

ESTTA Tracking number: **ESTTA74911**

Filing date: **04/06/2006**

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

Proceeding	92044270
Party	Plaintiff SMART CHOICE FOOD SALES, LTD. ,
Correspondence Address	SCOTT J. FIELDS, ESQ. NATIONAL IP RIGHTS CENTER, LLC 550 TOWNSHIP LINE ROAD, SUITE 400 BLUE BELL, PA 19422
Submission	Other Motions/Papers
Filer's Name	Scott J. Fields
Filer's e-mail	sfields@niprc.com
Signature	/Scott J. Fields/
Date	04/06/2006
Attachments	Declaration and Memorandum.pdf ( 15 pages )



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

In the matter of trademark Registration No.: **1,500,164**

For the mark:       THE GOLD STANDARD  
Date Registered:   August 16, 1988

SMART CHOICE FOOD SALES, LTD.,	:	
	:	Cancellation No. 92044270
Petitioner	:	
	:	
v.	:	
	:	
NATURE'S WAY PRODUCTS, INC.,	:	
	:	
Registrant.	:	

**DECLARATION OF ROBERT SEADER**

Robert Seader hereby declares the following under penalty of perjury:

1.     I am the president of Petitioner Smart Choice Food Sales, Ltd. This paper is submitted in support of our Memorandum establishing standing in this case.
2.     In December 2004, we determined that we desired to use the mark "Gold Standard" for a line of vitamins, minerals and nutritional supplements.
3.     I retained Scott J. Fields, Esquire and National IP Rights Center, LLC to determine whether this mark was free and available.
4.     On January 23, 2005, I was advised of the existence of Nature's Way's "The Gold Standard" trademark registration and that this registration posed a potential bar to our use of the Gold Standard.

5. I had a meeting with counsel shortly thereafter.

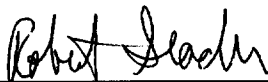
6. At the suggestion of counsel, we undertook a thorough examination of the trade to see if "The Gold Standard" mark was in use. This included internet searches, visits to several health food stores, review of trade press, reviewing Nature's Way trade/show booth and phone calls to Nature's Way Utah offices. Nature's Way indicated that there was no "The Gold Standard" product. Counsel also attempted to contact Nature's Way's legal department, but received no information.

7. We undertook preparation to use the "Gold Standard" mark, including the preparation of preliminary labeling, packaging, marketing and promotions.

8. I authorized the preparation of and the filing of an intent to use application. The application was docketed as U.S. Serial No. 78/585,224. The application presently stands rejected under Section 2(d) in view of U.S. Registration No. 1,500,164, the very registration at issue here.

9. As of the filing date of the Cancellation, we had already lined up a manufacturer to produce our products under the "Gold Standard" mark.

10. We have held off finalizing our activities, pending the resolution of this Cancellation, causing us substantial losses in potential business and lead time.

  
\_\_\_\_\_  
Robert Seader

Dated: April 6, 2006

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

In the matter of trademark Registration No.: **1,500,164**

For the mark:       THE GOLD STANDARD  
Date Registered:    August 16, 1988

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	:	Cancellation No. 92044270
Petitioner	:	
	:	
v.	:	
	:	
NATURE'S WAY PRODUCTS, INC.,	:	
	:	
Registrant.	:	

**MEMORANDUM IN SUPPORT OF PETITIONER'S STANDING**

This paper is submitted in support of Petitioner's stand to bring this action.

This paper is supported by the Declaration of Robert Seader. The Declaration sets forth the "real interest" and "possibility of damages" faced by the Petitioner.

Petitioner has a "real interest" and "possibility of damages." To summarize:

- In December 2004, Petitioner sought to adopt and use the "Gold Standard" mark. (Seader Declaration, ¶1)
- In January 2005, Petitioner undertook and paid for a trademark clearance search to determine if the mark was clear and identified Nature's Way "The Gold Standard" as a potential bar. (Seader Declaration, ¶2,3)

- In January 2005, Petitioner undertook a substantial investigation and determined that Nature's Way's "The Gold Standing" was abandoned. (Seader Declaration, ¶6)
- At this time, Petitioner undertook preparatory work to use the mark including the design of labels, packaging, marketing and promotions. (Seader Declaration, ¶7)
- Petitioner identified and lined up a manufacturer to make its product. (Seader Declaration, ¶9)
- Petitioner authorized the preparation and filing of an intent to use application. That application stands rejected under Section 2(d) based on the very registration at issue here. (Seader Declaration, ¶8)
- Petitioner has been forced to hold up its plans pending the resolution of this matter, causing it substantial lead time and opportunities. (Seader Declaration, ¶10)

### **Argument**

#### **I. The Standing Requirements for Inter Partes are Very Liberal**

The standard applied to standing in Inter Partes trademark proceedings is extremely liberal. To establish standing in an Inter Partes proceeding, the party need only be something more than a "gratuitous interloper" or a "vicarious avenger" of some else's rights. See Golden Gate Salami Co. v. Gulf States Paper Corp., 332 F.2d 184, 141 U.S.P.Q. 661 (C.C.P.A. 1964) (opposer cannot be a "mere intermeddler"); Lipton Industries, Inc. v. Ralston Purina, Co., 670 F.2d

1024, 213 U.S.P.Q. 185 (C.C.P.A. 1982) (purpose of standing is to weed out “intermeddlers” from those with “a personal interest in the outcome beyond that of the general public”); Selva & Sons, Inc. v. Nina Footware, Inc., 705 F.2d 1316, 217 U.S.P.Q. 614 (Fed. Cir. 1983) (it is only the basis for a reasonable belief in damage that is examined); Ritchie v. Simpson, 170 F.3d 1092, 50 U.S.P.Q.2d 1023, 1035 (Fed. Cir. 1999) (“This ‘real interest’ requirement stems from a policy of preventing ‘mere intermeddlers’ who do not raise a real controversy from bringing oppositions or cancellation proceedings in the PTO.”).

A petitioner need only plead and prove “a real commercial interest in its own marks and a reasonable basis for its belief that it would be damaged.” See Cerveceria Modelo, 55 U.S.P.Q. 2d 1298, 2000 WL 827785 (Trademark Trial & App. Bd. 2000) (the PTO ex parte citation of a registration as a bar is sufficient to grant the application standing to file a petition to cancel that registration.

The issue is not whether the opposer/petitioner owns the mark or is entitled to register it, but merely whether it is likely that he would be somehow damaged if a registration were maintained. See Wilson v. Delaunay, 245 F.2d 877, 114 U.S.P.Q. 339 (C.C.P.A. 1957). As the Trademark Board has stated: “All that is necessary ... is that the ‘person’ bringing the opposition establish conditions and circumstances from which damage to it from the opposed mark can be assumed.”


Petitioner has clearly met this burden. Petitioner undertook plans to use the “Gold Standard” mark prior to the cancellation, including the creation of preliminary labels and packaging and the lining up of a manufacturer. Petitioner

filed an Intent to Use application, which has been rejected based upon the subject registration. Petitioner's business activities are being impeded based upon the existence of this rejection.

**Conclusion**

Based upon the foregoing, Petitioner has standing.

Respectfully submitted,

By:   
\_\_\_\_\_  
Scott J. Fields, Esquire  
Attorney for Petitioner,  
Smart Choice Food Sales, Ltd.

NATIONAL IP RIGHTS CENTER, LLC  
550 Township Line Road, Suite 400  
Blue Bell, PA 19422  
(610) 680-2301 extension 102  
(610) 680-2319 (facsimile)  
sfields@niprc.com

Dated: April 6, 2006

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/585224

**APPLICANT:** Smart Choice Food Sales, LTD.

**\*78585224\***

**CORRESPONDENT ADDRESS:**

NATIONAL IP RIGHTS CENTER  
NATIONAL IP RIGHTS CENTER  
550 TOWNSHIP LINE RD STE 400  
BLUE BELL, PA 19422-2726

**RETURN ADDRESS:**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**MARK:** GOLD STANDARD

**CORRESPONDENT'S REFERENCE/DOCKET NO:** 11903-1

**CORRESPONDENT EMAIL ADDRESS:**

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**OFFICE ACTION**

**RESPONSE TIME LIMIT:** TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

Serial Number 78/585224

This Office action supersedes any previous Office action issued in connection with this application.

The assigned trademark examining attorney has reviewed the referenced application and has determined the following:

**Prior Pending Application**

Information regarding pending Application Serial No. 78494118 is enclosed. The filing date of the referenced application precedes the applicant's filing date. There may be a likelihood of confusion under Trademark Act Section 2(d) between applicant's mark and the referenced mark. If the referenced application registers, registration may be refused under Section 2(d) in addition to the Section 2(d) refusal below. 37 C.F.R. §2.83; TMEP §1208.01.

Upon receipt of the applicant's response to the refusal below and to the following requirements, action on this application will be suspended pending the disposition of Application Serial No. 78494118. 37 C.F.R. §2.83(c); TMEP §§716.02(c) and 1208.02(c).

### **Likelihood of Confusion**

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 1500164 as to be likely to cause confusion, or to cause mistake, or to deceive. TMEP §§1207.01 See the enclosed registration.

A likelihood of confusion determination requires a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01.

In comparing the marks, similarity in any one of the elements of sound, appearance or meaning is sufficient to find a likelihood of confusion. In comparing the goods, it is necessary to show that they are related in some manner. *In re Mack*, 197 USPQ 755, 757 (TTAB 1977); TMEP §§1207.01.

The applicant's mark is "Gold Standard" and the applicant's goods are "vitamins, dietary herbs and minerals and nutritional dietary supplements." The registrant's mark is "The Gold Standard" and the registrant's goods are "vitamins and nutritional dietary supplements." The applicant's and the registrant's marks are essentially the same in sound, appearance and meaning except for the additional word "the" in registrant's mark, a difference that is minimal regarding the commercial impression of the two marks. The applicant's and the registrant's goods are the same or highly related in that both the applicant and the registrant offer nutritional supplements and vitamins. Thus, because the applicant's and the registrant's marks are essentially the same, and because the applicant's and the registrant's goods are the same or highly related, there is a likelihood of confusion.

Although the trademark examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration. If the applicant chooses to respond to the refusal to register, then the applicant must also respond to the following requirement.

### **Indefinite Identification of Goods**

The identification of goods is unacceptable as indefinite. Pursuant to TMEP §1402.01, the applicant may adopt the following identification, if accurate:

Class 5: Vitamins, dietary herbal and mineral supplements, and nutritional dietary supplements.

The wording "dietary herbs" in the identification of goods needs clarification because it is too broad and could include goods classified in other international classes. TMEP §§1402.01 and 1402.03. The applicant must clarify the purpose of its dietary herbs and minerals. Specifically, the "dietary herbs" must be distinguished from processed herbs in class 30 and unprocessed herbs in class 31, both of which may be for dietary use.

Please note that, while the identification of goods may be amended to clarify or limit the goods, adding to the goods or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may not amend the identification to include goods that are not within the scope of the goods set forth in the present identification.

For assistance with amending this identification of goods, the applicant may consult the searchable *Manual of Acceptable Identifications of Goods and Services* online at <http://tess2.uspto.gov/netahtml/tidm.html>.

In addition to amending the identification of goods, the applicant must also clarify the number of classes for which registration is sought. The submitted filing fees are insufficient to cover all the classes in the application. Specifically, the application identifies goods that may be classified in at least two international classes; however, the applicant paid the fee for only one class.

The applicant must either: (1) restrict the identification of goods to the number of classes covered by the fee already paid, or (2) pay the required fee for each additional class. 37 C.F.R. §2.86(a)(2); TMEP §§810.01, 1401.04, 1401.04(b) and 1403.01.

If the applicant prosecutes this application as a combined, or multiple-class application, then applicant must comply with each of the following for those goods based on an intent to use the mark in commerce under Section 1(b) of the Trademark Act of 1946, as amended:

- (1) The applicant must list the goods by international class with the classes listed in ascending numerical order. TMEP § 1403.01; and
- (2) The applicant must submit a filing fee for each international class of goods not covered by the fee already paid. 37 C.F.R. §2.86(a)(2); TMEP §§810.01 and 1403.01.

The filing fee for adding classes to an application is as follows:

- (1) \$325 per class, when the fees are submitted with a response filed online via the Trademark Electronic Application System (TEAS) at <http://www.uspto.gov/teas/index.html>; and
- (2) \$375 per class, when the fees are submitted with a paper response.

37 C.F.R. §§2.6(a)(i) and (ii); TMEP §810.

/Dayna J. Browne/

Trademark Attorney

Law Office 104

Ph: (571) 272-8361

Fax: (571) 273-9114

**HOW TO RESPOND TO THIS OFFICE ACTION:**

- **ONLINE RESPONSE:** You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://www.uspto.gov/teas/index.html> and follow the instructions, but if the Office Action has been issued via email, you must wait 72 hours after receipt of the Office Action to respond via TEAS).
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above and include the serial number, law office number and examining attorney's name in your response.

**STATUS OF APPLICATION:** To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

**VIEW APPLICATION DOCUMENTS ONLINE:** Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

**GENERAL TRADEMARK INFORMATION:** For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.**

**Print: Oct 17, 2005**

**73708732**

**TYPED DRAWING**

**Serial Number**

73708732

**Status**

CANCELLATION PENDING

**Word Mark**

THE GOLD STANDARD

**Standard Character Mark**

No

**Registration Number**

1500164

**Date Registered**

1988/08/16

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(1) TYPED DRAWING

**Owner**

NATURE'S WAY PRODUCTS, INC. CORPORATION UTAH 10 MOUNTAIN SPRINGS  
PARKWAY SPRINGVILLE UTAH 84663

**Goods/Services**

Class Status -- ACTIVE. IC 005. US 018. G & S: VITAMINS AND  
NUTRITIONAL DIETARY SUPPLEMENTS. First Use: 1988/01/25. First Use In  
Commerce: 1988/01/25.

**Filing Date**

1988/02/05

**Examining Attorney**

UNKNOWN

**Attorney of Record**

LINDA R. EGGETT

**Print: Oct 17, 2005**

**78494118**

**DESIGN MARK**

**Serial Number**

78494118

**Status**

NON-FINAL ACTION - MAILED

**Word Mark**

100% WHEY GOLD STANDARD

**Standard Character Mark**

Yes

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

Optimum Nutrition, Inc. CORPORATION ILLINOIS 600 N. Commerce Aurora  
ILLINOIS 60504

**Goods/Services**

Class Status -- ACTIVE. IC 005. US 006 018 044 046 051 052. G & S:  
Dietary supplements. First Use: 2005/04/06. First Use In Commerce:  
2005/04/06.

**Filing Date**

2004/10/04

**Examining Attorney**

PERKINS, ELLEN

# 100% Whey Gold Standard

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

In the matter of trademark Registration No.: **1,500,164**

For the mark: THE GOLD STANDARD

Date Registered: August 16, 1988

SMART CHOICE FOOD SALES, LTD., :  
: Cancellation No. 92044270  
Petitioner :  
v. :  
NATURE'S WAY PRODUCTS, INC., :  
: Registrant. :

**CERTIFICATE OF SERVICE**

**Date of Deposit: April 6, 2006**

I hereby certify that this Memorandum in Support of Petitioner's Standing and Declaration of Robert Seader is being electronically transmitted to the Trademark Trial and Appeal Board and is being transmitted by facsimile at (801) 328-1701 and first class mail to Workman Nydegger, 1000 Eagle Gate Tower, 60 East South Temple, Salt Lake City, Utah 84111 to the attention of Robyn L. Phillips, Esquire, on the date indicated above.

  
SCOTT J. FIELDS

Date: April 6, 2006

NATIONAL IP RIGHTS CENTER, LLC  
550 Township Line Road, Suite 400  
Blue Bell, PA 19422  
(610) 680-2301 – Phone  
(610) 680-2319 - Fax