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Filing date: **10/04/2018**

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

Proceeding	92067089
Party	Plaintiff Ultimate Nutrition, Inc.
Correspondence Address	WILLIAM C WRIGHT EPSTEIN DRANGEL LLP ONE GRAND CENTRAL PLACE, 60 EAST 42ND STREET SUITE 2520 NEW YORK, NY 10165 UNITED STATES mail@ipcounselors.com 212-292-5390
Submission	Other Motions/Papers
Filer's Name	William C. Wright
Filer's email	mail@ipcounselors.com
Signature	/William C. Wright/
Date	10/04/2018
Attachments	Motion to Amend Remand and Suspend Executed.pdf(1817825 bytes)

William C. Wright
EPSTEIN DRANGEL LLP
60 East 42nd Street, Suite 2520
New York, NY 10165
Tel: 212-292-5390
Fax: 212-292-5391
E-Mail: mail@ipcounselors.com
Attorney for Petitioner

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

Ultimate Nutrition, Inc.,
Petitioner

v.

Dynamic Nutrition & Athletics, L.L.C.,
Registrant

Cancellation No. 92067089

JOINT MOTION TO AMEND APPLICATION, REQUEST FOR REMAND and
JOINT MOTION TO SUSPEND

Petitioner and Registrant have entered into the enclosed Coexistence Agreement (hereinafter, "Agreement").

As per the terms of the Agreement, Petitioner, with Registrant's consent, hereby amends its Class 05 description of goods for its U.S. Trademark Application Serial No. 87308611 to read as follows: "*pre-workout dietary supplements; dietary supplements for testosterone and libido enhancement*".

Petitioner hereby requests that the Trademark Trial and Appeal Board restore jurisdiction to the USPTO Examining Attorney for review of the Agreement and subsequent approval of U.S. Trademark Application Ser. No. 87308611.

Petitioner and Registrant hereby jointly request that the present cancellation action be suspended, pending the USPTO Examining Attorney's approval of U.S. Trademark Application Ser. No. 87308611.

Dated: 10/04/2018

EPSTEIN DRANGEL LLP
Attorneys for Petitioner

BY: 

William C. Wright
60 East 42nd Street, Suite 2520
New York, NY 10165
Telephone: 212-292-5390
E-Mail: mail@ipcounselors.com

Dated: 10/03/2018

LEXERO LAW
Attorneys for Registrant

BY: 


Eric Menhart
316 F Street NE, Suite 101
Washington, DC 20002
Telephone: 855-453-9376
E-Mail: eric.menhart@lexero.com

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing JOINT MOTION TO AMEND APPLICATION, REQUEST FOR REMAND and JOINT MOTION TO SUSPEND was served by e-mail on this 4th day of October, 2018 upon Registrant’s counsel at the following address:

Eric Menhart
Lexero Law
316 F Street NE, Suite 101
Washington, DC 20002
Telephone: 855-453-9376
E-Mail: eric.menhart@lexero.com

Dated: 10/4/18

BY: 
Annmary Ittan
60 East 42nd Street, Suite 2520
New York, New York 10165
Telephone: 212-292 5390
Facsimile: 212-292-5391
E-Mail: mail@ipcounselors.com
Attorney for Petitioner

AGREEMENT

This Agreement is entered into this 26th day of September, 2018 (“Effective Date”), between the Parties, Dynamic Nutrition & Athletics L.L.C., a corporation organized and existing under the laws of Missouri, and doing business at 4910 S. Jewell Avenue, Springfield, Missouri 65810 (“DYNAMIC”), and Ultimate Nutrition Inc., a corporation organized and existing under the laws of Connecticut, and doing business at 21 Hyde Road, Farmington, Connecticut 06034 (“ULTIMATE”), (wherein, DYNAMIC and ULTIMATE are hereinafter collectively referred to as the “Parties” and individually referred to as a “Party.”).

RECITALS

A. DYNAMIC is the registered owner of US Trademark Registration No. 3093105 for the word JACKED! (the “DYNAMIC Mark”) for the following goods: *dietary supplement[s] for boosting energy and burning fat* (the “DYNAMIC Goods”).

B. On January 20, 2017, ULTIMATE filed with the United States Patent and Trademark Office a Trademark Application under Section 1(b), for the word JACKT, Serial No. 87308611, (the “ULTIMATE Mark”), for the following goods: *dietary supplements* (the “ULTIMATE Goods”).

C. On April 24, 2017, the Examining Attorney assigned to the U.S. Application to register the ULTIMATE Mark issued a Non-Final Office Action, refusing registration of the ULTIMATE Mark under Trademark Act Section 2(d) based on the DYNAMIC Mark.

D. On October 10, 2017, ULTIMATE filed a Petition to Cancel the DYNAMIC Mark seeking cancellation of the DYNAMIC Mark based on abandonment, Cancellation Proceeding No. 92067089 (the “Cancellation Proceeding”).

E. On November 24, 2017, DYNAMIC answered the Petition denying the salient allegations.

F. The Parties wish to resolve any dispute that may exist between the Parties' marks which are the subject of this Agreement and respective rights thereof, so that ULTIMATE may be able to both use and register the ULTIMATE Mark.

G. The parties have peacefully co-existed in the marketplace for some time, during which time there has been no known evidence of any confusion between the Parties' marks which are the subject of this Agreement.

IN CONSIDERATION of the foregoing expressed and mutual recitals contained herein, the Parties agree as follows:

1. The Parties incorporate the above paragraphs as if fully set forth herein.
2. ULTIMATE agrees to use and register the ULTIMATE Mark only for pre-workout dietary supplements; dietary supplements for testosterone and libido enhancement ("Amended Goods")
3. Within five (5) business days from the Effective Date, ULTIMATE, with DYNAMIC's consent, shall file with the TTAB: a) an amendment to the application to register the ULTIMATE Mark to the Amended Goods; b) a request that the TTAB restore jurisdiction to the Examining Attorney so that the Examining Attorney can consider this Agreement and withdraw the DYNAMIC Mark as a bar to the application to register the ULTIMATE Mark; and c) a request to suspend action on the Cancellation Proceeding, pending the Examining Attorney withdrawing the DYNAMIC Mark as a bar to the application to register the ULTIMATE Mark.
4. In the event that the Examining Attorney does not withdraw the DYNAMIC Mark as a bar to the application to register the ULTIMATE Mark, the parties will work together and

amend this Agreement to ensure that the Examining Attorney does in fact withdraw the DYNAMIC Mark as a bar to registering the application to register the ULTIMATE Mark.

5. Within five (5) business days of the Examining Attorney withdrawing the DYNAMIC Mark as a bar to the application to register the ULTIMATE Mark, ULTIMATE, with DYNAMIC's consent, will withdraw, without prejudice, the Cancellation Proceeding.

6. The Parties believe, given the differences between the marks, the differences between the channels of trade for the goods in question, and the differences between the DYNAMIC Goods on the one hand and the Amended Goods on the other, that the ULTIMATE Mark for the Amended Goods is not likely to be confused with the DYNAMIC Mark for the DYNAMIC Goods.

7. DYNAMIC consents to the use and registration of the ULTIMATE Mark for the Amended Goods and agrees not to oppose, cancel, challenge, object, or interfere with ULTIMATE's use and registration of the ULTIMATE Mark for the Amended Goods.

8. ULTIMATE agrees it will not challenge any registration or oppose any application for the DYNAMIC Mark for the DYNAMIC Goods owned by DYNAMIC. ULTIMATE further agrees that its channels of trade for the DYNAMIC Mark are exclusively those that focus on athletes who depend on dietary supplements specifically formulated for pre-workout use to improve muscle-building results, increase testosterone, and enhance libido.

9. The respective marks which are the subject of this Agreement owned by the respective parties have co-existed in the marketplace without any actual confusion. In the unlikely event that actual confusion between said marks does however arise, the Parties agree to use best efforts to resolve any such actual confusion in the marketplace.

10. Any notice or other communication given pursuant to this Agreement shall be in writing by e-mail and postal mail, and shall be deemed to have been given on the earlier of (1) receipt or (2) five days after notice was sent to the receiving party at the following addresses,

To William C Wright
ULTIMATE: Epstein Drangel LLP
One Grand Central P Lacc,
60 East 42nd Street Suite 2520
New York, Ny 10165
mail@ipcounselors.com

To Eric Menhart
DYNAMIC: Lexero Law
316 F Street Ne, Ste 101
Washington, DC 20002
Eric.Menhart@Lexero.com

11. Should the Parties ever change the contact details in anyway with regards to the above notice provisions, the entry of same will be accepted upon acknowledgement by the other party in any written form of communication.

12. The failure of either party to enforce any provision of this Agreement shall not be construed as a waiver of such provision or waiver of the right of either party to thereafter enforce such provision.

13. The benefits and obligations resulting from the Agreement shall run with the ownership of the goodwill associated with the use and registration of the respective trademarks. This Agreement shall be binding on the assigns, successors in interest and subsidiaries, direct or indirect, of both Parties.

14. This Agreement may not be amended except by a writing signed by the Parties hereto. There are no understandings, Agreements or representations, express or implied, not otherwise specified herein. Each Party shall reserve their rights with respect to anything not covered by this Agreement.

15. Should any provision of this Agreement be invalid or unenforceable or should the Agreement contain an omission, the remaining provisions of this Agreement shall be valid. In the place of an invalid provision, a valid provision, which comes economically closest to the one actually agreed upon, is presumed to be agreed upon by the parties; the same shall apply in the case of an omission.

16. Nothing in this Agreement shall prevent either of the Parties from enforcing the terms set forth in this Agreement as of the Effective Date.

17. The Parties understand and intend to be bound by the terms of this Agreement. The Parties, provided it is commercially reasonable to do so, will use their best efforts to try and amicably resolve any breach of this Agreement outside of the judiciary.

18. This Agreement may be executed by the Parties in counterparts, each of which, when executed, shall be deemed an original and shall together constitute a single document. Faxed or scanned copies shall be deemed as originals.

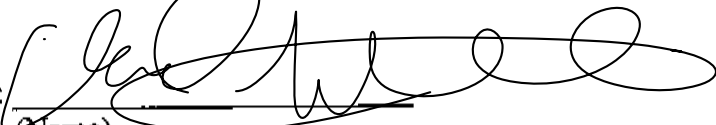
19. Neither Party may assign this Agreement without the express written consent of the other Party and the assignee's express written consent to assume all obligations and abide by all restrictions herein. Any assignment in contravention of this section shall be void.

20. The Parties agree that, should the need arise, this Agreement can be submitted to the United States Patent and Trademark Office and/or the Trademark Trial and Appeal Board.

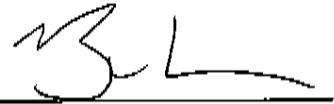
IN WITNESS WHEREOF, the Parties hereto have caused this Agreement to be executed on the date first written above.

[Signatures on Following Page]

DYNAMIC NUTRITION & ATHLETICS L.L.C.

By: 
(Name)
Title: President

ULTIMATE NUTRITION INC.

By: 
(Name) BRIAN RUBINO
Title: President