

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tupperware Products S.A.
Serial No.: 78/204,585
Filed: January 17, 2003
Mark: NUTRI-RICH
Our Ref: TUPP 0801509
Zhaleh Delaney
Examining Attorney
Law Office 116

REQUEST FOR RECONSIDERATION



02-25-2008

NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

U.S. Patent & TM Office Mail Report Form #39

This is in response to the final refusal to register the NUTRI-RICH mark dated August 27, 2007.

AMENDMENTS

Please amend the mark to read as follows: NUTRI-RICH OIL.

Please enter the following disclaimer: No claim is made to the exclusive right to use of the word OIL apart from the mark as shown.

Please enter the following claim of ownership: Applicant is the owner of U.S. Registration No. 2741331.

REMARKS

The specimen originally submitted with the application depicts the mark as NUTRI-RICH OIL (see Exhibit A). A substitute drawing is attached (see Exhibit B). Applicant seeks amendment of the mark to reflect the current manner of use. TMEP § 807.14. This amendment

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Rachel L. Barmack (Printed name of person mailing paper or fee)
Rachel L. Barmack (Signature)
February 21, 2008 (Date of Signature)

does not create a material alteration. TMEP § 807.14(a). The addition of the generic word OIL would not require a new search, and does not alter the commercial impression created by the mark. Also, this mark reflects the manner of use in which the mark was previously registered by the Applicant's predecessor-in-interest, in Reg. No. 1131128. Accordingly, the amendment of the mark is permissible.

Applicant is the owner of the registered mark NUTRI-RICHE for skin care products, Reg. No. 2741331. The Examining Attorney has refused registration on the basis of Registration No. 2741331; however, this registration is owned by the Applicant, and was assigned to the Applicant by an assignment recorded on December 5, 2006 at Reel 3438, Frame 0666. As such, the refusal to register based on this mark should be withdrawn.

The Examining Attorney has made final the refusal to register on the basis of Registration No. 2264121 for the mark NUTRI-RICH by Nutri-Rich International. This registration covers the following goods: "nutritional supplements which contain lecithin, lecithin granules, vitamin E, liquid calcium, cod liver oil, ginseng, shark liver oil, shark cartilage, royal jelly, anti-oxidant, ginkgo, melatonin, natural beta carotene, water soluble vitamin E, placenta, wheat germ oil, dhea, and dicby." When the owner of this registration, Nutri-Rich International, filed its application, it received a blocking citation to the Applicant's previously registered mark, NUTRI-RICH OIL, Registration No. 1131128. Nutri-Rich International argued strenuously and persuasively that there would be no likelihood of confusion on the basis that the parties' products are sold in different forms (creams versus pills) for different usages (skin care and beauty versus nutritional supplementation) through totally different channels of trade (beauty products section versus supplements section of stores). In support of its position, Nutri-Rich International supplied 29 affidavits from customers or suppliers attesting that there would be no likelihood of confusion between the NUTRI-RICH mark for nutritional supplements and the NUTRI-RICH

OIL mark for skin care products. This evidence was made of record with the Applicant's December 22, 2003 Response to Office Action.

Although the Trademark Office is not bound by the "prior mistakes" of other Examiners, the PTO has agreed with the cited registrant that there would be no likelihood of confusion by permitting the cited registrant's mark to register over the prior registration of the Applicant for the mark NUTRI-RICH OIL for skin care products. Moreover, the mark NUTRI-RICHE was registered in 2003 for skin care products and is now owned by the Applicant. The mark NUTRI-RICHE is essentially identical to the Applicant's mark herein, NUTRI-RICH, and covers the same type of product. As such, there could be no prejudice in allowing the mark NUTRI-RICH (or NUTRI-RICH OIL, with OIL disclaimed) to register since the NUTRI-RICHE mark is already registered and stands in the name of the Applicant.

Lastly, considerable weight must be given to the statements of record by the cited registrant, which are tantamount to a coexistence agreement. The arguments filed in support of its own application by Nutri-Rich International indicate that it has no objection to the use or registration of the NUTRI-RICH OIL mark by Applicant. The arguments specify that the products are different, they are sold through different trade outlets to different types of customers for different uses. Also, the products have been coexisting in the marketplace for over a decade with not a single instance of confusion ever coming to the attention of either of the parties. Based upon these significant differences, the parties believe that the marks can continue to coexist without any confusion. As the court stated in In re N.A.D., Inc., 224 U.S.P.Q. 969, 971 (Fed. Cir. 1985), quoting from In re E.I. duPont de Nemours & Co., 177 U.S.P.Q. 563, 568 (CCPA 1973), "a mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not."

In view of the compelling facts set forth in the arguments posed by the cited registrant, and considering that the Applicant already owns a registration for the essentially identical mark

NUTRI-RICHE for skin care products, it is respectfully submitted that the refusal to register under Section 2(d) be withdrawn, and that the mark be allowed for publication.

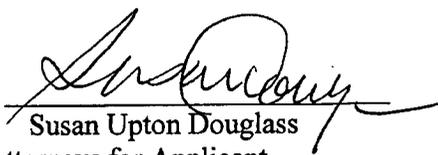
A Notice of Appeal is being filed today to preserve the Applicant's right to appeal, should the Request for Reconsideration not be granted.

Dated: February 21, 2008  
New York, New York

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU,  
P.C.

By:



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# Exhibit A

# Exhibit B

## DRAWING PAGE

Applicant: Tupperware Products S.A.  
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Class: 3  
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