

ESTTA Tracking number: **ESTTA785112**

Filing date: **11/23/2016**

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

Proceeding	92064526
Party	Plaintiff Wellnext LLC
Correspondence Address	ANTHONY ROBINSON 1301 SAWGRASS CORPORATE PARKWAY SUNRISE, FL 33323 UNITED STATES trademarks@naturesproducts.com, anthonyr@wellnexthealth.com
Submission	Opposition/Response to Motion
Filer's Name	Anthony Robinson
Filer's e-mail	anthonyr@wellnexthealth.com
Signature	/Anthony Robinson/
Date	11/23/2016
Attachments	Response to Motion to Suspend - 11-23-16.pdf(5309779 bytes)

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

Wellnext LLC,

Petitioner,

vs.

Wellnx Life Sciences Inc.

Registrant.

For the marks WELLNX and WELLNX
LIFE SCIENCES

Cancellation No. 92064526

RESPONSE TO MOTION TO SUSPEND

On September 26, 2016, Petitioner filed a petition for cancellation against Registration Nos. 3733444 and 3683450, WELLNX and WELLNX LIFE SCIENCES (the “Marks”), for abandonment. Registrant is warehousing the Marks in violation of well-established regulations and laws. Petitioner did not base its cancellation action on the likelihood of confusion between the Marks and any trademarks or service marks owned by Petitioner, as the Marks have been registered for more than five (5) years and have achieved incontestability. The issue presented in the instant cancellation action is whether Registrant deliberately ceases to use the trademark for three or more years, with no intention of using the trademark again in the future. Issues related to trademark infringement are not relevant to the abandonment inquiry or analysis.

On November 1, 2016, Registrant sued Petitioner in federal court for trademark infringement (the “Trademark Infringement Litigation”).¹ In the Trademark Infringement Litigation, Registrant asserts the following causes of action:

- Infringement of Registered Trademark.
- False Designation, Passing Off & Unfair Competition.
- Tradename Infringement under the Lanham Act and Delaware State Law.
- Violation of Delaware Consumer Fraud Act.
- Violation of Delaware Uniform Deceptive Trade Practices Act.

¹ *Wellnx Life Sciences Inc. v. Wellnext LLC*, Civil Action No. 1:16-cv-01016-UNA (D. Del. November 1, 2016). A copy of the Complaint is attached hereto as Exhibit A.

On November 10, 2016, Registrant filed the Motion to Suspend on the grounds that “the litigation involves issues and claims in common” with the instant cancellation proceeding. The relevant rule of procedure of the Board, codified in 37 CFR § 2.117, provides that “[w]henver it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding **which may have a bearing on the case**, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding. (Emphasis added.)

Given that the causes of action in the Trademark Infringement Litigation do not involve the same legal issues that are before the Board in the instant cancellation proceeding, it follows that the Trademark Infringement Litigation will have no bearing on the instant cancellation proceeding. Even in the event that Registrant succeeds in the Trademark Infringement Litigation, Petitioner will still have a viable claim for cancellation based on abandonment.

For example, the cancellation proceeding is related to the fact that Registrant does not use the Marks as part of an ongoing program to exploit the products it owns commercially. Rather the house marks SLIMQUICK[®] and NAUTURE’S SCIENCE[®] are the marks that are exploited commercially. The use of the Marks has not been “bona fide” and it is apparent from Registrant’s specimens that no customer could plausibly be deemed to depend upon the Marks to identify the source of the products. The Marks could not have contributed significantly to the revenue generated by the sales of Registrant’s products bearing the house marks SLIMQUICK[®] and NAUTURE’S SCIENCE[®] (i.e., Lose 3x, Garcinia Cambogia, Green Coffee Bean, Raspberry Ketone) because of the very limited placement on the Marks on the side and bottom panels of packaging where information about manufacturers, distributors, and packagers are customarily provided. While the quantity, scope, or degree of use must necessarily be considered, qualitative factors are the focus of the legal analyses of abandonment. Mere sales of a product featuring a mark are of no avail in an effort to prove continued “use” of a mark in the sense of § 1227 of the Lanham Act absent a bona fide intent to commercially exploit the mark, even if said use is continuous, not sporadic, and amount to hundreds of unit sales annually. Registrant’s specimens evidence a deliberate marketing strategy to generate revenue by commercially exploiting its house marks SLIMQUICK[®] and NAUTURE’S SCIENCE[®] not, the Marks. Registrant’s deliberate decision to place the Marks on the side panel in small font where they are entirely dominated by Registrant’s house marks SLIMQUICK[®] and NAUTURE’S SCIENCE[®] with respect to prominence and frequency of display is not consistent with a bona fide intent to

commercially exploit the Marks. Bona fide use is required to avoid abandonment. Rather, it is apparent from the quality of Registrant's use of the Marks that its primary objective is trademark maintenance and to prevent others from using the Marks.

None of these issues of abandonment will be litigated in the Trademark Infringement Litigation. Moreover, even if Registrant prevails on its trademark infringement claims in the Trademark Infringement Litigation, Petitioner will still have standing to petition for abandonment of the Marks. Accordingly, the Trademark Infringement Litigation will have no bearing on the instant cancellation proceeding.

For the above-stated reasons, Wellnext LLC respectfully requests that the Board deny Registrant's Motion to Suspend.

Respectfully submitted,

Date: November 23, 2016

/s/ Anthony Robinson
Anthony Robinson
General Counsel
Wellnext LLC
1301 Sawgrass Corporate Parkway
Sunrise, Florida 33323
Telephone (954) 233-3300 x1235
Email: anthonyr@wellnexthealth.com

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Response to Motion to Suspend was served by First Class Mail, with sufficient postage prepaid, on the 23rd day of November, 2016, upon Registrant's attorney,

William C. Wright
Epstein Drangel LLP
60 East 42nd Street, Suite 2520
New York, NY 10165
wwright@ipcounselors.com
Office: 212/292-5390

/s/ Anthony Robinson
Anthony Robinson
General Counsel
Wellnext LLC
1301 Sawgrass Corporate Parkway
Sunrise, Florida 33323
Telephone (954) 233-3300 x1235
Email: anthonyr@wellnexthealth.com

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.