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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79116397
Applicant	Bioprocess Pilot Facility B.V.
Applied for Mark	BPF
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Submission	Applicants Request for Remand and Amendment
Attachments	Req for Remand 79116397.pdf(51449 bytes ) Consent Agreement 79116397.pdf(412874 bytes )
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Signature	/Julie E. Reitz/
Date	12/03/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Trademark Application of

Bioprocess Pilot Facility B.V.

Serial No. 79/116,397

Filed: May 11, 2012

Mark: BPF

Law Office: 110

Trademark Examining Attorney  
Sara Benjamin

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**Request for Remand  
and  
Reconsideration**

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**Request for Remand**

Applicant, Bioprocess Pilot Facility B.V, (“Applicant” or “Bioprocess”) respectfully requests suspension of the current appeal proceedings relative to U.S. Trademark Serial No. 79/116, 397 and remand of the same to the Examining Attorney to consider additional evidence, pursuant to §1207.02 of the Trademark Trial and Appeal Board Manual of Procedure and to amend the application pursuant to §1205.01 of the Trademark Trial and Appeal Board Manual of Procedure.

The Examining Attorney, Sara Benjamin, has consented to this Request for Remand and Reconsideration.

Applicant requests this suspension and remand on the grounds that additional evidence has just recently come to Applicant's possession and in order to comply with the Examining Attorney's requirements for the description of services.

Attached as new evidence, not previously submitted, is a consent to register agreement executed between Caravan Ingredients, Inc. (owner of the cited registrations) ("Registrant") and Bioprocess Pilot Facility B.V. In addition, Applicant requests an amendment of its goods and services descriptions to comply with the Examining Attorney's requirements and the Consent Agreement.

The new evidence is in support of Applicant's appeal from the Final Office Action dated April 4, 2013 and the Denial of the Request for Reconsideration in which the Trademark Examining Attorney made final the refusal to register the trademark shown in U.S. Trademark Serial No. 79/116,397 under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the grounds of likelihood of confusion based on Registration Nos. 783,312 and 925,995 in the name of Caravan Ingredients, Inc. Applicant herein submits additional evidence supporting its position that the Section 2(d) refusal should be withdrawn and the services description in Class 42 be accepted.

On October 4, 2013, Bioprocess electronically filed a Request for Reconsideration after the Final Office Action. In the Request for Reconsideration, the Applicant responded by advising the Examining Attorney that Bioprocess and Registrant of Registration Nos. 783,312 and 925,993, Caravan Ingredients, Inc. were both owned by the same parent entity company and that Bioprocess had obtained a consent to register its mark from Caravan Ingredients, Inc. to register its mark BPF and that a consent agreement would follow. In addition, Applicant amended its service description for Class 42.

On November 7, 2013, the Examining Attorney denied Applicant's Request for Reconsideration as to the §2(d) likelihood of confusion refusal with respect to Registration Nos. 783,312 and 925,995 without considering the consent given by the Registrant. Further, the Examining Attorney maintained the refusal as to the Class 42 description of services, indicating that the new wording proposed by the Applicant in its Request for Reconsideration, namely "upscaling" was indefinite.

The Applicant was not aware that the new wording "upscaling" would be considered indefinite; therefore, it should be allowed to amend its services.

A copy of the Consent Agreement dated November 25, 2013 ("Consent Agreement") which was mentioned in the Request for Reconsideration, is requested to be submitted into evidence and is attached hereto. The Applicant, although with knowledge of the consent to register from the Registrant, did not have in its possession a signed agreement with Caravan Ingredients, Inc. The Consent Agreement, which was not previously available for submission to the Examining Attorney, is proof of the agreement between the parties as mentioned in the Request for Reconsideration. This Consent Agreement should be considered by the Examining Attorney in light of the Section 2(d) refusal.

Because this evidence and information is new and was not known or in the Applicant's possession at the time of filing the Request for Reconsideration, the Applicant should be allowed to submit the evidence and amend the goods and services. Further, the Examining Attorney should be allowed an opportunity to review this new evidence and the requested amendment of the goods and services in light of the refusals.

For the reasons set forth above, including the consent by the Examining Attorney, Applicant requests that the pending appeal be suspended and remanded to the Examining

Attorney for consideration of the additional evidence and the amendment of the goods and services descriptions.

**Request for Reconsideration by the Examining Attorney**

**Consent Agreement**

The owner of Registration Nos. 783,312 and 925,995, Caravan Ingredients, Inc., has consented to Applicant's use and registration of the mark BPF in the United States by agreement. The granting of consent by the Registrant is due the fact that both the Registrant and the Bioprocess do not believe that there would be any likelihood of confusion or conflict between the Bioprocess's use of its mark BPF and the Registrant's use of its marks BFP and BFP and Design. The reasons for this conclusion are set forth in the Consent Agreement between the parties, which includes the differences in the marks, the differences in the channels of trade and the restriction of the fields of use by the Applicant. Further, the parties have agreed in the event of any confusion, which is unlikely, that the parties will cooperate to eliminate such confusion.

"[I]t is well settled that in the absence of contrary evidence, a consent agreement itself may be evidence that there is no likelihood of confusion." *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 1569 (Fed. Cir. 1993). The Federal Circuit and its predecessor court have repeatedly stated that "those most familiar with and affected by the marketplace [are] best able to attest to its effects and determine whether there [is] likelihood of confusion – even in cases where marks [are] identical and goods closely related." *Id.* at 1568. Further, the Court of Appeals for the Federal Circuit has made it clear that consent agreements should be given great weight, and that the Office should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason. *Amalgamated*

*Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); *Bongrain International (American) Corp. v. Delice de France Inc.*, 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987); and *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985). See *TMEP* §1207.01(d)(viii).

In addition, it is clear from the Consent Agreement and the amendment of the Applicant's goods that the trade channels are vastly different. Because there will be little chance of an overlapping in the trade channels, confusion is unlikely. In regard to trade channels, the Examining Attorney makes a singular argument that while the Bioprocess asserts that its goods are only used for "research and education" that the goods state that "goods are used in the industry for manufacture of food products" and thus the goods of the Bioprocess and Registrant must flow from the same trade channels. Bioprocess however reaffirms that its goods are only used for "research and education" and therefore, has agreed to limit its goods to such industry. Further, as evidenced by the Consent Agreement, Caravan believes that the goods will flow in different trade channels. The Examining Attorney goes on to state that "[t]he overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to the use of a similar mark by a newcomer." As evidenced by the granting of consent to register by the Consent Agreement, Caravan Ingredients, Inc. has no "overriding concern" that it will suffer adverse commercial impact due to the use of the mark BPF by the Applicant.

Because the parties closest to the matter believe that no confusion is likely and because, Caravan Ingredients, Inc., has consented to Applicant's use and registration of the mark and has agreed to cooperate in the future to avoid confusion, and further because Bioprocess has agreed

to restrict its application and channels of trade, the Consent Agreement should be given strong consideration and the 2(d) refusal should be withdrawn.

**Goods and Services Amendment:**

In order to comply with the new requirement of the Examining Attorney, raised in the Denial of the Request for Reconsideration, Bioprocess will agree to remove the indefinite wording “upscaling” and amend description of services as follows:

- *Scientific and technological services, namely, analysis, and testing in the field of modular pretreatment and biorefinery, fermentation processes, downstream processing and separation technology bioconversion processes related to biobased chemicals and development of processes for the manufacture of biobased chemicals; industrial chemical analysis and research services in the field of biobased chemicals and in the field of development of processes for the manufacture of biobased chemicals; technical advice and consultancy relating to the development of processes for the manufacture of biobased chemicals and to biobased chemicals; research and development of new products for third parties in the field of biobased chemicals and in the field of development of processes for the manufacture of biobased chemicals; chemical research in the field of biobased chemicals and in the field of development of processes for the manufacture of biobased chemicals.*

In order to comply with the requirement of the Consent Agreement, the Applicant requests an amendment of the description of its goods in Class 1 to (underlined wording added):

- *Chemicals used in industry, namely, chemicals for use in the food, cosmetics, pharmaceutical, medical, chemical, polymers and technical industries; biobased*

*chemicals for use in industry, namely, the food, cosmetics, pharmaceutical, medical, chemical, polymers and technical industries; chemical additives for use in the manufacture of food products; chemicals and semi-finished chemical products for preserving foodstuffs; natural preservatives, namely, organic acids and salts thereof, namely, lactic acid, lactates, sodium lactate, potassium lactate, buffered lactic acid, propionic acid, propionates, acetic acid and acetates, and mixtures of the aforesaid substances, all aforesaid natural preservatives particularly being for use in the preservation of foodstuffs, all of which is marketed to researches, inventors and educator*

Given the circumstances of this case, the fact that the Applicant is willing to amend its goods and services to restrict its channel of trade, the parties not believe that confusion will occur and that the parties have entered into a Consent Agreement, the 2(d) refusal should be withdrawn and the Class 42 amendment of services and Class 1 amendment of goods should be accepted. Therefore, Applicant respectfully requests that the present application, as requested to be amended, be allowed to proceed.

HONIGMAN MILLER SCHWARTZ AND COHN LLP

Dated: December 3, 2013

By: /s/ Julie E. Reitz

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Bioprocess Pilot Facility B.V.  
For: BPF, U.S. App. Serial No. 79116397, International trademark No. 1125328  
Filed: May 11, 2012  
Int'l Classes: 1, 41, 42

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We, the undersigned Caravan Ingredients, Inc., a corporation organized under the laws of Georgia with an address at 7905 Quivira Road, Lenexa, Kansas 66215, United States of America, is the owner of U.S. Registration No. 0925995 for the mark BFP & Design and U.S. Registration No. 0783312 for the mark BFP.

The U.S. Patent and Trademark Office has initially cited U.S. Registration No. 0925995 for the mark BFP & Design and U.S. Registration No. 0783312 for the mark BFP against U.S. App. No. 79116397 for the mark BPF owned by Bioprocess Pilot Facility B.V.

Registrant Caravan Ingredients, Inc. and Applicant Bioprocess Pilot Facility B.V. believe that their respective use and registration of the marks BFP & Design, BFP, and BPF, with the amendment to the identification of goods in Class 1 as set forth below clarifying that the Class 1 goods are marketed to researchers, inventors and educators, respectively, are not likely to cause confusion, mistake, or deception as to the source or sponsorship of the parties' respective goods/services for several reasons. First, the respective marks are different in connotation and visual appearance. Second, the level of purchaser care for the respective goods/services is very high, which further serves to avoid confusion among consumers and the trade. Finally, no known instances of actual confusion have occurred despite concurrent use by the parties of their respective marks with their respective goods/services. Although the parties do not contemplate any future conflicts, the parties agree to cooperate and take any steps necessary to prevent consumer confusion in the future, should the need arise.

Registrant Caravan Ingredients, Inc. hereby consents to use and registration of U.S. App. No. 79116397 for the mark BPF for:

*Chemicals used in industry, namely, chemicals for use in the food, cosmetics, pharmaceutical, medical, chemical, polymers and technical industries; biobased chemicals for use in industry, namely the food, cosmetics, pharmaceutical, medical, chemical, polymers and technical industries; chemical additives for use in the manufacture of food products; chemicals and semi-finished chemical products for preserving foodstuffs; natural preservatives, namely, organic acids and salts thereof namely, lactic acid, lactates, sodium lactate, potassium lactate, buffered lactic acid, propionic acid, propionates, acetic acid and acetates, and mixtures of the aforesaid substances, all aforesaid natural preservatives particularly being for use in the preservation of foodstuffs, all of which is marketed to researchers, inventors and educators, in International Class 1,*

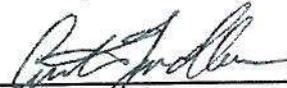
*Education, namely, providing of training, teaching, courses, workshops and seminars, all in the field of biobased chemicals as well as in the field of development of processes for the manufacture of biobased chemicals in International Class 41, and*

*Scientific and technological services, namely, scientific research, analysis, testing, design, and upscaling in the field of modular pretreatment and biorefinery, fermentation processes, downstream processing and separation technology bioconversion processes related to biobased chemicals and development of processes for the manufacture of biobased chemicals; industrial chemical analysis and research services in the field of*

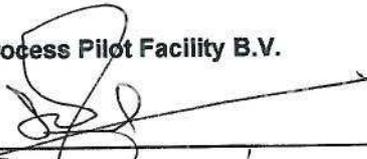
biobased chemicals and in the field of development of processes for the manufacture of biobased chemicals; technical advice and consultancy relating to the development of processes for the manufacture and upscaling of biobased chemicals and to biobased chemicals; research and development of new products for third parties in the field of biobased chemicals and in the field of development of processes for the manufacture of biobased chemicals; chemical research in the field of biobased chemicals and in the field of development of processes for the manufacture of biobased chemicals in International Class 42,

or such other description as is acceptable to the U.S. Patent and Trademark Office.

**Caravan Ingredients, Inc.**

By:   
Name: Curtis Landherr  
Title: VP and General Counsel  
Date: 11/20/13

**Bioprocess Pilot Facility B.V.**

By:   
Name: Hans van Leeuwen  
Title: Director  
Date: 25/11/2013



Annemiek Schulte  
Manager General Affairs  
26/11/2013