

Request for Reconsideration after Final Action

The table below presents the data as entered.

| Input Field | Entered |
|--|--|
| SERIAL NUMBER | 85912234 |
| LAW OFFICE ASSIGNED | LAW OFFICE 109 |
| MARK SECTION (no change) | |
| EVIDENCE SECTION | |
| EVIDENCE FILE NAME(S) | |
| ORIGINAL PDF FILE | evi_65606710-20140903190733769826_. Response-02d_Cyrex_3US1_final_w_ExhA.pdf |
| CONVERTED PDF FILE(S) (6 pages) | \\TICRS\EXPORT16\IMAGEOUT16\859\122\85912234\xml10\RFR0002.JPG |
| | \\TICRS\EXPORT16\IMAGEOUT16\859\122\85912234\xml10\RFR0003.JPG |
| | \\TICRS\EXPORT16\IMAGEOUT16\859\122\85912234\xml10\RFR0004.JPG |
| | \\TICRS\EXPORT16\IMAGEOUT16\859\122\85912234\xml10\RFR0005.JPG |
| | \\TICRS\EXPORT16\IMAGEOUT16\859\122\85912234\xml10\RFR0006.JPG |
| | \\TICRS\EXPORT16\IMAGEOUT16\859\122\85912234\xml10\RFR0007.JPG |
| DESCRIPTION OF EVIDENCE FILE | Evidence in the nature of arguments in support of registration has been attached. |
| GOODS AND/OR SERVICES SECTION (current) | |
| INTERNATIONAL CLASS | 010 |
| DESCRIPTION | |
| Specimen collection kits comprising tubes for collecting samples of oral fluid and serum | |
| FILING BASIS | Section 1(a) |
| FIRST USE ANYWHERE DATE | At least as early as 07/01/2012 |
| FIRST USE IN COMMERCE DATE | At least as early as 07/01/2012 |

| GOODS AND/OR SERVICES SECTION (proposed) | |
|---|--|
| INTERNATIONAL CLASS | 010 |
| TRACKED TEXT DESCRIPTION | |
| Specimen collection kits comprising tubes for collecting samples of oral fluid and serum ; Specimen collection kits comprising tubes for collecting samples of oral fluid and serum excluding injection and medical syringes | |
| FINAL DESCRIPTION | |
| Specimen collection kits comprising tubes for collecting samples of oral fluid and serum excluding injection and medical syringes | |
| FILING BASIS | Section 1(a) |
| FIRST USE ANYWHERE DATE | At least as early as 07/01/2012 |
| FIRST USE IN COMMERCE DATE | At least as early as 07/01/2012 |
| ADDITIONAL STATEMENTS SECTION | |
| DISCLAIMER | No claim is made to the exclusive right to use LABORATORIES apart from the mark as shown. |
| CORRESPONDENCE SECTION | |
| ORIGINAL ADDRESS | MEI TSANG FISH & ASSOCIATES, PC 2603 MAIN ST STE 1000 IRVINE California (CA) US 92614-4271 |
| NEW CORRESPONDENCE SECTION | |
| NAME | MEI TSANG |
| FIRM NAME | FISH & TSANG LLP |
| INDIVIDUAL ATTORNEY DOCKET/REFERENCE NUMBER | 102276.0003US1 |
| STREET | 2603 MAIN ST STE 1000 |
| CITY | IRVINE |
| STATE | California |
| ZIP/POSTAL CODE | 92614-4271 |
| COUNTRY | United States |

| | |
|---------------------------------------|---|
| PHONE | 949-943-8300 |
| FAX | 949-943-8358 |
| EMAIL | mtsang@fishiplaw.com;trademarks@fishiplaw.com; lherman@fishiplaw.com |
| AUTHORIZED EMAIL COMMUNICATION | Yes |
| SIGNATURE SECTION | |
| RESPONSE SIGNATURE | /Lindy Herman/ |
| SIGNATORY'S NAME | Lindy Herman |
| SIGNATORY'S POSITION | Attorney of record, CA State Bar Member |
| SIGNATORY'S PHONE NUMBER | 949-943-8300 |
| DATE SIGNED | 09/03/2014 |
| AUTHORIZED SIGNATORY | YES |
| CONCURRENT APPEAL NOTICE FILED | YES |
| FILING INFORMATION SECTION | |
| SUBMIT DATE | Wed Sep 03 19:12:07 EDT 2014 |
| TEAS STAMP | USPTO/RFR-65.60.67.10-201 40903191207877736-8591223 4-5007ba5da72b4e9bfb3e95d 599bb7d74ba81d1f7b66792bf 88f6a335afe81bf448-N/A-N/ A-20140903190733769826 |

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

Application serial no. **85912234** has been amended as follows:

EVIDENCE

Evidence in the nature of Evidence in the nature of arguments in support of registration has been attached.

has been attached.

Original PDF file:

[evi_65606710-20140903190733769826 . Response-02d Cyrex_3US1 final w ExhA.pdf](#)

Converted PDF file(s) (6 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Current: Class 010 for Specimen collection kits comprising tubes for collecting samples of oral fluid and serum

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 07/01/2012 and first used in commerce at least as early as 07/01/2012 , and is now in use in such commerce.

Proposed:

Tracked Text Description: ~~Specimen collection kits comprising tubes for collecting samples of oral fluid and serum;~~ [Specimen collection kits comprising tubes for collecting samples of oral fluid and serum excluding injection and medical syringes](#)

Class 010 for Specimen collection kits comprising tubes for collecting samples of oral fluid and serum excluding injection and medical syringes

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 07/01/2012 and first used in commerce at least as early as 07/01/2012 , and is now in use in such commerce.

CORRESPONDENCE ADDRESS CHANGE

Applicant proposes to amend the following:

Current:

MEI TSANG
FISH & ASSOCIATES, PC
2603 MAIN ST STE 1000
IRVINE
California (CA)
US
92614-4271

Proposed:

MEI TSANG of FISH & TSANG LLP, having an address of
2603 MAIN ST STE 1000 IRVINE, California 92614-4271
United States

mtsang@fishiplaw.com;trademarks@fishiplaw.com; lherman@fishiplaw.com
949-943-8300
949-943-8358
The attorney docket/reference number is 102276.0003US1 .

ADDITIONAL STATEMENTS

Disclaimer

No claim is made to the exclusive right to use LABORATORIES apart from the mark as shown.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Lindy Herman/ Date: 09/03/2014

Signatory's Name: Lindy Herman

Signatory's Position: Attorney of record, CA State Bar Member

Signatory's Phone Number: 949-943-8300

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 filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Mailing Address: MEI TSANG
FISH & TSANG LLP
2603 MAIN ST STE 1000
IRVINE, California 92614-4271

Serial Number: 85912234

Internet Transmission Date: Wed Sep 03 19:12:07 EDT 2014

TEAS Stamp: USPTO/RFR-65.60.67.10-201409031912078777

36-85912234-5007ba5da72b4e9bfb3e95d599bb

7d74ba81d1f7b66792bf88f6a335afe81bf448-N

/A-N/A-20140903190733769826

FISH & TSANG LLP

Mei Tsang, Esq. (CA Bar: 237959)
mtsang@fishiplaw.com
Lindy M. Herman, Esq. (CA Bar: 247017)
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Attorney for Applicant

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

Cyrex Laboratories, LLC

Filed on April 23, 2013

Serial Number: 85/912234

Mark: CYREX LABORATORIES

Examining Attorney
Gina M. Fink

Law Office: 109

REQUEST FOR RECONSIDERATION

In the Office Action dated March 4, 2014, the Examining Attorney refused registration of Applicant’s mark CYREX because of a purported likelihood of confusion with the mark SYREX in U.S. Reg. No. 3109357 (“the Registered Mark”). For the reasons set forth below, Applicant respectfully requests that the Examining Attorney withdraw this refusal and allow the mark to proceed to publication in the *Official Gazette*.

Section 2(d) Refusal

Applicant and the owner of the cited mark have entered into a Consent/Co-Existence Agreement regarding their respective uses of their respective marks, as discussed further herein. For the reasons stated herein, Applicant respectfully requests the Examining Attorney withdraw its 2(d) refusal and approve Applicant’s mark for publication.

I. Prior Registration Cited as 2(d) Bar to Registration: Owner of the Cited Mark has Consented to Registration of Applicant's Mark

A. Consent Agreement is Permitted to Overcome a 2(d) Refusal

A consent agreement is permitted by the USPTO to overcome a 2(d) refusal, to allow the mark to proceed to publication, and ultimately, registration (*see* U.S. Trademark Manual of Examining Procedure §1207.01(d)(viii)). A consent agreement must not be a mere “naked” consent, rather must detail the reasons why confusion is unlikely.

Upon issuance of the initial office action in this case, Applicant initiated an investigation of the owner of the cited mark and the services offered under the cited mark. Based on the results of its investigation, and its discussions with the owner of the cited mark, the parties concluded that their services were sufficiently dissimilar so that confusion was unlikely. The parties have come to an agreement regarding their respective use, co-existence, and consent to registration. A true and correct copy of the consent/co-existence agreement is attached hereto as Exhibit “A” (hereinafter the “Agreement”).

B. The Agreement Demonstrates that Confusion is Unlikely and that the Parties Shall Take Specific Steps to Prevent any Future Likelihood of Confusion

i. Not Merely a Naked Consent

The Agreement details the specific steps each party intends to take to prevent any potential consumer confusion and therefore the Agreement is not merely a “naked” consent.

Here, the Agreement not only demonstrates that the parties have determined that no likelihood of confusion currently exists (particularly as Applicant is focused on clinical immunology laboratory services and the owner of the cited mark is focused on unrelated injection and medical syringes) but it also lists the following steps each party will take with respect to preventing consumer confusion (Applicant is referred to as “CL” and the owner of the cited mark is referred to as “Excelsior”):

- Excelsior and CL have had the opportunity to investigate and believe that neither Excelsior nor CL's marks should prevent the registration of the other's marks, based on many factors including without limitation the dissimilarity of... (b) the nature of the goods described in the respective registration and applications; (c) the established, likely-to-continue trade channels... and (f) the number of years under which the marks have been used concurrently without customer confusion.

- CL has agreed to request the USPTO trademark examiner to add the following words to the description of goods and services in the aforementioned applications: "excluding injection and medical syringes." The parties further agree that all future worldwide applications and registrations will include the language "excluding injection and medical syringes."
- In order to carry out the intent of this Agreement, the parties agree to continue to cooperate in taking any reasonable action to avoid confusion and to correct any instances or likelihood of confusion which come to their attention.

ii. The Agreement is Accorded Great Weight in Determining Likelihood of Confusion

The court in *In re E. I. du Pont de Nemours & Co.* stated “[w]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won’t. A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.” (*In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1363, 177 USPQ 563, 568 (C.C.P.A. 1973)).

Therefore, in giving the Agreement great weight, as the Examining attorney should do, the Examining Attorney should withdraw its refusal under Section 2(d) of the Trademark Act based on the cited mark and approve Applicant’s mark for publication.

II. CONCLUSION

Applicant feels it has adequately addressed Examining Attorney’s concerns and therefore respectfully requests that the refusal based on Section 2(d) of the Trademark Act be withdrawn and its application proceed to publication.

Respectfully submitted

September 3, 2014

/lmh/
FISH & TSANG LLP
Lindy M. Herman, Esq. (CA Bar: 247017)
Attorney for Applicant

Serial Number: 85/912234
Mark: CYREX LABORATORIES

EXHIBIT A

CONSENT AND CO-EXISTENCE AGREEMENT

This worldwide Consent and Co-Existence Agreement ("Agreement") is entered into as of ^{August 7} July 2014 ("Effective Date"), between Excelsior Medical Corporation, with offices located in Neptune, NJ ("Excelsior") and Cyrex Laboratories, LLC with offices located in Phoenix, AZ ("CL"). In consideration of the mutual promises and terms set forth herein, and for other good and valuable consideration, the sufficiency of which is hereby acknowledged, the parties agree as follows:

1. Excelsior is a privately held medical device company that offers a number of products that fulfill the needs of the healthcare practitioner, including SwabCap®, saline and heparin flush syringes, dispensing pumps, and syringe pumps. Excelsior currently has the mark SYREX federally registered for injection syringes, medical syringes (registration number 3109357).
2. CL is an advanced clinical laboratory focusing on mucosal, cellular, and humoral immunology and specializing in antibody arrays for complex thyroid, gluten, and other food-associated autoimmunities and related neurodysregulation. CL currently is attempting to federally register the following marks: (a) CYREX and CYREX LABORATORIES for Laboratory services, namely providing clinical immunology laboratory services in functional immunology and autoimmunity (serial numbers 85909148 and 85909216 and design serial number 85912249); and (b) CYREX LABORATORIES for specimen collection kits comprising tubes for collecting samples of oral fluid and serum (serial number 85909206 and design serial number 85912234).
3. Excelsior and CL have had the opportunity to investigate and believe that neither Excelsior nor CL's marks should prevent the registration of the other's marks, based on many factors including without limitation the dissimilarity of: (a) the marks in appearance and spelling; (b) the nature of the goods described in the respective registration and applications; (c) the established, likely-to-continue trade channels; (d) the conditions under which buyers purchase the goods in question; (e) the sophisticated nature of the buyers of the goods in question; and (f) the number of years under which the marks have been used concurrently without customer confusion. The parties further agree that based on their past and current uses of their respective marks, including the services provided under each and the parties' respective consumers, there is no likelihood of confusion as to the source of the services provided by the parties under their respective marks.
4. Excelsior hereby consents to the worldwide use and registration of the following marks by CL: (a) CYREX and CYREX LABORATORIES for Laboratory services, namely providing clinical immunology laboratory services in functional immunology and autoimmunity (serial numbers 85909148 and 85909216 and design serial number 85912249); and (b) CYREX LABORATORIES for specimen collection kits comprising tubes for collecting samples of oral fluid and serum (serial number 85909206 and design serial number 85912234). CL has agreed to request that the USPTO trademark examiner add the following words to the description of goods and services in the aforementioned applications: "excluding injection and medical syringes." The parties further agree that all future worldwide applications and registrations will include the language "excluding injection and medical syringes."
5. CL hereby consents to the worldwide use and registration of the mark SYREX (registration number 3109357) for injection syringes, medical syringes by Excelsior.
6. In order to carry out the intent of this Agreement, the parties agree to continue to cooperate in taking any reasonable action to avoid confusion and to correct any instances or likelihood of confusion which come to their attention.
7. The parties agree to cooperate to the extent permitted by the USPTO and any foreign trademark office to ensure the registration and/or continued registration of their respective marks. Such cooperation shall include both current and future trademark applications and registrations. Such cooperation shall include execution of any further consent agreements, provided the terms are materially the same as the terms herein, as requested and/or required by any trademark office. The reasonable expenses associated with future cooperation or further consent agreements will be borne by the party seeking the consent.
8. Absent any breach of this Agreement, the parties agree that they will not initiate any trademark infringement action against the other party based on past, current, or future use of their respective marks mentioned in this Agreement in connection with their respective goods/services listed in Section 2 above and further agree that they will not initiate any cancellation or opposition proceedings against any such registration or application of the other party for such marks in connection with their respective goods/services listed in Section 2 above, will not dispute ownership of such marks of the other party in connection with their respective goods/services listed in Section 2 above, or otherwise challenge use and/or registration of such marks in connection with their respective goods/services listed in Section 2 above.
9. Neither party may license or assign their respective rights in the Agreement in any manner that expands or modifies this Agreement. Further, this Agreement constitutes the entire understanding and agreement between the parties hereto. This Agreement supersedes any and all prior discussions, negotiations and agreements, if any, between the parties with respect to the subject matter of this Agreement. This Agreement may be amended or terminated only if it set forth in writing and executed by both parties.

10. This Agreement may be executed in counterparts, including facsimile counterparts, with the same effect as if all parties have signed the same document, and each such executed counterpart shall be deemed to be an original instrument. All executed counterparts together shall constitute one and the same instrument.

IN WITNESS WHEREOF, the parties have caused this Agreement to be executed and made effective as of the date indicated above.

Excelsior Medical Corporation Date: 08/07/14
Signature: [Signature]
Printed Name: STEVEN THORNTON
Title: PRESIDENT AND CEO

Cyrex Laboratories, LLC Date: 08/07/14
Signature: [Signature]
Printed Name: JEAN BELLIN
Title: PRESIDENT