

FILE NO. : 5744-134 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: OCI Nitrogen B.V.
Serial No.: 79/096,066
Mark: OCI
Filing Date: March 17, 2011
International Classes: 1, 19 and 37
Examining Attorney: Jessica Ellinger Fathy
Trademark Examining Attorney
Law Office 110

AMENDMENT AND RESPONSE

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

Dear Sir:

Applicant is in receipt of the February 7, 2012 Office Action issued in connection with the above-captioned trademark application and hereby responds as follows:

AMENDMENTS

Applicant hereby amends this United States trademark application as indicated below:



07-23-2012

1. The identification of goods and recitation of services is hereby amended to read:

International Class 1: no change required

International Class 19: to be deleted

International Class 37: no change required

REMARKS

The Examining Attorney has reviewed Applicant's December 29, 2011 Amendment and Response and has maintained the Trademark Act Section 2(d) refusal based on United States Trademark Registration Number 3,953,513. In addition, the Examiner indicated that Applicant must further amend the identification of International Class 19 goods. Applicant responds to the issues raised by the Examiner as follows::

With regard to the Examining Attorney's refusal under Trademark Act Section 2(d), in support of registration of its mark, Applicant submits herewith at Exhibit A, a copy of the consent agreement executed by OCI Company Ltd., the owner of the cited registration. The consent agreement, entitled "Letter of Consent to Registration," was executed on February 14, 2012 by Cho Y. J., Managing Director of OCI Company Ltd. (as well as by the CEO and CFO of Applicant) and consents to the registration of Applicant's OCI trademark in the United States. Consequently, Applicant asserts that such evidence allows for registration of Applicant's mark.

It was held by the Court of Customs and Patent Appeals:

... when those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not. [Emphasis in original.]

In re E.I. du Pont de Nemours & Co., 177 USPQ 563, 568 (C.C.P.A. 1973)

The Federal Circuit has consistently upheld that consent agreements are to be accorded great weight. In *Bongrain International (American) Corporation v. Delice de France Inc.*, 1 USPQ 2d 1775 (Fed. Cir. 1987), the Federal Circuit stated:

We have often said, in trademark cases involving agreements reflecting parties' views on the likelihood of confusion in the marketplace, that they are in a much better position to know the real life situation than bureaucrats or judges and therefore such agreements may, depending upon the circumstances, carry great weight as was held in *DuPont*.

Bongrain International (American) Corporation v. Delice de France Inc., 1 USPQ 2d 1775, 1778 (Fed. Cir. 1987).

Moreover, in *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, the Court reiterated the CCPA's observations in *DuPont*:

Decisions of men who stand to lose if wrong are normally more reliable than those of examiner's and judges.

476 F.2d at 1363, 177 USPQ at 568.

It can be safely taken as fundamental that reputable businessmen – users of valuable trademarks have no interest in *causing* public confusion. [Emphasis in original.]

Id. At 1362, 177 USPQ at 568.

Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988)

For the reasons expressed by the Federal Circuit and its predecessor, the Court of Customs and Patent Appeals, Applicant asserts that the attached consent agreement supports registration of the OCI trademark by Applicant. Clearly, the owner of the cited OCI (STYLIZED) trademark registration has no concerns that there would be likelihood of confusion among consumers. For that reason, Applicant asserts that the Trademark Act Section 2(d) refusal should be withdrawn since the attached Agreement presents sufficient evidence precluding any likelihood of confusion in the marketplace.

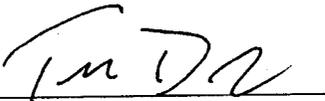
With regard to the identification of goods, Applicant has deleted International Class 19 from the application. Based on this and because the Examiner has already accepted the identification of International Class 1 goods and recitation of International Class 37 services, Applicant now believes that the identification of goods and recitation of services is in acceptable format for publication purposes.

Based on the foregoing, it is respectfully requested that the Examiner now pass this

application forward to publication at the earliest opportunity. If there are any final changes or modifications that can be handled by Examiner's Amendment, the Examiner is encouraged to contact the undersigned directly by telephone.

Respectfully submitted,

OCI Nitrogen B.V

BY: 
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Dated: 7/18/2012

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

7/18/2012
(Date of Deposit)


(Signature)

7/18/2012
(Date of Signature)

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Trademark Application Serial No. 79/096,066 for the mark OCI
Trademark Application Serial No. 85/450,717 for the mark OCI
Trademark Application Serial No. 85/433,301 for the mark OCI NITROGEN
(STYLIZED) & DESIGN

Applicant: OCI Nitrogen B.V.

LETTER OF CONSENT TO REGISTRATION

This letter confirms that OCI Company Ltd. ("Registrant") is the owner of United States Trademark Registration Number 3,953,513 for the mark OCI (STYLIZED).

Registrant hereby consents to the use and registration of the trademark OCI, United States Trademark Application Serial Numbers 79/096,066 and 85/450,717 as well as the use and registration of the trademark OCI NITROGEN (STYLIZED) & DESIGN, United States Trademark Application Serial Number 85/433,301, by Applicant OCI Nitrogen B.V. for the goods and services listed in United States Trademark Application Serial Numbers 79/096,066; 85/450,717 and 85/433,301.

The basis for this consent is our mutual determination that there is no likelihood that consumers have been or will be confused by the use and registration of the marks.

In order to carry out the intent of this consent agreement, the parties agree to continue to cooperate in taking any reasonable action to avoid confusion and to correct any instances or likelihood of confusion which come to their attention.

Dated: Seoul, Republic of Korea

OCI Company Ltd.

14 of Feb, 2012

BY:

조운제
Name: Cho. Y. J.
Title: Managing Director.

Dated: Geleen, Netherlands

OCI Nitrogen B.V.

10 of April, 2012

BY:

R. ZWIERS
Name: R. ZWIERS
Title: CEO

J. DEYBERGE
Name: J. DEYBERGE
Title: CFO