

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85303239
LAW OFFICE ASSIGNED	LAW OFFICE 115
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The only issue remaining in this application is the perceived likelihood of confusion between Applicant's mark and those in the cited blocking registrations.</p> <p>Applicant is in the process of obtaining the signature of the owner of the cited registrations on the consent agreement included herewith as Exhibit 1. Applicant anticipates having the fully executed agreement in hand next week. Accordingly, Applicant respectfully requests that the examining attorney exercise the discretion given to him under 37 C.F.R. 2.65(b) to allow Applicant an extra 30 days to perfect this response. This will save the resources of both the Applicant and the Office and will implement the desires of the parties most directly affected.</p>	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	<u>evi_6620812229-100219610_ex_1_morinaga.pdf</u>
CONVERTED PDF FILE(S) (4 pages)	<u>\\TICRS\EXPORT16\IMAGEOUT16\853\032\85303239\xml1\RFR0002.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT16\853\032\85303239\xml1\RFR0003.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT16\853\032\85303239\xml1\RFR0004.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT16\853\032\85303239\xml1\RFR0005.JPG</u>
DESCRIPTION OF EVIDENCE FILE	the consent agreement between Applicant and the owner of the cited blocking registrations
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Keith Barritt/
SIGNATORY'S NAME	Keith Barritt
SIGNATORY'S	attorney of record, Virginia bar member

POSITION	
SIGNATORY'S PHONE NUMBER	202-783-5070
DATE SIGNED	08/10/2012
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Aug 10 10:25:21 EDT 2012
TEAS STAMP	USPTO/RFR-66.208.12.229-2 0120810102521224883-85303 239-490f6b354d2c76e919728 a6dbab61da46a-N/A-N/A-201 20810100219610582

PTO Form 192a (Rev. 9/2011)
 OMB No. 0633-0059 (E.O. 13320)

**Request for Reconsideration after Final Action
 To the Commissioner for Trademarks:**

Application serial no. **85303239** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

The only issue remaining in this application is the perceived likelihood of confusion between Applicant's mark and those in the cited blocking registrations.

Applicant is in the process of obtaining the signature of the owner of the cited registrations on the consent agreement included herewith as Exhibit 1. Applicant anticipates having the fully executed agreement in hand next week. Accordingly, Applicant respectfully requests that the examining attorney exercise the discretion given to him under 37 C.F.R. 2.65(b) to allow Applicant an extra 30 days to perfect this response. This will save the resources of both the Applicant and the Office and will implement the desires of the parties most directly affected.

EVIDENCE

Evidence in the nature of the consent agreement between Applicant and the owner of the cited blocking

registrations has been attached.

Original PDF file:

cvi_6620812229-100219610 . ex. 1 morinaga.pdf

Converted PDF file(s) (4 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Keith Barritt/ Date: 08/10/2012

Signatory's Name: Keith Barritt

Signatory's Position: attorney of record, Virginia bar member

Signatory's Phone Number: 202-783-5070

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85303239

Internet Transmission Date: Fri Aug 10 10:25:21 EDT 2012

TEAS Stamp: USPTO/RFR-66.208.12.229-2012081010252122

4883-85303239-490f6b354d2c76e919728a6dba

b61da46a-N/A-N/A-20120810100219610582

EXHIBIT 1

Trademark Agreement

This Trademark Agreement ("Agreement"), effective as of the latter date of execution below, is made by and between (i) Morinaga Nyugyo Kabushiki Kaisha, trading as Morinaga Milk Industry Co., Ltd., a Japanese corporation with a business address of 33-1, Shiba 5-chome, Minato-ku Tokyo, Japan ("MMICL"), and (ii) Morinaga & Co., Ltd. ("MCL"), a Japanese corporation with a business address of 33-1, Shiba 5 Chome Minato-ku Tokyo, Japan. MMICL and MCL shall hereafter be referred to as "the Parties."

WITNESSETH:

WHEREAS MMICL currently owns two pending U.S. trademark applications for MORINANGA, Ser. No. 85471392 for tofu and instant pudding mixes and Ser. No. 85303239 for tofu puree, and a third application for M MORINAGA Ser. No. 85171245 for various goods in Class 1 and Class 5 (the "MMICL Applications");

WHEREAS MCL currently owns U.S. trademark registration nos. 3125656, 3097367, 3113677, and 3889165, for goods in Class 30, none of which are for tofu, tofu puree, instant pudding mixes, or other goods covered by the MMICL Applications, for the following four marks (the "MCL Registrations"):



WHEREAS the cumulative goods covered by the MCL Registrations are biscuits; chocolates; caramels; snacks, namely, cereal-based, rice-based, wheat-based and corn-based snack foods; cakes; ice cream; cocoa; hotcake mix; candy; gum, namely chewing gum and bubble gum; candy; biscuits; cookies; chocolate; cocoa; cocoa based beverages; candy for food; caramels; hotcake mixes; syrup for cakes, namely, corn syrup, starch syrup and topping syrup; and non-alcoholic rice-based beverages mainly made from sake lees;

WHEREAS MMICL's 85471392 and 85303239 applications have been initially refused due to the MCL Registrations;

WHEREAS the Parties believe that the substantial differences in the appearance of their respective marks and the differences in their respective scope of goods renders the marks distinguishable and consumer confusion unlikely;

NOW THEREFORE, in consideration of the mutual promises and covenants set forth herein, and for good and valuable consideration, the sufficiency and receipt of which is acknowledged, the Parties agree as follows:

1. MMICL may use the MORINAGA trademark as depicted in the MMICL Applications for the goods identified in the MMICL Applications, and MCL consents to the MMICL Applications and shall not take any action to challenge such use or registration of such mark.
2. MCL may use the MORINAGA trademark as depicted in the MCL Registrations for the goods identified in the MCL Registrations, and MMICL shall not take any action to challenge such use or registration of such mark.
3. In the event of any reports of possible consumer confusion between the marks referred to in this Agreement, the Parties agree to cooperate in good faith to attempt to resolve any such issues to eliminate any confusion from recurring.
4. The scope of this agreement is the United States of America.
5. If all of a Party's trademark registrations for marks incorporating MORINAGA expire or are declared abandoned by a national trademark office, the restrictions on the other Party's use of the mark in that jurisdiction shall cease.
6. This Agreement shall be binding upon and inure to the benefit of the undersigned and their respective affiliates, related companies, successors, licensees, and assigns.
7. This Agreement contains the entire understanding between the Parties with respect to the subject matter hereof. There are no other agreements, understandings, representations or conditions, express or implied, oral or written, with regard to this Agreement.
8. This Agreement may not be modified or amended other than by an agreement in writing.
9. The Parties do not intend to create a joint venture by this Agreement, and neither Party will in any event represent to any third party that it is the other Party's agent for any purpose whatsoever in connection with this Agreement.
10. This Agreement shall be governed by the laws of Japan, without reference to or application of principles of choice of law. Disputes regarding this Agreement may be brought before a court of competent jurisdiction within Japan.

IN WITNESS WHEREOF, the Parties have caused this Agreement to be executed as of the dates set forth below.

Morinaga Nyugyo Kabushiki Kaisha

By: _____

Title: _____

Date: _____

Morinaga & Co., Ltd.

By: _____

Title: _____

Date: _____

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