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February 18, 2006

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Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

Re: In re the application of Nutri/System, IPHC, Inc.

Serial No: 78/448222

Filed: July 9, 2004

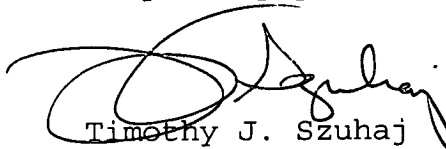
Mark: PEPTIDE PLAN

Our File No: 90009-001

Dear Sir/Madam:

Enclosed you will find an original copy of our Response to Office Action No. 2 and our Certificate of Express Mailing. Kindly file the enclosed document and confirm receipt thereof by applying your date stamp and serial number on the return receipt card attached hereto.

Very truly yours,



Timothy J. Szuhaj

TJS/ck

Enclosure(s)

cc: Jim Brown (w/enclosures)

Denise Bergner (w/enclosures)



02-27-2006

U.S. Patent & TMO/OTM Mail Rcpt Dt. #11

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:		
Nutri/System IPHC, Inc.	:		
Serial No.:	78/448222	:	Examining Attorney:
Filed:	July 9, 2004	:	Ellen Awrich
Mark:	PEPTIDE PLAN	:	Law Office 116
Our Ref.:	90009-001	:	

RESPONSE

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

Applicant acknowledges receipt of Office Action No. 2, emailed August 24, 2005, in connection with the above-referenced application (the "Office Action"). The Examining Attorney has made final the refusal to grant registration on the grounds that Applicant has not adequately responded to her request for information and that the Applicant's mark describes the subject matter of a publication and, therefore is merely descriptive under Section 2(e)(1). Applicant requests that the Examining Attorney reconsider and withdraw this refusal for the following reasons.

BASIS FOR RECONSIDERATION

I. Meaning of the Mark; Request for Information

The Examining Attorney has also made final her request that the Applicant indicate whether its mark "has any significance or meaning in the relevant trade." The Applicant submits

that the term “peptides” does not have any significance in the relevant industry other than the dictionary definition set forth in the Office Action. Moreover, as applied to Applicant’s goods and weight loss program, Applicant submits that its weight reduction services are namely related to the use of whey protein sub-units, which may contain peptides and dairy minerals.

II. Descriptiveness Refusal Under Section 2(e)(1).

In the Office Action, the Examining Attorney made final her refusal to register the mark PEPTIDE PLAN on the grounds that “a term that describes the subject matter of a publication is merely descriptive under Section 2(e)(1).” Applicant respectfully submits that its mark is not descriptive of the subject matter of its publications and video tapes. Applicant’s goods will be video tapes and literature regarding obesity, weight loss/weight management programs, nutrition and exercise. The term “peptides” does not appear in the description of the subject goods. In fact, the Examining Attorney’s own argument that peptides are directly associated with weight loss, nutrition and exercise demonstrates the substantial operation of imagination necessary to reach the Examining Attorney’s conclusion that Applicant’s mark “is merely descriptive of the publications and video recordings, which detail a weight loss plan featuring a peptide.” (Emphasis added). In essence, the Applicant submits that the Examining Attorney has incorrectly substituted peptide as a synonym for weight loss. It is the Applicant’s position that the relevant consumers will not make such a connection when viewing Applicant’s mark. The Applicant’s mark does not directly convey the proposition that the goods may or may not include subject matter about peptides. Accordingly, the Applicant submits that the mark is not descriptive of the subject goods and that the Examining Attorney’s opinion regarding descriptiveness is misplaced. Moreover, the Examining Attorney has sited numerous references

to articles and websites indicating “that peptides regulate appetite.” Applicant submits that there is a voluminous amount of references to article and websites indicating that peptides are a primary component of numerous skin care products and cosmetics. The Applicant refers the Examining Attorney to the 305 stories from the Lexis/Nexis Research database showing “peptides” within five (5) words of “cosmetics.” Fifteen of the stories are attached as representative examples. See Exhibit A. Finally, the Examining Attorney has not proffered any materials showing the use of the subject terms “peptide” and “plan” together as being immediately descriptive of Applicant’s goods. The above notwithstanding, Applicant reiterates its belief that the mark is, at a minimum, suggestive, rather than descriptive.

Accordingly, Applicant requests reconsideration of the refusal to register the mark PEPTIDE PLAN on descriptiveness grounds.

A. PEPTIDE PLAN Must be Considered as a Whole in Relation to the Identified Services.

As set forth above, the Examining Attorney has cited instances from the Internet of use of the term “peptide” in the general context of appetite regulation. Applicant submits that the components of its mark should not be treated as two separate elements for the purpose of evaluating Applicant’s mark. The mark should not be dissected and the terms analyzed separately. In re Hutchinson Technology, 852 F.2d 552 (Fed. Cir. 1988) (improper to dissect a mark and analyze the individual words it may incorporate). In doing so, the Examining Attorney has ignored the fanciful and/or arbitrary combination of the two elements together.

B. SLIM AND TONE is Suggestive of the Identified Services.

1. SLIM AND TONE is Not Merely Descriptive Under the Imagination Test.

As previously noted by Applicant, the primary test for determining whether PEPTIDE PLAN is descriptive within the meaning of Section 2(e)(1) is whether the mark immediately conveys to consumers the nature of the Applicant's goods or whether consumers must use "imagination, thought and perception" to draw that conclusion. Stix Prod., Inc. v. United Merchants & Mfrs., Inc., 295 F. Supp. 479, 488 (S.D.N.Y. 1968). See also Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366, 379 (7th Cir. 1976), cert. denied, 429 U.S. 830 (1976) (emphasis added). See also Bristol-Myers Squibb Co. v. McNeil P.P.C., Inc., 973 F.2d 1033, 1040 (2d Cir. 1992). Even if one were to assume that the two terms on their own were understood by the relevant consumer to have the connotations suggested by the Examining Attorney—essentially a method for appetite regulation--the use of the terms in combination results in a composite mark that is fanciful, unique and memorable and, therefore, it seems highly unlikely that Applicant's mark immediately and directly conveys information about the subject matter of Applicant's goods.

Moreover, the combination of two descriptive terms can result in a composite mark that is suggestive. See, e.g., Catamount Software v. Microsoft Corporation, 327 F. Supp. 2d 278, 284-85 (D. Vt. 2003) (combination of "pocket" and "money" resulted in a suggestive mark entitled to trademark protection); W.W.W. Pharm Co. v. Gillette Co., 808 F. Supp. 1013, 1022 (S.D.N.Y. 1992) (consolidation of two descriptive or generic terms, "sport" and "stick," suggested both product's form and usage, but required some imagination to surmise nature of product, and thus was suggestive mark), aff'd, 984 F.2d 567 (2d Cir. 1993). See also Banff, Ltd.

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