

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86145098
LAW OFFICE ASSIGNED	LAW OFFICE 119
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/86145098/large
LITERAL ELEMENT	ROYAL CANIN GENETIC HEALTH ANALYSIS
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.
GOODS AND/OR SERVICES SECTION (001)(current)	
INTERNATIONAL CLASS	001
DESCRIPTION	
Reagents for scientific and medical research use; Reagent kits comprising reagents, namely DNA, RNA, or vectors, for use in veterinary and biotechnology fields; Biotechnologically-formed genes for use in determining and analyzing the genome of animals, mammalian cells, plant cells; Genetic identity tests comprised of reagents	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (001)(proposed)	
INTERNATIONAL CLASS	001
TRACKED TEXT DESCRIPTION	
Reagents for scientific and medical research use; Reagents for scientific and research use; Reagent kits comprising reagents, namely DNA, RNA, or vectors, for use in veterinary and biotechnology fields; reagent kits comprising DNA and RNA sequences for use in veterinary and biotechnology fields; Biotechnologically-formed genes for use in determining and analyzing the genome of animals, mammalian cells, plant cells; biotechnologically-formed genes for use in editing and analyzing the genomes of animals and mammalian cells; genetic identity tests comprised of reagents	
FINAL DESCRIPTION	
Reagents for scientific and research use; reagent kits comprising DNA and RNA sequences for use in veterinary and biotechnology fields; biotechnologically-formed genes for use in editing and analyzing the genomes of animals and mammalian cells; genetic identity tests comprised of reagents	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (010)(current)	
INTERNATIONAL CLASS	010
DESCRIPTION	
Veterinary and medical diagnostic testing apparatus and instruments for the testing and analysis of DNA and genetics; In-vitro diagnostic blood testing apparatus for medical and veterinary use for blood testing and analysis; Veterinary and medical diagnostic testing kit comprised of tubes and vials for the collection, testing and analysis of DNA and genetics	

FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (010)(proposed)	
INTERNATIONAL CLASS	010
TRACKED TEXT DESCRIPTION	
Veterinary and medical diagnostic testing apparatus and instruments for the testing and analysis of DNA and genetics; Veterinary diagnostic testing apparatus and instruments for the testing and analysis of DNA and genetics; In-vitro diagnostic blood testing apparatus for medical and veterinary use for blood testing and analysis; in-vitro diagnostic blood testing apparatus for veterinary use for blood testing and analysis; Veterinary and medical diagnostic testing kit comprised of tubes and vials for the collection, testing and analysis of DNA and genetics; veterinary diagnostic testing kit comprised of tubes and vials, sold empty, for the collection, testing and analysis of DNA and genetics	
FINAL DESCRIPTION	
Veterinary diagnostic testing apparatus and instruments for the testing and analysis of DNA and genetics; in-vitro diagnostic blood testing apparatus for veterinary use for blood testing and analysis; veterinary diagnostic testing kit comprised of tubes and vials, sold empty, for the collection, testing and analysis of DNA and genetics	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (042)(no change)	
GOODS AND/OR SERVICES SECTION (044)(current)	
INTERNATIONAL CLASS	044
DESCRIPTION	
Veterinary medical services; DNA analysis services, namely, genetic and veterinary testing for veterinary medical purposes; Genetic testing for veterinary medical purposes	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (044)(proposed)	
INTERNATIONAL CLASS	044
TRACKED TEXT DESCRIPTION	
Veterinary medical services; Veterinary services; DNA analysis services, namely, genetic and veterinary testing for veterinary medical purposes; DNA analysis services, namely, genetic and veterinary testing for veterinary purposes; Genetic testing for veterinary medical purposes; genetic testing for veterinary purposes	
FINAL DESCRIPTION	
Veterinary services; DNA analysis services, namely, genetic and veterinary testing for veterinary purposes; genetic testing for veterinary purposes	
FILING BASIS	Section 1(b)
ADDITIONAL STATEMENTS SECTION	
DISCLAIMER	No claim is made to the exclusive right to use CANIN GENETIC HEALTH ANALYSIS apart from the mark as shown.
MISCELLANEOUS STATEMENT	
MISCELLANEOUS FILE NAME(S)	
ORIGINAL PDF FILE	mis-4539068-20160831121659930865 . ROYAL CANIN_GHA Parent App 86145098.pdf
CONVERTED PDF FILE(S) (3 pages)	\\TICRS\EXPORT16\IMAGEOUT16\861\450\86145098\xml16\RFR0002.JPG
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ORIGINAL PDF FILE	mis-4539068-20160831121659930865 . Exhibit E 1 10 42 44.pdf
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SIGNATURE SECTION	
RESPONSE SIGNATURE	/anthony j. palumbo/
SIGNATORY'S NAME	Anthony J. Palumbo
SIGNATORY'S POSITION	Attorney of record, Washington DC bar member
SIGNATORY'S PHONE NUMBER	9739971595
DATE SIGNED	08/31/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Aug 31 12:34:13 EDT 2016
TEAS STAMP	USPTO/RFR-X.XX.XX.XX-2016 0831123413230058-86145098 -5501336ac17739d4a669d82a 38b63871806cda5237c77a6e4 31b4fe5d45db227-N/A-N/A-2 0160831121659930865

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PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **86145098** ROYAL CANIN GENETIC HEALTH ANALYSIS(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86145098/large>) has been amended as follows:

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Current: Class 001 for Reagents for scientific and medical research use; Reagent kits comprising reagents, namely DNA, RNA, or vectors, for use in veterinary and biotechnology fields; Biotechnologically-formed genes for use in determining and analyzing the genome of animals, mammalian cells, plant cells; Genetic identity tests comprised of reagents

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. ***For a certification mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed:

Tracked Text Description: ~~Reagents for scientific and medical research use;~~ [Reagents for scientific and research use;](#) ~~Reagent kits comprising reagents, namely DNA, RNA, or vectors, for use in veterinary and biotechnology fields;~~ [reagent kits comprising DNA and RNA sequences for use in veterinary and biotechnology fields;](#) ~~Biotechnologically-formed genes for use in determining and analyzing the genome of animals,~~

~~mammalian cells, plant cells; biotechnologically-formed genes for use in editing and analyzing the genomes of animals and mammalian cells;~~
genetic identity tests comprised of reagents

Class 001 for Reagents for scientific and research use; reagent kits comprising DNA and RNA sequences for use in veterinary and biotechnology fields; biotechnologically-formed genes for use in editing and analyzing the genomes of animals and mammalian cells; genetic identity tests comprised of reagents

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

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

Current: Class 010 for Veterinary and medical diagnostic testing apparatus and instruments for the testing and analysis of DNA and genetics; In-vitro diagnostic blood testing apparatus for medical and veterinary use for blood testing and analysis; Veterinary and medical diagnostic testing kit comprised of tubes and vials for the collection, testing and analysis of DNA and genetics

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed:

Tracked Text Description: ~~Veterinary and medical diagnostic testing apparatus and instruments for the testing and analysis of DNA and genetics; Veterinary diagnostic testing apparatus and instruments for the testing and analysis of DNA and genetics; In-vitro diagnostic blood testing apparatus for medical and veterinary use for blood testing and analysis; Veterinary and medical diagnostic testing kit comprised of tubes and vials for the collection, testing and analysis of DNA and genetics;~~ [in-vitro diagnostic blood testing apparatus for veterinary use for blood testing and analysis;](#) [veterinary diagnostic testing kit comprised of tubes and vials, sold empty, for the collection, testing and analysis of DNA and genetics](#)

Class 010 for Veterinary diagnostic testing apparatus and instruments for the testing and analysis of DNA and genetics; in-vitro diagnostic blood testing apparatus for veterinary use for blood testing and analysis; veterinary diagnostic testing kit comprised of tubes and vials, sold empty, for the collection, testing and analysis of DNA and genetics

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

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

Current: Class 044 for Veterinary medical services; DNA analysis services, namely, genetic and veterinary testing for veterinary medical purposes; Genetic testing for veterinary medical purposes

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the

applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed:

Tracked Text Description: ~~Veterinary medical services; Veterinary services; DNA analysis services, namely, genetic and veterinary testing for veterinary medical purposes;~~ [Veterinary services; DNA analysis services, namely, genetic and veterinary testing for veterinary purposes;](#) ~~Genetic testing for veterinary medical purposes;~~ [genetic testing for veterinary purposes](#)

Class 044 for Veterinary services; DNA analysis services, namely, genetic and veterinary testing for veterinary purposes; genetic testing for veterinary purposes

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

ADDITIONAL STATEMENTS

Disclaimer

No claim is made to the exclusive right to use CANIN GENETIC HEALTH ANALYSIS apart from the mark as shown.

Miscellaneous Statement

Original PDF file:

[mis-4539068-20160831121659930865 . ROYAL CANIN GHA Parent App 86145098.pdf](#)

Converted PDF file(s) (3 pages)

[Miscellaneous File1](#)

[Miscellaneous File2](#)

[Miscellaneous File3](#)

Original PDF file:

[mis-4539068-20160831121659930865 . Exhibit E_1_10_42_44.pdf](#)

Converted PDF file(s) (3 pages)

[Miscellaneous File1](#)

[Miscellaneous File2](#)

[Miscellaneous File3](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /anthony j. palumbo/ Date: 08/31/2016

Signatory's Name: Anthony J. Palumbo

Signatory's Position: Attorney of record, Washington DC bar member

Signatory's Phone Number: 9739971595

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: 86145098

Internet Transmission Date: Wed Aug 31 12:34:13 EDT 2016

TEAS Stamp: USPTO/RFR-X.XX.XX.XX-2016083112341323005

8-86145098-5501336ac17739d4a669d82a38b63

871806cda5237c77a6e431b4fe5d45db227-N/A-

N/A-20160831121659930865

Request for Reconsideration

This responds to the Office Action issued on March 2, 2016. The Office has made final its refusal of Application Serial No. 86/145,098 on the following grounds:

- Applicant improperly identified the goods and services;
- Applicant has not provided sufficient evidentiary support, nor is the ownership of prior registrations sufficient to support Applicant’s Section 2(f) Claim for the term “CANIN”.

Applicant herein once again amends its identification of goods and services and disclaim “CANIN” only with respect to the specific goods and services set forth in this Application.

I. Amendment of Identification of Goods and Services

The Examining Attorney has once again refused the Application for the mark ROYAL CANIN GENETIC HEALTH ANALYSIS, despite Applicant’s efforts in addressing the identification issues raised in the previous three Office Actions.

Applicant has methodically revised and amended the identification of goods and services described in Application Ser. No. 86/145,098. The Applicant also notes that it has edited its multiple class Application often without specifics or guidance provided by the Examining Attorney. Applicant has prepared charts comparing its revisions to the USPTO ID Manual which demonstrates how its edits are unequivocally definite, concise and acceptable. See *U.S. Acceptable Identification of Goods and Services Manual (2016)*¹.

¹ See Exhibit D of Applicant’s Office Action Response filed on January 27, 2016 (Ser. No. 86/145,098).

Despite adhering to the requirements set forth by TMEP §1402.01 (an applicant must meet “the standards (not necessarily the language) set forth in the USPTO ID Manual”), the Examining Attorney once again claims in the Final Office Action that the Applicant has improperly described its goods and services. Applicant also references TMEP §1402.01 (a), in that “deference should be given to the language set forth by the applicant in the original application”.

While Applicant maintains that its prior edits submitted on January 27, 2016 were no doubt proper and acceptable, it has once again made further edits to the proposed identifications of goods and services by clearly adopting accurate wording that matches the *U.S. Acceptable Identification of Goods and Services Manual (2016)* (Exhibit E).

II. Disclaimer of the Term CANIN with Respect to the Goods and Services Listed in the Current Application

Through the three Office Action Responses already filed, Applicant has provided the Trademark Office with sufficient and extensive evidence supporting the claim of partial acquired distinctiveness for the term CANIN, under §2(f) of the Trademark Act; 37 CFR §2.41 (b); and has provided the types of evidence deemed acceptable to establish acquired distinctiveness pursuant to TMEP §1212.04, §1212.05 and §1212.06.

Nonetheless Applicant hereby enters a disclaimer for “CANIN GENETIC HEALTH ANALYSIS” only for the specific goods and services herein identified in Classes 1, 10, 42 and 44 as imposed by Examining Attorney.

Despite entering the disclaimer statement, Applicant firmly believes that both customers and competitors recognize the term CANIN as having acquired distinctiveness for the goods and services covered by this Application.

III. Conclusion

Applicant has addressed all of the matters raised in the Final Office Action and respectfully requests that the subject application be approved for publication. If the Examining Attorney has remaining questions, he is invited to call the undersigned attorney of record.

Exhibit E

Serial No. 86145098

8/31/2016

Identification of goods/services amended and filed on January 27, 2016	Identification of goods/services herein amended on August 31, 2016	Equivalent descriptions taken from the TM ID Manual are presented below for comparison purposes – these support the acceptance of the Applicant’s proposed identification of goods and services
<p>Class 1:</p> <p>Reagents for scientific and medical research use;</p> <p>Reagent kits comprising reagents, namely DNA, RNA, or vectors, for use in veterinary and biotechnology fields;</p> <p>Biotechnologically-formed genes for use in determining and analyzing the genome of animals, mammalian cells, plant cells;</p> <p>Genetic identity tests comprised of reagents.</p>	<p>Reagents for scientific and medical research use;</p> <p>Reagent kits comprising reagents, namely DNA and RNA sequences, or vectors, for use in veterinary and biotechnology fields;</p> <p>Biotechnologically-formed genes for use in editing determining and analyzing the genomes of animals and mammalian cells, plant cells;</p> <p>Genetic identity tests comprised of reagents.</p>	<p>“Reagents for scientific and research use” is an accepted description as per the Trademark ID Manual.</p> <p>“Reagent kits comprising generic DNA circle, DNA primers, polymerase and buffers for use in biotechnology fields” is an accepted description as per the Trademark ID Manual.</p> <p>“Biotechnologically-formed genes, microbes and enzymes for use in the production of agricultural seeds to enhance plants’ growth therefrom” is an accepted description as per the Trademark ID Manual.</p> <p>“Genetic identity tests comprised of reagents” is an accepted description as per the Trademark ID Manual.</p>
<p>Class 10:</p> <p>Veterinary and medical diagnostic testing apparatus and instruments for the testing and analysis of DNA and genetics;</p> <p>In-vitro diagnostic testing apparatus for medical and veterinary use for the testing and analysis of DNA and genetics;</p> <p>Veterinary and medical diagnostic testing kits consisting of tubes and vials, sold empty, for the testing and analysis of DNA and genetics.</p>	<p>Veterinary and medical diagnostic testing apparatus and instruments for the testing and analysis of DNA and genetics;</p> <p>In-vitro diagnostic blood testing apparatus for medical and veterinary use for blood testing and analysis;</p> <p>Veterinary and medical diagnostic testing kit comprised of tubes and vials, sold empty, for the collection, testing and analysis of DNA and genetics.</p>	<p>“Medical apparatus and instrument for diagnostic use, namely, apparatus for medical diagnostic testing in the fields of cancer or other tissue-based diagnostic testing, cytology and cell-based testing” is an accepted description as per the Trademark ID Manual.</p> <p>“Blood testing apparatus” is an accepted description as per the Trademark ID Manual</p> <p>“Blood collection kit comprised of blood collection bag, holder for medical sample tubes and vials, and medical sample tubes and vials” is an accepted description as per the Trademark ID Manual</p>

Identification of goods/services amended and filed on January 27, 2016	Identification of goods/services herein amended on August 31, 2016	Equivalent descriptions taken from the TM ID Manual are presented below for comparison purposes – these support the acceptance of the Applicant’s proposed identification of goods and services
<p>Class 42:</p> <p>DNA analysis services, namely genetic testing for scientific and veterinary research purposes;</p>	<p>DNA analysis services, namely genetic testing for scientific and veterinary research purposes;</p>	<p>“DNA analysis services, namely genetic testing for scientific and veterinary research purposes” is an accepted description as per the Trademark ID Manual</p>
<p>Class 44:</p> <p>Veterinary medical services;</p> <p>DNA analysis services, namely, genetic and veterinary testing for veterinary medical purposes;</p> <p>Genetic testing for veterinary medical purposes.</p>	<p>Veterinary medical services;</p> <p>DNA analysis services, namely, genetic and veterinary testing for veterinary medical purposes;</p> <p>Genetic testing for veterinary medical purposes.</p>	<p>“Veterinary services” is an accepted description as per the Trademark ID Manual</p> <p>“DNA analysis services for scientific research purposes” is an accepted description as per the Trademark ID Manual.</p> <p>“Genetic testing for medical purposes” is an accepted description as per the Trademark ID Manual.</p>