

**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513**

**Mail date: February 24, 2004**

**Opposition No. 91152775  
Opposition No. 91154020  
Opposition No. 91156355**

**Lipton Investments, Inc. and  
Conopco, Inc., dba Slim Fast  
Foods Company**

**v.**

**LifeMax, LLC**

**Cheryl Butler, Interlocutory Attorney, for Andrew Baxley,  
Interlocutory Attorney**

Opposition No. 91156355

The Board instituted this proceeding in an order dated May 19, 2003. Applicant's answer was due by June 28, 2003. On May 28, 2003, the order sent to applicant was returned as undeliverable. On August 8, 2003, applicant filed a motion for leave to file an answer. Applicant notes that it never received notice from the Board of the proceeding, and that the address used by the Board was not that of applicant's attorney of record. Applicant requests until September 17, 2003 to file its answer, and that the Board send its attorney a copy of the notice of opposition. Applicant also informs the Board of related Opposition Nos. 91152775 and 91154020. Applicant filed an answer to the notice of opposition on September 17, 2003.

**Opposition No. 91152775; 91154020; and 91156355**

Applicant's motion to file an answer to the notice of opposition is granted, and applicant's answer is noted and entered. A copy of the notice of opposition is attached for applicant. The database is updated to reflect applicant's representation and correspondence address.

Applicant, on November 25, 2003, filed a consented motion to extend dates, indicating that the parties are discussing settlement. Said motion will be addressed later in this order.

Opposition No. 91152775

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Opposition No. 91154020

This proceeding has been suspended since August 21, 2003 to facilitate the parties' settlement discussions.

Proceedings consolidated

Applicant has notified the Board of the pendency of the related proceedings, set out above. The Board has reviewed each of the oppositions, and answers have been filed. Each proceeding involves the same parties and at least some of the same questions of law and fact.

**Opposition No. 91152775; 91154020; and 91156355**

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. Such consolidation may be ordered on the Board's own initiative. See Fed. R. Civ. P. 42(a); *Regatta Sports Ltd. v. Telux-Pioneer, Inc.*, 20 USPQ2d 1154 (TTAB 1991); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991); and TBMP Section 511 (June 2003).

Accordingly, Opposition Nos. 91152775; 91154020; and 91156355 are hereby consolidated, and may be presented on the same records and briefs. The record will be maintained in Opposition No. **91152775** as the "parent" case, but all papers filed in these cases should include all proceeding numbers in ascending order.

Proceedings suspended

Applicant's consented motions, both filed on November 25, 2003 and requesting contemporaneous dates, to extend discovery and trial dates are granted. Moreover, because the parties are negotiating for possible settlement of this case, proceedings herein are suspended until **six months** from the mailing date of this action, subject to the right of either party to request resumption at any time. See Trademark Rule 2.117(c).

In the event that there is no word from either party concerning the progress of their negotiations within the next **six**

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**months**, the Board will issue an order resuming proceedings and resetting trial dates, including the time for discovery.

If, during the suspension period, either of the parties or their attorneys should have a change of address, the Board should be so informed.

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As grounds for opposition, it is alleged that:

1. Opposer Lipton Investments, Inc. is the owner of the trademark SLIM-FAST and variants thereof (collectively, the "SLIM-FAST Marks"), and the following registrations therefor, issued by the United States Patent and Trademark Office:

TRADEMARK	REG. NO.	REG. DATE	GOODS
SLIM-FAST	1,102,508	September 19, 1978	Protein food supplement
SLIM-FAST	1,288,616	August 7, 1984	Beverage powder meal replacement mix
SLIM-FAST	1,358,816	September 10, 1985	Dietary meal replacement nutritional bars, and instant pudding meal replacement mix

The above-listed registrations are valid, subsisting, unrevoked, uncancelled and incontestable.

2. Opposer, Conopco, Inc., dba Slim-Fast Foods Company is the exclusive licensee of Lipton Investments, Inc. to sell weight management and meal replacement products under the SLIM-FAST Marks in the United States. Conopco, Inc. dba Slim-Fast Foods Company and Lipton Investments, Inc. are hereinafter collectively referred to as "Opposers."

3. For many years, and long prior to any date upon which Applicant can rely for purposes of priority, Opposers and their predecessors-in-interest have used the SLIM-FAST Marks in commerce in connection with the nationwide production, distribution, sale and promotion of weight management and meal replacement products. As a result of these efforts, Opposers' SLIM-FAST Marks are famous in the United States and are associated with Opposers and their high quality weight management and meal replacement products only. Opposers' SLIM-FAST Marks became famous long before the filing date of Applicant's application, were

WHEREFORE, Opposers believe they will be damaged by registration of the FAST SLIM MINTS shown in Application Serial No. 76/254,406 and respectfully request that the registration sought by Applicant be denied.

Please charge the \$600 filing fee for opposition by two parties in one class to our deposit account No. 04-1679.

This paper is submitted in duplicate.

Dated: May 13, 2003

CERTIFICATE OF EXPRESS MAIL

"Express Mail" label No. ET 347219715 US

Date of Deposit: May 13, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513

Stephanie L. Jacobs  
(Printed name of person mailing paper or fee)

Stephanie L. Jacobs  
(Signature)

May 13, 2003  
(Date of Signature)

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