Vuksinick Decl.”), ¶ 3.] As a result, counsel for Petitioner contacted counsel for Topspin-Ids Acquisition, LLC and New Whey Nutrition, LLC and asked him to accept service of the petition, which he did. [*Id.*, ¶ 4.]

Subsequently, Petitioner received a Scheduling Order dated April 30, 2013, from the Board for the present cancellation proceeding, which indicated that pursuant to 37 C.F.R. § 2.111(a), Petitioner should have served the registrant of each of the challenged registrations. [Dkt. No. 2.] In the Order the Board stated that “petitioner’s proof of service is a reasonable attempt to effect service,” but directed Petitioner to forward a copy of the Petition to Cancel to the owner of record for the registrations, at their address of record. [*Id.*] On June 12, 2013, Registrant filed an Answer, Affirmative Defenses, and Counterclaims to Petitioner Neways, Inc.’s Petition to Cancel. [Dkt. No. 5.]

Meanwhile, it came to the attention of counsel for Petitioner that the additional copy of the Petition to Cancel had not been served on the owner of record for the challenged registrations at their address of record as directed by the Board. Therefore, as shown by Exhibits A and B attached hereto, on June 13, 2013, Petitioner sent correspondence to the owner of record of each of the challenged registrations at their address of record with a copy of the Petition to Cancel. [*See* Exhs. A and B.] In addition, in the correspondence Petitioner informed the owners that their counsel had previously accepted service and had a copy of the Petition to Cancel. [*Id.*]

While the Board indicated that Petitioner's attempt Proof of Service was reasonable and Petitioner has now complied with the Board's instructions, after a further review of the relevant rules, and particularly TBMP § 309(c)(2), Petitioner is moving, out of an abundance of caution, to amend the proof of service, if necessary, and for an Order from this Board that it has complied with 37 C.F.R. § 2.111(a) at least as of the date it forwarded a copy of the Petition to the owner of record at the correspondence address of record.

II. Legal Standard.

As pointed out by the Board, pursuant to 37 C.F.R. § 2.111(a), "Petitioner must serve a copy of the petition, including any exhibits, on the owner of record, for the registration, . . . at the correspondence address of record in the Office." TBMP § 309(c)(2) states that "If Respondent has appointed an attorney to represent it in post-registration trademark matters, and petitioner serves the petition on the attorney appointed for the post-registration matters instead of respondent, petitioner may be excused if its failure to serve a copy of the petition was due to excusable error, and if petitioner thereafter sends a service copy to respondent and files a motion to amend proof of service accordingly." TBMP § 309(c)(2), at 300-53.

A determination of excusable neglect or error must take into account the relevant circumstances, including (1) the danger of prejudice to the nonmovant, (2) the length of the delay or omission and its potential impact on judicial proceedings, (3) the reason for the delay or omission, and (4) whether the movant acted in good faith. TBMP § 509(b)(1); *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997). Further the "prejudice to the nonmovant" must be more than the mere inconvenience and the delay caused by the movant's previous failure to take timely action". TBMP § 509(b)(1). The prejudice that is contemplated must be prejudice to the nonmovant's ability to litigate the case. *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997).

III. Analysis.

The parties in this proceeding are also involved in an Opposition proceeding before this Board, and counsel for Registrant agreed to accept service of the Petition to Cancel.

[Vuksinick Decl., ¶ 4.]. Counsel for Petitioner believed, although mistakenly, that it was proper for counsel for the Registrants, who were also counsel for Registrant in the Opposition proceeding, to accept service of the petition, and therefore, did not also serve the owner of record for the registrations at their address of record. [See Vuksinick Decl., ¶ 5.] Further, as previously indicated, the Board stated that “petitioner’s proof of service is a reasonable attempt to effect service.” [Dkt. No. 2.] Petitioner was acting in good faith. As shown by Exhibits A and B attached hereto, once Petitioner realized that through an oversight, it had not complied with the Board’s instructions in the Scheduling Order, Petitioner took steps to comply with the Board’s instructions. [See Exhs. A and B.] Further, Registrant has not been prejudiced in this matter by Petitioner serving Registrants’ counsel or the delay in forwarding the additional copy to Registrants. In fact, Registrant was able to file an Answer, Affirmative Defenses, and Counterclaims to Petitioner Neways, Inc.’s Petition to Cancel. [Dkt. No. 5.] Therefore, when Petitioner initially filed the Petition to Cancel and served counsel for Registrant who had accepted service, Petitioner made an excusable error, as indicated by the Board when it stated that Petitioner had made a reasonable attempt to effectual service. [See Dkt. No. 2.]

As previously discussed, Petitioner has now forwarded an additional copy of the Petition to Cancel to the Registrants at their address of record. [See Exhs. A and B.] Accordingly, Petitioner respectfully submits that it has complied with the instructions in the Scheduling Order from the Board as well as 37 C.F.R. § 2.111(a). Therefore, as suggested in TBMP § 309(c)(2), out of an abundance of caution, Petitioner filed the present Motion to Amend Proof of Service and should be allowed to Amend Proof of Service, if required. See TBMP § 309(c)(2), at 300-53; *The Equine Touch Foundation Inc. v. Equinology Inc.*, 91 USPQ2d 1943, 1945 (TTAB 2009). In fact, by serving the Registrants at their address of record, Petitioner has more fully complied with the service requirements than the petitioner did in *The Equine Touch Foundation Inc. v. Equinology Inc.*, 91 USPQ2d 1943 (TTAB 2009), where petitioner failed to even serve the petition to cancel, and when he did serve it, he served

counsel for the registrant rather than the actual registrant. *See id.* at 1944. Nevertheless, the Board granted petitioner's motion to amend. *Id.* at 1945. Accordingly, Petitioner has shown that it complied with 37 C.F.R. § 2.111(a) and this Motion to Amend Proof of Service should be granted.

IV. Conclusion.

For the reasons discussed above, Petitioner respectfully submits that it has shown that it has met the standard for excusable error in failing to serve the Registrants at their address of record. Further, Petitioner respectfully requests that the Board find that Petitioner has complied with 37 C.F.R. § 2.111(a) at least as of the date it forwarded a copy of the Petition to the owner of record at the correspondence address of record, and that the Proof of Service be amended, if required, to June 13, 2013.

DATED this 14th day of June, 2013.

Respectfully submitted,

/Robyn L. Phillips/

John C. Stringham, Reg. No. 40,831
Thomas R. Vuksinick
Robyn L. Phillips, Reg. No. 39,330
Matthew A. Barlow

WORKMAN NYDEGGER

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ATTORNEYS FOR PETITIONER
NEWAYS, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **PETITIONER NEWAYS, INC.'S MOTION TO AMEND PROOF OF SERVICE OF PETITION TO CANCEL** was served upon Applicant via U.S. Mail and is addressed to the counsel of record for Applicant:

Peter M. Brody
Nicole Rizzo Smith
Meera Nair
ROPES & GRAY LLP
One Metro Center
700 12th Street NW, Suite 900
Washington, DC 20005
peter.brody@ropesgray.com
nicole.smith@ropesgray.com
meera.nair@ropesgray.com

Dated this 14th day of June, 2013.

/Robyn L. Phillips/

4173766_1

EXHIBIT A

ROBYN L. PHILLIPS
EMAIL: rphillips@WNLAW.COM

June 13, 2013

NEW WHEY NUTRITION, LLC
5707 Dot Com Court, Suite 1079
Oviedo, FL 32765-3401

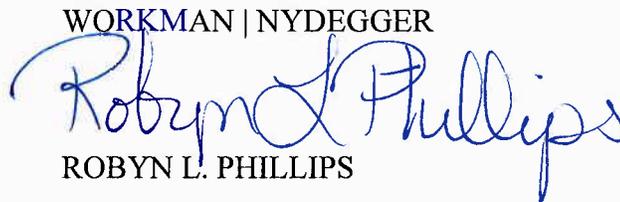
Re: *Neways, Inc. v. New Whey Nutrition, et al.*, Cancellation No. 92057122,
re the marks “NEW-WHEY”, “NEW WHEY NUTRITION” and “NEW WHEY
NUTRITION with design”
WN File: 14564.127.1

Dear Sir:

As directed by Trademark Trial and Appeal Board (“TTAB”) in the Order dated April 30, 2013, we enclose herewith an additional copy of the Petition for Cancellation of the marks “NEW-WHEY”, Registration No. 3,448,249, “NEW WHEY NUTRITION”, Registration No. 4,214,663, and “NEW WHEY NUTRITION with design”, Registration No. 4,172,454, filed in the TTAB on behalf of Neways, Inc. on April 25, 2013. Your counsel has previously agreed to accept service and we have served this document on him. However, in light of the TTAB’s correspondence and out of an abundance of caution we are serving these on you directly.

If you have any questions, please feel free to contact me.

Cordially,

WORKMAN | NYDEGGER

ROBYN L. PHILLIPS

cc: Peter M. Brody

Enclosure
RLP:sc
4173760_1

ESTTA Tracking number: **ESTTA534365**

Filing date: **04/25/2013**

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	NEWAYS, INC.		
Entity	Corporation	Citizenship	Utah
Address	2089 West Neways Drive SPRINGVILLE, UT 84663 UNITED STATES		

Attorney information	Matthew A. Barlow Workman Nydegger 60 E. South Temple, Suite 1000 Salt Lake City, UT 84111 UNITED STATES mbarlow@wnlaw.com, tvuksinick@wnlaw.com, jstringham@wnlaw.com Phone:801-533-9800
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Registrations Subject to Cancellation

Registration No	3448249	Registration date	06/17/2008
Registrant	TOPSPIN-IDS ACQUISITION, LLC 5707 DOT COM COURT SUITE 1079 OVIDO, FL 327653401 UNITED STATES		

Goods/Services Subject to Cancellation

Class 005. First Use: 2006/02/28 First Use In Commerce: 2006/03/31 All goods and services in the class are cancelled, namely: Nutritionally fortified beverages containing whey protein
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)		
The mark is merely descriptive	Trademark Act section 2(e)(1)		
Registration No	4214663	Registration date	09/25/2012
Registrant	NEW WHEY NUTRITION, LLC SUITE 1079 5707 DOT COM COURT OVIDO, FL 32765 UNITED STATES		

Goods/Services Subject to Cancellation

Class 005. First Use: 2010/08/11 First Use In Commerce: 2010/08/11 All goods and services in the class are cancelled, namely: nutritional supplement containing whey protein

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)		
The mark is merely descriptive	Trademark Act section 2(e)(1)		
Registration No	4172454	Registration date	07/10/2012
Registrant	New Whey Nutrition, LLC 5707 Dot Com Court Suite 1079 Oviedo, FL 32765 UNITED STATES		

Goods/Services Subject to Cancellation

Class 005. First Use: 2011/02/28 First Use In Commerce: 2011/02/28 All goods and services in the class are cancelled, namely: nutritional supplements containing whey protein
--

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)		
The mark is merely descriptive	Trademark Act section 2(e)(1)		
Related Proceedings	Opposition No. 91201238		

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2471380	Application Date	03/31/2000
Registration Date	07/24/2001	Foreign Priority Date	NONE
Word Mark	NEWAYS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1992/09/00 First Use In Commerce: 1992/09/00 Housemark for a complete line of nutritional and herbal supplements		

U.S. Registration No.	2389764	Application Date	09/16/1999
Registration Date	09/26/2000	Foreign Priority Date	NONE
Word Mark	NEWAYS AUTHENTIC HAWAIIAN NONI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1999/08/13 First Use In Commerce: 1999/08/13 nutritional supplement		

U.S. Registration No.	2731042	Application Date	03/04/2000
Registration Date	07/01/2003	Foreign Priority	NONE

		Date	
Word Mark	NEWAYS CASCADING REVENOL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2000/02/00 First Use In Commerce: 2000/02/00 Herbal and Nutritional Supplement		

U.S. Registration No.	2492629	Application Date	11/16/2000
Registration Date	09/25/2001	Foreign Priority Date	NONE
Word Mark	NEWAYS INGENIOUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2000/11/14 First Use In Commerce: 2000/11/14 Herbal and Nutritional Supplement		

U.S. Registration No.	2799001	Application Date	09/20/2002
Registration Date	12/23/2003	Foreign Priority Date	NONE
Word Mark	NEWAYS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 2003/01/17 First Use In Commerce: 2003/01/17 Nail care preparations, namely, polish which provides a hardened coating to the nail, cuticle creams, nail creams and lotions; laundry detergents; cosmetics, skin disinfectants, namely skin toners; hair preparations, namely, shampoos, conditioners, gels, lotions, and hair sprays; sun tanning preparations; shaving gels and soaps; cosmetic skin preparations, namely, soaps, skin and facial lotions and creams; eye makeups; skin makeup; dental preparations, namely, toothpaste and mouthwash; personal cosmetic deodorants; cosmetic preparations for bath, namely, soaps, gels and bubble bath; disinfectant solutions for general household use; sun blocking preparations; personal deodorants; and essential oils for personal use</p> <p>Class 005. First use: First Use: 2003/01/17 First Use In Commerce: 2003/01/17 Nutritional, dietary and herbal supplements; dietary drink mix for use as a meal replacement</p>		

U.S. Registration No.	3006252	Application Date	09/23/2003
Registration Date	10/11/2005	Foreign Priority Date	NONE
Word Mark	NEWAYS GREEN QI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2004/01/13 First Use In Commerce: 2004/01/13		

	Dietary Supplement		
U.S. Registration No.	3850494	Application Date	02/06/2008
Registration Date	09/21/2010	Foreign Priority Date	NONE
Word Mark	NEWAYS HEALTHY HOMES		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 2008/03/28 First Use In Commerce: 2008/03/28 Nail care preparations, namely, nail polish, cuticle creams, nail creams and lotions; cosmetic skin preparations, namely, soaps, skin and facial lotions and creams; cosmetics, namely, eye makeups, skin makeup; skin disinfectants, namely, skin toners; hair preparations, namely, shampoos, conditioners, gels, lotions, and hair sprays; cosmetic preparations for bath, namely, soaps, gels and bubble bath personal deodorants; essential oils for personal use; sun tanning preparations, sun blocking preparations; shaving gels and soaps; dental preparations, namely, toothpaste and mouthwash; laundry detergents</p> <p>Class 005. First use: First Use: 2008/03/28 First Use In Commerce: 2008/03/28 Nutritional, dietary and herbal supplements; dietary drink mix for use as a meal replacement; disinfectant solutions for general household use</p> <p>Class 016. First use: First Use: 2008/03/28 First Use In Commerce: 2008/03/28 Magazines on the subject of health and fitness in the residential environment</p>		
U.S. Registration No.	3709468	Application Date	02/06/2008
Registration Date	11/10/2009	Foreign Priority Date	NONE
Word Mark	NEWAYS HEALTHY HOMES		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 2008/04/30 First Use In Commerce: 2008/04/30 Nail care preparations, namely, nail polish, cuticle creams, nail creams and lotions; cosmetic skin preparations, namely, soaps, skin and facial lotions and creams; cosmetics, namely, eye makeups, skin makeup; skin disinfectants, namely, skin toners; hair preparations, namely, shampoos, conditioners, gels, lotions, and hair sprays; cosmetic preparations for bath, namely, soaps, gels and bubble bath personal deodorants; essential oils for personal use; sun tanning preparations, sun blocking preparations; shaving gels and soaps; dental preparations, namely, toothpaste and mouthwash; laundry detergents</p> <p>Class 005. First use: First Use: 2008/04/30 First Use In Commerce: 2008/04/30 Nutritional, dietary and herbal supplements; dietary drink mix for use as a meal replacement; disinfectant solutions for general household use</p> <p>Class 016. First use: First Use: 2008/04/30 First Use In Commerce: 2008/04/30 Magazines on the subject of health and fitness in the residential environment</p>		
U.S. Registration No.	3703119	Application Date	09/04/2008
Registration Date	10/27/2009	Foreign Priority Date	NONE

Word Mark	NEWAYS
Design Mark	
Description of Mark	The mark consists of a stylized leaf appearing above the word "NEWAYS".
Goods/Services	<p>Class 003. First use: First Use: 2008/11/28 First Use In Commerce: 2008/11/28 NAIL CARE PREPARATIONS, NAMELY, POLISH WHICH PROVIDES A HARDENED COATING TO THE NAIL, CUTICLE CREAMS, NAIL CREAMS AND LOTIONS; LAUNDRY DETERGENTS; SKIN TONERS; HAIR PREPARATIONS, NAMELY, SHAMPOOS, CONDITIONERS, GELS, LOTIONS, AND HAIR SPRAYS; SUN TANNING PREPARATIONS; SHAVING GELS AND SOAPS; COSMETIC SKIN PREPARATIONS, NAMELY, SOAPS, SKIN AND FACIAL LOTIONS AND CREAMS; EYE MAKEUPS; SKIN MAKEUP; DENTAL PREPARATIONS, NAMELY, TOOTHPASTE AND MOUTHWASH; PERSONAL COSMETIC DEODORANTS; COSMETIC PREPARATIONS FOR BATH, NAMELY, SOAPS, GELS AND BUBBLE BATH; SUN BLOCKING PREPARATIONS; PERSONAL DEODORANTS; AND ESSENTIAL OILS FOR PERSONAL USE</p> <p>Class 005. First use: First Use: 2008/11/28 First Use In Commerce: 2008/11/28 NUTRITIONAL, DIETARY, AND HERBAL SUPPLEMENTS; DIETARY DRINK MIX FOR USE AS A MEAL REPLACEMENT; ALL PURPOSE DISINFECTANTS FOR GENERAL HOUSEHOLD USE; DISINFECTANTS FOR HYGIENE PURPOSES</p>

Attachments	Combined Petition to Cancel NEW WHEY NUTRITION marks.pdf (13 pages) (195957 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	/Matthew A. Barlow/
Name	Matthew A. Barlow
Date	04/25/2013

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

In the matter of Trademark Registration No. 3,448,249

Mark: **NEW-WHEY**

Registered: June 17, 2008

-and-

Trademark Registration No. 4,214,663

For the Mark: **NEW WHEY NUTRITION**

Registered: September 25, 2012

-and-

Trademark Registration No. 4,172,454



For the Mark: **New Whey
Nutrition**

Registered: July 10, 2012

NEWAYS, INC.,

Petitioner,

v.

NEW WHEY NUTRITION, LLC, f/k/a
TOPSPIN-IDS ACQUISITION, LLC

Respondent.

Cancellation No. _____

PETITION TO CANCEL

PETITION TO CANCEL

NEWAYS, INC. ("Petitioner"), a Utah corporation, believes that it will be damaged by the continued registration of the marks NEW-WHEY, NEW WHEY NUTRITION, and



**New Whey
Nutrition**, which are the subject of Registration Nos. 3,448,249, 4,214,663 and 4,172,454,

respectively, held in the name of New Whey Nutrition, LLC, and hereby petitions to cancel said marks.

As grounds for cancellation, Petitioner alleges that:

1. Respondent New Whey Nutrition, LLC (“Respondent”), is a Delaware Limited Liability Company, with a principal place of business located at 5707 Dot Com Court Suite 1079, Oviedo, Florida 32765.

2. Upon information and belief, prior to about September 17, 2010, when Respondent changed its name to New Whey Nutrition, LLC, Respondent was known as Topspin-IDS Acquisition, LLC. Upon information and belief, New Whey Nutrition, LLC and Topspin-IDS Acquisition, LLC are the same entity.

3. Respondent is the record owner of United States Trademark Registration No. 3,448,249 (“the ‘249 Registration”) for the mark NEW-WHEY in international class 5 for “nutritionally fortified beverages containing whey protein.” The registered mark consists of standard characters without claim to any particular font, style, size, or color and is not limited to the sale of the specified goods in any particular channel or channels of trade. The ‘249 Registration issued from an application filed on August 14, 2007. The ‘249 Registration claims a date of first use of at least as early as February 28, 2006 and a date of first use in commerce of at least as early as March 31, 2006.

4. Respondent is the record owner of United States Trademark Registration No. 4,214,663 (“the ‘663 Registration”) for the mark NEW WHEY NUTRITION in international class 5 for “nutritional supplement containing whey protein.” The registered mark consists of standard characters without claim to any particular font, style, size, or color and is not limited to the sale of the specified goods in any particular channel or channels of trade. The ‘663

Registration issued from an application filed on January 7, 2011. The '663 Registration claims a date of first use and a date of first use in commerce of at least as early as August 11, 2010.

5. Respondent is the record owner of United States Trademark Registration No.



4,172,454 (“the ‘454 Registration”) for the mark  in international class 5 for “nutritional supplements containing whey protein” (“the NEW WHEY NUTRITION and design mark”). The Respondent does not claim color as a feature of the NEW WHEY NUTRITION and design mark and the registered mark is not limited to the sale of the specified goods in any particular channel or channels of trade. The ‘454 Registration issued from an application filed on January 7, 2011. The ‘454 Registration claims a date of first use and a date of first use in commerce of at least as early as February 28, 2011.

6. The '249 Registration, the '663 Registration, and the '454 Registration are referred to collectively herein as “Respondent’s Registrations” and the marks subject to those registrations are collectively referred to as “Respondent’s Marks.”

7. Petitioner is the owner of the following trademark registrations for NEWAYS marks or marks incorporating “neways” in international class 5 for use on, among other things, nutritional or dietary supplements, or both:

REGISTRATIONS

Registration	Mark	Goods and Services
2471380	NEWAYS	<p>U.S. Class: 006, 018, 044, 046, 051, 052 (International Class 05) Housemark for a complete line of nutritional and herbal supplements Basis: 1(a) First Use Date: 1992-09-00 First Use in Commerce Date: 1992-09-00</p>

2389764	NEWAYS AUTHENTIC HAWAIIAN NONI	U.S. Class: 006, 018, 044, 046, 051, 052 (International Class: 005) Nutritional supplement Basis: 1(a) First Use Date: 1999-08-13 First Use in Commerce Date: 1999-08-13
2731042	NEWAYS CASCADING REVENOL	U.S. Class: 006, 018, 044, 046, 051, 052 (International Class: 005) Herbal and nutritional supplement Basis: 1(a) First Use Date: 2000-02-00 First Use in Commerce Date: 2000-02-00
2492629	NEWAYS INGENIOUS	U.S. Class: 006, 018, 044, 046, 051, 052 (International Class: 005) Herbal and nutritional supplement Basis: 1(a) First Use Date: 2001-01-14 First Use in Commerce Date: 2001-01-14
2799001		U.S. Class: 001, 004, 006, 018, 044, 046, 050, 051, 052 (International Class 003 and 005) Class Status: Active Nail care preparations, namely, polish which provides a hardened coating to the nail, cuticle creams, nail creams and lotions; laundry detergents; skin toners; hair preparations, namely, shampoos, conditioners, gels, lotions, and hair sprays; sun tanning preparations; shaving gels and soaps; cosmetic skin preparations, namely, soaps, skin and facial lotions and creams; eye makeups; skin makeup; dental preparations, namely, toothpaste and mouthwash; personal cosmetic deodorants; cosmetic preparations for bath, namely, soaps, gels and bubble bath; sun blocking preparations; personal deodorants; and essential oils for personal use; Nutritional, dietary, and herbal supplements; dietary drink mix for use as a meal replacement; all purpose disinfectants for general household use; disinfectants for hygiene purposes Basis: 1(a) First Use Date: 2003-01-17 First Use in Commerce Date: 2003-01-17
3006252	NEWAYS GREEN QI	U.S. Class: 006, 018, 044, 046, 051, 052 (International Class: 005) Dietary Supplement Basis: 1(a) First Use Date: 2004-01-13 First Use in Commerce Date: 2004-01-13

3850494	NEWAYS HEALTHY HOMES	<p>U.S. Class: 001, 004, 006, 018, 044, 046, 050, 051, 052 (International Class 003 and 005)</p> <p>Class Status: Active</p> <p>Nail care preparations, namely, polish which provides a hardened coating to the nail, cuticle creams, nail creams and lotions; laundry detergents; skin toners; hair preparations, namely, shampoos, conditioners, gels, lotions, and hair sprays; sun tanning preparations; shaving gels and soaps; cosmetic skin preparations, namely, soaps, skin and facial lotions and creams; eye makeups; skin makeup; dental preparations, namely, toothpaste and mouthwash; personal cosmetic deodorants; cosmetic preparations for bath, namely, soaps, gels and bubble bath; sun blocking preparations; personal deodorants; and essential oils for personal use; Nutritional, dietary, and herbal supplements; dietary drink mix for use as a meal replacement; disinfectants for general household use</p> <p>Basis: 1(a)</p> <p>First Use Date: 2008-03-28</p> <p>First Use in Commerce Date: 2008-03-28</p>
3709468		<p>U.S. Class: 001, 004, 006, 018, 044, 046, 050, 051, 052 (International Class 003 and 005)</p> <p>Class Status: Active</p> <p>Nail care preparations, namely, polish which provides a hardened coating to the nail, cuticle creams, nail creams and lotions; laundry detergents; skin toners; hair preparations, namely, shampoos, conditioners, gels, lotions, and hair sprays; sun tanning preparations; shaving gels and soaps; cosmetic skin preparations, namely, soaps, skin and facial lotions and creams; eye makeups; skin makeup; dental preparations, namely, toothpaste and mouthwash; personal cosmetic deodorants; cosmetic preparations for bath, namely, soaps, gels and bubble bath; sun blocking preparations; personal deodorants; and essential oils for personal use; Nutritional, dietary, and herbal supplements; dietary drink mix for use as a meal replacement; disinfectants for general household use</p> <p>Basis: 1(a)</p> <p>First Use Date: 2008-03-28</p> <p>First Use in Commerce Date: 2008-03-28</p>

3703119		<p>U.S. Class: 001, 004, 006, 018, 044, 046, 050, 051, 052 (International Class 003 and 005)</p> <p>Class Status: Active</p> <p>Nail care preparations, namely, polish which provides a hardened coating to the nail, cuticle creams, nail creams and lotions; laundry detergents; skin toners; hair preparations, namely, shampoos, conditioners, gels, lotions, and hair sprays; sun tanning preparations; shaving gels and soaps; cosmetic skin preparations, namely, soaps, skin and facial lotions and creams; eye makeups; skin makeup; dental preparations, namely, toothpaste and mouthwash; personal cosmetic deodorants; cosmetic preparations for bath, namely, soaps, gels and bubble bath; sun blocking preparations; personal deodorants; and essential oils for personal use; Nutritional, dietary, and herbal supplements; dietary drink mix for use as a meal replacement; all purpose disinfectants for general household use; disinfectants for hygiene purposes</p> <p>Basis: 1(a)</p> <p>First Use Date: 2008-11-28</p> <p>First Use in Commerce Date: 2008-11-28</p>
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8. Petitioner is also the owner of trademark registrations for NEWAYS marks or marks incorporating “neways” for use on personal care and household products, some of which are identified in the preceding paragraphs, and the remainder of which follow:

REGISTRATIONS

Registration	Mark	Goods and Services
2454358	NEWAYS	<p>U.S. Class: 001, 004, 006, 050, 051, 052 (International Class 03)</p> <p>Nail care preparations, namely, polish which provides a hardened coating to the nail, cuticle creams, nail creams and lotions; laundry detergents; cosmetics, namely, lipsticks, eye makeups and skin makeups; skin disinfectants, namely, skin toners; hair preparations, namely, shampoos, conditioners, gels, lotions and hair sprays; sun tanning preparations; shaving gels and soaps; cosmetic skin preparations, namely, soaps, skin and facial lotions and creams; dental preparations, namely, toothpaste and mouthwash; personal cosmetic deodorants; cosmetic preparations for bath, namely, soaps, gels and bubble bath; disinfectant solutions for general household use; sun blocking preparations; and anti-perspirants</p> <p>Basis: 1(a) First Use Date: 1992-08-31 First Use in Commerce Date: 1992-08-31</p>
2414219	NEWAYS SASSY	<p>U.S. Class: 001, 004, 006, 050, 051, 052 (International Class 003)</p> <p>Class Status: Active</p> <p>Hair care preparation, namely, hair spray</p> <p>Basis: 1(a) First Use Date: 1993-00-00 First Use in Commerce Date: 1993-00-00</p>
2656486	NEWAYS SKIN BRIGHTENER	<p>U.S. Class: 001, 004, 006, 050, 051, 052 (International Class 003)</p> <p>Class Status: Active</p> <p>Skin lightening lotion</p> <p>Basis: 1(a) First Use Date: 2002-01-25 First Use in Commerce Date: 2002-01-25</p>
2656490	NEWAYS CIRCLES & LINES	<p>U.S. Class: 001, 004, 006, 050, 051, 052 (International Class 003)</p> <p>Class Status: Active</p> <p>Facial Lotion</p> <p>Basis: 1(a) First Use Date: 2002-01-25 First Use in Commerce Date: 2002-01-25</p>

2779438	NEWAYS LAVENDER- CHAMOMILE	U.S. Class: 001, 004, 006, 050, 051, 052 (International Class 03) Essential oils for personal use Basis: 1(a) First Use Date: 2003-01-17 First Use in Commerce Date: 2003-01-17
2943333	NEWAYS GENERATIONS	U.S. Class: 001, 004, 006, 050, 051, 052 (International Class 03) Class Status: Active Personal care preparations, namely, baby bubble bath, baby hair detangler, baby bath and shower gel, baby shampoos, baby powder, baby wipes, and baby lotions, namely, skin and body lotions Basis: 1(a) First Use Date: 2003-01-17 First Use in Commerce Date: 2003-01-17
2984458		U.S. Class: 001, 004, 006, 050, 051, 052 (International Class 03) Class Status: Active Personal care preparations, namely, baby bubble bath, baby hair detangler, baby bath and shower gel, baby shampoos, baby powder, baby wipes, and baby lotions, namely, skin and body lotions Basis: 1(a) First Use Date: 2003-01-17 First Use in Commerce Date: 2003-01-17

9. The word portions of Petitioner's registered marks consist of standard characters without claim to any particular font, style, size, or color.

10. Petitioner's Registrations do not limit the sale of the specified goods identified to any particular channel or channels of trade.

11. Since at least the date of issuance of the above registrations, the names and marks have been continuously used in interstate commerce. Since the issuance of these trademark registrations, notice has been given to the public that the marks are registered trademarks by affixing notice provided in 15 U.S.C. § 1111.

12. The marks in U.S. Registration Nos. 2414219, 2492629, 2731042, 2656486, 2656490, 2799001, 2779438, 2431703, 2943333, 2471380, 2389764, and 2454358 are deemed incontestable under Trademark Act Section 15, 15 U.S.C. § 1065.

13. Petitioner formulates, manufactures, and distributes throughout the United States and the world an extensive line of personal care products, household products, and nutritional and dietary supplements. Since at least 1992 and long prior to the effective filing date and the dates of first use stated in Respondent's Registrations, Petitioner has sold those products in the United States under NEWAYS marks, or marks incorporating "Neways," giving rise to the common law trademark rights in various NEWAYS marks and marks incorporating "neways." Petitioner's common law trademarks and registered NEWAYS trademarks are referred to collectively as "the NEWAYS Marks."

14. Petitioner sells, and since at least 2003, has sold nutritional supplements containing whey protein under one or more NEWAYS Marks.

15. Since Petitioner's initial use of the NEWAYS Marks, Petitioner has made a substantial investment in marketing and promoting its goods under those marks. Petitioner has extensively used, advertised, promoted and offered its goods in association with the NEWAYS Marks and other marks with the result that Petitioner's customers and the general public have come to know and recognize Petitioner's NEWAYS Marks and other marks and that the public associates these marks with Petitioner and/or its goods. Petitioner has built up extensive goodwill in connection with its goods under the NEWAYS Marks and other marks.

16. By virtue of Petitioner's long use of the NEWAYS Marks for personal care products, household products, nutritional and dietary supplements, and related goods and services, the NEWAYS Marks have become strong, well known and famous, and have come

to be exclusively associated with Petitioner and with products and services emanating from Petitioner.

17. The marks in Respondent's Registrations consist of, or incorporate in dominant part, words that are virtually identical in sound and similar in spelling to Petitioner's NEWAYS Marks, or the dominant portion of those marks. The goods specified in certain of Petitioner's registrations (nutritional supplements and dietary supplements) are broad enough to encompass the goods specified in Respondent's Registrations (nutritionally fortified beverages containing whey protein and nutritional supplements containing whey protein), so that for purposes of this cancellation proceeding the goods and channels of trade of the Petitioner and Respondent are considered to be the same. The marks in Respondent's Registrations so resemble Petitioner's previously used and registered NEWAYS Marks, as to be likely, when applied to goods as specified in Respondent's Registrations, to cause confusion, mistake or to deceive within the meaning of 15 U.S.C. § 1052(d).

18. As a separate and alternative ground for cancellation, Petitioner alleges that the mark NEW-WHEY of the '249 Registration is merely descriptive of "nutritionally fortified beverages containing whey protein" and upon information and belief, has not acquired distinctiveness; that the NEW WHEY NUTRITION mark of the '663 Registration is merely descriptive of "nutritional supplement(s) containing whey protein" and upon information and belief, has not acquired distinctiveness; and that the mark NEW-WHEY NUTRITION (and design) of the '454 Registration is merely descriptive of "nutritional supplements containing whey protein" and upon information and belief, has not acquired distinctiveness.

19. Petitioner believes that continued registration of the marks set forth in Respondent's Registrations will damage Petitioner for at least the following reasons:

a. If the Respondent's Registrations are permitted to subsist, and if Respondent is permitted to use the registered marks for goods as specified in Respondent's Registrations, confusion in the trade resulting in damage and injury to the Petitioner would be caused by reason of the similarity between Respondent's Marks and Petitioner's NEWAYS Marks.

b. While Respondent's Registrations are allowed to subsist, they present at least a prima facie exclusive right to use the marks that are the subject of Respondent's Registrations on the goods identified in the Respondent's Registrations. Respondent's Registrations are, thus, a source of damage and injury to Petitioner because Respondent's Registrations are in conflict with Petitioner's prior registrations and use of its NEWAYS Marks.

c. In the alternative, if the '663, '249, and '454 Registrations are descriptive and allowed to subsist, Petitioner will be damaged and injured because the continuance of those registrations infringes on its equal right to use in its business the descriptive terms that are the subject of those registrations.

20. Respondent's Registrations were granted contrary to the requirements of 15 U.S.C. §§ 1052(d), or in the alternative, contrary to the requirements of 1052(e)(1), and therefore should be cancelled.

WHEREFORE, Petitioner respectfully prays that this petition be sustained and that the '249 Registration, the '663 Registration, and the '454 Registration be cancelled.

The required filing fee for the filing of this Petition is submitted herewith.

DATED this 25th day of April 2013.

Respectfully submitted,

/Matthew A. Barlow/

John C. Stringham, Reg. No. 40,831

Thomas R. Vuksinick

Matthew A. Barlow

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ATTORNEYS FOR OPPOSER
NEWAYS, INC.

4099317_1

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **PETITION TO CANCEL** was served upon Applicant via U.S. Mail and is addressed to the counsel of record for Applicant:

Peter M. Brody
Nicole Rizzo Smith
Meera Nair
ROPES & GRAY LLP
One Metro Center
700 12th Street NW, Suite 900
Washington, DC 20005
peter.brody@ropesgray.com
nicole.smith@ropesgray.com
meera.nair@ropesgray.com

Dated this 25th day of April, 2013.

/Matthew A. Barlow/

EXHIBIT B

ROBYN L. PHILLIPS
EMAIL: rphillips@WNLAW.COM

June 13, 2013

TOPSPIN-IDS ACQUISITION, LLC
5707 Dot Com Court, Suite 1079
Oviedo, FL 32765-3401

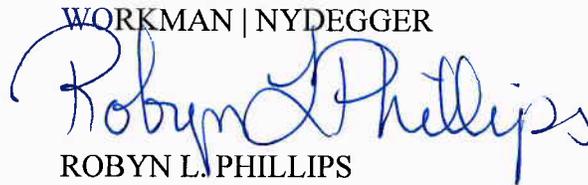
Re: *Neways, Inc. v. New Whey Nutrition, et al.*, Cancellation No. 92057122,
re the marks “NEW-WHEY”, “NEW WHEY NUTRITION” and “NEW WHEY
NUTRITION with design”
WN File: 14564.127.1

Dear Sir:

As directed by Trademark Trial and Appeal Board (“TTAB”) in the Order dated April 30, 2013, we enclose herewith an additional copy of the Petition for Cancellation of the marks “NEW-WHEY”, Registration No. 3,448,249, “NEW WHEY NUTRITION”, Registration No. 4,214,663, and “NEW WHEY NUTRITION with design”, Registration No. 4,172,454, filed in the TTAB on behalf of Neways, Inc. on April 25, 2013. Your counsel has previously agreed to accept service and we have served this document on him. However, in light of the TTAB’s correspondence and out of an abundance of caution we are serving these on you directly.

If you have any questions, please feel free to contact me.

Cordially,

WORKMAN | NYDEGGER

ROBYN L. PHILLIPS

cc: Peter M. Brody

Enclosure
RLP:sc
4173740_1

ESTTA Tracking number: **ESTTA534365**

Filing date: **04/25/2013**

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	NEWAYS, INC.		
Entity	Corporation	Citizenship	Utah
Address	2089 West Neways Drive SPRINGVILLE, UT 84663 UNITED STATES		

Attorney information	Matthew A. Barlow Workman Nydegger 60 E. South Temple, Suite 1000 Salt Lake City, UT 84111 UNITED STATES mbarlow@wnlaw.com, tvuksinick@wnlaw.com, jstringham@wnlaw.com Phone:801-533-9800
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Registrations Subject to Cancellation

Registration No	3448249	Registration date	06/17/2008
Registrant	TOPSPIN-IDS ACQUISITION, LLC 5707 DOT COM COURT SUITE 1079 OVIEDO, FL 327653401 UNITED STATES		

Goods/Services Subject to Cancellation

Class 005. First Use: 2006/02/28 First Use In Commerce: 2006/03/31 All goods and services in the class are cancelled, namely: Nutritionally fortified beverages containing whey protein
--

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)		
The mark is merely descriptive	Trademark Act section 2(e)(1)		
Registration No	4214663	Registration date	09/25/2012
Registrant	NEW WHEY NUTRITION, LLC SUITE 1079 5707 DOT COM COURT OVIEDO, FL 32765 UNITED STATES		

Goods/Services Subject to Cancellation

Class 005. First Use: 2010/08/11 First Use In Commerce: 2010/08/11 All goods and services in the class are cancelled, namely: nutritional supplement containing whey protein

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)		
The mark is merely descriptive	Trademark Act section 2(e)(1)		
Registration No	4172454	Registration date	07/10/2012
Registrant	New Whey Nutrition, LLC 5707 Dot Com Court Suite 1079 Oviedo, FL 32765 UNITED STATES		

Goods/Services Subject to Cancellation

Class 005. First Use: 2011/02/28 First Use In Commerce: 2011/02/28 All goods and services in the class are cancelled, namely: nutritional supplements containing whey protein
--

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)		
The mark is merely descriptive	Trademark Act section 2(e)(1)		
Related Proceedings	Opposition No. 91201238		

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2471380	Application Date	03/31/2000
Registration Date	07/24/2001	Foreign Priority Date	NONE
Word Mark	NEWAYS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1992/09/00 First Use In Commerce: 1992/09/00 Housemark for a complete line of nutritional and herbal supplements		

U.S. Registration No.	2389764	Application Date	09/16/1999
Registration Date	09/26/2000	Foreign Priority Date	NONE
Word Mark	NEWAYS AUTHENTIC HAWAIIAN NONI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1999/08/13 First Use In Commerce: 1999/08/13 nutritional supplement		

U.S. Registration No.	2731042	Application Date	03/04/2000
Registration Date	07/01/2003	Foreign Priority	NONE

		Date	
Word Mark	NEWAYS CASCADING REVENOL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2000/02/00 First Use In Commerce: 2000/02/00 Herbal and Nutritional Supplement		

U.S. Registration No.	2492629	Application Date	11/16/2000
Registration Date	09/25/2001	Foreign Priority Date	NONE
Word Mark	NEWAYS INGENIOUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2000/11/14 First Use In Commerce: 2000/11/14 Herbal and Nutritional Supplement		

U.S. Registration No.	2799001	Application Date	09/20/2002
Registration Date	12/23/2003	Foreign Priority Date	NONE
Word Mark	NEWAYS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 2003/01/17 First Use In Commerce: 2003/01/17 Nail care preparations, namely, polish which provides a hardened coating to the nail, cuticle creams, nail creams and lotions; laundry detergents; cosmetics, skin disinfectants, namely skin toners; hair preparations, namely, shampoos, conditioners, gels, lotions, and hair sprays; sun tanning preparations; shaving gels and soaps; cosmetic skin preparations, namely, soaps, skin and facial lotions and creams; eye makeups; skin makeup; dental preparations, namely, toothpaste and mouthwash; personal cosmetic deodorants; cosmetic preparations for bath, namely, soaps, gels and bubble bath; disinfectant solutions for general household use; sun blocking preparations; personal deodorants; and essential oils for personal use</p> <p>Class 005. First use: First Use: 2003/01/17 First Use In Commerce: 2003/01/17 Nutritional, dietary and herbal supplements; dietary drink mix for use as a meal replacement</p>		

U.S. Registration No.	3006252	Application Date	09/23/2003
Registration Date	10/11/2005	Foreign Priority Date	NONE
Word Mark	NEWAYS GREEN QI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2004/01/13 First Use In Commerce: 2004/01/13		

	Dietary Supplement		
U.S. Registration No.	3850494	Application Date	02/06/2008
Registration Date	09/21/2010	Foreign Priority Date	NONE
Word Mark	NEWAYS HEALTHY HOMES		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 2008/03/28 First Use In Commerce: 2008/03/28 Nail care preparations, namely, nail polish, cuticle creams, nail creams and lotions; cosmetic skin preparations, namely, soaps, skin and facial lotions and creams; cosmetics, namely, eye makeups, skin makeup; skin disinfectants, namely, skin toners; hair preparations, namely, shampoos, conditioners, gels, lotions, and hair sprays; cosmetic preparations for bath, namely, soaps, gels and bubble bath personal deodorants; essential oils for personal use; sun tanning preparations, sun blocking preparations; shaving gels and soaps; dental preparations, namely, toothpaste and mouthwash; laundry detergents</p> <p>Class 005. First use: First Use: 2008/03/28 First Use In Commerce: 2008/03/28 Nutritional, dietary and herbal supplements; dietary drink mix for use as a meal replacement; disinfectant solutions for general household use</p> <p>Class 016. First use: First Use: 2008/03/28 First Use In Commerce: 2008/03/28 Magazines on the subject of health and fitness in the residential environment</p>		
U.S. Registration No.	3709468	Application Date	02/06/2008
Registration Date	11/10/2009	Foreign Priority Date	NONE
Word Mark	NEWAYS HEALTHY HOMES		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 2008/04/30 First Use In Commerce: 2008/04/30 Nail care preparations, namely, nail polish, cuticle creams, nail creams and lotions; cosmetic skin preparations, namely, soaps, skin and facial lotions and creams; cosmetics, namely, eye makeups, skin makeup; skin disinfectants, namely, skin toners; hair preparations, namely, shampoos, conditioners, gels, lotions, and hair sprays; cosmetic preparations for bath, namely, soaps, gels and bubble bath personal deodorants; essential oils for personal use; sun tanning preparations, sun blocking preparations; shaving gels and soaps; dental preparations, namely, toothpaste and mouthwash; laundry detergents</p> <p>Class 005. First use: First Use: 2008/04/30 First Use In Commerce: 2008/04/30 Nutritional, dietary and herbal supplements; dietary drink mix for use as a meal replacement; disinfectant solutions for general household use</p> <p>Class 016. First use: First Use: 2008/04/30 First Use In Commerce: 2008/04/30 Magazines on the subject of health and fitness in the residential environment</p>		
U.S. Registration No.	3703119	Application Date	09/04/2008
Registration Date	10/27/2009	Foreign Priority Date	NONE

Word Mark	NEWAYS
Design Mark	
Description of Mark	The mark consists of a stylized leaf appearing above the word "NEWAYS".
Goods/Services	<p>Class 003. First use: First Use: 2008/11/28 First Use In Commerce: 2008/11/28 NAIL CARE PREPARATIONS, NAMELY, POLISH WHICH PROVIDES A HARDENED COATING TO THE NAIL, CUTICLE CREAMS, NAIL CREAMS AND LOTIONS; LAUNDRY DETERGENTS; SKIN TONERS; HAIR PREPARATIONS, NAMELY, SHAMPOOS, CONDITIONERS, GELS, LOTIONS, AND HAIR SPRAYS; SUN TANNING PREPARATIONS; SHAVING GELS AND SOAPS; COSMETIC SKIN PREPARATIONS, NAMELY, SOAPS, SKIN AND FACIAL LOTIONS AND CREAMS; EYE MAKEUPS; SKIN MAKEUP; DENTAL PREPARATIONS, NAMELY, TOOTHPASTE AND MOUTHWASH; PERSONAL COSMETIC DEODORANTS; COSMETIC PREPARATIONS FOR BATH, NAMELY, SOAPS, GELS AND BUBBLE BATH; SUN BLOCKING PREPARATIONS; PERSONAL DEODORANTS; AND ESSENTIAL OILS FOR PERSONAL USE</p> <p>Class 005. First use: First Use: 2008/11/28 First Use In Commerce: 2008/11/28 NUTRITIONAL, DIETARY, AND HERBAL SUPPLEMENTS; DIETARY DRINK MIX FOR USE AS A MEAL REPLACEMENT; ALL PURPOSE DISINFECTANTS FOR GENERAL HOUSEHOLD USE; DISINFECTANTS FOR HYGIENE PURPOSES</p>

Attachments	Combined Petition to Cancel NEW WHEY NUTRITION marks.pdf (13 pages) (195957 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	/Matthew A. Barlow/
Name	Matthew A. Barlow
Date	04/25/2013

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

In the matter of Trademark Registration No. 3,448,249

Mark: **NEW-WHEY**

Registered: June 17, 2008

-and-

Trademark Registration No. 4,214,663

For the Mark: **NEW WHEY NUTRITION**

Registered: September 25, 2012

-and-

Trademark Registration No. 4,172,454



For the Mark: **New Whey
Nutrition**

Registered: July 10, 2012

NEWAYS, INC.,

Petitioner,

v.

NEW WHEY NUTRITION, LLC, f/k/a
TOPSPIN-IDS ACQUISITION, LLC

Respondent.

Cancellation No. _____

PETITION TO CANCEL

PETITION TO CANCEL

NEWAYS, INC. ("Petitioner"), a Utah corporation, believes that it will be damaged by the continued registration of the marks NEW-WHEY, NEW WHEY NUTRITION, and



**New Whey
Nutrition**, which are the subject of Registration Nos. 3,448,249, 4,214,663 and 4,172,454,

respectively, held in the name of New Whey Nutrition, LLC, and hereby petitions to cancel said marks.

As grounds for cancellation, Petitioner alleges that:

1. Respondent New Whey Nutrition, LLC (“Respondent”), is a Delaware Limited Liability Company, with a principal place of business located at 5707 Dot Com Court Suite 1079, Oviedo, Florida 32765.

2. Upon information and belief, prior to about September 17, 2010, when Respondent changed its name to New Whey Nutrition, LLC, Respondent was known as Topspin-IDS Acquisition, LLC. Upon information and belief, New Whey Nutrition, LLC and Topspin-IDS Acquisition, LLC are the same entity.

3. Respondent is the record owner of United States Trademark Registration No. 3,448,249 (“the ‘249 Registration”) for the mark NEW-WHEY in international class 5 for “nutritionally fortified beverages containing whey protein.” The registered mark consists of standard characters without claim to any particular font, style, size, or color and is not limited to the sale of the specified goods in any particular channel or channels of trade. The ‘249 Registration issued from an application filed on August 14, 2007. The ‘249 Registration claims a date of first use of at least as early as February 28, 2006 and a date of first use in commerce of at least as early as March 31, 2006.

4. Respondent is the record owner of United States Trademark Registration No. 4,214,663 (“the ‘663 Registration”) for the mark NEW WHEY NUTRITION in international class 5 for “nutritional supplement containing whey protein.” The registered mark consists of standard characters without claim to any particular font, style, size, or color and is not limited to the sale of the specified goods in any particular channel or channels of trade. The ‘663

Registration issued from an application filed on January 7, 2011. The '663 Registration claims a date of first use and a date of first use in commerce of at least as early as August 11, 2010.

5. Respondent is the record owner of United States Trademark Registration No.



4,172,454 (“the ‘454 Registration”) for the mark  in international class 5 for “nutritional supplements containing whey protein” (“the NEW WHEY NUTRITION and design mark”). The Respondent does not claim color as a feature of the NEW WHEY NUTRITION and design mark and the registered mark is not limited to the sale of the specified goods in any particular channel or channels of trade. The ‘454 Registration issued from an application filed on January 7, 2011. The ‘454 Registration claims a date of first use and a date of first use in commerce of at least as early as February 28, 2011.

6. The '249 Registration, the '663 Registration, and the '454 Registration are referred to collectively herein as “Respondent’s Registrations” and the marks subject to those registrations are collectively referred to as “Respondent’s Marks.”

7. Petitioner is the owner of the following trademark registrations for NEWAYS marks or marks incorporating “neways” in international class 5 for use on, among other things, nutritional or dietary supplements, or both:

REGISTRATIONS

Registration	Mark	Goods and Services
2471380	NEWAYS	<p>U.S. Class: 006, 018, 044, 046, 051, 052 (International Class 05) Housemark for a complete line of nutritional and herbal supplements Basis: 1(a) First Use Date: 1992-09-00 First Use in Commerce Date: 1992-09-00</p>

2389764	NEWAYS AUTHENTIC HAWAIIAN NONI	U.S. Class: 006, 018, 044, 046, 051, 052 (International Class: 005) Nutritional supplement Basis: 1(a) First Use Date: 1999-08-13 First Use in Commerce Date: 1999-08-13
2731042	NEWAYS CASCADING REVENOL	U.S. Class: 006, 018, 044, 046, 051, 052 (International Class: 005) Herbal and nutritional supplement Basis: 1(a) First Use Date: 2000-02-00 First Use in Commerce Date: 2000-02-00
2492629	NEWAYS INGENIOUS	U.S. Class: 006, 018, 044, 046, 051, 052 (International Class: 005) Herbal and nutritional supplement Basis: 1(a) First Use Date: 2001-01-14 First Use in Commerce Date: 2001-01-14
2799001		U.S. Class: 001, 004, 006, 018, 044, 046, 050, 051, 052 (International Class 003 and 005) Class Status: Active Nail care preparations, namely, polish which provides a hardened coating to the nail, cuticle creams, nail creams and lotions; laundry detergents; skin toners; hair preparations, namely, shampoos, conditioners, gels, lotions, and hair sprays; sun tanning preparations; shaving gels and soaps; cosmetic skin preparations, namely, soaps, skin and facial lotions and creams; eye makeups; skin makeup; dental preparations, namely, toothpaste and mouthwash; personal cosmetic deodorants; cosmetic preparations for bath, namely, soaps, gels and bubble bath; sun blocking preparations; personal deodorants; and essential oils for personal use; Nutritional, dietary, and herbal supplements; dietary drink mix for use as a meal replacement; all purpose disinfectants for general household use; disinfectants for hygiene purposes Basis: 1(a) First Use Date: 2003-01-17 First Use in Commerce Date: 2003-01-17
3006252	NEWAYS GREEN QI	U.S. Class: 006, 018, 044, 046, 051, 052 (International Class: 005) Dietary Supplement Basis: 1(a) First Use Date: 2004-01-13 First Use in Commerce Date: 2004-01-13

3850494	NEWAYS HEALTHY HOMES	<p>U.S. Class: 001, 004, 006, 018, 044, 046, 050, 051, 052 (International Class 003 and 005)</p> <p>Class Status: Active</p> <p>Nail care preparations, namely, polish which provides a hardened coating to the nail, cuticle creams, nail creams and lotions; laundry detergents; skin toners; hair preparations, namely, shampoos, conditioners, gels, lotions, and hair sprays; sun tanning preparations; shaving gels and soaps; cosmetic skin preparations, namely, soaps, skin and facial lotions and creams; eye makeups; skin makeup; dental preparations, namely, toothpaste and mouthwash; personal cosmetic deodorants; cosmetic preparations for bath, namely, soaps, gels and bubble bath; sun blocking preparations; personal deodorants; and essential oils for personal use; Nutritional, dietary, and herbal supplements; dietary drink mix for use as a meal replacement; disinfectants for general household use</p> <p>Basis: 1(a)</p> <p>First Use Date: 2008-03-28</p> <p>First Use in Commerce Date: 2008-03-28</p>
3709468		<p>U.S. Class: 001, 004, 006, 018, 044, 046, 050, 051, 052 (International Class 003 and 005)</p> <p>Class Status: Active</p> <p>Nail care preparations, namely, polish which provides a hardened coating to the nail, cuticle creams, nail creams and lotions; laundry detergents; skin toners; hair preparations, namely, shampoos, conditioners, gels, lotions, and hair sprays; sun tanning preparations; shaving gels and soaps; cosmetic skin preparations, namely, soaps, skin and facial lotions and creams; eye makeups; skin makeup; dental preparations, namely, toothpaste and mouthwash; personal cosmetic deodorants; cosmetic preparations for bath, namely, soaps, gels and bubble bath; sun blocking preparations; personal deodorants; and essential oils for personal use; Nutritional, dietary, and herbal supplements; dietary drink mix for use as a meal replacement; disinfectants for general household use</p> <p>Basis: 1(a)</p> <p>First Use Date: 2008-03-28</p> <p>First Use in Commerce Date: 2008-03-28</p>

3703119		<p>U.S. Class: 001, 004, 006, 018, 044, 046, 050, 051, 052 (International Class 003 and 005)</p> <p>Class Status: Active</p> <p>Nail care preparations, namely, polish which provides a hardened coating to the nail, cuticle creams, nail creams and lotions; laundry detergents; skin toners; hair preparations, namely, shampoos, conditioners, gels, lotions, and hair sprays; sun tanning preparations; shaving gels and soaps; cosmetic skin preparations, namely, soaps, skin and facial lotions and creams; eye makeups; skin makeup; dental preparations, namely, toothpaste and mouthwash; personal cosmetic deodorants; cosmetic preparations for bath, namely, soaps, gels and bubble bath; sun blocking preparations; personal deodorants; and essential oils for personal use; Nutritional, dietary, and herbal supplements; dietary drink mix for use as a meal replacement; all purpose disinfectants for general household use; disinfectants for hygiene purposes</p> <p>Basis: 1(a)</p> <p>First Use Date: 2008-11-28</p> <p>First Use in Commerce Date: 2008-11-28</p>
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8. Petitioner is also the owner of trademark registrations for NEWAYS marks or marks incorporating “neways” for use on personal care and household products, some of which are identified in the preceding paragraphs, and the remainder of which follow:

REGISTRATIONS

Registration	Mark	Goods and Services
2454358	NEWAYS	<p>U.S. Class: 001, 004, 006, 050, 051, 052 (International Class 03)</p> <p>Nail care preparations, namely, polish which provides a hardened coating to the nail, cuticle creams, nail creams and lotions; laundry detergents; cosmetics, namely, lipsticks, eye makeups and skin makeups; skin disinfectants, namely, skin toners; hair preparations, namely, shampoos, conditioners, gels, lotions and hair sprays; sun tanning preparations; shaving gels and soaps; cosmetic skin preparations, namely, soaps, skin and facial lotions and creams; dental preparations, namely, toothpaste and mouthwash; personal cosmetic deodorants; cosmetic preparations for bath, namely, soaps, gels and bubble bath; disinfectant solutions for general household use; sun blocking preparations; and anti-perspirants</p> <p>Basis: 1(a) First Use Date: 1992-08-31 First Use in Commerce Date: 1992-08-31</p>
2414219	NEWAYS SASSY	<p>U.S. Class: 001, 004, 006, 050, 051, 052 (International Class 003)</p> <p>Class Status: Active</p> <p>Hair care preparation, namely, hair spray</p> <p>Basis: 1(a) First Use Date: 1993-00-00 First Use in Commerce Date: 1993-00-00</p>
2656486	NEWAYS SKIN BRIGHTENER	<p>U.S. Class: 001, 004, 006, 050, 051, 052 (International Class 003)</p> <p>Class Status: Active</p> <p>Skin lightening lotion</p> <p>Basis: 1(a) First Use Date: 2002-01-25 First Use in Commerce Date: 2002-01-25</p>
2656490	NEWAYS CIRCLES & LINES	<p>U.S. Class: 001, 004, 006, 050, 051, 052 (International Class 003)</p> <p>Class Status: Active</p> <p>Facial Lotion</p> <p>Basis: 1(a) First Use Date: 2002-01-25 First Use in Commerce Date: 2002-01-25</p>

2779438	NEWAYS LAVENDER- CHAMOMILE	U.S. Class: 001, 004, 006, 050, 051, 052 (International Class 03) Essential oils for personal use Basis: 1(a) First Use Date: 2003-01-17 First Use in Commerce Date: 2003-01-17
2943333	NEWAYS GENERATIONS	U.S. Class: 001, 004, 006, 050, 051, 052 (International Class 03) Class Status: Active Personal care preparations, namely, baby bubble bath, baby hair detangler, baby bath and shower gel, baby shampoos, baby powder, baby wipes, and baby lotions, namely, skin and body lotions Basis: 1(a) First Use Date: 2003-01-17 First Use in Commerce Date: 2003-01-17
2984458		U.S. Class: 001, 004, 006, 050, 051, 052 (International Class 03) Class Status: Active Personal care preparations, namely, baby bubble bath, baby hair detangler, baby bath and shower gel, baby shampoos, baby powder, baby wipes, and baby lotions, namely, skin and body lotions Basis: 1(a) First Use Date: 2003-01-17 First Use in Commerce Date: 2003-01-17

9. The word portions of Petitioner's registered marks consist of standard characters without claim to any particular font, style, size, or color.

10. Petitioner's Registrations do not limit the sale of the specified goods identified to any particular channel or channels of trade.

11. Since at least the date of issuance of the above registrations, the names and marks have been continuously used in interstate commerce. Since the issuance of these trademark registrations, notice has been given to the public that the marks are registered trademarks by affixing notice provided in 15 U.S.C. § 1111.

12. The marks in U.S. Registration Nos. 2414219, 2492629, 2731042, 2656486, 2656490, 2799001, 2779438, 2431703, 2943333, 2471380, 2389764, and 2454358 are deemed incontestable under Trademark Act Section 15, 15 U.S.C. § 1065.

13. Petitioner formulates, manufactures, and distributes throughout the United States and the world an extensive line of personal care products, household products, and nutritional and dietary supplements. Since at least 1992 and long prior to the effective filing date and the dates of first use stated in Respondent's Registrations, Petitioner has sold those products in the United States under NEWAYS marks, or marks incorporating "Neways," giving rise to the common law trademark rights in various NEWAYS marks and marks incorporating "neways." Petitioner's common law trademarks and registered NEWAYS trademarks are referred to collectively as "the NEWAYS Marks."

14. Petitioner sells, and since at least 2003, has sold nutritional supplements containing whey protein under one or more NEWAYS Marks.

15. Since Petitioner's initial use of the NEWAYS Marks, Petitioner has made a substantial investment in marketing and promoting its goods under those marks. Petitioner has extensively used, advertised, promoted and offered its goods in association with the NEWAYS Marks and other marks with the result that Petitioner's customers and the general public have come to know and recognize Petitioner's NEWAYS Marks and other marks and that the public associates these marks with Petitioner and/or its goods. Petitioner has built up extensive goodwill in connection with its goods under the NEWAYS Marks and other marks.

16. By virtue of Petitioner's long use of the NEWAYS Marks for personal care products, household products, nutritional and dietary supplements, and related goods and services, the NEWAYS Marks have become strong, well known and famous, and have come

to be exclusively associated with Petitioner and with products and services emanating from Petitioner.

17. The marks in Respondent's Registrations consist of, or incorporate in dominant part, words that are virtually identical in sound and similar in spelling to Petitioner's NEWAYS Marks, or the dominant portion of those marks. The goods specified in certain of Petitioner's registrations (nutritional supplements and dietary supplements) are broad enough to encompass the goods specified in Respondent's Registrations (nutritionally fortified beverages containing whey protein and nutritional supplements containing whey protein), so that for purposes of this cancellation proceeding the goods and channels of trade of the Petitioner and Respondent are considered to be the same. The marks in Respondent's Registrations so resemble Petitioner's previously used and registered NEWAYS Marks, as to be likely, when applied to goods as specified in Respondent's Registrations, to cause confusion, mistake or to deceive within the meaning of 15 U.S.C. § 1052(d).

18. As a separate and alternative ground for cancellation, Petitioner alleges that the mark NEW-WHEY of the '249 Registration is merely descriptive of "nutritionally fortified beverages containing whey protein" and upon information and belief, has not acquired distinctiveness; that the NEW WHEY NUTRITION mark of the '663 Registration is merely descriptive of "nutritional supplement(s) containing whey protein" and upon information and belief, has not acquired distinctiveness; and that the mark NEW-WHEY NUTRITION (and design) of the '454 Registration is merely descriptive of "nutritional supplements containing whey protein" and upon information and belief, has not acquired distinctiveness.

19. Petitioner believes that continued registration of the marks set forth in Respondent's Registrations will damage Petitioner for at least the following reasons:

a. If the Respondent's Registrations are permitted to subsist, and if Respondent is permitted to use the registered marks for goods as specified in Respondent's Registrations, confusion in the trade resulting in damage and injury to the Petitioner would be caused by reason of the similarity between Respondent's Marks and Petitioner's NEWAYS Marks.

b. While Respondent's Registrations are allowed to subsist, they present at least a prima facie exclusive right to use the marks that are the subject of Respondent's Registrations on the goods identified in the Respondent's Registrations. Respondent's Registrations are, thus, a source of damage and injury to Petitioner because Respondent's Registrations are in conflict with Petitioner's prior registrations and use of its NEWAYS Marks.

c. In the alternative, if the '663, '249, and '454 Registrations are descriptive and allowed to subsist, Petitioner will be damaged and injured because the continuance of those registrations infringes on its equal right to use in its business the descriptive terms that are the subject of those registrations.

20. Respondent's Registrations were granted contrary to the requirements of 15 U.S.C. §§ 1052(d), or in the alternative, contrary to the requirements of 1052(e)(1), and therefore should be cancelled.

WHEREFORE, Petitioner respectfully prays that this petition be sustained and that the '249 Registration, the '663 Registration, and the '454 Registration be cancelled.

The required filing fee for the filing of this Petition is submitted herewith.

DATED this 25th day of April 2013.

Respectfully submitted,

/Matthew A. Barlow/

John C. Stringham, Reg. No. 40,831

Thomas R. Vuksinick

Matthew A. Barlow

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ATTORNEYS FOR OPPOSER
NEWAYS, INC.

4099317_1

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **PETITION TO CANCEL** was served upon Applicant via U.S. Mail and is addressed to the counsel of record for Applicant:

Peter M. Brody
Nicole Rizzo Smith
Meera Nair
ROPES & GRAY LLP
One Metro Center
700 12th Street NW, Suite 900
Washington, DC 20005
peter.brody@ropesgray.com
nicole.smith@ropesgray.com
meera.nair@ropesgray.com

Dated this 25th day of April, 2013.

/Matthew A. Barlow/

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

In the matter of Trademark Registration No. 3,448,249

Mark: **NEW-WHEY**

Registered: June 17, 2008

-and-

Trademark Registration No. 4,214,663

For the Mark: **NEW WHEY NUTRITION**

Registered: September 25, 2012

-and-

Trademark Registration No. 4,172,454



For the Mark: **New Whey
Nutrition**

Registered: July 10, 2012

NEWAYS, INC.,

Petitioner,

v.

NEW WHEY NUTRITION, LLC, f/k/a
TOPSPIN-IDS ACQUISITION, LLC

Registrant.

Cancellation No. 92057122

**DECLARATION OF THOMAS R.
VUKSINICK IN SUPPORT OF
PETITIONER NEWAYS, INC.
MOTION TO AMEND PROOF
OF SERVICE OF PETITION TO
CANCEL**

I, Thomas R. Vuksinick, hereby state:

1. I am a shareholder in the firm Workman Nydegger, counsel for Petitioner Neways, Inc. ("Petitioner").

2. I make this declaration based upon my own personal knowledge, and based upon records maintained by Workman Nydegger to which I have access in the course of fulfilling my duties for the firm and its clients.

3. On April 25, 2013, a Petition to Cancel was filed on behalf of Petitioner in the above-entitled action with the United States Trademark Trial and Appeal Board. At that time, Petitioner and Registrant Topspin-Ids Acquisition, LLC, the former name of Registrant New Whey Nutrition, LLC were already involved in an Opposition proceeding (Opposition No. 91201238) before this Board.

4. Prior to filing the Petition to Cancel, I contacted counsel for Topspin-Ids Acquisition, LLC and New Whey Nutrition, LLC, and asked him to accept service of the petition, which he did. Attached hereto as Exhibit 1 is a true and correct copy of my electronic correspondence in which I confirmed that Registrant's counsel had agreed to accept service of the Petition to Cancel.

5. It was my understanding that it was proper for counsel for the Registrants, who were also counsel for Registrant in the Opposition proceeding, to accept service of the petition.

I declare under penalty of perjury under the laws of the United States of America that the statements set forth hereinabove are true and correct to the best of my knowledge and understanding.

DATED this 14th day of June, 2013.

Respectfully submitted,

/Thomas R. Vuksinick/

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **DECLARATION OF THOMAS R. VUKSINICK IN SUPPORT OF PETITIONER NEWAYS, INC.'S MOTION TO AMEND PROOF OF SERVICE OF PETITION TO CANCEL** was served upon Applicant via U.S. Mail and is addressed to the counsel of record for Applicant:

Peter M. Brody
Nicole Rizzo Smith
Meera Nair
ROPES & GRAY LLP
One Metro Center
700 12th Street NW, Suite 900
Washington, DC 20005
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nicole.smith@ropesgray.com
meera.nair@ropesgray.com

Dated this 14th day of June, 2013.

/Robyn L. Phillips/

4174745_1

EXHIBIT 1

Robyn L. Phillips

From: Tom R. Vuksinick
Sent: Thursday, April 25, 2013 12:17 PM
To: Brody, Peter M.; Brody, Peter M.
Subject: Neways/New Whey

Peter,

Based on our telephone conversation of a few minutes ago, I understand that you have agreed to accept service of Neways' petition to cancel the other New Whey marks on behalf of your client, New Whey Nutrition. We will serve the petition accordingly.

Regards, Tom

Thomas R. Vuksinick
Workman Nydegger
60 East South Temple Suite 1000
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