

ESTTA Tracking number: **ESTTA1106141**

Filing date: **01/06/2021**

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

Proceeding	91254188
Party	Defendant Le-Vel Brands, LLC
Correspondence Address	MARK SOMMERS FINNEGAN HENDERSON FARABOW ET AL 901 NEW YORK AVENUE NW WASHINGTON, DC 20001 UNITED STATES Primary Email: docketing@finnegan.com Secondary Email(s): mark.sommers@finnegan.com , morgan.smith@finnegan.com , patrick.rodgers@finnegan.com , TTAB-Legal-Assistants@finnegan.com 202-408-4000
Submission	Motion for Summary Judgment Yes , the Filer previously made its initial disclosures pursuant to Trademark Rule 2.120(a); OR the motion for summary judgment is based on claim or issue preclusion, or lack of jurisdiction. The deadline for pretrial disclosures for the first testimony period as originally set or reset: 07/08/2021
Filer's Name	Mark Sommers
Filer's email	docketing@finnegan.com , mark.sommers@finnegan.com , morgan.smith@finnegan.com , patrick.rodgers@finnegan.com , TTAB-Legal-Assistants@finnegan.com
Signature	/Mark Sommers/
Date	01/06/2021
Attachments	2021-01-06 Rodgers Dec ISO Le-Vel Motion for Summary Judgment.pdf(3320250 bytes)

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

<p>VITAMIN SHOPPE PROCUREMENT SERVICES, LLC</p> <p style="text-align:center">Opposer</p> <p style="text-align:center">v.</p> <p>LE-VEL BRANDS, LLC</p> <p style="text-align:center">Applicant</p>	<p>Opposition No. 91254188</p> <p>Mark: THRIVE Serial No. 88400489 Filed: April 24, 2019</p>
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**DECLARATION OF PATRICK J. RODGERS IN SUPPORT OF
LE-VEL'S MOTION FOR SUMMARY JUDGMENT**

I, Patrick J. Rodgers, declare as follows:

1. I am an attorney at Finnegan, Henderson, Farabow, Garrett & Dunner LLP and am counsel for Applicant Le-Vel Brands, LLC in this action. I make this declaration in support of Le-Vel's Motion for Summary Judgment. This declaration is based on my personal knowledge.

2. On April 24, 2019, Le-Vel filed Application Serial No. 88400489 for the trademark THRIVE covering (as amended) the following Class 5 goods:

Nutritional supplements and vitamins for health and wellness, excluding frozen nutritional supplements in the nature of frozen nutritionally enhanced ice cream and other nutritional enhanced frozen desserts.

3. Attached as Exhibit 1 is a true and correct copy of the specimen submitted to the United States Patent and Trademark Office ("USPTO") in connection with Le-Vel's Application Serial No. 88400489.

4. On October 2, 2019, a Notice of Publication issued for Le-Vel's Application Serial No. 88400489, and the application was published for opposition on October 22, 2019.

5. The USPTO Examining Attorney did not require proof of secondary meaning nor raise any issue that Le-Vel's THRIVE mark failed to function as a trademark or that "Thrive" was generic for vitamins or supplements in approving Le-Vel's Application Serial No. 88400489 for publication.

6. Attached as Exhibit 2 are true and correct printouts from the USPTO TESS and TSDR databases of the trademark applications and registrations cited by Opposer in Paragraph 4 of Opposer's Notice of Opposition (1 TTABVUE at ¶ 4). None of these trademark applications or registrations disclaim the word "Thrive."

7. Attached as Exhibit 3 are true and correct printouts from the USPTO TESS and TSDR databases of the trademark registrations cited by Opposer in Paragraph 20 of Opposer's Notice of Opposition (1 TTABVUE at ¶ 20). None of these trademark registrations disclaim the word "Thrive."

8. In Paragraph 5 of Opposer's Notice of Opposition, Opposer also references the mark INNERTHRIVE (Reg. No. 4232799) owned by Innerthrive, LLC for dietary and nutritional supplements in Class 5 and on-line retail services featuring dietary and nutritional supplements in Class 35 (1 TTABVUE at ¶ 5). Attached as Exhibit 4 are true and accurate printouts from the USPTO TESS and TSDR databases for the cancelled INNERTHRIVE trademark registration. This registration was cancelled on May 31, 2019 for failure to file an acceptable declaration under Section 8. This registration also did not disclaim the word "Thrive."

9. Attached as Exhibit 5 are true and correct copies of the non-precedential TTAB decisions cited in Le-Vel's Motion for Summary Judgment.

I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct pursuant to 28 U.S.C. § 1746. This declaration was executed on January 6, 2021 in Washington, DC.



Patrick J. Rodgers

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing DECLARATION OF PATRICK J. RODGERS IN SUPPORT OF LE-VEL'S MOTION FOR SUMMARY JUDGMENT was served on January 6, 2021 via e-mail on counsel for Opposer at the following address of record:

James E. Rosini
HUNTON ANDREWS KURTH LLP
200 PARK AVENUE
NEW YORK, NY 10166

aghiam@huntonak.com
jrosini@huntonak.com
jboczko@huntonak.com
sfurst@huntonak.com
tmdocketny@huntonak.com

/ Judy Valusek /
Trademark Legal Assistant

Opposition No. 91254188
Declaration of Patrick J. Rodgers in Support of
Le-Vel's Motion for Summary Judgment

Exhibit 1

Level premium lifestyle capsule

THRIVE

M

FORMULATED FOR MEN



Opposition No. 91254188
Declaration of Patrick J. Rodgers in Support of
Le-Vel's Motion for Summary Judgment

Exhibit 2



United States Patent and Trademark Office

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Start List At: OR Jump to record: **Record 2 out of 2**

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

INSPIRE, NOURISH, THRIVE EVERY DAY.

Word Mark INSPIRE, NOURISH, THRIVE EVERY DAY.**Goods and Services** IC 035. US 100 101 102. G & S: Retail store services, mail order catalog services and online retail store services provided via a global computer network featuring vitamins, minerals, dietary and nutritional supplements, weight loss supplements, foods, beverages and sports performance drinks; promoting public awareness of health and nutrition. FIRST USE: 20150701. FIRST USE IN COMMERCE: 20150701**Standard Characters Claimed****Mark Drawing Code** (4) STANDARD CHARACTER MARK**Serial Number** 87536419**Filing Date** July 20, 2017**Current Basis** 1A**Original Filing Basis** 1B**Published for Opposition** November 21, 2017**Registration Number** 5471372**Registration Date** May 15, 2018**Owner** (REGISTRANT) Vitamin Shoppe Procurement Services, Inc. CORPORATION DELAWARE 300 Harmon Meadow Boulevard Secaucus NEW JERSEY 07094

(LAST LISTED OWNER) VITAMIN SHOPPE PROCUREMENT SERVICES, LLC LIMITED LIABILITY COMPANY DELAWARE 300 HARMON MEADOW BOULEVARD SECAUCUS NEW JERSEY 07094

Assignment Recorded ASSIGNMENT RECORDED**Attorney of Record** James E. Rosini**Type of Mark** SERVICE MARK**Register** PRINCIPAL**Live/Dead Indicator** LIVE

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [TOP](#) | [HELP](#) | [PREV LIST](#) | [CURR LIST](#) | [NEXT LIST](#) | [FIRST DOC](#) | [PREV DOC](#)
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Generated on: This page was generated by TSDR on 2021-01-05 12:36:03 EST

Mark: INSPIRE, NOURISH, THRIVE EVERY DAY.

INSPIRE, NOURISH, THRIVE
EVERY DAY.

US Serial Number: 87536419

Application Filing Date: Jul. 20, 2017

US Registration Number: 5471372

Registration Date: May 15, 2018

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: May 15, 2018

Publication Date: Nov. 21, 2017

Notice of Allowance Date: Jan. 16, 2018

Mark Information

Mark Literal Elements: INSPIRE, NOURISH, THRIVE EVERY DAY.

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For: Retail store services, mail order catalog services and online retail store services provided via a global computer network featuring vitamins, minerals, dietary and nutritional supplements, weight loss supplements, foods, beverages and sports performance drinks; promoting public awareness of health and nutrition

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: Jul. 01, 2015

Use in Commerce: Jul. 01, 2015

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: VITAMIN SHOPPE PROCUREMENT SERVICES, LLC
Owner Address: 300 HARMON MEADOW BOULEVARD
SECAUCUS, NEW JERSEY UNITED STATES 07094
Legal Entity Type: LIMITED LIABILITY COMPANY
State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: James E. Rosini
Attorney Primary Email Address: TMDocketNY@HuntonAK.com
Docket Number: 119137269368
Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: James E. Rosini
Hunton Andrews Kurth LLP
200 Park Avenue
New York, NEW YORK UNITED STATES 10166
Phone: 212-309-1000
Fax: 212-309-1100
Correspondent e-mail: TMDocketNY@HuntonAK.com
Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Nov. 24, 2019	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Nov. 24, 2019	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Jan. 16, 2019	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
May 15, 2018	REGISTERED-PRINCIPAL REGISTER	
Apr. 10, 2018	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Apr. 09, 2018	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Apr. 06, 2018	STATEMENT OF USE PROCESSING COMPLETE	69302
Mar. 15, 2018	USE AMENDMENT FILED	69302
Apr. 02, 2018	CASE ASSIGNED TO INTENT TO USE PARALEGAL	69302
Mar. 15, 2018	TEAS STATEMENT OF USE RECEIVED	
Jan. 16, 2018	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Nov. 21, 2017	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Nov. 21, 2017	PUBLISHED FOR OPPOSITION	
Nov. 01, 2017	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Oct. 19, 2017	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 19, 2017	ASSIGNED TO EXAMINER	93656
Jul. 27, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jul. 24, 2017	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION
Date in Location: Apr. 09, 2018

Assignment Abstract Of Title Information

Summary

Total Assignments: 4
Registrant: Vitamin Shoppe Procurement Services, Inc.

Assignment 1 of 4

Conveyance: ENTITY CONVERSION

Reel/Frame: [6517/0532](#)

Pages: 7

Date Recorded: Jan. 04, 2019

Supporting Documents: [assignment-tm-6517-0532.pdf](#)

Assignor

Name: [VITAMIN SHOPPE PROCUREMENT SERVICES, INC.](#)

Execution Date: May 09, 2018

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Assignee

Name: [VITAMIN SHOPPE PROCUREMENT SERVICES, LLC](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: 300 HARMON MEADOW BOULEVARD
SECAUCUS, NEW JERSEY 07094

Correspondent

Correspondent Name: JAMES E. ROSINI

Correspondent Address: 200 PARK AVENUE
NEW YORK, NY 10166

Domestic Representative - Not Found

Assignment 2 of 4

Conveyance: SECURITY INTEREST

Reel/Frame: [6817/0023](#)

Pages: 44

Date Recorded: Dec. 16, 2019

Supporting Documents: [assignment-tm-6817-0023.pdf](#)

Assignor

Name: [VITAMIN SHOPPE PROCUREMENT SERVICES, LLC](#)

Execution Date: Dec. 16, 2019

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [GACP FINANCE CO., LLC, AS AGENT](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: 11100 SANTA MONICA BLVD., SUITE 800
LOS ANGELES, CALIFORNIA 90025

Correspondent

Correspondent Name: DUSAN CLARK, ESQ.

Correspondent Address: SIDLEY AUSTIN LLP
2021 MCKINNEY AVE., SUITE 2000
DALLAS, TX 75201

Domestic Representative - Not Found

Assignment 3 of 4

Conveyance: SECURITY INTEREST

Reel/Frame: [6826/0907](#)

Pages: 45

Date Recorded: Dec. 27, 2019

Supporting Documents: [assignment-tm-6826-0907.pdf](#)

Assignor

Name: [VITAMIN SHOPPE PROCUREMENT SERVICES, LLC](#)

Execution Date: Dec. 16, 2019

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Where Organized:

DBA, AKA, TA, Formerly: FORMERLY VITAMIN SHOPPE
PROCUREMENT SERVICES, INC.

Assignee

Name: [JPMORGAN CHASE BANK, N.A.](#)

Legal Entity Type: NATIONAL BANKING ASSOCIATION

State or Country Where Organized: UNITED STATES

Address: 237 PARK AVENUE
7TH FLOOR
NEW YORK, NEW YORK 10017

Correspondent

Correspondent Name: SEAN M. HILL

Correspondent Address: 1001 FANNIN STREET, SUITE 2500
VINSON & ELKINS LLP
HOUSTON, TX 77002

Domestic Representative - Not Found**Assignment 4 of 4**

Conveyance: RELEASE BY SECURED PARTY

Reel/Frame: [7060/0923](#)

Pages: 43

Date Recorded: Aug. 25, 2020

Supporting Documents: [assignment-tm-7060-0923.pdf](#)

Assignor

Name: [GACP FINANCE CO., LLC](#)

Execution Date: Aug. 25, 2020

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [VITAMIN SHOPPE PROCUREMENT SERVICES, LLC](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: 300 HARMON MEADOW BLVD
SECAUCUS, NEW JERSEY 07094

Correspondent

Correspondent Name: HEATHER SCHNEIDER

Correspondent Address: 787 SEVENTH AVENUE
NEW YORK, NY 10019

Domestic Representative - Not Found**Proceedings****Summary**

Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding Number: [91254188](#)

Filing Date: Feb 19, 2020

Status: Pending

Status Date: Sep 16, 2020

Interlocutory Attorney: ANDREW P BAXLEY

Defendant

Name: Le-Vel Brands, LLC

Correspondent Address: MARK SOMMERS
FINNEGAN HENDERSON FARABOW ET AL
901 NEW YORK AVENUE NW
WASHINGTON DC UNITED STATES , 20001

Correspondent e-mail: docketing@finnegan.com , mark.sommers@finnegan.com , morgan.smith@finnegan.com , patrick.rodgers@finnegan.com , TTAB-Legal-Assistants@finnegan.com

Associated marks			
Mark	Application Status	Serial Number	Registration Number
THRIVE	Opposition Pending	88400489	

Plaintiff(s)

Name: Vitamin Shoppe Procurement Services, LLC

Correspondent Address: JAMES E ROSINI
HUNTON ANDREWS KURTH LLP
200 PARK AVENUE
NEW YORK NY UNITED STATES , 10166

Correspondent e-mail: aghiam@huntonak.com , jrosini@huntonak.com , jboczko@huntonak.com , sfurst@huntonak.com , tmdocketny@huntonak.com

Associated marks			
Mark	Application Status	Serial Number	Registration Number
INSPIRE, NOURISH, THRIVE EVERY DAY.	Registered	87536419	5471372
THRIVE EVERY DAY	Registered	88320340	5850922
VTHRIVE THE VITAMIN SHOPPE	Suspension Letter - Mailed	88337530	
VTHRIVE THE VITAMIN SHOPPE	Suspension Letter - Mailed	88337522	

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Feb 19, 2020	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Feb 19, 2020	Mar 30, 2020
3	INSTITUTED	Feb 19, 2020	
4	D CHANGE OF CORRESP ADDRESS	Mar 30, 2020	
5	D MOT TO DISMISS: FRCP 12(B)	Mar 30, 2020	
6	P CHANGE OF CORRESP ADDRESS	Mar 30, 2020	
7	P MOT FOR EXT W/ CONSENT	Apr 09, 2020	
8	SUSP PEND DISP OF OUTSTNDNG MOT	Apr 27, 2020	
9	P OPP/RESP TO MOTION	May 05, 2020	
10	D REPLY IN SUPPORT OF MOTION	May 22, 2020	
11	TRIAL DATES RESET	Sep 16, 2020	
12	CHANGE OF CORRESP ADDRESS	Sep 18, 2020	
13	ANSWER	Oct 26, 2020	
14	P APPEARANCE / POWER OF ATTORNEY	Dec 07, 2020	



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Trademarks > Trademark Electronic Search System (TESS)

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THRIVE EVERY DAY

Word Mark THRIVE EVERY DAY

Goods and Services IC 003. US 001 004 006 050 051 052. G & S: Essential oils for use in aromatherapy. FIRST USE: 20160600. FIRST USE IN COMMERCE: 20160600

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 88320340

Filing Date February 28, 2019

Current Basis 1A

Original Filing Basis 1A

Published for Opposition June 18, 2019

Registration Number 5850922

Registration Date September 3, 2019

Owner (REGISTRANT) Vitamin Shoppe Procurement Services, LLC LIMITED LIABILITY COMPANY DELAWARE 300 Harmon Meadow Boulevard Secaucus NEW JERSEY 07094

Attorney of Record James E. Rosini

Prior Registrations 5471372

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

- [TESS HOME](#)
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Mark: THRIVE EVERY DAY

THRIVE EVERY DAY

US Serial Number: 88320340

Application Filing Date: Feb. 28, 2019

US Registration Number: 5850922

Registration Date: Sep. 03, 2019

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Sep. 03, 2019

Publication Date: Jun. 18, 2019

Mark Information

Mark Literal Elements: THRIVE EVERY DAY

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Claimed Ownership of US Registrations: 5471372

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (..) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Essential oils for use in aromatherapy

International Class(es): 003 - Primary Class

U.S Class(es): 001, 004, 006, 050, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Jun. 2016

Use in Commerce: Jun. 2016

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Vitamin Shoppe Procurement Services, LLC

Owner Address: 300 Harmon Meadow Boulevard
Secaucus, NEW JERSEY UNITED STATES 07094

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: James E. Rosini

Docket Number: 119137-00028

Attorney Primary Email Address: TMDocketNY@HuntonAK.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: James E. Rosini
Hunton Andrews Kurth LLP
200 Park Avenue
New York, NEW YORK UNITED STATES 10166

Phone: 212-309-1000

Fax: 212-309-1100

Correspondent e-mail: TMDocketNY@HuntonAK.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Nov. 24, 2019	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Nov. 24, 2019	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Sep. 03, 2019	REGISTERED-PRINCIPAL REGISTER	
Jun. 18, 2019	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jun. 18, 2019	PUBLISHED FOR OPPOSITION	
May 29, 2019	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
May 13, 2019	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 09, 2019	ASSIGNED TO EXAMINER	94369
Mar. 20, 2019	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Mar. 04, 2019	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Sep. 03, 2019

Assignment Abstract Of Title Information

Summary

Total Assignments: 3

Registrant: Vitamin Shoppe Procurement Services, LLC

Assignment 1 of 3

Conveyance: SECURITY INTEREST

Reel/Frame: [6817/0023](#)

Pages: 44

Date Recorded: Dec. 16, 2019

Supporting Documents: [assignment-tm-6817-0023.pdf](#)

Assignor**Name:** [VITAMIN SHOPPE PROCUREMENT SERVICES, LLC](#)**Execution Date:** Dec. 16, 2019**Legal Entity Type:** LIMITED LIABILITY COMPANY**State or Country Where Organized:** No Place Where Organized Found**Assignee****Name:** [GACP FINANCE CO., LLC, AS AGENT](#)**Legal Entity Type:** LIMITED LIABILITY COMPANY**State or Country Where Organized:** DELAWARE**Address:** 11100 SANTA MONICA BLVD., SUITE 800
LOS ANGELES, CALIFORNIA 90025**Correspondent****Correspondent Name:** DUSAN CLARK, ESQ.**Correspondent Address:** SIDLEY AUSTIN LLP
2021 MCKINNEY AVE., SUITE 2000
DALLAS, TX 75201**Domestic Representative - Not Found****Assignment 2 of 3****Conveyance:** SECURITY INTEREST**Reel/Frame:** [6826/0907](#)**Pages:** 45**Date Recorded:** Dec. 27, 2019**Supporting Documents:** [assignment-tm-6826-0907.pdf](#)**Assignor****Name:** [VITAMIN SHOPPE PROCUREMENT SERVICES, LLC](#)**Execution Date:** Dec. 16, 2019**Legal Entity Type:** LIMITED LIABILITY COMPANY**State or Country Where Organized:** DELAWARE**DBA, AKA, TA, Formerly:** FORMERLY VITAMIN SHOPPE
PROCUREMENT SERVICES, INC.**Assignee****Name:** [JPMORGAN CHASE BANK, N.A.](#)**Legal Entity Type:** NATIONAL BANKING ASSOCIATION**State or Country Where Organized:** UNITED STATES**Address:** 237 PARK AVENUE
7TH FLOOR
NEW YORK, NEW YORK 10017**Correspondent****Correspondent Name:** SEAN M. HILL**Correspondent Address:** 1001 FANNIN STREET, SUITE 2500
VINSON & ELKINS LLP
HOUSTON, TX 77002**Domestic Representative - Not Found****Assignment 3 of 3****Conveyance:** RELEASE BY SECURED PARTY**Reel/Frame:** [7060/0923](#)**Pages:** 43**Date Recorded:** Aug. 25, 2020**Supporting Documents:** [assignment-tm-7060-0923.pdf](#)**Assignor****Name:** [GACP FINANCE CO., LLC](#)**Execution Date:** Aug. 25, 2020**Legal Entity Type:** LIMITED LIABILITY COMPANY**State or Country Where Organized:** No Place Where Organized Found**Assignee**

Name: [VITAMIN SHOPPE PROCUREMENT SERVICES, LLC](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: 300 HARMON MEADOW BLVD
SECAUCUS, NEW JERSEY 07094

Correspondent

Correspondent Name: HEATHER SCHNEIDER

Correspondent Address: 787 SEVENTH AVENUE
NEW YORK, NY 10019

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding Number: [91254188](#)

Filing Date: Feb 19, 2020

Status: Pending

Status Date: Sep 16, 2020

Interlocutory Attorney: ANDREW P BAXLEY

Defendant

Name: Le-Vel Brands, LLC

Correspondent Address: MARK SOMMERS
FINNEGAN HENDERSON FARABOW ET AL
901 NEW YORK AVENUE NW
WASHINGTON DC UNITED STATES , 20001

Correspondent e-mail: docketing@finnegan.com , mark.sommers@finnegan.com , morgan.smith@finnegan.com , patrick.rodgers@finnegan.com , [TTAB-Legal-Assistants@finnegan.com](#)

Associated marks

Mark	Application Status	Serial Number	Registration Number
THRIVE	Opposition Pending	88400489	

Plaintiff(s)

Name: Vitamin Shoppe Procurement Services, LLC

Correspondent Address: JAMES E ROSINI
HUNTON ANDREWS KURTH LLP
200 PARK AVENUE
NEW YORK NY UNITED STATES , 10166

Correspondent e-mail: aghiam@huntonak.com , jrosini@huntonak.com , jboczko@huntonak.com , sfurst@huntonak.com , tmdocketny@huntonak.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
INSPIRE, NOURISH, THRIVE EVERY DAY.	Registered	87536419	5471372
THRIVE EVERY DAY	Registered	88320340	5850922
VTHRIVE THE VITAMIN SHOPPE	Suspension Letter - Mailed	88337530	
VTHRIVE THE VITAMIN SHOPPE	Suspension Letter - Mailed	88337522	

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Feb 19, 2020	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Feb 19, 2020	Mar 30, 2020
3	INSTITUTED	Feb 19, 2020	
4	D CHANGE OF CORRESP ADDRESS	Mar 30, 2020	
5	D MOT TO DISMISS: FRCP 12(B)	Mar 30, 2020	

6	P CHANGE OF CORRESP ADDRESS	Mar 30, 2020
7	P MOT FOR EXT W/ CONSENT	Apr 09, 2020
8	SUSP PEND DISP OF OUTSTNDNG MOT	Apr 27, 2020
9	P OPP/RESP TO MOTION	May 05, 2020
10	D REPLY IN SUPPORT OF MOTION	May 22, 2020
11	TRIAL DATES RESET	Sep 16, 2020
12	CHANGE OF CORRESP ADDRESS	Sep 18, 2020
13	ANSWER	Oct 26, 2020
14	P APPEARANCE / POWER OF ATTORNEY	Dec 07, 2020



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Record 1 out of 1

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[TTAB Status](#)

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Word Mark VTHRIVE THE VITAMIN SHOPPE

Goods and Services IC 035. US 100 101 102. G & S: Retail store services, mail order catalog services and online retail store services provided via a global computer network featuring vitamins, nutritional supplements, complementary and alternative medicine products, books, herbal products, aromatherapy products, bath and shower products, health and beauty products, skin treatment creams; providing incentive award programs for customers through issuance and processing of loyalty coupons for frequent use of participating businesses; promoting public awareness of the need for beneficial and nutritious lifestyles and taking daily vitamins and supplement via an in-store program

Mark Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number 88337530

Filing Date March 13, 2019

Current Basis 1B

Original Filing Basis 1B

Owner (APPLICANT) Vitamin Shoppe Procurement Services, LLC LIMITED LIABILITY COMPANY DELAWARE 300 Harmon Meadow Boulevard Secaucus NEW JERSEY 07094

Attorney of Record James E. Rosini

Description of Mark Color is not claimed as a feature of the mark. The mark consists of a stylized "V" with the word "thrive" above the wording "THE VITAMIN SHOPPE".

Type of Mark SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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[HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)

Generated on: This page was generated by TSDR on 2021-01-05 12:38:58 EST

Mark: VTHRIVE THE VITAMIN SHOPPE



US Serial Number: 88337530

Application Filing Date: Mar. 13, 2019

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Under Examination

The trademark application has been accepted by the Office (has met the minimum filing requirements) and that this application has been assigned to an examiner.

Status: An Office action suspending further action on the application has been sent (issued) to the applicant. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Aug. 03, 2020

Mark Information

Mark Literal Elements: VTHRIVE THE VITAMIN SHOPPE

Standard Character Claim: No

Mark Drawing Type: 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

Description of Mark: The mark consists of a stylized "V" with the word "thrive" above the wording "THE VITAMIN SHOPPE".

Color(s) Claimed: Color is not claimed as a feature of the mark.

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Retail store services, mail order catalog services and online retail store services provided via a global computer network featuring vitamins, nutritional supplements, complementary and alternative medicine products, books, herbal products, aromatherapy products, bath and shower products, health and beauty products, skin treatment creams; providing incentive award programs for customers through issuance and processing of loyalty coupons for frequent use of participating businesses; promoting public awareness of the need for beneficial and nutritious lifestyles and taking daily vitamins and supplement via an in-store program

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Filed ITU: Yes

Currently ITU: Yes

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Vitamin Shoppe Procurement Services, LLC

Owner Address: 300 Harmon Meadow Boulevard
Secaucus, NEW JERSEY UNITED STATES 07094

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: James E. Rosini

Docket Number: 119137-00039

Attorney Primary Email Address: TMDocketNY@HuntonAK.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: James E. Rosini
Hunton Andrews Kurth LLP
200 Park Avenue
New York, NEW YORK UNITED STATES 10166

Phone: 212-309-1000

Fax: 212-309-1100

Correspondent e-mail: TMDocketNY@HuntonAK.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Aug. 03, 2020	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Aug. 03, 2020	LETTER OF SUSPENSION E-MAILED	6332
Aug. 03, 2020	SUSPENSION LETTER WRITTEN	94351
Jul. 23, 2020	LIE CHECKED SUSP - TO ATTY FOR ACTION	70629
Jul. 20, 2020	ASSIGNED TO LIE	70629
Dec. 17, 2019	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Dec. 17, 2019	LETTER OF SUSPENSION E-MAILED	6332
Dec. 17, 2019	SUSPENSION LETTER WRITTEN	94351
Dec. 03, 2019	ASSIGNED TO EXAMINER	94351
Nov. 24, 2019	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Nov. 24, 2019	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Nov. 15, 2019	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Nov. 14, 2019	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Nov. 14, 2019	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
May 20, 2019	COMBINED EXAMINER'S AMENDMENT/PRIORITY ACTION ENTERED	76568
May 20, 2019	ASSIGNED TO LIE	76568
May 20, 2019	NOTIFICATION OF EXAMINER'S AMENDMENT/PRIORITY ACTION E-MAILED	6326
May 20, 2019	EXAMINER'S AMENDMENT/PRIORITY ACTION E-MAILED	6326
May 20, 2019	EXAMINERS AMENDMENT AND/OR PRIORITY ACTION - COMPLETED	94369
May 09, 2019	ASSIGNED TO EXAMINER	94369
Mar. 30, 2019	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Mar. 16, 2019	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: MCCARTHY, JOSEPH PATRI

Law Office Assigned: LAW OFFICE 127

File Location

Current Location: TMO LAW OFFICE 127 - EXAMINING

Date in Location: Aug. 03, 2020

Assignment Abstract Of Title Information

Summary

Total Assignments: 3

Applicant: Vitamin Shoppe Procurement Services, LLC

Assignment 1 of 3

Conveyance: SECURITY INTEREST

Reel/Frame: [6817/0023](#)

Pages: 44

Date Recorded: Dec. 16, 2019

Supporting Documents: [assignment-tm-6817-0023.pdf](#)

Assignor

Name: [VITAMIN SHOPPE PROCUREMENT SERVICES, LLC](#)

Execution Date: Dec. 16, 2019

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [GACP FINANCE CO., LLC, AS AGENT](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: 11100 SANTA MONICA BLVD., SUITE 800
LOS ANGELES, CALIFORNIA 90025

Correspondent

Correspondent Name: DUSAN CLARK, ESQ.

Correspondent Address: SIDLEY AUSTIN LLP
2021 MCKINNEY AVE., SUITE 2000
DALLAS, TX 75201

Domestic Representative - Not Found

Assignment 2 of 3

Conveyance: SECURITY INTEREST

Reel/Frame: [6826/0907](#)

Pages: 45

Date Recorded: Dec. 27, 2019

Supporting Documents: [assignment-tm-6826-0907.pdf](#)

Assignor

Name: [VITAMIN SHOPPE PROCUREMENT SERVICES, LLC](#)

Execution Date: Dec. 16, 2019

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

DBA, AKA, TA, Formerly: FORMERLY VITAMIN SHOPPE
PROCUREMENT SERVICES, INC.

Assignee

Name: [JPMORGAN CHASE BANK, N.A.](#)

Legal Entity Type: NATIONAL BANKING ASSOCIATION

State or Country Where Organized: UNITED STATES

Address: 237 PARK AVENUE
7TH FLOOR
NEW YORK, NEW YORK 10017

Correspondent

Correspondent Name: SEAN M. HILL

Correspondent Address: 1001 FANNIN STREET, SUITE 2500
VINSON & ELKINS LLP
HOUSTON, TX 77002

Domestic Representative - Not Found

Assignment 3 of 3

Conveyance: RELEASE BY SECURED PARTY

Reel/Frame: [7060/0923](#)

Pages: 43

Date Recorded: Aug. 25, 2020

Supporting Documents: [assignment-tm-7060-0923.pdf](#)

Assignor

Name: [GACP FINANCE CO., LLC](#)

Execution Date: Aug. 25, 2020

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [VITAMIN SHOPPE PROCUREMENT SERVICES, LLC](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: 300 HARMON MEADOW BLVD
SECAUCUS, NEW JERSEY 07094

Correspondent

Correspondent Name: HEATHER SCHNEIDER

Correspondent Address: 787 SEVENTH AVENUE
NEW YORK, NY 10019

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding Number: [91254188](#)

Filing Date: Feb 19, 2020

Status: Pending

Status Date: Sep 16, 2020

Interlocutory Attorney: ANDREW P BAXLEY

Defendant

Name: Le-Vel Brands, LLC

Correspondent Address: MARK SOMMERS
FINNEGAN HENDERSON FARABOW ET AL
901 NEW YORK AVENUE NW
WASHINGTON DC UNITED STATES , 20001

Correspondent e-mail: docketing@finnegan.com , mark.sommers@finnegan.com , morgan.smith@finnegan.com , patrick.rodgers@finnegan.com , TTAB-Legal-Assistants@finnegan.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
THRIVE	Opposition Pending	88400489	

Plaintiff(s)

Name: Vitamin Shoppe Procurement Services, LLC

Correspondent Address: JAMES E ROSINI
HUNTON ANDREWS KURTH LLP
200 PARK AVENUE
NEW YORK NY UNITED STATES , 10166

Correspondent e-mail: agham@huntonak.com , rosini@huntonak.com , jboczko@huntonak.com , sfurst@huntonak.com , tmdocketny@huntonak.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
INSPIRE, NOURISH, THRIVE EVERY DAY.	Registered	87536419	5471372
THRIVE EVERY DAY	Registered	88320340	5850922
VTHRIVE THE VITAMIN SHOPPE	Suspension Letter - Mailed	88337530	
VTHRIVE THE VITAMIN SHOPPE	Suspension Letter - Mailed	88337522	

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Feb 19, 2020	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Feb 19, 2020	Mar 30, 2020
3	INSTITUTED	Feb 19, 2020	
4	D CHANGE OF CORRESP ADDRESS	Mar 30, 2020	
5	D MOT TO DISMISS: FRCP 12(B)	Mar 30, 2020	
6	P CHANGE OF CORRESP ADDRESS	Mar 30, 2020	
7	P MOT FOR EXT W/ CONSENT	Apr 09, 2020	
8	SUSP PEND DISP OF OUTSTNDNG MOT	Apr 27, 2020	
9	P OPP/RESP TO MOTION	May 05, 2020	
10	D REPLY IN SUPPORT OF MOTION	May 22, 2020	
11	TRIAL DATES RESET	Sep 16, 2020	
12	CHANGE OF CORRESP ADDRESS	Sep 18, 2020	
13	ANSWER	Oct 26, 2020	
14	P APPEARANCE / POWER OF ATTORNEY	Dec 07, 2020	



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Word Mark VTHRIVE THE VITAMIN SHOPPE

Goods and Services IC 005. US 006 018 044 046 051 052. G & S: Vitamins; mineral, dietary and nutritional supplements; dietary and nutritional supplement for sports nutrition, body building, muscle gain and training; nutritional drink mixes and powders in the nature of powdered nutritional supplement drink mixes for use as a meal replacement

Mark Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number 88337522

Filing Date March 13, 2019

Current Basis 1B

Original Filing Basis 1B

Owner (APPLICANT) Vitamin Shoppe Procurement Services, LLC LIMITED LIABILITY COMPANY DELAWARE 300 Harmon Meadow Boulevard Secaucus NEW JERSEY 07094

Attorney of Record James E. Rosini

Description of Mark Color is not claimed as a feature of the mark. The mark consists of a stylized V with the word thrive above the words THE VITAMIN SHOPPE.

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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Mark: VTHRIVE THE VITAMIN SHOPPE



US Serial Number: 88337522

Application Filing Date: Mar. 13, 2019

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Under Examination

The trademark application has been accepted by the Office (has met the minimum filing requirements) and that this application has been assigned to an examiner.

Status: An Office action suspending further action on the application has been sent (issued) to the applicant. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Aug. 03, 2020

Mark Information

Mark Literal Elements: VTHRIVE THE VITAMIN SHOPPE

Standard Character Claim: No

Mark Drawing Type: 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

Description of Mark: The mark consists of a stylized V with the word thrive above the words THE VITAMIN SHOPPE.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Vitamins; mineral, dietary and nutritional supplements; dietary and nutritional supplement for sports nutrition, body building, muscle gain and training; nutritional drink mixes and powders in the nature of powdered nutritional supplement drink mixes for use as a meal replacement

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Filed ITU: Yes

Currently ITU: Yes

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Vitamin Shoppe Procurement Services, LLC

Owner Address: 300 Harmon Meadow Boulevard
Secaucus, NEW JERSEY UNITED STATES 07094

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: James E. Rosini

Docket Number: 119137-00038

Attorney Primary Email Address: TMDocketNY@HuntonAK.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: James E. Rosini
Hunton Andrews Kurth LLP
200 Park Avenue
New York, NEW YORK UNITED STATES 10166

Phone: 212-309-1000

Fax: 212-309-1100

Correspondent e-mail: TMDocketNY@HuntonAK.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Aug. 03, 2020	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Aug. 03, 2020	LETTER OF SUSPENSION E-MAILED	6332
Aug. 03, 2020	SUSPENSION LETTER WRITTEN	94351
Jul. 23, 2020	LIE CHECKED SUSP - TO ATTY FOR ACTION	70629
Jul. 20, 2020	ASSIGNED TO LIE	70629
Dec. 17, 2019	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Dec. 17, 2019	LETTER OF SUSPENSION E-MAILED	6332
Dec. 17, 2019	SUSPENSION LETTER WRITTEN	94351
Dec. 03, 2019	ASSIGNED TO EXAMINER	94351
Nov. 24, 2019	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Nov. 24, 2019	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Nov. 15, 2019	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Nov. 14, 2019	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Nov. 14, 2019	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
May 20, 2019	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
May 20, 2019	NON-FINAL ACTION E-MAILED	6325
May 20, 2019	NON-FINAL ACTION WRITTEN	94369
May 09, 2019	ASSIGNED TO EXAMINER	94369
Mar. 30, 2019	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Mar. 16, 2019	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: MCCARTHY, JOSEPH PATRI

Law Office Assigned: LAW OFFICE 127

File Location

Current Location: TMO LAW OFFICE 127 - EXAMINING ATTORNEY ASSIGNED

Date in Location: Aug. 03, 2020

Assignment Abstract Of Title Information

Summary

Total Assignments: 3

Applicant: Vitamin Shoppe Procurement Services, LLC

Assignment 1 of 3

Conveyance: SECURITY INTEREST

Reel/Frame: [6817/0023](#)

Pages: 44

Date Recorded: Dec. 16, 2019

Supporting Documents: [assignment-tm-6817-0023.pdf](#)

Assignor

Name: [VITAMIN SHOPPE PROCUREMENT SERVICES, LLC](#)

Execution Date: Dec. 16, 2019

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [GACP FINANCE CO., LLC, AS AGENT](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: 11100 SANTA MONICA BLVD., SUITE 800
LOS ANGELES, CALIFORNIA 90025

Correspondent

Correspondent Name: DUSAN CLARK, ESQ.

Correspondent Address: SIDLEY AUSTIN LLP
2021 MCKINNEY AVE., SUITE 2000
DALLAS, TX 75201

Domestic Representative - Not Found

Assignment 2 of 3

Conveyance: SECURITY INTEREST

Reel/Frame: [6826/0907](#)

Pages: 45

Date Recorded: Dec. 27, 2019

Supporting Documents: [assignment-tm-6826-0907.pdf](#)

Assignor

Name: [VITAMIN SHOPPE PROCUREMENT SERVICES, LLC](#)

Execution Date: Dec. 16, 2019

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

DBA, AKA, TA, Formerly: FORMERLY VITAMIN SHOPPE
PROCUREMENT SERVICES, INC.

Assignee

Name: [JPMORGAN CHASE BANK, N.A.](#)

Legal Entity Type: NATIONAL BANKING ASSOCIATION

State or Country Where Organized: UNITED STATES

Address: 237 PARK AVENUE
7TH FLOOR
NEW YORK, NEW YORK 10017

Correspondent

Correspondent Name: SEAN M. HILL

Correspondent Address: 1001 FANNIN STREET, SUITE 2500
VINSON & ELKINS LLP
HOUSTON, TX 77002

Domestic Representative - Not Found

Assignment 3 of 3

Conveyance: RELEASE BY SECURED PARTY

Reel/Frame: [7060/0923](#)

Pages: 43

Date Recorded: Aug. 25, 2020

Supporting Documents: [assignment-tm-7060-0923.pdf](#)

Assignor

Name: [GACP FINANCE CO., LLC](#) Execution Date: Aug. 25, 2020
Legal Entity Type: LIMITED LIABILITY COMPANY State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [VITAMIN SHOPPE PROCUREMENT SERVICES, LLC](#)
Legal Entity Type: LIMITED LIABILITY COMPANY State or Country Where Organized: DELAWARE
Address: 300 HARMON MEADOW BLVD
SECAUCUS, NEW JERSEY 07094

Correspondent

Correspondent Name: HEATHER SCHNEIDER
Correspondent Address: 787 SEVENTH AVENUE
NEW YORK, NY 10019

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding Number: [91254188](#) Filing Date: Feb 19, 2020
Status: Pending Status Date: Sep 16, 2020
Interlocutory Attorney: ANDREW P BAXLEY

Defendant

Name: Le-Vel Brands, LLC
Correspondent Address: MARK SOMMERS
FINNEGAN HENDERSON FARABOW ET AL
901 NEW YORK AVENUE NW
WASHINGTON DC UNITED STATES , 20001
Correspondent e-mail: docketing@finnegan.com , mark.sommers@finnegan.com , morgan.smith@finnegan.com , patrick.rodgers@finnegan.com , TTAB-Legal-Assistants@finnegan.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
THRIVE	Opposition Pending	88400489	

Plaintiff(s)

Name: Vitamin Shoppe Procurement Services, LLC
Correspondent Address: JAMES E ROSINI
HUNTON ANDREWS KURTH LLP
200 PARK AVENUE
NEW YORK NY UNITED STATES , 10166
Correspondent e-mail: aghiam@huntonak.com , jrosini@huntonak.com , jbczko@huntonak.com , sfurst@huntonak.com , tmdocketny@huntonak.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
INSPIRE, NOURISH, THRIVE EVERY DAY.	Registered	87536419	5471372
THRIVE EVERY DAY	Registered	88320340	5850922
VTHRIVE THE VITAMIN SHOPPE	Suspension Letter - Mailed	88337530	

Prosecution History

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2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Feb 19, 2020	Mar 30, 2020
3	INSTITUTED	Feb 19, 2020	
4	D CHANGE OF CORRESP ADDRESS	Mar 30, 2020	
5	D MOT TO DISMISS: FRCP 12(B)	Mar 30, 2020	
6	P CHANGE OF CORRESP ADDRESS	Mar 30, 2020	
7	P MOT FOR EXT W/ CONSENT	Apr 09, 2020	
8	SUSP PEND DISP OF OUTSTNDNG MOT	Apr 27, 2020	
9	P OPP/RESP TO MOTION	May 05, 2020	
10	D REPLY IN SUPPORT OF MOTION	May 22, 2020	
11	TRIAL DATES RESET	Sep 16, 2020	
12	CHANGE OF CORRESP ADDRESS	Sep 18, 2020	
13	ANSWER	Oct 26, 2020	
14	P APPEARANCE / POWER OF ATTORNEY	Dec 07, 2020	

Opposition No. 91254188
Declaration of Patrick J. Rodgers in Support of
Le-Vel's Motion for Summary Judgment

Exhibit 3



United States Patent and Trademark Office

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TESS was last updated on Tue Jan 5 03:32:22 EST 2021

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#) 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)***THRIVIDA DON'T JUST
LIVE...THRIVE!**

Word Mark THRIVIDA DON'T JUST LIVE...THRIVE!

Goods and Services IC 005. US 006 018 044 046 051 052. G & S: Dietary and nutritional supplements; Dietary food supplements; Nutritionally fortified water; Powdered nutritional supplement drink mix. FIRST USE: 20150311. FIRST USE IN COMMERCE: 20150701

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 86499736

Filing Date January 9, 2015

Current Basis 1A

Original Filing Basis 1B

Published for Opposition June 2, 2015

Registration Number **4875814**

Registration Date December 22, 2015

Owner (REGISTRANT) Essential Beverage Company CORPORATION NEVADA PO Box 568 Southeastern PENNSYLVANIA 19399

(LAST LISTED OWNER) BOHNER, RICHARD E. INDIVIDUAL UNITED STATES 1201 BRENTFORD LANE MALVERN PENNSYLVANIA 19355

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Adam Garson

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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Mark: THRIVIDA DON'T JUST LIVE...THRIVE!

THRIVIDA DON'T JUST
LIVE...THRIVE!

US Serial Number: 86499736

Application Filing Date: Jan. 09, 2015

US Registration Number: 4875814

Registration Date: Dec. 22, 2015

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Cancellation/Invalidation Pending

This trademark application has been registered with the Office, but it is currently undergoing a challenge which may result in its removal from the registry.

Status: A cancellation proceeding is pending at the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Status Date: Nov. 03, 2020

Publication Date: Jun. 02, 2015

Notice of Allowance Date: Jul. 28, 2015

Mark Information

Mark Literal Elements: THRIVIDA DON'T JUST LIVE...THRIVE!

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Parent Of: 86977717

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (..) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Dietary and nutritional supplements; Dietary food supplements; Nutritionally fortified water; Powdered nutritional supplement drink mix

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Mar. 11, 2015

Use in Commerce: Jul. 01, 2015

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: BOHNER, RICHARD E.

Owner Address: 1201 BRENTFORD LANE
MALVERN, PENNSYLVANIA UNITED STATES 19355

Legal Entity Type: INDIVIDUAL

Citizenship: UNITED STATES

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Adam Garson

Docket Number: 173-2

Attorney Primary Email Address: agarson@lwh-law.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: RICHARD E. BOHNER
1201 BRENTFORD LANE
MALVERN, PENNSYLVANIA UNITED STATES 19355

Phone: (610) 565-7630

Fax: 610-565-7631

Correspondent e-mail: agarson@lwh-law.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Nov. 03, 2020	CANCELLATION INSTITUTED NO. 999999	75629
Jan. 25, 2017	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Dec. 22, 2015	REGISTERED-PRINCIPAL REGISTER	
Nov. 19, 2015	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Nov. 18, 2015	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Nov. 17, 2015	STATEMENT OF USE PROCESSING COMPLETE	66230
Nov. 04, 2015	USE AMENDMENT FILED	66230
Nov. 04, 2015	TEAS STATEMENT OF USE RECEIVED	
Nov. 04, 2015	CORRECTED NOA E-MAILED	
Nov. 03, 2015	DIVISIONAL PROCESSING COMPLETE	
Sep. 29, 2015	DIVISIONAL REQUEST RECEIVED	
Oct. 16, 2015	CASE ASSIGNED TO INTENT TO USE PARALEGAL	66230
Sep. 29, 2015	TEAS REQUEST TO DIVIDE RECEIVED	
Jul. 28, 2015	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Jun. 02, 2015	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jun. 02, 2015	PUBLISHED FOR OPPOSITION	
May 13, 2015	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Apr. 16, 2015	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 14, 2015	ASSIGNED TO EXAMINER	81092
Jan. 23, 2015	NOTICE OF PSEUDO MARK E-MAILED	
Jan. 22, 2015	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jan. 13, 2015	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Nov. 18, 2015

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Registrant: Essential Beverage Company

Assignment 1 of 1

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [5961/0178](#)

Pages: 5

Date Recorded: Jan. 09, 2017

Supporting Documents: [assignment-tm-5961-0178.pdf](#)

Assignor

Name: [THE ESSENTIAL BUSINESS COMPANY](#)

Execution Date: Jan. 06, 2017

Legal Entity Type: CORPORATION

State or Country Where Organized: NEVADA

Assignee

Name: [BOHNER, RICHARD E.](#)

Legal Entity Type: INDIVIDUAL

Citizenship: UNITED STATES

Address: 1201 BRENTFORD LANE
MALVERN, PENNSYLVANIA 19355

Correspondent

Correspondent Name: ADAM G. GARSON

Correspondent Address: 201 N. JACKSON ST.
MEDIA, PA 19063

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Cancellation

Proceeding Number: [92075629](#)

Filing Date: Nov 02, 2020

Status: Suspended

Status Date: Dec 23, 2020

Interlocutory Attorney: YONG OH (RICHARD) KIM

Defendant

Name: Richard e. Bohner

Correspondent Address: RICHARD E. BOHNER
1201 BRENTFORD LANE
MALVERN PA UNITED STATES , 19355

Associated marks

Mark	Application Status	Serial Number	Registration Number
THRIVIDA	Cancellation Pending	86499474	4856873
THRIVIDA DON'T JUST LIVE...THRIVE!	Cancellation Pending	86499736	4875814
THRIVIDA DON'T JUST LIVE... THRIVE!	Cancellation Pending	86501793	4852642
THRIVIDA DON'T JUST LIVE...THRIVE!	Cancellation Pending	86977717	4868521

Plaintiff(s)

Name: Le-Vel Brands, LLC

Correspondent Address: MARK SOMMERS
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER, LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC UNITED STATES , 20001

Correspondent e-mail: docketing@finnegan.com , mark.sommers@finnegan.com , morgan.smith@finnegan.com , patrick.rodgers@finnegan.com , TTAB-Legal-Assistants@finnegan.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
THRIVE	Registered	86761270	5772374
THRIVE EXPERIENCE	Registered	86894030	5174403
RELEASE THE THRIVE	Registered	86894067	5144648
THRIVE BY LE-VEL	Registered	86894090	5169444
THRIVE PLUS ACTIVATE	Registered	86445841	5663886
THRIVE PLUS BALANCE	Registered	86445941	5663888
THRIVE PLUS BOOST	Registered	86445889	5663887
THRIVE PREMIUM LIFESTYLE MIX	Registered	86429213	5663884
THRIVE PREMIUM LIFESTYLE CAPSULE	Registered	86429210	5663883
THRIVE PREMIUM LIFESTYLE DFT	Registered	86429217	5663885

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Nov 02, 2020	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Nov 03, 2020	Dec 13, 2020
3	INSTITUTED	Nov 03, 2020	
4	NOTICE OF DEFAULT	Dec 23, 2020	



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Record 1 out of 1

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EAT. DRINK. THRIVE.

Word Mark EAT. DRINK. THRIVE.

Goods and Services (CANCELLED) IC 005. US 006 018 044 046 051 052. G & S: Dietary herbal supplement containing ginger; tablet containing ginger to help with symptoms of motion sickness, nausea, and stomach queasiness; capsule containing ginger to help with symptoms of motion sickness, nausea, and stomach queasiness; dietary supplement containing ginger formulated for sublingual delivery to help with symptoms of motion sickness, nausea, and stomach queasiness. FIRST USE: 20120630. FIRST USE IN COMMERCE: 20120630

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 86030292

Filing Date August 6, 2013

Current Basis 1A

Original Filing Basis 1A

Published for Opposition January 7, 2014

Registration Number 4501285

Registration Date March 25, 2014

Owner (REGISTRANT) Pacific Resorts Investments Limited LIMITED LIABILITY COMPANY BR.VIRGIN ISLANDS c/o Reese Henry & Company, Inc. 400 East Main Street Aspen COLORADO 81611

(LAST LISTED OWNER) THE WAKAYA GROUP, LP LIMITED PARTNERSHIP DELAWARE 9520 WRANGLER DRIVE LAKE WORTH FLORIDA 33467

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Lisel M. Ferguson

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator DEAD

Cancellation Date October 30, 2020

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Mark: EAT. DRINK. THRIVE.



US Serial Number: 86030292

Application Filing Date: Aug. 06, 2013

US Registration Number: 4501285

Registration Date: Mar. 25, 2014

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



DEAD/REGISTRATION/Cancelled/Invalidated

The trademark application was registered, but subsequently it was cancelled or invalidated and removed from the registry.

Status: Registration cancelled because registrant did not file an acceptable declaration under Section 8. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Oct. 30, 2020

Publication Date: Jan. 07, 2014

Date Cancelled: Oct. 30, 2020

Mark Information

Mark Literal Elements: EAT. DRINK. THRIVE.

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Dietary herbal supplement containing ginger; tablet containing ginger to help with symptoms of motion sickness, nausea, and stomach queasiness; capsule containing ginger to help with symptoms of motion sickness, nausea, and stomach queasiness; dietary supplement containing ginger formulated for sublingual delivery to help with symptoms of motion sickness, nausea, and stomach queasiness

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: Jun. 30, 2012

Use in Commerce: Jun. 30, 2012

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: THE WAKAYA GROUP, LP

Owner Address: 9520 WRANGLER DRIVE
LAKE WORTH, FLORIDA UNITED STATES 33467

Legal Entity Type: LIMITED PARTNERSHIP

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Lisel M. Ferguson

Docket Number: 11852804US01

Attorney Primary Email Address: docketing@procopio.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Lisel M. Ferguson
Procopio, Cory, Hargreaves & Savitch LLP
525 B Street, Suite 2200
San Diego, CALIFORNIA UNITED STATES 92101

Phone: 619-515-3207

Fax: 619-744-5407

Correspondent e-mail: docketing@procopio.com lisel.ferguson@procopio.com
pamela.lawson@procopio.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Oct. 30, 2020	CANCELLED SEC. 8 (6-YR)	
Oct. 09, 2019	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Oct. 09, 2019	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Sep. 18, 2019	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Mar. 25, 2019	COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED	
Nov. 11, 2015	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Nov. 11, 2015	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Nov. 04, 2015	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Mar. 25, 2014	REGISTERED-PRINCIPAL REGISTER	
Jan. 07, 2014	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jan. 07, 2014	PUBLISHED FOR OPPOSITION	
Dec. 18, 2013	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Dec. 02, 2013	LAW OFFICE PUBLICATION REVIEW COMPLETED	77976
Nov. 26, 2013	APPROVED FOR PUB - PRINCIPAL REGISTER	
Nov. 19, 2013	ASSIGNED TO EXAMINER	90331
Aug. 21, 2013	APPLICANT AMENDMENT PRIOR TO EXAMINATION - ENTERED	77976
Aug. 19, 2013	ASSIGNED TO LIE	77976
Aug. 14, 2013	TEAS VOLUNTARY AMENDMENT RECEIVED	
Aug. 14, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Aug. 09, 2013	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Mar. 25, 2014

Assignment Abstract Of Title Information

Summary

Assignment 1 of 3

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [5654/0152](#)

Pages: 4

Date Recorded: Oct. 28, 2015

Supporting Documents: [assignment-tm-5654-0152.pdf](#)

Assignor

Name: [PACIFIC RESORTS INVESTMENTS LIMITED](#)

Execution Date: Oct. 26, 2015

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: VIRGIN ISLANDS, BRITISH

Assignee

Name: [WAKAYA PERFECTION, LLC](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: UTAH

Address: 13423 NORTH ALPINE COVE DRIVE
ALPINE, UTAH 84004

Correspondent

Correspondent Name: LISEL FERGUSON WITH PROCOPIO ET AL.

Correspondent Address: 525 B STREET, SUITE 2200
SAN DIEGO, CA 92101

Domestic Representative - Not Found

Assignment 2 of 3

Conveyance: SECURITY INTEREST

Reel/Frame: [5661/0757](#)

Pages: 9

Date Recorded: Nov. 03, 2015

Supporting Documents: [assignment-tm-5661-0757.pdf](#)

Assignor

Name: [WAKAYA PERFECTION, LLC](#)

Execution Date: Oct. 26, 2015

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: UTAH

Assignee

Name: [WAKAYA PERFECTION, LP](#)

Legal Entity Type: LIMITED PARTNERSHIP

State or Country Where Organized: DELAWARE

Address: 480 HIBISCUS STREET, SUITE 642
WEST PALM BEACH, FLORIDA 33401

Correspondent

Correspondent Name: LISEL M. FERGUSON - PROCOPIO ET AL.

Correspondent Address: 525 B STREET, SUITE 2200
SAN DIEGO, CA 92101

Domestic Representative - Not Found

Assignment 3 of 3

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [6742/0304](#)

Pages: 5

Date Recorded: Sep. 12, 2019

Supporting Documents: [assignment-tm-6742-0304.pdf](#)

Assignor

Name: [WAKAYA PERFECTION, LLC](#)

Execution Date: Aug. 22, 2019

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country UTAH
Where Organized:

Assignee

Name: [THE WAKAYA GROUP, LP](#)

Legal Entity Type: LIMITED PARTNERSHIP

State or Country DELAWARE
Where Organized:

Address: 9520 WRANGLER DRIVE
LAKE WORTH, FLORIDA 33467

Correspondent

Correspondent Name: LISEL M. FERGUSON - PROCOPIO, ET AL.

Correspondent Address: 525 B STREET, SUITE 2200
SAN DIEGO, CA 92101

Domestic Representative - Not Found



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Word Mark THRIVE NEWBORN

Goods and Services IC 005. US 006 018 044 046 051 052. G & S: Animal feed supplements. FIRST USE: 20160914. FIRST USE IN COMMERCE: 20160914

Mark

Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search Code 03.07.01 - Cattle; Oxen, cows, calves, bulls; Steers
03.07.03 - Heads of oxen, cows, calves, bulls
26.17.13 - Letters or words underlined and/or overlined by one or more strokes or lines; Overlined words or letters; Underlined words or letters
27.01.02 - Animals composed of letters or numerals; Letters forming animals; Numbers forming animals; Punctuation forming animals

Serial Number 87344157

Filing Date February 21, 2017

Current Basis 1A

Original Filing Basis 1A

Published for Opposition July 18, 2017

Registration Number 5300498

Registration Date October 3, 2017

Owner (REGISTRANT) Pacific Powder Company, LLC LIMITED LIABILITY COMPANY IDAHO P.O. Box 266 Twin Falls IDAHO 83303

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "NEWBORN" APART FROM THE MARK AS SHOWN

Description of Mark Color is not claimed as a feature of the mark. The mark consists of the wording "THRIVE NEWBORN" in a stylized font. A design of a calf's head appears over the letter "V" and the letter "V" is scripted to represent the body of the calf. The letter "T" in "THRIVE" is extended down with the letters "HRIVE" being underscored. The word "NEWBORN" is underneath the underscore and is to the far right.

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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Mark: THRIVE NEWBORN



US Serial Number: 87344157

Application Filing Date: Feb. 21, 2017

US Registration Number: 5300498

Registration Date: Oct. 03, 2017

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Oct. 03, 2017

Publication Date: Jul. 18, 2017

Mark Information

Mark Literal Elements: THRIVE NEWBORN

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of the wording "THRIVE NEWBORN" in a stylized font. A design of a calf's head appears over the letter "V" and the letter "V" is scripted to represent the body of the calf. The letter "T" in "THRIVE" is extended down with the letters "HRIVE" being underscored. The word "NEWBORN" is underneath the underscore and is to the far right.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Disclaimer: "NEWBORN"

Design Search Code(s): 03.07.01 - Oxen, cows, calves, bulls; Cattle; Steers

03.07.03 - Heads of oxen, cows, calves, bulls

26.17.13 - Overlined words or letters; Underlined words or letters; Letters or words underlined and/or overlined by one or more strokes or lines

27.01.02 - Animals composed of letters or numerals; Letters forming animals; Punctuation forming animals; Numbers forming animals

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Animal feed supplements

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Sep. 14, 2016

Use in Commerce: Sep. 14, 2016

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Pacific Powder Company, LLC

Owner Address: P.O. Box 266
Twin Falls, IDAHO UNITED STATES 83303

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country IDAHO
Where Organized:

Attorney/Correspondence Information

Attorney of Record - None

Correspondent

Correspondent Name/Address: PACIFIC POWDER COMPANY, LLC
PACIFIC POWDER COMPANY, LLC
P.O. BOX 266
TWIN FALLS, IDAHO UNITED STATES 83303

Phone: (208) 736-1607

Fax: (208) 735-8418

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Oct. 03, 2017	REGISTERED-PRINCIPAL REGISTER	
Jul. 18, 2017	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jul. 18, 2017	PUBLISHED FOR OPPOSITION	
Jun. 28, 2017	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
May 15, 2017	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 15, 2017	EXAMINER'S AMENDMENT ENTERED	88888
May 15, 2017	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
May 15, 2017	EXAMINERS AMENDMENT E-MAILED	6328
May 15, 2017	EXAMINERS AMENDMENT -WRITTEN	92557
May 15, 2017	ASSIGNED TO EXAMINER	92557
Mar. 01, 2017	NOTICE OF DESIGN SEARCH CODE E-MAILED	
Feb. 28, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Feb. 24, 2017	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Oct. 03, 2017



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AdrenaThrive

Word Mark	ADRENATHRIVE
Goods and Services	(CANCELLED) IC 005. US 006 018 044 046 051 052. G & S: Dietary and nutritional supplements. FIRST USE: 20171208. FIRST USE IN COMMERCE: 20171208
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	87557203
Filing Date	August 4, 2017
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	December 12, 2017
Registration Number	5466332
Registration Date	May 8, 2018
Owner	(REGISTRANT) Truegenics Pte. Ltd. FORMERLY Success Vantage Group Pte. Ltd. limited liability company SINGAPORE #18-07 Fortune Centre 190 Middle Road Singapore SINGAPORE 188979
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	DEAD
Cancellation Date	December 17, 2020

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Mark: ADRENATHRIVE

AdrenaThrive

US Serial Number: 87557203

Application Filing Date: Aug. 04, 2017

US Registration Number: 5466332

Registration Date: May 08, 2018

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



DEAD/REGISTRATION/Cancelled/Invalidated

The trademark application was registered, but subsequently it was cancelled or invalidated and removed from the registry.

Status: Registration cancelled under Section 18 by the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Status Date: Dec. 17, 2020

Publication Date: Dec. 12, 2017

Notice of Allowance Date: Feb. 06, 2018

Date Cancelled: Dec. 17, 2020

Mark Information

Mark Literal Elements: ADRENATHRIVE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Dietary and nutritional supplements

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: SECTION 18 - CANCELLED

Basis: 1(a)

First Use: Dec. 08, 2017

Use in Commerce: Dec. 08, 2017

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Truegenics Pte. Ltd.

DBA, AKA, Formerly: FORMERLY Success Vantage Group Pte. Ltd.

Owner Address: #18-07 Fortune Centre
190 Middle Road
Singapore SINGAPORE 188979

Legal Entity Type: limited liability company

State or Country Where Organized: SINGAPORE

Attorney/Correspondence Information

Attorney of Record - None

Correspondent

Correspondent Name/Address: TRUEGENICS PTE LTD
#18-07 FORTUNE CENTRE
190 MIDDLE ROAD
SINGAPORE SINGAPORE 188979

Phone: +65-65683842

Fax: 503-512-6113

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Dec. 17, 2020	CANCELLED SECTION 18-TOTAL	
Dec. 17, 2020	CANCELLATION TERMINATED NO. 999999	75163
Dec. 16, 2020	CANCELLATION GRANTED NO. 999999	75163
Sep. 14, 2020	CANCELLATION INSTITUTED NO. 999999	75163
May 08, 2018	REGISTERED-PRINCIPAL REGISTER	
Apr. 04, 2018	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Apr. 03, 2018	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Apr. 02, 2018	STATEMENT OF USE PROCESSING COMPLETE	71906
Mar. 12, 2018	USE AMENDMENT FILED	71906
Mar. 29, 2018	CASE ASSIGNED TO INTENT TO USE PARALEGAL	71906
Mar. 12, 2018	TEAS STATEMENT OF USE RECEIVED	
Feb. 06, 2018	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Dec. 12, 2017	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Dec. 12, 2017	PUBLISHED FOR OPPOSITION	
Nov. 22, 2017	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Nov. 08, 2017	APPROVED FOR PUB - PRINCIPAL REGISTER	
Nov. 01, 2017	ASSIGNED TO EXAMINER	82088
Aug. 09, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Aug. 08, 2017	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TTAB

Date in Location: Dec. 17, 2020

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Cancellation

Proceeding [92075163](#)
Number:

Filing Date: Sep 04, 2020

Status: Terminated

Status Date: Dec 17, 2020

Interlocutory Attorney: ASHLEY D HAYES

Defendant

Name: Truegenics Pte. Ltd.

Correspondent Address: TRUEGENICS PTE LTD
#18-07 FORTUNE CENTRE, 190 MIDDLE ROAD
SINGAPORE SINGAPORE , 188979

Associated marks

Mark	Application Status	Serial Number	Registration Number
ADRENATHRIVE	Cancelled - Section 18	87557203	5466332

Plaintiff(s)

Name: Le-Vel Brands, LLC

Correspondent Address: MARK SOMMERS
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER, LLP
901 NEW YORK AVE NW
WASHINGTON DC UNITED STATES , 20001

Correspondent e-mail: docketing@finnegan.com , mark.sommers@finnegan.com , morgan.smith@finnegan.com , patrick.rodgers@finnegan.com , TTAB-Legal-Assistants@finnegan.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
THRIVE	Registered	86761270	5772374
THRIVE EXPERIENCE	Registered	86894030	5174403
RELEASE THE THRIVE	Registered	86894067	5144648
THRIVE BY LE-VEL	Registered	86894090	5169444
THRIVE PLUS ACTIVATE	Registered	86445841	5663886
THRIVE PLUS BALANCE	Registered	86445941	5663888
THRIVE PLUS BOOST	Registered	86445889	5663887
THRIVE PREMIUM LIFESTYLE MIX	Registered	86429213	5663884
THRIVE PREMIUM LIFESTYLE CAPSULE	Registered	86429210	5663883
THRIVE PREMIUM LIFESTYLE DFT	Registered	86429217	5663885

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Sep 04, 2020	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Sep 14, 2020	Oct 24, 2020
3	INSTITUTED	Sep 14, 2020	
4	NOTICE OF DEFAULT	Nov 03, 2020	
5	BD DECISION: CAN GRANTED	Dec 16, 2020	
6	COMMR ORDER CANCELLING REG	Dec 17, 2020	
7	TERMINATED	Dec 17, 2020	



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BIOTHRIVE

Word Mark BIOTHRIVE

Goods and Services IC 005. US 006 018 044 046 051 052. G & S: Nutritional and dietary supplements for humans, namely, pills, tablets, capsules, caplets, powders and liquid drops; vitamins; hormone replacement therapy preparations. FIRST USE: 20150403. FIRST USE IN COMMERCE: 20150403

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 85183124

Filing Date November 23, 2010

Current Basis 1A

Original Filing Basis 1B

Published for Opposition March 13, 2012

Registration Number 4768869

Registration Date July 7, 2015

Owner (REGISTRANT) Fisher, Garth INDIVIDUAL UNITED STATES 120 South Spalding Drive, Suite 222 Beverly Hills CALIFORNIA 90212

Attorney of Record Louis C. Paul

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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[PREV DOC](#) | [NEXT DOC](#) | [LAST DOC](#)

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Mark: BIOTHRIVE



US Serial Number: 85183124

Application Filing Date: Nov. 23, 2010

US Registration Number: 4768869

Registration Date: Jul. 07, 2015

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Jul. 07, 2015

Publication Date: Mar. 13, 2012

Notice of Allowance Date: May 08, 2012

Mark Information

Mark Literal Elements: BIOTHRIVE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Nutritional and dietary supplements for humans, namely, pills, tablets, capsules, caplets, powders and liquid drops; vitamins; hormone replacement therapy preparations

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Apr. 03, 2015

Use in Commerce: Apr. 03, 2015

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Fisher, Garth

Owner Address: 120 South Spalding Drive, Suite 222
Beverly Hills, CALIFORNIA UNITED STATES 90212

Legal Entity Type: INDIVIDUAL

Citizenship: UNITED STATES

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Louis C. Paul

Docket Number: 561-T012-10-

Attorney Primary Email Address: trademarks@cosmeticslaw.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: LOUIS C. PAUL
Louis C Paul & Associates Pllc
299 Park Avenue, 6th Floor
New York, NEW YORK UNITED STATES 10171

Phone: 212-223-8200

Fax: 212-223-8259

Correspondent e-mail: docting@paulipgroup.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jul. 07, 2020	COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED	
Jul. 07, 2015	REGISTERED-PRINCIPAL REGISTER	
Jun. 02, 2015	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Jun. 01, 2015	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
May 14, 2015	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
May 14, 2015	STATEMENT OF USE PROCESSING COMPLETE	65362
May 04, 2015	USE AMENDMENT FILED	65362
May 04, 2015	TEAS STATEMENT OF USE RECEIVED	
Feb. 18, 2015	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Feb. 17, 2015	EXTENSION 5 GRANTED	65362
Nov. 08, 2014	EXTENSION 5 FILED	65362
Feb. 13, 2015	NOTICE OF REVIVAL - E-MAILED	
Feb. 13, 2015	EXTENSION RECEIVED WITH TEAS PETITION	
Feb. 13, 2015	PETITION TO REVIVE-GRANTED	88889
Feb. 13, 2015	TEAS PETITION TO REVIVE RECEIVED	
Dec. 15, 2014	ABANDONMENT NOTICE MAILED - NO USE STATEMENT FILED	
Dec. 15, 2014	ABANDONMENT - NO USE STATEMENT FILED	99999
May 23, 2014	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
May 22, 2014	EXTENSION 4 GRANTED	65362
May 08, 2014	EXTENSION 4 FILED	65362
May 08, 2014	TEAS EXTENSION RECEIVED	
May 08, 2014	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Nov. 19, 2013	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Nov. 18, 2013	EXTENSION 3 GRANTED	65362
Nov. 08, 2013	EXTENSION 3 FILED	65362
Nov. 08, 2013	TEAS EXTENSION RECEIVED	
Jun. 06, 2013	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Jun. 05, 2013	EXTENSION 2 GRANTED	65362
May 08, 2013	EXTENSION 2 FILED	65362
Jun. 05, 2013	CASE ASSIGNED TO INTENT TO USE PARALEGAL	65362
May 08, 2013	TEAS EXTENSION RECEIVED	
Nov. 10, 2012	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Nov. 08, 2012	EXTENSION 1 GRANTED	98765

Nov. 08, 2012	EXTENSION 1 FILED	98765
Nov. 08, 2012	TEAS EXTENSION RECEIVED	
May 08, 2012	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Mar. 13, 2012	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Mar. 13, 2012	PUBLISHED FOR OPPOSITION	
Feb. 22, 2012	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Feb. 09, 2012	LAW OFFICE PUBLICATION REVIEW COMPLETED	70633
Feb. 09, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 17, 2012	TEAS/EMAIL CORRESPONDENCE ENTERED	70633
Jan. 17, 2012	CORRESPONDENCE RECEIVED IN LAW OFFICE	70633
Jan. 05, 2012	TEAS RESPONSE TO SUSPENSION INQUIRY RECEIVED	
Sep. 19, 2011	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	70633
Sep. 09, 2011	ASSIGNED TO LIE	70633
Mar. 08, 2011	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Mar. 08, 2011	LETTER OF SUSPENSION E-MAILED	6332
Mar. 08, 2011	SUSPENSION LETTER WRITTEN	83174
Mar. 03, 2011	ASSIGNED TO EXAMINER	83174
Nov. 30, 2010	NOTICE OF PSEUDO MARK MAILED	
Nov. 29, 2010	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Nov. 26, 2010	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Jun. 01, 2015



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THRIVE! for life

Word Mark	THRIVE! FOR LIFE
Goods and Services	IC 005. US 006 018 044 046 051 052. G & S: Dietary and nutritional supplements. FIRST USE: 20110527. FIRST USE IN COMMERCE: 20110614
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	85332352
Filing Date	May 27, 2011
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	October 25, 2011
Registration Number	4238561
Registration Date	November 6, 2012
Owner	(REGISTRANT) Lang Naturals, Inc. CORPORATION RHODE ISLAND 20 Silva Lane Middletown RHODE ISLAND 02842 (LAST LISTED OWNER) LANG PHARMA NUTRITION, INC. CORPORATION RHODE ISLAND 20 SILVA LANE MIDDLETOWN RHODE ISLAND 02842
Assignment Recorded	ASSIGNMENT RECORDED
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

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Mark: THRIVE! FOR LIFE

THRIVE! for life

US Serial Number: 85332352

Application Filing Date: May 27, 2011

US Registration Number: 4238561

Registration Date: Nov. 06, 2012

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: Nov. 27, 2018

Publication Date: Oct. 25, 2011

Notice of Allowance Date: Dec. 20, 2011

Mark Information

Mark Literal Elements: THRIVE! FOR LIFE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Dietary and nutritional supplements

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: May 27, 2011

Use in Commerce: Jun. 14, 2011

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: LANG PHARMA NUTRITION, INC.

Owner Address: 20 SILVA LANE
MIDDLETOWN, RHODE ISLAND UNITED STATES 02842

Legal Entity Type: CORPORATION

State or Country RHODE ISLAND
Where Organized:

Attorney/Correspondence Information

Attorney of Record - None
Correspondent

Correspondent Name/Address: LANG PHARMA NUTRITION, INC.
20 SILVA LANE
MIDDLETOWN, RHODE ISLAND UNITED STATES 02842

Phone: 4018487700

Fax: 4018487701

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Nov. 27, 2018	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Nov. 27, 2018	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	70187
Nov. 27, 2018	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	70187
Nov. 06, 2018	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Nov. 06, 2018	TEAS SECTION 8 & 15 RECEIVED	
Nov. 06, 2017	COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED	
Apr. 29, 2015	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Nov. 06, 2012	REGISTERED-PRINCIPAL REGISTER	
Oct. 02, 2012	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Oct. 01, 2012	LAW OFFICE REGISTRATION REVIEW COMPLETED	68171
Sep. 28, 2012	ASSIGNED TO LIE	68171
Sep. 18, 2012	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Jul. 14, 2012	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Jul. 13, 2012	STATEMENT OF USE PROCESSING COMPLETE	76985
Jun. 18, 2012	USE AMENDMENT FILED	76985
Jul. 13, 2012	EXTENSION 1 GRANTED	76985
Jun. 18, 2012	EXTENSION 1 FILED	76985
Jul. 13, 2012	CASE ASSIGNED TO INTENT TO USE PARALEGAL	76985
Jun. 18, 2012	TEAS EXTENSION RECEIVED	
Jun. 18, 2012	TEAS STATEMENT OF USE RECEIVED	
Jun. 18, 2012	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jun. 18, 2012	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Dec. 20, 2011	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Oct. 25, 2011	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Oct. 25, 2011	PUBLISHED FOR OPPOSITION	
Sep. 15, 2011	APPROVED FOR PUB - PRINCIPAL REGISTER	
Sep. 14, 2011	ASSIGNED TO EXAMINER	85329
Jun. 02, 2011	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
May 31, 2011	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None
File Location

Current Location: TMO LAW OFFICE 112

Date in Location: Nov. 27, 2018

Assignment Abstract Of Title Information

Summary

Total Assignments: 2

Registrant: Lang Naturals, Inc.

Assignment 1 of 2

Conveyance: CHANGE OF NAME

Reel/Frame: [5500/0919](#)

Pages: 4

Date Recorded: Apr. 20, 2015

Supporting Documents: [assignment-tm-5500-0919.pdf](#)**Assignor**Name: [LANG NATURALS, INC.](#)

Execution Date: Sep. 13, 2012

Legal Entity Type: CORPORATION

State or Country Where Organized: RHODE ISLAND

AssigneeName: [LANG PHARMA NUTRITION, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: RHODE ISLAND

Address: 20 SILVA LANE
MIDDLETOWN, RHODE ISLAND 02842**Correspondent**

Correspondent Name: RYAN M. KAISER

Correspondent Address: 55 WEST MONROE STREET
SUITE 3400
CHICAGO, IL 60603**Domestic Representative - Not Found****Assignment 2 of 2**

Conveyance: SECURITY INTEREST

Reel/Frame: [6634/0120](#)

Pages: 9

Date Recorded: May 01, 2019

Supporting Documents: [assignment-tm-6634-0120.pdf](#)**Assignor**Name: [LANG PHARMA NUTRITION, INC.](#)

Execution Date: Apr. 30, 2019

Legal Entity Type: CORPORATION

State or Country Where Organized: RHODE ISLAND

AssigneeName: [DNB BANK ASA](#)

Legal Entity Type: ALLMENNAKSJESELSKAP (ASA)

State or Country Where Organized: NORWAY

Address: DRONNING EUFEMIAS GATE 30
OSLO, NORWAY 0191**Correspondent**

Correspondent Name: BETH H. ALTER/SEWARD & KISSEL LLP

Correspondent Address: ONE BATTERY PARK PLAZA
NEW YORK, NY 10004**Domestic Representative - Not Found**



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JUST THRIVE

Word Mark JUST THRIVE

Goods and Services IC 005. US 006 018 044 046 051 052. G & S: Dietary and nutritional supplements, nutritional supplements containing probiotics, and nutritional supplements, namely, probiotic compositions. FIRST USE: 20131227. FIRST USE IN COMMERCE: 20140429

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 85947214

Filing Date May 31, 2013

Current Basis 1A

Original Filing Basis 1B

Published for Opposition November 5, 2013

Registration Number 4598351

Registration Date September 2, 2014

Owner (REGISTRANT) DMS Natural Health LLC LIMITED LIABILITY COMPANY WYOMING 810 Busse Hwy Park Ridge ILLINOIS 60068

Attorney of Record Sana Hakim

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 8 (6-YR).

Live/Dead Indicator LIVE

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Mark: JUST THRIVE

JUST THRIVE

US Serial Number: 85947214

Application Filing Date: May 31, 2013

US Registration Number: 4598351

Registration Date: Sep. 02, 2014

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Cancellation/Invalidation Pending

This trademark application has been registered with the Office, but it is currently undergoing a challenge which may result in its removal from the registry.

Status: A cancellation proceeding is pending at the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Status Date: Aug. 20, 2019

Publication Date: Nov. 05, 2013

Notice of Allowance Date: Dec. 31, 2013

Mark Information

Mark Literal Elements: JUST THRIVE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Dietary and nutritional supplements, nutritional supplements containing probiotics, and nutritional supplements, namely, probiotic compositions

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 27, 2013

Use in Commerce: Apr. 29, 2014

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: DMS Natural Health LLC

Owner Address: 810 Busse Hwy
Park Ridge, ILLINOIS UNITED STATES 60068

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country WYOMING
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Sana Hakim

Docket Number: 3724126-002

Attorney Primary citrademarks@klgates.com
Email Address:

Attorney Email Yes
Authorized:

Correspondent

Correspondent Name/Address: SANA HAKIM
K&L GATES LLP
PO BOX 1135
CHICAGO, ILLINOIS UNITED STATES 60690-1135

Phone: 312-807-4350

Fax: 312-827-8185

Correspondent e-mail: sana.hakim@klgates.com Christopher.Fahy@klgates.com
Anisha.Mehta@klgates.com TTABLitigationDocket@klgates.com

Correspondent e-mail Yes
Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Nov. 12, 2020	NOTICE OF ACCEPTANCE OF SEC. 8 - E-MAILED	
Nov. 12, 2020	REGISTERED - SEC. 8 (6-YR) ACCEPTED	70997
Nov. 10, 2020	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	70997
Aug. 13, 2020	TEAS SECTION 8 RECEIVED	
Sep. 02, 2019	COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED	
Aug. 20, 2019	CANCELLATION INSTITUTED NO. 999999	72043
Sep. 02, 2014	REGISTERED-PRINCIPAL REGISTER	
Jul. 26, 2014	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Jul. 25, 2014	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Jul. 20, 2014	STATEMENT OF USE PROCESSING COMPLETE	61813
Jun. 27, 2014	USE AMENDMENT FILED	61813
Jul. 18, 2014	CASE ASSIGNED TO INTENT TO USE PARALEGAL	61813
Jun. 27, 2014	TEAS STATEMENT OF USE RECEIVED	
Dec. 31, 2013	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Nov. 05, 2013	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Nov. 05, 2013	PUBLISHED FOR OPPOSITION	
Oct. 16, 2013	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Oct. 02, 2013	LAW OFFICE PUBLICATION REVIEW COMPLETED	66213
Sep. 30, 2013	ASSIGNED TO LIE	66213
Sep. 19, 2013	APPROVED FOR PUB - PRINCIPAL REGISTER	
Sep. 19, 2013	EXAMINER'S AMENDMENT ENTERED	88888
Sep. 19, 2013	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Sep. 19, 2013	EXAMINERS AMENDMENT E-MAILED	6328
Sep. 19, 2013	EXAMINERS AMENDMENT -WRITTEN	81095
Sep. 16, 2013	ASSIGNED TO EXAMINER	81095
Jun. 11, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jun. 04, 2013	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location**Current Location:** TMEG LAW OFFICE 105**Date in Location:** Nov. 12, 2020**Proceedings****Summary****Number of Proceedings:** 1**Type of Proceeding: Cancellation****Proceeding Number:** [92072043](#)**Filing Date:** Aug 19, 2019**Status:** Suspended**Status Date:** Jun 25, 2020**Interlocutory Attorney:** MARY CATHERINE FAINT**Defendant****Name:** DMS Natural Health LLC**Correspondent Address:** SANA HAKIM
K&L GATES LLP
PO BOX 1135
CHICAGO IL UNITED STATES , 60690-1135**Correspondent e-mail:** sana.hakim@klgates.com , Christopher.Fahy@klgates.com , Anisha.Mehta@klgates.com , TTABLitigationDocket@klgates.com**Associated marks**

Mark	Application Status	Serial Number	Registration Number
JUST THRIVE	Cancellation Pending	85947214	4598351

Plaintiff(s)**Name:** Le-Vel Brands, LLC**Correspondent Address:** MARK SOMMERS
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP
901 NEW YORK AVENUE NW
WASHINGTON DC UNITED STATES , 20001-4413**Correspondent e-mail:** docketing@finnegan.com , mark.sommers@finnegan.com , morgan.smith@finnegan.com , patrick.rodgers@finnegan.com , TTAB-Legal-Assistants@finnegan.com**Associated marks**

Mark	Application Status	Serial Number	Registration Number
THRIVE	Registered	86761270	5772374
THRIVE EXPERIENCE	Registered	86894030	5174403
RELEASE THE THRIVE	Registered	86894067	5144648
THRIVE BY LE-VEL	Registered	86894090	5169444
THRIVE PLUS ACTIVATE	Registered	86445841	5663886
THRIVE PLUS BALANCE	Registered	86445941	5663888
THRIVE PLUS BOOST	Registered	86445889	5663887
THRIVE PREMIUM LIFESTYLE MIX	Registered	86429213	5663884
THRIVE PREMIUM LIFESTYLE CAPSULE	Registered	86429210	5663883
THRIVE PREMIUM LIFESTYLE DFT	Registered	86429217	5663885

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Aug 19, 2019	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Aug 20, 2019	Sep 29, 2019
3	INSTITUTED	Aug 20, 2019	
4	ANSWER	Sep 30, 2019	
5	P MOT TO STRIKE PLEADING/AFFIRMATIVE DEFENSE	Oct 21, 2019	
6	SUSP PEND DISP OF OUTSTNDNG MOT	Nov 02, 2019	
7	D OPP/RESP TO MOTION	Nov 12, 2019	

8	P MOT TO STRIKE PLEADING/AFFIRMATIVE DEFENSE	Dec 02, 2019
9	P MOT TO STRIKE PLEADING/AFFIRMATIVE DEFENSE	Dec 02, 2019
10	TRIAL DATES RESET	Mar 25, 2020
11	D MOT TO SUSP PEND DISP CIV ACT W/ CONSENT	Jun 25, 2020
12	SUSP PEND DISP OF CIVIL ACTION	Jun 25, 2020
13	D REQ TO WD #11 REQUEST FILED	Jun 25, 2020
14	D MOT TO SUSP PEND DISP CIV ACT W/ CONSENT	Jun 25, 2020
15	SUSP PEND DISP OF CIVIL ACTION	Nov 18, 2020
16	P UPDATE RE STATUS OF CIVIL ACTION	Dec 10, 2020



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PHTHRIVE

Word Mark PHTHRIVE

Goods and Services IC 005. US 006 018 044 046 051 052. G & S: Mineral supplements, namely, mineral drops; Liquid nutritional supplements, namely, pH drops; Liquid nutritional supplements, namely, alkalizing drops; Liquid nutritional supplements, namely, drops for increasing pH levels. FIRST USE: 20120200. FIRST USE IN COMMERCE: 20120200

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 85566940

Filing Date March 12, 2012

Current Basis 1A

Original Filing Basis 1A

Published for Opposition June 12, 2012

Registration Number 4198598

Registration Date August 28, 2012

Owner (REGISTRANT) Journey Ventures, LLC DBA pH Life LIMITED LIABILITY COMPANY MISSOURI 2733 E. Battlefield #129 Springfield MISSOURI 65804
(LAST LISTED OWNER) PH LIFE LIMITED LIABILITY COMPANY FLORIDA 1919 BAYWOOD DR UNIT A SARASOTA FLORIDA 34231

Assignment Recorded ASSIGNMENT RECORDED

Type of Mark TRADEMARK

Register PRINCIPAL

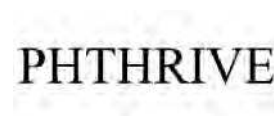
Affidavit Text SECT 8 (6-YR).

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Mark: PHTHRIVE



US Serial Number: 85566940

Application Filing Date: Mar. 12, 2012

US Registration Number: 4198598

Registration Date: Aug. 28, 2012

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: A Section 8 declaration has been accepted.

Status Date: Aug. 27, 2018

Publication Date: Jun. 12, 2012

Mark Information

Mark Literal Elements: PHTHRIVE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Mineral supplements, namely, mineral drops; Liquid nutritional supplements, namely, pH drops; Liquid nutritional supplements, namely, alkalizing drops; Liquid nutritional supplements, namely, drops for increasing pH levels

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Feb. 2012

Use in Commerce: Feb. 2012

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: PH LIFE

Owner Address: 1919 BAYWOOD DR UNIT A
SARASOTA, FLORIDA UNITED STATES 34231

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country: FLORIDA
Where Organized:

Attorney/Correspondence Information

Attorney of Record - None

Correspondent

Correspondent Name/Address: NICOLE KIMMEL
1919 BAYWOOD DR UNIT A
SARASOTA, FLORIDA UNITED STATES 34231

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Aug. 27, 2018	NOTICE OF ACCEPTANCE OF SEC. 8 - E-MAILED	
Aug. 27, 2018	REGISTERED - SEC. 8 (6-YR) ACCEPTED	59136
Aug. 27, 2018	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	59136
Aug. 22, 2018	TEAS SECTION 8 RECEIVED	
Aug. 22, 2018	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Aug. 28, 2017	COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED	
May 10, 2017	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Aug. 28, 2012	REGISTERED-PRINCIPAL REGISTER	
Jun. 12, 2012	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jun. 12, 2012	PUBLISHED FOR OPPOSITION	
May 23, 2012	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
May 08, 2012	LAW OFFICE PUBLICATION REVIEW COMPLETED	68171
May 04, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 01, 2012	EXAMINER'S AMENDMENT ENTERED	68171
May 01, 2012	ASSIGNED TO LIE	68171
May 01, 2012	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
May 01, 2012	EXAMINERS AMENDMENT E-MAILED	6328
May 01, 2012	EXAMINERS AMENDMENT -WRITTEN	83177
Apr. 04, 2012	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Apr. 04, 2012	NON-FINAL ACTION E-MAILED	6325
Apr. 04, 2012	NON-FINAL ACTION WRITTEN	83177
Mar. 27, 2012	ASSIGNED TO EXAMINER	83177
Mar. 19, 2012	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Mar. 15, 2012	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMEG LAW OFFICE 105

Date in Location: Aug. 27, 2018

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Registrant: Journey Ventures, LLC

Assignment 1 of 1

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [6048/0819](#)

Pages: 6

Date Recorded: Apr. 28, 2017

Supporting [assignment-tm-6048-0819.pdf](#)
Documents:

Assignor

Name: [JOURNEY VENTURES](#)
Legal Entity Type: LIMITED LIABILITY COMPANY
Execution Date: Apr. 24, 2017
State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [PH LIFE](#)
Legal Entity Type: LIMITED LIABILITY COMPANY
Address: 1919 BAYWOOD DR UNIT A
SARASOTA, FLORIDA 34231
State or Country Where Organized: FLORIDA

Correspondent

Correspondent Name: NICOLE KIMMEL
Correspondent Address: 1919 BAYWOOD DR UNIT A
SARASOTA, FL 34231

Domestic Representative - Not Found



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SURTHRIVAL

Word Mark SURTHRIVAL

Goods and Services IC 005. US 006 018 044 046 051 052. G & S: Dietary food supplements; Dietary supplements for human consumption; Herbal supplements; Mineral food supplements; Mineral supplements; Natural herbal supplements. FIRST USE: 20090525. FIRST USE IN COMMERCE: 20090525

IC 035. US 100 101 102. G & S: On-line retail store services featuring raw foods and dietary supplements. FIRST USE: 20090600. FIRST USE IN COMMERCE: 20090600

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 77636944

Filing Date December 19, 2008

Current Basis 1A

Original Filing Basis 1B

Published for Opposition April 28, 2009

Registration Number 3772920

Registration Date April 6, 2010

Owner (REGISTRANT) Feral Integrity Inc. CORPORATION MAINE PO Box 1823 Sanford MAINE 04073
(LAST LISTED OWNER) SURTHRIVAL LLC LIMITED LIABILITY COMPANY MAINE 63 Cider Hill Rd. York MAINE 03909

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Jeffrey C. Joyce

Type of Mark TRADEMARK. SERVICE MARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20200624.

Renewal 1ST RENEWAL 20200624

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Mark: SURTHRIVAL

SURTHRIVAL

US Serial Number: 77636944

Application Filing Date: Dec. 19, 2008

US Registration Number: 3772920

Registration Date: Apr. 06, 2010

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Trademark, Service Mark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: The registration has been renewed.

Status Date: Jun. 24, 2020

Publication Date: Apr. 28, 2009

Notice of Allowance Date: Jul. 21, 2009

Mark Information

Mark Literal Elements: SURTHRIVAL

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Dietary food supplements; Dietary supplements for human consumption; Herbal supplements; Mineral food supplements; Mineral supplements; Natural herbal supplements

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: May 25, 2009

Use in Commerce: May 25, 2009

For: On-line retail store services featuring raw foods and dietary supplements

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: Jun. 2009

Use in Commerce: Jun. 2009

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: SURTHRIVAL LLC

Owner Address: 63 Cider Hill Rd.
York, MAINE UNITED STATES 03909

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country MAINE
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jeffrey C. Joyce

Docket Number: 35787.1

Attorney Primary lpdocket@eatonpeabody.com
Email Address:

Attorney Email Yes
Authorized:

Correspondent

Correspondent Jeffrey C. Joyce
Name/Address: Eaton Peabody
P.O. Box 15235
PORTLAND, MAINE UNITED STATES 04112

Phone: 207-274-5266

Correspondent e- lpdocket@eatonpeabody.com
mail:

Correspondent e- Yes
mail Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jun. 24, 2020	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Jun. 24, 2020	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	77074
Jun. 24, 2020	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	77074
Jun. 23, 2020	TEAS RESPONSE TO OFFICE ACTION-POST REG RECEIVED	
Jun. 13, 2020	POST REGISTRATION ACTION MAILED - SEC. 8 & 9	77074
Jun. 13, 2020	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	77074
Mar. 30, 2020	TEAS SECTION 8 & 9 RECEIVED	
May 03, 2019	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Apr. 06, 2019	COURTESY REMINDER - SEC. 8 (10-YR)/SEC. 9 E-MAILED	
Dec. 17, 2018	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jun. 10, 2016	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Jun. 10, 2016	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	64591
Jun. 10, 2016	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	64591
Mar. 31, 2016	TEAS SECTION 8 & 15 RECEIVED	
Apr. 06, 2015	COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED	
Dec. 18, 2013	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
May 06, 2010	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Apr. 06, 2010	REGISTERED-PRINCIPAL REGISTER	
Mar. 01, 2010	LAW OFFICE REGISTRATION REVIEW COMPLETED	68123
Feb. 28, 2010	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Feb. 23, 2010	ASSIGNED TO EXAMINER	76465
Feb. 18, 2010	STATEMENT OF USE PROCESSING COMPLETE	76538
Jan. 15, 2010	USE AMENDMENT FILED	76538
Feb. 18, 2010	CASE ASSIGNED TO INTENT TO USE PARALEGAL	76538

Jan. 15, 2010	TEAS STATEMENT OF USE RECEIVED	
Jul. 21, 2009	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Apr. 28, 2009	PUBLISHED FOR OPPOSITION	
Apr. 08, 2009	NOTICE OF PUBLICATION	
Mar. 23, 2009	LAW OFFICE PUBLICATION REVIEW COMPLETED	68123
Mar. 20, 2009	ASSIGNED TO LIE	68123
Mar. 20, 2009	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 14, 2009	ASSIGNED TO EXAMINER	78553
Dec. 24, 2008	NOTICE OF PSEUDO MARK MAILED	
Dec. 23, 2008	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Jun. 24, 2020

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Registrant: Feral Integrity Inc.

Assignment 1 of 1

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [4195/0894](#)

Pages: 3

Date Recorded: Apr. 29, 2010

Supporting Documents: [assignment-tm-4195-0894.pdf](#)

Assignor

Name: [FERAL INTEGRITY, INC.](#)

Execution Date: Apr. 28, 2010

Legal Entity Type: CORPORATION

State or Country Where Organized: MAINE

Assignee

Name: [SURTHRIVAL LLC](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: MAINE

Address: 9 HARRISON AVENUE
SPRINGVALE, MAINE 04083

Correspondent

Correspondent Name: PATRICIA M. MATHERS

Correspondent Address: PO BOX 17707
PORTLAND, ME 04112-8707

Domestic Representative - Not Found



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THRIVELINK

Word Mark THRIVELINK

Goods and Services IC 035. US 100 101 102. G & S: Online marketing services in the fields of health, wellness and lifestyle; business consulting, marketing and advertising services in the field of health, wellness or lifestyle companies. FIRST USE: 20150618. FIRST USE IN COMMERCE: 20150914

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 87099988

Filing Date July 11, 2016

Current Basis 1A

Original Filing Basis 1A

Published for Opposition February 27, 2018

Registration Number 5466927

Registration Date May 15, 2018

Owner (REGISTRANT) ThriveLink, LLC LIMITED LIABILITY COMPANY DELAWARE 73 Indian Head Road Riverside CONNECTICUT 06878

Attorney of Record Larisa Migachyov

Type of Mark SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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Mark: THRIVELINK

THRIVELINK

US Serial Number: 87099988

Application Filing Date: Jul. 11, 2016

US Registration Number: 5466927

Registration Date: May 15, 2018

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: May 15, 2018

Publication Date: Feb. 27, 2018

Mark Information

Mark Literal Elements: THRIVELINK

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (..) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Online marketing services in the fields of health, wellness and lifestyle; business consulting, marketing and advertising services in the field of health, wellness or lifestyle companies

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: Jun. 18, 2015

Use in Commerce: Sep. 14, 2015

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: ThriveLink, LLC

Owner Address: 73 Indian Head Road
Riverside, CONNECTICUT UNITED STATES 06878

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Larisa Migachyov

Docket Number: THRIVELINK1

Attorney Primary Email Address: larisa@migachyov.com

Attorney Email Authorized: Yes

Correspondent

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Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
May 15, 2018	REGISTERED-PRINCIPAL REGISTER	
Feb. 27, 2018	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Feb. 27, 2018	PUBLISHED FOR OPPOSITION	
Feb. 07, 2018	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jan. 24, 2018	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 19, 2018	NOTICE OF REVIVAL - E-MAILED	
Jan. 19, 2018	TEAS/EMAIL CORRESPONDENCE ENTERED	76568
Jan. 19, 2018	CORRESPONDENCE RECEIVED IN LAW OFFICE	76568
Jan. 19, 2018	ASSIGNED TO LIE	76568
Jan. 19, 2018	PETITION GRANTED - RESPONSE RECEIVED	66600
Jan. 10, 2018	ASSIGNED TO PETITION STAFF	66600
Nov. 30, 2017	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Nov. 30, 2017	TEAS PETITION TO REVIVE RECEIVED	
May 18, 2017	NOTIFICATION OF FINAL REFUSAL EMAILED	
May 18, 2017	FINAL REFUSAL E-MAILED	
May 18, 2017	FINAL REFUSAL WRITTEN	76081
Apr. 27, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Apr. 26, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Apr. 26, 2017	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Oct. 26, 2016	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Oct. 26, 2016	NON-FINAL ACTION E-MAILED	6325
Oct. 26, 2016	NON-FINAL ACTION WRITTEN	76081
Oct. 19, 2016	ASSIGNED TO EXAMINER	76081
Jul. 19, 2016	NOTICE OF PSEUDO MARK E-MAILED	
Jul. 18, 2016	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jul. 14, 2016	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: May 15, 2018

Opposition No. 91254188
Declaration of Patrick J. Rodgers in Support of
Le-Vel's Motion for Summary Judgment

Exhibit 4



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INNERTHRIVE

Word Mark	INNERTHRIVE
Goods and Services	(CANCELLED) IC 005. US 006 018 044 046 051 052. G & S: Dietary and nutritional supplements. FIRST USE: 20111200. FIRST USE IN COMMERCE: 20111200 (CANCELLED) IC 035. US 100 101 102. G & S: On-line retail store services featuring dietary and nutritional supplements. FIRST USE: 20111200. FIRST USE IN COMMERCE: 20111200
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	85499991
Filing Date	December 20, 2011
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	August 14, 2012
Registration Number	4232799
Registration Date	October 30, 2012
Owner	(REGISTRANT) INNERTHRIVE, LLC LIMITED LIABILITY COMPANY NEVADA 2248 MERIDIAN BLVD, SUITE H MINDEN NEVADA 89423
Assignment Recorded	ASSIGNMENT RECORDED
Type of Mark	TRADEMARK. SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	DEAD
Cancellation Date	May 31, 2019

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Mark: INNERTHRIVE

INNERTHRIVE

US Serial Number: 85499991

Application Filing Date: Dec. 20, 2011

US Registration Number: 4232799

Registration Date: Oct. 30, 2012

Register: Principal

Mark Type: Trademark, Service Mark

TM5 Common Status Descriptor:



DEAD/REGISTRATION/Cancelled/Invalidated

The trademark application was registered, but subsequently it was cancelled or invalidated and removed from the registry.

Status: Registration cancelled because registrant did not file an acceptable declaration under Section 8. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: May 31, 2019

Publication Date: Aug. 14, 2012

Date Cancelled: May 31, 2019

Mark Information

Mark Literal Elements: INNERTHRIVE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Dietary and nutritional supplements

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: Dec. 2011

Use in Commerce: Dec. 2011

For: On-line retail store services featuring dietary and nutritional supplements

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: Dec. 2011

Use in Commerce: Dec. 2011

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: INNERTHRIVE, LLC

Owner Address: 2248 MERIDIAN BLVD, SUITE H
MINDEN, NEVADA UNITED STATES 89423

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: NEVADA

Attorney/Correspondence Information

Attorney of Record

Docket Number: 6195-6

Correspondent

Correspondent Name/Address: Sarah J. Schneider
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Fax: 303-863-0223

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jan. 20, 2020	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Jan. 20, 2020	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
May 31, 2019	CANCELLED SEC. 8 (6-YR)	
Oct. 30, 2017	COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED	
Oct. 30, 2012	REGISTERED-PRINCIPAL REGISTER	
Aug. 14, 2012	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Aug. 14, 2012	PUBLISHED FOR OPPOSITION	
Jul. 25, 2012	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jul. 11, 2012	LAW OFFICE PUBLICATION REVIEW COMPLETED	73797
Jul. 11, 2012	ASSIGNED TO LIE	73797
Jun. 22, 2012	NOTICE OF ACCEPTANCE OF AMENDMENT TO ALLEGE USE E-MAILED	
Jun. 21, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jun. 21, 2012	USE AMENDMENT ACCEPTED	82416
Jun. 16, 2012	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Jun. 15, 2012	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Jun. 15, 2012	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jun. 16, 2012	AMENDMENT TO USE PROCESSING COMPLETE	88889
Jun. 16, 2012	USE AMENDMENT FILED	88889
Jun. 15, 2012	TEAS AMENDMENT OF USE RECEIVED	
Apr. 18, 2012	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Apr. 03, 2012	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Apr. 03, 2012	NON-FINAL ACTION E-MAILED	6325
Apr. 03, 2012	NON-FINAL ACTION WRITTEN	82416
Mar. 27, 2012	ASSIGNED TO EXAMINER	82416
Jan. 04, 2012	NOTICE OF PSEUDO MARK MAILED	
Jan. 03, 2012	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Dec. 23, 2011	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Oct. 30, 2012

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Registrant: INNERTHRIVE, LLC

Assignment 1 of 1

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [4755/0514](#)

Pages: 3

Date Recorded: Apr. 12, 2012

Supporting Documents: [assignment-tm-4755-0514.pdf](#)

Assignor

Name: [AXIS LABS, INC.](#)

Execution Date: Mar. 16, 2012

Legal Entity Type: CORPORATION

State or Country Where Organized: COLORADO

Assignee

Name: [INNERTHRIVE, LLC](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: NEVADA

Address: 2248 MERIDIAN BLVD, SUITE H
MINDEN, NEVADA 89423

Correspondent

Correspondent Name: LEW HANSEN

Correspondent Address: 1560 BROADWAY, SUITE 1200
DENVER, CO 80202

Domestic Representative - Not Found

Opposition No. 91254188
Declaration of Patrick J. Rodgers in Support of
Le-Vel's Motion for Summary Judgment

Exhibit 5

2001 WL 1028372 (Trademark Tr. & App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

CHRISTOPHER WADE

v.

RILES & COMPANY

Cancellation No. 21,869

September 6, 2001

*1 David J. Davis of Baker & McKenzie for Christopher Wade.
David R. Shaub of Shaub & Williams for Riles & Company, Inc.

Before Quinn, Walters and Holtzman
Administrative Trademark Judges.
Opinion by Holtzman
Administrative Trademark Judge:

On June 2, 1993, Christopher Wade, an individual, filed a petition to cancel a registration assigned to Riles & Company, Inc., (“Riles”), a California corporation, for the mark THREE-PEAT for “shirts, jackets and hats.”¹

Petitioner alleges in the petition that he sells t-shirts and other apparel items and that he has “a bona fide intent” to produce and sell apparel which includes the word THREE-PEAT as part of the ornamental design. Petitioner also alleges that THREE-PEAT has become a generic slang word meaning “to perform an action or feat three consecutive times” particularly in relation to athletic events; that the designation is an informational and ornamental feature of respondent's goods and does not function as a mark; that the designation is generic or descriptive as used on respondent's goods and has not acquired distinctiveness; that the designation has been abandoned as the result of an invalid assignment of the underlying application to Riles by the former owner of the mark; and that the designation has been abandoned as the result of nonuse by respondent for a period of at least two years.

Respondent admits that the underlying application was assigned to Riles and denies the remaining allegations.

Petitioner did not take any testimony but filed a notice of reliance on printed publications consisting of stories retrieved from the NEXIS database purporting to show generic and informational use of THREE-PEAT; respondent's responses to certain interrogatories; documents including copies of representative license agreements between petitioner and various companies for the use of THREE-PEAT on goods such as hats and t-shirts, copies of “apparel designs” for the asserted mark, and correspondence “produced by Registrant during discovery” to illustrate the ways in which THREE-PEAT is “used or proposed to be used” by respondent on its goods.² (Petitioner's brief, p. 3-4).

Respondent in turn filed a notice of reliance on petitioner's responses to certain discovery requests and printed publications obtained from the WESTLAW and NEXIS databases to show public recognition of THREE-PEAT as a mark. In addition, respondent submitted the testimony (with exhibits) of Bijan Khezri, former president of P.d.P. Paperon De Paperoni, the original owner and assignor of the underlying application to Riles; Christine Riley, vice-president and director of respondent; and respondent's financial consultant and business manager, John Aldrich, an account manager for AYCO Company, LP.³ The exhibits introduced during the examination of Mr. Aldrich include a declaration of Christopher Wade dated July 14 1994,

duplicates of the “apparel designs” previously submitted under petitioner's notice of reliance, and petitioner's own examples of use of THREE-PEAT on shirts.

*2 Both parties filed trial briefs but an oral hearing was not requested.

In his brief, petitioner states that he is a seller of t-shirts, that he intends to sell apparel which includes the word “three-peat” as part of the ornamental design, and that he believes he should not be required to pay a royalty fee to respondent in order to do so. Petitioner argues that the registration for THREE-PEAT should be cancelled “on the grounds that it fails to function as a trademark and is generic.” (Brief, p. 13). Petitioner contends that the term serves an informational and ornamental function in view of the “location, size, prominence and significance” of the asserted mark on respondent's goods. (Brief, p. 11). Petitioner relies on the NEXIS evidence to show that the public would view THREE-PEAT as a generic term meaning a third successive accomplishment or to perform an act for a third consecutive time, rather than to identify respondent's apparel. Petitioner contends that respondent's license agreements show that THREE-PEAT is always used in combination with other parties' trademarks such as “CHICAGO BULLS” and “BUFFALO BILLS” and that the “representative” apparel designs show that the combined designation is used in an ornamental and informational manner. Petitioner maintains that as a result of the use of THREE-PEAT with numerous other parties' trademarks, consumers would not be able to associate THREE-PEAT with any particular source and instead would believe that the clothing on which it is used originates from different entities such as the source of, for example, a CHICAGO BULLS shirt. Petitioner further argues that the use of these third-party marks creates the demand for the goods contending that THREE-PEAT alone without any other mark “would not be perceived as an indicator of the source of the t-shirt.”⁴ (Brief, p. 12).

Respondent maintains that no evidence has been submitted to support petitioner's claim that he is a competitor of respondent or that he has an intention to use THREE-PEAT on apparel. Noting that petitioner “filed no testimony” in this case, respondent argues that “[f]or this reason alone, the Petition should be dismissed” because the “failure to present testimony is a failure to prove the case-in-chief.” (Brief, p. 10). Respondent points to its own testimony and evidence showing that THREE-PEAT is a coined term which is recognized as a mark, and contends that although the term may be commonly used by media, respondent has controlled the use of THREE-PEAT as a trademark. Respondent argues that THREE-PEAT is not generic for its goods and contends that the numerous media stories as well as its own evidence of use demonstrate that the term functions as a mark and is recognized as an identification of source.⁵

We turn first to the issue of standing. Petitioner has not taken any testimony nor properly introduced any evidence to prove his standing in this case. Nevertheless, and quite surprisingly, petitioner's standing has been established by evidence made of record by respondent. This evidence consists of a declaration of Christopher Wade which was submitted by petitioner in support of an earlier motion for summary judgment in this case. Ordinarily, evidence submitted in connection with a motion for summary judgment is not considered of record for purposes of the final decision in a case unless properly introduced at trial. See *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998) and TBMP § 528.05(a). In this case, respondent has made Mr. Wade's declaration of record by introducing it as an exhibit to the testimony of Mr. Aldrich. Having been properly introduced into evidence, the declaration may be referred to or relied upon by either party for any purpose permitted by the applicable rules.

*3 Mr. Wade states in his declaration that he is a seller of t-shirts and other apparel and that he is entitled to use the term in an ornamental fashion on his goods. Respondent, however, maintains that the declaration “is no longer valid because the declaration is dated July 14, 1994” and that “[I]t no longer can be assumed that Mr. Wade presently intends to compete with Riles & Co., currently sells apparel items which display designs and terms relating to sporting events and teams, [or] ... still intends to produce, distribute and sell apparel which includes the words ‘THREE-PEAT’....” (Respondent's brief, p.5).

The purpose of the standing requirement is to prevent mere intermeddlers from initiating proceedings. Thus, to meet this requirement, a plaintiff need only show that it has a real interest in the outcome of the proceeding. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). Petitioner's interest in this case is established by the uncontroverted statement in petitioner's declaration to the effect that he is engaged in the sale of the same goods as respondent. See, e.g., *Eastman Kodak*

Co. v. Bell & Howell Document Management Products Co., 23 USPQ2d 1878 (TTAB 1992), *aff'd* 994 F.2d 1569, 26 USPQ2d 1912, (Fed. Cir. 1993). Respondent has relied on petitioner's responses to interrogatories presumably to show that petitioner has not established any "intention" to use the term THREE-PEAT in connection with any goods. However, for purposes of standing, petitioner does not need to prove an intention, or even an interest, in using the asserted mark on his own goods. See, e.g., *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988). It is only necessary that he has a right to use the asserted mark in his business. This right is presumed from petitioner's status as a competitor of respondent. See *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999).

We turn then to the merits of the petition. Petitioner has the burden of proving his claims that THREE-PEAT is generic and otherwise fails to function as a mark. Although petitioner has taken no testimony, he has properly introduced certain evidence in support of his case by way of notice of reliance.⁶ However, the evidence as a whole is insufficient to sustain petitioner's burden.

To begin with, the generic meaning of a mark is not determined in a vacuum but rather in relation to the goods on which it is used. See, for example, *In re Abcor Development Corp., Inc.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Notwithstanding that the NEXIS articles may show that THREE-PEAT is widely used by the media to denote a type of athletic accomplishment, there is no indication that this term conveys any meaning, let alone generic meaning, about respondent's goods. See, for example, *In re Classic Beverage Inc.*, 6 USPQ2d 1383 (TTAB 1988). There is no indication that the term has anything other than arbitrary significance with respect to those goods.

*4 Moreover, petitioner has failed to show that the term is not used in the manner of a mark or that it otherwise would not be perceived as a mark indicating source. Petitioner has failed to produce any evidence that THREE-PEAT is used in an ornamental manner or that the term is an inseparable part of other marks or designs on respondent's goods. In fact, petitioner has submitted no evidence whatsoever of use of THREE-PEAT on goods. Although Mr. Aldrich admits that one of the apparel designs relied on by petitioner had been approved for use, there is no evidence that any of the designs were ever actually used on or applied to any goods.

In any event, respondent has submitted media articles demonstrating recognition of THREE-PEAT as a trademark and clear evidence of use of THREE-PEAT as a mark. In one such example, the term THREE-PEAT is applied to the front pocket of a polo shirt where its size and placement on the shirt clearly demonstrates use in the manner of a mark. There is nothing in the record to establish that the term used in this manner would not be recognized as an indication of source.

Finally, the mere fact that respondent has licensed the use of THREE-PEAT to a number of different companies does not, in itself, diminish its ability to identify a single source for respondent's goods. The owner of a trademark is free to license its mark to as many third parties as it chooses, to be used on goods which it does not itself manufacture, provided the owner controls licensees as to the nature and quality of the goods on which the mark is used. See Sections 5 and 45 of the Trademark Act. Moreover, a mark does not necessarily have to indicate a single physical source for the goods but may also indicate a single, i.e., consistent, source of quality, regardless of the actual physical source or producer of the goods. *J.T. McCarthy, McCarthy on Trademarks and Unfair Competition* § 18:41 (4th ed. 2000) citing *In re Abcor Development Corporation*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978). Petitioner has pointed to nothing in respondent's license agreements or any other evidence which would indicate that the quality of the goods to which the mark is applied is not properly or adequately controlled by respondent.

Thus, petitioner has failed to establish that THREE-PEAT is generic for respondent's goods or that it otherwise would not be perceived as a mark for those goods.

Decision: The petition to cancel is dismissed.

Footnotes

- 1 Registration No. 1,552,980; issued August 22, 1989; Section 8 affidavit accepted. The underlying application was filed by P.d.P. Paperon de Paperoni S.p.A. and was assigned to Riles in May 1989. Although the assignment was recorded in the Office on July 11, 1989, the registration issued in the name of the original owner.
- 2 None of these documents is proper subject matter for a notice of reliance. See, for example, Trademark Rules 2.120(j)(3)(ii), 2.122(e), and TBMP § 711. However, as explained in footnote 6, *infra*, these materials are being treated as being of record in this case.
- 3 Petitioner did not attend any of these depositions.
- 4 Although petitioner also pleaded claims of descriptiveness, lack of acquired distinctiveness, and abandonment on two grounds, none of those claims were pursued or argued in petitioner's brief and have therefore been considered dropped from the case.
- 5 Mr. Aldrich has testified as to respondent's ownership of at least two other registrations for THREE-PEAT for goods including collector plates, mugs and key chains. Since respondent did not establish the current status of those registrations, the registrations are not properly of record and have not been considered. See Trademark Rule 2.122(d)(2) and, generally, TBMP § 703.02(a).
- 6 Contrary to respondent's apparent contention, petitioner's NEXIS evidence, to the extent that it consists of articles published in newspapers or magazines of general circulation, was properly made of record by notice of reliance. See *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992). Moreover, the NEXIS material is not hearsay since it is not relied on by petitioner for the truth of the statements made in the articles but rather to show the context of use of the term by the media. We also note that respondent itself has introduced the same type of evidence by notice of reliance. To the extent that respondent has objected to the introduction of other evidence submitted by petitioner under a notice of reliance, and although such evidence, as noted earlier, was improperly offered by petitioner, the evidence has been considered by the Board since respondent has either relied on or introduced the evidence as part of its own case. See, generally, TBMP §§ 708 and 711.

2001 WL 1028372 (Trademark Tr. & App. Bd.)

2003 WL 21996100 (Trademark Tr. & App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

IN RE THE LANGUAGE WORKSHOP FOR CHILDREN/CERCLE FRANCO AMERICAIN, INC.

Serial No. 75/516,045

August 14, 2003

*1 Charles H Knull of Graham, Campaign P.C. for The Language Workshop for Children/Cercle Franco Americain, Inc.
Toni Y. Hickey, Trademark Examining Attorney
Law Office 115
(Tomas Vlcek, Managing Attorney)

Before Hohein, Chapman and Rogers
Administrative Trademark Judges
Opinion by Hohein
Administrative Trademark Judge:

The Language Workshop for Children/Cercle Franco Americain, Inc. has filed an application to register the term “FOR TOTS” for “educational services, namely, providing classes in foreign languages to children and distributing course material in connection therewith.”¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that, when used in connection with applicant's services, the term “FOR TOTS” is merely descriptive of them and that the evidentiary showing relied upon by applicant is insufficient to establish that such term has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).² Registration also has been finally refused under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. § 1051, 1052, 1053 and 1127, on the ground that, as used in connection with the specimens furnished by applicant, the term “FOR TOTS” does not function as a service mark for applicant's services.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register as to the ground of mere descriptiveness, but reverse the refusal to register with respect to the ground of failure to function as a service mark.

Turning first to the latter ground of refusal, we note that applicant originally submitted various advertisements and promotional literature as specimens in which the term “FOR TOTS” appears as part of such phrases as “French for Tots,” “Spanish for Tots,” “Languages for Tots” and “Fun with French and Spanish for Tots.” While in none of those instances is the term “FOR TOTS” used in such a manner that it makes a separate and distinct commercial impression which serves to identify and distinguish applicant's services, applicant submitted another specimen, consisting of the advertisement reproduced below,



together with a declaration from its president properly verifying that such additional specimen was in use in commerce since at least as early as the filing date of its application.

*2 As the Examining Attorney, citing *In re Advertising & Marketing Development Inc.*, 821 F.2d 614, 2 USPQ2d 2010, 2015 (Fed. Cir. 1987), indicates in her brief, whether a term has been used as a mark for a particular service is a question of fact which is determined primarily on the basis of the specimen or specimens of use submitted with the application. In particular, she correctly observes that:

The fact that the proposed mark appears in an advertisement or brochure in which the services are advertised does not in itself show use as a mark. The record must show that there is a direct association between the mark and the service. See *Peopleware Systems, Inc. v. Peopleware, Inc.*, 226 USPQ 320 (TTAB 1985)

While a service mark does not have to be displayed in any particular size or degree of prominence, it must be used in a way that makes a commercial impression separate and apart from the other elements of the advertising matter or other material upon which it is used, such that the designation will be recognized by prospective purchasers as a source identifier. *In re C.R. Anthony Co.*, 3 USPQ2d 1894 (TTAB 1987). Moreover, the proposed mark must not blend so well with other matter on [the] specimens that it is difficult or impossible to discern what the mark is. *In re Royal Viking Line A/S*, 216 USPQ 795 (TTAB 1982).

Factors to be considered in determining whether the asserted mark is used as a service mark include whether the wording [claimed to constitute the mark] is physically separate from textual matter, whether [such] wording is displayed in capital letters or enclosed in quotation marks, and the manner in which a term is used in relation to other material on the specimens. See *Smith International, Inc. v. Olin Corp.*, 209 USPQ 1033 (TTAB 1981).

While a slogan can function as a ... service mark, use of a phrase or slogan to convey advertising or promotional information, rather than to identify and indicate the source of the services, is not service mark use. See *In re Brock Residence Inns, Inc.*, 222 USPQ 920 (TTAB 1984) (FOR A DAY, A WEEK, A MONTH OR MORE [held] so highly descriptive and informational in nature that purchasers would be unlikely to perceive it as an indicator of the source of hotel services).

Although asserting in her brief, in light of the above, that “upon viewing the proposed mark on the ... specimens, the ordinary customer sees the wording FOR TOTS couched between other informational wording in such a way that it does not create a separate and distinct commercial impression apart from the other elements to constitute service mark use,” the primary focus of the Examining Attorney's argument is that such wording “is used to convey to customers that the [applicant's] services are intended for use by children.” Specifically, the Examining Attorney maintains that “the phrase ‘FOR TOTS’ is a familiar expression widely used to give customers, as the Applicant does, information about services that are offered to young children.” Referring to various “Internet evidence which includes usage of the phrase ‘FOR TOTS,’ and evidence retrieved from Lexis/Nexis® which illustrates that the phrase ‘FOR TOTS’ is commonly used in connection with goods and services targeted to, and for use by [,] young children,” the Examining Attorney contends that “[t]he widespread use of such a phrase has more than likely conditioned the public to look upon the proposed mark as merely an informational advertising slogan and not as an indicator of the source of the services.”

*3 With respect, in particular, to the additional specimen furnished by applicant and reproduced above, the Examining Attorney likewise argues that “[t]he proposed phrase FOR TOTS merely utilizes ordinary words to convey information about the Applicant's services, namely, that the services are ‘for tots.’” The evidence, the Examining Attorney reiterates, clearly demonstrates that “the proposed mark is used to identify characteristics of the services and is not likely to be recognized by the public as a source indicator.”

While the Examining Attorney thus concludes that “the proposed mark fails to function as a service mark,” we find that, as used on the additional specimen submitted by applicant, the term “FOR TOTS” is indeed used in the manner of a service mark. Like the words and design comprising “THE LANGUAGE WORKSHOP FOR CHILDREN” mark, the term “FOR TOTS” is set off separately from the other matter in the advertisement and it is also displayed in larger type than the descriptive matter listing the locations in which applicant appears to render its services. As so used, there is a direct association between such term and applicant's services. It plainly is used in a way that makes a commercial impression which is separate and apart from the other matter in the advertisement, such that the term “FOR TOTS” would be recognized by prospective purchasers as a source identifier. In short, unlike the other specimens submitted by applicant, the use of the term “FOR TOTS” as shown in the additional specimen filed by applicant is service mark use.

Moreover, intrinsically, the term “FOR TOTS” is clearly different from such general informational or public service advertising slogans as those at issue in, *e.g.*, *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1460-61 (TTAB 1998) [phrase “DRIVE SAFELY” found an ordinary and commonly used safety admonition which does not function as a mark for automobiles]; *In re Manco, Inc.*, 24 USPQ2d 1938, 1942 (TTAB 1992) [term “THINK GREEN” held an informational slogan for environmental/ecological concerns which does not function as a mark for mailing and shipping boxes and weatherstripping]; *In re Remington Products Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987) [phrase “PROUDLY MADE IN USA” found an informational slogan which does not function as a mark for electric shavers]; *In re Brock Residence Inns, Inc.*, *supra* at 922 [slogan “FOR A DAY, A WEEK, A MONTH OR MORE” held so highly descriptive and informational in nature that it would not be perceived as an indicator of source for hotel services]; and *In re Tilcon Warren, Inc.*, 221 USPQ 86, 88 (TTAB 1984) [phrase “WATCH THAT CHILD” is a familiar safety slogan which does not function as a mark for crushed stone and concrete]. It is apparent, therefore, that the Examining Attorney's argument that the term “FOR TOTS” fails to function as a mark is, in essence, a contention that such term is merely descriptive of applicant's services, rather than one based on the manner in which the term is used on the additional specimen.

*4 Turning, then, to consideration of the issue of mere descriptiveness, there is no doubt that the term “FOR TOTS” is merely descriptive of applicant's educational services of providing classes in foreign languages to children and distributing course material in connection therewith. Applicant, in fact, has in effect conceded such, having amended its application to include a claim of acquired distinctiveness in response to the refusal to register on the ground of mere descriptiveness without arguing in the alternative against the refusal to register. Such a claim is tantamount to an admission that the term “FOR TOTS” is not inherently distinctive when used in connection with applicant's services and that, because it is merely descriptive thereof, it is unregistrable on the Principal Register absent a showing of acquired distinctiveness.³ *See, e.g.*, *Yamaha International Corp. v.*

Hoshino Gakki Co. Ltd., supra at 1005; In re Cabot Corp., 15 USPQ2d 1224, 1229 (TTAB 1990); In re Professional Learning Centers, Inc., supra at 71; and TMEP Section 1212.02(b) (3d ed. 2d rev. May 2003). Applicant, in essence, has also conceded the mere descriptiveness of the term “FOR TOTS” inasmuch as its prior registrations on the Principal Register of the marks “SPANISH FOR TOTS” and “FRENCH FOR TOTS” for, respectively, “educational services, namely, providing classes in the Spanish language to children and distributing course material in connection therewith” and “educational services, namely, providing classes in the French language to children and distributing course material in connection therewith,” each registered pursuant to the provisions of Section 2(f) with a disclaimer of the generic term “SPANISH” or “FRENCH.” Because the entirety of each of such marks registered on the basis of a showing of acquired distinctiveness, it is apparent that each element of such marks, including the term “FOR TOTS,” was initially considered to be merely descriptive of the respective services. See TMEP Sections 1212.02(e) and 1213.03(b) (3d ed. 2d rev. May 2003).

Furthermore, and aside from applicant's concessions, it is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of such use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, “[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

*5 Applicant, in its initial brief, “contends that FOR TOTS standing alone is a suggestive mark” because it “does not describe the attributes” of applicant's educational services of providing classes in foreign languages to children “other than the possible recipients of the services, who would not even be the decision-makers as to purchasing the services,” which of course would instead be selected by the children's parents or other interested adults. While acknowledging that the record contains examples of third-party “uses of FOR TOTS in connection with other services,” as well third-party registrations in which the term “TOTS” has been disclaimed, applicant points out that none of such instances pertains to language instruction programs or studies directed to children. Applicant admits, however, that as to the third-party uses of the term “FOR TOTS,” such “usages are, in fact, similar to Applicant's use of FOR TOTS with descriptive words denoting language, e.g., ‘shots for tots,’ ‘Torah for Tots’ and ‘Tech for Tots.’”

The Examining Attorney, on the other hand, correctly notes that a term which describes the intended users of, or targeted audience for, a particular product or service is merely descriptive thereof, See, e.g., Hunter Publishing Co. v. Caulfield Publishing Ltd., 1 USPQ2d 1996, 1998 (TTAB 1986) [term “SYSTEMS USER” found merely descriptive of a trade journal directed toward users of large data processing systems]; In re Camel Mfg. Co., Inc., 222 USPQ 1031, 1032 (TTAB 1984) [term “MOUNTAIN CAMPER” held merely descriptive of retail mail order services in the field of outdoor equipment and apparel]; In re Gentex Corp., 151 USPQ 435, 435-36 (TTAB 1966) [term “PARADER” found merely descriptive of protective helmets for persons who parade]. She persuasively argues, in view thereof, that the record demonstrates that the term “FOR TOTS” merely describes a characteristic or feature of applicant's educational services in that such term specifies that the intended users for which it provides classes in foreign languages to children are tots.

Specifically, she points out that The American Heritage Dictionary of the English Language (3d ed. 1992) defines “tot” in relevant part as “1. A small child.” In addition, she indicates in her brief that:

The examining attorney also provided evidence of the descriptive nature of the mark in the form of (1) excerpted articles from ... LEXIS/NEXIS, a computerized database in which FOR TOTS is a common

phrase used to describe products and services geared toward a recognizable consumer group; (2) excerpted articles from ... the Search Engine GOOGLE, ... which demonstrate that participants in the market place need to use the term FOR TOTS to describe the target audience for their goods and services; and (3) a sample of eight registrations wherein the term TOTS when used in connection with children related services is consistently disclaimed. The applicant's specimens include a ... mailer card, ... advertisements, and a ... brochure. All of this evidence collectively demonstrates that [applicant's] proposed mark is merely descriptive of the services because it describes the intended users of the applicant's services.

*6 Representative examples of the above mentioned evidence include the following "LEXIS/NEXIS" excerpts (emphasis added):

"Children age 3 to 5 can enjoy a two-week camp designed just for them at Time **for Tots**" -- Press-Enterprise (Riverside, CA), August 14, 2002;

"Kay Vandergrift, professor of children's literature at Rutgers University, says tracts **for tots** are akin to 19th century chapbooks--'the child-sized books with good illustrations at a time when there weren't many books available to kids.'" -- USA Today, November 6, 2000;

"SCHAFFLER: Tech **for tots**. Your kids may soon throw away their blocks. Alfy.com -- is after your tech-savvy toddler, next." -- CNN Business Unusual, October 9, 2000;

"Water floats **for tots** are sold in toy stores because they're toys, not lifesaving devices." -- CNN News, July 27, 1997;

"Stocks **for tots**: If you want to buy a couple shares of the Boston Celtics or McDonald's for a child, Charles Schwab has made the gift a bit cheaper." -- USA Today, September 12, 1996; and

"... counties that didn't have a place for children to get their shots.

....

'Shots **for Tots**' coordinator Donna Sacknoff says the program has helped, since 70% of the immunizations in Louisiana are done in public clinics." -- USA Today, April 19, 1994.

Articles excerpted from "GOOGLE" include the following representative examples (emphasis added):

"'Tales **for Tots**,' the free monthly ... storyhour for youngsters ages three to six, will begin its Fall Program on ... September 21, in the Children's Room." -- <http://www.-hobokeni.com/fohl/tots/html>;

"'ART **FOR TOTS**' with Julie Herold

....

Parents! Bring your wee ones (18 months - 3 years) down and join in the fun! Julie Herold has lots of neat art activities for you and your child to share.

Note: 'All Art **for Tots**' classes meet on Thursday mornings from 10:30-11:30 a.m." -- <http://www.muscatineartcenter.org/education.htm>;

"Torah **For Tots** is a wonderful enrichment program The classes ... provide an educational experience for three-and four-year olds, and revolve around holidays, and our wonderful Jewish culture and traditions." -- http://uahc.org/congs/-ny/ny037/torah_for_tots.htm; and

"Wings **For Tots** is an innovative ... program designed for children in preschool through second grade. Each presentation uses four birds of prey, plus touchable items such as feathers, feet and wings. Through the *hands-on* experience of Wings **For Tots** children learn through teaching and tactile experience how and why a bird differs from other animals and what makes a raptor unique among birds." -- <http://www.worldbirdsanctuary.org/educate.html>.

*7 The various third-party registrations, in which the word "TOTS" has been disclaimed, include such marks and associated services as "TOTALLY FOR TOTS" for "promoting shots for children"; "TERRIFIC TOTS" for "conducting parent-child interacting activity classes"; "TOTS OH MY!" for "day care services for tots and children"; "TECHNO TOTS" for "providing computer instruction to children"; "TITAN TOTS" for "child daycare centers"; and "JOLLY TOTS" and design for "specialized child care for infants age six weeks to pre-kindergarten." As to applicant's advertising and promotional materials, such specimens indicate, among other things, that its "FRENCH FOR TOTS" workshop is "[a] special playgroup that teaches toddlers to love French," while its "LANGUAGES FOR TOTS" programs, which include its "SPANISH FOR TOTS" as well as "FRENCH FOR TOTS" workshops, are touted as being "conducted by native speakers," so that "tots hear and absorb a correct form of pronunciation."

It is plain in light of the above that the term "FOR TOTS," as contended by the Examining Attorney, merely describes the intended users of or audience to whom applicant's educational services are principally directed. Nothing in such term is ambiguous or incongruous when considered in relation to applicant's educational services of providing classes in foreign languages to children and distributing course material in connection therewith. Consequently, no imagination, cogitation or gathering of further information would be necessary in order for customers to perceive precisely the merely descriptive significance of the term "FOR TOTS." Such term immediately describes, without the need for conjecture or speculation, that a significant characteristic or feature of applicant's services is that they are intended for tots, *i.e.*, very young children.

In addition, the fact that none of the third-party uses or registrations relates to the same services as those provided by applicant does not lessen the probative value of such evidence, since it shows, as applicant essentially admits, that regardless of the particular services in connection with which the term "FOR TOTS" is employed, it still conveys forthwith the meaning that the services are intended for tots. Several of the "GOOGLE" excerpts, in particular, illustrate such meaning with respect to various educational services consisting of classes designed for very young children. Furthermore, and in any event, even if applicant is the first and/or only user of the term "FOR TOTS" in connection with its specific educational services of providing classes in foreign languages to children and distributing course material in connection therewith, it is well established that being the initial and/or sole user of a term does not justify the registration thereof where, as here, the term projects only a merely descriptive significance, *See, e.g.*, *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 n. 8 (CCPA 1980); and *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983).

*8 Turning to the remaining issue in this appeal, it is settled that applicant has the burden of proof with respect to establishing a prima facie case that the term "FOR TOTS" has acquired distinctiveness, *See Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, *supra* at 1006. The amount and character of evidence needed to demonstrate that a term has acquired distinctiveness, however, necessarily varies, depending upon the degree of descriptiveness involved, and becomes progressively greater as the

descriptiveness of the term increases. See, e.g., *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1728 n. 4 (Fed. Cir. 1990); *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, supra at 1008; *In re Mine Safety Appliances Co.*, 66 USPQ2d 1694, 1697 (TTAB 2002); and *In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443, 1451 (TTAB 1994).

In this regard, Trademark Rule 2.41(a) provides in relevant part that an applicant may demonstrate that its mark has acquired distinctiveness by submitting “affidavits, or declarations in accordance with §2.20, depositions, or other evidence showing duration, extent and nature of use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and affidavits, or declarations in accordance with §2.20, letters or statements from the trade or public, or both, or other appropriate evidence tending to show that the mark distinguishes such goods.” In the alternative, Trademark Rule 2.41(b) provides that “[i]n appropriate cases, ownership of one or more prior registrations on the Principal Register ... of the same mark may be accepted as prima facie evidence of distinctiveness” and that an acquired distinctiveness claim may also be based on a verified statement that the mark has been in “substantially exclusive and continuous use in commerce ... by applicant for the five years before the date on which the claim of distinctiveness is made”. Trademark Rule 2.41(b) additionally states that while either of such showings “may, in appropriate cases, be accepted as prima facie evidence of distinctiveness,” “[i]n each of these situations, however, further evidence may be required.” In addition, as set forth in TMEP Section 1212.05(a) (3d ed. 2d rev. May 2003), it is the practice of the United States Patent and Trademark Office, based upon the cases cited therein, that: “If the mark is highly descriptive or misdescriptive of the goods or services named in the application, the statement of five years' use alone will be deemed insufficient to establish acquired distinctiveness.”

*9 Applicant, as indicated earlier, amended its application in response to the mere descriptiveness refusal to set forth a claim of acquired distinctiveness. Initially, applicant based such claim upon an assertion of five years substantially exclusive and continuous use of the term “FOR TOTS” in commerce in connection with its services. However, because such basis was found insufficient, due to the contention that the term sought to be registered was highly descriptive of its services, applicant subsequently submitted a declaration from its president, Francois Thibaut.

In his declaration, which is dated April 13, 2000, Mr. Thibaut avers, among other things, that applicant “first made use of the service mark FOR TOTS in connection with our school in 1973; that “[s]ince that time, use of the mark has been extended not only to many other new educational programs at our school in New York City, but also to the establishment of other programs in other states”; that “[t]he mark is now used on all the programs just mentioned”; that sales of “[t]he services offered under the FOR TOTS mark during each of the past five years have amounted to” \$802,309 in 1999, \$360,183 in 1998, \$169,238 in 1997, \$109,363 in 1996 and \$108,566 in 1995; that in the same period applicant “spent the following amounts on advertising to those people (primarily parents) who purchase our services by enrolling their children in our programs”: \$75,986 in 1999, \$85,000 in 1998, \$66,333 in 1997, \$33,475 in 1996 and \$35,165 in 1995; that applicant has “advertised recently” in 18 different newspapers and parenting guides published and distributed in New York City and other localities in the States of New York, New Jersey and Connecticut; that “[t]he service mark FOR TOTS is recognized in the educational sector and among parents purchasing education for their children as being a service mark of” applicant; that, as an example of such, is “an [attached] article from the Wall Street Journal [which appeared] pre-1992, concerning Spanish FOR TOTS and our other programs”; that applicant “is not aware that the service mark FOR TOTS has been used by any other school or educator to denote the providing of educational services to children”; and that applicant accordingly believes that its “use of the service mark FOR TOTS is and has been distinctive.” As additional evidence offered in support of its claim of acquired distinctiveness, applicant relies upon ownership of its previously noted registrations for the marks “FRENCH FOR TOTS” and “SPANISH FOR TOTS.”

Applicant insists that the above evidence suffices to demonstrate acquired distinctiveness of the term “FOR TOTS” for its educational services, asserting in its initial brief that, among other things, the Examining Attorney has not shown how “a business spending about 10% of its revenues on advertising and marketing the services under its mark for a period of years does not meet the threshold criteria for acquired distinctiveness.” We concur with the Examining Attorney, however, that the problem with such figures, which likewise extends to evaluation of the amounts of applicant's sales, lies in the fact that, as stated in her brief, “applicant did not submit copies of the cited advertisements” and, thus, there is no way of discerning whether the term “FOR TOTS” has been used in such advertising in a manner that the purchasing public has come to recognize it as a mark. Of the

sole advertising and promotional materials of record, namely, the specimens originally submitted with the application and the additional specimen subsequently filed in connection therewith, only the latter shows use, as we held above, of the term “FOR TOTS” in such a way that it functions as a mark for applicant's educational services. The extent to which applicant has used such ad, including the percentage or other indication of the amounts of its advertising and promotional expenditures spent thereon, is unknown. In view thereof, and especially in light of several instances of third-party use of the term “FOR TOTS” (e.g., “Tales for Tots,” “Art for Tots,” “Torah For Tots” and “Wings For Tots”) in connection with educational services for tots, it is plainly the case that such term is highly descriptive of applicant's services and that sales and advertising figures, in the abstract, are insufficient to demonstrate acquired distinctiveness. Such figures, at best, may show the popularity of applicant's services, but they do not establish recognition of the term “FOR TOTS” as a mark. See, e.g., In re Bongrain International (American) Corp., supra at 1729.

***10** Furthermore, given the high degree of descriptiveness demonstrated by the record with respect to the term “FOR TOTS,” it is clear that a claim of five years substantially exclusive and continuous use thereof in commerce is insufficient to establish acquired distinctiveness. As to applicant's additional argument, however, that its ownership of registrations on the Principal Register of the marks “FRENCH FOR TOTS” and “SPANISH FOR TOTS,” for basically the same services as those set forth in this application, entitles it to a finding of acquired distinctiveness for the term “FOR TOTS,” we agree with the Examining Attorney that the former are not the “same mark” as the latter for purposes of the showing permitted by Trademark Rule 2.41(b).

Applicant, as reiterated in its reply brief, argues in this regard that “[t]he difference between FOR TOTS and SPANISH FOR TOTS and FRENCH FOR TOTS is that the latter two marks add the descriptive names of languages which are the subject of the services” and which “have been disclaimed in the registrations.” While conceding that “the marks are technically not the same (being of different word count),” applicant contends that “the difference is not in the distinctive portion.” Applicant's contention is misplaced since, as noted earlier, it is not the term “FOR TOTS” which was shown to have acquired distinctiveness but the entire phrases “SPANISH FOR TOTS” and “FRENCH FOR TOTS” which, with disclaimers of, respectively, the generic words “SPANISH” and “FRENCH,” were found registrable pursuant to the provisions of Section 2(f) of the statute. Nevertheless, applicant further “urges the Board to adopt the view that in considering registrations for new word marks within a Family of Marks ... the essential common element of the marks be the measure of the same mark” (underlining in original).⁴

We decline applicant's invitation to adopt its viewpoint. As the Examining Attorney persuasively points out in her brief:

Applicant's prior registrations involve different marks. Even though the [marks in the] prior registrations [each] include the current proposed designation ..., the applied-for mark, FOR TOTS, does not include the word SPANISH or FRENCH. The public's association of the designations SPANISH FOR TOTS or FRENCH FOR TOTS with applicant does not mean that the mark FOR TOTS will automatically be seen by the public as also indicating source in applicant; and applicant has provided [virtually] no evidence at all as to the public perception of the applied-for mark.

Thus, we share the Examining Attorney's conclusion in her brief that applicant's “prior registrations do not demonstrate that the ... proposed mark has acquired distinctiveness because ... the additional terms SPANISH and FRENCH change the overall commercial impressions of the marks” so that they are not the same mark as the term “FOR TOTS.” Consequently, applicant's claim under Section 2(f) falls short of the necessary showing that the term “FOR TOTS” has acquired distinctiveness with respect to its educational services and is not registrable on the Principal Register.

***11 Decision:** The refusal to register on the ground of failure to function as a service mark is reversed, but the refusal on the ground of mere descriptiveness, including the insufficiency of the evidentiary showing with respect to the claim of acquired distinctiveness, is affirmed.

Footnotes

- 1 Ser. No. 75/516,045, filed on July 9, 1998, which alleges a date of first use anywhere and in commerce of 1973.
- 2 Thus, in the absence of a showing of acquired distinctiveness, if the term “FOR TOTS” is considered to be merely descriptive of applicant's services, it would remain unregistrable under Section 2(e)(1). See, e.g., *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1007 (Fed. Cir. 1988), *citing* *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 n. 2 (TTAB 1983).
- 3 This situation is to be distinguished from that where an applicant, in response to a mere descriptiveness refusal, not only adds a claim in the alternative that the matter sought to be registered has acquired distinctiveness pursuant to Section 2(f), but also argues against the merits of the Examining Attorney's position. In such instance, it is permissible to advance the claim that such matter has acquired distinctiveness, yet argue in the alternative that the matter sought to be registered is not merely descriptive, inasmuch as the former does not constitute a concession that the matter sought to be registered is not inherently distinctive. See, e.g., *In re E S Robbins Corp.*, 30 USPQ2d 1540, 1542 (TTAB 1992); *In re Professional Learning Centers, Inc.*, 230 USPQ 70, 71 n. 2 (TTAB 1986); and TMEP Section 1212.02(c) (3d ed. 2d rev. May 2003).
- 4 It should be pointed out that the fact that the record shows that applicant is the owner of the two registrations mentioned above and also uses the phrase “LANGUAGES FOR TOTS” does not prove that applicant has created a “family of marks” which the purchasing public recognizes by the surname “FOR TOTS.” See, e.g., *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991). As the Examining Attorney properly observes in her brief, to establish a family of marks “it must first be shown by competent evidence ‘that ... the marks containing the claimed ‘family feature[,] or at least a substantial number of them, were used and promoted together ... in such a manner as to create public recognition coupled with an association of common origin predicated on the ‘family’ feature; and second, that the ‘family’ feature is distinctive (i.e. not descriptive or highly suggestive or so commonly used in the trade that it cannot function as a distinguishing feature of any party's mark),” *citing* *Land-O-Nod Co. v. Paulison*, 220 USPQ 61, 65-66 (TTAB 1983). Here, even assuming that proof of a family of marks could be used to demonstrate acquired distinctiveness of the family element or surname, the Examining Attorney is correct in noting that “the words FOR TOTS are highly descriptive of the [applicant's] services [,] which ... are provided to young children, i.e., ‘tots,’” and thus application of the family of marks doctrine “does not support registration of the designation FOR TOTS.”

2003 WL 21996100 (Trademark Tr. & App. Bd.)

2012 WL 2930643 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

IN RE THOMAS JEFFERSON FOUNDATION, INC.

Serial No. 77967242

June 29, 2012

Filed on March 24, 2010

*1 Mary Daton Baril of McGuire Woods LLP for Thomas Jefferson Foundation, Inc.

Judy M. Helfman

Trademark Examining Attorney

Law Office 114

(K. Margaret Le, Managing Attorney)

Before Kuhlke, Wellington and Greenbaum

Administrative Trademark Judges

Opinion by Wellington

Administrative Trademark Judge:

Thomas Jefferson Foundation, Inc. filed an application to register MONTICELLO (in standard characters) as a trademark on the Principal Register for “house paint” in International Class 2.

The examining attorney has refused registration of applicant's mark under the provisions of Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127, on the ground that the mark, “as used on the specimens of record, serves solely as a color designation and does not serve a trademark function.” Brief, p. 1. In addition, the examining attorney rejects applicant's argument that its mark functions as a trademark because it has secondary source significance.

The application was originally filed based on applicant's intent to use in commerce and it was approved by the Office for publication in the Official Gazette for opposition. Upon expiration of the opposition period and without any opposition having been filed, the Office issued a Notice of Allowance. Applicant then filed its Statement of Use (SOU), alleging a date of first use in commerce and providing the following specimen of use:



Applicant describes the specimen in the SOU as the “front and back of the paint card found at point of purchase display” and that the mark “is being used pursuant to a license from applicant to Ralph Lauren.”

The applied-for mark was then refused registration by the examining attorney who asserted that the mark is merely a color designation and does not function as a trademark. In particular, she stated that the proposed mark is “used to denote one color of paint and to distinguish it from other colors of paints” and the “impression that MONTICELLO makes on the relevant public would be solely connected to a specific shade of yellow paint, and not as a trademark denoting origin of the identified goods.” Office action (January 5, 2011).

*2 In response to the refusal to register, applicant filed the following additional specimens of use:



Applicant states that the additional specimens comprise “a point of purchase placard that shows a photo of the product with the mark on it.” Applicant also goes on to argue that its mark “is functioning to identify a secondary source” because “[t]he word Monticello used in connection with paint can signify that Monticello authorizes or licenses the sale of the paint by Ralph Lauren, which is in fact a licensee of the mark Monticello for use with paint.” Applicant attached copies of printouts from the Ralph Lauren Home website explaining the relationship between it and applicant, including a brief history of the actual paint colors used in Thomas Jefferson's home, Monticello.

The examining attorney was not convinced by the additional specimens and, in the July 25, 2011 Office action, made the refusal “final,” maintaining that “no specimen of record demonstrates trademark use of the proposed mark for the identified goods.”

Applicant has appealed and both applicant and the examining attorney filed briefs. For the reasons explained below, we reverse the refusal to registration.

Although we disagree with the examining attorney's ultimate conclusion, we note that she has correctly set forth in her brief the statutes and cases governing our review of this matter given the particular refusal to register the applied-for mark. In particular, for determining whether applicant's MONTICELLO functions as a trademark, we keep in mind that in order to be registrable, the term must be perceived by the purchasing public as identifying and distinguishing the source of the goods. Section 2 of the Act, 15 U.S.C. § 1052. “The Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be registration, there must be a trademark, and unless words have been so used they cannot qualify.” *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976), citing *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (CCPA 1960). “A critical element in determining whether a term or phrase is a trademark is the impression the term or phrase makes on the relevant public.” *In re Volvo Cars of North America, Inc.*, 46 USPQ2d 1455, 1458 (TTAB 1998). “The question whether the subject matter of an application for registration functions as a mark is determined by examining the specimens along with any other relevant material submitted by applicant during prosecution of the application.” *In re The Signal Companies, Inc.*, 228 USPQ 956, 957 (TTAB 1986).

*3 An important function of specimens in a trademark application is, manifestly, to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used as a trademark with respect to the goods named in the application.

Bose, 192 USPQ at 216 (footnote omitted).

With regard to color designations, the Board has long held that the use of a proposed mark to identify one particular style or color shade for the goods, *e.g.*, lipstick, paints, etc., does not necessarily render the term unable to function as a trademark. The fact that a term may be used as a color or style designation to identify one particular style or color of a product and distinguish it from the other colors or styles of the same type of merchandise does not necessarily mean that it likewise cannot function as a trademark to identify such goods from like goods of others... [T]he criteria for registration of a term such as that involved herein are that the term be an arbitrary designation which does not in itself have a connotation of color as used on and in connection with the goods in question and that it is applied in the manner of a trademark to the product. In the instant case, there is no question but that the mark “BLANCO” is used in the manner of a trademark on labels affixed to the plywood panels.

In re Champion International Corporation, 183 USPQ 318 (TTAB 1974), citing to *In re Clairol Inc.*, 173 USPQ 355, 457 F.2d 509 (CCPA 1972), (other internal citations omitted). In *Champion*, the Board noted that applicant was applying its proposed mark “in the manner of a trademark on labels affixed to the [goods],” but ultimately refused registration because the term BLANCO (meaning “white”) was merely descriptive of the identified goods. In the *Clairol* decision, the predecessor of our primary reviewing court reversed the Board and found SWEDISH CRYSTAL for hair color products registrable because it was a “coined and completely arbitrary term” and was used as a trademark despite also being a color designation and always followed by wording, “light muted ash.” The *Clairol* court instructed that a proper inquiry involves looking beyond any intent by applicant to use the mark as a color designation:

...a mark may be used for both a trademark purpose and a non-trademark purpose and still be a valid trademark. (Internal citation omitted). We are of the opinion that the facts in this case—including the manner in which the mark is used, the fact that it is always used in addition to a shade designation and the arbitrariness of the mark—evidence a clear intent to use the mark to indicate the source of the goods. The cases cited by the board are not controlling on these facts. The arbitrariness of the mark further tends to establish that the ordinary purchaser would consider that the mark indicates origin.

*4 *Clairol*, 173 USPQ at 355-356.

The facts and evidence, in particular the specimens of use, demonstrate that applicant's use of MONTICELLO is akin to that of the applicant in the *Clairol* decision. Like “Swedish Crystal,” the term “Monticello” has no meaning or suggestive connotation with respect to a color. That is, unlike, *e.g.*, “lemon” or “banana,” it is not a term that would describe or even suggest a shade of yellow. Moreover and more importantly, applicant's manner of use of “Monticello” in connection with the identified goods rises to a level where consumers would view the term as more than merely being a color designation. To be clear, we point out that we share the same concerns as the examining attorney with regard to the original specimen of use, comprising a paint swatch card merely bearing the wording “Monticello Yellow” on one side and the color swatch on the other side. That swatch card alone does not constitute trademark use because, as shown by the evidence submitted by the examining attorney, a paint manufacturer such as applicant's licensee may assign terms to various colors and shades of paint without any intention of using said terms to identify or distinguish the source of the paint. However, the additional specimen submitted by applicant, viewed in its entirety, does constitute proper trademark use on the identified goods. The point-of-purchase placard was presumably prepared by applicant's licensee, Ralph Lauren, and shows the wording “Monticello™ Yellow” on a can of paint. On the adjoining page, the wording “Ralph Lauren Introduces Monticello™ Yellow” appears prominently at the top.¹ The term “Monticello” is also used on both pages in reference to the historic home of Thomas Jefferson, and discusses how the home inspired the paint. We find that consumers who receive this point-of-sale placard will perceive applicant's use, through its licensee, of the term “Monticello” as a term used uniquely by applicant to identify and distinguish applicant as the source of that particular paint.

We acknowledge the record indicates that applicant uses “Monticello” to designate a single shade of yellow paint, rather than to identify a line of various paints in different colors. Indeed, the record reflects that names of other historic homes, such as Biltmore and Mount Vernon, are used by others as source identifiers on a series of various styles or colors of paints. Nevertheless, the fact that applicant may use Monticello as identifying one particular color or shade does not prohibit the term from also being used by applicant in a trademark manner. Again, “a mark may be used for both a trademark purpose and a non-trademark purpose and still be a valid trademark.” *Clairol* at 355. Simply put, so long as applicant has submitted a specimen showing proper trademark use of the term MONTICELLO, and it has, then the mark may be registered.

*5 Because we find that applicant's mark, MONTICELLO, is capable of functioning as a trademark and the substitute specimen of use is acceptable and reflects such trademark use, we need not discuss the alternative issue of whether applicant's mark functions as trademark as a result of any secondary source attributions.²

Decision: The refusal to register MONTICELLO on the ground that it fails to function as a mark is reversed.

Footnotes

- 1 The fact that the trademark symbol or superscript TM is employed in the specimens should not be viewed, by itself, as elevating applicant's use of the term “Monticello” to trademark use.
- 2 We would be remiss, however, if we did not point out that applicant's argument that secondary source meaning as a result of applicant's use of the term MONTICELLO on other goods is not supported by the evidence. The record does not establish that applicant has used the term MONTICELLO on any other goods. Rather, in its June 22, 2011 response to an Office action, applicant merely states that it licenses use of the term to others for use on goods and applicant references its “retail website” (providing a URL). Printouts from the website showing use of the mark on other goods were not submitted.

2012 WL 2930643 (Trademark Tr. & App. Bd.)

2001 WL 253633 (Trademark Tr. & App. Bd.)

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

MCCORMICK DELAWARE, INC. AND MCCORMICK & COMPANY, INCORPORATED

v.

WILLIAMS FOODS, INC.

Cancellation No. 28,967

February 14, 2001

*1 Before Hanak, Wendel and Rogers
Administrative Trademark Judges.

By the Board:

Petitioners seek to cancel the registration of respondent's mark SEASON 'N BAKE for "meat seasonings sold together with a roasting bag" in Class 16.¹ As grounds for the cancellation, petitioners allege that respondent's mark, when used on the identified goods, so resembles petitioners' previously used and registered marks as to be likely to cause confusion, mistake or deception. Petitioners' pleaded registered marks are:



for "seasoning mixes for meats and roasting bags combined in unitary packages and sold in the seasoning departments of retail outlets" in Class 46² and SEASON 'N FRY for "seasoning and flavor intensifier" in Class 30.³

In its answer, respondent admits that the dates of issuance and the dates of first use of petitioners' pleaded registrations are prior to any date of first use upon which respondent can rely.⁴ Respondent also admits that goods sold under the parties' respective marks are similar; that the goods are sold to the same classes of consumers in the same channels of trade; and that the parties' respective goods are competitive.⁵ With respect to its SEASON 'N BAKE mark and petitioners' pleaded BAG'N SEASON mark, respondent admits that the packaging of the parties' respective goods uses the same color scheme.⁶ With respect to its SEASON 'N BAKE mark and petitioners' SEASON 'N FRY mark, respondent admits that "both consist of the word 'SEASON' and a word identifying a cooking process separated by an apostrophe and the letter 'N'." DD"⁷ Respondent otherwise denies the salient allegations of the petition to cancel, and filed a counterclaim to cancel petitioners' pleaded registration for the mark BAG'N SEASON (Registration No. 980,062), alleging that BAG'N SEASON is the generic name for the goods for which the mark is registered.

Petitioners deny the salient allegations of the counterclaim.

This case now comes up on the following motions:

- 1) petitioners' fully briefed motion for summary judgment in their favor on respondent's counterclaim;
- 2) respondent's fully briefed cross motion for summary judgment in its favor on its counterclaim;
- 3) petitioners' motion for summary judgment in their favor on their main claim of likelihood of confusion;

- 4) respondent's motion to defer consideration of petitioners' motion on their main claim and motion to allow respondent discovery under Fed. R. Civ. P. 56(f) with respect to petitioners' motion;
- 5) petitioners' fully briefed motion for sanctions against respondent under Fed. R. Civ. P. 11;
- 6) respondent's motion for determination of sufficiency of objections to requests for admission; and
- *2 7) respondent's motion to compel discovery and for discovery sanctions.

The Board has carefully reviewed the parties' respective arguments and evidentiary submissions with respect to the above-identified motions, according the evidence its appropriate probative weight.

Petitioners' motion for appropriate sanctions, including dismissal of the counterclaim with prejudice, under Fed. R. Civ. P. 11

In support of their motion, petitioners argue that, subsequent to respondent's filing of its counterclaim, the Federal Circuit issued its decision in *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (1999); and that in view of said decision, petitioners' counsel "suggested to" respondent's counsel that respondent's counterclaim was without legal basis and should be withdrawn. Additionally, petitioners argue that respondent did not make a reasonable inquiry as to whether BAG'N SEASON is generic because respondent did not produce any evidence of the generic use of BAG'N SEASON. Petitioners contend that BAG'N SEASON is a phrase, not a compound word, because there are two separate words and a separate abbreviation. Thus, according to petitioners, the holding of *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) is not applicable because *American Fertility* expressly limits *Gould Paper* to "compound terms formed by the union of words." See *American Fertility*, 188 F.3d at 1348. Petitioners also speculate that respondent may have brought the counterclaim for the improper motive of harassing petitioners into settlement or into withdrawing their petition to cancel.

In response, respondent argues that its counterclaim is not frivolous simply because the parties have different interpretations of the applicability of the case law. It is respondent's position that BAG'N SEASON is a compound word that is generic under *Gould Paper*; and that a term may be generic yet not represented in any dictionary. In addition, respondent contends that petitioners portray their mark inconsistently in "attempting to characterize" the term as a phrase rather than a compound word, thus actually undermining petitioners' claim that their mark is a phrase. Respondent has identified the following portrayals of petitioners' mark: BAG'N SEASON; BAG 'N SEASON; BAG'nSEASON. Respondent states that its counterclaim was brought for a proper purpose, namely, to prevent its registered mark from being cancelled on the ground that there is likelihood of confusion with a term respondent believes is generic.

Under Fed. R. Civ. P. 11(b),⁸ the signatory to a document is certifying that the document under scrutiny was not brought for an improper purpose; and that, after reasonable inquiry into both the law and the facts, the signer has concluded that there are good grounds to support the document.

The disagreement of respondent and petitioners over the applicability of the law set forth in *American Fertility* to the circumstances presented herein, and their disagreement whether petitioners' mark is a compound word or a phrase, do not support the imposition of sanctions under Fed. R. Civ. P. 11.

*3 In view thereof, petitioners' motion for sanctions against respondent pursuant to Fed. R. Civ. P. 11 is denied.

The parties' cross motions for summary judgment on respondent's counterclaim to cancel petitioners' BAG'N SEASON mark as generic

By their motion for summary judgment, petitioners seek judgment as a matter of law on respondent's counterclaim, arguing that there are no genuine issues of material fact and that their mark BAG'N SEASON is not generic for "seasoning mixes for meats and roasting bags combined in unitary packages and sold in the seasoning departments of retail outlets."

By its cross motion for summary judgment, respondent seeks judgment as a matter of law on its counterclaim, arguing that there are no genuine issues of material fact and that petitioners' mark BAG'N SEASON is generic because it is a compound term that is composed of words that have the same meaning taken individually or combined.

A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548 (1986). The mere fact that we are presented with cross motions does not dictate that summary judgment is appropriate. We will examine the evidence to see whether, if there are no genuine disputes, either party is entitled to summary judgment as a matter of law.

A generic term identifies a type of goods or services and not the source of such goods or services. 3 *Callman Unfair Competition, Trademarks & Monopolies*, Section 18.03 (4th ed. 1983). A determination that a term is generic requires evidence showing the genus of the goods or services at issue and an understanding by the general public that the term refers primarily to that genus of goods or services. See *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986); and *American Fertility*, 51 USPQ2d at p. 1834. The holding of *Gould* provides additional assistance in determining genericness with respect to compound words, where it can be shown that the public understands the individual terms to be generic for a genus of goods and services and the joining of the individual terms into one compound word lends no additional meaning to the term. See *American Fertility*, 51 USPQ2d at p. 1837.

In support of their motion, and in response to respondent's cross motion, petitioners argue that BAG'N SEASON is understood by the public to refer to its product and not generally to "products that combine seasoning mix and roasting bags." Petitioners argue that there is no evidence of generic use of BAG'N SEASON, that its competitors do not use BAG'N SEASON to sell their competing products, and that respondent has indicated through the discovery depositions of its officers that it knows of no generic use of BAG'N SEASON. In addition, it is petitioners' position that BAG'N SEASON is a phrase, not a compound word, and, thus, cannot be generic even if the components taken individually were found to be generic (which, in any event, petitioners do not believe to be the case).

*4 In support of its cross motion, and in response to petitioners' motion for summary judgment, respondent argues that the Federal Circuit in *American Fertility* articulated two different tests for determining genericness, one for phrases and another for compound terms. Respondent contends that petitioners' BAG'N SEASON mark is a compound term that combines the generic words "bag" and "season" in a union that has no unique meaning apart from its components; that the words separately and combined describe a container and the act of enhancing the flavor of food; and that, because the words separately and combined have the same meaning, genericness has been established conclusively. Respondent argues that petitioners' packaging "bolsters the conclusion" that BAG'N SEASON is generic because information directly below the mark describes what the product is and how a consumer is to use the product: "Cooking Bag & Seasoning Blend" and "Roasting Bag & Seasoning Blend." Respondent argues that petitioners have used their mark in an inconsistent presentation format, apparently trying to establish that the mark is a variable phrase and not a compound term, because a measurable space between certain components may exist. The presentation formats identified by respondent are: BAG 'N SEASON, BAG'nSEASON, and BAG'n SEASON.

As evidentiary support for their arguments, petitioners have submitted the following: relevant pages from five representative dictionaries indicating an absence of entries for the term BAG'N SEASON; results of a NEXIS search disclosing eight references to BAG'N SEASON, all of which refer to petitioners' product; results of Internet searches using the GOOGLE, ALTA VISTA, and GOTO search engines wherein all disclosures from the searches of BAG'N SEASON refer to petitioners' products; the declaration of Virginia Maycock, director of Internet Marketing Applications for the McCormick Schilling Division of petitioner McCormick & Company, averring in part that the phrase BAG'N SEASON does not appear on the packaging of petitioners' major competitors or on respondent's web site,⁹ with accompanying exhibits including copies of competitors' packaging and

an excerpt from respondent's web site; the deposition testimony of respondent's officers and personnel that they are not aware of any use of BAG'N SEASON to refer to something other than petitioners' products, that they do not use BAG'N SEASON to refer to respondent's products, and that BAG'N SEASON is not generic for the products.¹⁰ In addition, petitioners have submitted excerpts from responses to their discovery requests; the declarations of Judith Sapp, petitioners' attorney, and Robert W. Skelton, vice president, general counsel and secretary of McCormick & Company concerning the presentation formats of BAG'N SEASON; pricing lists for petitioners' goods; actual packaging for petitioners' goods showing the mark thereon; and excerpts from the Office's database of registered and pending marks, and other Office records.

*5 As evidentiary support for its arguments, respondent has submitted the following: photocopies of packaging for petitioners' goods; dictionary definitions of the words "bag" and "season;" copies of on-line advertisements showing "n" as a connector between two words; a copy of a trademark search for ""n" used to join words in the food products category and for "season" used in the food industry; and an excerpt from the deposition of John F. Sauer (discussed further at footnote 11 herein).

After careful consideration of the evidentiary submissions presented by each party, we find that petitioners have met their burden of establishing that no genuine issues of material fact exist and that their registered mark BAG'N SEASON is not generic for "seasoning mixes for meats and roasting bags combined in unitary packages and sold in the seasoning departments of retail outlets." In coming to this conclusion, we find it immaterial whether BAG'N SEASON is a phrase or a compound word. Contrary to respondent's position, the Court in *American Fertility* did not articulate two separate tests for genericness depending on whether the mark was a compound term or a phrase. Rather, the Court made it eminently clear that the correct legal test is that set forth in *Marvin Ginn*, requiring evidence of "the genus of the goods or services at issue" and the understanding by the general public that the mark refers primarily to "that genus of goods or services," and that *Gould* does not justify a short-cut around this test but, rather, may provide additional assistance in determining the genericness of compound words only. See *American Fertility*, 51 USPQ2d at p. 1837. Whether a mark is a phrase or a compound word, the inquiry remains the same: is the sum total of the separate components no less generic than the components themselves, or does the combination yield something more? Here, there is no evidence to establish that the combination of words BAG'N SEASON is perceived by the public as a generic phrase or term. Rather, the evidence establishes that there is no genuine issue of material fact, and that, as a matter of law, BAG'N SEASON is not generic.

Accordingly, respondent's cross motion for summary judgment in its favor on its counterclaim is denied; petitioners' motion for summary judgment in its favor on respondent's counterclaim is granted; and the counterclaim is dismissed with prejudice.¹¹

Petitioners' motion for summary judgment on likelihood of confusion; respondent's motion to defer consideration of petitioner's motion on their main claim; and respondent's motion for a continuance under 56(f)

Petitioners seek judgment, as a matter of law, arguing that there are no genuine issues of material fact, and a likelihood of confusion exists between their registered mark BAG'N SEASON for "seasoning mixes for meats and roasting bags combined in unitary packages and sold in the seasoning departments of retail outlets" and respondent's registered mark SEASON 'N BAKE for "meat seasonings sold together with a roasting bag."

*6 In response, respondent moved for deferment of the Board's consideration of petitioners' motion for summary judgment on likelihood of confusion, pending the Board's decision on the parties' cross motions for summary judgment on the counterclaim. Respondent also moved for discovery pursuant to Fed. R. Civ. P. 56(f) with respect to petitioners' motion for summary judgment on likelihood of confusion.

In view of our decision granting petitioners' motion for summary judgment, and denying respondent's cross motion for summary judgment, on the counterclaim, respondent's motion for deferment is now moot and need not be considered.

In support of its 56(f) motion, respondent argues that it does not have all the facts necessary to respond to petitioners' motion and seeks discovery in the following areas:¹²

- 1) Specific facts and documentation relating to petitioners' design of the packaging in which BAG'N SEASON products are currently sold;
- 2) Specific facts and documentation relating to petitioners' actual and continuous use of BAG'N SEASON in connection with the goods set forth in Registration No. 980,062;
- 3) Specific facts and documentation relating to petitioners' marketing and advertising for BAG'N SEASON from at least the period immediately preceding and through the period after the re-launch and re-design of the BAG'N SEASON product;
- 4) Information regarding any discontinuance of use of petitioners' mark;
- 5) Documentation relating to specific interrogatories associated with each of the above requests; and
- 6) Information supporting petitioners' claim that BAG'N SEASON products are extremely popular with customers.

In response, petitioners argue that respondent's 56(f) motion does not comply with the requirements of the Rule because the declaration of respondent's attorney in support of the motion is deficient. Specifically, petitioners argue that the declaration omits the essential statement under 28 U.S.C. 1746 as follows: "I declare (or certify, verify or state) under penalty of perjury that the foregoing is true and correct. Executed on (date)." In addition, petitioners argue that respondent has not pled that petitioners have abandoned their mark and, thus, is not entitled to discovery on this unpleaded issue; and that the remaining information sought by respondent is in respondent's possession or is irrelevant.

In reply, with respect to her declaration in support of the 56(f) motion, respondent's attorney argues that, by signing the statement, she made a certified statement under Patent and Trademark Rule 10.19(b) that is equivalent to the language specified in 28 U.S.C. 1746.

While the better practice would have been to set forth the language of 28 U.S.C. 1746, we agree with respondent's attorney that her declaration is sufficient. Moreover, by referencing 28 U.S.C. 1746 in her statement, respondent's attorney has indicated her familiarity with the language and incorporated the requisite language by reference. Thus, respondent's motion under Fed. R. Civ. P. 56(f) is properly before us.

*7 As a general rule, motions under 56(f) will be liberally treated. If a party has demonstrated a need for discovery which is reasonably directed to facts essential to its opposition to the motion for summary judgment, discovery will be permitted. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). We note at the outset that petitioners did not respond to most of respondent's discovery requests, served well before the filing of petitioners' summary judgment motions.¹³

The only discovery which may be requested at this time is that specifically directed to the issues raised by petitioners motion for summary judgment on likelihood of confusion. Despite respondent's arguments to the effect that petitioners have raised the issue of abandonment by discussing their relaunch and redesign of the BAG'N SEASON product line, any alleged abandonment by petitioners of their mark was not pleaded in respondent's counterclaim or raised as a defense by respondent. Moreover, even if it were pleaded, abandonment is not at issue in the summary judgment motion. Thus, discovery requests concerning the issue of abandonment are not essential to respondent's opposition to petitioners' motion for summary judgment and lie beyond the permissible scope of discovery under Rule 56(f).

Accordingly, respondent's motion for 56(f) discovery is **denied** as to the following areas:

- 1) specific facts and documentation relating to petitioners' actual and continuous use of BAG'N SEASON in connection with the goods set forth in Registration No. 980,062, and documentation related thereto (respondent's first set of interrogatories Nos. 30, 10 and 20, and respondent's first set of requests for production of documents No. 30); and
- 2) information regarding any discontinuance of use of petitioners' mark, and documentation related thereto (respondent's first set of interrogatories, No. 29, and respondent's first set of requests for production of documents No. 10).

We find that respondent's remaining requests under 56(f) are essential to its opposition of petitioners' motion for summary judgment. Accordingly, respondent's motion for 56(f) discovery is **granted** and respondent is entitled to discovery as follows:

- 1) specific facts and documentation relating to petitioners' design of the packaging in which BAG'N SEASON products are currently sold, and documentation related thereto;
- 2) specific facts and documentation relating to petitioners' marketing and advertising for BAG'N SEASON from at least the period immediately preceding and through the period after the re-launch and re-design of the BAG'N SEASON product, and documentation related thereto; and
- 3) information supporting petitioners' claim that BAG'N SEASON products are extremely popular with customers.

Petitioners' are allowed until **thirty days** from the mailing date of this order to serve responses to respondent's first set of interrogatories Nos. 1, 7, 8, 9, 17, 20, 21, 22, and to respondent's first requests for production of documents Nos. 7, 9, 22, 30, 41, and 3, with document request No. 3 limited to interrogatories for which 56(f) discovery has been granted, as requested.

***8** Respondent is allowed until **sixty days** from the mailing date of this order to file its response to petitioners' motion for summary judgment on their claim of likelihood of confusion.

Respondent's motion for determination of sufficiency of objections to requests for admission and respondent's motion to compel discovery

Consideration of respondent's discovery motions are deferred pending consideration of petitioners' motion for summary judgment on their main claim. In the event that proceedings are resumed, the Board will allow time for petitioners to respond to respondent's discovery motions.

We find it necessary at this point, however, to address the parties' apparent dispute as to the adequacy of service with respect to respondent's first set of interrogatories and first requests for production of documents.

Respondent's attorney indicates that, on November 2, 1999, she served petitioners' counsel by first class mail and by facsimile transmission, with respondent's first interrogatories and document requests and that, inadvertently, the certificate of service for the copy transmitted by facsimile was also attached to the original discovery requests served by first class mail. Respondent's attorney avers that she personally placed the discovery requests at issue in an envelope properly addressed to petitioners' counsel and deposited them with her law firm's mail service on November 2, 1999, for delivery by first class mail.

In letters dated January 6 and 21, 2000, petitioners' counsel informed respondent's counsel that no responses to the first requests for interrogatories and documents have been made because petitioners have not been served with them. More specifically, petitioners' attorney informed respondent that respondent's certificates indicate that service was made by facsimile, which does not constitute service under Fed. R. Civ. P. 5(b) or Trademark Rule 2.119. In response to respondent's January 14, 2000 request that petitioners' counsel advise respondent if petitioners' counsel had not received the hard copies sent by first class mail, petitioners' counsel stated that respondent's "certificate of service speaks for itself."

While respondent's certificate of service may have been inadequate on its face, respondent's attorney has stated by affidavit that she deposited the discovery requests in question with her law firm's mail service for delivery by first class mail and petitioners' attorney has not denied that the hard copies were received by mail. A mistake on the face of the certificate of service will not cause the papers otherwise properly served to be disregarded where there has been actual receipt. See, for example, Wright & Miller, 4A *Federal Practice and Procedure: Civil 2d*, Sections 1147-1150 (1987, supp. 2000).

Accordingly, the Board will not entertain any arguments concerning the adequacy of respondent's service by first class mail of its first set of interrogatories and first requests for production of documents in view of petitioners' apparent actual receipt by first class mail thereof.

*9 The parties are reminded that they are expected to cooperate with one another in the discovery process and to treat one another cordially and reasonably, to avoid the need for Board intervention and "micro-management" of the case. The Board is not a court, and this proceeding is an administrative hearing on the question of registrability only. See Section 17 of the Trademark Act; and TBMP Section 102.01. Moreover, with respect to discovery, each party (and its attorney) has a duty to seek only relevant discovery and to provide relevant discovery. See TBMP Section 412.01. The Board expects this case to proceed accordingly.

Footnotes

- 1 U.S. Registration No. 2,242,205, registered on April 27, 1999, claiming use in commerce since January 28, 1997.
- 2 U.S. Registration No. 980,062, registered on March 5, 1974, claiming use in commerce since March 24, 1972. Section 8 accepted; Section 15 acknowledged; first renewal June 28, 1994.
- 3 U.S. Registration No. 1,041,898, registered on June 22, 1976, claiming use in commerce since August 13, 1975. Section 8 accepted; Section 15 acknowledged; first renewal February 28, 1996.
- 4 Paragraph Nos. 3 and 8 of respondent's answer.
- 5 Paragraph Nos. 10, 11, and 13 of respondent's answer.
- 6 Paragraph No. 10 of respondent's answer.
- 7 Paragraph No. 12 of respondent's answer.
- 8 The full text of Fed. R. Civ. P. 11(b) is as follows: **Representations to Court.** By presenting to the court (whether by signing, filing, submitting, or later advocating) a pleading, written motion, or other paper, an attorney or unrepresented party is certifying that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, —
 - (1) it is not being presented for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation;
 - (2) the claims, defenses, and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;
 - (3) the allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and
 - (4) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on a lack of information or belief.
- 9 More specifically, Ms. Maycock identifies Williams (respondent herein) and Tone as petitioners' major competitors with respect to the roasting bag and seasoning mix products; and that Williams sells its goods under the SEASON'N BAKE mark while Tone sells its goods under the DURKEE and FRENCH'S marks.
- 10 More specifically, the excerpts submitted by petitioners are from the depositions of George M. Young, senior vice president for respondent; Rob Atkinson officer of respondent and John F. Sauer, vice president of marketing for

respondent. While petitioners have submitted some excerpts from Mr. Sauer's deposition to prove that respondent's officers do not believe BAG'N SEASON is generic, we are mindful that, as pointed out by respondent with accompanying excerpts from the deposition, Mr. Sauer may not understand the meaning of "generic" with respect to trademarks. Thus, we have accorded Mr. Sauer's statements in this regard their limited probative weight.

11 The fact that respondent's motion for summary judgment was denied does not amount to a finding that its counterclaim was frivolous. Consequently, the Board will not entertain any renewed motion under Fed. R. Civ. P. 11 to that effect. See, for example, Fed. R. Civ. P. 11(b) and (c), Advisory Committee's Notes (1993).

12 For each area for which discovery is sought under Fed. R. Civ. P. 56(f), respondent identified its specific request numbers from its original discovery requests. Although it appears that petitioners responded to some of the requests before the summary judgment motions were filed, because of the suspension of proceedings herein after the motions were filed, they did not respond to all of respondent's discovery requests.

13 Petitioners' non-responsiveness to respondent's discovery requests is the subject of respondent's pending motion to compel discovery and motion for determination of the sufficiency of objections to requests for admissions.

2001 WL 253633 (Trademark Tr. & App. Bd.)

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1999 TTAB LEXIS 406

Trademark Trial and Appeal Board

August 10, 1999, Decided

Opposition No. 108,947; Opposition No. 113,776; Cancellation No. 27,301 ¹

Reporter

1999 TTAB LEXIS 406 *

Sansegal Sportswear, Inc. v. Cynthia Tivers

Core Terms

counterclaim, clothing, cancellation, registration, marks, consolidation, generic, dilution, Trademark, asserts, summary judgment motion, argues

Panel: [*1] Before Hairston, Holtzman, and Rogers, Administrative Trademark Judges.

Opinion

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

By the Board:

On December 15, 1997, opposer [Sansegal] filed an opposition alleging that the registration of applicant's mark A BIG ATTITUDE should be refused because of a likelihood of confusion among consumers, in view of opposer's previously registered marks ATTITUDE and ATTITUDE ANYWEAR. ² On February 6, 1998, applicant [Tivers] filed an answer in the opposition proceeding and a separate petition for cancellation of Sansegal's registration of the mark ATTITUDE. ³

Sansegal moved to dismiss the petition, arguing that Tivers should have filed a counterclaim in the opposition. The Board denied that motion, ordered consolidation of the two [*2] cases, and directed that the petition be considered as a counterclaim in the opposition.

¹ By this order, Opposition No. 108,947, previously consolidated with the cancellation case, is consolidated with Opposition No. 113,776. The consolidation is discussed within.

² The parties' respective marks are used for various clothing items in International Class 25.

³ Registration No. 1,915,006 on the Principal Register, issued August 29, 1995, which sets forth dates of first use of 1985, for ATTITUDE for clothing and sportswear, namely jackets, sweatsuits, shorts, swimwear, shirts, t-shirts, sweatshirts, hats, and tanktops, in International Class 25.

Sansegal filed a motion for summary judgment on August 25, 1998, asking the Board to dismiss Tivers' counterclaim. In the counterclaim, Tivers asserts three grounds for cancellation. She claims that the word ATTITUDE is: (1) "a common, generic word with no distinguishing properties"; (2) "highly diluted through its often repeated use as part of many word combinations comprising numerous marks in the Class 25 category"; and (3) "generic to any kind of clothes." Sansegal argues that Tivers has failed to assert a proper ground for cancellation; argues that the mark ATTITUDE used in connection with clothing and sportswear is arbitrary in that it neither describes nor suggests the products; and asks the Board to rule as a matter of law that the mark ATTITUDE is not generic for clothing and sportswear and is, instead, inherently distinctive and entitled to trademark protection. In addition, Sansegal asserts that Tivers' "dilution" allegation does not provide a basis for a petition to cancel its registration.

In response, Tivers filed only a short affidavit. Tivers argues that Sansegal's mark ATTITUDE [*3] is weak, and that the general public does not recognize the word "attitude" as solely belonging to Sansegal. Tivers lists twenty marks which include the term "attitude" and which assertedly are used on or in connection with goods in International Class 25. ⁴ Tivers draws a distinction between her mark BIG ATTITUDE for "high-end women's exercise and active wear" and Sansegal's mark ATTITUDE for a "masculine or unisex clothing line that it sells through lower level retail outlets." Finally, Tivers argues that Sansegal is attempting to claim sole ownership of the term "attitude," and should not be allowed to do so.

[*4]

In its reply brief, Sansegal essentially argues that Tivers' assertions are irrelevant and immaterial to this case. Sansegal reiterates that because there is no genuine issue of material fact, its motion for summary judgment should be granted, and the counterclaim should be dismissed.

Summary judgment is an appropriate method of disposing of cases or claims when there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See *Fed. R. Civ. P. 56(c)*. Since Sansegal is the party moving for summary judgment, Sansegal bears the initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). To defeat the motion, Tivers need not present her entire case on the counterclaim, but must present sufficient evidence to show an evidentiary conflict as to one or more material facts at issue. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). [*5] The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences must be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 U.S.P.Q.2d 2027 (Fed. Cir. 1993); *Opryland USA, supra*.

After carefully reviewing the parties' arguments and supporting evidence, and drawing all inferences in favor of Tivers as the non-moving party, we find that disposition of the counterclaim by summary judgment is appropriate.

In general, a petition to cancel a mark that has been on the Principal Register for less than five years may be grounded on either of two bases: (1) that the mark is barred from registration under one of the statutory bars of Lanham Act § 2; and (2) that the mark comes within any of the specifically enumerated grounds under which a registration may be cancelled "at any time." See 15 U.S.C. §§ 1052, 1064.

⁴ Tivers lists only the marks, not the goods with which they purportedly are used or for which they are registered. Tivers has not provided the registration numbers of any that are registered, or copies of the certificates of registration. When a party to a Board proceeding seeks to introduce evidence of third party registrations, the party must use one of the methods outlined in Section 703.02(B) of the Board's manual of procedure, the TBMP.

Tivers' first and third asserted grounds for cancellation essentially state only one claim, i.e., that Sansegal's mark ATTITUDE is a common, generic word with no distinguishing properties when used for clothing. Although [*6] 15 U.S.C. § 1064 allows a registered mark to be cancelled if it becomes the generic name for the goods or services, Sansegal's mark ATTITUDE clearly is not generic for clothing and sportswear. In Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc., 228 U.S.P.Q. 528 (Fed. Cir. 1986), the court held that the critical inquiry in determining whether a term is generic is whether the relevant public primarily uses or understands the term to refer to the category of goods applicant sells under that term. Evidence of the public's understanding of a term may be evidenced by competent sources, such as purchaser testimony, surveys, dictionaries, trade journals, newspapers and other publications. In re Northland Aluminum Products, Inc., 227 U.S.P.Q. 961 (Fed. Cir. 1985).

Sansegal, in support of its request for entry of a judgment holding that its mark is not generic, relies on the presumption of validity that attaches to its ownership of a registration for its mark on the Principal Register; a dictionary definition that shows there are no definitions for the word "attitude" that describe or refer to clothing, a [*7] feature of clothing, or a characteristic of clothing; and an affidavit of a vice president of opposer who stated, "Based on my experience in the clothing industry and based on the usage of the marks ATTITUDE and ATTITUDE ANYWEAR, these marks do not describe an ingredient, quality, characteristic, function, feature, purpose or use of the goods clothing and sportswear, namely jackets, sweatsuits, shorts, swimwear, shirts, T-shirts, hats, and tanktops." ⁵

Tivers' affidavit, the content of which has already been discussed, does nothing to counter Sansegal's evidence that its challenged mark is not generic or to establish that there is an issue relative to this counterclaim that can be decided only after trial. We hold, as a matter of law, that Sansegal's mark is not generic and enter summary judgment in Sansegal's favor on this part of the counterclaim.

Tivers' second asserted ground for cancellation is based upon dilution. The Board has held that the Federal Trademark Dilution Act "includes no provision that enables [*8] the Board to consider dilution as a ground for an opposition or cancellation." Babson Brothers Co. v. Surge Power Corp., 39 U.S.P.Q.2d 1954, 1955 (TTAB 1996). It appears likely that Tivers' intended her "dilution" ground to be interpreted as an assertion of the weakness of the mark ATTITUDE for Class 25 goods. However, even weak marks are entitled to protection against subsequent registration of the same or similar marks for closely competitive goods. See A. H. Robins Co., Inc. v. Evsco Pharmaceutical Corp., 190 USPQ 340, 342 (T.T.A.B. 1976). We grant Sansegal's request for entry of judgment dismissing that part of the counterclaim which asserts dilution, because such a claim is not within our jurisdiction. We do not, however, by dismissing this claim, make any finding regarding the degree of distinctiveness of Sansegal's mark. We deny Sansegal's request for entry of a judgment holding its mark to be inherently distinctive.

Tivers' mere citation of purported third party registrations is not proof of third party uses for the purpose of showing a crowded field and relative weakness. 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition [*9] § 11.89 (1998). The Board has previously held that a trademark search report, in addition to being hearsay evidence, is incompetent to prove either registration or use of third party marks. National Football League v. Jasper Alliance Corp., 16 U.S.P.Q.2d 1212, n.3 (T.T.A.B. 1990). Nonetheless, Tivers has raised a genuine issue as to the degree of distinctiveness of Sansegal's mark and we leave this issue to be developed at trial, if the parties proceed to trial.

Consolidation of Opposition No. 108,947 and Opposition No. 113,776

On May 27, 1999, Tivers filed a motion in Opposition No. 113,776 to suspend that case, pending disposition of the motion for summary judgment in regard to Tivers' counterclaim. Tivers also requested prospective consolidation of the two oppositions, following disposition of the motion for summary judgment. Sansegal filed a brief in opposition to Tivers' motion to suspend and request for consolidation. The request for suspension is now considered moot, only the consolidation of the two opposition proceedings remains at issue.

⁵The counterclaim only involves opposer's registration for the mark ATTITUDE. Therefore, the Board considers this testimony only in regard to the mark ATTITUDE.

When cases involving common questions of law or fact are pending before the Board, the Board may order [*10] the consolidation of the cases. See F.R.C.P. 42(a). The parties and the marks involved in both opposition proceedings are the same. Sansegal asserts that the two oppositions involve "vastly dissimilar issues" in that the two proceedings concern different goods and channels of trade. Although the goods listed in Tivers' respective applications differ, she asserts they are marketed to the same class of consumers. If there are differences in the classes of consumers or channels of trade, the Board can sort out the evidence and make separate rulings as to the registrability of each of Tivers' marks. Administrative efficiency militates in favor of consolidation.

Conclusion

Sansegal's motion for summary judgment is granted and the counterclaim is dismissed. Tivers' motion to consolidate the oppositions is granted. Opposition No. 108,947 and Opposition No. 113,776 are consolidated and discovery and trial dates are reset as follows:

Discovery period to close:	February 4, 2000
Testimony period for party in position of plaintiff to close:	May 4, 2000
Testimony period for party In position of defendant to close:	July 3, 2000
Rebuttal testimony period to close:	August 17, 2000

[*11]

Briefs shall be filed in accordance with Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Rule 2.129.

P. T. Hairston

T. E. Holtzman

G. F. Rogers

Administrative Trademark Judges, Trademark Trial and Appeal Board

2004 WL 1997743 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

SMITHKLINE BEECHAM PLC AND SMITHKLINE BEECHAM CORPORATION

v.

TOPOTARGET APS CORPORATION

Opposition No. 91157491

September 2, 2004

*1 Before Simms, Hanak and Rogers
Administrative Trademark Judges

By the Board:

TopoTarget ApS Corporation seeks to register the mark TOPOTECT for “pharmaceutical preparations for the treatment of cancer and pharmaceutical preparations for neutralizing the negative effects of cancer treatment; veterinary preparations, namely, preparations for the treatment of cancer in animals and veterinary preparations for neutralizing the negative effects of cancer treatment of animals.”¹ Smithkline Beecham PLC and Smithkline Beecham Corporation have opposed registration on the grounds that the term “topotect,” is a slight misspelling or abbreviation of the term “topotecan,” which is the generic name for applicant's goods. Opposers further allege that applicant's involved mark is deceptively misdescriptive under Section 2(e)(1) or deceptive under Section 2(a) to the extent that applicant's products are not topotecan pharmaceutical preparations or differ in composition from generic topotecan pharmaceutical preparations.²

Applicant, in its answer, has admitted that “Opposers manufacture, distribute, and sell pharmaceuticals” and that “Opposers market a product they call Hycamtin (topotecan HCL) in the United States,” but otherwise has denied the essential allegations of the notice of opposition. Applicant has also alleged certain affirmative defenses.

This case now comes up for consideration of (1) applicant's motion for summary judgment on the grounds that there are no material factual issues in dispute that its TOPOTECT mark is not generic, is not deceptively misdescriptive and is not deceptive³; and (2) opposers' cross-motion for summary judgment on the grounds that there are no genuine issues of material fact that (i) applicant's TOPOTECT mark, as a slight misspelling, abbreviation or variation of the generic term “topotecan,” is the generic name for applicant's pharmaceutical preparation used in the treatment of cancer and (ii) applicant's TOPOTECT mark is deceptively misdescriptive under Section 2(e)(1) or deceptive under Section 2(a) to the extent that applicant's products are not “topotecan” pharmaceutical preparations or differ in composition from the generic “topotecan” pharmaceutical preparations.

As has often been stated, the purpose of summary judgment is one of judicial economy, namely, to save the time and expense of a useless trial where no genuine issue of material fact remains and more evidence than is already available in connection with the motion for summary judgment could not be reasonably expected to change the result. *See, e.g., Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 941 (Fed. Cir. 1984) and *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741, 743 (Fed. Cir. 1984). The burden in a motion for summary judgment is on the moving party to establish prima facie that there is no genuine issue of material fact and that it is entitled to a judgment as a matter of law. Fed. R. Civ. P. 56(c). That is, the moving party in each of the pending motions has the burden as to its motion. Additionally, the evidence must be viewed

in a light favorable to the non-movant in each party's pending motion, and all justifiable inferences are to be drawn in the non-movant's favor. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993).

*2 We further note that as a general rule, the resolution of Board proceedings by means of summary judgment is to be encouraged. *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1795 (Fed. Cir. 1987). This is particularly true when both sides seek resolution of their dispute by means of summary judgment. *Blue Cross & Blue Shield Association v. Harvard Community Health Plan, Inc.*, 17 USPQ2d 1075, 1076 (TTAB 1990) and *Phoenix Closures Inc. v. Yen Shaing Corp. Ltd.*, 9 USPQ2d 1891, 1892 (TTAB 1988). While it is also true that the mere fact that cross-motions for summary judgment have been presented does not necessarily mean that there are no genuine issues of material fact or authorize the resolution of such issues, where there is no dispute as to the material facts, summary judgment - if otherwise appropriate as a matter of law - is warranted and thus should be granted. See e.g., *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389-1390 (TTAB 1994) (citations omitted).

In support of its motion, applicant argues that there are no genuine issues of material fact in dispute regarding opposers' assertions that applicant's mark is generic, deceptively misdescriptive or deceptive. More specifically, applicant argues that there is no evidence that the term TOPOTECT has been used to refer to the genus of goods identified in the involved application. Applicant also argues that TOPOTECT is not the equivalent of the generic term "topotecan" because contrary to opposers' position, leading reference publications in the pharmaceutical industry do not categorize opposers' topotecan HCL product (sold under the HYCAMTIM mark) using the single word "topotecan" but, rather, use the phrase "topotecan hydrochloride" to identify opposers' product. Applicant further argues that even if the generic term for the HYCAMTIN product was the sole term "topotecan," opposers have not cited a single instance in which TOPOTECT has been used as the name of the entire genus of goods set forth in applicant's involved application.

Applicant also argues that it is aware of no instance in which TOPOTECT has been referred to as a generic term and points out that TOPOTECT is not found in leading medical dictionaries. Applicant further argues that leading resource materials in the health care and pharmaceutical industries, i.e., the relevant segment of the public for this proceeding, fail to establish any evidence that applicant's involved TOPOTECT mark is generic; and that TOPOTECT is not recognized as generic with a much broader audience inasmuch as a search of the top seven Internet search engines show that third parties use the term "topotect" to refer to applicant's products.

Applicant therefore maintains that the relevant public understands that TOPOTECT refers to applicant's products rather than the generic name "topotecan" or "topotecan hydrochloride" and, thus, opposers' claim that applicant's TOPOTECT mark is generic should be dismissed as a matter of law.

*3 Applicant also contends that its involved mark is not deceptively misdescriptive or deceptive as a matter of law. Specifically, applicant argues that its involved mark does not meet the test for deceptive misdescriptiveness set forth in *In re Quady Winery, Inc.*⁴, 221 USPQ 1213 (TTAB 1984). This is so, applicant argues, because: (1) its involved mark is not deceptively misdescriptive, but rather a coined mark that is a combination of the words "to protect"; (2) there is no evidence that would imply that pharmaceuticals involved in the treatment of cancer must, by their very nature, contain "topotecan hydrochloride"; and (3) the term "topotect" does not appear in common dictionaries or medical dictionaries, and therefore, does not have a common meaning from which deception can arise.

Applicant also argues that even if the TOPOTECT mark misdescribes its goods, consumers would be unlikely to believe the "purported" misrepresentation because applicant's product is technical in nature requiring a prescription from sophisticated medical professionals.

Accordingly, applicant maintains that its motion for summary judgment on the issues of whether its involved mark is deceptively misdescriptive or deceptive should be granted.⁵

As evidentiary support for its motion, applicant has submitted the affidavit of one of its attorneys, Kyle T. Peterson, introducing the following: relevant pages from five representative dictionaries⁶ indicating the absence of entries for the term “topotect”; results of Internet searches using the AOLSEARCH, MSNSEARCH, OVERTURE, LYCOS, ALTAVISTA, GOOGLE and YAHOO search engines wherein all disclosures from the search of TOPOTECT refer to applicant's products; relevant pages from the Physicians' Desk Reference showing the listing for opposers' product sold under the mark HYCAMTIN; and a copy of a web page from opposers' www.hycamtin.com web site.

In support of their cross-motion for summary judgment and in opposition to applicant's motion for summary judgment, opposers contend that there are no genuine issues of material fact that applicant's TOPOTECT mark, as a slight misspelling, abbreviation, or variation of the generic term “topotecan,” is the generic name for applicant's pharmaceutical preparation used in the treatment of cancer. More specifically, opposers contend that applicant erroneously argues that leading dictionaries do not contain the single word “topotecan” as a generic term for a pharmaceutical preparation, and argue that leading medical dictionaries, as well as other printed articles, define the sole term “topotecan” as the generic name for a pharmaceutical preparation used in the treatment of cancer. Opposers further argue that several on-line medical dictionaries also define “topotecan” as a “chemotherapy drug” or “anticancer drug that belongs to the family of drugs called topoisomerase inhibitors.” These dictionaries, opposers point out, identify the chemotherapy or anticancer drug as “topotecan” without joinder of “hydrochloride.”

*4 Relying on several medical and pharmaceutical journals and abstracts, opposers argue that there is no genuine issue of material fact that the relevant public is exposed to and therefore understands the term “topotecan” to identify a type or category of pharmaceutical preparations used in the treatment of various types of cancer.

Opposers also contend that applicant is wrong in its assertions that: (1) the term “topotect” is not generic for applicant's goods because it does not appear in dictionaries, articles, or on the Internet as the common name of a pharmaceutical preparation, but rather appears only in reference to applicant's goods; and (2) “topotect” is not the equivalent of “topotecan” because publications use the entire phrase “topotecan hydrochloride” rather than the single word “topotecan.” Opposers argue “there is no genuine issue of material fact that consumers will perceive the term ‘topotect’ as the generic word ‘topotecan,’ or an abbreviation or slight misspelling of that generic term. This is so, opposers argue because applicant's proposed TOPOTECT mark differs from the generic term “topotecan” by deleting only the last two letters of the generic name.⁷ Opposers therefore argue that it is reasonable to conclude that consumers viewing the proposed mark in the ordinary course will not detect such a slight misspelling.⁸

Opposers further argue that there is evidence that TOPOTECT is a common misspelling of the generic word “topotecan,” and that consumers would recognize it as such. As support for this assertion, opposers note that the spell-check feature in common software programs and Internet search engines recognize the term “topotect” as the generic term “topotecan” and will automatically inquire whether the user means the word “topotecan.”

Opposers also assert that the contemporaneous use of TOPOTECT as a trademark with the generic drug name “topotecan” presents a significant threat to public health and safety and that both the World Health Organization and USAN strongly discourage the use of USAN and INN generic terms as trademarks.

As regards the issues of whether applicant's mark is deceptively misdescriptive or deceptive, opposers argue that they “have already established” that topotecan is the generic name for pharmaceutical preparations used in the treatment of cancer and that consumers are likely to perceive applicant's TOPOTECT mark as a slight abbreviation or misspelling of the term. Because applicant has averred in its answer to the notice of opposition that it may seek to amend its identification of goods to “pharmaceutical preparations, namely anthracylin, for the treatment of tissue damage,” opposers further argue that to the extent that applicant's proposed amendment is an admission that the underlying pharmaceuticals are not used in the treatment of cancer and/or not comprised of topoisomerase I inhibitors, applicant's TOPOTECT mark misdescribes the goods. Opposers also argue that given the nature of the underlying products and the substantial similarity between TOPOTECT and the generic term “topotecan,” relevant consumers are likely to believe the misdescription, and it is likely to be critical to their purchasing and/or prescription decision.

*5 Opposers also contend that applicant has presented no evidence that its products would require a prescription from a medical professional such that there would be no opportunity for confusion among general consumers, and argues that the mere fact that physicians and pharmacists may be knowledgeable does not mean that they are immune from mistaking one mark for another or from confusing a mark for a generic term.

Last, opposers contend that there is no genuine issue of material fact that they have standing to bring this proceeding. More particularly, opposers argue that the record establishes, and applicant has admitted, that opposers market the “topotecan” pharmaceutical preparation in the United States for the treatment of cancer under the mark HYCAMTIN and that opposers are required to include the generic term “topotecan” on its labels for the HYCAMTIM pharmaceutical preparations.

As evidentiary support for their motion, opposers have submitted the declaration of the trademark director and counsel for GlaxoSmithKline, Pamela A. May, which, among other things, introduces: a copy of opposers' registration for the HYCAMTIM mark; a copy of the relevant Food and Drug Administration regulation requiring that the term “topotecan” appear on labels for the pharmaceutical preparation sold under opposers' HYCAMTIM mark; abstracts from the MEDLINE database referring to topotecan as a pharmaceutical preparation used in the treatment of cancer; articles from well known medical research publications discussing topotecan pharmaceutical preparation; and a copy of The United States Pharmacopeial Convention, Inc.'s, USP Quality Review (March 2001) reporting on mistakes and confusion over similar drug names.

Opposers have also submitted the declaration of one of its attorneys, Linda K. McLeod, introducing: dictionary definitions of the term “topotecan”; results of Internet searches using the Google search engine wherein several online dictionaries define “topotecan” as an anticancer drug; copies of printouts from various web sites containing articles, summaries, and/or information pertaining to topotecan pharmaceutical preparations and discussing the use of topotecan in the treatment of various forms of cancer; copies of abstracts from the Library of Medicine of the National Institute of Health located at www.ncbi.nlm.nih.gov discussing clinical trial and research of topotecan in connection with the treatment of cancer; copies of information on topotecan printed from databases of authorities responsible for assigning generic drug names; results of Internet and website search engines for the term “topotect” wherein upon reading the term topotect, the search engines automatically inquired whether the user means the word topotecan; and results from a search of applicant www.topotarget.com web site regarding applicant and applicant's pharmaceutical preparations.

In its brief in opposition to the cross-motion for summary judgment, applicant contends that opposers have presented no evidence that its TOPOTECT mark is a slight misspelling or abbreviation of the generic term “topotecan.” Applicant further contends that TOPOTECT does not constitute a slight misspelling of the generic “term fragment” topotecan because the two terms are visually different. More specifically, applicant argues that its TOPOTECT mark consists of eight letters, beginning with the prefix “TOPO” and ending with the suffix “TECT,”⁹ which is suggestive of a sense of security or protection, while the generic term “topotecan” has nine letters, beginning with “TOPO” prefix and ending with the suffix “TECAN.” Applicant further argues that the similarity in the prefixes is without consequence because “TOPO” is known within the pharmaceutical field as referring to a certain class of enzymes to which both topotecan hydrochloride and applicant's product relate.

*6 Additionally, applicant observes that opposers reference instances in which computer search engines and other computer applications automatically inquired whether the user meant to use the term “topotecan” when searching the term TOPOTECT. Applicant argues, however, that these searches are indicative of computer-based rules and are totally irrelevant to human “confusion” or to the issues in this motion. Applicant also notes that opposers' search of the LYCOS search engine for TOPOTECT resulted in 37 hits, with all 37 references relating to applicant's TOPOTECT product.

Finally, applicant reiterates that its TOPOTECT mark is not deceptively misdescriptive or deceptive of its goods and maintains that opposers' cross-motion for summary judgment should be denied.

As evidentiary support for its opposition brief, applicant submitted the declaration of one of its attorneys, Mark D. Schuman, stating that he sent an e-mail to Google inquiring what “algorithm” Google used to generate its spelling suggestion and that he received an e-mail reply stating that the algorithm is proprietary.

Applicant also submitted the declaration of Kyle T. Petersen, introducing: copies of the decision from the Danish Trademark Office and translation thereof; relevant pages from the *USP Dictionary of USAN and International Drug Names*, wherein all references use the full generic name “topotecan hydrochloride” to identify certain pharmaceutical preparations; a copy the web page located at www.google.com/help/features.html regarding spell checking software; a list of registered U.S. trademarks that contain the “TECT” prefix¹⁰; a copy of a printout from the U.S. Food and Drug Administration website regarding the patent for opposers' HYCAMTIN product and a copy of the patent; a copy of “The Guiding Principles for Coining United States Adopted Names for Drugs,” published in the *USP Dictionary of USAN and International Drug Names*; and a copy of a printout from the Office for Harmonization in the International Market showing that TOPOTECT was registered on September 9, 2002.

In reply, opposers contend that “Applicant has failed to raise genuine issues, regarding the following facts: (1) ‘topotecan’ is a generic term for a certain pharmaceutical used in cancer treatment; (2) relevant consumers will perceive TOPOTECT as ‘topotecan’ or an abbreviation or slight misspelling of ‘topotecan’; and (3) it will be a matter of great concern to relevant consumers whether Applicant's TOPOTECT pharmaceutical does or does not contain the same chemical composition as ‘topotecan’; and that applicant has provided only unsupported and conclusory allegations, and irrelevant argument and, thus, opposers are entitled to summary judgment on their claims.

We begin our discussion by noting that applicant only disputes opposers' standing with regard to opposers' likelihood of confusion “claim.” However, inasmuch as that “claim” was stricken from the notice of opposition and, accordingly, has not been considered on summary judgment, we find that applicant, for purposes of this motion for summary judgment, has conceded that opposers have standing to bring their other valid claims. See Trademark Rule 2.127(a). Indeed, applicant, in its answer, admitted that “Opposers manufacture, distribute, and sell pharmaceuticals” and that “Opposers market a product they call HYCAMTIN (topotecan HCL) in the United States.”

*7 As regards the parties' motions for summary judgment on the issue of genericness, a generic term identifies a type of goods or services and not the source of such goods or services. 3 Callman Unfair Competition, Trademarks & Monopolies, Section 18.03 (4th ed. 1983). A determination that a term is generic requires evidence showing the genus of the goods or services at issue and an understanding by the relevant public that the term refers primarily to that genus of goods or services. See *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including direct testimony of consumers, consumer surveys, newspapers, magazines, dictionaries, catalogs, and other publications. See *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1411 (Fed. Cir. 1987) and *In re Northern Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

After careful consideration of the evidentiary submissions presented by each party, we find that applicant has met its burden of establishing that no genuine issues of material fact exist and that its involved TOPOTECT mark is not generic for pharmaceutical and veterinary preparations for the treatment of cancer and pharmaceutical preparations for neutralizing the negative effects of cancer treatment. More specifically, under the first part of the *Ginn* two-part genericness test, we find that the genus of the goods at issue in this proceeding is “pharmaceutical preparations for the treatment of cancer and pharmaceutical preparations for neutralizing the negative effects of cancer treatment; veterinary preparations, namely, preparations for the treatment of cancer in animals and veterinary preparations for neutralizing the negative effects of cancer treatment of animals,” i.e., the goods recited in the involved application. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991).

Under the second part of the *Ginn* test, we find that TOPOTECT is not understood by the relevant public primarily to refer to pharmaceutical preparations used in the treatment of cancer or for neutralizing the negative effects of cancer. More particularly, on this record, the term TOPOTECT is not found in any leading dictionary. Indeed, there is no evidence of record that suggests

that the term “topotect” is the name of a pharmaceutical preparation used in the treatment of cancer. By contrast, there is evidence, i.e., results of searches of the term “topotect” on the AOLSEARCH, MSNSEARCH, OVERTURE, ALTAVISTA, GOOGLE, YAHOO, and LYCOS search engines wherein the results reference applicant's TOPOTECT product. (Peterson Affidavit at Exts. F, G, H, I, J, K, and L).

*8 Furthermore, while the evidence of record establishes that the single term “topotecan” is generic for pharmaceutical preparations used in the treatment of cancer, contrary to opposers' assertion, there is no evidence to establish that the term TOPOTECT is perceived by the public as a slight misspelling or abbreviation of topotecan. First, and contrary to opposers' contention, we do not find that the terms “topotecan” and “topotect” are visually similar. Although they share seven letters in common, the construction of the two terms is distinct - the former consisting of nine letters and four syllables with the last part of the term being “tecan,” the latter consisting of eight letters and three syllables with the last part of the term being “tect.” Nor are the two terms aurally similar - TOPOTECT, being the combination of the prefix “topo” from the word “topotecan” and the suffix of the word “protect,” is pronounced similar to the individual terms from which it is derived and topotecan is pronounced “toe-poe-TEE-kan.” (McLeod declaration at Exhibit D).¹¹ These visual and aural differences distinguish the two terms from one another. As such, we find that TOPOTECT is not a slight misspelling or abbreviation of topotecan. Consequently, the situation in this case is not in accord with the findings of the cases cited by opposers in support of their position that slight misspellings or abbreviations of generic terms do not render those terms registerable.

Additionally, we do not find that the automatic computer search engine inquiry into whether a user, when searching “topotect,” meant to search “topotecan” establishes that TOPOTECT is a slight misspelling of topotecan. Rather, we find the inquiry is the result of artificial search engine rules, which have no bearing on how the relevant public perceives either term.

In short, there is no evidence to establish that TOPOTECT is perceived by the relevant public as a generic term. Rather, the evidence establishes that there is no genuine issue of material fact and, as a matter of law, TOPOTECT is not generic for pharmaceutical and veterinary preparations used in the treatment of cancer.

In view thereof, applicant's motion for summary judgment on the grounds that its applied-for mark TOPOTECT is not generic for “pharmaceutical preparations for the treatment of cancer and pharmaceutical preparations for neutralizing the negative effects of cancer treatment; veterinary preparations, namely, preparations for the treatment of cancer in animals and veterinary preparations for neutralizing the negative effects of cancer treatment of animals” is granted; and opposers' motion for summary judgment on the issue of genericness is denied. *See, e.g., In re American Fertility Society*, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999); *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 4 USPQ2d 1141 (Fed. Cir. 1987); and *Taylor Brothers, Inc. v. The Pinkerton Tobacco Company*, 231 USPQ 412 (TTAB 1986).

*9 As regards the parties' motions for summary judgment on the issues of whether applicant's TOPOTECT mark is deceptively misdescriptive or deceptive, we find that there are genuine issues of material fact which preclude granting summary judgment to either party. At a minimum, there exist genuine issues of material fact regarding, at least, whether the term “Topotect” misdescribes the goods identified in the involved application; whether purchasers are likely to believe the misdescription; and whether the misdescription would materially affect their decision to purchase the goods. *See In re Budge Manufacturing Co. Inc.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988); *U.S. West v. BellSouth Corp.*, 18 USPQ2d 1307 (TTAB 1990); *Tanners' Council of America, Inc. v. Samsonite Corporation*, 204 USPQ 150 (TTAB 1979).

Accordingly, applicant's motion for summary judgment and opposers' cross-motion for summary judgment on the issues of whether applicant's involved mark is deceptively misdescriptive or deceptive are denied.

Proceedings herein are resumed as to those claims and trial dates are reset as indicated below. The parties are allowed until **thirty days** from the mailing date of this order to respond to any outstanding discovery requests.

Trial dates, including the close of discovery, are reset as indicated below.

THE PERIOD FOR DISCOVERY TO CLOSE: December 31, 2004

30-day testimony period for party in position of plaintiff to close: March 31, 2005

30-day testimony period for party in position of defendant to close: May 30, 2005

15-day rebuttal testimony period to close: July 14, 2005

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

***10** Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Footnotes

- 1 Application Serial No. 78064912, filed May 22, 2002, and based on Section 44(e) of the Lanham Act. The filing date of the foreign application is December 14, 2000 and the foreign registration date is September 9, 2002.
- 2 Opposers also allege that, due to the close similarity in appearance, pronunciation and meaning of applicant's TOPOTECT mark and the generic term "topotecan," which opposers are required to use on their labels, applicant's mark is likely to cause confusion, mistake, or to deceive. Opposers, however, contend that these allegations of "consumer confusion" do not form a separate ground for opposition under Section 2(d), but rather amplify opposer's claim of damage. We agree that these allegations do not comprise a valid claim of likelihood of confusion. In order to properly state a claim of likelihood of confusion, a plaintiff must plead that (1) the defendant's mark, as applied to its goods or services, so resembles the plaintiff's mark or trade name as to be likely to cause confusion, mistake, or deception; and (2) priority of use. *See* Fed. R. Civ. P. 8; *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Simply put, a plaintiff must establish rights in a mark, not a generic term. Inasmuch as opposers did not and, on this record, cannot allege that they have established trademark rights in any conflicting mark, they have failed to state a proper claim of likelihood of confusion. Moreover, because opposers' allegations of "likelihood of confusion" confuse rather than amplify opposers' valid claims for opposition, opposers' allegations of "likelihood of confusion," i.e., paragraphs 20, 21 and 22 of the notice of opposition, are hereby stricken.
The paragraphs read as follows:
20. Opposers repeat and reallege the allegations contained in Paragraphs 1-19 above.
21. Opposers have used the generic term "topotecan" on the labels for the Hycamtin pharmaceutical preparations prior to the filing date of Application Serial No. 78/064,912.
22. Due to the close similarity in appearance, pronunciation and meaning of Applicant's mark TOPOTECT and the generic term "topotecan" which opposers use on labels for its Hycamtin pharmaceutical preparations, Applicant's mark is likely to cause confusion, mistake, or to deceive.
- 3 Applicant also has moved for summary judgment on the grounds that there is no likelihood of confusion between applicant's involved mark and the generic term "topotecan." Inasmuch as we have stricken the likelihood of confusion

“claim” from the notice of opposition, we will give no consideration to any arguments regarding this issue. *See* Fed. R. Civ. P. 56(a) and 56(b); and *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994).

4 Under the test set forth in *Quady*, it must first be determined that the matter sought to be registered misdescribes the goods and, if so, then it must be ascertained if anyone is likely to believe the misrepresentation. *In re Quady*, 221 USPQ at 1214.

5 Applicant also argues that the Danish Patent Office has distinguished applicant's TOPOTECT mark from the generic term “topotecan” based upon visual and aural dissimilarities. However, as opposers point out, and applicant acknowledges, foreign rulings are not controlling with regard to the issue of registrability before the U.S. Patent and Trademark Office. *See e.g., Miles Laboratories, Inc. v. International Diagnostic Technology, Inc.*, 220 USPQ 438 (TTAB 1983), *aff'd* 746 F.2d 798, 223 USPQ 977 (Fed. Cir. 1984). Accordingly, little, if any, weight will be given to the Danish decision.

6 The dictionaries are as follows: *Merriam-Webster's Collegiate Dictionary* (10th Edition); *Random House Webster's College Dictionary*; *Remington's Pharmaceutical Sciences* (14th Edition 1970); *USP Dictionary of USAN and International Drug Names* (2001 Edition); and *Dorland's Illustrated Medical Dictionary* (27th Edition).

7 Opposer's argument that applicant's mark differs from the generic term only because two letters have been deleted from the latter fails to acknowledge applicant's substitution of a different letter in place of the deleted letters.

8 Notably, in this regard, opposers have relied on a line of court and Board cases that have held that the misspelling or variation in a few letters is far too little to turn a generic term into a protectable trademark. *See e.g., Leon Finker, Inc. v. Schlusel*, 469 F.Supp 674, 202 USPQ 452 (SDNY 1979), *aff'd*, 614 F.2d 1288, 204 USPQ 422 (2d Cir. 1979) (TRILLIANT held misspelled equivalent to generic name TRILLION for brilliant cut, triangular diamonds); *American Druggists' Sydicate v. United States Industrial Alcohol Co.*, 55 App. D.C. 140, 2 F.2d 942 (D.C. Cir. 1924) (AL-KOL misspelled equivalent of ALCOHOL); and *In re Organik Technologies Inc.*, 41 USPQ2d 1690 (TTAB 1997) (ORGANIK phonetic equivalent to misdescriptive term “organic”).

9 Applicant further argues that more than 100 trademarks containing the “TECT” suffix are currently registered in the Office, many of which are suggestive of some sort of protection.

10 We presume that applicant means, “suffix.”

11 Specifically, the phonetic spelling is found in the search results form the cite <http://health.yahoo.com/health/drug/203049/>.

2004 WL 1997743 (Trademark Tr. & App. Bd.)

2020 WL 2039758 (Trademark Tr. & App. Bd.)

THIS ORDER IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

SNAP INC.¹

v.

NFOSNAP, INC.

Opposition No. 91238805

April 23, 2020

*1 Before Zervas, Kuczma and Johnson
Administrative Trademark Judges

By the Board:

On January 8, 2018, Snap Inc. (“Snap”) filed a notice of opposition against NfoSnap, Inc.'s (“NfoSnap”) Application Serial No. 87330965 for the mark NFOSNAP in standard characters for “computer software to allow controlled access for one or multiple users to scan an optical code with a portable computer or imaging device to access custom and interactive content” in International Class 9, pleading dilution and likelihood of confusion² with, *inter alia*, its standard character mark SNAPCHAT for “computer application software for mobile phones, portable media players, and handheld computers, namely, software for sending digital photos, videos, images, and text to others via the global computer network” in International Class 9.³ NfoSnap denied the salient allegations of the notice of opposition in its answer, and counterclaimed to cancel the '712 registration alleging genericness.⁴ Snap denied the salient allegations of the counterclaim in its answer.⁵ Discovery closed on March 11, 2019,⁶ and, as last reset, Snap's pretrial disclosures were due on July 24, 2019.⁷

This matter now comes up on Snap's motion (filed July 23, 2019)⁸ and on NfoSnap's cross-motion (filed September 5, 2019)⁹ for summary judgment on NfoSnap's counterclaim. The motions have been fully briefed.

Legal Standard and Burdens on Summary Judgment

A motion for summary judgment is a pretrial device intended to save the time and expense of a full trial when the moving party is able to demonstrate, prior to trial, that there is no genuine dispute of material fact, and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The evidence on summary judgment is viewed in a light most favorable to the nonmoving party, and all reasonable inferences are drawn in the nonmovant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA, supra*. A factual dispute will be deemed genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the nonmoving party. *See Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The Board does not resolve disputes of material fact on summary judgment; rather, the Board only ascertains whether disputes of material fact exist. *See Univ. Book Store v. Univ. of Wisconsin Bd. of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994); *see also Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249 (1986) (“at the summary judgment stage the judge's function is not himself to weigh the evidence and determine the truth of the matter but to determine whether there is a genuine issue for trial.”).

*2 Where the party moving for summary judgment on a claim bears the burden of proof at trial on that claim, the moving party “must lay out the elements of its claim, citing the facts it believes satisfies those elements, and demonstrating why the record is so one-sided as to rule out the prospect of the nonmovant prevailing.” 10A C. WRIGHT, A. MILLER & M. KANE, FEDERAL PRACTICE AND PROCEDURE Civil § 2727.1 (4th ed. 2019); *see also Celotex*, 477 U.S. at 331 (Brennan, J., dissenting) (“If the moving party will bear the burden of persuasion at trial, that party must support its motion with credible evidence--using any of the materials specified in [Fed. R. Civ. P.] 56(c)-- that would entitle it to a directed verdict if not controverted at trial.”).

Where the party moving for summary judgment does not bear the burden of proof at trial, the party may discharge its initial burden of production by either submitting affirmative evidence that negates an essential element of the nonmoving party's claim or by demonstrating that the nonmoving party's evidence is insufficient to establish an essential element of the claim. *See id.* at 321-26.

If the movant successfully discharges its initial burden of production, the burden shifts to the nonmovant to demonstrate the existence of a genuine dispute for trial. *Id.* at 324. This requires more than a mere showing “of a scintilla of evidence in support of the [nonmovant's] position ...; there must be evidence on which the jury could reasonably find for the [nonmovant]” and what may be considered reasonable for a jury “necessarily implicates the substantive evidentiary standard of proof that would apply at the trial on the merits.” *Anderson*, 477 U.S. at 252. Since the standard of proof in Board inter partes proceedings on a claim of genericness is a preponderance of the evidence, *see Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015), the Board must, on summary judgment, “view the evidence presented through the prism of [this] substantive evidentiary burden” in determining if a genuine dispute exists. *Anderson*, 477 U.S. at 254. If the nonmovant's showing is insufficient to demonstrate that a genuine dispute exists on an essential element of the subject claim, the moving party is entitled to judgment as a matter of law. *See Celotex*, 477 U.S. at 322.

Legal Standard for Genericness

*3 To prevail on a claim that a designation is generic, the claimant must identify the genus of goods or services at issue and demonstrate that the relevant public understands the designation primarily to refer to that genus of goods or services. *See H. Marvin Ginn Corp. v. Int'l Assn. of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986) (“The critical issue ... is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.”). The inquiry “into the public's understanding of a mark requires consideration of the mark as a whole. Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark.” *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005).

The Parties' Arguments on Snap's Motion

Turning first to Snap's motion, Snap argues that its registration is entitled to the presumption of validity under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), which “includes the presumption that the mark subject thereof is not merely descriptive of or generic in relation to the goods.” *Editorial Am., S.A. v. Gruner + Jahr Ag & Co.*, 213 USPQ 498, 504 (TTAB 1982). Since “[a] party moving for summary judgment is entitled to the benefit of any relevant presumptions that support the motion,” this presumption alone is sufficient to shift the burden of production to NfoSnap. *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250, 216 USPQ 579, 582 (9th Cir. 1982) (“By virtue of the presumption that the trademark ‘Coke’ is not generic, Coca-Cola has met its burden of demonstrating that the genericness of the trademark ‘Coke’ does not raise a genuine issue of material fact.”).

Nevertheless, Snap also argues that the evidence thus far adduced by NfoSnap is insufficient to establish an essential element of NfoSnap's claim of genericness, i.e., that the relevant public understands SNAPCHAT, as a whole, primarily to refer to the genus of goods at issue.

Snap first defines the relevant genus as the goods identified in the subject registration, i.e., “computer application software for mobile phones, portable media players, and handheld computers, namely, software for sending digital photos, videos, images, and text to others via the global computer network,” and we agree that the genus is as stated by Snap.¹⁰ See *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (“a proper genericness inquiry focuses on the description of [goods or] services set forth in the certificate of registration”).

*4 Snap then points out that the evidence NfoSnap has produced only addresses the genericness of the component terms “snap” and “chat” rather than the mark SNAPCHAT as a whole and that NfoSnap has otherwise failed to produce any evidence showing that the relevant public understands SNAPCHAT to primarily refer to the genus of goods at issue.¹¹

NfoSnap does not dispute that its evidence pertains to demonstrating that the individual terms “snap” and “chat” are generic when used in reference to Snap's goods, but contends that “the same evidence shows that [SNAPCHAT] is generic” because the joining of the component generic terms results in a compound term that “does not create a different commercial impression from the parts [and] is nothing more than the sum of its parts and is not capable of identifying and distinguishing a single source and therefore the sum of the parts remains generic.”¹²

Discussion

The relevant public's use or understanding of SNAPCHAT is critical to a determination of the mark's genericness and requires consideration of the mark as a whole. See *In re Steelbuilding.com*, 75 USPQ2d at 1421. Accordingly, in order to survive Snap's motion for summary judgment, NfoSnap may not simply rest on a showing that the constituent terms are generic or argument that such evidence is sufficient to raise a genuine dispute of material fact. See *Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986) (party opposing summary judgment “must do more than simply show that there is some metaphysical doubt as to the material facts.”). Rather, NfoSnap must adduce evidence sufficient to raise a genuine dispute that the relevant public understands SNAPCHAT as a generic designation for “computer application software for mobile phones, portable media players, and handheld computers, namely, software for sending digital photos, videos, images, and text to others via the global computer network.”

In its briefing, NfoSnap appears to equate the relevant members of the public to the general public at large.¹³ This is overbroad and inaccurate. The relevant public in a genericness inquiry are the “actual or potential purchasers of the goods or services.” *Magic Wand*, 19 USPQ2d at 1553. Thus, based on the identification of goods in Snap's registration, which is unrestricted as to trade channels and end users, we presume, for purposes of summary judgment, that the relevant consumers of Snap's goods are individuals who use mobile devices to send media and text messages to others via a global computer network. See *In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1957 (TTAB 2018).

*5 Most of the evidence NfoSnap has put forward seeks to establish the public's “common understanding” of each constituent term as a generic designation. This evidence, however, is insufficient to raise a genuine dispute as to whether the relevant public views SNAPCHAT as a generic designation for the genus of goods herein because, as we have noted *supra*, even if genericness is proved as to the constituent terms, the compound term will not be found generic “unless the entire formulation does not add any meaning to the otherwise generic mark.” *In re Steelbuilding.com*, 75 USPQ2d at 1421. To that end, NfoSnap submitted dictionary definitions of and references in online publications to SNAPCHAT as a whole. A representative sampling of that evidence is reproduced below:

Online publications:

How to Use Snapchat: Share Vanishing Photos with Snap Chat

(from <https://www.lifewire.com>):¹⁴

Snapchat is a mobile messaging app for sharing pictures that disappear.

Snapchat: How the vanishing-photo app managed not to fade

(from <https://phys.org>):¹⁵

Snapchat has managed to build something lasting out of photos that vanished almost instantly.

The fast-growing social network for millennials has come a long way since its founder Evan Spiegel dropped out of Stanford University in 2012, three classes shy of graduation.

Snap: From disappearing photos to blockbuster IPO

(from <https://www.usatoday.com>):¹⁶

Originally an app to share moments privately, Snapchat grew out of a Stanford University dorm room experiment that caught on big time with young mobile users.

Instagram Direct takes a page from Snapchat with disappearing photos and videos

(from <https://www.androidpolice.com>):¹⁷

... Instagram is adding some features you're probably familiar with from Snapchat--you can send images and videos that self-destruct after being viewed.

How Reggie Brown invented Snapchat

(from <https://techcrunch.com>):¹⁸

They quickly realized it would be much easier and more private for users, and thus more widely used, if they build a mobile app instead of a website; to this day, Snapchat still does not offer a web product.

...

With the benefit of hindsight, we can see that Facebook developed the conditions that allowed Snapchat to flourish.

The rise of Snapchat from a sexting app by Stanford frat bros to a \$3 billion IPO

(from <https://www.businessinsider.com>):¹⁹

Snapchat's beginning sounds a lot like Facebook's from "The Social Network."

...

At stake was the founding story of a social network to make photos disappear. Snapchat's founders ended up paying \$157.5 million.

*6 ...

Snapchat wasn't Spiegel's first startup.

...

In Summer 2011, Snapchat was born--except it wasn't called Snapchat at first.

...

The now-duo changed the app's name to Snapchat in September 2011, its official birthday.

*MUO article "What Is Snapchat and Is It Right for You?":*²⁰

The popularity of Snapchat has skyrocketed since launch. And Snapchat is especially popular with younger generations.

...

So, what is Snapchat? How does Snapchat work? Is Snapchat right for you?

...

Snapchat is a multimedia app that can be used on smartphones running Android or iOS. It allows you to send pictures or videos, named "Snaps," to friends. These Snaps vanish after they've been viewed.

The platform also offers a Chat function, similar to instant messaging services like WhatsApp. The main difference, however, is that, as with Snaps, Chats disappear once they've been viewed.

Online dictionary definitions

*Cambridge Advanced Learner's Dictionary & Thesaurus:*²¹

Snapchat: the name of a social media service for sending pictures, messages, and videos that are only available to be seen for a limited amount of time.

*SearchMobileComputing:*²²

Snapchat is a mobile app that allows users to send and receive "self-destructing" photos and videos.

*Techterms:*²³

Snapchat is a mobile app and service for sharing photos, videos, and messages with other people. Once you view a message received via Snapchat, it is automatically deleted.

NfoSnap relies on this evidence to argue that "the combination of the generic term 'Snap' with the generic term 'Chat' ... is nothing more than the sum of its parts and is not capable of identifying and distinguishing a single source and therefore the sum of the parts remains generic."²⁴ The problem with this argument is that this very same evidence of use of the compound term

SNAPCHAT, including definitions thereof, uniformly refer to Snap and demonstrate that SNAPCHAT as a whole does indeed have a meaning beyond the generic meanings of the constituent terms.

Since the critical inquiry in determining genericness is the relevant public's understanding of the entirety of the designation against which the claim of genericness is raised, NfoSnap's evidence concerning the genericness of "snap" and "chat" as separate terms is insufficient to raise a genuine dispute as to the genericness of the combination SNAPCHAT in the face of NfoSnap's own evidence to the contrary. *See Princeton Vanguard*, 114 USPQ2d at 1832-33 ("even in circumstances where the Board finds it useful to consider the public's understanding of the individual words in a compound term as a first step in its analysis, the Board must then consider available record evidence of the public's understanding of whether joining those individual words into one lends additional meaning to the mark as a whole.").

*7 Since NfoSnap has "fail[ed] to make a showing sufficient to establish the existence of an element essential to [its] case" for which it bears the burden of proof at trial, *see Celotex Corp.*, 477 U.S. at 322, Snap is entitled to judgment as a matter of law on NfoSnap's counterclaim.

Decision

Snap's motion for summary judgment on NfoSnap's counterclaim of genericness is **GRANTED** and the counterclaim is **DISMISSED with prejudice**.²⁵

Proceedings are **RESUMED** on the following schedule:

Plaintiff's Pretrial Disclosures Due	5/22/2020
Plaintiff's 30-day Trial Period Ends	7/6/2020
Defendant's Pretrial Disclosures Due	7/21/2020
Defendant's 30-day Trial Period Ends	9/4/2020
Plaintiff's Rebuttal Disclosures Due	9/19/2020
Plaintiff's 15-day Rebuttal Period Ends	10/19/2020
Plaintiff's Opening Brief Due	12/18/2020
Defendant's Brief Due	1/17/2021
Plaintiff's Reply Brief Due	2/1/2021
Request for Oral Hearing (optional) Due	2/11/2021

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, matters in evidence, the manner and timing of taking testimony, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence.

Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

Footnotes

- 1 Snap Inc.'s change of correspondence address (filed September 13, 2019) has been noted and entered into the proceeding
file.
- 2 1 TTABVUE.
- 3 Registration No. 4375712 (“the ‘712 registration”) registered on the Principal Register on July 30, 2013, under Section
1(a) of the Trademark Act, 15 U.S.C. § 1051(a). Declaration under Section 8 of the Trademark Act, 15 U.S.C. § 1058,
accepted on July 15, 2019.
- 4 5 TTABVUE.
- 5 7 TTABVUE.
- 6 14 TTABVUE 6.
- 7 18 TTABVUE 1; 19 TTABVUE.
- 8 20 TTABVUE (public copy) and 21 TTABVUE (confidential copy).
- 9 31 TTABVUE. Since the Board presumes that later filings are intended to supersede earlier versions of the same filing,
NfoSnap’s filings at 27 TTABVUE, 29 TTABVUE and 30 TTABVUE, have been given no consideration.
- 10 NfoSnap defines the genus at issue not in terms of SNAPCHAT as a whole but rather in terms of the individual
components “snap” and “chat.” Specifically, NfoSnap identifies two separate genera based on wording from the
identification of goods in the ‘712 registration, i.e., “photo” and “sending ... videos, images, and text to others via the
global computer network,” and contends that “snap” is commonly understood as “photo” and that “chat” is commonly
understood as “sending ... videos, images, and text to others via the global computer network” to conclude that “[t]he
whole term is generic and is understood by the relevant members of the public as referring to digital photos and informal
conversations via short text exchanges in a specific application as instant messaging, or by using images, voice, video,
or some combination of these.” 31 TTABVUE 11 and 20. *Marvin Ginn* requires us to define only one genus.
- 11 20 TTABVUE 11-16.
- 12 31 TTABVUE 9 and 19.
- 13 See 31 TTABVUE 6 (“Opposer’s mark ‘SNAPCHAT’ is the combination of the generic terms ‘snap’ and ‘chat’ which
are common terms recognized by the relevant public. These two terms are used excessively in the general public as
generic terms. The proliferation and use of smart phones and mobile apps have greatly accelerated the use of digital
photos and instant messaging, a type of online chat; thereby further causing the terms ‘snap’ and ‘chat’ to become a
[sic] common and generic terms to the general public.”).
- 14 31 TTABVUE 344.
- 15 *Id.* at 345.
- 16 *Id.* at 346.
- 17 *Id.* at 347.
- 18 *Id.* at 350 and 353.
- 19 *Id.* at 357-360.
- 20 *Id.* at 419-420.
- 21 *Id.* at 369 and 411.
- 22 *Id.* at 369.
- 23 *Id.*
- 24 *Id.* at 9.
- 25 In view of the decision herein, NfoSnap’s cross-motion on its counterclaim is moot. The parties are reminded that
evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration
of that motion. Any such evidence to be considered at final hearing must be properly introduced during the appropriate
trial period. *See, e.g., Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

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2008 WL 4675414 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

Subs Unlimited, Inc.

v.

Wild Wings n' Things, LLC

Cancellation No. 92045919

September 30, 2008

*1 Subs Unlimited, Inc., pro se
Scott T. Kannady of Brown & Kannady, LLC for Wild Wings n' Things, LLC

Before Quinn, Holtzman and Rogers
Administrative Trademark Judges
Opinion by Holtzman
Administrative Trademark Judge:

Petitioner, Subs Unlimited, Inc., filed a petition to cancel a registration on the Principal Register owned by Wild Wings n' Things, LLC (respondent) for the mark WILD WINGS'N THINGS (in standard character form) for “fast food restaurants” in Class 43.¹

As its ground for cancellation, petitioner asserts priority and likelihood of confusion under Section 2(d) of the Trademark Act. Petitioner alleges that respondent's mark when applied to respondent's services so resembles petitioner's previously used and registered marks, which consist of or include BUFFALO WINGS- N-THINGS, in connection with restaurant services and food products as to be likely to cause confusion. Petitioner has claimed ownership of the following registrations on the Principal Register:

Registration No. 2935759 for the mark BUFFALO WINGS-N-THINGS for “restaurants, restaurants featuring home delivery” in Class 43, registered under Section 2(f) of the Trademark Act; and

Registration No. 1882663 for the mark shown below for “restaurant services featuring home delivery” in Class 42.



Respondent filed an amended answer denying the salient allegations in the petition.² In addition, respondent filed counterclaims to cancel Registration No. 2935759 for the mark BUFFALO WINGS-N-THINGS for “restaurants, restaurants featuring home delivery.”³ Respondent alleges that the BUFFALO WINGS portion of the mark is generic for chicken wings sold in restaurants, and that “the overall mark is merely descriptive of a generic term that identifies a spicy chicken wing product and other presumably chicken parts that are served as food products in the restaurants identified by the mark.” We construe these allegations as a claim that the mark as a whole is merely descriptive of the services.⁴ Respondent further alleges that the mark does not function as a service mark.

Petitioner filed an answer to the counterclaims denying the allegations therein.

Evidentiary Matters

By operation of Trademark Rule 2.122, the record includes the pleadings; the file of respondent's involved registration; and the file of petitioner's registration which is the subject of the counterclaims.

Neither party introduced any testimony or other evidence during their respective testimony periods. However, both parties filed briefs, and both parties included evidence with their briefs. Petitioner attached printouts of the involved registrations, which was unnecessary as these registrations automatically form part of the record. Petitioner also attached a plain copy of its unchallenged Registration No. 1882663 along with printouts of Office records indicating that the registration is renewed; and copies of documents which were apparently exchanged by the parties during discovery. Respondent, for its part, attached petitioner's answers to respondent's interrogatories; and also refers, in its brief, to an entry for “Buffalo wings” purportedly from the website wikipedia.org without providing a copy of the entry.

*2 It is inappropriate to submit evidence in this manner. As stated in TBMP §704.05(b) (2d ed. rev. 2004), “Exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony.” See also Trademark Rule 2.123(1). With the exception of the parties' involved registrations, none of this evidence is properly of record. However, since neither party has objected to the materials submitted by the other and, moreover, each party, in turn, introduced their evidence in the same improper manner, we will treat all the evidence as if stipulated into the record.

We turn next to petitioner's uncontested motion to strike respondent's counterclaim reply brief as untimely.⁵ Respondent's reply brief, which was due on June 28, 2008, was not filed until July 1, 2008. While the Board has the discretion to consider late-filed briefs, in this case, we decline to do so. Respondent's reply brief, which consists entirely of arguments directed to the issue of likelihood of confusion, serves as a reply brief on petitioner's claim, rather than on respondent's counterclaims. There is no provision in the rules for filing a reply brief by a party in the position of defendant. The motion to strike is accordingly granted.

Counterclaims to Cancel Registration No. 2935759

Respondent's conclusory and unsupported statement in its brief that petitioner's mark BUFFALO WINGS-N- THINGS fails to function as a service mark is clearly insufficient to carry respondent's burden of proof on that claim. Moreover, it is clear from petitioner's evidence, a photograph of a menu prominently displaying BUFFALO WINGS-N-THINGS as the name of the restaurant, that the term does, in fact, function as a service mark.

We turn to the counterclaim on the ground that petitioner's mark is merely descriptive of restaurant services. The mark in this case is registered with a claim of acquired distinctiveness under Section 2(f).⁶ But, regardless of whether or not a mark is registered under Section 2(f), the plaintiff (in this instance the counterclaim plaintiff) still has the same initial burden of establishing a prima facie case of descriptiveness, and the fact of registration pursuant to Section 2(f) is only some evidence of descriptiveness. See *Omnicom Inc. v. Open Systems Inc.*, 19 USPQ2d 1876, 1878 (TTAB 1989) citing *Yamaha International*

Corp. v. Hoshina Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). If that burden is met, and the mark is established prima facie to be merely descriptive, the plaintiff must then establish that the defendant's 2(f) evidence, in this case the evidence submitted with petitioner's underlying application, is insufficient to show that the mark has acquired distinctiveness. See *Yamaha International Corp.*, supra.

*3 We first address descriptiveness. A term is merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act if it forthwith conveys an immediate idea of a quality, characteristic, function, feature, purpose or use of the services with which it is used. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Moreover, the immediate idea must be conveyed forthwith with a “degree of particularity.” See *Goodyear Tire & Rubber Co. v. Continental General Tire Inc.*, 70 USPQ2d 1067, 1069 (TTAB 2003); and *In re Entenmann's Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. 1991).

The Wikipedia entry relied on by respondent suggests that the term BUFFALO WINGS is highly descriptive, if not generic, for a food product served in a restaurant. However, respondent has not shown that the N-THINGS portion of the mark is descriptive, or that the mark is descriptive as a whole. The term N-THINGS, in the context of restaurant services, broadly suggests a number of food or drink items offered in a restaurant, but yet it describes no one product or other attribute of the restaurant service with any degree of particularity.⁷ Furthermore, respondent's contention that the term “THINGS” is “extensively” used by others in the field, is unsupported. In fact, the record is devoid of any evidence of third-party use.

We find that respondent has not met its burden of proving that the mark is merely descriptive. As respondent has not established that the mark is merely descriptive, we need not reach the question of whether petitioner's evidence is sufficient to show that the mark has acquired distinctiveness.

Respondent's counterclaims for cancellation are denied.

Petition to cancel

As noted, the ground for the petition to cancel is priority and likelihood of confusion. In our analysis we will focus on the registration of petitioner that is closest to the respondent's registration, namely, Registration No. 2935759 for the mark BUFFALO WINGS-N-THINGS for “restaurants, restaurants featuring home delivery.”

Petitioner's pleaded registration for this mark is automatically of record as a result of the counterclaims, but the counterclaims have now been denied. Thus, petitioner, as the owner of a valid and subsisting registration of record, has standing to bring the petition. Moreover, the registration is entitled to all the presumptions flowing from Section 7(b) of the Trademark Act, including the presumption that the mark is distinctive.

PRIORITY

In a cancellation proceeding, where both parties own registrations, a petitioner asserting a claim under Section 2(d) must prove priority of use. See *Brewski Beer Co. v. Brewski Brothers, Inc.*, 47 USPQ2d 1281 (TTAB 1998) and cases cited therein. Petitioner may rely on its registration as proof that the mark was in use as of the filing date of the underlying application. See *J. C. Hall Company v. Hallmark Cards, Incorporated*, 340 F.2d 960, 144 USPQ 435, 437 (CCPA 1965) (“The presumption of use emanating from the fact of registration relates back to the filing date of the application on which the registration is predicated.”).

*4 The filing date of petitioner's underlying application is August 21, 2003. This date is prior to the December 22, 2004 filing date of respondent's underlying application, which in view of the absence of evidence of any earlier use, is the earliest date of use on which respondent may rely. Thus, petitioner is entitled to its priority.

LIKELIHOOD OF CONFUSION

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In *re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Services/Trade channels/Conditions of sale

We must consider the services as they are described in the registrations, rather than in light of what the services may actually be. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). If the services are described broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registrations encompass all services of the type described, that they move in all channels of trade normal for these services, and that they are available to all classes of purchasers for the described services. See *Hewlett-Packard Co.*, *supra*; and *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

Based on the description of services in each of the registrations, the parties' services are legally identical. Petitioner's services, identified in part as "restaurants" are broad enough to include different types of restaurants including respondent's fast food restaurants.

Because the services are identical, and there are no limitations in the registrations, the channels of trade and classes of purchasers for the parties' restaurant services also are presumed to be identical. See *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000); and *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

Respondent's arguments concerning purchaser sophistication are unsupported and unpersuasive. The potential customers of restaurants include ordinary members of the general public who are not necessarily sophisticated and who may not necessarily exercise more than ordinary care in selecting a restaurant.

*5 Furthermore, it is not relevant, as respondent claims, that the parties' restaurants may be located in different geographic regions. Neither registration is geographically restricted, and the registrations therefore must be presumed to be nationwide in scope, and we therefore must presume that the parties could be providing restaurant services in the same areas.

The marks

We turn next to a comparison of respondent's mark WILD WINGS'N THINGS and petitioner's mark BUFFALO WINGS-N-THINGS, keeping in mind that when marks would appear on identical services, the degree of similarity between the marks necessary to support a finding of likelihood of confusion declines. *Century 21 Real Estate v. Century Life*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

We must also consider that the test under this *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Respondent argues that while the dominant part of petitioner's mark is the generic term BUFFALO WINGS, the dominant part of respondent's mark is the term WILD WINGS, "which is not descriptive of the food product, but is arbitrary and fanciful."

Respondent further argues that the shared elements of the marks, “WINGS N THINGS,” are weak in that they are highly suggestive “of the food products that are featured in [the parties'] restaurants” and are “extensively used by others.”

We find that the marks WILD WINGS'N THINGS and BUFFALO WINGS-N-THINGS, when compared in their entireties, are similar in sound, appearance, meaning and commercial impression.

The shared phrase “WINGS'N THINGS” or “WINGS-N-THINGS” is aurally and visually a significant component of each mark. The two phrases are identical in sound, with the same rhyming cadence, and they are virtually identical in appearance. The slight difference in appearance due to the hyphens in petitioner's mark and the apostrophe in respondent's mark, are insignificant details that are not likely to be noticed or remembered by consumers when seeing these marks at separate times on identical services. See, e.g., *In re General Electric Co.*, 180 USPQ 542, 544 (TTAB 1973) (BRAND REX confusingly similar to RE-X “Notwithstanding the hyphen in applicant's mark”).

The phrase “WINGS N THINGS” is also significant in conveying the meaning and commercial impression of the marks. The words WILD and BUFFALO are obviously different, but they have related meanings in that they both modify the phrase “WINGS N THINGS” and they either suggest or describe a type or style of chicken wings. Thus, the marks as a whole WILD WINGS'N THINGS and BUFFALO WINGS-N-THINGS connote the same, or variations of the same, goods, and they convey a substantially similar image and overall commercial impression.

*6 While respondent did not prove that BUFFALO WINGS-N_THINGS is descriptive, we recognize that the mark is at least highly suggestive of the services. However, that suggestive meaning is the same in both marks. Furthermore, there is no evidence that the term is commonly used or registered for its suggestive meaning in the field. In any event, we certainly cannot find, based on this record, that the scope of protection accorded petitioner's mark should not extend to respondent's highly similar mark for identical services. Purchasers who are familiar with petitioner's BUFFALO WINGS-N-THINGS restaurant would be likely to believe, upon encountering respondent's highly similar mark WILD WINGS' N THINGS also for restaurants, that such services originated with or are in some way associated with or sponsored by petitioner.

Absence of actual confusion

Contrary to respondent's contention, the absence of evidence of actual confusion does not weigh in respondent's favor. Respondent acknowledges that the parties' restaurants are located in different geographic regions. The record shows that petitioner's restaurants are located in Maine, and that respondent's restaurants are located in Colorado, Nevada and Utah. Thus, we are not persuaded that a meaningful opportunity for actual confusion has ever existed. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). Under the circumstances, we consider this factor to be neutral. See *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811 (TTAB 2005).⁸

Conclusion

Because highly similar marks are used in connection with identical services, presumptively offered to the same consumers through the same channels of trade, a likelihood of confusion exists.⁹

Decision: The petition to cancel is granted, and Registration No. 3088792 will be cancelled in due course. The counterclaims for cancellation are denied.

Footnotes

- 1 Registration No. 3088792, issued May 2, 2006.
- 2 Respondent's "affirmative defense" that the petition must be dismissed for failure of petitioner to sign the petition is meritless. The petition was filed electronically through ESTTA with a proper electronic signature on the signature block of the form in accordance with Trademark Rule 2.193(c) (1) (iii) (A). A separate signature is not required on the attachment to the ESTTA form.
- 3 The registration issued on March 25, 2005. We note petitioner's argument in its brief that the mark is "part of an incontestable composite word mark and design" in its Registration No. 1882663. However, because the registration consists only in part of that wording, we do not consider the counterclaims to constitute a collateral attack on the registration. See *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987) ("The registration affords prima facie rights in the marks as a whole, not in any component. Thus, a showing of descriptiveness or genericness of part of a mark does not constitute an attack on the registration.")
- 4 See discussion, *infra*, regarding the assertion of a descriptiveness claim against a registration issued under Section 2(f) of the Trademark Act.
- 5 The Board issued an order on August 19, 2008 deferring consideration of this motion until final decision.
- 6 Petitioner's underlying application was originally filed with a claim of acquired distinctiveness based on several prior registrations, including Registration No. 1882663. The application was subsequently amended to delete reliance on all registrations except Registration No. 1882663, and to add a claim of acquired distinctiveness based on a declaration of five-years' substantially exclusive and continuous use of the mark in commerce.
- 7 We take judicial notice of the definition of "thing" as meaning, "an unspecified object." Compact Oxford English dictionary of Current English (Third Edition) (from the website askoxford.com). The board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002).
- 8 It is not inconsistent for the Board to read the involved identifications in a way that presumes the services to be offered in the same area, yet to focus on areas of actual use when assessing the probative weight to be accorded to the absence of actual confusion. Such analysis is required by applicable precedent.
- 9 The fact that respondent, in selecting its mark, may not have intended to create confusion is not relevant to the question of whether the marks are in fact likely to cause confusion.

2008 WL 4675414 (Trademark Tr. & App. Bd.)

2018 WL 3533397 (Trademark Tr. & App. Bd.)

THIS ORDER IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

UNIVERSITY OF KENTUCKY

v.

40-0, LLC

Opposition No. 91224310

July 18, 2018

*1 Before Cataldo, Gorowitz and Pologeorgis
Administrative Trademark Judges

By the Board:

This proceeding comes before the Board for consideration of (1) Applicant's unconsented motion (filed January 26, 2018) to amend its involved application, (2) Applicant's motion (filed January 26, 2018) for summary judgment, and (3) Opposer's cross-motion (filed February 26, 2018) for summary judgment. The motions for summary judgment are fully briefed.

I. Background

Applicant seeks to register the mark 40-0, in standard characters, for the following goods in International Class 25: "Clothing, namely, T-shirts, sport shirts, shorts, sweatshirts, mufflers, hats, jackets, athletic jerseys, sweatpants, cloth bibs, shoes, scarves, bandanas, wrist-bands and socks."¹

On October 13, 2015, Opposer filed a notice of opposition opposing registration of Applicant's involved mark on the following grounds: failure to function as a mark; fraud; and likelihood of confusion pursuant to Section 2(d) of the Trademark Act.

On April 26, 2017, Opposer filed a motion for leave to amend its notice of opposition to remove the claim of likelihood of confusion and to assert a claim that Applicant did not make use of its mark in commerce as of the filing date in connection with all of the goods identified in its involved application. Inasmuch as Applicant did not oppose the amendment and filed an answer thereto on May 16, 2017, the Board granted Opposer's motion and Opposer's April 26, 2017 amended notice of opposition was accepted as the operative pleading in this case. In its May 16, 2017 answer to the amended notice of opposition, Applicant denied the salient allegations therein.

On January 26, 2018, Applicant filed an unconsented motion to amend its involved application to delete the following from its identification of goods: "sport shirts, shorts, sweatshirts, mufflers, hats, jackets, athletic jerseys, sweatpants, cloth bibs, shoes, scarves, bandanas, wrist-bands and socks."

On January 26, 2018, Applicant also moved for summary judgment on each of Opposer's asserted claims, namely, that its involved mark fails to function as a mark, fraud, and non-use.

Opposer cross-moves for summary judgment on its standing, as well as each of its pleaded claims.

In support of its motion for summary judgment and in response to Opposer's cross-motion for summary judgment, Applicant submitted, *inter alia*, the following: excerpts from the discovery deposition of Applicant's Fed. R. Civ. P. 30(b)(6) witness, David Son, owner of Applicant; Reinstatement Application and Reinstatement Annual Report for Applicant; the affidavit of Mr. Son; screenshots taken from the Internet Archive Wayback Machine; screenshots of Applicant's Facebook page; Applicant's responses and supplemental responses to Opposer's First Set of Interrogatories;² screenshots of Applicant's website; the affidavit of Brian McGraw, counsel for Applicant; excerpts from the deposition transcript of Jason Schlafer;³ and email correspondence between counsel for Opposer and counsel for Applicant.

*2 In support of its response and cross-motion for summary judgment, Opposer submitted the declaration of Michael S. Hargis, counsel for Opposer, who attaches, *inter alia*, the following: excerpts from the deposition of Applicant's Fed. R. Civ. P. 30(b)(6) witness, Mr. Son; documents produced by Applicant to Opposer; Applicant's answer to Opposer's first notice of opposition; online articles using "40-0" in connection with various sports teams.

II. Applicant's Motion to Amend Its Application

The Board turns first to Applicant's motion to amend its involved application.

By virtue of the proposed amendment, Applicant seeks to delete all goods save "T-shirts" from its identification of goods. While the Board will generally defer determination of a timely filed (i.e., pretrial) unconsented motion to amend in substance until final decision, or until the case is decided upon summary judgment, in practice, an acceptable amendment to the identification of goods or recitation of services often may be permitted, even where an opposer objects, if the proposed amendment serves to limit the identification of goods and if the applicant consents to the entry of judgment as to **all** claims asserted by an opposer with respect to the broader identification of goods or recitation of services. *See, e.g., Drive Trademark Holdings LLC v. Inofin*, 83 USPQ2d 1433 (TTAB 2007); *see also Int'l Harvester Co. v. Int'l Telephone and Telegraph Corp.*, 208 USPQ 940, 941 (TTAB 1980) (amendment to identification may be permitted if made before trial, if it serves to limit the scope of goods, and if applicant consents to judgment with respect to the broader identification of goods).

If the applicant wishes to avoid the possibility of a res judicata effect of the entry of judgment, an applicant seeking to amend its identification of goods or recitation of services must set forth adequate reasons for the amendment. *See Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986); *Int'l Harvester Company*, 208 USPQ at 941. That is, an applicant must make a prima facie showing that the proposed amendment serves to change the nature and character of the goods or services or to restrict their channels of trade and customers in such a manner that a substantially different issue for trial has been introduced from the issue presented by the opposition against the application based on the original identification of goods and services. *Drive Trademark Holdings LLC*, 83 USPQ2d at 1435.

Here, although the proposed deletion narrows the identification of goods, Applicant has not clearly and affirmatively stated that it will accept judgment on Opposer's claims as to the broader identification of goods. Applicant states, rather, that it "accepts judgment against it with respect to **only** those goods that it has proposed to delete."⁴ Applicant further argues that the deletion of the identified goods would provide Opposer with "the same relief that Opposer could have obtained if it prevailed on its claims for non-use (Count Three) and fraud (Count Two) of its Amended Notice of Opposition."⁵ Applicant is incorrect. Fraud as to any goods or services within a single class results in a finding that the application is void as to the entire class. *Herbaceuticals Inc. v. Xel Herbaceuticals*, 86 USPQ2d 1572, 1577 (TTAB 2008); *Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205, 1208 (TTAB 2003). Therefore, acceptance of judgment as to the broader identification of goods would result in the Board finding the class void in its entirety. Insofar as Applicant has not clearly accepted judgment as to all of Opposer's asserted claims based on the broader identification, Applicant's motion to amend its identification of goods is **deferred** until final decision. *See* TBMP § 514.03 (June 2018).

III. The Parties' Motions for Summary Judgment

*3 The Board next turns to the parties' motions for summary judgment. For purposes of this order, the Board presumes the parties' familiarity with the pleadings, the history of the proceeding, and the arguments and evidence submitted with respect to the cross-motions for summary judgment.

Summary judgment is appropriate where the movant shows that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be or is genuinely disputed must support its assertion by either (1) citing to particular parts of materials in the record, or (2) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support that fact. Fed. R. Civ. P. 56(c).

A movant for summary judgment carries the burden of proof in regard to its motion. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986). In deciding the motion, the Board does not try issues of fact, but only determines if there are any genuine disputes of material fact to be tried. *See* TBMP § 528.01 and cases cited therein. When the moving party has supported its motion with sufficient evidence that, if unopposed, indicates there is no genuine dispute of material fact, the burden then shifts to the nonmoving party to demonstrate the existence of a genuine dispute of material fact to be resolved at trial. *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009). Further, merely because both parties have moved for summary judgment does not necessarily mean that there are no genuine disputes of material fact, and does not dictate that judgment should be entered. *See Univ. Book Store v. Univ. of Wis. Bd. of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994).

The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992).

A. Standing

Section 13 of the Trademark Act provides that “[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register ... may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office...” 15 U.S.C. § 1063. Section 13 thus establishes a broad doctrine of standing; by its terms, the statute requires only that a person have a belief that he would suffer some kind of damage if the mark is registered. As interpreted in binding precedent, a plaintiff must have a “real interest” in the outcome of the proceeding, and a “reasonable basis” for its belief that it would suffer some kind of damage by the registration of the mark. *See Empresa Cubana del Tabaco*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)); *Universal Oil Prods. Co. v. Rexall Drug & Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972).

*4 In support of its standing, Opposer argues that the Board should “look to the well-pleaded allegations of the complaint and should not examine the evidentiary record ‘unless such record establishes clearly and convincingly that the allegation was a sham pleading.’”⁶ A plaintiff’s allegations alone do not establish standing; rather, a plaintiff must provide evidence to demonstrate its standing. *Lipton Industries, Inc.*, 213 USPQ at 189 (“The facts regarding standing...are part of a [plaintiff’s] case and must be affirmatively proved.”). Therefore, contrary to Opposer’s position, the allegations in Opposer’s amended notice of opposition do not establish its standing. Similarly, statements made in Opposer’s brief and attorney argument do not constitute evidence of Opposer’s standing. *See Enzo Biochem Inc. v. Gen Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005).

Additionally, Opposer relies, in part, on exhibits attached to its amended notice of opposition. The exhibits to a pleading do not constitute evidence on behalf of the party to whose pleading they are attached, unless they are thereafter properly identified and introduced in evidence as exhibits. Trademark Rule 2.122(c), 37 C.F.R. § 2.122(c); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1846 n.6 (TTAB 2004). Accordingly, the Board has not given the exhibits attached to Opposer’s amended notice of opposition any consideration.

Upon careful consideration of the parties' arguments and evidence, and drawing all inferences with respect to the nonmoving party, the Board finds that Opposer has not demonstrated the absence of a genuine dispute of material fact for trial with respect to its standing and that Opposer is not entitled to summary judgment under applicable law.

Insofar as Opposer has failed to demonstrate its standing as a matter of law, Opposer's cross-motion for summary judgment is **denied**. See *United Rum Merchants Ltd. v. Distillers Corp. (S.A.)*, 9 USPQ2d 1481, 1483-84 (TTAB 1988) (“opposer's motion for summary judgment has been denied in view of opposer's failure to demonstrate its standing as a matter of law...”).

B. Non-use

In its motion for summary judgment, Applicant has conceded that it did not have use of its mark in connection with any goods other than T-shirts at the time of the filing of its involved application.⁷ In light of the fact that Applicant concedes it did not have use of its mark in connection with “sport shirts, shorts, sweatshirts, mufflers, hats, jackets, athletic jerseys, sweatpants, cloth bibs, shoes, scarves, bandanas, wrist-bands and socks” at the time it filed its involved application, we find that there is no genuine dispute of material fact with respect to Applicant's non-use of its mark in connection therewith. Opposer's claim of non-use with respect to the above-identified goods remains subject to Opposer's proof of standing at trial, however.

*5 With respect to T-shirts, Opposer concedes that Applicant did use its involved mark on T-shirts at the time of the filing of its involved application, but contests whether such use constituted trademark use of the 40-0 designation.⁸

Upon careful consideration of the parties' arguments and evidence, and drawing all inferences with respect to each motion in favor of each nonmoving party, we find that neither party has demonstrated the absence of a genuine dispute of material fact for trial and that neither party is entitled to summary judgment on the claim of nonuse under applicable law. Based upon the present record, we find, at a minimum, a genuine dispute of material fact as to whether Applicant had use of its 40-0 mark as a trademark in connection with T-shirts at the time of the filing of its involved application. Accordingly, the parties' motions for summary judgment on Opposer's claim of non-use are **denied**.

C. Failure to Function as a Mark

Section 45 of the Trademark Act, 15 U.S.C. § 1127, defines a “trademark” as “any word, name, symbol, or device, or any combination thereof...used by a person...to identify and distinguish his or her goods...from those manufactured or sold by others to indicate the source of the goods, even if that source is unknown.” It is well settled that not every designation that is placed or used on a product necessarily functions as a trademark and not every designation adopted with the intention that it perform a trademark function necessarily does so. *In re Hulting*, 107 USPQ2d 1175, 1177 (TTAB 2013) (citing *American Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 USPQ 149, 154 (TTAB 1973)).

A claim of failure to function as a mark is based on an assertion that, due to the inherent nature or the manner of use of the mark sought to be registered, such matter does not function as a mark to identify and distinguish a party's goods. See Trademark Act Sections 1 and 2, 15 U.S.C. §§ 1051 and 1052; TMEP § 1202 (October 2017). Slogans and other terms that are considered to be merely informational in nature, or that express support, admiration or affiliation, are generally not registrable. See *In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1232 (TTAB 2010); *In re Pro-Line Corp.*, 28 USPQ2d 1141, 1142 (TTAB 1993).

The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public. TMEP § 1202.04. To make this determination, the Board may consider specimens and evidence of record showing how the designation is actually used. *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010) (citing *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998)). Thus, the manner in which the mark is actually used is the determinative factor. See *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1135 (TTAB 2000).

*6 Applicant contends that consumers perceive its 40-0 designation as a mark. In support of its motion for summary judgment, Applicant submits, *inter alia*, evidence of its use of its mark on its goods, as well as in connection with its advertising and promotion thereof online.⁹ Opposer, on the other hand, contends that (1) “40-0” is informational only and refers to an undefeated college basketball season and championship and (2) as used by Applicant, the 40-0 designation fails to function as a mark. In response to Applicant's motion and in support of its cross-motion, Opposer submits, *inter alia*, evidence of third party use of the “40-0” term as informational.¹⁰

Upon careful consideration of the parties' arguments and evidence, and drawing all inferences with respect to each motion in favor of each nonmoving party, we find that neither Opposer nor Applicant has demonstrated the absence of a genuine dispute of material fact for trial and that neither is entitled to summary judgment on the claim of failure to function as a mark under applicable law. Based upon the present record, we find, at a minimum, a genuine dispute of material fact as to whether consumers perceive the 40-0 designation as a source indicator of Applicant's identified goods.

Accordingly, Applicant's motion for summary judgment and Opposer's cross-motion on Opposer's claim that Applicant's designation fails to function as a trademark are **denied**.

D. Fraud

A claim of fraud requires a plaintiff to prove that an applicant for registration knowingly made a false, material misrepresentation of fact in connection with the application with the intent to deceive the USPTO to obtain a registration to which it is not otherwise entitled. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986). False statements regarding use of a mark are material. *See Nationstar Mort. LLC v. Ahmad*, 112 USPQ2d 1361, 1365 (TTAB 2014) (citing *Hachette Filipacchi Presse v. Elle Belle LLC*, 85 USPQ2d 1090, 1093 (TTAB 2007)).

A party alleging fraud bears a heavy burden of proof. *In re Bose*, 91 USPQ2d at 1939. Indeed, “the very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence.” *Id.* (quoting *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981)).

While Applicant concedes that it did not have use of its mark on any goods other than T-shirts at the time of the filing of its use-based application, Applicant contends that its filing was based on an honest misunderstanding and was done without intent to deceive.¹¹ Opposer, on the other hand, contends that intent may be inferred based on Applicant's sophistication and the fact that Applicant was represented by counsel at the time it filed its involved application.¹²

*7 Upon careful consideration of the parties' arguments and evidence, and drawing all inferences with respect to each motion in favor of each nonmoving party, we find that neither Applicant nor Opposer has demonstrated the absence of a genuine dispute of material fact for trial with respect to Opposer's claim of fraud. Based on the present record, we find, at a minimum, that a genuine dispute of material fact exists as to Applicant's intent. Additionally, we note that the factual question of intent is particularly unsuited to disposition on summary judgment. *See Copelands' Enters. Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991).

In view thereof, the parties' motions for summary judgment on Opposer's claim of fraud are **denied**.¹³

Inasmuch as this case is on the verge of trial, the Board will not entertain any further motions for summary judgment in this proceeding.

IV. Trial Schedule

Proceedings herein are resumed. Remaining dates are reset as follows:

Plaintiff's Pretrial Disclosures Due	7/23/2018
Plaintiff's 30-day Trial Period Ends	9/6/2018
Defendant's Pretrial Disclosures Due	9/21/2018
Defendant's 30-day Trial Period Ends	11/5/2018
Plaintiff's Rebuttal Disclosures Due	11/20/2018
Plaintiff's 15-day Rebuttal Period Ends	12/20/2018
Plaintiff's Opening Brief Due	2/18/2019
Defendant's Brief Due	3/20/2019
Plaintiff's Reply Brief Due	4/4/2019
Request for Oral Hearing (optional) Due	4/14/2019

*8 Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

Footnotes

- 1 Application Serial No. 86534269, filed February 13, 2015, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming October 24, 2013 as both the date of first use and the date of first use in commerce.
- 2 Pursuant to Trademark Rule 2.120(k)(5), 37 C.F.R. § 2.120(k)(5), typically responses to interrogatories may be submitted only by the receiving party. The Board has therefore given Applicant's responses to Opposer's interrogatories no consideration.
- 3 Neither party identified Mr. Schlafer or indicated if the deposition was of Mr. Schlafer in his personal capacity or as a 30(b)(6) witness on behalf of Opposer. Moreover, Applicant did not submit portions of the deposition transcript identifying Mr. Schlafer or his position, if any, with Opposer.
- 4 33 TTABVUE 14 (emphasis added).
- 5 32 TTABVUE 4.
- 6 35 TTABVUE 7 (quoting *Lipton Indus. v. Ralston Purina Co.*, 670 F.2d 1024, 1027, 213 USPQ 185 (CCPA 1982)).
- 7 33 TTABVUE 14.
- 8 35 TTABVUE 10 (“Opposer concedes that the evidence of record indicates that Applicant distributed T-shirts with the phrase 40-0 printed across the front thereof prior to the filing date of [Applicant's involved application].”).

9 *See, e.g.*, 33 TTABVUE 7-13.

10 *See, e.g.*, 35 TTABVUE 10-21.

11 33 TTABVUE 15-17.

12 35 TTABVUE 22-26.

13 The fact that we have identified and discussed certain genuine disputes of material fact as sufficient bases for denying the motions for summary judgment should not be construed as a finding that these are necessarily the only disputes that remain for trial. Additionally, the parties should note that the evidence submitted in connection with a motion for summary judgment or opposition thereto is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); and *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983).

2018 WL 3533397 (Trademark Tr. & App. Bd.)

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2011 TTAB LEXIS 296

Trademark Trial and Appeal Board

September 22, 2011, Decided

Cancellation No. 92051212 Cancellation No. 92051213 Cancellation No. 92051215

Reporter

2011 TTAB LEXIS 296 *

Karen L. Willis v. Can't Stop Productions, Inc.

Subsequent History:

Motion granted by *Willis v. Can't Stop Prods., 2012 U.S. App. LEXIS 4433 (Fed. Cir., Mar. 2, 2012)*

Affirmed by *Willis v. Can't Stop Prods., 497 Fed. Appx. 975, 2012 U.S. App. LEXIS 23269 (Fed. Cir., Nov. 13, 2012)*

Core Terms

Registration, Cancellation, declarations, musical, abandonment, VILLAGE, fraud claim, marks, allegations, recordings, trademark, non-use, pleaded, proceedings, summary judgment motion, first use, summary judgment, genuine dispute, misrepresentation, vocal, amended petition, filing date, entertainment, material fact, resume

Panel: [*1] Before Seeherman, Walters and Taylor, Administrative Trademark Judges.

Opinion By:

Faint, M. Catherine

Opinion

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

By the Board:

Petitioner, the wife and manager of a former member of the musical recording group the Village People, has filed amended petitions for cancellation¹ of respondent's three registrations: two registrations are for the typed word mark, VILLAGE PEOPLE,² and one is for the design mark shown below:



3

[*2]

This case now comes up for consideration of respondent's motions for summary judgment on petitioner's pleaded grounds of fraud, abandonment and genericness in each of the three cancellation proceedings. [*3]

I. Single Order

While there is no motion to consolidate these proceedings pending, *Fed. R. Civ. P. 42(a)*, as made applicable to Board proceedings by *37 CFR Section 2.116(a)* (Trademark Rule 2.116(a)), provides that when actions involving common questions of law and fact are pending before the Board, the Board may order all of the actions consolidated, and it may make any orders concerning proceedings to avoid unnecessary costs or delay. In this case there is sufficient commonality of factual and legal issues in the proceedings that consolidation for consideration of the summary judgment motions is appropriate. All three cancellation proceedings involve the same parties and contain very similar pleadings. However, because Cancellation Nos. 92051213 and 92051215 are disposed of by this order, as explained more fully below, consolidation is unnecessary beyond the issuance of this single order applicable to all three proceedings.

II. Sufficiency of Pleadings

¹ In Cancellation No. 92051212 petitioner filed a first amended petition to cancel on July 21, 2009, and a second amended petition to cancel on August 11, 2009. Respondent appears to have filed its answer as to the second amended petition to cancel. The proper procedure would have been for petitioner to file a motion to amend the petition to cancel with her second amended petition, or to file it with respondent's consent. See *Fed. R. Civ. P. 15(a)(2)*. In view of respondent's answer, it appears that respondent has consented to the amendment of the pleading, and therefore we have accepted the second amended petition to cancel and respondent's answer thereto. However, petitioner is reminded that strict compliance with the rules is required in the future. We also note that petitioner has created some confusion by alleging damage in the original and amended petitions to cancel from two registrations, Nos. 1101013 and 2184290, although the petition to cancel filed in this proceeding relates only to Registration No. 2184290, and Registration No. 1101013 is the subject of Cancellation No. 92051213. To clarify, the Board deems the petition to cancel in Cancellation No. 92051212 as relating solely to Registration No. 2184290.

² Registration No. 1101013, issued August 29, 1978, for "entertainment services rendered by a musical and vocal group" in Class 41, based on an application filed November 17, 1977 and asserting dates of first use and first use in commerce of July 11, 1977.

Registration No. 2184290, issued August 25, 1998, for "prerecorded phonograph records, audio cassettes, audio tapes and compact discs featuring music and vocals" in Class 9, based on an application filed November 17, 1993 and asserting dates of first use and first use in commerce of 1978; goods in class 16 were cancelled pursuant to § 8 of the Trademark Act in 2008.

³ Registration No. 2330857, issued March 21, 2000, for "entertainment services, namely, live performances by a musical and vocal group" in Class 41, based on an application filed April 3, 1998, and asserting dates of first use and first use in commerce of July 11, 1977.

A decision on summary judgment necessarily requires a review of the operative pleadings of these three cases. See, e.g., Asian and Western Classics B.V. v. Selkow, 92 USPQ2d 1478, 1478 (TTAB 2009). [*4] Therefore, we start by noting that the petitions do not properly plead claims of fraud.

The Court of Appeals for the Federal Circuit has held that a trademark registration is obtained, or maintained, fraudulently only if the respondent knowingly makes a false, material representation with the intent to deceive the USPTO. In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009). Under Fed. R. Civ. P. 9(b), any allegations of fraud based upon "information and belief" must be accompanied by a statement of facts upon which the belief is founded. See Exergen Corp. v. Wal-Mart Stores, Inc., 575 F.3d 1312, 91 USPQ2d 1656, 1670 n.7 (Fed. Cir. 2009); Meckatzer Lowenbrau Benedikt Weiss KG v. White Gold LLC, 95 USPQ2d 1185 (TTAB 2010).

In order to properly plead a claim of fraud in a trademark cancellation proceeding, a petitioner must allege with particularity that the respondent knowingly made a false, material misrepresentation when applying for a trademark registration, or when renewing a registration, with intent to deceive the USPTO. Enbridge Inc. v. Excelerate Energy LP, 92 USPQ2d 1537, 1540 (TTAB 2009). It [*5] is the preferred practice of the Board that the element of intent be pled specifically, but intent, as a condition of mind of a person, may be averred generally. Fed. R. Civ. P. 9(b); see also DaimlerChrysler Corp. v. American Motors Corp., 94 USPQ2d 1086, 1089 (TTAB 2010) (finding allegations of material misrepresentations knowingly made to procure a registration constitute sufficient allegation of intent element for pleading fraud).

Petitioner bases her claims of fraud on various theories that require some construction and which we summarize as follows: 1) respondent provided false dates of first use in its applications either in the application as originally filed or in a statement of use; 2) the marks have not been in use in commerce since the original Village People group disbanded and respondent's post-registration filings continued this fraud regarding dates of use; 3) the marks misrepresent the source of the goods because the Village People group disbanded about 1982; and 4) various claims relating to the nature of respondent's services, as discussed more fully below. To the extent petitioner considers each of these claims to allege a particular type of fraud, [*6] we consider them each in turn.

1. Dates of Use in the Applications/Statement of Use

Petitioner alleges in her amended petitions for cancellation that the dates of first use claimed in the applications which resulted in issuance of respondent's registrations, namely, July 11, 1977 in Registration Nos. 1101013 and 2330857, and 1978 in Registration No. 2184290, were false.

With regard to Registration Nos. 1101013 and 2330857, for the mark VILLAGE PEOPLE and the design mark for entertainment services rendered by a musical and vocal group, petitioner argues that the only member of the "group" as of the July 11, 1977 claimed date of first use was petitioner's husband, who was accompanied by professional background singers. To the extent petitioner is alleging that the date of use is false or inaccurate because her husband only performed with background singers as of the claimed date of first use and did not perform with others who would later become known as members of the Village People group until after July 11, 1997, we do not find this distinction to state a claim of fraud.

With regard to Registration No. 2184290, also for the mark VILLAGE PEOPLE, but for various types of recordings, [*7] petitioner essentially argues that the first musical album was recorded in July 1977, not 1978. This claim also fails to state a claim of fraud because the dates of first use alleged by an applicant in a use-based application or statement of use filed in an intent-to-use application, even if false, do not constitute fraud, as long as there was technical trademark use on or before the filing date of the application or statement of use. Clearly, petitioner contends that there was use prior to the filing date of November 17, 1993.

With respect to the design mark shown in Registration No. 2330857 for entertainment services, the application was filed on April 3, 1998, and claimed a date of first use of July 11, 1977. Petitioner alleges, however, that the earliest date the mark could have been used was 1979, because all of the characters represented in the mark did not exist until that time, and the appearance of the characters changed over time. This claim, too, does not state a claim of

fraud, because by petitioner's own reckoning, all the characters represented in the mark were part of the group by the time the application was filed. Again, a claim of fraud based on assertion of a false [*8] date of first use will not lie unless there is no use of the mark on or before the filing date.

Respondent contends that petitioner has not adequately alleged that the marks were not in use as of the filing dates of the applications or statements of use, submits further evidence of its claimed dates of use, and argues that, as a matter of law, there is no proper pleading of claims of fraud regarding the dates of use. We agree.

In view thereof, petitioner's fraud claims based on allegedly false dates of first use are stricken.

2. Non-use as of the Post Registration Filing Dates

Petitioner alleges that respondent was not using the marks on the filing dates of the respective Section 8 and 15 declarations, and the declarations filed in the Section 9 renewal applications, because the specimens submitted with the post registration declarations were not in continuous use for the five years immediately preceding the filing of the declarations. We construe these as claims of fraud for non-use. Fraud based on non-use of a mark occurs when a party knowingly, and with the intent to deceive the USPTO, represents that it is using the mark in connection with goods or services, when in fact [*9] no use of the mark has been made. *Herbaceuticals, Inc. v. Xel Herbaceuticals, Inc.*, 86 USPQ2d 1572 (TTAB 2008).

Specimens of use need only illustrate current use of the mark at the time of filing the Section 8 and 15 declarations and the application for renewal. In fact, a declaration of continuing use filed pursuant to Section 8 does not require that the mark be in use for the five years preceding the filing of the declaration, only that the mark be in use at the time the declaration is executed. The same is true of the application for renewal. Even for a Section 15 declaration, which asserts five years of continuous use, there is no requirement that the *same* specimen be used for those five years, only that the mark be in use for five continuous years prior to the filing of the declaration. To the extent petitioner is claiming fraud on these grounds, petitioner simply misunderstands the law.⁴ In view thereof, petitioner's fraud claims based on allegations that the specimens were not in use at the time of the post registration filings are stricken as insufficient.

[*10]

3. Misrepresentation of Source

A claim of misrepresentation of source under Section 14(3) is a separate claim from fraud, and has not been separately pleaded by petitioner. It pertains to situations where a registered mark is used to deliberately misrepresent that goods or services originate from the registrant when in fact those goods or services originate from the petitioner. A pleading of misrepresentation of source must include allegations of blatant misuse of the mark by the registrant in a manner calculated to trade on the goodwill and reputation of the petitioner. *Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007). Petitioner's allegations fall short of these requirements. In view thereof, to the extent petitioner bases her fraud claims on alleged misrepresentation of source, the claims are insufficient both as fraud claims and as separate misrepresentation of source claims, and are stricken.

4. Nature of the Services

Petitioner makes various claims regarding the nature of respondent's services, including, the Village People is not a "musical and vocal group" but a "concept group;"⁵ the design mark does not depict petitioner's [*11] husband, Victor Willis; subsequent groups did not include petitioner's husband as a member or performer; and the group

⁴ Petitioner concedes that the use made by respondent's licensee Universal Music and Video Distribution inures to respondent's benefit and, in her opposing brief in Cancellation No. 92051212, withdraws her reliance on the claim that use was made by respondent's licensee, rather than by respondent.

⁵ To the extent petitioner intends this as a claim of abandonment for the identified services, the claim is addressed below in the section on abandonment.

members lip-sync when performing and this constitutes "Milli Vanilli fraud." The Board's jurisdiction is limited to the registrability of trademarks, and none of these claims constitutes a legally cognizable trademark claim within the Board's jurisdiction.

5. Requirements for Adequate Fraud Pleading

Petitioner's claims recite that "upon information and belief" fraud has been committed, but these claims are largely devoid of any facts upon which the alleged belief can be reasonably based. Further, petitioner has not alleged fraud with the required particularity. It is only upon review of the declarations of petitioner and her husband, Victor Willis, attached to petitioner's papers opposing respondent's motion for summary judgment, [*12] that we discern a possible claim, but the claim is not adequately pleaded. With respect to Registration No. 2184290, that possible claim is non-use of the mark VILLAGE PEOPLE as of the underlying application filing date of November 17, 1993, and non-use of the mark as of the date of execution of all subsequent declarations of continued use, on prerecorded phonograph records, audio cassettes and audio tapes featuring music and vocals.

We emphasize that, for the reasons set out above, petitioner has not properly pleaded any claim of fraud, but we nonetheless note that respondent has not presented evidence in support of its motion for summary judgment that would entirely preclude proper potential pleading by petitioner of non-use claims, and possibly a fraud claim based on allegations of non-use. While respondent has presented evidence of use on prerecorded phonograph records for the years 1977-1982, there is no evidence offered that the mark was used beyond that date for those goods.

Therefore, petitioner's claims of fraud are legally insufficient and are hereby stricken from the pleadings. However, petitioner may, if appropriate, submit an amended petition to cancel asserting proper [*13] claims of non-use and/or fraud in Cancellation No. 92051212 only.

In view thereof, petitioner may, within **THIRTY DAYS** from the mailing date of this order, submit a third amended petition to cancel in Cancellation No. 92051212 which adequately pleads fraud and/or non-use.

We turn now to the claims of abandonment and genericness argued in respondent's motions for summary judgment as to all three cases.

III. Summary Judgment

Summary judgment is appropriate when there is no genuine dispute as to any material fact and the moving party is entitled to judgment as a matter of law. See *Fed. R. Civ. P. 56(a)*. A party moving for summary judgment has the initial burden of demonstrating the absence of evidence to support the nonmoving party's case, and that it is entitled to judgment as a matter of law. *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1795-1796 (Fed. Cir. 1987), citing *Celotex Corp. v. Catrett*, 477 U.S. 317, 325, 106 S.Ct. 2548, 2554, 91 L. Ed. 2d 265 (1986). When the moving party has supported its motion with sufficient evidence which, if unopposed, indicates there is no genuine dispute of material fact, the [*14] burden then shifts to the non-moving party to demonstrate the existence of a genuine dispute as to a material fact to be resolved at trial. *Enbridge*, 92 USPQ2d at 1540. A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See, *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

A trademark registration more than five years old may be canceled at any time if, inter alia, the mark becomes generic or is abandoned, or if the registration was obtained through fraud. See *15 U.S.C. § 1064*.

A. Abandonment

Petitioner makes similar allegations regarding abandonment of all three of the registered marks, namely that since the 1980's the marks have only been licensed for live performances and no new recordings have been made since 1985; that the mark is for a "concept group," not a musical group; and that changes have been made to the design

mark because of changes [*15] to certain of the characters depicted in the mark. Petitioner alleges that these changes amount to abandonment of all three marks without an intent to resume use.

Under Section 45 of the Trademark Act, a mark is deemed abandoned if its use has been discontinued without intent to resume use, and nonuse in the United States for a period of three consecutive years establishes a *prima facie* case of abandonment. See 15 U.S.C. § 1127. Thus, in order to prove abandonment, petitioner must be able to show that respondent's use of the mark has been discontinued for at least three consecutive years, or that respondent has discontinued use of the mark without an intent to resume use. *Id.*; see also, On-Line Careline, Inc. v. America Online, Inc., 229 F.3d 1080, 1087, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000). Conversely, respondent, as the party moving for summary judgment dismissing the claims of abandonment, must establish continuous use of its marks for all of the goods and services named in the registrations, or that it has not ceased use without an intent to resume use. Respondent provides declarations from its managing director, Henri Belolo, [*16] declaring that Can't Stop Productions has offered pre-recorded musical recordings since 1977 and they are currently distributed, and that it has continually owned and used the marks with entertainment services since 1977. Also provided were the declarations of Mitchell Weiss, the manager of respondent's licensee, declaring that the licensed marks include VILLAGE PEOPLE and the design mark, and the marks have been continuously used by the licensee for over twenty years for musical performances. Attached to these declarations is evidence in the form of exhibits to show that the three marks have continuously been used and are still in use.

We must view respondent's motion for summary judgment on abandonment in a light most favorable to petitioner as the non-moving party. With regard to Registration No. 2184290, petitioner pleads that respondent cannot be offering recordings because the group has made no new recordings since the 1980's, and the mark has been licensed only for live performances since that time. Respondent has presented declarations and exhibits showing that compact discs have been continuously sold up to the present time, and petitioner does not dispute that point. Respondent [*17] has not shown, however, that it is still using the mark in connection with pre-recorded phonograph records, audio cassettes and audio tapes featuring music and vocals. At the least there is a genuine dispute of material fact as to whether respondent has ceased using its mark in connection with those goods. Accordingly, respondent's motion for summary judgment is denied in Cancellation No. 92051212.

With regard to Registration Nos. 1101013 and 2330857 for entertainment services, petitioner's arguments revolve around whether the performing group is a "real" musical and vocal group, or a "concept group," but petitioner does not allege or even argue that no performances are taking place. Petitioner presents her own declarations that she has seen the group perform, taking issue with the manner of performance, not the fact of it.⁶ Respondent has submitted magazine and internet advertisements, supported by the declaration of Mitchell Weiss, showing that the mark VILLAGE PEOPLE and the design mark have been used in connection with musical performances in 1994, 1995, 1997, 1998, 2001, 2002, 2003, 2004, 2005, 2006, 2008 and 2010. Further, respondent has asserted that use has been continuous, [*18] as evidenced by the Belolo and Weiss declarations. Whether or not petitioner believes there is a distinction between a "real" musical and vocal group and a concept group, petitioner has not raised a genuine dispute that the performances by respondent's group are not the rendering of performances by a musical and vocal group. Accordingly, there is no genuine dispute that respondent has used its marks for entertainment services in commerce without any gap of three years of nonuse, and *prima facie* evidence of abandonment therefore does not exist. Accordingly, respondent's motions for summary judgment on the grounds of abandonment are granted in Cancellation Nos. 92051213 and 92051215.

[*19]

B. Genericness

⁶ The Board notes that petitioner filed two additional declarations in Cancellation No. 92051213 because of an alleged scanning and upload error in the e-filing of a declaration signed by Victor Willis in that proceeding. Respondent filed an objection to the filing as untimely. Under the circumstances of this case, where an essentially identical declaration was filed in the other two cancellation proceedings, the Board grants the motion to amend to the extent that the corrected declaration of Victor Willis is substituted in Cancellation No. 92051213.

Although respondent has brought a motion for summary judgment regarding petitioner's genericness claims, in actuality respondent is arguing that this ground should be dismissed. Petitioner alleges in all three cases that the mark is generic because it identifies people in a village, and provides evidence attached to her response briefs to show the term VILLAGE PEOPLE is used to describe groups of people living in a community or small town. Respondent argues that petitioner does not allege that there are any other users of the mark for musical recordings or entertainment services, and provides evidence, supported by the Belolo declaration, that it has been the exclusive user of the VILLAGE PEOPLE marks in connection with musical recordings and performances for a significant period of time.

We note first that petitioner's allegations cannot apply to the design mark shown in Registration No. 2330857, because the words "Village People" do not appear in the mark.

A term is generic if it is the common descriptive name for a genus of goods or services, and should be refused registration because it does not function as a trademark or service mark. Park' N Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189, 194, 105 S. Ct. 658, 83 L. Ed. 2d 582 (1985). [*20] But a term can be a generic term in one context and arbitrary or fanciful in another, and thus serve as a valid trademark when used as a mark for goods or services in another context. It is fallacious to allege that because a term is the generic name for one thing, it cannot serve as the trademark for another thing. See, e.g., Eurotech, Inc. v. Cosmos European Travels Aktiengesellschaft, 213 F.Supp.2d 612, 620, (E.D. Va. 2002) (rejecting as fallacious the argument that because COSMOS is generic for universe, it cannot serve as a trademark for travel agency services); see also 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:1 (4th ed. WESTLAW Update Aug. 2011).

We find that petitioner has not, and apparently cannot, raise any genuine dispute of material fact with regard to this ground as petitioner has submitted no evidence, nor even made allegations, to show the term VILLAGE PEOPLE is used as a generic term for musical recordings or performances. Accordingly, summary judgment is granted with respect to the ground of genericness in all three proceedings.

IV. Summary

In summary, respondent's motions for summary judgment [*21] are granted on petitioner's claims of abandonment in Cancellation Nos. 92051213 and 92051215, and as to genericness in all three proceedings. Because there are no properly pleaded fraud or non-use claims in Cancellation Nos. 92051213 and 92051215, and there do not appear to be any such viable claims against Registration Nos. 1101013 and 2330857 in those proceedings, summary judgment on the grounds of abandonment and genericness in those proceedings are a final disposition of the cases. Accordingly, Cancellation Nos. 92051213 and 92051215 are dismissed with prejudice.⁷

[*22]

V. Schedule

Within **THIRTY (30) DAYS** of the mailing date of this order petitioner may submit a third amended petition to cancel in Cancellation No. 92051212 which adequately pleads fraud and/or non-use of certain goods, failing which the cancellation proceeding will go forward solely on the issue of abandonment. In the event petitioner files and serves

⁷ Because this is a final decision of the Board, the decision as to Cancellation Nos. 92051213 and 92051215 may be appealed to the Court of Appeals for the Federal Circuit or to a U.S. District Court with appropriate jurisdiction. See Trademark Act Sections 21(a)(1) and 21(b)(1), 15 U.S.C. §§ 1071(a)(1) and 1071(b)(1); Trademark Rule 2.145, 37 C.F.R. § 2.145; and TBMP § 901.01 (3d ed. 2011). The decision in Cancellation No. 92051212 is interlocutory in nature, therefore, any appeal thereof can be raised only after final disposition of that proceeding. See Copelands' Enterprises, Inc. v. CNV, Inc., 887 F.2d 1065, 12 USPQ2d 1562 (Fed. Cir. 1989).

such an amended petition for cancellation, the Board will assess the sufficiency of those pleadings and reset answer dates, if appropriate.⁸

[*23]

Proceedings in Cancellation No. 92051212 are resumed and dates are reset as set out below.

Expert Disclosures Due	10/27/2011
Discovery Closes	11/26/2011
Plaintiff's Pretrial Disclosures Due	1/10/2012
Plaintiff's 30-day Trial Period Ends	2/24/2012
Defendant's Pretrial Disclosures Due	3/10/2012
Defendant's 30-day Trial Period Ends	4/24/2012
Plaintiff's Rebuttal Disclosures Due	5/9/2012
Plaintiff's 15-day Rebuttal Period Ends	6/8/2012

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⁸ The parties should note that the evidence submitted in connection with the motions for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See, *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). The parties may, however, stipulate that any or all of the summary judgment evidence be treated as properly of record for purposes of final decision. See, e.g., *Eveready Battery Co., Inc. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial pursuant to Accelerated Case Resolution (ACR)); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial).