

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79107541
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The Examiner has rejected the application under section 2(d) on the grounds that the mark sought to be registered is likely to be confused with that which is the subject of Registration Nos. 3880248 and 1823470. Said refusal of registration has been made final. Inasmuch as Applicant owns U.S. Registration No.3168623 of the typewritten word MAAG for gear pumps and parts thereof, namely, filter, chucks, extruders, supercharger kits for gear pumps and Registration No. 1872218 of the mark MAAG PUMP SYSTEMS & Design for computer programs for controlling motor driven gear pumps and said registrations have co-existed with the cited registrations of the marks MAAG FL SMIDTH and MAAG & Design even though they are owned by two different entities, Applicant submits the mark MAAG GROUP & Design in the subject application can co-exist on the Register as well. To further support Applicant's request, Applicant submits the Statement of Consent to Use and Register provided by Registrant and executed by Registrant's Senior Vice President Group General Counsel, MGT, Annete Hoi Butt Terndrup. Based Applicant's ownership of Registration Nos. 3168623 and 1872218 and the Statement of Consent to Use and Register, Applicant requests reconsideration and withdrawal of the final refusal.</p>	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_1082811015-220949546 . 130314 Signed letter of consent Maag US.pdf
CONVERTED PDF FILE(S) (4 pages)	\\TICRS\EXPORT16\IMAGEOUT16\791\075\79107541\xml4\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\791\075\79107541\xml4\RFR0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\791\075\79107541\xml4\RFR0004.JPG
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DESCRIPTION OF EVIDENCE FILE	Signed Statement of Consent to Use and Register

GOODS AND/OR SERVICES SECTION (007)(current)

INTERNATIONAL CLASS

007

DESCRIPTION

Pumps, namely, chemical and industrial pumps, elastomer extrusion pumps, thermoplast extrusion pumps, polymer production pumps and electric pumps; extruding machines, namely, polymer extruding machines and polymer mixing machines; gear pumps and the parts thereof; handling apparatus for loading and unloading for gear pumps; filters; machine parts, namely, mandrels; screen changers, namely, polymer filtration machines; superchargers; extrusion nozzles, namely, extrusion nozzles sold as an integral component of extrusion machines and automatic extrusion nozzles; mixing machines; machines and the parts thereof; machines for the manufacture and processing of plastics; machine accessories, namely nozzle rings, suction apparatus and water installations, all included in this class; grinders; spinning frames

GOODS AND/OR SERVICES SECTION (007)(proposed)

INTERNATIONAL CLASS

007

TRACKED TEXT DESCRIPTION

~~Pumps, namely, chemical and industrial pumps, elastomer extrusion pumps, thermoplast extrusion pumps, polymer production pumps and electric pumps;~~ Extruding machines, namely, polymer extruding machines and polymer mixing machines; pumps, namely, chemical and industrial compressed air, lubricating, oil drain, pneumatic and electric pumps, elastomer extrusion pumps, thermoplast extrusion compressed air, lubricating, oil drain, pneumatic and electric pumps, polymer production compressed air, lubricating, oil drain, pneumatic and electric pumps and electric gear pumps and the parts thereof; ~~gear pumps and the parts thereof;~~ gear compressed air, lubricating, oil drain, pneumatic and electric pumps and their parts; ~~handling apparatus for loading and unloading for gear pumps;~~ handling apparatus for loading and unloading for gear pumps, namely, front end loaders, loading and unloading machines; ~~filters;~~ filters, namely, oil filters, filters for front end loading machines, air filters for automobile engines; ~~machine parts, namely, mandrels;~~ machine parts, namely, chucks for power drills, drill chucks for power drills; screen changers, namely, polymer filtration machines; ~~superchargers;~~ superchargers for gears; ~~extrusion nozzles, namely, extrusion nozzles sold as an integral component of extrusion machines and automatic extrusion nozzles;~~ extrusion nozzles, namely, extrusion nozzles sold as an integral component of extrusion machines thermoplastic extrusion and automatic extrusion nozzles; mixing machines; ~~machines and the parts thereof;~~ ~~machines for the manufacture and processing of plastics;~~ ~~machine accessories, namely nozzle rings, suction apparatus and water installations, all included in this class;~~ ~~grinders;~~ ~~spinning frames~~

FINAL DESCRIPTION

Extruding machines, namely, polymer extruding machines and polymer mixing machines; pumps, namely, chemical and industrial compressed air, lubricating, oil drain, pneumatic and electric pumps, elastomer extrusion pumps, thermoplast extrusion compressed air, lubricating, oil drain, pneumatic and electric pumps, polymer production compressed air, lubricating, oil drain, pneumatic and electric pumps and electric gear pumps and the parts thereof; gear compressed air, lubricating, oil drain, pneumatic and electric pumps and their parts; handling apparatus for loading and unloading for gear pumps, namely, front end loaders, loading and unloading machines; filters, namely, oil filters, filters for front end loading machines, air filters for automobile engines; machine parts, namely, chucks for power drills,

drill chucks for power drills; screen changers, namely, polymer filtration machines; superchargers for gears; extrusion nozzles, namely, extrusion nozzles sold as an integral component of extrusion machines thermoplastic extrusion and automatic extrusion nozzles; mixing machines

GOODS AND/OR SERVICES SECTION (009)(no change)

GOODS AND/OR SERVICES SECTION (040)(no change)

GOODS AND/OR SERVICES SECTION (042)(no change)

ADDITIONAL STATEMENTS SECTION

PRIOR REGISTRATION(S)	The applicant claims ownership of U.S. Registration Number(s) 3168623 and 1872218.
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SIGNATURE SECTION

RESPONSE SIGNATURE	/eric t. fingerhut/
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SIGNATORY'S NAME	Eric Fingerhut
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SIGNATORY'S POSITION	Attorney of record, DC Bar Member
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DATE SIGNED	03/18/2013
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AUTHORIZED SIGNATORY	YES
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CONCURRENT APPEAL NOTICE FILED	NO
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FILING INFORMATION SECTION

SUBMIT DATE	Mon Mar 18 22:22:28 EDT 2013
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TEAS STAMP	USPTO/RFR-108.28.110.15-2 0130318222228485045-79107 541-500186e363dd41c9a1b07 ac86782f516f521de49494416 ca637478383c2507b1c-N/A-N /A-20130318220949546298
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**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **79107541** has been amended as follows:

ARGUMENT(S)

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

The Examiner has rejected the application under section 2(d) on the grounds that the mark sought to be registered is likely to be confused with that which is the subject of Registration Nos. 3880248 and 1823470. Said refusal of registration has been made final. Inasmuch as Applicant owns U.S. Registration No.3168623 of the typewritten word MAAG for gear pumps and parts thereof, namely, filter, chucks, extruders, supercharger kits for gear pumps and Registration No. 1872218 of the mark MAAG PUMP SYSTEMS & Design for computer programs for controlling motor driven gear pumps and said registrations have co-existed with the cited registrations of the marks MAAG FL SMIDTH and MAAG & Design even though they are owned by two different entities, Applicant submits the mark MAAG GROUP & Design in the subject application can co-exist on the Register as well. To further support Applicant's request, Applicant submits the Statement of Consent to Use and Register provided by Registrant and executed by Registrant's Senior Vice President Group General Counsel, MGT, Annete Hoi Butt Terndrup. Based Applicant's ownership of Registration Nos. 3168623 and 1872218 and the Statement of Consent to Use and Register, Applicant requests reconsideration and withdrawal of the final refusal.

EVIDENCE

Evidence in the nature of Signed Statement of Consent to Use and Register has been attached.

Original PDF file:

[evi_1082811015-220949546 . 130314 Signed letter of consent Maag US.pdf](#)

Converted PDF file(s) (4 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Current: Class 007 for Pumps, namely, chemical and industrial pumps, elastomer extrusion pumps, thermoplast extrusion pumps, polymer production pumps and electric pumps; extruding machines, namely, polymer extruding machines and polymer mixing machines; gear pumps and the parts thereof; handling apparatus for loading and unloading for gear pumps; filters; machine parts, namely, mandrels; screen changers, namely, polymer filtration machines; superchargers; extrusion nozzles, namely, extrusion nozzles sold as an integral component of extrusion machines and automatic extrusion nozzles; mixing machines; machines and the parts thereof; machines for the manufacture and processing of plastics; machine accessories, namely nozzle rings, suction apparatus and water installations, all included in this class; grinders; spinning frames

Original Filing Basis:

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~Pumps, namely, chemical and industrial pumps, elastomer extrusion pumps, thermoplast extrusion pumps, polymer production pumps and electric pumps~~; Extruding machines, namely, polymer extruding machines and polymer mixing machines; [pumps, namely, chemical and industrial compressed air, lubricating, oil drain, pneumatic and electric pumps, elastomer extrusion pumps, thermoplast extrusion compressed air, lubricating, oil drain, pneumatic and electric pumps, polymer production compressed air, lubricating, oil drain, pneumatic and electric pumps and electric gear pumps](#)

~~and the parts thereof; gear pumps and the parts thereof; gear compressed air, lubricating, oil drain, pneumatic and electric pumps and their parts; handling apparatus for loading and unloading for gear pumps; handling apparatus for loading and unloading for gear pumps, namely, front end loaders, loading and unloading machines; filters; filters, namely, oil filters, filters for front end loading machines, air filters for automobile engines; machine parts, namely, mandrels; machine parts, namely, chucks for power drills, drill chucks for power drills; screen changers, namely, polymer filtration machines; superchargers; superchargers for gears; extrusion nozzles, namely, extrusion nozzles sold as an integral component of extrusion machines and automatic extrusion nozzles; extrusion nozzles, namely, extrusion nozzles sold as an integral component of extrusion machines thermoplastic extrusion and automatic extrusion nozzles; mixing machines; machines and the parts thereof; machines for the manufacture and processing of plastics; machine accessories, namely nozzle rings, suction apparatus and water installations, all included in this class; grinders; spinning frames~~

Class 007 for Extruding machines, namely, polymer extruding machines and polymer mixing machines; pumps, namely, chemical and industrial compressed air, lubricating, oil drain, pneumatic and electric pumps, elastomer extrusion pumps, thermoplast extrusion compressed air, lubricating, oil drain, pneumatic and electric pumps, polymer production compressed air, lubricating, oil drain, pneumatic and electric pumps and electric gear pumps and the parts thereof; gear compressed air, lubricating, oil drain, pneumatic and electric pumps and their parts; handling apparatus for loading and unloading for gear pumps, namely, front end loaders, loading and unloading machines; filters, namely, oil filters, filters for front end loading machines, air filters for automobile engines; machine parts, namely, chucks for power drills, drill chucks for power drills; screen changers, namely, polymer filtration machines; superchargers for gears; extrusion nozzles, namely, extrusion nozzles sold as an integral component of extrusion machines thermoplastic extrusion and automatic extrusion nozzles; mixing machines

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

ADDITIONAL STATEMENTS

Claim of Prior Registration(s)

The applicant claims ownership of U.S. Registration Number(s) 3168623 and 1872218.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /eric t. fingerhut/ Date: 03/18/2013

Signatory's Name: Eric Fingerhut

Signatory's Position: Attorney of record, DC 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: 79107541

Internet Transmission Date: Mon Mar 18 22:22:28 EDT 2013

TEAS Stamp: USPTO/RFR-108.28.110.15-2013031822222848

5045-79107541-500186e363dd41c9a1b07ac867

82f516f521de49494416ca637478383c2507b1c-

N/A-N/A-20130318220949546298

STATEMENT OF CONSENT TO USE AND REGISTER

The undersigned officer of FLSMIDTH A/S, a corporation of Denmark (hereinafter "FLSMIDTH") and owner of United States Registration Nos. 1,823,470 for the mark MAAG & Design for "machine parts; namely, gear mechanisms, gear wheels, gear synchronizing couplings, planetary gearings, pinion/greater wheels in Class 7 and electrical monitoring and control apparatus for ear mechanisms in Class 9" and 3,880,248 for the mark MAAG FLSMIDTH & Design for "gears and enclosed drives for industrial machinery in Class 7" (hereinafter "FLSMIDTH's MAAG Marks") does hereby declare and state as follows:

1. I am currently the Senior Vice President Group General Counsel, MGT of FLSMIDTH, owner of FLSMIDTH's MAAG marks and U.S. Registration Nos. 1,823,470 and 3,880,248, and have held this position for the past 1 year. I am familiar with the facts surrounding the use of FLSMIDTH's MAAG marks for the goods covered by the above-identified registrations.

2. I also am aware that Maag Pump Systems AG, a corporation of Switzerland (hereinafter "MPS") has filed Applications Service Nos. 79/107,104 and 79/107,541 seeking registration of the marks MAAG PUMP SYSTEMS & Designs for "extruding machines, namely, polymer extruding machines and polymer mixing machines; pumps, namely, chemical and industrial pumps, elastomer extrusion pumps, thermoplast extrusion pumps, polymer production pumps and electric pumps gear pumps and the parts thereof; gear pumps and their parts; handling apparatus for loading and unloading for gear pumps; filters; machine parts, namely, chucks; screen

changers, namely, polymer filtration machines; superchargers; extrusion nozzles, namely, extrusion nozzles sold as an integral component of extrusion machines and automatic extrusion nozzles; mixing machines, in Class 7; and monitoring apparatus, electric, namely, control systems for gear pumps and extruding machines, namely, polymer extruding machines; pressure measuring apparatus, all in connection with extruding machines, gear pumps and their parts, namely, pressure gauges, pressure sensors and pressure indicators; and handling apparatus for gear pumps, namely, pressure gauges, pressure sensors and pressure indicators, in Class 9" and MAAG GROUP & Design for "pumps, namely, chemical and industrial pumps, elastomer extrusion pumps, thermoplast extrusion pumps, polymer production pumps and electric pumps; extruding machines, namely, polymer extruding machines and polymer mixing machines; gear pumps and the parts thereof; handling apparatus for loading and unloading for gear pumps; filters; machine parts, namely, mandrels; screen changers, namely, polymer filtration machines; superchargers; extrusion nozzles, namely, extrusion nozzles sold as an integral component of extrusion machines and automatic extrusion nozzles; mixing machines; machines and the parts thereof; machines for the manufacture and processing of plastics; machine accessories, namely, nozzle rings, suction apparatus and water installations, all included in this class; grinders; spinning frames, in Class 7; electric monitoring apparatus, namely, control systems for gear pumps and extruding machines, namely, polymer extruding machines; pressure measuring apparatus, all in connection with extruding machines, gear pumps and their parts, namely, pressure gauges, pressure sensors and pressure indicators; and handling apparatus for gear pumps, namely, pressure gauges, pressure sensors and pressure

indicators, in Class 9; grinding services in Class 40; and engineering services in Class 42" (hereinafter, both these marks are referred to as "MPS' MAAG marks").

3. FLSMIDTH and MPS are completely separate companies who have agreed to co-exist in the U.S. marketplace and on the U.S. Trademark Register, with each party having authorized the other to own, register and use the mark MAAG for the goods and, where applicable, services covered by their registrations and pending applications. In fact, FLSMIDTH's MAAG Marks and MPS' Marks for which registration is now sought have both been in use continuously by the parties since October 2011.

4. During the 1,5 years in which FLSMIDTH's MAAG Marks and MPS' MAAG Marks have co-existed there has been no known instance of confusion as to the source of the goods nor any evidence of the same.

5. Based upon my experience in the industry, so long as MPS' marks and goods and services are restricted to the form of the marks shown in the MPS MAAG Marks and the goods and services listed in paragraph 2 above, FLSMIDTH's and MPS' respective goods and service would not be considered to be closely related by the purchasers of these goods and services. In particular, FLSMIDTH's MAAG logo is different from MPS' MAAG logo. Moreover, FLSMIDTH is focused on gears and related machinery whereas MPS is focusing on pumps and related machinery. Both gears and pumps are very expensive and such goods are purchased with great care.

6. In order to insure that there will be no likelihood of confusion in the future, FLSMIDTH and MPS will consult with each other in the unlikely event of any actual confusion about how best to avoid confusion thereafter.

7. In view of the above, FLSMIDTH, owner of Registration Nos. 1,823,470 and 3,880,248, hereby gives its consent to the registration of MPS' marks as presented in applications SN 79/107,104 and 79/107,541.

FLSMIDTH A/S



Anette Høi Butt Terndrup, Senior Vice
President Group General Counsel, MGT