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

Proceeding	91166451
Party	Defendant Nutri/System IPHC, Inc. Nutri/System IPHC, Inc. Suite 1704 300 Delaware Avenue Wilmington, DE 19801
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Attachments	Motion Seeking Consideration.pdf (8 pages)(113272 bytes)

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

In the matter of trademark application Serial No. 78/975262

YOPLAIT MARQUES	:	
INTERNATIONALES	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91166451
	:	
NUTRI/SYSTEM IPHC, INC.,	:	
	:	
Applicant.	:	

Motion Seeking Consideration of Request to Divide Application

The Nutri/System IPHC, Inc. (the "Applicant") respectfully moves to have the Board consider its previously filed Request to Divide Application and remand the same for division pursuant to 37 C.F.R. § 2.87(c), TBMP § 516 and TMEP § 1110.06.

Facts

The Applicant filed its original application on August 21, 2003 (the "Parent Application"). The Parent Application was assigned Serial Number 78/290738. The Parent Application sought registration of the mark NOURISH for goods and services in four International Classes, 29, 30, 32 and 44. On December 17, 2003, the Applicant filed a Request to Divide Application regarding the Parent Application (the "First Request"). See Attached Exhibit "A." In the First Request, the Applicant requested that the goods in International Classes 29, 30 and 44 be retained in the Parent Application and that the goods in International Class 32 be placed in a new divided application. On January 31, 2004, First Request was processed and completed by the ITU/Divisional Unit of the PTO; however, instead of retaining the goods in Classes 29, 30 and 44 in the Parent Application, the same were placed in a new divided application and given Serial Number 78/975262 (the "Child Application"). The goods in Class 32 were retained in the Parent Application.

On February 17, 2004, the Applicant filed a Request to Divide the Child Application and paid the requisite fee (the "Second Request"). See attached Exhibit "B." In the Second Request, Applicant requested that the goods and services in International Classes 30 and 44 be divided into two new and separate applications, with the goods in Class 29 to remain in the Child Application. In short, the Applicant sought to have its goods and services in Classes 29, 30 and 44 resided in three separate single class applications. To date, no action has been taken on the Second Request by the ITU/Divisional Unit of the PTO. Despite repeated attempts by the Applicant to clarify the status of the Second Request, the ITU/Divisional Unit of the PTO has been unable to explain why the Second Request has not been considered.

On February 2, 2005, the Child Application was published for opposition. Yoplait Marques Internationales (the "Opposer") filed a Notice of Opposition to the Child Application on August 22, 2005. Opposition Proceeding Number 91166451 was instituted on September 2, 2005 (the "Opposition"). Subsequently, the parties to the Opposition filed Stipulations to suspend the Opposition pending settlement negotiations on November 14, 2005 and May 12, 2006, respectively. Currently, the Opposition is suspended until November 8, 2006.

The Relief Requested

Pursuant to 37 C.F.R. § 2.87(c), TBMP § 516 and TMEP § 1110.06, the Applicant respectfully requests that the Board consider and grant the Second Request and instruct the ITU/Divisional Unit of the PTO to divide the Child Application into three separate single class applications with the goods in Class 29 remaining in the Child Application and the goods and services in Classes 30 and 44 being placed into two new divided applications.

In the instant matter, the Applicant filed a timely Request to Divide Application and paid the required fee. Apparently, through some oversight by the ITU/Divisional Unit of the PTO, the Second Request has not been considered. The Applicant will be prejudiced if the Second Request is not considered, if for no other reason than the loss of the fee already paid. Further, the Opposer will suffer no prejudice in light of the facts that: (i) the Opposition is currently suspended and (ii) the applicable discovery period related to the Opposition does not end until March 9, 2007. Moreover, the Opposition only relates to two of the three classes set forth in the Child Application, Classes 29 and 30. Therefore, placing the services in Class 44 in a separate application will remove this class of services from the scope of the Opposition and allow that application to process to registration in due course, thus at least partially accomplishing the result originally requested by the Applicant in its request of February 17, 2004.

Conclusion

For the reasons set forth above, the Applicant respectfully requests that the Board determine that the Second Request should be granted and that the Board refer the Second Request to the ITU/Divisional Unit of the PTO with instructions for dividing application 78/975262 in accordance with the Second Request.

Respectfully submitted,

SPECTOR GADON & ROSEN, P.C.


Timothy J. Szuhaj
Attorney for Applicant

Dated: August 23, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
:
Nutri/System IPHC, Inc. :
:
Serial No.: 78-290738 : Examining Attorney
: (Not yet assigned)
:
Filed: August 21, 2003 : Law Office #114
:
Mark: NOURISH :

REQUEST TO DIVIDE APPLICATION

Asst. Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

The Applicant hereby requests that the application identified above be divided as follows: Please retain in the original application the following goods/services—

CLASS 29: BREAKFAST, LUNCH AND DINNER ENTREES, AND SNACKS CONTAINING MEAT, FISH AND POULTRY, EGGS, MILK AND MILK PRODUCTS, MILKSHAKES, PUDDINGS, DRIED AND COOKED FRUITS AND VEGETABLES, JELLIES, SAUCES, SNACK DIPS AND SOUPS

CLASS 30: BREAKFAST, LUNCH, DINNER ENTREES, SNACKS AND DESSERTS, NAMELY FOR CEREALS, CEREAL BARS, MUFFINS, BREADS, PROTEIN BARS, DESSERT BARS, YOGURTS, RICE, SAUCES, GRAVIES, SALAD DRESSINGS, FROZEN BARS AND ICES, FOOD BEVERAGES WITH A COFFEE, TEA OR COCOA BASE

CLASS 44: PROVIDING TREATMENT, PLANNING, CONSULTATION AND SUPERVISION OF OBESITY, WEIGHT LOSS/WEIGHT MANAGEMENT PROGRAM, NUTRITION AND EXERCISE, VIDEO AND LITERATURE INSTRUCTIONAL MATERIALS

12-18-2003

U.S. Patent & TMO/TM Mail Rpt D1. 908

Please include in the new, divided application the following goods and services—

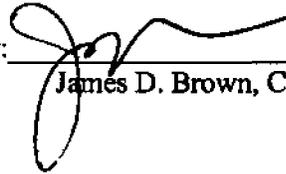
**CLASS 32: FRUIT DRINKS, FRUIT JUICES, SYRUPS AND OTHER PREPARATIONS FOR MAKING
BEVERAGES**

Enclosed is a check in payment of the processing fee for the divided application.

Respectfully submitted,

Date: December 17, 2003

By:



James D. Brown, CFO

CERTIFICATE OF EXPRESS MAILING—37 C.F.R. § 1.10

“Express Mail” mailing label number ER 558104855 US

Date of Deposit 12-17-03

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 22203-3513.

Denise Berger

(Typed or printed name of person mailing paper or fee)

Denise Berger

(Signature of person mailing paper or fee)

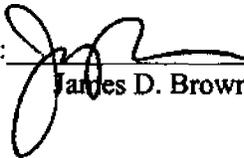
Please include in an additional new, divided application the following goods and services—

CLASS 44: PROVIDING TREATMENT, PLANNING, CONSULTATION AND SUPERVISION OF OBESITY,
WEIGHT LOSS/WEIGHT MANAGEMENT PROGRAM, NUTRITION AND EXERCISE, VIDEO AND
LITERATURE INSTRUCTIONAL MATERIALS

Enclosed is a check in payment of the processing fee for the divided application.

Respectfully submitted,

Date: February 17, 2004

By:  _____
James D. Brown, CFO

CERTIFICATE OF EXPRESS MAILING—37 C.F.R. § 1.10

“Express Mail” mailing label number ER 720520313 US
Date of Deposit 2-17-04

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 22203-3513.

Denise Bergner

(Typed or printed name of person mailing paper or fee)

Denise Bergner

(Signature of person mailing paper or fee)