

ESTTA Tracking number: **ESTTA711041**

Filing date: **11/25/2015**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|---------------------------------------|-------------------------------------------------------------|
| Name | VDF FutureCeuticals, Inc. |
| Granted to Date of previous extension | 11/25/2015 |
| Address | 300 West Sixth Street Momence, IL 60954 UNITED STATES |

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|----------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Attorney information | Tiffany A. Blofield WINTHROP & WEINSTINE, P.A. 225 South Sixth Street, Suite 3500 Minneapolis, MN 55402 UNITED STATES tblofield@winthrop.com, sbaird@winthrop.com, trademark@winthrop.com, sbell@winthrop.com, ayoung@winthrop.com, greyes@winthrop.com Phone:6126046684 |
|----------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

Applicant Information

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|------------------------|--------------------------------------------------------------------------------|------------------------|------------|
| Application No | 86556891 | Publication date | 07/28/2015 |
| Opposition Filing Date | 11/25/2015 | Opposition Period Ends | 11/25/2015 |
| Applicant | Magceutics, Inc. 3159 Corporate Place Hayward, CA 94545 UNITED STATES | | |

Goods/Services Affected by Opposition

Class 005. First Use: 2015/03/01 First Use In Commerce: 2015/03/01
All goods and services in the class are opposed, namely: Dietary and nutritional supplements; Nutraceuticals for use as a dietary supplement

Grounds for Opposition

| | |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|

Marks Cited by Opposer as Basis for Opposition

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3527544 | Application Date | 02/02/2004 |
| Registration Date | 11/04/2008 | Foreign Priority Date | NONE |
| Word Mark | NUTRIM | | |

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|---------------------|---------------------------------------------------------------------------------------------------------------------|--|--|
| Design Mark | <h1>NUTRIM</h1> | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 005. First use: First Use: 2001/02/22 First Use In Commerce: 2001/02/22 Oat bran-based dietary supplements | | |

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3286745 | Application Date | 11/12/2002 |
| Registration Date | 08/28/2007 | Foreign Priority Date | NONE |

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|-----------|--------|
| Word Mark | NUTRIM |
|-----------|--------|

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|-------------|--------------------------------------------------------------------------------------|--|--|
| Design Mark |  | | |
|-------------|--------------------------------------------------------------------------------------|--|--|

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|---------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--|--|
| Description of Mark | NONE | | |
| Goods/Services | Class 005. First use: First Use: 2001/02/22 First Use In Commerce: 2001/02/22 Oat bran hydrocolloid for use as a dietary supplement Class 030. First use: First Use: 2001/02/22 First Use In Commerce: 2001/02/22 Food additive, namely, oat bran hydrocolloid for use as an ingredient | | |

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3081622 | Application Date | 02/02/2004 |
| Registration Date | 04/18/2006 | Foreign Priority Date | NONE |

| | |
|---------------------|--------------------------------------------------------------------------------------------------------------------------------|
| Word Mark | NUTRIM |
| Design Mark |  |
| Description of Mark | NONE |
| Goods/Services | Class 030. First use: First Use: 2001/02/22 First Use In Commerce: 2001/02/22 Food ingredient, namely, processed whole oats |

| | |
|---------------------|-------|
| Related Proceedings | None. |
|---------------------|-------|

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|-------------|-------------------------------------------------------------------------------------------------------------------------------------------------|
| Attachments | 78360958#TMSN.png(bytes) 78184289#TMSN.png(bytes) 78360960#TMSN.png(bytes) Notice of Opposition (Mageceutics).pdf(311874 bytes) |
|-------------|-------------------------------------------------------------------------------------------------------------------------------------------------|

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|-----------------------|
| Signature | /Tiffany A. Blofield/ |
| Name | Tiffany A. Blofield |
| Date | 11/25/2015 |

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

In the matter of Application Serial No.: 86/556,891
Filed: March 8, 2015
For the mark: NUTRIMEM
Published in the *Trademark Official Gazette* on July 28, 2015

VDF FUTURECEUTICALS, INC.,

Opposer,

v.

Opposition No. _____

MAGECEUTICS, INC.,

Applicant.

NOTICE OF OPPOSITION

VDF FUTURECEUTICALS, INC. (“Opposer”) believes that it will be damaged by registration of the NUTRIMEM mark shown in Application Serial No. 86/556,891 (the “Application”) in International Class 5 and hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer is a vertically integrated bio-technology company that specializes in the discovery, development, manufacturing, processing, growing and marketing of scientifically innovative nutraceuticals, dietary and nutritional supplements, food and beverage products and ingredients, functional foods, and cosmetic ingredients. Opposer offers an extensive line of probiotic, nutritional supplement, food-based antioxidant, soy isoflavone, and food and beverage ingredients. Opposer’s state-of-the-art facilities process over 50 million pounds of product every year.

2. Opposer has used NUTRIM® as a trademark in connection with dietary supplements, food additives and food ingredients for over fourteen years (collectively referred to as the “NUTRIM Marks”).

3. Opposer is the record owner of the following incontestable U.S. Trademark registrations for the NUTRIM Marks:

- a. U.S. Trademark Registration No. 3,527,544 for NUTRIM® in connection with “oat bran-based dietary supplements” in International Class 5, filed on February 2, 2004, and registered on November 4, 2008;
- b. U.S. Trademark Registration No. 3,286,745 for NUTRIM® and Design **Nutrim** in connection with “oat bran hydrocolloid for use as a dietary supplement” in International Class 5, and “food additive, namely, oat bran hydrocolloid for use as an ingredient” in International Class 30 filed on November 12, 2002, and registered on August 28, 2007; and
- c. U.S. Trademark Registration No. 3,081,622 for NUTRIM® in connection with “food ingredient, namely, processed whole oats” in International Class 5, filed on February 2, 2004, and registered on April 18, 2006.

(the U.S. Trademark Registrations identified in paragraphs 3(a)-(c) collectively shall be referred to as the “NUTRIM Registrations.”)

4. True and correct copies of Opposer’s foregoing NUTRIM Registrations are attached hereto as **Exhibit A**.

5. NUTRIM® comes in both a chewable tablet form and an easy-to-use dietary supplement that is mixed with any beverage or food. NUTRIM® brand and marks have been widely advertised. Consequently, the consuming public knows FutureCeuticals as the source of goods bearing the NUTRIM® Marks.

6. Consumers likewise recognize that the NUTRIM® mark refers to FutureCeuticals’ revolutionary powder that was originally developed by the United States Department of Agriculture (“USDA”) as a healthy fat replacer.

7. The process to manufacture NUTRIM® was patented by the USDA. FutureCeuticals obtained the worldwide exclusive license to use the patented process.

8. Consumers who see the name “NUTRIMEM” used by Magecuetics, Inc. (“Applicant”) will be misled into believing that its product(s) are manufactured in the same manner as NUTRIM®.

9. Opposer expends considerable time, effort and expense in promoting, advertising and popularizing its distinctive NUTRIM® Marks and the goods offered under them. Consumers have come to know, rely upon and recognize the NUTRIM® Marks as strong indicators of the source of Opposer’s goods.

10. In the subject Application, Applicant seeks to register the substantially similar mark “NUTRIMEM” as a trademark for “dietary and nutritional supplements; nutraceuticals for use as a dietary supplement” in International Class 5 (“Applicant’s Goods”).

11. The Application was filed on March 8, 2015 (“Applicant’s Filing Date”).

12. In the Application, Applicant asserts a first use date of March 1, 2015.

13. Applicant’s claimed “NUTRIMEM” trademark was published for opposition in connection with the Application in the *Trademark Official Gazette* on July 28, 2015.

14. Opposer commenced use of its NUTRIM® Marks in commerce more than fourteen years prior to the March 8, 2015 filing date of the Application. Opposer has continuously used in commerce, from the dates set forth in the corresponding NUTRIM Registrations, its NUTRIM® Marks. Consequently, Opposer’s use and registrations have priority over the Application as a result of Opposer’s earlier registration and continuous use of its federally-registered NUTRIM® Marks.

15. Opposer has priority of common law rights in its NUTRIM® Marks in connection with nutraceuticals for use as a dietary supplements, food ingredient, and food additive.

16. Allowing the Application for Applicant's proposed "NUTRIM" mark to register would damage Opposer, as registration would confer upon Applicant various statutory presumptions to which it is not entitled in view of Opposer's prior use and registration of its NUTRIM® Marks.

17. Opposer's NUTRIM® Marks and Applicant's "NUTRIMEM" mark are substantially similar.

18. Applicant's "NUTRIMEM" mark uses Opposer's NUTRIM® Marks in its entirety.

19. Opposer's NUTRIM® Marks and Applicant's "NUTRIMEM" are phonetically similar.

20. Opposer's NUTRIM® Marks and Applicant's "NUTRIMEM" both beginning with the letters "Nutri" and ending with the letter "M."

21. Applicant's Goods are closely related to the goods offered under Opposer's NUTRIM® Marks and are likely to travel through the same channels of trade as the goods offered under Opposer's NUTRIM® Marks.

22. Upon information and belief, Applicant's Goods and the goods Opposer offers under the NUTRIM® Marks are likely to be promoted and sold to identical and/or overlapping consumers.

23. Because of the same, similar and/or related nature of the goods, and that the parties respective goods are likely to travel in the same channels of trade and promotion and be sold to identical and/or overlapping customers, purchasers and prospective purchasers are likely to be confused, mistakenly believe or be deceived that the goods Applicant offers under the

proposed "NUTRIMEM" mark are affiliated with, connected to, or associated with Opposer, or in some other way originate with or are sponsored, endorsed or approved by Opposer, all to the detriment of Opposer.

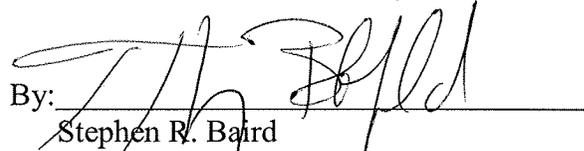
24. Applicant's proposed "NUTRIMEM" mark is substantially the same as Opposer's NUTRIM® Marks so that purchasers and prospective purchasers are likely to be confused, mistakenly believe or be deceived that Applicant's Goods offered under Applicant's proposed "NUTRIMEM" mark are affiliated with, connected to, or associated with Opposer, or in some other way originate with or are sponsored, endorsed or approved by Opposer, all to the detriment of Opposer.

25. Applicant's "NUTRIMEM" mark is likely to cause consumer confusion. Therefore, registration of Applicant's Mark should be refused under 15 U.S.C. §§ 1052(d) and 1063.

WHEREFORE, Opposer prays that Application Serial No. 86/556,891 be rejected, that registration of the mark therein for the goods therein specified be refused, and that the present opposition be sustained.

Dated: November 25, 2015

WINTHROP & WEINSTINE, P.A.

By: 
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Tiffany A. Blofield

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Minneapolis, Minnesota 55402
(612) 604-6400 (Telephone)
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Attorneys for VDF FutureCeuticals, Inc.

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

In the matter of Application Serial No.: 86/556,891
Filed: March 8, 2015
For the mark: NUTRIMEM
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VDF FUTURECEUTICALS, INC.,

Opposer,

v.

Opposition No. _____

Mageceutics, Inc.,

Applicant.

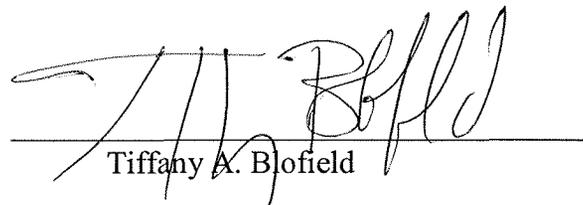
CERTIFICATE OF SERVICE BY MAIL

This is to certify that on this 25th day of November, 2015, I served by U.S. Mail a true and correct copy of the following document:

- Notice of Opposition

in the above-captioned action to the following at the last known address, to-wit:

Elizabeth Oliner
345 Grove St Fl. 2
San Francisco, CA 94102-4462



Tiffany A. Blofield

11190283v1

Exhibit A

Int. Cl.: 5

Prior U.S. Cls.: 6, 18, 44, 46, 51 and 52

Reg. No. 3,527,544

United States Patent and Trademark Office

Registered Nov. 4, 2008

TRADEMARK
PRINCIPAL REGISTER

NUTRIM

VDF FUTURECEUTICALS, INC. (ILLINOIS CORPORATION)
300 WEST SIXTH STREET
MOMENCE, IL 60954

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

FOR: OAT BRAN-BASED DIETARY SUPPLEMENTS, IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

SER. NO. 78-360,958, FILED 2-2-2004.

FIRST USE 2-22-2001; IN COMMERCE 2-22-2001.

KATHLEEN M. VANSTON, EXAMINING ATTORNEY

Int. Cls.: 5 and 30

Prior U.S. Cls.: 6, 18, 44, 46, 51, and 52

United States Patent and Trademark Office

Reg. No. 3,286,745

Registered Aug. 28, 2007

TRADEMARK
PRINCIPAL REGISTER

The logo for "Nutrim" features the word "Nutrim" in a bold, italicized, sans-serif font. The letter "i" is stylized with a vertical line and a small sunburst or starburst graphic above it.

VDF FUTURECEUTICALS INC. (ILLINOIS CORPORATION)
300 WEST 6TH STREET
MOMENCE, IL 60954

FOR: OAT BRAN HYDROCOLLOID FOR USE AS A DIETARY SUPPLEMENT, IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FIRST USE 2-22-2001; IN COMMERCE 2-22-2001.

FOR: FOOD ADDITIVE, NAMELY, OAT BRAN HYDROCOLLOID FOR USE AS AN INGREDIENT, IN CLASS 30 (U.S. CL. 46).

FIRST USE 2-22-2001; IN COMMERCE 2-22-2001.

SN 78-184,289, FILED 11-12-2002.

BERYL GARDNER, EXAMINING ATTORNEY

Int. Cl.: 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office

Reg. No. 3,081,622

Registered Apr. 18, 2006

**TRADEMARK
PRINCIPAL REGISTER**

NUTRIM

VDF FUTURECEUTICALS, INC. (ILLINOIS CORPORATION)
300 WEST SIXTH STREET
MOMENCE, IL 60954

FOR: FOOD INGREDIENT, NAMELY, PROCESSED WHOLE OATS, IN CLASS 30 (U.S. CL. 46).

FIRST USE 2-22-2001; IN COMMERCE 2-22-2001.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 78-360,960, FILED 2-2-2004.

REBECCA GILBERT, EXAMINING ATTORNEY