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

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|------------------------|--|
| Proceeding | 79139080 |
| Applicant | Siemens Medical Instruments Pte. Ltd. |
| Applied for Mark | JOY |
| Correspondence Address | MARIE-ANNE MASTROVITO ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017 UNITED STATES MAMastrovito@lawabel.com |
| Submission | Applicants Request for Remand and Amendment |
| Attachments | JOY 79139080 Request for Remand 4-24-15.pdf(40999 bytes) JOY 79139080 consent letter from KK TOP.pdf(190453 bytes) POA Siemens Medical signed.pdf(127094 bytes) |
| Filer's Name | Janice Housey |
| Filer's e-mail | jhousey@symbus.com, trademarks@symbus.com |
| Signature | /janice housey/ |
| Date | 04/24/2015 |

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

Serial Number: 79139080
Mark: JOY
Applicant: Siemens Medical Instruments Pte. Ltd.
Filing Date: Oct. 29, 2013
Examining Attorney: Joanna Elisa Fiorelli
Law Office 105

**REQUEST FOR REMAND
AND SUBMISSION OF LETTER OF CONSENT**

COMES NOW the Applicant, Siemens Medical Instruments Pte. Ltd. (“SMI”), by counsel, and pursuant to TBMP §1205, hereby moves the Board to remand the present appeal to the Examining Attorney for consideration of the attached Letter of Consent by KABUSHIKI KAISHA TOP, the owner of the prior registrations cited as bars to the present application.

In support of this request, Applicant shows the Board the following:

1. In a FINAL Office Action issued on August 28, 2014, the Examining Attorney maintained and made final the refusal to register Applicant’s mark based on Trademark Act Section 2(d), citing Registration Nos. 4081775 for the mark MEDIJOY and 4232061 for the mark MEDJOY, both owned by KABUSHIKI KAISHA TOP (“KK-TOP”).
2. On March 2, 2015, Applicant’s prior U.S. counsel filed a pro forma Request for Reconsideration, submitting brief arguments that:

“[The cited] registrations cover a wide range of goods in Class 10, including "hearing aids for the deaf." Applicant submits that there is no likelihood of confusion between the marks JOY and MEDJOY or MEDIJOY because the marks look and sound different and will have different commercial impressions. Further,

investigations into Top's use of the mark MEDJOY and MEDIJOY show no evidence of the use of the mark in connection with hearing aids or other assistive listening devices. Thus, these marks should not continue to block the instant Applicant with respect to these goods.”

No evidence was provided with this Request for Reconsideration.

3. In addition to the Request for Reconsideration, Applicant’s prior U.S. counsel filed a Notice of Appeal on March 2, 2015.
4. Due to miscommunications, Applicant’s primary counsel in Germany was not aware that U.S. counsel had filed the Request for Reconsideration and Notice of Appeal. Applicant’s counsel in Germany had been corresponding with Applicant and with counsel for KK-TOP, owner of the cited registrations, regarding the possibility of obtaining a letter of consent from KK-TOP to registration of Applicant’s mark.
5. On April 2, 2015, the Request for Reconsideration that was filed by the prior U.S. counsel was denied, and the refusal to register Applicant’s mark was maintained based on likelihood of confusion with prior registrations 4081775 MEDIJOY and 4232061 MEDJOY.
6. On April 9, 2015, the letter consenting to registration of Applicant’s mark was signed by KK-TOP, owner of the cited registrations.
7. On April 16, 2015, the undersigned contacted the Examining Attorney, Joanna Elisa Fiorelli, by email, explained that there had been some miscommunications between prior counsel and the client, and asked if it would be possible for the Examining Attorney to consider the letter of consent and approve the application for publication.
8. On April 16, 2015 the Examining Attorney responded that she was not able to consider the consent statement because more than six months had passed since the Final Action was issued.

9. Applicant's Appeal brief deadline is June 7, 2015.
10. Good cause exists for remanding this appeal to the Examining Attorney for consideration of the letter of consent because accepting this consent will allow the Examining Attorney to approve the application for publication.
11. This request is being submitted in good faith.

WHEREFORE, Applicant respectfully requests that the Board grant Applicant's request and remand the application to the Examining Attorney to consider the attached letter of consent to registration of Applicant's mark by the owner of the cited registrations.

Respectfully submitted,



Janice W. Housey
Attorney for Applicant

Date: April 24, 2015

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KABUSHIKI KAISHA TOP

19-10 Senjunakai-cho,
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TEL : 03-3882-3101
FAX : 03-3882-3301

April 9, 2015

Re: Trademark Application Ser. No. 79139080
In the name of Siemens Medical Instruments Pte. Ltd.
Mark: JOY

Dear Sirs:

The undersigned is aware that Siemens Medical Instruments Pte. Ltd. ("SMI") filed an extension of its International Registration No. 1183243 for the trademark JOY to the U.S. and the same has been assigned Ser. No. 79139080 (the "'080 application"). The '080 application recites medical hearing aids in Class 10.

This company, KABUSHIKI KAISHA TOP, ("KK Top") is the owner of the following registrations (both extensions of International Registrations to the U.S.):

- MEDJOY U.S. Registration No. 4232061; and
- MEDIJOY U.S. Registration No. 4081775

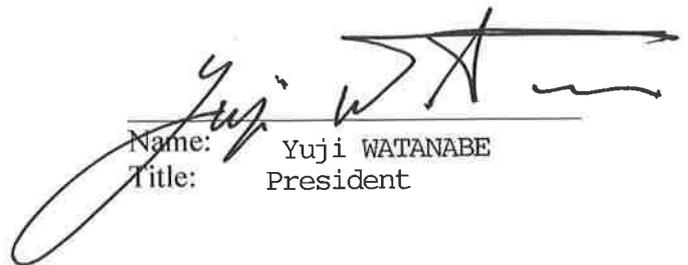
both of which recite the following goods: Surgical apparatus and instruments, namely, sharp curettes, surgical retractors, surgical forceps, surgical elevators, thoroscopes, obstetric dilators, gynecological dilators, surgical excisers, namely, surgical scissors, surgical amputators and electric bone operating machines, namely, surgical saws, surgical perforators, dressing forceps for surgical use, electric scalpels for surgical purposes, blunt curettes for surgical use, surgical knives, bougies and anaesthetic masks, injection needles for nerve block; dental apparatus and instruments, namely, drills for dental applications, X-ray appliances for dental and medical use; veterinary apparatus and instruments, namely, injection syringes, syringe barrels, injection needles, infusion sets with injection needle, intravenous catheters, infusion pumps, syringe pumps; electrocardiographs; medical diagnostic apparatus and instruments, namely, gastroscopes, magnetic resonance ct imaging apparatus, keratoscope, tonometers, speculums, sphygmomanometers, pelvimeters, clinical urethral and cardiac probes, electrocardiographs, tongue depressors, clinical thermometers for medical use, body-fat monitors, stethoscopes, audiometers and electroencephalographs and blood testing apparatus, namely, blood drawing apparatus and blood glucose meter; surgical apparatus and instruments; therapeutic apparatus and instruments, namely, therapeutic inhalers, radio-frequency electrodes for pain therapy, oxygen inhalers for therapeutic purposes, ultraviolet radiator units for therapeutic purposes, defibrillators, pneumothorax apparatus for reinflating a collapsed lung, heart pacemakers, infrared radiator units for therapeutic purposes, puncture apparatus for therapeutic purposes, namely, acupuncture needles, lavage apparatus for therapeutic purposes, infusion apparatus for therapeutic purpose, dialyzers, sprayers for medical purposes sold empty, suture apparatus for medical purposes, namely, suturing needles, massage apparatus for medical purposes, incubators for babies and blood transfusion apparatus; medical supportive equipment for hospitals, namely,

support belts, back supports. artificial eyes; artificial limbs; acoustic aids, namely, hearing aids for the deaf; auxiliary medical devices, namely, stethoscopes and orthodontic appliances; medical X-ray apparatus; orthopedic articles, namely, orthopedic footwear, cushions for orthopedic care; three-way stopcocks for medical use; tubes for medical purposes, namely, endotracheal tubes, infusion tubes, gastrostomy tubes, feeding tubes; drainage tubes for medical purposes; catheters; gastrostomy kits comprising catheter tips and universal adapters; peg (percutaneous endoscopic gastrostomy) kits, comprised essentially of peg tube, feeding adapter, retention disc, and loop insertion wire; infusion bags for medical purposes, sold empty; feeding bags for medical purposes, sold empty; injectors for medical purposes, namely, syringes and needles; injection syringes; syringe barrels; injection needles; infusion sets with injection needles for medical purposes; intravenous catheters; urinary bags for medical purposes; tubing connectors for medical purposes; pumps for medical purposes, namely, syringe pumps; infusion pumps for medical purposes; suture needles; ultraviolet sterilizer for medical purposes; rigid and flexible medical endoscopes; medical apparatus in the nature of tubes through which the endoscope is inserted; puncture needles for medical endoscopes; surgical drapes; surgical thread; teething rings; ice bag pillows for medical purposes; triangular bandages, namely, elastic bandages, supportive bandages, compression bandages; supportive bandages; catgut for surgical use; feeding cups; dropping pipettes for medical purposes; teats; medical ice bags; medical ice bag holders; babies' bottles; vacuum bottles for nursing; finger guards for medical purposes; one-piece clothing especially for operating rooms, namely, surgical scrub suits; medical treatment apparel, namely, clothing for treatment before or after operation; gloves for medical purposes. aprons for surgical use; surgical caps; masks for surgical use

KK Top's MEDJOY and MEDIJOY trademark registrations were cited as bases for refusals of the '080 application.

KK Top's MEDJOY and MEDIJOY trademarks are directed primarily to medical instruments. KK Top's MEDJOY and MEDIJOY trademarks are readily distinguishable from SMI's JOY trademark for medical hearing aids. Therefore, KK Top hereby consents to SMI's use and registration of the JOY trademark for medical hearing aids.

Should the need arise, SMI and KK Top will cooperate and take all steps necessary to ameliorate any likelihood of customer or potential customer confusion that may arise in the future.


Name: Yuji WATANABE
Title: President

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

POWER OF ATTORNEY

Siemens Medical Instruments Pte. Ltd. hereby appoints Janice Housey and Symbus Law Group, LLC with an address of PO Box 11085, McLean, VA 22102 as its attorneys to transact all business with the U.S. Patent and Trademark Office in connection with its applications and receive the certificates of registration therefor.

Respectfully submitted,

2015 MAR 16

Date: _____

Signature: 

Name: Frank Wagner

Title: Chief Executive Officer

Signature: 

Name: Rajesh Bhambhani

Title: Chief Financial Officer