

From: King, Linda

Sent: 10/21/2011 9:05:51 AM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 77628373 - IPSEN INNOVATION
FOR PATIENT CARE - 752301-8038 - SU - Request for Reconsideration Denied -
Return to TTAB

Attachment Information:

Count: 1

Files: 77628373.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 77628373

MARK: IPSEN INNOVATION FOR PATIENT CARE



CORRESPONDENT ADDRESS:
WILLIAM S. FROMMER, ESQ.
FROMMER LAWRENCE & HAUG LLP
745 5TH AVE
NEW YORK, NY 10151-0099

GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: IPSEN S.A.

CORRESPONDENT'S REFERENCE/DOCKET NO:
752301-8038

CORRESPONDENT E-MAIL ADDRESS:
docket@flhlaw.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 10/21/2011

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a), 715.04(a). The specimen requirement made final in the Office action dated March 31, 2011 is maintained as final for the reasons indicated below. *See* TMEP §§715.03(a), 715.04(a). Furthermore, the amendment of the identification of goods cannot be accepted for the reasons indicated below.

Identification of Goods

The identification of goods is indefinite and must be clarified because it is overly broad. *See* TMEP §1402.01. Applicant may adopt the following identification, if accurate:

Pharmaceutical preparations for *the treatment of* oncology, endocrinology, neurology, hematology, gastroenterology, cardiovascular and cognitive disorders.

For further assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netathtml/tidm.html>. *See* TMEP §1402.04.

An applicant may amend an identification of goods only to clarify or limit the goods; adding to or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*

Specimen

The specimen is not acceptable because it is a printer's proof and thus does not show the applied-for mark in use in commerce. Printer's proofs are printed materials in draft form used for making corrections before a final print run. As such, they are not disseminated to the public and do not show use of the mark in the ordinary course of trade on the actual goods that are sold or transported in commerce. *See In re The Signal Cos.*, 228 USPQ 956, 957-58 n.4 (TTAB 1986); TMEP §§904.04(a), 904.07(a).

Trademark Act Section 45 requires that the mark be in "use in commerce" and defines such term to mean "the bona fide use of a mark in the ordinary course of trade." 15 U.S.C. §1127. A mark is used in commerce in relation to goods when it is used on the goods, containers for the goods, displays associated with the goods or tags or labels affixed to the goods, and the goods are sold or transported in commerce. 15 U.S.C. §1127; TMEP §901.01; *see* 37 C.F.R. §2.56(b)(1).

Furthermore, the proposed mark only appears on the rectangle below the mock-up of the packaging. It is unclear how the proposed mark will be used on the packaging.

A statement of use must include a specimen showing the applied-for mark in use in commerce for each class of goods specified in the statement of use. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56(a), 2.88(b)(2); TMEP §§904, 1109.09(b).

Therefore, applicant must submit the following:

- (1) A substitute specimen showing the mark in use in commerce for each class of goods specified in the statement of use; and
- (2) The following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: "**The substitute specimen was in use in commerce prior to the expiration of the deadline for filing the statement of use.**" 37 C.F.R. §2.59(b)(2); TMEP §904.05; *see* 37 C.F.R. §2.193(e)(1). If submitting a substitute specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c); TMEP §904.05.

Examples of specimens for goods are tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging, or displays associated with the actual goods at their point of sale. *See* TMEP §§904.03 *et seq.*

Applicant may not withdraw the statement of use. 37 C.F.R. §2.88(g); TMEP §1109.17.

In the present case, applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issues in the final Office action. In addition, applicant's analysis and

arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §§715.03, 715.03(a), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

/Linda M. King/
Trademark Attorney
Law Office 116
571-272-9180
Linda.King@uspto.gov