

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 79107898

MARK: IVAC

79107898

CORRESPONDENT ADDRESS:

KATHRYN E GARIPAY
OLSON & CEPURITIS LTD
20 NORTH WACKER DRIVE 36TH FLOOR
CHICAGO, IL 60606

GENERAL TRADEMARK INFORMATION
<http://www.uspto.gov/trademarks/index.jsp>

APPLICANT: Ribological GmbH

CORRESPONDENT'S REFERENCE/DOCKET NO :

N/A

CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

INTERNATIONAL REGISTRATION NO. 1103583

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)(2)(B), (a)(2)(E), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated October 30, 2013, are maintained and continue to be FINAL. *See* TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, the applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) 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.

With its response, the applicant argued that the applied-for and registered mark are not similar and submitted a dictionary definition. This evidence is cumulative of the evidence already in the record. The applicant argues that because its mark ends in C and the registered mark ends in X that they do not sound the same. Words that end with a C can sound similar to those that end with an X and vice versa. Slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983); *see In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012). The marks are highly similar in sound, appearance, connotation and commercial impression. Attached hereto is additional evidence showing third-parties using the letters -AX to end words instead of C/K, C/KS or CKS.

In its request for reconsideration, the applicant states that the Examining Attorney said that the plural of the applied-for mark is IVAX. That is not accurate. The Examining Attorney did not state that the plural form of the applied-for mark is IVAX.

In the Office action mailed February 7, 2012, the Examining Attorney wrote that “The registrant’s marks are the phonetic equivalent of the plural form of the applicant’s mark.” Here, the plural of the applicant’s mark is presumably IVACS. The applicant appears to agree to this determination on page 2 of the request for reconsideration. Thus, the plural of the applied-for mark, which is IVACS, is the phonetic equivalent of the registered marks, IVAX.

Plural and singular terms are essentially the same mark in a likelihood of confusion analysis. *See Wilson v. Delaunay*, 245 F.2d 877, 878, 114 USPQ 339, 341 (C.C.P.A. 1957) (finding no material difference between the singular and plural forms of ZOMBIE such that the marks were considered the same mark); *In re Pix of Am., Inc.*, 225 USPQ 691, 692 (TTAB 1985) (noting that the pluralization of NEWPORT is “almost totally insignificant” in terms of likelihood of confusion among purchasers); *In re Sarjanian*, 136 USPQ 307, 308 (TTAB 1962) (finding no material difference between the singular and plural forms of RED DEVIL).

The applicant’s arguments regarding likelihood of confusion were considered again but found unpersuasive. Thus, the final refusal under Trademark Act Section 2(d), 15 U.S.C. §1052(d), with respect to U.S. Registration Nos. 2834931 and 2884993, is *maintained*. 37 C.F.R. §2.64(a).

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, (a)(2)(B), (a)(2)(E), (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)(2)(B), (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).

/LeighLowry/
Leigh A. Lowry
Trademark Examining Attorney
leigh.lowry@uspto.gov (informal only)
Law Office 115
(571) 272-9725

Print: May 6, 2013

76322978

DESIGN MARK

Serial Number

76322978

Status

REGISTERED AND RENEWED

Word Mark

PEPPERJAX GRILL

Standard Character Mark

No

Registration Number

2591503

Date Registered

2002/07/09

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

ROHWER, GARY L. INDIVIDUAL UNITED STATES 12606 Burt Street OMAHA
NEBRASKA 681544014

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: RESTAURANT
SERVICES. First Use: 2001/09/01. First Use In Commerce: 2001/09/01.

Prior Registration(s)

1913979

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GRILL" APART FROM THE
MARK AS SHOWN.

Filing Date

2001/10/09

Examining Attorney

BEYER, BROOKE

Attorney of Record

Print: May 6, 2013

76322978

KEITH A. GREEN

PEPPERJAX GRILL

Print: May 6, 2013

76622216

DESIGN MARK

Serial Number

76622216

Status

REGISTERED

Word Mark

MAXRAX.

Standard Character Mark

Yes

Registration Number

3159562

Date Registered

2006/10/17

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

HORROCKS, SHANE M INDIVIDUAL UNITED STATES 192 FM 1713 WHITNEY TEXAS
76892

Goods/Services

Class Status -- ACTIVE. IC 031. US 001 046. G & S: Live stock
feed. First Use: 2006/01/15. First Use In Commerce: 2006/06/01.

Filing Date

2004/11/26

Examining Attorney

HUGHITT, ELIZABETH

MAXRAX.

Print: May 6, 2013

76658342

DESIGN MARK

Serial Number

76658342

Status

REGISTERED

Word Mark

WETPAX

Standard Character Mark

Yes

Registration Number

3462819

Date Registered

2008/07/08

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Palma, Sandra L. INDIVIDUAL UNITED STATES 13504 Springhaven Drive
Fairfax VIRGINIA 22033

Goods/Services

Class Status -- ACTIVE. IC 010. US 026 039 044. G & S: water repellent and water proof covers for PICC lines, intravenous drug delivery lines, casts, splints, and other medical dressings. First Use: 2007/06/00. First Use In Commerce: 2007/06/00.

Filing Date

2006/04/12

Examining Attorney

ESTRADA, LINDA

Attorney of Record

John C. Eisenhart

WETPAX

DESIGN MARK

Serial Number

77776712

Status

REGISTERED

Word Mark

ANYTRAX

Standard Character Mark

Yes

Registration Number

4283267

Date Registered

2013/01/29

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

AnyTransactions, Inc. CORPORATION GEORGIA Suite 490 125 Clairemont
Avenue Decatur GEORGIA 30030

Goods/Services

Class Status -- ACTIVE. IC 045. US 100 101. G & S: Electronic monitoring and supervision services in the field of corrections, law enforcement, social services, healthcare, case management and judicial fields, and other government and business entities, namely, monitoring of individuals under the control of a duly authorized official, in the nature of monitoring individuals under house arrest, or individuals under restricted activity status, or individuals required to comply with program conditions, or individuals required to report matters regarding their physical or mental health using automated voice interactive telephone systems or computers which authenticate the individual with biometrics, in order to determine compliance with applicable conditions, deliver messages as applicable to those or other conditions, document contact results, generate exceptions, and generate alarms to authorities using phones, pagers, faxes or e-mail; electronic supervision services in the nature of identification verification, namely, providing authentication of personal identification information to and from an individual and their duly

authorized official having responsibility for their respective case plan by determining locations of individuals under supervision using automatic phone number identification or automatic location identification via automated computer telephone systems in order to confirm an individual is in compliance with applicable conditions and documenting contact results, generating exceptions, and generating alarms and messages to authorities, all of said services are rendered in association with legal compliance, courts and/or criminals, namely, court imposed legal restrictions, court orders for probation, pretrial issues, trial issues, parole, juvenile actions, client/attorney issues, curfews, court dates, drug tests, legal appointments, self reporting matters, and legal matters and/or court imposed sentencing requirements. First Use: 2009/08/23. First Use In Commerce: 2009/08/23.

Goods/Services

Class Status -- ACTIVE. IC 038. US 100 101 104. G & S: Automated communication services in the field of corrections, law enforcement, social services, healthcare, case management fields, and other government and business entities, namely, conducting confirmed two-way communications with individuals under the control of a duly authorized official, such as monitoring individuals under house arrest, or individuals under restricted activity status, or individuals required to comply with program conditions, or individuals required to report matters regarding their physical or mental health using automated voice interactive telephone systems or computers which authenticate the individual with biometrics, in order to determine compliance with applicable conditions, deliver messages as applicable to those or other conditions, document contact results, generate exceptions, and generate alarms to authorities using phones, pagers, faxes or e-mail; all of said services are rendered in association with legal compliance, courts and/or criminals, namely, court imposed legal restrictions, court orders for probation, pretrial issues, trial issues, parole, juvenile actions, client/attorney issues, curfews, court dates, drug tests, legal appointments, self reporting matters, and legal matters and/or court imposed sentencing requirements. First Use: 2009/08/23. First Use In Commerce: 2009/08/23.

Filing Date

2009/07/08

Examining Attorney

MISTER, KATINA

Attorney of Record

Dale Lischer

ANYTRAX

Print: May 6, 2013

85096729

DESIGN MARK

Serial Number

85096729

Status

REGISTERED

Word Mark

MEDI-SNAX

Standard Character Mark

Yes

Registration Number

3937861

Date Registered

2011/03/29

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Blue Sky Bakery, Inc. CORPORATION WYOMING 275 1437 N. Denver Ave.
Loveland COLORADO 80538

Goods/Services

Class Status -- ACTIVE. IC 005. US 006 018 044 046 051 052. G & S:
Foods for individuals with special dietary requirements necessitated
by medical treatments. First Use: 2010/01/10. First Use In Commerce:
2010/01/10.

Filing Date

2010/07/30

Examining Attorney

SMITH, BRIDGETT

Medi-Snax

Print: May 6, 2013

85147376

DESIGN MARK

Serial Number

85147376

Status

REGISTERED

Word Mark

MEDPAX

Standard Character Mark

Yes

Registration Number

4139843

Date Registered

2012/05/08

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

MEDPAX LLC LIMITED LIABILITY COMPANY OHIO 2925 Eaton Road Shaker Heights OHIO 44122

Goods/Services

Class Status -- ACTIVE. IC 021. US 002 013 023 029 030 033 040 050.
G & S: Medication containers for individual use for safely storing and providing information concerning the medication for timely access to such medication. First Use: 2011/01/19. First Use In Commerce: 2011/06/09.

Filing Date

2010/10/07

Examining Attorney

BRACEY, KAREN

Attorney of Record

Jeanne E. Longmuir

MEDPAX

Print: May 6, 2013

85159248

DESIGN MARK

Serial Number

85159248

Status

REGISTERED

Word Mark

BABY TRAX

Standard Character Mark

Yes

Registration Number

3961894

Date Registered

2011/05/17

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

ProgenyHealth, Inc. CORPORATION PENNSYLVANIA 1100 East Hector Street,
Suite 470 Conshohocken PENNSYLVANIA 19428

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: Providing use of on-line non-downloadable software in the field of medical care, namely, software for use by medical professionals to monitor and manage neonatal cases, for use by parents to review their infant's plan of care and for use by third party health care payers to review cases and service authorizations for their members. First Use: 2006/07/00. First Use In Commerce: 2006/07/00.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BABY" APART FROM THE MARK AS SHOWN.

Filing Date

2010/10/22

Examining Attorney

RINGLE, JIM

Print: May 6, 2013

85159248

Attorney of Record
Bryna S. Scott

BABY TRAX

Print: May 6, 2013

85430825

DESIGN MARK

Serial Number

85430825

Status

REGISTERED

Word Mark

MUM-MUM SNAX

Standard Character Mark

Yes

Registration Number

4146283

Date Registered

2012/05/22

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

I Lan Foods Industrial Co., Ltd. CORPORATION TAIWAN No. 19-13, Shin Cheng N. Road Shin Cheng Li TAIWAN

Goods/Services

Class Status -- ACTIVE. IC 030. US 046. G & S: Rice-based snack foods. First Use: 2010/11/25. First Use In Commerce: 2011/05/30.

Prior Registration(s)

2840897;3727473

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SNACKS" APART FROM THE MARK AS SHOWN.

Filing Date

2011/09/23

Examining Attorney

PHAM, LANA

Attorney of Record

Print: May 6, 2013

85430825

Marina A. Lewis

MUM-MUM SNAX

DESIGN MARK

Serial Number

85707696

Status

REGISTERED

Word Mark

JAXPRO

Standard Character Mark

No

Registration Number

4323756

Date Registered

2013/04/23

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

Southwest Texas Equipment Distributors, Inc. DBA Mission Restaurant Supply CORPORATION TEXAS PO Box 10310 San Antonio TEXAS 78210

Goods/Services

Class Status -- ACTIVE. IC 007. US 013 019 021 023 031 034 035. G & S: Electric food slicers; Electric Mixers; Kitchen machines, namely, electric standing mixers. First Use: 2012/08/01. First Use In Commerce: 2012/08/01.

Goods/Services

Class Status -- ACTIVE. IC 011. US 013 021 023 031 034. G & S: Electric food warmers; Electric kettles; Faucets; Sinks. First Use: 2012/08/01. First Use In Commerce: 2012/08/01.

Goods/Services

Class Status -- ACTIVE. IC 020. US 002 013 022 025 032 050. G & S: Chairs; Dining chairs; Metal furniture; Metal shelving; Seating furniture; Seats; Shelves for storage; Stools; Table tops; Tables; Work surfaces. First Use: 2011/04/01. First Use In Commerce: 2011/04/01.

Print: May 6, 2013

85707696

Goods/Services

Class Status -- ACTIVE. IC 021. US 002 013 023 029 030 033 040 050.
G & S: Metal pans; Pans; Servingware for serving food. First Use:
2011/05/01. First Use In Commerce: 2012/05/01.

Description of Mark

The mark consists of all capitalized: a blue "J" then "A" followed by a gray jack, representing the letter "X", and ending with a blue "P", "R" and "O".

Colors Claimed

The color(s) blue and gray is/are claimed as a feature of the mark.

Filing Date

2012/08/20

Examining Attorney

CLARKE, AISHA

JAXPRO