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

Proceeding	87386324
Applicant	Three Twins Organic, Inc. AKA Three Twins Ice Cream Corp.
Applied for Mark	MAXINE'S
Correspondence Address	EUGENE M PAK WENDEL ROSEN BLACK & DEAN LLP 1111 BROADWAY 24TH FLOOR OAKLAND, CA 94607 UNITED STATES tmdocket@wendel.com, epak@wendel.com 510-834-6600
Submission	Applicants Request for Remand and Amendment
Attachments	Request to Suspend and Remand MAXINES Three Twins Ice Cream.pdf(554138 bytes)
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Date	07/31/2019

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

In re Trademark Application of
Three Twins Organic, Inc. aka Three Twins
Ice Cream Corp.

Applicant

Ex Parte Appeal

Trademarks: 1) MAXINE'S; and
2) MAXINE'S BY THREE TWINS ICE
CREAM and Design

Serial No. 87386324
Filed: 3/27/2017

Serial No. 87408691
Filed: 4/12/2017

**APPLICANT'S REQUEST TO SUSPEND AND
REMAND FOR ADDITIONAL EVIDENCE**

I. INTRODUCTION

Pursuant to TBMP Section 1207.02 and 37 C.F.R. § 2.142(d) Applicant Three Twins Organic, Inc. dba Three Twins Ice Cream (hereafter "Applicant" or "Three Twins") respectfully requests suspension of the above-referenced appeal and remand to the Examining Attorney to consider additional evidence, namely: i) an executed trademark consent agreement between Applicant and the owner of the marks cited in the Office Action, Hi Performance Health Pty Ltd of Australia, and 2) consents to use of the likenesses of the individuals depicted in the mark MAXINE'S BY THREE TWINS ICE CREAM and Design (Serial No. 87408691).

A copy of the executed consent agreement and the signed consents regarding use of likenesses are attached to this Request as Exhibits A and B, respectively.

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I. INTRODUCTION

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A copy of the executed consent agreement and the signed consents regarding use of likenesses are attached to this Request as Exhibits A and B, respectively.

II. BACKGROUND¹

Applicant Three Twins Ice Cream is a maker of ice cream based in Petaluma, California. Three Twins was founded in 2005 by Neal Gottlieb. At the time, Neal, his twin brother Carl, and Carl's wife Liz, who is also a twin, were sharing an apartment, hence the name of the company.

A graphic of the three twins is shown below, which is part of one of the marks on appeal, and is the subject of its own federal registration THREE TWINS ICE CREAM and Design (Reg. No. 3408923). This logo is on every ice cream product made by the Three Twins.



Three Twins began selling its organic ice cream at local stores and farmers' markets, and it quickly became popular. The company grew and now sells its ice cream in grocery stores and ice cream stores.

In or about 2017, Three Twins decided to create a new family-size ice cream brand, which would be priced economically for families and sold in large 1.5 quart sizes. Mr. Gottlieb named this line of family-friendly ice creams after his mother, Maxine Gottlieb. On March 27 and April 12, 2017, respectively, Three Twins filed intent-to-use applications to register two marks: 1) MAXINE'S in standard characters (Serial No. 87386324) and 2) MAXINE'S BY THREE TWINS ICE CREAM and Design which featured a graphic image of Ms. Gottlieb and also incorporated Three Twin's name and the three twins logo (Serial No. 87408691), shown

¹ This Background section is essentially identical to the Background section in Applicant's earlier-filed extension requests.

below. Both applications were for a single product, namely, “ice cream.” Three Twins only makes ice cream products.



The USPTO issued Office Actions against both of Three Twins’ “MAXINE’S” applications, refusing registration of the marks under Section 2(d) of the Lanham Act. The USPTO cited the registered mark MAXINE’S (Reg. No. 4219905) owned by **Hi Performance Health Pty. Ltd.** (hereafter “Hi Performance Health”). Hi Performance Health is an Australian company that makes nutritional and dietary products. The cited MAXINE’S registration covers the following goods:

Class 5:

- Dietetic foods and beverages adapted for medical use and meal replacement substances, namely, cookies, bars and drinks;
- sports nutrition products, namely, dietary and nutritional supplements for endurance sports, and electrolyte replacement solutions;
- food supplements; medicated and pharmaceutical sweets;
- food and nutritional supplements being muscle-building food supplements;
- protein, vitamin and mineral supplements in powder or liquid form;
- dietetic preparations for muscle-building, namely, dietetic cookies, bars, meal replacement drinks and high protein drinks adapted for medical use

Class 29: [Milk; soya milk]

Class 30: Chocolates; cookies; sweets; granola-based snack bars

Notably, these goods do *not* include ice cream. In addition, the class 29 goods (milk and soya milk) were deleted from the registration in August 2018.

Nonetheless, the USPTO continued to refuse registration and issued a Final Office Action against the applications earlier this year. Applicant filed Notices of Appeal as to both applications as well as Requests for Reconsideration which were denied by the USPTO Examining Attorney, and the appeals resumed.

The appeals were consolidated by the Board on November 6, 2018 upon motion by Applicant filed on October 28, 2018. The Board granted extensions of time to file the opening brief to August 12, 2019.

III. ARGUMENT

Pursuant to TBMP Section 1207.02, Applicant respectfully requests suspension of this appeal and remand to the Examining Attorney for consideration of the consent agreement between Applicant and Hi Performance Health Pty Ltd., and the consents as to use of likenesses.

Good cause exists for this request. As stated in TBMP Section 1207.02 “because a consent agreement offered in response to a refusal to register under Trademark Act § 2(d), 15 U.S.C. § 1052(d), is inherently difficult and time-consuming to obtain, and may be highly persuasive of registrability, the Board will grant a request to suspend and remand for consideration of a consent agreement if the request, accompanied by the consent agreement, is filed at any time prior to the rendering of the Board’s final decision on the appeal.”

Applicant notes that Hi Performance Health Pty. Ltd. and a third party, Maxine’s Heavenly, have also agreed to and entered a similar consent agreement which was submitted by Maxine’s Heavenly and accepted by the USPTO. *See* TTAB Proceeding No. 92069909 and Serial No. 87939382. If the USPTO also accepts the consent agreement between Applicant and Hi Performance Health Pty. Ltd., and the Section 2(d) refusal is withdrawn in light of the consent agreement, then this appeal will become moot.

IV. CONCLUSION

For the foregoing reasons, Applicant respectfully requests that this appeal be suspended and the matter be remanded to the Examining Attorney to consider the additional evidence.

DATED: July 31, 2019

Respectfully submitted,

WENDEL ROSEN LLP

By: /Eugene M. Pak/

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Attorneys for Applicant Three Twins Organic, Inc.

EXHIBIT A

CONSENT AGREEMENT

This Consent Agreement (“Agreement”) is entered into by and between Three Twins Organic, Inc. (“Three Twins Organic”), with a mailing address at 419 1st Street Petaluma, California 94952, United States, and Hi-Performance Health Pty Ltd (“Hi-Performance”), with a mailing address at 17 Trade Place, Vermont VIC 3133 Australia, with an Effective Date of the date last signed below.

WHEREAS, Three Twins Organic is the owner of U.S. Application Serial No. 87/386324 for the mark MAXINE'S and U.S. Application Serial No. 87/408691 for the mark MAXINE'S (Device) in connection with “Ice cream” in International Class 030 (hereinafter referred to as “Three Twins Organic’s Marks”);

WHEREAS, Hi-Performance is the owner of all right, title and interest in U.S. Registration No. 4,219,905 for the mark MAXINE’S in connection with “Dietetic foods and beverages adapted for medical use and meal replacement substances, namely, cookies, bars and drinks; sports nutrition products, namely, dietary and nutritional supplements for endurance sports, and electrolyte replacement solutions; food supplements; medicated and pharmaceutical sweets; food and nutritional supplements being muscle-building food supplements; protein, vitamin and mineral supplements in powder or liquid form; dietetic preparations for muscle-building, namely, dietetic cookies, bars, meal replacement drinks and high protein drinks adapted for medical use” in International Class 005 and “Chocolates; cookies; sweets; granola-based snack bars” in International Class 030, as well as registrations and pending applications in Australia, Hong Kong, EU, Japan, Singapore, Indonesia, and Malaysia (hereinafter collectively referred to as “Hi-Performance’s Mark”);

WHEREAS, Three Twins Organic's U.S. Application Serial No. 87/408691 for the mark MAXINE'S and U.S. Application Serial No. 87/386324 for the mark MAXINE'S (Device) were refused registration by the United States Patent & Trademark Office based on a finding of likelihood of confusion with Hi-Performance's U.S. Registration No. 4,219,905 for the mark MAXINE'S;

WHEREAS, the parties wish to settle this matter outside of the administrative procedures of the United States Patent and Trademark Office and the litigation procedures of the United States courts and throughout the world;

NOW THEREFORE, in consideration of mutual covenants, terms and conditions set forth in this Agreement, and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties agree as follows:

1. Hi-Performance consents to and shall not challenge the use or registration of Three Twins Organic's Marks in connection with the goods set forth in Application Serial Nos 87/408691 and 87/386324 (i.e., "ice cream" in International Class 030) or any natural expansion thereof in the U.S and globally, including future applications and registrations, if any, for the Three Twins Organic's Marks for ice cream products, and shall not aid any third party in any such challenge. A "challenge" shall include opposing, cancelling, or attacking the validity or ownership of such applications and registrations for the Three Twins Organic Mark.

2 Three Twins Organic consents to and shall not challenge Hi-Performance's use or registration of its Hi-Performance's Mark in connection with the goods set forth in its registrations and pending applications (which do not include ice cream).. Three Twins Organic agrees not challenge, oppose, or attack the validity of the Registration No. 4,219,905, any existing

registrations, future applications for Hi-Performance's Mark, or any other registrations or future applications with the term or use of MAXINE'S or variations thereof provided that such does not include THREE TWINS or any other combination of MAXINE's in combination with the terms THREE or TWINS, or MAXINE'S in combination with a graphic design of a woman's face that is identical to or substantially similar to the one used in U.S. Application Serial No. 87/408691, anywhere in the world, or Hi-Performance's ownership thereof anywhere in the world for the goods listed in Registration No. 4,219,905 or any natural expansion thereof and shall not aid any third party in any such challenge.

3. The parties agree that there is unlikely to be any consumer confusion between Hi-Performance's Mark and Three Twins Organic's Marks.

4. The parties agree that their respective marks differ in appearance and sound, as set forth in Application Serial No. 87/408691, and as actually used by the parties. .

5. The parties agree that their goods are different and unrelated.

6. The parties agree that their goods are marketed and sold to different consumers through different channels of trade.

7. Each party agrees that their consumers are knowledgeable and sophisticated enough to be able to distinguish between the parties' goods as used with their respective marks.

8. Each party agrees that the differences between their respective marks and goods are significant enough to eliminate any likelihood of consumer confusion.

9. Each party agrees not to represent that they are related to the other or that their goods stem from the same source.

10. The parties do not anticipate that any confusion or mistakes will arise from their simultaneous use of their respective marks. However, in the event that any confusion does arise the parties agree to cooperate to take steps to abate the confusion, and to prevent confusion from recurring.

12. Three Twins Organic agrees to pay Hi-Performance's reasonable attorney fees up to the amount of \$1,500 (One Thousand Five Hundred United States Dollars) in reviewing and finalizing this Agreement. Three Twins Organic shall submit payment to counsel for Hi-Performance within seven (7) business days of receipt of the invoice by wire transfer to the Trust Account of Hi-Performance's counsel, K&L Gates LLP.

13. This Agreement shall be binding upon and shall inure to the benefit of the parties and their respective successors and assigns.

14. This Agreement may only be amended, modified, or supplemented by an agreement in writing signed by each party hereto, and any of the terms thereof may be waived only by a written document signed by the party or parties waiving compliance. Except as otherwise set forth in this Agreement, no failure to exercise, or delay in exercising, any rights, remedy, power, or privilege arising from this Agreement shall operate or be construed as a waiver thereof; nor shall any single or partial exercise of any right, remedy, power, or privilege hereunder preclude any other or further exercise thereof or the exercise of any other right, remedy, power, or privilege.

15. If any term or provision of this Agreement is invalid, illegal, or unenforceable in any jurisdiction, such invalidity, illegality, or unenforceability shall not affect any other term or provision of this Agreement or invalidate or render unenforceable such term or provision in any other jurisdiction.

16. Any notices required or permitted under this Agreement shall be in writing, shall specifically refer to this Agreement, and shall be sent by courier, confirmed electronic mail, or registered or certified mail, postage prepaid, return-receipt requested to the following addresses:

If to Three Twins Organic:

419 1st Street Petaluma,
California 94952
neal@threetwins.com, _____

With a copy to:

William C. Acevedo, Esq.
Eugene M. Pak, Esq.
Wendel Rosen Black & Dean LLP
1111 Broadway, 24th Floor
Oakland, CA 94607
United States
wacevedo@wendel.com; epak@wendel.com

If to Hi-Performance Health Pty Ltd:

17 Trade Place,
Vermont VIC 3133 Australia
paulk@aminoactive.com.au

With a copy to:

Sana Hakim, Esq.
K&L Gates LLP
70 W. Madison St., Suite 3200
Chicago, IL 60602
United States
sana.hakim@klgates.com

All notices under this Agreement shall be effective upon receipt. A party may change its contact information upon written notice to the other party in the manner provided under this paragraph.

17. This Agreement may be executed in multiple counterparts and by facsimile signature, each of which shall be deemed an original and all of which together shall constitute one instrument. A signed copy of this Agreement delivered by facsimile, email, or other means of electronic transmission shall be deemed to have the same legal effect as delivery of an original signed copy of this Agreement.

WHEREFORE the parties have caused this Agreement to be duly executed and become effective on the last date of execution indicated below.

HI-PERFORMANCE HEALTH PTY LTD


By: _____

Name: _____

Title: _____

Date: _____

THREE TWINS ORGANIC

By:  _____

Name: Neil H. Gottlieb

Title: CEO

Date: 4/18/19

WHEREFORE the parties have caused this Agreement to be duly executed and become effective on the last date of execution indicated below.

HI-PERFORMANCE HEALTH PTY LTD

THREE TWINS ORGANIC

By: 

By: _____

Name: Paul Kirkham

Name: _____

Title: Director

Title: _____

Date: 30 May 2019

Date: _____

EXHIBIT B

CONSENT OF NEAL GOTTLIEB

I, NEAL GOTTLIEB , an individual, hereby consent to the use and registration by Three Twins Organic Inc., a California corporation, of my likeness within a trademark with the United States Patent and Trademark Office ("USPTO"), specifically, within Application Serial No. 87408691 (MAXINE'S BY THREE TWINS ICE CREAM and Design) and Reg. No. 3408293 (THREE TWINS ICE CREAM and Design).

Dated: 6/11, 2019

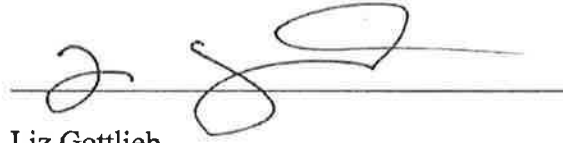
A handwritten signature in black ink, appearing to read 'Neal Gottlieb', is written over a horizontal line.

Neal Gottlieb

CONSENT OF LIZ GOTTLIEB

I, LIZ GOTTLIEB , an individual, hereby consent to the use and registration by Three Twins Organic Inc., a California corporation, of my likeness within a trademark with the United States Patent and Trademark Office ("USPTO"), specifically, within Application Serial No. 87408691 (MAXINE'S BY THREE TWINS ICE CREAM and Design) and Reg. No. 3408293 (THREE TWINS ICE CREAM and Design).

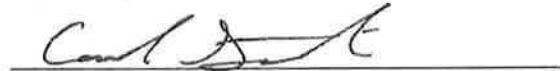
Dated: 6/16, 2019


Liz Gottlieb

CONSENT OF CARL GOTTLIEB

I, CARL GOTTLIEB , an individual, hereby consent to the use and registration by Three Twins Organic Inc., a California corporation, of my likeness within a trademark with the United States Patent and Trademark Office ("USPTO"), specifically, within Application Serial No. 87408691 (MAXINE'S BY THREE TWINS ICE CREAM and Design) and Reg. No. 3408293 (THREE TWINS ICE CREAM and Design).

Dated: 6/16, 2019

A handwritten signature in cursive script, appearing to read "Carl Gottlieb", is written above a solid horizontal line.

Carl Gottlieb