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Subject: U.S. TRADEMARK APPLICATION NO. 86277037 - APTIOM - 508.11(US16) - Request for  
Reconsideration Denied - Return to TTAB

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Files: 86277037.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 86277037

**MARK:** APTIOM



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

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**APPLICANT:** Bial - Portela & Ca., S.A.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

508.11(US16)

**CORRESPONDENT E-MAIL ADDRESS:**

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**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 12/1/2015

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following refusal made final in the Office action dated April 20, 2015, is maintained and continue to be final: *Trademark Act Section 2(d) refusal*. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues.

Specifically, registration of the applied-for mark, APTIOM for "printed materials, namely, periodicals, booklets, brochures, and pamphlets in the fields of diseases and conditions of the central and peripheral nervous system, namely epilepsy," has been refused because of a likelihood of confusion with the mark in U.S. Registration No. 3727530, APTIOM for "pharmaceutical preparations for the treatment of central nervous system diseases and disorders." Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.*

The proposed mark is identical to the registrant's mark. In addition, the goods of the parties are highly related in that the applicant's printed materials feature information about the same disease as that treated using the registrant's pharmaceuticals. Consumers encountering the proposed mark used simultaneously with the registrant's mark are likely to mistakenly conclude that the goods originate from the same source.

The applicant argues confusion is unlikely because the applicant has a contractual agreement with the registrant's wholly owned subsidiary. The applicant further argues that the registrant's subsidiary's use of the word APTIOM is through license granted to the subsidiary by the applicant and the applicant controls the use of the mark by the registrant's subsidiary. The applicant further argues that the registrant will not be harmed by the applicant's registration of the proposed mark because the potential for a negative impact was dealt with in the contract between the parties and that the registrant has implicitly agreed that the applicant is entitled to registration of the trademark.

However, nowhere in the documents submitted by the applicant does the registrant consent to the applicant's registration of the proposed mark. In Exhibit K, Sunovion claims in its news release that it has acquired the rights from the applicant to develop and commercialize Aptiom in the United States. Nothing is said about the applicant retaining the right to register APTIOM as a trademark with the USPTO or, conversely, the registrant agreeing to the applicant's right to register the proposed mark for highly related goods.

Furthermore, a trademark or service mark registration on the Principal Register is prima facie evidence of the validity of the registration and the registrant's exclusive right to use the mark in commerce in connection with the specified goods and/or services. *See* 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv).

The applicant maintains that consumers are unlikely to be harmed by the registration of the proposed mark because of statements made on packaging for the registrant's pharmaceutical products. However, there is no evidence that consumers would be aware of agreements between the parties or press or news releases. Similarly, nothing in the identifications of goods for the application or registration controls how the goods are presented or what statements or averments are made on the packaging for the registrant's pharmaceutical products. With respect to applicant's and registrant's goods, the question of likelihood of confusion is determined based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Accordingly, for the foregoing reasons the final Trademark Act Section 2(d) refusal is continued and the request for reconsideration is denied.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

/Martha L. Fromm/

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