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

Proceeding	92066320
Party	Plaintiff Fitness Labs Nutrition Corporation
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Submission	Request for Reconsideration of Non-Final Board Order
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Registration No. 4,286,987

Mark: GERMAN CREATINE

Owner: Research Sports Nutrition, LLC; Nutrition Distribution, LLC

Fitness Labs Nutrition Corporation, a California Corporation, Petitioner, v. Research Sports Nutrition, LLC, an Arizona Limited Liability Company, and Nutrition Distribution, LLC, an Arizona Limited Liability Company Registrant.	Cancellation No. 92066320

PETITIONER FITNESS LABS NUTRITION CORPORATION'S MOTION FOR RECONSIDERATION OF THE BOARD'S SUMMARY JUDGMENT RULING

Pursuant to 37 C.F.R. § 2.127(b) and T.B.M.P. § 518, Petitioner Fitness Labs Nutrition Corporation ("FLN" or Petitioner"), by its attorneys, hereby moves for reconsideration[1] of the Board's ruling of March 21, 2019 (TTABVue 33, the "Ruling") denying in part Petitioner's motion for summary judgment to cancel United States Trademark Registration No. 4,286,987 ("the '987 Registration") on the Supplemental Register, owned by Nutrition Distribution, LLC and formerly owned by Research Sports Nutrition, LLC (collectively, "RSN" or "Registrant").

In footnote 11 of the Ruling, the Board stated:

> Petitioner, relying on *Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987), asserts that it need only show prior use to prevail. However, the Federal Circuit in *Towers* referred to the relied-upon passage as "dictum" and affirmed the *Otto Roth* rule, *i.e.*, that a plaintiff alleging likelihood of confusion must establish proprietary rights in its pleaded mark, even against a registration on the Supplemental Register. *Towers*, 16 USPQ2d at 1042.

ISSUE PRESENTED

In the case of a cancellation proceeding pertaining to a mark registered on the Supplemental Register, does a petitioner need to prove acquired distinctiveness if the petitioner has priority of use and the registrant has not acquired distinctiveness?

[1] While Petitioner disagrees with certain factual determinations of the Board in the Ruling, such as those regarding acquired distinctiveness, Petitioner does not in this motion address those issues. Instead, Petitioner requests that the Board reconsider the legal question of the Issue Presented. Petitioner maintains that it has acquired distinctiveness and that Registrant waived any argument regarding distinctiveness, and reserves the right to appeal and/or reargue these and other portions of the Ruling. In any event, Petitioner's summary judgment motion should be granted in full because the ultimate result in this case is the same no matter what the Board finds regarding acquired distinctiveness—either Petitioner has priority of acquired distinctiveness, or *arguendo* even if neither party has acquired distinctiveness, then Petitioner has priority of use. *See* TTABVue 18 at 12-18. In other words, should the Board decide in Petitioner's favor on the Issue Presented, then that result necessarily dictates an entry of summary judgment in Petitioner's favor even without analysis of the acquired distinctiveness issue. *Id.*

ARGUMENT

Petitioner respectfully disagrees with the Board's statement in footnote 11 of the Ruling, and requests that the Board reconsider. The Federal Circuit in *Books on Tape, Inc. v. Booktape Corp.*, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987) ("*Books on Tape*") stated that "[t]he statute does not require the anomalous result that a junior user is entitled to keep its Supplemental Registration for a descriptive term in which it has not established secondary meaning (as evidenced by registration on the Supplemental Register) because a *prior* user cannot show secondary meaning in that term either" (emphasis in original). The Board has nonetheless cited *Towers v. Advent Software, Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1042 (Fed Cir. 1990) ("*Towers*") for the proposition that "a plaintiff alleging likelihood of confusion must establish proprietary rights in its pleaded mark, even against a registration on the Supplemental Register." Ruling at 9, n. 11.

"However, *Books on Tape* was not and could not have been overruled by the *Towers* panel because *Towers* was not an *en banc* decision, the situation in this case is on all fours with that in *Books on Tape* (but not *Towers*, in which, as in *Otto Roth*, the plaintiff asserted use of a descriptive term against a registration on the Principal Register) and it is not just the 'dicta' but the ultimate result in *Books on Tape* which compels a similar result here." *Jeffrey Feulner, P.A. v. Cordell Practice Mgmt. Grp., LLC*, Canc. No. 92056202, TTABVue 41 at 12 (TTAB Oct. 26, 2015) ("*Feulner*") (non-precedential).[2] The Board in *Feulner*—less than four years ago—explicitly stated that "it would be an anomalous result if [Registrant] was permitted to keep its Supplemental Register registration . . . in the face of Petitioner's prior use. As in *Books on Tape*, Petitioner in this case need not establish secondary meaning in [the term at issue]." *Id.*

[2] While "[a] decision that is not designated as precedential is not binding on the Board, but may be cited for whatever persuasive value it might have." TBMP § 801.03.

Additionally, the Board again followed *Books on Tape* in 2017. In *Theatrical Stage Employees*, the Board ruled that a petitioner "need not wait until it has acquired distinctiveness in its mark before seeking to clear away the impediment" of a later user's Supplemental Register registration. *Theatrical Stage Employees Union Local No. 2 of the International Alliance of Theatrical Stage Employees and Moving Picture Technicians, Artists and Allied Crafts of the United States and Canada v. David B. Eaves*, 2017 TTAB LEXIS 54 at *11-13, Canc. No. 92055242, TTABVue 117 at 9 (non-precedential).

The Board's previous rulings make clear that absent a showing of acquired distinctiveness by either party, a petition to cancel should be granted where the petitioner is the first user (as is the case here). The Ruling, on the other hand, directly contradicts the Board's previous rulings on the exact same issue. Registrant itself has argued for the consistent application of federal law (TTABVue 24 at 17-19), and consistency on the Issue Presented is needed. Petitioner therefore respectfully submits that the Board should withdraw its ruling on that issue, and should instead follow the Federal Circuit's guidance from *Books on Tape*.

CONCLUSION

For the foregoing reasons, Petitioner submits that good grounds exist for reversing footnote 11 of the Ruling, and such action is hereby requested. Petitioner further submits that such a reversal necessarily results in summary judgment being granted to Petitioner, and as such also requests such an entry of judgment.

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Respectfully submitted,

FERGUSON CASE ORR PATERSON LLP

April 20, 2019 By: /Corey A. Donaldson/
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CERTIFICATE OF ESTTA FILING

I, Corey A. Donaldson, hereby certify that on April 20, 2019, this motion with supporting memorandum is being electronically filed with the U.S. Patent and Trademark Office Trademark Trial and Appeal Board, PO Box 1451, Alexandria, VA 22313, via ESTTA.

/Corey A. Donaldson/
COREY A. DONALDSON
Attorney for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **PETITIONER FITNESS LABS NUTRITION CORPORATION'S MOTION FOR RECONSIDERATION OF A PORTION OF THE BOARD'S SUMMARY JUDGMENT RULING** has been served on Tauler Smith LLP, counsel for Registrant Research Sports Nutrition, LLC, by email on April 20, 2019, to:

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