

ESTTA Tracking number: **ESTTA398572**

Filing date: **03/17/2011**

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

Proceeding	77416487
Applicant	Intuity Medical, Inc.
Applied for Mark	ONE-STEP
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Submission	Reply Brief
Attachments	Intuity Reply Brief.pdf (13 pages)(91183 bytes)
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Signature	/dag/
Date	03/17/2011

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

In re Intuity Medical, Inc.)
)
Consolidated Matter)
)
Serial No.: 77/416484 ONE STEP)
Serial No.: 77/416487 ONE-STEP)
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APPLICANT’S CONSOLIDATED REPLY IN SUPPORT OF APPEAL

Pending before this Board are two Appeal Briefs filed by Applicant, Intuity Medical, Inc. concerning the rejection of Serial Numbers 77/416484 and 77/416487, and the Examining Attorney’s corresponding Appeal Briefs dated February 25, 2011.

Although the filing of a reply brief is not mandatory pursuant to TBMP Section 1203.02(c), Applicant hereby submits this reply to address issues raised for the first time in the Examiner’s Appeal Briefs. Specifically, the Examiner argues, for the first time, that “the letter of consent filed on January 13, 2010, does not evidence an agreement between the parties because it is signed by only one party, the registrant.” First, the *Registrant* granted consent to *Applicant* to register Applicant’s marks. Thus, it is appropriate that the *Registrant* sign the consent agreement. Further, *both* parties have in fact signed a confidential Settlement and Co-Existence Agreement regarding Applicant’s consent to use and register the marks at issue. In fact, the Letters of Consent provided to the Examiner was prepared “[p]ursuant to the Settlement and co-Existence Agreement . . . by and among Intuity Medical, Inc. and MediPurpose Pt. Ltd.” For the Board’s convenience, a redacted copy of the confidential settlement agreement showing the signature of both parties is attached hereto at Declaration of Deborah A. Gubernick

("Gubernick Decl."), Exhibit A. The Letters of Consent is also provided at Gubernick Decl., Exhibit B.

The Examining Attorney also argues, for the first time, that Applicant has not submitted any *evidence* to show the consent agreement was more than a naked consent. The Examiner fails to acknowledge Applicant's explanations regarding Registrant's and Applicant's different trade channels, sophisticated purchasers, and the distinguishing features of their respective marks. She discounts the Letters of Consent and the quotations from the parties' confidential Settlement and Co-Existence Agreement as evidence to support Applicant's request for registration of its ONE STEP and ONE-STEP marks. More surprisingly, the Examiner refuses to give great weight to the Letters of Consent—a requirement well established by case law.

Ultimately, the Examiner's assertion that the parties' agreement is naked consent must fail. Applicant has adequately addressed all issues raised by the Examiner. Applicant respectfully requests the Board review the record in its entirety and grant Intuity Medical, Inc.'s appeal to register Serial Numbers 77/416484 for ONE STEP, and 77/416487 for ONE-STEP.

Dated: March 17, 2011

LATHAM & WATKINS LLP

By: Deborah A. Gubernick

Deborah A. Gubernick
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Attorneys for Applicant
Intuity Medical, Inc.

Dated: March 17, 2011

LATHAM & WATKINS LLP

By: Deborah A. Gubernick

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Costa Mesa, California 92626-1925
(714) 540-1235
Attorneys for Applicant
Intuity Medical, Inc.

EXHIBIT A

SETTLEMENT AND CO-EXISTENCE AGREEMENT
(hereinafter referred to as "Agreement")

This Agreement is made between **Intuity Medical, Inc.** (hereinafter "Intuity Medical") on the one hand, with registered address at 350 Potrero Avenue, Sunnyvale, CA 94085, and **MediPurpose Pte. Ltd** (hereinafter "MediPurpose") on the other hand, with registered address at 15 Hoe Chiang Road, #12-02 Tower Fifteen, Singapore 089316 (collectively, "the Parties").

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Phone: (404) 885-3406
Fax: (404) 962-6785
Email: daniele.bourgeois@troutmansanders.com

Place and date: Intuity 11/30/09

For:
Intuity Medical, Inc.


Signature:
Name: ROBIN GAFFNEY
Capacity: Director of Marketing

Place and date: Novexross 12/2/09

For:
MediPurpose Pte. Ltd.

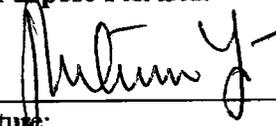

Signature:
Name: PATRICK YI
Capacity: CEO

EXHIBIT B

LETTERS OF CONSENT

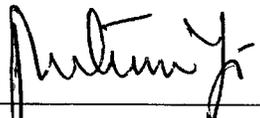
Intuity Medical, Inc., a corporation organized and existing under the laws of California, located at 350 Potrero Avenue, Sunnyvale, CA 94085, United States of America, is the owner of U.S. Trademark Application Serial Numbers 77/416,484 and 77/416,487 for the marks **ONE STEP** and **ONE-STEP**, respectively.

MediPurpose Pte. Ltd, a limited liability company organized and existing under the laws of Singapore, located at 15 Hoe Chiang Road, #12-02 Tower Fifteen, Singapore 089316, is the owner of U.S. Trademark Registration Number 2,719,496 for the mark **ONE-STEP (Stylized)**, U.S. Trademark Registration Number 2,922,552 for the mark **ONE-STEP**, and U.S. Trademark Registration Number 2,969,890 for the mark **ONE-STEP SAFETY LANCET**.

Pursuant to the Settlement and Co-Existence Agreement dated as of the date hereof by and among Intuity Medical, Inc. and MediPurpose Pte. Ltd, MediPurpose Pte. Ltd hereby grants its consent for Intuity Medical, Inc. to use and obtain registration in the United States and internationally of its **ONE STEP** and **ONE-STEP** marks in connection with the following goods: *blood glucose monitoring systems including the devices, and parts and accessories thereof* in Class 10.

MediPurpose Pte. Ltd

Dated: 2 Dec 2009

By: 

Name: PATRIEK YI

Title: CEO