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

Proceeding	85284093
Applicant	Zico Beverage LLC
Applied for Mark	NATURALLY POWERED
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Submission	Applicants Request for Remand and Amendment
Attachments	Request for Remand.pdf (5 pages)(23074 bytes) Exhibit A.pdf (17 pages)(88477 bytes) Exhibit B.pdf (157 pages)(4318924 bytes) Exhibit C.pdf (37 pages)(859304 bytes) Exhibit D.pdf (8 pages)(211686 bytes)
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Date	07/10/2012

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

In re Application of	:	
	:	
Zico Beverages LLC	:	
	:	Law Office 114
Filed: April 1, 2011	:	
	:	Shaila E. Lewis
Serial No.: 85/284,093	:	Examining Attorney
	:	
Mark: NATURALLY POWERED	:	
	:	
Attorney Docket No.: 0073873-024	:	

REQUEST TO REMAND FOR ADDITIONAL EVIDENCE

Pursuant to Section 1207.02 of the Trademark Trial and Appeal Board Manual of Procedure (TBMP), and 37 C.F.R. § 2.142(d), Applicant requests that the Board suspend this appeal and remand the case to the examining attorney for consideration of Exhibits A – D submitted herewith.

I. Grounds for Request

The issue is whether the examining attorney has in requiring Applicant to disclaim the word “NATURALLY” as a condition to registration of “NATURALLY POWERED” in connection with coconut water in International Class 32. The purpose of this request is to supplement the record with 134 third-party registrations for trademarks and service marks containing the word “NATURALLY,” not previously cited by Applicant, that have been issued by the U.S. Patent and Trademark Office for food and beverage products with no requirement for disclaimer of the word “NATURALLY.”

As grounds for this request Applicant submits that the examining attorney, in a final action dated January 17, 2012, erroneously misled Applicant to believe that the disclaimer requirement could be overcome by the submission of USPTO records for twenty (20) third-party

registrations and applications previously cited by Applicant under representation by prior counsel. Applicant, represented by new counsel, filed a motion for reconsideration on April 16, 2012. However, in reliance on the examining attorney's statements in the office action dated January 17, 2012, Applicant's motion for reconsideration was accompanied only by records for the twenty previously cited applications and registrations, whereas in reality the number of relevant registrations (not including applications) is at least 150, as illustrated in the chart appended hereto as Exhibit A and documented in the PTO records submitted collectively as Exhibit B.

II. The January 17, 2012, Office Action

In the January 17, 2012, office action, the examining attorney stated:

Applicant argues that several registrations have been allowed that contain the word "NATURALLY" with no disclaimer, and in support of this argument, applicant has provides a list of registrations. The mere submission of a list of registrations or a copy of a private company search report does not make such registrations part of the record. *In re Promo Ink*, 78 USPQ2d 1301, 1304 (TTAB 2006); TBMP §1208.02; TMEP §710.03.

To make third-party registrations part of the record, an applicant must submit copies of the actual registrations or printouts of the registrations from the USPTO's database. *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002); *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 n.2 (TTAB 1998); TBMP §1208.02; TMEP §710.03.

Applicant interpreted the language quoted above as a requirement for submission of "copies of the actual registrations or printouts of the registrations from the USPTO's database." In reliance on that representation, Applicant considered it reasonable and acceptable to comply with the examining attorney's directive and otherwise to refrain from the comprehensive compilation and submission of the additional third-party registrations illustrated in the exhibits hereto.

II. Argument

Section 1207.02 of the TBMP states:

If an applicant or examining attorney wishes to introduce additional evidence after an appeal has been filed, the applicant or examining attorney may file a written request with the Board to suspend the appeal and remand the application for further examination. . . . [T]he request must include a showing of good cause therefor (which may take the form of a satisfactory explanation as to why the evidence was not filed prior to appeal), and be accompanied by the additional evidence sought to be introduced.

TBMP § 1207.02.

Examples of circumstances that have been found to constitute good cause for a remand for additional evidence include a change of counsel. *See* TBMP § 1207.02(1), *id.* In the present case, undersigned counsel assumed responsibility for this application in March 2012, prior to submission of the motion for reconsideration on April 16, 2012. However, if Applicant had been represented by undersigned counsel at the time of the December 2011 office action response, the issue would not have arisen. because that office action response would have been accompanied by the twenty (20) third-party registrations and applications cited in the response.

The issue is whether it was reasonable for Applicant to interpret the statement of the examining attorney in the office action dated January 17, 2012, regarding the absence of USPTO records for the cited registrations and applications, to conclude that the submission of such records would overcome the disclaimer requirement. The Board has held that an applicant's reasonable reliance on an examining attorney's statements may constitute grounds for reversal of a refusal to register. *See In re Donnay International*, 31 USPQ2d 1953, n. 5 (TTAB 1994)(reversing refusal to register where examining attorney rejected consent agreement after leading applicant to believe that such agreement would overcome the refusal). It follows that such reliance must also constitute good cause to suspend this appeal and to remand the case for an opportunity to consider the additional evidence submitted with this request.

The disclaimer issue is of vital importance to Applicant because of the intense competition and proliferation of new brands in the market for coconut water and coconut-related beverages. The dynamics of this burgeoning industry are reflected in the list appended hereto as Exhibit C, compiled from TESS records, illustrating more than a thousand applications and registrations for marks involving coconut related products in International Class 32, of which the substantial majority were filed in the relatively recent past. *See, e.g.*, NATURALLY UNTOUCHED, U.S. Application Serial No. 85514009, filed January 11, 2012, for “coconut water” in International Class 32 (no disclaimer requirement to date)(PTO records of application appended hereto as Exhibit D). Adherence to the disclaimer requirement could have a prejudicial impact on Applicant’s ability to defend its mark in this environment. As such the discriminatory imposition of this requirement on Applicant would be erroneous and should be withdrawn.

IV. Conclusion

The final action dated January 17, 2012, leaves the clear impression that submission of PTO records for the twenty (20) third-party registrations and applications cited by Applicant’s prior counsel would overcome the disclaimer requirement. Accordingly it was reasonable for Applicant to submit those records with its motion for reconsideration dated April 16, 2012, and otherwise to refrain from the comprehensive compilation and submission of third-party registrations illustrated in the exhibits hereto. Applicant’s reasonable reliance on the examining

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