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Trademark Trial and Appeal Board
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Cancellation No. 92061862

Cyanotech Corporation

v.

Nutrex Research, Inc.

Concurrent Use No. 94002616


Cyanotech Corp.

v.


Nutrex Research, Inc.

Before Zervas, Ritchie and Adlin,
Administrative Trademark Judges.

By the Board:

In the above-captioned cancellation proceeding, Cyanotech Corporation (“Cyanotech”) seeks to cancel Nutrex Research, Inc’s (“NRI”) registrations for the mark NUTREX RESEARCH in the following stylized form, , for “Dietary supplements for enhancing energy, athletic performance, physical prowess and libido, developing muscle mass, and weight loss” in International Class 5 and “Online retail store services featuring dietary supplements for enhancing energy, athletic performance, physical prowess and libido, developing muscle mass, and

weight loss” in International Class 35¹ on the ground of likelihood of confusion with its “previously used nationwide in the United States since 1991” marks NUTREX and NUTREX HAWAII for “nutritional supplements.” (emphasis added)² NRI denied the salient allegations of the petition to cancel in its answer.

In the above-captioned concurrent use proceeding, Cyanotech seeks to register the marks NUTREX and design in the following form, ³ and NUTREX HAWAII in standard characters⁴ for a variety of nutritional and dietary supplements.

¹ Registration Nos. 3870696 and 3870697, issued November 2, 2010 and alleging 2002 as the date of first use anywhere and date of first use in commerce. Each registration includes a disclaimer of RESEARCH and a statement that color is not claimed as a feature of the mark.

² Cyanotech also attempted to plead claims of fraud and abandonment; however, those claims were determined to be insufficiently pleaded in the Board’s September 30, 2016 order. 8 TTABVUE 2 n.2 & 3.

³ Application Serial No. 85423883, filed September 15, 2011, and alleging May 5, 2010 as the date of first use anywhere and date of first use in commerce. The identified goods in this application are: “Nutritional supplements for human consumption; nutraceuticals for the treatment of oxidative stress, decreased immunity, and inflammatory conditions; nutraceuticals for use as a dietary supplement; dietary supplements; nutritional supplements; nutritional additives for medical purposes for use in foods and dietary supplements for human consumption; nutritional additives for use in feed for animals for medical purposes; dietary supplements for animal consumption; food supplements; food supplements, namely, anti-oxidants; homeopathic supplements, namely, diluted doses from the plant, mineral and animal kingdoms for human consumption; drink mixes, namely, dietary drink mix for use as a meal replacement, powdered fruit-flavored dietary supplement drink mix, nutritional supplement in the nature of a nutrient-dense, protein-based drink mix” in International Class 5 (emphasis added).

⁴ Application Serial No. 85423915, filed September 15, 2011, and alleging December 6, 1990 as the date of first use anywhere and March 1, 1991 as the date of first use in commerce. The application includes a disclaimer of HAWAII. The identified goods in this application are: “Nutritional supplements for human consumption; nutraceuticals for the treatment of oxidative stress, decreased immunity, and inflammatory conditions; nutraceuticals for use as a dietary supplement; dietary supplements; nutritional supplements; nutritional additives for medical purposes for use in foods and dietary supplements for human consumption; nutritional additives for use in feed for animals for medical purposes; dietary supplements for animal consumption; food supplements; food supplements, namely, anti-oxidants;

In its applications, Cyanotech named NRI's registrations as exceptions to its asserted exclusive right to use its marks. Both applications include the following concurrent use statement:


Subject to Concurrent Use Proceeding with 3204937,⁵ 3798632, 3849395,⁶ 3870696 and 3870697. [Cyanotech] claims the exclusive right to use the mark in the area comprising the states of Alaska, Colorado, Hawaii, Idaho, Maine, Mississippi, Missouri, Montana, Nebraska, New Hampshire, New Mexico, North Dakota, Rhode Island, South Dakota, Utah, Vermont, West Virginia, Wyoming and all U.S. Territories, including without limitation, Guam, Puerto Rico and the U.S. Virgin Islands.

In a March 29, 2017 order, we, among other things, denied Cyanotech's and NRI's joint motion that the Board approve Cyanotech's involved concurrent use applications for registration based on the agreement that Cyanotech and NRI filed on June 17,

homeopathic supplements, namely, diluted doses from the plant, mineral and animal kingdoms for human consumption; drink mixes, namely, dietary drink mix for use as a meal replacement, powdered fruit-flavored dietary supplement drink mix, nutritional supplement in the nature of a nutrient-dense, protein-based drink mix" in International Class 5 (emphasis added).

⁵ Registration No. 3204937 for the mark NUTRIX in standard characters for goods in International Classes 5 and 29 was issued to Monique Loppe on February 6, 2007. This registration was cancelled on September 13, 2013. Loppe was deleted as an excepted user in the Board's September 30, 2016 order.

⁶ Registration No. 3798632 for the mark NUTREX in standard characters for goods in International Classes 1 and 5 was issued on July 15, 2009 to Nutrex nv.

Registration No. 3849395 for the mark NUTREX THE FINISHING TOUCH FOR NUTRITION and design in the following form, , for goods in International Classes 1 and 5 was issued on September 21, 2010 to Nutrex nv.

These registrations were the subjects of Cancellation No. 92061883, styled *Cyanotech Corp. v. Nutrex nv* and were cancelled on November 13, 2015, after default judgment was entered in that proceeding. Nutrex nv was deleted as an excepted user and party to the above-captioned concurrent use proceeding in the Board's March 29, 2017 order.

2016 and allowed the parties until May 27, 2017 to file a revised agreement. On May 30, 2017, the parties timely filed a revised agreement. *See* Trademark Rule 2.196.

In the revised agreement, the parties agree to: (1) amend Cyanotech's involved applications to delete the concurrent use statement therefrom (12 TTABVUE 3, paragraph 1); and (2) the registration of Cyanotech's applied for marks (12 TTABVUE 3, paragraph 2).

The amendments are noted and approved. The concurrent use statements are hereby deleted from Cyanotech's involved applications.⁷ Because Cyanotech's involved applications are no longer restricted, they are no longer properly the subjects of the above-captioned concurrent use proceeding. *See* Trademark Act Section 2(d), 15 U.S.C. § 1052(d); *Chichi's, Inc. v. Chi-Chi's, Inc.*, 222 USPQ 831, 832 (Comm'r 1984) (Commissioner has no power to order the commencement of a concurrent use proceeding absent a concurrent use application). Accordingly, the above-captioned concurrent use proceeding is dissolved.

Nonetheless, we point out that Cyanotech only amended its involved applications to seek concurrent use registrations after those applications were refused unrestricted registrations under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on NRI's registrations and now-cancelled Registration Nos. 3204937, 3798632, and 3849395. Inasmuch as Cyanotech's applications again seek unrestricted

⁷ Because Cyanotech has deleted the concurrent use statements from its applications, those applications may be republished for opposition. *See* TMEP § 1505.03(a) (October 2017).

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registrations, we hereby remand those applications to the examining attorney for consideration of the parties' concurrent use agreement. *See* Trademark Rule 2.131.

The cancellation proceeding is hereby suspended pending abandonment of, or issuance of a registration from, Cyanotech's involved applications.