

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	76682620
LAW OFFICE ASSIGNED	LAW OFFICE 111
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The Examining Attorney maintains the refusal of registration of applicant's mark for the reason that there is an alleged likelihood of confusion between applicant's mark and the mark set forth in U.S. Trademark Registration No. 3,114,650. Applicant again traverses this refusal, and requests favorable consideration of same.</p> <p>In determining a likelihood of confusion, the Examining Attorney must compare the respective marks in their entirety, evaluating the similarity or dissimilarity of the marks in relation to appearance, sound, connotation, and commercial impression, as well as differences or similarities in the respective goods.</p> <p>In support of the refusal, the Examining Attorney states at page 2 of the Action that "the cited registered mark is DR. JESSICA WU". This statement is incorrect, and appears to have caused the Examining Attorney to base the refusal to register on a faulty premise. More correctly, the registered mark is DR. JESSICA WU COSMECEUTICALS, which results in entirely different considerations to be employed in support of the refusal to register.</p> <p>When comparing applicant's mark to the cited mark, it is apparent that the respective marks are not identical, but instead differ in appearance, sound, connotation and commercial impression.</p> <p>Notwithstanding the above, the Examining Attorney takes the position that "applicant's mark has simply deleted the first name in the registered mark, namely JESSICA". The Examining Attorney's logic is ill-founded as the Examining Attorney in such a circumstance fails to view the respective marks in their entirety. Even if JESSICA is removed from the cited mark, the respective marks would not be identical as apparently asserted by the Examining Attorney.</p> <p>The Examining Attorney appears to equate a disclaimer of the word COSMECEUTICALS with its absence from the registered mark – this is not true, as COSMECEUTICALS remains part of the cited registration, and cannot be divorced from the likelihood of confusion analysis. Indeed, the word COSMECEUTICALS is given equal prominence in the cited registration, and the Examining Attorney must accordingly view the cited mark in relation to applicant's mark in such context. To do otherwise is to ignore the requirements of the law.</p>	

The Examining Attorney also takes the position at the paragraph bridging pages 3 and 4 of the Action that “as the goods are virtually the same, consumers are likely to believe that ‘Dr. Wu’ and ‘Dr. Jessica Wu’ are the same person, and that the goods emanate from a common source”. The Examining Attorney, in taking this position, again ignores a material portion of the cited registration – the issue to be resolved is not whether the consumer might find such persons to be related, but whether there is a likelihood of confusion between the respective marks in their entirety – which there is not for the reasons noted above.

Even if the Examiner’s position as to the possibility of confusion as between such persons has merit, the Trademark Office has issued registrations that rebut such a position. Registration No. 2,596,881 previously issued for the mark WU for related and/or similar goods as those of the cited registration. Accordingly, the mark DR. JESSICA WU COSMECEUTICALS was deemed not confusingly similar to the mark WU for related and/or similar goods. This rebuts any inference that the cited mark should serve to bar the registration of any mark containing the word WU, as the Examining Attorney is asserting in the present instance.

In view of the above, the refusal to register applicant’s mark should be withdrawn, and the application allowed.

SIGNATURE SECTION

RESPONSE SIGNATURE	/Joe McKinney Muncy/
SIGNATORY'S NAME	Joe McKinney Muncy
SIGNATORY'S POSITION	Attorney of record, VA bar member
DATE SIGNED	12/01/2009
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO

FILING INFORMATION SECTION

SUBMIT DATE	Tue Dec 01 14:21:29 EST 2009
TEAS STAMP	USPTO/RFR-72.44.190.141-2 0091201142129371658-76682 620-4604a80b7b015e4a3a9bc a84217457629f-N/A-N/A-200 91201133957888889

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To the Commissioner for Trademarks:

Application serial no. **76682620** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

The Examining Attorney maintains the refusal of registration of applicant's mark for the reason that there is an alleged likelihood of confusion between applicant's mark and the mark set forth in U.S. Trademark Registration No. 3,114,650. Applicant again traverses this refusal, and requests favorable consideration of same.

In determining a likelihood of confusion, the Examining Attorney must compare the respective marks in their entirety, evaluating the similarity or dissimilarity of the marks in relation to appearance, sound, connotation, and commercial impression, as well as differences or similarities in the respective goods.

In support of the refusal, the Examining Attorney states at page 2 of the Action that "the cited registered mark is DR. JESSICA WU". This statement is incorrect, and appears to have caused the Examining Attorney to base the refusal to register on a faulty premise. More correctly, the registered mark is DR. JESSICA WU COSMECEUTICALS, which results in entirely different considerations to be employed in support of the refusal to register.

When comparing applicant's mark to the cited mark, it is apparent that the respective marks are not identical, but instead differ in appearance, sound, connotation and commercial impression.

Notwithstanding the above, the Examining Attorney takes the position that "applicant's mark has simply deleted the first name in the registered mark, namely JESSICA". The Examining Attorney's logic is ill-founded as the Examining Attorney in such a circumstance fails to view the respective marks in their entirety. Even if JESSICA is removed from the cited mark, the respective marks would not be identical as apparently asserted by the Examining Attorney.

The Examining Attorney appears to equate a disclaimer of the word COSMECEUTICALS with its absence from the registered mark – this is not true, as COSMECEUTICALS remains part of the cited registration, and cannot be divorced from the likelihood of confusion analysis. Indeed, the word COSMECEUTICALS is given equal prominence in the cited registration, and the Examining Attorney must accordingly view the cited mark in relation to applicant's mark in such context. To do otherwise is to ignore the requirements of the law.

The Examining Attorney also takes the position at the paragraph bridging pages 3 and 4 of the Action that "as the goods are virtually the same, consumers are likely to believe that 'Dr. Wu' and 'Dr. Jessica Wu' are the same person, and that the goods emanate from a common source". The Examining Attorney, in taking this position, again ignores a material portion of the cited registration – the issue to be resolved is not whether the consumer might find such persons to be related, but whether there is a likelihood of confusion between the respective marks in their entirety – which there is not for the reasons noted above.

Even if the Examiner's position as to the possibility of confusion as between such persons has merit, the Trademark Office has issued registrations that rebut such a position. Registration No. 2,596,881 previously issued for the mark WU for related and/or similar goods as those of the cited registration. Accordingly, the mark DR. JESSICA WU COSMECEUTICALS was deemed not confusingly similar to the mark WU for related and/or similar goods. This rebuts any inference that the

cited mark should serve to bar the registration of any mark containing the word WU, as the Examining Attorney is asserting in the present instance.

In view of the above, the refusal to register applicant's mark should be withdrawn, and the application allowed.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Joe McKinney Muncy/ Date: 12/01/2009

Signatory's Name: Joe McKinney Muncy

Signatory's Position: Attorney of record, VA bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 76682620

Internet Transmission Date: Tue Dec 01 14:21:29 EST 2009

TEAS Stamp: USPTO/RFR-72.44.190.141-2009120114212937

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