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Examining Attorney: LEVINE, HOWARD B.
Serial Number: 79/151708



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Dr. Willmar Schwabe GmbH & Co. KG
Serial No. : 79/151,708
Filed : January 17, 2014
Mark : GASPAN
Examiner : Howard B. Levine
Examining Attorney
Law Office 115

September 1, 2015

Commissioner for Trademarks
P. O. Box 1451
Alexandria, VA 22313-1451

AMENDMENT

The further Office Action of the Examiner, dated March 16, 2015, has been carefully reviewed.

The only open issue is the description of goods. Applicant believes that the description below, a description which has been further amended, is completely satisfactory.

The further amended Class 5 description simply follows the Examiner's suggestions. The further amended Class 29 and



09-08-2015

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30 descriptions are both within the instant application as filed and identical to the descriptions in applicant's very recently allowed and published application Serial Number 79/157,103.¹ They are also much narrower than the previously approved descriptions in Registrations 4,120,205 and 4,008,174.

Since the Examiner has marked his pending Office Action as FINAL, it would be appreciated if he would kindly advise the undersigned, at his earliest convenience prior to September 16, 2015, on the status of the instant application.

With regard to the descriptions for Classes 29 and 30, applicant notes that regardless of whether a prior description decision of a single trademark Examiner is binding on another Examiner, so that the latter would have no alternative but to accept it, the Federal Circuit has, in fact, urged Examiners to use existing precedents for new applications rather than requiring the formulation of fresh descriptions. In re Omega SA, 83 USPQ2d 1541 (Fed. Cir. 2007)

¹ A TESS printout of that application (published on July 21, 2015) is attached for the convenience of the Examiner.

As that most recent Federal Circuit decision on point has stated:

"We agree that consistency [in descriptions of goods and services] is highly desirable, and that the time and expense of complying with inconsistent applications burdens both the PTO and the public that depends on its services." In re Omega SA, supra.

Put differently, in nearly all cases, descriptions of goods, especially those recently approved by the Patent and Trademark Office, are the only available precedents for the public and the Examining corps for language that is acceptable under the statutes and rules of the Office for later applications.

Like other precedents in the law, they serve to provide published standards for both the public and the Patent and Trademark Office and, absent any contrary published standards, conformance with such precedents should prima facie be sufficient to satisfy the requirements of the statute and rules.

Aside and apart from the extremely recent determination in connection with application SN 79/157,103, referred to

above, it is also noted that the language of the further amended Class 29 and 30 descriptions, set forth below in the penultimate paragraph of this Amendment, is now a good deal narrower than the language of Classes 29 and 30 in the previously cited Registration 4,120,205, which reads:

IC 029: Processed food consisting wholly or principally of extracts of plant in the form of block, powder, granulated powder, grain, capsule, tablet, liquid or jelly, excluding those for medical purposes

IC 030: Processed food consisting wholly or principally of grain extracts in the form of block, powder, granulated powder, grain, capsule, tablet, liquid or jelly, excluding those for medical purposes

The language of the further amended Class 29 and 30 descriptions, set forth below, is also a good deal narrower than language in the previously cited Registration 4,008,174, which reads:

IC 029 (last entry): processed food consisting wholly or principally of extracts of plant in the form of block, powder, granulated powder, grain, capsule, tablet, liquid or jelly, excluding those for medical purposes

IC 030 (penultimate entry): processed food consisting wholly or principally of grain extracts in the form of block, powder, granulated powder, grain, capsule, tablet, liquid or jelly, excluding those for medical purposes

Accordingly, please amend the description of goods in the instant application to read as follows:

IC 005: pharmaceutical preparations for use in the treatment of gastrointestinal disorders; veterinary preparations used to treat gastrointestinal disorders in domestic pets and livestock; food in the form of blocks, powder, granulated powder, grain, capsule, tablet, liquid or jelly; food supplements in beverage form.

IC 029: Low-fat foods based on proteins and fat, with added fatty acids, namely, those principally consisting of extracts of plant in the form of blocks, powders, granulated powders, grains, capsules, tablets, liquids or jellies, excluding those for medical purposes

IC 030: Low-fat foods based on carbohydrates, namely, those consisting wholly or principally of grain extracts in the form of blocks, powders, granulated powders, grains, capsules, tablets, liquids and jellies, excluding those for medical purposes

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As the Examiner has searched the Office records and determined that there is no third party mark that conflicts with the instant mark, publication is respectfully requested.

Respectfully submitted,

KIRSCHSTEIN, ISRAEL, SCHIFFMILLER
& PIERONI, P.C.

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Attachment:

TESS printouts of Application S.N. 79/157,103

Date of Deposit: September 1, 2015

I hereby certify that a copy of this paper or fee is being deposited with the United States Postal Services with sufficient postage as First Class Mail in an envelope addressed to:
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on September 1, 2015

KIRSCHSTEIN, ISRAEL, SCHIFFMILLER & PIERONI, P.C.

By: Ute Nolan
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Goods and Services IC 005. US 006 018 044 046 051 052. G & S: Pharmaceutical preparations for the treatment of gastrointestinal disorders; sanitary preparations for medical purposes; dietetic substances adapted for medical use, namely, beverages and food supplements adapted for medical use in the form of blocks, powders, granulated powders, grains, capsules, tablets, liquids and jellies

IC 029. US 046. G & S: Low-fat foods based on proteins and fat, with added fatty acids, namely, those principally consisting of extracts of plant in the form of blocks, powders, granulated powders, grains, capsules, tablets, liquids or jellies, excluding those for medical purposes

IC 030. US 046. G & S: Low-fat foods based on carbohydrates, namely, those consisting wholly or principally of grain extracts in the form of blocks, powders, granulated powders, grains, capsules, tablets, liquids and jellies, excluding those for medical purposes

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 79157103

Filing Date October 22, 2014

Current Basis 66A

Original Filing Basis 66A

Published for Opposition July 21, 2015

International Registration Number 1228091

Owner (APPLICANT) Dr. Willmar Schwabe GmbH & Co. KG GmbH& Co. KG FED REP GERMANY Willmar-Schwabe-Str.4 76227 Karlsruhe FED REP GERMANY

Type of Mark Register TRADEMARK PRINCIPAL

Live/Dead
Indicator

LIVE

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