

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79130243
LAW OFFICE ASSIGNED	LAW OFFICE 104
MARK SECTION (no change)	
ARGUMENT(S)	
<p>Applicant herein addresses the partial refusal raised by the Trademark Examining Attorney with regard to the instant application and hereby asks for reconsideration of the refusal to register as to the goods of International Class 5. Applicant understands that the application has not been refused as to the goods in International Classes 10 and 34.</p> <p>Applicant maintains that the goods claimed in the instant application are sufficiently distinct from the goods of the cited registrations so as to avoid giving rise to consumer confusion in the marketplace.</p> <p>Applicant has herein narrowed the Class 5 goods to read as follows: "Pharmaceutical preparations for human use, namely inhalers containing nicotine for delivering nicotine to the body." Such goods are very different from the "dietary supplements" and "non-medicated lozenges" of the cited registrations both in form and ingredient, as well as in purpose. Indeed, as previously noted, nicotine-related products are typically treated as regulated products in the United States and thus are not likely to be sold in the same types of stores – and certainly not in the same areas of stores – as would be dietary supplements, further supporting the conclusion that confusion would be unlikely. While the Trademark Examining Attorney suggests that some of the goods formerly listed in the Class 5 recitation for Applicant's mark were of the type that could be found in retail stores selling non-medicated lozenges and dietary supplements, Applicant submits that the nicotine inhalers of the revised Class 5 recitation are very different from the goods of the cited references and, even if they were to be found in the same stores, would not be found in the same locations. Indeed, the Applicant's goods are likely to be found behind pharmacist-controlled barriers. As such, these products are not products that are going to be</p>	

mistakenly purchased by an uninformed consumer looking for a lozenge, irrespective of the fact that they could, in theory, appear in the same retail establishment. Indeed, even if Applicant's Class 5 products were to be sold in the same stores as those of Registrant (a fact which has not been established by the Trademark Examining Attorney), that fact alone would not be determinative here. *See, e.g., Inter Ikea Sys. B.V. v. Akea, LLC*, 110 U.S.P.Q.2d 1734, 1743-44 (T.T.A.B. 2014) and cases cited therein. Again, Applicant respectfully submits that the wholly dissimilar and unrelated nature of the parties' respective products should be determinative in finding that there is no likelihood of confusion between these marks. *See Local Trademarks, Inc. v. The Handy Boys, Inc.*, 16 U.S.P.Q.2d 1156 (T.T.A.B. 1990) (no likelihood of confusion between "LITTLE PLUMBER" for liquid drain opener and "LITTLE PLUMBER" for advertising services marketed to plumbing contractors because the goods and services are sold through different channels of trade to different classes of consumers and are so different from one another that confusion is unlikely); *Quartz Radiation Corp. v. Comm/Scope Company*, 1 U.S.P.Q.2d 1668 (T.T.A.B. 1986) (confusion unlikely between "QR" for coaxial cable and "QR" for products related to the photocopying field because the products are different in nature, are promoted differently and are purchased by different classes of purchasers). In view of the foregoing, it is respectfully submitted that when the goods of the instant application are considered in light of the unrelated goods of the Cited Registrations, the fundamental differences compel the conclusion that consumer confusion is not likely.

Based on the foregoing, Applicant respectfully requests that the Examining Attorney withdraw the likelihood of confusion refusal related to the Class 5 goods claimed in the application as set forth in the Office Action dated August 19, 2014, and, in light of the other amendments to the application as set forth in the instant response, pass the subject application to publication.

GOODS AND/OR SERVICES SECTION (005)(current)

INTERNATIONAL CLASS

005

DESCRIPTION

Pharmaceutical preparations for human use, namely, transdermal patches containing nicotine, throat lozenges, mouth sprays, nasal sprays, inhalers and microtablets containing nicotine for delivering nicotine to the body

GOODS AND/OR SERVICES SECTION (005)(proposed)

INTERNATIONAL CLASS

005

TRACKED TEXT DESCRIPTION	
Pharmaceutical preparations for human use, namely, transdermal patches containing nicotine, throat lozenges, mouth sprays, nasal sprays, inhalers and microtablets containing nicotine for delivering nicotine to the body; Pharmaceutical preparations for human use, namely, inhalers containing nicotine for delivering nicotine to the body	
FINAL DESCRIPTION	
Pharmaceutical preparations for human use, namely, inhalers containing nicotine for delivering nicotine to the body	
GOODS AND/OR SERVICES SECTION (010)(no change)	
GOODS AND/OR SERVICES SECTION (034)(no change)	
SIGNATURE SECTION	
RESPONSE SIGNATURE	/tjk/
SIGNATORY'S NAME	Timothy J. Kelly
SIGNATORY'S POSITION	Attorney of Record, New York State Bar Member
SIGNATORY'S PHONE NUMBER	2122182100
DATE SIGNED	02/18/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Feb 18 12:31:42 EST 2015
TEAS STAMP	USPTO/RFR-216.91.12.76-20 150218123142696642-791302 43-530376c1db9b5b81b98af5 e9c21bdffdf4bedbe72429255 349dc7e9f38ccea92-N/A-N/A -20150218121939553608

**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **79130243** has been amended as follows:

ARGUMENT(S)

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

Applicant herein addresses the partial refusal raised by the Trademark Examining Attorney with regard to the instant application and hereby asks for reconsideration of the refusal to register as to the goods of International Class 5. Applicant understands that the application has not been refused as to the goods in International Classes 10 and 34.

Applicant maintains that the goods claimed in the instant application are sufficiently distinct from the goods of the cited registrations so as to avoid giving rise to consumer confusion in the marketplace.

Applicant has herein narrowed the Class 5 goods to read as follows: "Pharmaceutical preparations for human use, namely inhalers containing nicotine for delivering nicotine to the body." Such goods are very different from the "dietary supplements" and "non-medicated lozenges" of the cited registrations both in form and ingredient, as well as in purpose. Indeed, as previously noted, nicotine-related products are typically treated as regulated products in the United States and thus are not likely to be sold in the same types of stores – and certainly not in the same areas of stores – as would be dietary supplements, further supporting the conclusion that confusion would be unlikely. While the Trademark Examining Attorney suggests that some of the goods formerly listed in the Class 5 recitation for Applicant's mark were of the type that could be found in retail stores selling non-medicated lozenges and dietary supplements, Applicant submits that the nicotine inhalers of the revised Class 5 recitation are very different from the goods of the cited references and, even if they were to be found in the same stores, would not be found in the same locations. Indeed, the Applicant's goods are likely to be found behind pharmacist-controlled barriers. As such, these products are not products that are going to be mistakenly purchased by an uninformed consumer looking for a lozenge, irrespective of the fact that they could, in theory, appear in the same retail establishment. Indeed, even if Applicant's Class 5 products were to be sold in the same stores as those of Registrant (a fact which has not been established by the Trademark Examining Attorney), that fact alone would not be determinative here. *See, e.g., Inter Ikea Sys. B.V. v. Akea, LLC*, 110 U.S.P.Q.2d 1734, 1743-44 (T.T.A.B. 2014) and cases cited therein.

Again, Applicant respectfully submits that the wholly dissimilar and unrelated nature of the parties' respective products should be determinative in finding that there is no likelihood of confusion between these marks. *See Local Trademarks, Inc. v. The Handy Boys, Inc.*, 16 U.S.P.Q.2d 1156 (T.T.A.B. 1990)

(no likelihood of confusion between “LITTLE PLUMBER” for liquid drain opener and “LITTLE PLUMBER” for advertising services marketed to plumbing contractors because the goods and services are sold through different channels of trade to different classes of consumers and are so different from one another that confusion is unlikely); *Quartz Radiation Corp. v. Comm/Scope Company*, 1 U.S.P.Q.2d 1668 (T.T.A.B. 1986) (confusion unlikely between “QR” for coaxial cable and “QR” for products related to the photocopying field because the products are different in nature, are promoted differently and are purchased by different classes of purchasers). In view of the foregoing, it is respectfully submitted that when the goods of the instant application are considered in light of the unrelated goods of the Cited Registrations, the fundamental differences compel the conclusion that consumer confusion is not likely. Based on the foregoing, Applicant respectfully requests that the Examining Attorney withdraw the likelihood of confusion refusal related to the Class 5 goods claimed in the application as set forth in the Office Action dated August 19, 2014, and, in light of the other amendments to the application as set forth in the instant response, pass the subject application to publication.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Current: Class 005 for Pharmaceutical preparations for human use, namely, transdermal patches containing nicotine, throat lozenges, mouth sprays, nasal sprays, inhalers and microtablets containing nicotine for delivering nicotine to the body

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: ~~Pharmaceutical preparations for human use, namely, transdermal patches containing nicotine, throat lozenges, mouth sprays, nasal sprays, inhalers and microtablets containing nicotine for delivering nicotine to the body;~~ Pharmaceutical preparations for human use, namely, inhalers containing nicotine for delivering nicotine to the body

Class 005 for Pharmaceutical preparations for human use, namely, inhalers containing nicotine for delivering nicotine to the body

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.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /tjk/ Date: 02/18/2015

Signatory's Name: Timothy J. Kelly

Signatory's Position: Attorney of Record, New York State Bar Member

Signatory's Phone Number: 2122182100

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 filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79130243

Internet Transmission Date: Wed Feb 18 12:31:42 EST 2015

TEAS Stamp: USPTO/RFR-216.91.12.76-20150218123142696

642-79130243-530376c1db9b5b81b98af5e9c21

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A-N/A-20150218121939553608