

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79142160
LAW OFFICE ASSIGNED	LAW OFFICE 119
MARK SECTION	
MARK	<a href="http://tsdr.uspto.gov/img/79142160/large">http://tsdr.uspto.gov/img/79142160/large</a>
LITERAL ELEMENT	NIVAPREP
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
<b><u>Request for Reconsideration</u></b>	
Trademark: NIVAPREP Serial Number: 79142160 Applicant: Velinor AG	
<b><u>I. Background</u></b>	
<p>This is responsive to the Final Office Action dated September 21, 2014 based on the Examining Attorney's position that the trademark NIVAPREP (Applicant's Mark) is likely to be confused with prior registration number 3591366 for NOVAPREP (Cited Mark). In support of registration, Applicant submits the following response and arguments and requests that the refusal be withdrawn and that the trademark be approved for publication.</p>	
<p>This Request for Reconsideration is being filed in accordance with TMEP Section 715.03. Applicant has also today filed a Notice of Ex Parte Appeal concurrently herewith. In addition, the Applicant has hereby also requests that the Examiner suspend the application under TMEP 716.02 pending the filing of an Affidavit of use to support the maintenance of the Cited Mark. The Applicant submits that the arguments and evidence provided herein overcome the Examiner's refusal or alternatively, requests the suspension of the application under TEMP Section 716.02(e).</p>	

## **II. Rejection Based on Prior Registration**

The Examining Attorney has refused registration of the mark "NIVAPREP" ("Applicant's Mark") under Trademark Act § 2 (d), 15 U.S.C. § 1052(d), on the ground that Applicant's Mark so resembles the mark shown in U.S. Registration No. 3591366 for "NOVA PREP" (the "Cited Mark"), as to be likely to cause confusion, to cause mistake or to deceive a potential customer as to the source of the goods of the applicant and registrant. Applicant respectfully disagrees with the findings and requests that the Examining Attorney reconsider the refusal to register and allow the publication of the application.

## **III. Summary of Argument- Legal Standard to be Followed**

Applicant incorporates by reference the arguments made in Applicant's Response to Office Action submitted September 4, 2014. The TTAB and the CAFC have identified several factors to be considered in determining whether a likelihood of confusion exists under Section 2 d of the Lanham Act. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*"). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). "Not all of the *du Pont* factors are relevant to every case, and only factors of significance to the particular mark need be considered." *In re Mighty Leaf Tea*, 601F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010).

The factors that are relevant to the present case include:

(A) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

(B) The relatedness of the goods or services as described in an application or registration or in connection with which a prior mark is in use.

(C) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.

(D) any other established fact probative of the effect of use.

The existence of a likelihood of confusion must be determined on the basis of all evidence viewed in its entirety. In *In Re E.I. Du Pont DeNemours & Co.*, 476 F.2d 1357, 1360-62 (C.C.P.A. 1973). These factors counsel against finding a likelihood of confusion when applied to Applicant's Mark and the Cited Mark and the facts of the present case.

### **a. The Trademarks Differ in Appearance, Sound and Connotation**

In determining likelihood of confusion, "marks must be compared in their entireties." Likelihood of confusion "cannot be predicated on dissection of a mark, that is, only on part of a mark," while ignoring other elements of the marks (emphasis added). *In re National Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985); see also *Franklin Mint v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (C.C.P.A. 1981); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974). The marks cannot be dissected or split into component parts and each part compared with other parts. Since it is the entire mark that consumers perceive, it is the entire mark that must be compared to another mark.

The Examiner continues to believe that the overall appearance of the trademarks are similar because of the single letter difference. Applicant believes that this point minimizes the overall differences in the pronunciation, meaning and look of the trademarks.

### **b. Third Party Registrations of "NOVA" and "PREP" Erode the Strength of the Cited**

## Mark

There are at least 163 active US PTO registrations and applications in International Class 5 and class 10 for marks incorporating the exact term “NOVA” as the prefix in filed trademarks, and there are at least 139 active US PTO registrations and applications in International Class 5 and 10 for marks incorporating the exact term “PREP” as a suffix. These third party applications and registrations for “NOVA” and “PREP” marks, all identifying goods in classes 5 and 10 are relevant to the determination of a likelihood of confusion with another user of the same or virtually the same mark. *In re E.I. DuPont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (CCPA 1973); *Olde Tyme Foods Inc v. Roundy's Inc.*, 22 U.S.P.Q.2d 1542, 1545 (TTAB 1992). Specifically, these third party marks demonstrate that ‘NOVA’ and ‘PREP’ are suggestive terms and that there is room for the concurrent registrations of marks with distinguishing components identifying similar goods, and marks, such as Applicant’s, with similar components which identify completely different goods. Confronted with the marks in their entireties, consumers are left with distinct images. Applicant’s mark and the Cited Mark differ in terms of sight, sound, and appearance. As a result, Applicant’s mark creates a distinct commercial impression separate and apart from the Cited Mark, such that confusion is unlikely.

### c. The Dissimilarity of the Parties' Goods Supports a Finding of No Likelihood of Confusion

To find a likelihood of confusion, the goods and/or services for which the marks have been applied for or registered must be related. If the goods and/or services are not related or marketed in such a manner that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. Further, the nature and scope of a party’s goods or services must be determined on the basis of the goods or services set forth in the application or registration. See, e.g., *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490 (Fed. Cir. 1987).

Clearly the focus of the registrant’s goods and Applicant’s goods have no similarities or relatedness in the medical profession to create a potential for confusion. Registrant’s goods are focused on cytological chemical reagents and cytology and in-vitro medical equipment versus the Applicant’s gastro-intestinal pharmaceutical preparations and related medical equipment.

To the extent that the Examiner would maintain that confusion is likely due to the relatedness of the goods at issue, Applicant respectfully submits that any relatedness is far too general to sustain a finding of confusion.

### IV. Request for Suspension

Alternatively, the Examining Attorney should note that the cited registration for NOVAPREP was registered on March 17, 2009 and based on a check of the US PTO records as of today, there has been no affidavit of use filed to maintain the registration. As such, the registration is now formally in the “grace period”. In view of the status of the registration being ultimately maintained, Applicant believes that a suspension pursuant to Section 716.02 and 716.02e of the application would be appropriate to avoid the time and expense of the US Trademark

Office to handle the application and any actions associated with the Notice of Appeal that has been filed. The relevant section from Section 716.02(e)

716.02(e) Pending Cancellation or Expiration of Cited Registration

“Similarly, if the examining attorney is ready to issue a denial of a request for reconsideration of a final refusal of registration under §2(d), and the cited registration is in the grace period for filing a §8 or §71 affidavit or §9 renewal application, the examining attorney must suspend action. If the registrant timely files, and the USPTO accepts, the §8 or §71 affidavit and/or the cited registration is renewed, the examining attorney will remove the application from suspension and issue an Examiner’s Subsequent Final Refusal, thereby giving the applicant six months in which to file an appeal.”

**V. Conclusion**

Each of the required factors weighs against finding a likelihood of confusion between Applicant's Mark and the Cited Mark, and supports registration of Applicant's Mark. Applicant respectfully requests that the Examining Attorney reconsider the possible refusal to register, and that the Application be allowed to proceed to publication.

**ADDITIONAL STATEMENTS SECTION**

<b>MISCELLANEOUS STATEMENT</b>	Please note that a Notice of Appeal will be filed today.
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**SIGNATURE SECTION**

<b>RESPONSE SIGNATURE</b>	/OGRP-TJM-ANA/
<b>SIGNATORY'S NAME</b>	Terrence J. McAllister
<b>SIGNATORY'S POSITION</b>	Attorney of record for Applicant- New York
<b>SIGNATORY'S PHONE NUMBER</b>	203 327 4500
<b>DATE SIGNED</b>	03/23/2015
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	NO

**FILING INFORMATION SECTION**

<b>SUBMIT DATE</b>	Mon Mar 23 18:26:02 EDT 2015
<b>TEAS STAMP</b>	USPTO/RFR-108.170.127.98- 20150323182602378378-7914 2160-530d07e22d6bc4c2b185 1bcfc954f095c92e6ef46f636 4ffab7a45e28709175b8-N/A- N/A-20150323140834120831

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

Application serial no. **79142160** NIVAPREP(Standard Characters, see <http://tsdr.uspto.gov/img/79142160/large>) has been amended as follows:

**ARGUMENT(S)**

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

**Request for Reconsideration**

Trademark: NIVAPREP  
Serial Number: 79142160  
Applicant: Velinor AG

**I. Background**

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### **ADDITIONAL STATEMENTS**

#### **Miscellaneous Statement**

Please note that a Notice of Appeal will be filed today.

### **SIGNATURE(S)**

#### **Request for Reconsideration Signature**

Signature: /OGRP-TJM-ANA/ Date: 03/23/2015

Signatory's Name: Terrence J. McAllister

Signatory's Position: Attorney of record for Applicant- New York

Signatory's Phone Number: 203 327 4500

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: 79142160

Internet Transmission Date: Mon Mar 23 18:26:02 EDT 2015

TEAS Stamp: USPTO/RFR-108.170.127.98-201503231826023

78378-79142160-530d07e22d6bc4c2b1851bcfc

954f095c92e6ef46f6364ffab7a45e28709175b8

-N/A-N/A-20150323140834120831