

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79140199
LAW OFFICE ASSIGNED	LAW OFFICE 108
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The following is in response to the Final Office Action dated July 31, 2014.</p> <p>With regard to the outstanding refusal in view of Registration No. 4,326,366, submitted herewith is an executed Trademark Consent Agreement between the owner of the cited registration, DOGAWIST-Investment GmbH ("Dogawist") and the applicant, QIAGEN GmbH . As the Consent Agreement details why the Parties do not believe there is confusion, and as the Parties are in the best position to know their market and sophistication of their customers, Applicant believes that the Agreement should be given substantial weight. The parties have also agreed to take steps to resolve any confusion in the unlikely event it should arise in the marketplace. Applicant therefore requests that the refusal in view of Reg. No. 4,326,366 be withdrawn.</p> <p>With regard to the refusal in view of Registration No. 3,770,847, applicant has recorded the assignment to Applicant's sister company, QIAGEN, Inc. and requests reconsideration of the refusal, given the related nature of the companies. The assignment was recorded on January 29, 2014 at Reel 5449, Frame 0161. A copy of the Notice of Recordation of Assignment is attached. If the Examiner maintains this refusal, applicant's sister company QIAGEN, Inc., will expressly abandon Registration No. 3,770,847 as needed to fully resolve this final basis for refusal.</p> <p>Applicant respectfully submits that the application is in condition for allowance and seeks publication of the application.</p> <p>If questions remain, the Examining Attorney is invited to contact Applicant's counsel, Lorraine Linford, by telephone at 206.622.4900 or by e-mail at LorraineL.docketing@SeedIP.com.</p>	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_38100227210-20150130143755317576_._Consent_Agreement.pdf
CONVERTED PDF FILE(S) (3 pages)	\\TICRS\EXPORT16\IMAGEOUT16\791\401\79140199\xml12\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\791\401\79140199\xml12\RFR0003.JPG

	\\TICRS\EXPORT16\IMAGEOUT16\791\401\79140199\xml12\RFR0004.JPG
ORIGINAL PDF FILE	evi_38100227210-20150130143755317576_. Notice_of Recordation.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\791\401\79140199\xml12\RFR0005.JPG
DESCRIPTION OF EVIDENCE FILE	Consent Agreement and Notice of Recordation of Assignment
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Lorraine Linford/
SIGNATORY'S NAME	Lorraine Linford
SIGNATORY'S POSITION	Attorney for Applicant, Washington State Bar Member
SIGNATORY'S PHONE NUMBER	206-622-4900
DATE SIGNED	01/30/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Jan 30 15:57:08 EST 2015
TEAS STAMP	USPTO/RFR-38.100.227.210-20150130155708222821-79140199-53045f7c52452746bb98df388ddc8e32b4f5a416e5eb99271f2e210c8bab1ffed4c-N/A-N/A-20150130143755317576

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

Application serial no. **79140199** has been amended as follows:

ARGUMENT(S)

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

The following is in response to the Final Office Action dated July 31, 2014.

With regard to the outstanding refusal in view of Registration No. 4,326,366, submitted herewith is an executed Trademark Consent Agreement between the owner of the cited registration, DOGAWIST-Investment GmbH ("Dogawist") and the applicant, QIAGEN GmbH . As the Consent Agreement details why the Parties do not believe there is confusion, and as the Parties are in the best position to know their market and sophistication of their customers, Applicant believes that the Agreement should be given substantial weight. The parties have also agreed to take steps to resolve any confusion in the unlikely event it should arise in the marketplace. Applicant therefore requests that the refusal in view of Reg. No. 4,326,366 be withdrawn.

With regard to the refusal in view of Registration No. 3,770,847, applicant has recorded the assignment to Applicant's sister company, QIAGEN, Inc. and requests reconsideration of the refusal, given the related nature of the companies. The assignment was recorded on January 29, 2014 at Reel 5449, Frame 0161. A copy of the Notice of Recordation of Assignment is attached. If the Examiner maintains this refusal, applicant's sister company QIAGEN, Inc., will expressly abandon Registration No. 3,770,847 as needed to fully resolve this final basis for refusal.

Applicant respectfully submits that the application is in condition for allowance and seeks publication of the application.

If questions remain, the Examining Attorney is invited to contact Applicant's counsel, Lorraine Linford, by telephone at 206.622.4900 or by e-mail at LorraineL.docketing@SeedIP.com.

EVIDENCE

Evidence in the nature of Consent Agreement and Notice of Recordation of Assignment has been attached.

Original PDF file:

[evi_38100227210-20150130143755317576_ . Consent Agreement.pdf](#)

Converted PDF file(s) (3 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

Original PDF file:

[evi_38100227210-20150130143755317576_ . Notice of Recordation.pdf](#)

Converted PDF file(s) (1 page)

[Evidence-1](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Lorraine Linford/ Date: 01/30/2015

Signatory's Name: Lorraine Linford

Signatory's Position: Attorney for Applicant, Washington State Bar Member

Signatory's Phone Number: 206-622-4900

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 not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79140199

Internet Transmission Date: Fri Jan 30 15:57:08 EST 2015

TEAS Stamp: USPTO/RFR-38.100.227.210-201501301557082

22821-79140199-53045f7c52452746bb98df388

ddc8e32b4f5a416e5eb99271f2e210c8bab1ffed

4c-N/A-N/A-20150130143755317576

Trademark Consent Agreement

This is an agreement by and between the following parties:

DOGAWIST-Investment GmbH, a limited liability company of Germany having a mailing address of Am Landbach 2B, 64342 Seeheim-Jugenheim, Germany ("DOGAWIST"); and

QIAGEN GmbH, a limited liability company of Germany having a mailing address of Qiagen Str. 1, 40724 Hilden, Germany ("QIAGEN").

WHEREAS, DOGAWIST is the owner of U.S. Trademark Registration No. 4,326,366 for the mark PEAK Design shown below:



in connection with the following goods:

Class 9: Computer hardware for use in laboratory analysis and vehicle technology; hardware and software for communication technology and parts of control systems for the industrial production, and for use in laboratory analysis and vehicle technology; electronic and electro-technical equipment namely, transformers, interface devices and cables used in connection with computers, computer peripheral devices, and network and telecommunication equipment in the fields of communications technology, laboratory analysis and vehicle technology; communications equipment, namely, apparatus for transmission of data and communication in the fields of communications technology, laboratory analysis and vehicle technology; control test and measuring equipment, namely, instrumentation used to test and certify new and existing data communication circuits, cables and interfaces in the fields of communications technology, laboratory analysis and vehicle technology; laboratory analyzers for use in the fields of communications technology, industrial production and vehicle technology; computers for use in the fields of communications technology, laboratory analysis and vehicle technology; electronic devices for computers, namely, interfaces and peripheral devices for computers for use in the fields of communications technology, laboratory analysis and vehicle technology; computer hardware and software used for setting up, configuring, managing and monitoring data communication and networks in the communication technology and as parts of closed-loop and open-loop control systems for the industrial production, laboratory analysis and vehicle technology industries

Class 37: Repair and maintenance of electric and electro-technical equipment, equipment for analyses in laboratories and of sanitary equipment and systems, in the fields of communications technology, laboratory analysis and vehicle technology

Class 41: Organization, management and conduction of training courses and seminars in the fields of communications technology, laboratory analysis and vehicle technology; organization and conduction of training courses in the use of computer hardware and software and in the use of computer databases and computer networks in the fields of communications technology, laboratory analysis and vehicle technology excluding services in the field of pilates sport

Class 42: Development and installation of software and software for databases in the fields of communications technology, laboratory analysis and vehicle technology; communications technology, laboratory analysis and vehicle technology consultancy services for software, hardware, databases and networks; planning, design, configuration and development of electronic communications networks in the

fields of communications technology, laboratory analysis and vehicle technology; computer programming, for software and software modules for control systems for the industrial production and for use in the vehicle technology; development of engineering services for hardware components in the fields of communications technology, laboratory analysis and vehicle technology; engineering design services in the fields of communications technology, laboratory analysis and vehicle technology; development of electro-technical equipment for the fields of communications technology, laboratory analysis and vehicle technology; engineering design services in the fields of communications technology, laboratory analysis and vehicle technology; consultancy services in the field of technical maintenance of laboratory analysis equipment;

WHEREAS, QIAGEN seeks to register the mark PEAK SERVICE Design shown below, and is the owner of U.S. Trademark Application Serial No. 79/140,199:



for the following goods:

Class 37: Installation, overhaul, rebuilding, maintenance and repair of apparatus, equipment, instruments, systems, machines and plants; installation, overhaul, rebuilding, maintenance and repair information in particular of apparatus, equipment, instruments, systems, machines and plants; installation, maintenance and repair of computer hardware and computer peripherals, in particular of computer hardware and computer peripherals being a part of or for use in connection with apparatus, instruments, systems, machines and plants; all of the aforementioned services in particular for and in connection with apparatus, instruments, systems, machines and plants for laboratory, diagnostic, medical, medical-technical and industrial use

Class 42: Calibration measuring; calibration services relating to analytical, diagnostic, medical and medical-technical apparatus; certification quality control; quality control; quality control testing; consultancy services relating to application system testing and quality control; technical testing services; technical project studies; surveying; technical consultancy relating to design, research and development in the field of and in connection with apparatus, instruments, systems, machines and plants for laboratory, diagnostic, medical, medical-technical and industrial use; consultancy in the field of computer hardware, computer peripherals and computer software; design, developing, installation, maintenance, repair, updating, adapting and rental of computer software; software customisation services; support and maintenance services for computer software; the aforementioned services relating in particular to software for operation and maintenance of scientific apparatus, instruments and equipment as well as apparatus, instruments and equipment for use in industrial processes, software for creating experimental and process profiles, software for providing experimental and process reports and reports of apparatus performance verification, software for analysing, displaying and visualizing experimental and process data, software for entry, storage, evaluation and retrieval of data, in particular in or from databases and for database forms, database extracts and database queries, in particular in the field of laboratory information management, i.e. for use in scientific and industrial laboratories, in particular in chemical, physical, biological and medical laboratories, for entry, storage, processing, evaluation and managing experimental and process data and documents, for managing of process flows and operating processes and for quality control;

WHEREAS, the parties believe confusion is unlikely between their respective uses, *inter alia*, because of differences in their marks and the sophistication of their target consumers; and

WHEREAS, the parties wish to provide for the continued use and registration of their respective marks as set forth below.

NOW, THEREFORE, in consideration of the mutual promises and undertakings contained herein, and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties agree as follows:

1. QIAGEN consents to and agrees not to object to or oppose DOGA WIST's use or registration of PEAK Design as described in U.S. Trademark Registration No. 4,326,366.
2. DOGA WIST consents to and agrees not to object to or oppose QIAGEN's use or registration of PEAK SERVICE Design as described in U.S. Trademark Application Serial No. 79/140,199.
3. The parties are not aware of any existing confusion and do not believe any confusion will result from their concurrent use of PEAK Design and PEAK SERVICE Design for their respective goods given the differences in their marks and the sophistication of their target consumers. In the unlikely event that confusion should arise, the parties will take steps necessary to prevent the possibility of consumer confusion in the future.
4. This Agreement and the consents granted herein shall apply to the use and registration of the parties' marks by the parties and their affiliates and subsidiaries anywhere in the world. Should either party or its affiliate or subsidiary require consent from the other, consistent with and limited to the terms of this Agreement, to support an application to register its mark in the Trademark Office of a particular country, the other party shall cooperate in the execution of such consent, at the request of and sole expense of the requesting party.
5. The terms and conditions of this Agreement shall inure to the benefit of and be binding and enforceable against each party's agents, successors, licensees, assignees and other present or future parties in interest.

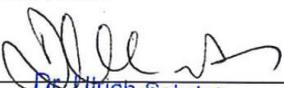
IN WITNESS WHEREOF, the parties hereto enter into this Agreement on the last date set forth below.

DOGA WIST-Investment GmbH

By: 
Axel Dohmann, CEO
(type or print name and title)

Date: January 26, 2015

QIAGEN GmbH

By: 
Dr. Ulrich Schriek
Senior Vice President
Corporate Business Development
(type or print name and title)

Date: _____

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Dr. Ralf Blumenthal
Senior Director
Corporate Business Development

QIAGEN Legal



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

JANUARY 30, 2015

PTAS

LORRAINE LINFORD
701 FIFTH AVENUE
SUITE 5400
SEATTLE, WA 98104

900314105

UNITED STATES PATENT AND TRADEMARK OFFICE NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

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RECORDATION DATE: 01/29/2015

REEL/FRAME: 5449/0161
NUMBER OF PAGES: 6

BRIEF: ASSIGNS THE ENTIRE INTEREST

DOCKET NUMBER: 770025.242

ASSIGNOR:

PEAK-SERVICE USA, LLC

DOC DATE: 02/29/2012

CITIZENSHIP: DELAWARE

ENTITY: LIMITED LIABILITY COMPANY

ASSIGNEE:

QIAGEN INC.

CITIZENSHIP: CALIFORNIA

ENTITY: CORPORATION

27220 TURNBERRY LANE
SUITE 200
VALENCIA, CALIFORNIA 91355

SERIAL NUMBER: 77807309

FILING DATE: 08/18/2009

REGISTRATION NUMBER: 3770847

REGISTRATION DATE: 04/06/2010

MARK: PEAK USA

DRAWING TYPE: STANDARD CHARACTER MARK

ASSIGNMENT RECORDATION BRANCH
PUBLIC RECORDS DIVISION