IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Ribological GmbH	:
		:
Serial No.:	79/107,898	: Trademark
		:
Filing Date:	October 10, 2011	: IVAC
		:
Trademark		: Class 5
Attorney:	Leigh A. Lowry	:
	Law Office 115	:

REQUEST FOR RECONSIDERATION

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

Sir:

This Request for Reconsideration is in response to the Office Action mailed October 31, 2013. In that Action, the Trademark Attorney made final the Section 2(d) refusal based on the citation of Registration No. 2,834,931, and No. 2,884,993. Applicant submits new arguments and evidence that demonstrate that the IVAC mark is not likely to be confused with the cited marks. For the reasons that follow, Applicant respectfully requests that the final refusal be reconsidered and withdrawn.

REMARKS

The determination that Applicant's mark is confusingly similar to the cited registrations is based on a faulty premise. In its analysis of the marks, the Trademark Office has taken the position that the "registrant's marks are the phonetic equivalent of the plural form of applicant's

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mark" and that "the marks are phonetic equivalents in plural form". That premise is not based on evidence. No evidence is provided to support the statement that "Vax" is the plural of "Vac". Rather, it would appear that the plural of "Vac" is "Vacs". *See* attached printout from <wordhippo.com>. Inasmuch as there is no support for the assertion that "Vax" is the plural of "Vac", the Office cannot rely on the cited case law for the proposition that "[t]rademarks consisting of the singular and plural forms of the same term are essentially the same marks". Applicant's mark IVAC is not the singular form of the cited marks, and therefore is not essentially the same mark as the cited marks. Consequently, IVAC is not the equivalent of the cited marks, and cannot support the basis for finding that the marks are confusingly similar.

In view of this, the Trademark Office must re-consider Applicant's arguments that the marks are not similar. As previously stated, the articulate pronunciation of IVAC (I-Vac) does not sound like the cited registrations for IVAX (I-vAX). In the cited registrations, the emphasis is on the "Ax" portion of the mark, which is in contrast to Applicant's mark where the ending is "Vac". These differences in pronunciation and phonetics are enough to find a difference between the marks. *The Coca-Cola Co. v. Essential Products Co., Inc.*, 164 USPQ 628, 630 (CCPA 1970) ("Considering the marks in their entireties, we find that it is only the first syllable of the four syllables in each mark which could be pronounced alike and that the articulate utterance of one mark is far from identical with that of the other mark." COCO LOCO not confusingly similar to COCA COLA).

Applicant's mark also creates a different commercial impression from the cited marks. IVAC is an acronym for "**I**ndividualized **Va**ccines for **C**ancer". In contrast, and as previously argued, the cited marks create the impression that they are house marks.

A difference in commercial impression is enough by itself to find that Applicant's mark is not confusingly similar to the cited registrations. The Board has previously found that a difference in commercial impression is sufficient to find no confusion, even if the marks at issue have phonetic and visual similarities. *In re Nobody's Perfect Inc.*, 44 USPQ2d 1054, 1057 (TTAB 1997) (unpublished) ("[N]othwithstanding the substantial phonetic and visual similarities in the respective marks and the closely related nature of applicant's services and registrant goods, ..., in light of the significant differences in connotation, [NOBODY'S PERFECT] is sufficiently distinguishable in commercial impression from [NO BODY'S PERFECT] that confusion as to origin or affiliation is not likely.") The case for finding no confusing similarity is stronger here. As previously argued, Applicant's mark does not have any phonetic or visual similarity to the cited marks.

The dissimilarity between the marks may be dispositive in a confusion analysis. "[W]e have previously upheld Board determinations that one *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks." *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 47 USPQ2d 1459 (Fed. Cir. 1998) (upheld Board decision that the differences between CRYSTAL CREEK for wine and CRISTAL for champagne dispositive of the issue of confusion). *Keebler Co. v. Murray Bakery Products*, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) (agreed with Board "'that the more important fact for resolving the issue of likelihood of confusion ... is the dissimilarity in commercial impression between the marks'"). Here, the differences in sight, sound, and commercial impression all support the conclusion that Applicant's mark is not likely to be confused with the cited registrations.

A careful consideration of all the relevant factors leads to the conclusion that IVAC is not likely to be confused with the cited registrations. The overall differences between the marks, and the existence of other third party "IVAX" marks for related goods, all favor a finding of no likelihood of confusion. Under these circumstances, the citations should be withdrawn.

For the foregoing reasons, Applicant respectfully requests that the Section 2(d) refusal be reconsidered and withdrawn, and that the application be approved and passed to publication on the Principal Register.

Respectfully submitted,

RIBOLOGICAL GMBH

Date: April 30, 2013

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CERTIFICATE OF MAILING

I hereby certify that this **REQUEST FOR RECONSIDERATION with attachment** is being deposited with the United States Postal Service with sufficient postage prepaid as First Class Mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, on this 30th day of April, 2013.

Kathryn E. Garipay

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