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

Proceeding	79160528
Applicant	OSYPKA AG
Applied for Mark	OSYPKA-MEDTEC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
IN RE **TRADEMARK APPLICATION**

Applicant: OSYPKA AG

Trademark Atty: Mayur C. Vaghani

Appln. No.: 79/160,528

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Mark: OSYPKA-MEDTEC

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MAIN BRIEF OF APPLICANT ON APPEAL

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Applicant, OSYPKA AG (referred to herein as “Applicant”), submits this Main Brief of Applicant on Appeal in support of the registration of U.S. Application Serial No. 79/160,528 for “OSYPKA-MEDTEC.”

I. DESCRIPTION OF THE RECORD AND STATEMENT OF FACTS

A first Office Action issued in this matter on February 24, 2015. In that Office Action, the Examining Attorney refused Applicant’s Mark based on: (1) ; and (2) the indefiniteness of the identification of goods for international classes 09, 10, 37, and 42. Applicant filed a response to the first Office Action on August 25, 2015. The Examining Attorney maintained the objections and issued a FINAL Office Action on September 14, 2015. Subsequently, Applicant timely filed a Request for Reconsideration in response to the FINAL Office Action on March 14, 2016. On March 14, 2016, Applicant also filed a Notice of Appeal with the Board. On May 19, 2016, the Examining Attorney issued an action denying Applicant’s Request for Reconsideration. Applicant is now filing its Appeal Brief with the TTAB. Due to an inadvertent docketing error, Applicant is filing this Appeal Brief on July 25, 2016 rather than July 22, 2016. Applicant has correspondingly filed a Petition to Revive the subject application with the USPTO in order to address this error.

II. STATEMENT OF ISSUES

The issues on appeal are as follows:

1. Whether likelihood of confusion exists under Section 2(d) based on the existence of the following active U.S. Registrations cited by the Examining Attorney (all of which are owned by Osypka Medical

GmbH): (1) U.S. Registration No. 2,772,553 for the mark OSYPKA MEDICAL; (2) U.S. Registration No. 4,465,353 for the mark OSYPKA; (3) U.S. Registration No. 2,940,643 for the mark OSYPKA and Design; and (4) U.S. Registration No. 2,818,257 for the mark CARDIOTRONIC AN OSYPKA COMPANY and Design (collectively referenced herein as the “Cited Registrations”).

2. Whether certain items in the identification of goods for international classes 09, 10, 37 and 42 are indefinite.

III. ARGUMENT

A. Likelihood of Confusion Rejection Under Section 2(d)

As previously submitted by Applicant, 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. The parties are no in the process of finalizing the consent agreement to formalize and execute the aforementioned understanding.

Applicant 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 in view of the consent agreement negotiated by the parties, and will promptly submit same consent agreement upon final execution shortly. Applicant has a good faith belief that submission of this valid and fully executed consent agreement will

resolve the sole remaining issue regarding likelihood of confusion under Section 2(d). In view of the above, Applicant respectfully requests a 60-day suspension of the appeal pursuant to the provisions of 37 C.F.R. §2.142(d) and subsequent remand of the application to the Examining Attorney in order to allow consideration of the appeal for processing the final amendments to resolve the issue.

B. Identification of Goods and Services

The current wording at issue with respect to the identification of goods is as follows:

- Class 009: “Electric and electronic devices and instruments for the measurement, input, storage, display, analysis, processing, generation and transmission of data and signals, namely instruments in the nature of sensors for use with computers.”
- Class 010: “Parts of the aforesaid goods as well as additional parts for this purpose, as far as included in this class, namely, cables in the nature of patient cables and interface cables.”

The Examining Attorney has objected to the above-cited portion of the identification of goods as indefinite and previously proposed the following:

- 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 printers**, and instruments **in the nature of scanners** for 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 {indicate specific devices, e.g. radios, televisions, stereos}**, programmable units **in the nature of {specify type by common commercial**

name, e.g., computers}; all the aforesaid goods for the medical sector.”

- Class 010: “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, **medical tubing** connectors, cables **in the nature of {specify type by common commercial name in Class 010}** and surface electrodes **for medical use.**”

Applicant respectfully submits that the current wording for the goods at issue is sufficiently narrow and definite for purposes of registration. However, in order to further specify the nature of these goods and obviate any possible remaining grounds for objection, Applicant seeks to add the following language to the goods as indicated below:

- Class 009: “Electric and electronic devices and instruments for the measurement, input, storage, display, analysis, processing, generation and transmission of data and signals, namely instruments in the nature of sensors for use with computers **for medical use.**”
- Class 010: “Parts of the aforesaid goods as well as additional parts for this purpose, as far as included in this class, namely, cables in the nature of patient cables and interface cables **for medical use.**”

Applicant has a good faith belief that these amendments will resolve the sole remaining issue regarding the identification of goods. In view of the above, Applicant respectfully requests a 60-day suspension of the appeal pursuant to the provisions of 37 C.F.R. §2.142(d) and subsequent remand of the application to the

Examining Attorney in order to allow consideration of the appeal for processing the final amendments to resolve the issue.

IV. CONCLUSION

In view of the foregoing, Applicant respectfully requests a 60-day suspension of the subject appeal in anticipation of being able to submit a valid and fully executed consent agreement between Applicant and the owner of the Cited Registrations in due course, as well as to finalize the above-discussed amendments to the identification of goods.

Respectfully submitted,

OSYPKA AG

July 25, 2016

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