

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86453492
LAW OFFICE ASSIGNED	LAW OFFICE 111
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/86453492/large
LITERAL ELEMENT	ESSURESIM
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)	
<p>A section 2(d) refusal based on prior registrations for the mark ESSURE owned by Bayer Essure Inc. has been maintained and made final.</p> <p>In response, it is respectfully reported to the USPTO that the undersigned has been advised that ownership of both the instant application AND the two cited issued registrations is in the process of being transferred to a single entity, Bayer Healthcare LLC. The formalities relating to this transfer of ownership should be completed in the near future, thereby rendering moot any citation of the prior registrations against the instant application, as all these documents will be in common ownership (see option 3 in the final Office Action).</p> <p>In view of change of ownership, applicant will not further address the substance of the 2(d) issue at this time; and it is believed that no further information regarding the nature of the applicant's goods should be necessary, in view of the pending transfer of ownership of all the relevant marks to the same party.</p> <p>In order to have the necessary time to complete the formalities related to the transfer above, applicant is filing an appeal brief in this application, in order to preserve its position while the formalities are addressed and completed.</p>	
ADDITIONAL STATEMENTS SECTION	
MISCELLANEOUS STATEMENT	Applicant has been asked to provide additional information as to the nature of the identified goods/services; however, in view of the change of ownership of all the relevant marks, as discussed above, it is believed that no such submission is necessary.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/marilyn matthes brogan/
SIGNATORY'S NAME	Marilyn Matthes Brogan
SIGNATORY'S POSITION	attorney
SIGNATORY'S PHONE NUMBER	212 588 0800
DATE SIGNED	02/11/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	

SUBMIT DATE	Thu Feb 11 12:05:23 EST 2016
TEAS STAMP	USPTO/RFR-XX.XXX.XXX.X-20 160211120523582512-864534 92-550e6b7c62472b7709595f 2d0d1137512b27e10cb3da739 4c4fa59370a35632ef52-N/A- N/A-20160211115248218234

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.

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. **86453492** ESSURESIM(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86453492/large>) has been amended as follows:

ARGUMENT(S)

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

A section 2(d) refusal based on prior registrations for the mark ESSURE owned by Bayer Essure Inc. has been maintained and made final.

In response, it is respectfully reported to the USPTO that the undersigned has been advised that ownership of both the instant application AND the two cited issued registrations is in the process of being transferred to a single entity, Bayer Healthcare LLC. The formalities relating to this transfer of ownership should be completed in the near future, thereby rendering moot any citation of the prior registrations against the instant application, as all these documents will be in common ownership (see option 3 in the final Office Action).

In view of change of ownership, applicant will not further address the substance of the 2(d) issue at this time; and it is believed that no further information regarding the nature of the applicant's goods should be necessary, in view of the pending transfer of ownership of all the relevant marks to the same party.

In order to have the necessary time to complete the formalities related to the transfer above, applicant is filing an appeal brief in this application, in order to preserve its position while the formalities are addressed and completed.

ADDITIONAL STATEMENTS

Miscellaneous Statement

Applicant has been asked to provide additional information as to the nature of the identified goods/services; however, in view of the change of ownership of all the relevant marks, as discussed above, it is believed that no such submission is necessary.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /marilyn matthes brogan/ Date: 02/11/2016

Signatory's Name: Marilyn Matthes Brogan

Signatory's Position: attorney

Signatory's Phone Number: 212 588 0800

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: 86453492

Internet Transmission Date: Thu Feb 11 12:05:23 EST 2016

TEAS Stamp: USPTO/RFR-XX.XXX.XXX.X-20160211120523582

512-86453492-550e6b7c62472b7709595f2d0d1

137512b27e10cb3da7394c4fa59370a35632ef52

-N/A-N/A-20160211115248218234