

ESTTA Tracking number: **ESTTA969944**

Filing date: **04/28/2019**

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

Proceeding	91247064
Party	Defendant Prosource Performance Products, Inc.
Correspondence Address	SCOTT E. CHARNEY CHARNEY IP LAW LLC 233 MOUNT AIRY ROAD SUITE 100 BASKING RIDGE, NJ 07920 docket@charneyiplaw.com no phone number provided
Submission	Answer
Filer's Name	Scott E. Charney
Filer's email	docket@charneyiplaw.com
Signature	/scott e. charney/
Date	04/28/2019
Attachments	FILED Answer PROSOURCE PROTEIN.pdf(217711 bytes)

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

<i>MEDTRITION, INC.</i>)	
)	
Opposer)	
)	Opposition No.: 91247064
v.)	
)	App. No.: 87631544
<i>PROSOURCE PERFORMANCE</i>)	
<i>PRODUCTS, INC.</i>)	Mark: PROSOURCE PROTEIN
)	
Applicant)	
_____)	

ANSWER TO NOTICE OF OPPOSITION

Applicant, Prosource Performance Products, Inc. (“Applicant”), through its undersigned attorneys, hereby answers the Notice of Opposition, filed by Opposer, Medtrition, Inc. (“Opposer”), with respect to the above-captioned opposition proceeding as follows:

1. Applicant is without sufficient information to admit or deny the residency or address of Opposer, but nonetheless admits them. Applicant denies that Opposer will be damaged by registration of the mark shown in Serial No. 87/631,544 ("the '544 Application"). Applicant is without sufficient information to admit or deny the remaining allegations of Paragraph 1, and therefore denies them.
2. Applicant admits the allegations of Paragraph 2.
3. Applicant admits the allegations of Paragraph 3.
4. Applicant is without information sufficient to admit or deny the allegations of Paragraph 4, other than Applicant admits that attached to the Notice of Opposition appears to be the TESS entry for U.S. Registration No. 2,191,488 ("the '488 Registration").

5. Applicant is without sufficient information to admit or deny the allegations of Paragraph 5, and therefore denies them.
6. Applicant is without sufficient information to admit or deny the allegations of Paragraph 6, and therefore denies them.
7. Applicant is without sufficient information to admit or deny the allegations of Paragraph 7, and therefore denies them.
8. The Notice of Opposition has no paragraph numbered as paragraph number 8. This entry is merely a placeholder.
9. Applicant denies the allegations of Paragraph 9.
10. Applicant denies the allegations of Paragraph 10.
11. Applicant denies the allegations of Paragraph 11.
12. Applicant denies the allegations of Paragraph 12.
13. Applicant is without sufficient information to admit or deny what Opposer believes, and therefore denies the allegations of Paragraph 13.
14. Applicant is without sufficient information to admit or deny what Opposer believes, and therefore denies the allegations of Paragraph 14.
15. Applicant denies the allegations of Paragraph 15.
16. Applicant denies the allegations of Paragraph 16.

17. As to the unnumbered paragraph starting with "WHEREFORE," to the extent that a response is required, Applicant denies that Opposer is entitled to the requested relief or any other relief.

AFFIRMATIVE DEFENSES

18. Applicant is the owner of U.S. Trademark Registration No. 2,303,469 for the mark PROSOURCE for nutritional supplements in international class 5, with a registration date of December 28, 1999 and dates of first use of September 2016 ("ProSource Registration 1").

19. Applicant is the owner of U.S. Trademark Registration No. 2,278,959 for the mark PROSOURCE for mail order catalog services in the field of nutritional supplements in international class 35, with a registration date of September 21, 1999 and dates of first use of September 15, 1996 ("ProSource Registration 2").

20. Applicant is the owner of U.S. Trademark Registration No. 4,583,704 for the mark PROSOURCE.NET for on-line retail store services featuring dietary and nutritional supplements in international class 35.

21. Attached as Exhibit A are true and correct printouts from the United States Patent and Trademark Office's TESS electronic database showing the current status and title of ProSource Registration 1, ProSource Registration 2, and U.S. Trademark Registration No. 4,583,704.

22. Applicant has been using the mark PROSOURCE in association with nutritional supplements (ProSource Registration 1) and mail order catalog services in the field of nutritional supplements (ProSource Registration 2) long before both the application date and dates of first use of the '488 Registration, and in any event for greater than five years.

23. The '544 Application is directed toward "Nutritional supplements containing protein" in international class 5.

24. The recitation of goods in the '544 Application and ProSource Registration 1 and ProSource Registration 2 are identical in part, at least so related as to be nearly identical, or are substantially similar.

25. The '488 Registration was filed for on March 12, 1997, with dates of first use of October 2, 1997.

AFFIRMATIVE DEFENSE NUMBER 1

26. Based on the coexistence of ProSource Registration 1 and ProSource Registration 2 with the '488 Registration, there is no likelihood of confusion between the '488 Registration and the '544 Application. *In re Strategic Partners, Inc.*, TTAB Serial No. 77903451 (March 28, 2012).

AFFIRMATIVE DEFENSE NUMBER 2

27. Based on the coexistence of ProSource Registration 1 and ProSource Registration 2 with the '488 Registration, Opposer cannot be damaged within the meaning of Lanham Act §13 by registration of the '544 Application. *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 166 USPQ 715 (CCPA 1969).

AFFIRMATIVE DEFENSE NUMBER 3

28. Opposer is contractually and/or equitably estopped from the requested relief because Applicant will then have been prejudiced by conduct relied upon to create the estoppel, namely a prior agreement between the Opposer and Applicant.

WHEREFORE, Applicant requests that this opposition proceeding be dismissed and that that judgment in favor of Applicant and against Opposer be entered.

Respectfully Submitted,

/scott e. charney/
Scott E. Charney, Esq.
CHARNEY IP LAW LLC
233 Mount Airy Road
Suite 100
Basking Ridge, New Jersey 07920
Telephone: (908) 758-1374
Fax: (908) 758-1201
docket@charneyiplaw.com
Attorneys for Applicant

EXHIBIT A



[Trademarks](#) > [Trademark Electronic Search System \(TESS\)](#)

TESS was last updated on Fri Apr 26 05:21:44 EDT 2019

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#)

[Logout](#) Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

[TSDR](#) | [ASSIGN Status](#) | [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)

PROSOURCE

Word Mark	PROSOURCE
Goods and Services	IC 005. US 006 018 044 046 051 052. G & S: NUTRITIONAL SUPPLEMENTS. FIRST USE: 19960900. FIRST USE IN COMMERCE: 19960900
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75431824
Filing Date	February 10, 1998
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	December 1, 1998
Registration Number	2303469
Registration Date	December 28, 1999
Owner	(REGISTRANT) PROSOURCE PERFORMANCE PRODUCTS, INC. CORPORATION NEW JERSEY 2231 Landmark Place Manasquan NEW JERSEY 08736
Attorney of Record	Catherine M. Clayton
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20090929.
Renewal	1ST RENEWAL 20090929
Live/Dead Indicator	LIVE

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [TOP](#) | [HELP](#)



[Trademarks](#) > [Trademark Electronic Search System \(TESS\)](#)

TESS was last updated on Fri Apr 26 05:21:44 EDT 2019

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#)

[Logout](#) Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

[TSDR](#) | [ASSIGN Status](#) | [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)

PROSOURCE

Word Mark PROSOURCE

Goods and Services IC 035. US 100 101 102. G & S: MAIL ORDER CATALOG SERVICES IN THE FIELD OF NUTRITIONAL SUPPLEMENTS. FIRST USE: 19960915. FIRST USE IN COMMERCE: 19960915

Mark Drawing Code (1) TYPED DRAWING

Serial Number 75439998

Filing Date February 25, 1998

Current Basis 1A

Original Filing Basis 1A

Published for Opposition December 8, 1998

Registration Number **2278959**

Registration Date September 21, 1999

Owner (REGISTRANT) PROSOURCE PERFORMANCE PRODUCTS, INC. CORPORATION NEW JERSEY 2231 LANDMARK PLACE MANASQUAN NEW JERSEY 08736

Attorney of Record Catherine M. Clayton

Type of Mark SERVICE MARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20080926.

Renewal 1ST RENEWAL 20080926

Live/Dead Indicator LIVE

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [TOP](#) | [HELP](#)



[Trademarks](#) > [Trademark Electronic Search System \(TESS\)](#)

TESS was last updated on Fri Apr 26 05:21:44 EDT 2019

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#)

[Logout](#) Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

[TSDR](#) | [ASSIGN Status](#) | [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)

PROSOURCE.NET

Word Mark	PROSOURCE.NET
Goods and Services	IC 035. US 100 101 102. G & S: On-line retail store services featuring dietary and nutritional supplements. FIRST USE: 20030000. FIRST USE IN COMMERCE: 20030000
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	86145637
Filing Date	December 17, 2013
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	May 27, 2014
Registration Number	4583704
Registration Date	August 12, 2014
Owner	(REGISTRANT) Prosource Performance Products, Inc. CORPORATION NEW JERSEY 2231 Landmark Place Manasquan NEW JERSEY 08736
Attorney of Record	Catherine M. Clayton
Prior Registrations	2278959;2303469
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [TOP](#) | [HELP](#)

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **ANSWER TO NOTICE OF OPPOSITION** has been served on Lois B. Duquette, representing the Opposer, by forwarding a copy on April 28, 2019, to Michael A. Doctrow, Lois B. Duquette, Carol Steinour Young, Brian P. Gregg, and Emily N. Doan, at McNees Wallace & Nurick LLC, via email to trademarks@mcneeslaw.com, lduquette@mcneeslaw.com, and mdoctrow@mcneeslaw.com.

Dated: April 28, 2019

/scott e. charney/
Scott E. Charney, Esq.
CHARNEY IP LAW LLC
233 Mount Airy Road
Suite 100
Basking Ridge, New Jersey 07920
Telephone: (908) 758-1374
Fax: (908) 758-1201
docket@charneyiplaw.com
Attorneys for Applicant