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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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Date	04/10/2007
Attachments	motion seeking amendment applications - V2.pdf ( 7 pages )(235258 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 Amendment Applications**

Nutri/System IPHC, Inc. (the “Applicant”) respectfully moves the Board to consider Applicant’s request to amend certain applications pursuant to 37 C.F.R. § 2.133 and TBMP § 514.

**Facts**

On February 7, 2007, Yoplait Marques Internationales (the “Opposer”) and Applicant entered into a Settlement Agreement (the “Settlement Agreement”). See attached Exhibit “A.” On February 14, 2007, this Board granted Applicant’s Request to Divide the application underlying this Opposition resulting in three separate applications (Ser. Nos. 78/975262, 78/978127 and 78/978128, respectively). As part of the Settlement Agreement, Applicant agreed to amend its application to narrow the description of goods. Essentially, Applicant is willing to delete “Yogurts” from its ‘262 Application and add the limiting language “used in conjunction with a weight management program” to the following goods: cream cheese spread, cottage cheese, sour cream, milk shakes and puddings in both the ‘262 and ‘127 applications, as applicable. Pursuant to the Settlement Agreement, upon such amendment becoming effective, Opposer will withdraw this Opposition with prejudice.

Applicant submits that such amendments are proper as they do not expand the scope of the goods identified in the subject applications. Further, the amendments are by consent as the Opposer has agreed to the same as evidenced in the Settlement Agreement. Accordingly, Applicant submits that re-publication of the applications is not necessary and respectfully requests that the below amendments be made.

### **The Relief Requested**

Pursuant to 37 C.F.R. § 2.133 and TBMP § 514, the Applicant respectfully requests that the Board delete the current description of goods set for in Applicant's '262 application and replace it with the following:

BREAKFAST, LUNCH AND DINNER ENTREES, AND SNACKS CONTAINING MEAT, FISH AND POULTRY, EGGS, MILK AND MILK PRODUCTS, NAMELY, cream cheese spread, cheese spread, cottage cheese, sour cream used in conjunction with a weight management program, DRIED AND COOKED FRUITS AND VEGETABLES, JELLIES, SAUCES, NAMELY, applesauce, SNACK DIPS AND SOUPS; PROTEIN BASED NUTRIENT-DENSE SNACK BARS

Likewise, Applicant requests that the Board delete the current description of goods set forth in Applicant's '127 application and replace it with the following:

MILKSHAKES and PUDDINGS used in conjunction with a weight management program, BREAKFAST, LUNCH, DINNER ENTREES, SNACKS AND DESSERTS, NAMELY, CEREALS, CEREAL BARS, NAMELY, ready to eat, cereal derived food bars, MUFFINS, BREADS, DESSERT BARS, NAMELY, brownies, coffee flavored dessert bars, chocolate crunch bars, peanut butter, caramel and mint chewy chocolate bars, fruit bars, nut bars, RICE, SAUCES, NAMELY, salsas and tomato sauces, gravies, SALAD dressings, FROZEN BARS AND ICES, namely fudge bars, creamsicles and ice pops, FOOD BEVERAGES WITH A COFFEE, TEA OR COCOA BASE, NAMELY, coffee based beverages containing milk, cocoa based beverages containing milk, iced teas

### **Conclusion**

For the reasons set forth above, the Applicant respectfully requests that the Board grant the requested relief.

Respectfully submitted,

SPECTOR GADON & ROSEN, P.C.

\_\_\_\_\_/Timothy J. Szuhaj/\_\_\_\_\_  
Timothy J. Szuhaj  
Attorney for Applicant

Dated: April 10, 2007

## **CERTIFICATE OF SERVICE**

It is hereby certified that the undersigned has this day served a true and correct copy of Nutri/System IPHC, Inc.'s Motion Seeking Amendment of Applications by regular mail to:

John C. Filosa, Esquire  
Baker & McKenzie LLP  
One Prudential Plaza, Suite 3500  
Chicago, IL 60601  
Attorney for Yoplait Marques Internationales

/Timothy J. Szuhaj/  
Timothy J. Szuhaj  
Attorney for Nutri/System IPHC, Inc.

Dated: April 10, 2007

## SETTLEMENT AGREEMENT

This Settlement Agreement (“Agreement”), is effective as of the date that it is fully executed as indicated by the signatures at the end of this Agreement and is between Yoplait Marques Internationales, a French corporation, with a principal place of business at 170 Bis Boulevard du Montparnasse, 75014, Paris, France, (“Yoplait”), and Nutri/System IPHC, Inc., (“NutriSystem”), a Delaware corporation, with a principal place of business at 300 Delaware Avenue, Suite 1704, Wilmington, Delaware 19801, (collectively “the Parties”).

WHEREAS, Yoplait is the owner of Registration No. 2,643,955 for NOURICHE;

WHEREAS, NutriSystem filed a United States trademark application, Application Serial No. 78/975,262, for NOURISH;

WHEREAS, Yoplait filed Opposition No. 91,166,451 against NutriSystem’s Application;

WHEREAS, the Parties wish to resolve this matter;

NOW THEREFORE, in exchange for the mutual covenants contained herein and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the Parties agree as follows:

1. NutriSystem shall amend its application and delete "yogurts" from Application Serial No. 78/975,262 and shall not apply in the future to register NOURISH or any mark likely to create confusion with NOURICHE for yogurts.
2. Yoplait shall not use its common law rights in NOURICHE to challenge NutriSystem’s use or registration of the mark NUTRISYSTEM NOURISH for products



or services of any kind and consents to NutriSystem's use and registration of NUTRISYSTEM NOURISH on products and services of any kind.

3. NutriSystem may continue its present use of NOURISH on "cream cheese spread, cottage cheese, sour cream, milk shakes and puddings" only in conjunction with foods that are part of meal plans offered as part of weight management programs. The description of these goods in any trademark application must include the limitation on sales as "part of a weight management program" and NutriSystem shall always use the NUTRISYSTEM mark (or other name for a weight loss management program that is not similar to NOURICHE) prominently on packaging sold in retail grocery channels.

4. NutriSystem shall not use its common law rights in NOURISH to challenge Yoplait's use or registration of the mark NOURICHE for dairy products of any kind and consents to Yoplait's use and registration of NOURICHE on dairy products.

5. Within ten business days after the United States Patent and Trademark Office accepts and processes NutriSystem's amendment to Application Serial No. 78/975,262 outlined in paragraph 1 above, the Parties shall by consent dismiss Opposition No. 91,166,451 with prejudice.

6. The following representations and warranties shall survive the execution of this Agreement and the completion of the settlement provided below:

a) The Parties to this Agreement warrant and represent that they have the power and authority to enter into this Agreement and that this Agreement is valid, binding, and enforceable upon each of the Parties.

b) The Parties warrant and represent that no consent, approval, authorization or order of, and notice to, or filing with any court, governmental authority, person, or entity is required for the execution, delivery, and performance of this Agreement.

c) The Parties warrant and represent that they own the claim or claims that they purport to own and have asserted or released in this Agreement and that no part of their claim or claims asserted against any Party or released by any Party in this Agreement has been assigned or transferred to any other person or entity, by way of subrogation, operation of law, or otherwise, and that no releases or settlement agreements are necessary or need to be obtained from any other person or entity.

7. This Agreement contains the entire understanding between the Parties and can only be amended by a written instrument, signed by both of the Parties, and this Agreement supersedes any prior understandings or agreements.

8. This Agreement has been prepared by the joint efforts of the Parties and their counsel and has been reviewed and accepted by the Parties.

9. This Agreement is binding on the Parties and any and all principals, owners, affiliates, subsidiaries, subsidiaries of affiliates, parents, affiliates or subsidiaries of parents, officers, directors, employees, agents, representatives, successors in interest, and assigns.

10. If any term of this Agreement is determined to be invalid or unenforceable by a court of competent jurisdiction, that term shall be enforced to the full extent possible under the law, and the validity and enforceability of the remaining terms shall remain unaffected.

IN WITNESS WHEREOF, Yoplait and NutriSystem have executed this agreement as of the later date noted below.

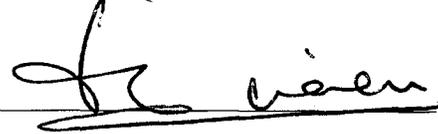
Date January 15, 2007

NUTRISYSTEM IPHC, INC.

By   
Its Wice President and Treasurer

Date February 05, 2007

YOPLAIT MARQUES INTERNATIONALES

By   
Its \_\_\_\_\_