

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79160528
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/79160528/large
LITERAL ELEMENT	OSYPKA-MEDTEC
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)

Remarks

Applicant writes in response to the Office Action issued in connection with the U.S. Application Serial No. 79/160,528 on September 14, 2015 and addresses the Examining Attorney's objections in full as follows:

I. Identification of Goods and Services

The Examining Attorney contends that certain wording set forth in the identification of goods and services remains indefinite and must be clarified. Accordingly, the identification of goods and services has been amended in accordance with the Examining Attorney's requirement. As amended, Applicant's goods and services are more narrowly defined and incorporate the Examining Attorney's proposed revisions. As amended, the identification of goods and services reads as follows:

International Class 009: "Electric and electronic devices and instruments for the measurement, input, storage, display, analysis, processing, generation and transmission of data and signals, namely, input devices for computers, output devices in the nature of computer monitors, and instruments in the nature of sensors for use with computers; monitors, namely, implant device computer monitors, data processing devices, namely, data processors, computers, computer programs for programming and fitting implantable devices, parts of the aforesaid goods as well as additional parts for this purpose as far as included in this class, namely, electronic cables, remote controls for computers and implant device computer monitors; programmable units in the nature of computers and implant device computer monitors; all the aforesaid goods for the medical sector."

International Class 010: "Medical devices and instruments for the application in diagnosis and therapy of heart and blood circulation functions, except external pacemakers; implantable catheter for pacemaker; electrodes for medical purposes, in particular heart wires; sensing and/or stimulation apparatus, namely, heart and nerve stimulator apparatus and defibrillators, each positioned outside the body and capable of being temporarily connected to the heart by means of heart wires, except external pacemakers; parts of the aforesaid goods as well as additional parts for this purpose, as far as included in this class, namely, medical tubing connectors, cables in the nature of patient cables and interface cables, and surface electrodes for medical use."

International Class 037: "Cleaning, disinfection and sterilization of medical devices, apparatus and instruments for third parties."

International Class 042: "Technical advice relating to the development of medical and electro-medical equipment, in particular in the field of diagnosis and therapy of heart and blood circulation functions, carrying out of research and development in the field of medical devices, apparatus and instruments, development and implementation of computer software and computer programs for data treatment."

It is respectfully submitted that the identification of goods and services, as amended, is now sufficiently definite for purposes of registration

and acceptance is respectfully urged.

II. Section 2(d) Likelihood of Confusion Objection

As previously submitted, the owner of Osypka Medical GmbH is the son of the founder of Applicant, Osypka AG, and both companies remain in active correspondence regarding use and registration of their respective OSYPKA-formative marks in Germany, the United States, and various other international jurisdictions. Specifically, both companies have discussed and agreed upon the peaceful co-existence of their respective OSYPKA-formative trademarks in Germany, the United States, and various of international jurisdictions and have agreed to work together to mitigate the possibility of any consumer confusion pertaining to same trademarks in those jurisdictions. Notably, the current CEO of Osypka Medical GmbH, Dr. Markus Osypka, has provided his assurance to Applicant that Osypka Medical GmbH will not oppose Applicant's registration of the subject mark in the United States. Further, the companies have been able to register their respective OSYPKA-formative marks in Germany over one another based on this co-existence understanding.

Applicant acknowledges the Examining Attorney's arguments, but respectfully maintains that the existence of this consent agreement between the parties (which provides for Applicant's use and registration of the subject mark in the United States) obviates Osypka Medical GmbH's Cited Registrations as a possible basis for maintaining any likelihood of confusion objection.

Under Section 1207.01(d)(viii) of the USPTO's Trademark Manual of Examining Procedure ("TMEP"), an applicant may cite an active consent agreement to overcome a likelihood of confusion objection. According to TMEP, the examining attorney should give great weight to a proper consent agreement, and should not interpose his or her own judgment concerning likelihood of confusion when an applicant and registrant have entered into a credible consent agreement. See Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank, 842 F.2d 1270 (Fed. Cir. 1988); Bongrain International (American) Corp. v. Delice de France Inc., 811 F.2d 1479 (Fed. Cir. 1987). Thus, Applicant respectfully maintains that no likelihood of confusion exists and the Examining Attorney's objections have been overcome in full.

Conclusion

In view of the foregoing, it is respectfully submitted that all grounds for rejection have been successfully traversed by Applicant and the application is now in order for publication.

GOODS AND/OR SERVICES SECTION (009)(current)

INTERNATIONAL CLASS

009

DESCRIPTION

Electric and electronic devices and instruments for the measurement, input, storage, display, analysis, processing, generation and transmission of data and signals, namely, input and output devices and instruments for computers; monitors, namely, implant device monitors, data processing devices, namely, data processors, computers, computer programs for programming and fitting implantable devices, parts of the aforesaid goods as well as additional parts for this purpose as far as included in this class, namely, electronic cables, remote controls, programmable units; all the aforesaid goods for the medical sector

GOODS AND/OR SERVICES SECTION (009)(proposed)

INTERNATIONAL CLASS

009

TRACKED TEXT DESCRIPTION

~~Electric and electronic devices and instruments for the measurement, input, storage, display, analysis, processing, generation and transmission of data and signals, namely, input and output devices and instruments for computers;~~ Electric and electronic devices and instruments for the measurement, input, storage, display, analysis, processing, generation and transmission of data and signals, namely, input devices for computers, output devices in the nature of computer monitors, and instruments in the nature of sensors for use with computers; ~~monitors, namely, implant device monitors, data processing devices, namely, data processors, computers, computer programs for programming and fitting implantable devices, parts of the aforesaid goods as well as additional parts for this purpose as far as included in this class, namely, electronic cables, remote controls, programmable units;~~ monitors, namely, implant device computer monitors, data processing devices, namely, data processors, computers, computer programs for programming and fitting implantable devices, parts of the aforesaid goods as well as additional parts for this purpose as far as included in this class, namely, electronic cables, remote controls for computers and implant device computer monitors; ~~all the aforesaid goods for the medical sector;~~ programmable units in the nature of computers and implant device computer monitors; all the aforesaid goods for the medical sector

FINAL DESCRIPTION

Electric and electronic devices and instruments for the measurement, input, storage, display, analysis, processing, generation and transmission of data and signals, namely, input devices for computers, output devices in the nature of computer monitors, and instruments in the nature of sensors for use with computers; monitors, namely, implant device computer monitors, data processing devices, namely, data processors, computers, computer programs for programming and fitting implantable devices, parts of the aforesaid goods as well as additional parts for

this purpose as far as included in this class, namely, electronic cables, remote controls for computers and implant device computer monitors; programmable units in the nature of computers and implant device computer monitors; all the aforesaid goods for the medical secto

GOODS AND/OR SERVICES SECTION (010)(current)

INTERNATIONAL CLASS 010

DESCRIPTION

Medical devices and instruments for the application in diagnosis and therapy of heart and blood circulation functions; implantable catheter for pacemaker; electrodes for medical purposes, in particular heart wires; sensing and/or stimulation apparatus, namely, heart and nerve stimulator apparatus and defibrillators, each positioned outside the body and capable of being temporarily connected to the heart by means of heart wires; parts of the aforesaid goods as well as additional parts for this purpose, as far as included in this class, namely, connectors, cables and surface electrodes

GOODS AND/OR SERVICES SECTION (010)(proposed)

INTERNATIONAL CLASS 010

TRACKED TEXT DESCRIPTION

~~Medical devices and instruments for the application in diagnosis and therapy of heart and blood circulation functions;~~ Medical devices and instruments for the application in diagnosis and therapy of heart and blood circulation functions, except external pacemakers; implantable catheter for pacemaker; electrodes for medical purposes, in particular heart wires; ~~sensing and/or stimulation apparatus, namely, heart and nerve stimulator apparatus and defibrillators, each positioned outside the body and capable of being temporarily connected to the heart by means of heart wires;~~ sensing and/or stimulation apparatus, namely, heart and nerve stimulator apparatus and defibrillators, each positioned outside the body and capable of being temporarily connected to the heart by means of heart wires, except external pacemakers; ~~parts of the aforesaid goods as well as additional parts for this purpose, as far as included in this class, namely, connectors, cables and surface electrodes;~~ parts of the aforesaid goods as well as additional parts for this purpose, as far as included in this class, namely, medical tubing connectors, cables in the nature of patient cables and interface cables, and surface electrodes for medical use

FINAL DESCRIPTION

Medical devices and instruments for the application in diagnosis and therapy of heart and blood circulation functions, except external pacemakers; implantable catheter for pacemaker; electrodes for medical purposes, in particular heart wires; sensing and/or stimulation apparatus, namely, heart and nerve stimulator apparatus and defibrillators, each positioned outside the body and capable of being temporarily connected to the heart by means of heart wires, except external pacemakers; parts of the aforesaid goods as well as additional parts for this purpose, as far as included in this class, namely, medical tubing connectors, cables in the nature of patient cables and interface cables, and surface electrodes for medical use

GOODS AND/OR SERVICES SECTION (037)(no change)

GOODS AND/OR SERVICES SECTION (042)(no change)

SIGNATURE SECTION

RESPONSE SIGNATURE /John P. Sullivan/
SIGNATORY'S NAME John P. Sullivan
SIGNATORY'S POSITION Attorney of Record, Pennsylvania Bar Member
SIGNATORY'S PHONE NUMBER 215-568-6400
DATE SIGNED 03/14/2016
AUTHORIZED SIGNATORY YES
CONCURRENT APPEAL NOTICE FILED YES

FILING INFORMATION SECTION

SUBMIT DATE Mon Mar 14 18:32:14 EDT 2016

TEAS STAMP

USPTO/RFR-XX.XX.XXX.XX-20
160314183214017307-791605
28-550d59b973eacfe27fb9b4
b7a1c9a988c0d929a64b7b893
6a97d36d763d27228d-N/A-N/
A-20160314182928693677

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **79160528** OSYPKA-MEDTEC(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/79160528/large>) has been amended as follows:

ARGUMENT(S)

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

Remarks

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I. Identification of Goods and Services

The Examining Attorney contends that certain wording set forth in the identification of goods and services remains indefinite and must be clarified. Accordingly, the identification of goods and services has been amended in accordance with the Examining Attorney's requirement. As amended, Applicant's goods and services are more narrowly defined and incorporate the Examining Attorney's proposed revisions. As amended, the identification of goods and services reads as follows:

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International Class 010: "Medical devices and instruments for the application in diagnosis and therapy of heart and blood circulation functions, except external pacemakers; implantable catheter for pacemaker; electrodes for medical purposes, in particular heart wires; sensing and/or stimulation apparatus, namely, heart and nerve stimulator apparatus and defibrillators, each positioned outside the body and capable of being temporarily connected to the heart by means of heart wires, except external pacemakers; parts of the aforesaid goods as well as additional parts for this purpose, as far as included in this class, namely, medical tubing connectors, cables in the nature of patient cables and interface cables, and surface electrodes for medical use."

International Class 037: "Cleaning, disinfection and sterilization of medical devices, apparatus and instruments for third parties."

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It is respectfully submitted that the identification of goods and services, as amended, is now sufficiently definite for purposes of registration and acceptance is respectfully urged.

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Conclusion

In view of the foregoing, it is respectfully submitted that all grounds for rejection have been successfully traversed by Applicant and the application is now in order for publication.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Current: Class 009 for Electric and electronic devices and instruments for the measurement, input, storage, display, analysis, processing, generation and transmission of data and signals, namely, input and output devices and instruments for computers; monitors, namely, implant device monitors, data processing devices, namely, data processors, computers, computer programs for programming and fitting implantable devices, parts of the aforesaid goods as well as additional parts for this purpose as far as included in this class, namely, electronic cables, remote controls, programmable units; all the aforesaid goods for the medical sector

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: ~~Electric and electronic devices and instruments for the measurement, input, storage, display, analysis, processing, generation and transmission of data and signals, namely, input and output devices and instruments for computers;~~ Electric and electronic devices and instruments for the measurement, input, storage, display, analysis, processing, generation and transmission of data and signals, namely, input devices for computers, output devices in the nature of computer monitors, and instruments in the nature of sensors for use with computers; monitors, namely, implant device monitors, data processing devices, namely, data processors, computers, computer programs for programming and fitting implantable devices, parts of the aforesaid goods as well as additional parts for this purpose as far as included in this class, namely, electronic cables, remote controls, programmable units; monitors, namely, implant device computer monitors, data processing devices, namely, data processors, computers, computer programs for programming and fitting implantable devices, parts of the aforesaid goods as well as additional parts for this purpose as far as included in this class, namely, electronic cables, remote controls for computers and implant device computer monitors; all the aforesaid goods for the medical sector; programmable units in the nature of computers and implant device computer monitors; all the aforesaid goods for the medical sector

Class 009 for Electric and electronic devices and instruments for the measurement, input, storage, display, analysis, processing, generation and transmission of data and signals, namely, input devices for computers, output devices in the nature of computer monitors, and instruments in the nature of sensors for use with computers; monitors, namely, implant device computer monitors, data processing devices, namely, data processors, computers, computer programs for programming and fitting implantable devices, parts of the aforesaid goods as well as additional parts for this purpose as far as included in this class, namely, electronic cables, remote controls for computers and implant device computer monitors; programmable units in the nature of computers and implant device computer monitors; all the aforesaid goods for the medical sector

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.

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

Current: Class 010 for Medical devices and instruments for the application in diagnosis and therapy of heart and blood circulation functions; implantable catheter for pacemaker; electrodes for medical purposes, in particular heart wires; sensing and/or stimulation apparatus, namely, heart and nerve stimulator apparatus and defibrillators, each positioned outside the body and capable of being temporarily connected to the heart by means of heart wires; parts of the aforesaid goods as well as additional parts for this purpose, as far as included in this class, namely, connectors, cables and surface electrodes

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: ~~Medical devices and instruments for the application in diagnosis and therapy of heart and blood circulation functions;~~ Medical devices and instruments for the application in diagnosis and therapy of heart and blood circulation functions, except external pacemakers; implantable catheter for pacemaker; electrodes for medical purposes, in particular heart wires; ~~sensing and/or stimulation apparatus, namely, heart and nerve stimulator apparatus and defibrillators, each positioned outside the body and capable of being temporarily connected to the heart by means of heart wires;~~ sensing and/or stimulation apparatus, namely, heart and nerve stimulator apparatus and defibrillators, each positioned outside the body and capable of being temporarily connected to the heart by means of heart wires, except external pacemakers; ~~parts of the aforesaid goods as well as additional parts for this purpose, as far as included in this class, namely, connectors, cables and surface electrodes;~~ parts of the aforesaid goods as well as additional parts for this purpose, as far as included in this class, namely, medical tubing connectors, cables in the nature of patient cables and interface cables, and surface electrodes for medical use

Class 010 for Medical devices and instruments for the application in diagnosis and therapy of heart and blood circulation functions, except external pacemakers; implantable catheter for pacemaker; electrodes for medical purposes, in particular heart wires; sensing and/or stimulation apparatus, namely, heart and nerve stimulator apparatus and defibrillators, each positioned outside the body and capable of being temporarily connected to the heart by means of heart wires, except external pacemakers; parts of the aforesaid goods as well as additional parts for this purpose, as far as included in this class, namely, medical tubing connectors, cables in the nature of patient cables and interface cables, and surface electrodes for medical use

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: /John P. Sullivan/ Date: 03/14/2016

Signatory's Name: John P. Sullivan

Signatory's Position: Attorney of Record, Pennsylvania Bar Member

Signatory's Phone Number: 215-568-6400

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 owner's/holder'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 owner/holder in this matter: (1) the owner/holder 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 owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder'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: 79160528

Internet Transmission Date: Mon Mar 14 18:32:14 EDT 2016

TEAS Stamp: USPTO/RFR-XX.XX.XXX.XX-20160314183214017

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