

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86691218
LAW OFFICE ASSIGNED	LAW OFFICE 113
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/86691218/large
LITERAL ELEMENT	FELIPEPTA
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>Applicant has amended the identification of goods to clarify that the diagnostic reagents are medical in nature, as requested by the Examining Attorney.</p> <p>However, Applicant respectfully disagrees with the Examining Attorney's position that the "medical diagnostic reagents" fall outside of the scope of the foreign registration, which covers "reagent kits." The "reagents" are merely elements of the "reagent kits" (in fact, the most important element). Many "reagent kits" are simply kits consisting of multiple samples of reagents (for examples, see http://www.genomics.agilent.com/en/SureSelect-DNA-Library-Preps/SureSelectXT-Reagent-Kits/?cid=AG-PT-177&tabId=AG-PR-1302 and http://www.izon.com/products/reagent-kits/).</p> <p>Applicant's "reagents" thus clearly fall within the scope of the original "reagent kits" and do not impermissibly broaden the identification of goods in a manner that would encompass goods not included within the scope of the foreign registration.</p> <p>Alternatively, Applicant also believes that the "medical diagnostic reagents" also fall within the scope of "pharmaceutical and veterinary preparations and substances." Applicant does not necessarily agree with the Examining Attorney's argument that a pharmaceutical "substance" refers only to a medicine or drug used to diagnose, cure, or treat a disease, since "substance" is a broad term that incorporates a wide range of products. Regardless, however, Applicant's "medical diagnostic reagents" are used to diagnose disease, as indicated by the follow-up language "for...diagnosing allergies, autoimmune disease, transplant rejection, and immunodeficiency disorders." Therefore, even applying the Examining Attorney's narrow definition of a "pharmaceutical substance," Applicant's medical diagnostic reagents clearly fall within this definition.</p> <p>Furthermore, Applicant also notes that it was allowed to register its prior mark CIRCASSIA (U.S. Reg. No. 5,009,971) in connection with "diagnostic and testing reagents" in Class 5 where the foreign registration (International Reg. No. 1214755) covered only "pharmaceutical and veterinary preparations; vaccines." While the decision of the Examiner in that case is obviously not binding in the current application, Applicant submits that the decision to allow "diagnostic and testing reagents" in that case indicates that these types of products are generally understood to fall within the broad range of products considered to be "pharmaceutical and veterinary preparations and substances"</p> <p>Therefore, Applicant respectfully requests that the Examining Attorney allow these products to remain in the identification of goods.</p>	
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	005
DESCRIPTION	
Pharmaceutical and veterinary preparations and substances for the testing, diagnosis, prevention and treatment of drug dependency, substance addiction, poisoning, overdose, envenomation, infectious diseases, blood disorders, pain, inflammation, sepsis, alopecia, polyposis, sinusitis,	

non-allergic rhinitis, obesity, cognitive disorders and viral, metabolic, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, gynaecological, oncological, hepatological, ocular, haemostasis, obstetric, ophthalmic, respiratory, neurological, gastrointestinal, hormonal, dermatological, renal system, urinary tract, otolaryngology, psychiatric, fertility and immune system related diseases and disorders; pharmaceutical and veterinary preparations and substances for the testing, diagnosis, prevention and treatment of allergies, autoimmune disease, transplant rejection and immunodeficiency disorders; diagnostic reagents for testing and diagnosing allergies, autoimmune disease, transplant rejection, and immunodeficiency disorders; vaccines

FILING BASIS	Section 44(e)
FOREIGN REGISTRATION NUMBER	00003090455
FOREIGN REGISTRATION COUNTRY	United Kingdom
FOREIGN REGISTRATION DATE	01/21/2015
FOREIGN EXPIRATION DATE	01/21/2025

GOODS AND/OR SERVICES SECTION (proposed)

INTERNATIONAL CLASS	005
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TRACKED TEXT DESCRIPTION

Pharmaceutical and veterinary preparations and substances for the testing, diagnosis, prevention and treatment of drug dependency, substance addiction, poisoning, overdose, envenomation, infectious diseases, blood disorders, pain, inflammation, sepsis, alopecia, polyposis, sinusitis, non-allergic rhinitis, obesity, cognitive disorders and viral, metabolic, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, gynaecological, oncological, hepatological, ocular, haemostasis, obstetric, ophthalmic, respiratory, neurological, gastrointestinal, hormonal, dermatological, renal system, urinary tract, otolaryngology, psychiatric, fertility and immune system related diseases and disorders; pharmaceutical and veterinary preparations and substances for the testing, diagnosis, prevention and treatment of allergies, autoimmune disease, transplant rejection and immunodeficiency disorders; ~~diagnostic reagents for testing and diagnosing allergies, autoimmune disease, transplant rejection, and immunodeficiency disorders~~; medical diagnostic reagents for testing and diagnosing allergies, autoimmune disease, transplant rejection, and immunodeficiency disorders; vaccines

FINAL DESCRIPTION

Pharmaceutical and veterinary preparations and substances for the testing, diagnosis, prevention and treatment of drug dependency, substance addiction, poisoning, overdose, envenomation, infectious diseases, blood disorders, pain, inflammation, sepsis, alopecia, polyposis, sinusitis, non-allergic rhinitis, obesity, cognitive disorders and viral, metabolic, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, gynaecological, oncological, hepatological, ocular, haemostasis, obstetric, ophthalmic, respiratory, neurological, gastrointestinal, hormonal, dermatological, renal system, urinary tract, otolaryngology, psychiatric, fertility and immune system related diseases and disorders; pharmaceutical and veterinary preparations and substances for the testing, diagnosis, prevention and treatment of allergies, autoimmune disease, transplant rejection and immunodeficiency disorders; medical diagnostic reagents for testing and diagnosing allergies, autoimmune disease, transplant rejection, and immunodeficiency disorders; vaccines

FILING BASIS	Section 44(e)
FOREIGN REGISTRATION NUMBER	00003090455
FOREIGN REGISTRATION COUNTRY	United Kingdom
FOREIGN REGISTRATION DATE	01/21/2015
FOREIGN EXPIRATION DATE	01/21/2025

SIGNATURE SECTION

RESPONSE SIGNATURE	/Bryce J. Maynard/
SIGNATORY'S NAME	Bryce J. Maynard
SIGNATORY'S POSITION	Attorney for Applicant, Virginia Bar Member
DATE SIGNED	10/18/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION	
SUBMIT DATE	Tue Oct 18 12:33:38 EDT 2016
TEAS STAMP	USPTO/RFR-XXX.XX.XXX.XX-2 0161018123338752582-86691 218-570acf86e3157b34d847f 7ab0b4b933516bf2b7a0f4c72 31ef5bb8612ac25cb727-N/A- N/A-20161018115009282561

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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. **86691218** FELIPEPTA(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86691218/large>) has been amended as follows:

ARGUMENT(S)

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

Applicant has amended the identification of goods to clarify that the diagnostic reagents are medical in nature, as requested by the Examining Attorney.

However, Applicant respectfully disagrees with the Examining Attorney's position that the "medical diagnostic reagents" fall outside of the scope of the foreign registration, which covers "reagent kits." The "reagents" are merely elements of the "reagent kits" (in fact, the most important element). Many "reagent kits" are simply kits consisting of multiple samples of reagents (for examples, see <http://www.genomics.agilent.com/en/SureSelect-DNA-Library-Preps/SureSelectXT-Reagent-Kits/?cid=AG-PT-177&tabId=AG-PR-1302> and <http://www.izon.com/products/reagent-kits/>).

Applicant's "reagents" thus clearly fall within the scope of the original "reagent kits" and do not impermissibly broaden the identification of goods in a manner that would encompass goods not included within the scope of the foreign registration.

Alternatively, Applicant also believes that the "medical diagnostic reagents" also fall within the scope of "pharmaceutical and veterinary preparations and substances." Applicant does not necessarily agree with the Examining Attorney's argument that a pharmaceutical "substance" refers only to a medicine or drug used to diagnose, cure, or treat a disease, since "substance" is a broad term that incorporates a wide range of products. Regardless, however, Applicant's "medical diagnostic reagents" **are** used to diagnose disease, as indicated by the follow-up language "for...diagnosing allergies, autoimmune disease, transplant rejection, and immunodeficiency disorders." Therefore, even applying the Examining Attorney's narrow definition of a "pharmaceutical substance," Applicant's medical diagnostic reagents clearly fall within this definition.

Furthermore, Applicant also notes that it was allowed to register its prior mark CIRCASSIA (U.S. Reg. No. 5,009,971) in connection with "diagnostic and testing reagents" in Class 5 where the foreign registration (International Reg. No. 1214755) covered only "pharmaceutical and veterinary preparations; vaccines." While the decision of the Examiner in that case is obviously not binding in the current application, Applicant submits that the decision to allow "diagnostic and testing reagents" in that case indicates that these types of products are generally understood to fall within the broad range of products considered to be "pharmaceutical and veterinary preparations and substances"

Therefore, Applicant respectfully requests that the Examining Attorney allow these products to remain in the identification of goods.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Current: Class 005 for Pharmaceutical and veterinary preparations and substances for the testing, diagnosis, prevention and treatment of drug

dependency, substance addiction, poisoning, overdose, envenomation, infectious diseases, blood disorders, pain, inflammation, sepsis, alopecia, polyposis, sinusitis, non-allergic rhinitis, obesity, cognitive disorders and viral, metabolic, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, gynaecological, oncological, hepatological, ocular, haemostasis, obstetric, ophthalmic, respiratory, neurological, gastrointestinal, hormonal, dermatological, renal system, urinary tract, otolaryngology, psychiatric, fertility and immune system related diseases and disorders; pharmaceutical and veterinary preparations and substances for the testing, diagnosis, prevention and treatment of allergies, autoimmune disease, transplant rejection and immunodeficiency disorders; diagnostic reagents for testing and diagnosing allergies, autoimmune disease, transplant rejection, and immunodeficiency disorders; vaccines

Original Filing Basis:

Filing Basis: Section 44(e), Based on Foreign Registration: For all applications: The applicant attaches a copy of [United Kingdom registration number 00003090455 registered 01/21/2015 with a renewal date of _____ and an expiration date of 01/21/2025], and translation thereof, if appropriate. **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. **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 on or 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 or services that meet the certification standards of the applicant.

Proposed:

Tracked Text Description: Pharmaceutical and veterinary preparations and substances for the testing, diagnosis, prevention and treatment of drug dependency, substance addiction, poisoning, overdose, envenomation, infectious diseases, blood disorders, pain, inflammation, sepsis, alopecia, polyposis, sinusitis, non-allergic rhinitis, obesity, cognitive disorders and viral, metabolic, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, gynaecological, oncological, hepatological, ocular, haemostasis, obstetric, ophthalmic, respiratory, neurological, gastrointestinal, hormonal, dermatological, renal system, urinary tract, otolaryngology, psychiatric, fertility and immune system related diseases and disorders; pharmaceutical and veterinary preparations and substances for the testing, diagnosis, prevention and treatment of allergies, autoimmune disease, transplant rejection and immunodeficiency disorders; ~~diagnostic reagents for testing and diagnosing allergies, autoimmune disease, transplant rejection, and immunodeficiency disorders;~~ [medical diagnostic reagents for testing and diagnosing allergies, autoimmune disease, transplant rejection, and immunodeficiency disorders;](#) vaccines

Class 005 for Pharmaceutical and veterinary preparations and substances for the testing, diagnosis, prevention and treatment of drug dependency, substance addiction, poisoning, overdose, envenomation, infectious diseases, blood disorders, pain, inflammation, sepsis, alopecia, polyposis, sinusitis, non-allergic rhinitis, obesity, cognitive disorders and viral, metabolic, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, gynaecological, oncological, hepatological, ocular, haemostasis, obstetric, ophthalmic, respiratory, neurological, gastrointestinal, hormonal, dermatological, renal system, urinary tract, otolaryngology, psychiatric, fertility and immune system related diseases and disorders; pharmaceutical and veterinary preparations and substances for the testing, diagnosis, prevention and treatment of allergies, autoimmune disease, transplant rejection and immunodeficiency disorders; medical diagnostic reagents for testing and diagnosing allergies, autoimmune disease, transplant rejection, and immunodeficiency disorders; vaccines

Filing Basis: Section 44(e), Based on Foreign Registration:For all applications: The applicant attaches a copy of [United Kingdom registration number 00003090455 registered 01/21/2015 with a renewal date of _____ and an expiration date of 01/21/2025], and translation thereof, if appropriate, before the application may proceed to registration. **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. **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 on or 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 or services that meet the certification standards of the applicant.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Bryce J. Maynard/ Date: 10/18/2016

Signatory's Name: Bryce J. Maynard

Signatory's Position: Attorney for Applicant, Virginia Bar Member

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: 86691218

Internet Transmission Date: Tue Oct 18 12:33:38 EDT 2016

TEAS Stamp: USPTO/RFR-XXX.XX.XXX.XX-2016101812333875

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