

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 | 77183690 |
| LAW OFFICE ASSIGNED | LAW OFFICE 103 |
| MARK SECTION (no change) | |
| ARGUMENT(S) | |
| <p>Dear Sir:</p> <p style="text-align: center;">Applicant Diabetes America, Inc. hereby responds to the final Office Action electronically mailed on February 23, 2008, in connection with the instant application. Applicant has carefully reviewed the Examining Attorney's comments and submits the following Amendments and Remarks.</p> <p style="text-align: center;"><u>AMENDMENT</u></p> <p>Please delete Applicant's recitation of services in its entirety and replace same with:</p> <p style="text-align: center;">Education services, namely, providing classes, seminars, and computer-assisted learning in the field of health care and diabetes which includes lifestyle education and printed materials distributed in connection therewith; providing information in the field of exercise training; all services rendered from a healthcare facility.</p> <p style="text-align: center;"><u>REMARKS</u></p> <p>The Examining Attorney has accepted Applicant's claim of distinctiveness under Section 2(f) of the Lanham act and has withdrawn the Section 2(e)(2) refusal. However, the Examining Attorney has maintained and made final the refusal of registration under Section 2(d), because in the Examining Attorney's opinion, Applicant's mark ("Mark") so resembles those identified in U.S. Registration Nos. 1218650, 2012343, 2201126, 2558354, and 2707535 (the "Cited Registrations"), the Mark is likely to cause confusion, to cause mistake, or to deceive. For the foregoing reasons, Applicant respectfully requests reconsideration of the refusal and passage of the instant application to publication. In addition, Applicant notifies the Examining Attorney that a Notice of Appeal is</p> | |

concurrently being e-filed.

A. No Likelihood of Confusion

Applicant incorporates its previous responses and maintains that Applicant's Mark is not confusingly similar to the Cited Marks. Applicant has amended its recitation of services and respectfully requests entry.

The marks are dissimilar in sight, sound and commercial impressions. The use of the terms DIABETES and AMERICA (by Applicant) and AMERICAN (by Registrant) is a transposition of the terms. A transposition of terms can obviate a finding of similarity. The Cited Mark uses the term AMERICAN to refer to a person (an American), rather than Applicant's use of the term AMERIDA as a geographic term. In addition, Applicant's first word is DIABETES, while Registrant uses the word AMERICAN. It is appropriate in the instant case to give weight to the first word of Applicant's mark. *See, e.g., Conde Nast Pubs, Inc. v. Miss Quality, Inc.*, 184 U.S.P.Q. 422 (C.C.P.A. 1975) ("COUNTRY VOGUE" not confusingly similar to "VOGUE"); *Aries Systems Corp. v. World Book Inc.*, 26 U.S.P.Q.2d 1926 (T.T.A.B. 1993) (confusion is not likely between applicant's "INFORMATION FINDER" and opposer's "KNOWLEDGE FINDER"); *Mead Johnson & Co. v. Eckes*, 195 U.S.P.Q. 187 (T.T.A.B. 1977) ("METRECAL" and "MINIKAL", for dietary food, held not confusingly similar); , 188 U.S.P.Q. 520 (T.T.A.B. 1975) ("PROTEIN PLUS" not confusingly similar to "PLUS").

The marks have been in concurrent use for many years without confusion. In addition, the fact that the Cited Marks are used by an association (the American Diabetes Association) for the education of its association members, rather than as recited in Applicant's amended recitation of services (where the services are rendered to patients of the health care facility), confusion of the marks is unlikely. Applicant's services are provided by a health care facility, where persons on staff, include licensed physicians and registered nurses. The type of "education" provided by Applicant may be specific to Applicant's patients. In stark contrast, the Cited Marks are used in connection with association services for which the education may be for the association's masses.

Furthermore, the strength of the marks dictates the scope of protection afforded a trademark owner. That is, when a party uses a weak mark, its competitors may come closer to its mark than would be the case with a strong mark without violating its rights. *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353, 22 U.S.P.Q.2d 1453 (Fed. Cir. 1992). The marks in the Cited Registrations are not inherently distinctive. All of the marks in the Cited Registrations rely upon Section 2(f) of the Lanham Act to overcome the weak nature of Registrant's uses of the terms AMERICAN and DIABETES. Therefore, the scope of the marks in the Cited Registrations must be narrowly construed. The fact that the Mark does not share any elements (except for the weak term

DIABETES that Applicant now disclaims) with the Cited Registrations indicates that confusion is unlikely. Furthermore, confusion is unlikely since the terms AMERICA/AMERICAN and DIABETES are transposed and convey a different commercial impression.

Furthermore, a registration on the Principal Register is *prima facie* evidence that the registered mark is valid. 15 U.S.C. 1057(b) (“[A certificate of registration is]...prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate...”) As indicated in the record, Applicant is the owner of U.S. Registration No. 3311219 for the mark DIABETES AMERICA on the Principal Register for health care services (the term DIABETES has been disclaimed). Consequently, Applicant is presumed owner of the mark in connection with health care services. In view of the dissimilarity of the marks, the unrelatedness of the services, a finding of a likelihood of confusion is unwarranted. Applicant respectfully requests withdrawal of the refusal.

Recitation of Services

To clarify Applicant's services, Applicant requests amendment of the application to include the nature of Applicant's services. In particular, Applicant's services are targeted to patients of Applicant's health care facilities. This amendment does not broaden the scope of Applicant's services and thus an amendment of the services is permissible.

Notice of Appeal

So that the Examining Attorney may consider this Request for Reconsideration, Applicant notifies the Examining Attorney that a Notice of Appeal is concurrently e-filed with this Request.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance, and requests passage of the instant application to publication.

GOODS AND/OR SERVICES SECTION (current)

INTERNATIONAL CLASS

041

DESCRIPTION

education services, namely, providing classes, seminars, and computer-assisted learning in the field of health care and diabetes which includes lifestyle education and printed materials distributed in connection therewith; providing information in the field of exercise training

| | |
|--|--------------------------------------|
| FILING BASIS | Section 1(a) |
| FIRST USE ANYWHERE DATE | At least as early as 06/00/1999 |
| FIRST USE IN COMMERCE DATE | At least as early as 06/00/1999 |
| GOODS AND/OR SERVICES SECTION (proposed) | |
| INTERNATIONAL CLASS | 041 |
| DESCRIPTION | |
| Education services, namely, providing classes, seminars, and computer-assisted learning in the field of health care and diabetes which includes lifestyle education and printed materials distributed in connection therewith; providing information in the field of exercise training; all services rendered from a healthcare facility | |
| FILING BASIS | Section 1(a) |
| FIRST USE ANYWHERE DATE | At least as early as 06/00/1999 |
| FIRST USE IN COMMERCE DATE | At least as early as 06/00/1999 |
| CORRESPONDENCE SECTION | |
| NAME | John A. Tang |
| FIRM NAME | Strasburger & Price, LLP |
| INTERNAL ADDRESS | Suite 2200 |
| STREET | 1401 McKinney Street |
| CITY | Houston |
| STATE | Texas |
| ZIP/POSTAL CODE | 77010 |
| COUNTRY | United States |
| PHONE | 713.951.5600 |
| FAX | 713.951.5660 |
| EMAIL | ipdocketing@strasburger.com |
| AUTHORIZED EMAIL COMMUNICATION | Yes |
| SIGNATURE SECTION | |
| RESPONSE SIGNATURE | /John A. Tang/ |
| SIGNATORY'S NAME | John A. Tang |
| SIGNATORY'S POSITION | Attorney of record, Texas bar member |
| DATE SIGNED | 08/25/2008 |

| | |
|-----------------------------------|---|
| AUTHORIZED SIGNATORY | YES |
| CONCURRENT APPEAL NOTICE FILED | YES |
| FILING INFORMATION SECTION | |
| SUBMIT DATE | Mon Aug 25 15:54:12 EDT 2008 |
| TEAS STAMP | USPTO/RFR-198.67.32.103-2 0080825155412559379-77183 690-430901da3c4248c5142cb 3684444937fbb-N/A-N/A-200 80825153651433413 |

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

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **77183690** has been amended as follows:

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

Dear Sir:

Applicant Diabetes America, Inc. hereby responds to the final Office Action electronically mailed on February 23, 2008, in connection with the instant application. Applicant has carefully reviewed the Examining Attorney's comments and submits the following Amendments and Remarks.

AMENDMENT

Please delete Applicant's recitation of services in its entirety and replace same with:

Education services, namely, providing classes, seminars, and computer-assisted learning in the field of health care and diabetes which includes lifestyle education and printed materials distributed in connection therewith; providing information in the field of exercise training; all services rendered from a healthcare facility.

REMARKS

The Examining Attorney has accepted Applicant's claim of distinctiveness under Section 2(f)

of the Lanham act and has withdrawn the Section 2(e)(2) refusal. However, the Examining Attorney has maintained and made final the refusal of registration under Section 2(d), because in the Examining Attorney's opinion, Applicant's mark ("Mark") so resembles those identified in U.S. Registration Nos. 1218650, 2012343, 2201126, 2558354, and 2707535 (the "Cited Registrations"), the Mark is likely to cause confusion, to cause mistake, or to deceive. For the foregoing reasons, Applicant respectfully requests reconsideration of the refusal and passage of the instant application to publication. In addition, Applicant notifies the Examining Attorney that a Notice of Appeal is concurrently being e-filed.

A. No Likelihood of Confusion

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Furthermore, the strength of the marks dictates the scope of protection afforded a trademark owner. That is, when a party uses a weak mark, its competitors may come closer to its mark than would be the case with a strong mark without violating its rights. *Kenner Parker Toys, Inc. v. Rose Art Indus.*,

Inc., 963 F.2d 350, 353, 22 U.S.P.Q.2d 1453 (Fed. Cir. 1992). The marks in the Cited Registrations are not inherently distinctive. All of the marks in the Cited Registrations rely upon Section 2(f) of the Lanham Act to overcome the weak nature of Registrant's uses of the terms AMERICAN and DIABETES. Therefore, the scope of the marks in the Cited Registrations must be narrowly construed. The fact that the Mark does not share any elements (except for the weak term DIABETES that Applicant now disclaims) with the Cited Registrations indicates that confusion is unlikely. Furthermore, confusion is unlikely since the terms AMERICA/AMERICAN and DIABETES are transposed and convey a different commercial impression.

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Notice of Appeal

So that the Examining Attorney may consider this Request for Reconsideration, Applicant notifies the Examining Attorney that a Notice of Appeal is concurrently e-filed with this Request.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance, and requests passage of the instant application to publication.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 041 for education services, namely, providing classes, seminars, and computer-assisted learning in the field of health care and diabetes which includes lifestyle education and printed materials distributed in connection therewith; providing information in the field of exercise training

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 06/00/1999 and first used in commerce at least as early as 06/00/1999, and is now in use in such commerce.

Proposed: Class 041 for Education services, namely, providing classes, seminars, and computer-assisted learning in the field of health care and diabetes which includes lifestyle education and printed materials distributed in connection therewith; providing information in the field of exercise training; all services rendered from a healthcare facility

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 06/00/1999 and first used in commerce at least as early as 06/00/1999, and is now in use in such commerce.

CORRESPONDENCE ADDRESS CHANGE

Applicant proposes to amend the following:

Current: Richard D. Fladung STRASBURGER & PRICE, LLP 1401 MCKINNEY ST STE 2200 HOUSTON TX 77010-4041

Proposed: John A. Tang of Strasburger & Price, LLP, having an address of Suite 2200 1401 McKinney Street Houston, Texas United States 77010, whose e-mail address is ipdocketing@strasburger.com, whose phone number is 713.951.5600 and whose fax number is 713.951.5660.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /John A. Tang/ Date: 08/25/2008

Signatory's Name: John A. Tang

Signatory's Position: Attorney of record, Texas 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 filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Mailing Address: John A. Tang
Strasburger & Price, LLP
Suite 2200

1401 McKinney Street
Houston, Texas 77010

Serial Number: 77183690

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