

TTAB

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

In Re Trademark Opposition of
National Tobacco Company, L.P.,
Opposer,
v.
Beech-Nut Nutrition Corporation
Applicant.

Opposition No. 91176125

Serial No. 78/666,753

Box TTAB
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Communication Notifying of Submission of Requested
Amendment of Trademark Application with Consent of Opposer

The undersigned, Lance J. Lieberman, is the attorney of record and representative of Applicant Beech-Nut Nutrition Corporation (“Beech-Nut”) in connection with Beech-Nut’s U.S. Trademark Application No.78/666,753, filed July 9, 2005 (“the ‘753 Application”), which is the subject of the above-identified opposition proceeding No. 91176125.

This paper is submitted to notify the Trademark Trial and Appeal Board (“the Board”) that Applicant has filed, concurrently herewith, a Second Request for Amendment by Consent of Trademark Application.



04-02-2009

Opposer and Applicant have agreed on and completed terms of settlement of the instant opposition, which terms have been memorialized in a writing that has been signed by Applicant and Opposer. By its terms, Applicant has agreed to amend the Identification of Goods of the '753 Application to further limit them so that, after said amendment, the Identification of Goods of the '753 Application will recite "diaper bags, tote bags, backpacks, duffel bags, fanny packs and waist packs *all for use by infant or child care-givers as a secondary source indicator of Applicant's infant-related products*" in International Class 018, and "cooler bags *for use by infant or child care-givers as a secondary source indicator of Applicant's infant-related products*" in International Class 021; the italicized language is to be added by amendment. Upon entry of this agreed-upon limiting amendment of the Identification of Goods of the '753 Application, pursuant to the terms of the settlement agreement, Opposer will withdraw the instant opposition.

Applicant accordingly submitted to the USPTO, accompanied by a Certificate of First Class Mailing on January 12, 2009, a Request for Amendment by Consent of Trademark Application, seeking entry of the revised Identification of Goods to which Opposer and Applicant had expressly agreed. In a Decision mailed February 10, 2009, however, the Board refused entry of the requested amendment of the Identification of Goods of the opposed trademark application because its language included the term "Applicant". The Decision suggested that the wording "Trademark Owner" be substituted for "Applicant", and that a revised amendment of the trademark application then be submitted.

The Second Request for Amendment by Consent of Trademark Application, which Applicant has filed concurrently herewith, thus seeks entry of the revised Identification of Goods language to which Opposer and Applicant had originally agreed, modified however to substitute the wording "Trademark Owner" for the term "Applicant". Counsel for Opposer has expressly agreed to this further revised wording of the Identification of Goods.

A copy of the concurrently-filed Second Request for Amendment by Consent of Trademark Application is, for the convenience of the Board, attached hereto.

Upon entry of the concurrently-requested amendment of the subject trademark application, it is respectfully submitted that the instant opposition may be dismissed without prejudice.

It is believed that no fees or charges are required at this time in connection with the instant opposition. Nevertheless, in the event that any such fees or charges are required at this time, they may be charged to our Patent and Trademark Account No. 23-2412.

Respectfully submitted,

COHEN PONTANI LIEBERMAN & PAVANE LLP

By _____

Lance J. Lieberman
Reg. No. 28,437
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770
Attorneys for Applicant

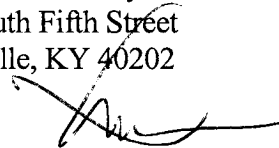
Dated: March 31, 2009

CERTIFICATE OF SERVICE

I certify that a true and correct copy of the foregoing COMMUNICATION NOTIFYING OF SUBMISSION OF REQUESTED AMENDMENT OF TRADEMARK APPLICATION WITH CONSENT OF OPPOSER was served by First Class Mail, postage prepaid, on counsel for Opposer as follows:

Suzan J. Hixon, Esq.
Greenbaum Doll & McDonald PLLC
3500 National City Tower
101 South Fifth Street
Louisville, KY 40202

Dated: March 31, 2009



Lance J. Lieberman

CERTIFICATE OF FIRST CLASS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Box TTAB, Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

Dated: March 31, 2009



Lance J. Lieberman

Attorney Docket No.: 463702-91

Trademark

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Trademark Application of

Beech-Nut Nutrition Corporation

Serial No.: **78/666,753**

Filed: **July 8, 2005**

Mark: **BEECH-NUT**

Attorney: **Rebecca Gan**
Law Office: **103**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Trademarks, Box 1451, Alexandria, VA 22313-1451, on

March 31, 2009

(Date of Deposit)

Lance J. Lieberman

Name of applicant, assignee or Registered Representative

Signature

March 31, 2009

Date of Signature

Box RESPONSES NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

**SECOND REQUEST FOR AMENDMENT
BY CONSENT OF TRADEMARK APPLICATION**

S I R:

Applicant hereby requests that the above-identified trademark application, which is the subject of pending Opposition No. 91176125, be amended as follows:

In The Statement:

Cancel the Identification of Goods in its entirety, and insert therefor:

--DIAPER BAGS, TOTE BAGS, BACKPACKS, DUFFEL BAGS, FANNY PACKS AND WAIST PACKS ALL FOR USE BY INFANT OR CHILD CARE-GIVERS AS A SECONDARY

SOURCE INDICATOR OF TRADEMARK OWNER'S INFANT-RELATED PRODUCTS; in International Class 018; and COOLER BAGS FOR USE BY INFANT OR CHILD CARE-GIVERS AS A SECONDARY SOURCE INDICATOR OF TRADEMARK OWNER'S INFANT-RELATED PRODUCTS; in International Class 021.--

REMARKS

This trademark application is the subject of pending Opposition No. 91176125.

Applicant and Opposer have reached agreement on terms of settlement of the pending opposition. In accordance with those agreed-upon terms, which have been memorialized in a writing signed by both Applicant and Opposer, Applicant will amend its Identification of Goods, to limit the recited goods in the manner set forth above, and Opposer will then withdraw the pending opposition when the above-requested amendment of the Identification of Goods has been entered.

Thus, the above-requested amendment of the Identification of Goods of this trademark application is being submitted with the consent of Opposer.

This is Applicant's second request for amendment with Opposer's consent of the above-identified application in settlement of the pending opposition. Applicant's first such request, which was submitted to the USPTO with a Certificate of First Class Mailing dated January 12, 2009, was refused because the requested amendment of the Identification of Goods included the term "Applicant". In refusing entry of that first requested amendment in a Decision mailed

February 10, 2009, the Interlocutory Attorney of the TTAB in Opposition No. 91176125 suggested that Applicant substitute the term "Trademark Owner" for "Applicant" and resubmit its request for amendment of the instant trademark application. Opposer has expressly agreed to this further amendment.

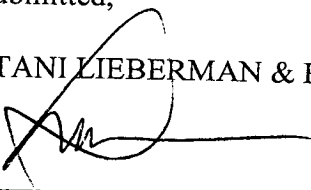
It is not believed that republication of the mark will be required upon entry of the above-requested amendment of the instant trademark application.

Finally, it is not believed that any fees or charges are required in connection with this Second Request for Amendment. Nevertheless, any such fees or charges that are required in connection with this Second Request for Amendment may be charged to our Patent and Trademark Account No. 23-2412.

Respectfully submitted,

COHEN PONTANI LIEBERMAN & PAVANE LLP

By



Lance J. Lieberman
Reg. No. 28,437
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

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