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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91196526
Party	Defendant Hughes-Medical, Corporation
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Date	10/19/2010
Attachments	Answer to Amended Notice of Opposition.pdf (7 pages)(48013 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

FERROSAN A/S,

Opposer,

v.

HUGHES-MEDICAL CORP.,

Applicant.

Opposition No. 91196526

Serial No. 77905234

Mark: FERROSTAT

Filing Date: January 5, 2010

ANSWER TO AMENDED NOTICE OF OPPOSITION

Hughes-Medical Corp., by its attorney, hereby submits its Answer to the Amended Notice of Opposition filed by, Ferrosan A/S (“Opposer”) as follows, with the following numbered paragraphs corresponding to the numbers of the paragraphs of the Amended Notice of Opposition under the headings therein:

Opposer and its FERROSAN Mark

1. Applicant is without knowledge or information sufficient to form a belief as to the allegations of paragraph 1, and therefore denies the same.
2. Applicant is without knowledge or information sufficient to form a belief as to the allegations of paragraph 2, and therefore denies the same.



3. Applicant is without knowledge or information sufficient to form a belief as to the allegations of paragraph 3, and therefore denies the same.
4. Applicant admits that Opposer is shown as the owner of U.S. Application No. 79046689 in the records of the United States Patent and Trademark Office, however Applicant is without knowledge or information sufficient to form a belief as to the remaining assertions of paragraph 4 and therefore denies the same.
5. Applicant is without knowledge or information sufficient to form a belief as to the allegations of paragraph 5, and therefore denies the same.

Applicant and its FERROSTAT Application

6. Applicant admits the allegations of paragraph 6.

I. Likelihood of Confusion, 15 U.S.C. § 1052(d)

7. Applicant is without knowledge or information sufficient to form a belief as to the allegations of paragraph 7, and therefore denies the same.
8. Applicant denies that its FERROSTAT mark is identical to Opposer's FERROSAN trade name and trademark. Applicant's mark is not divisible and thus the meaning of its syllabic components should not be parsed. Applicant denies that the dominant "A" vowel sound in the last syllable of both marks is the same. Applicant admits that both marks have the same number of syllables. Applicant is without knowledge or information



sufficient to form a belief as to the remaining allegations of paragraph 8, and therefore denies the same.

9. Applicant denies the allegations of paragraph 9.

II. Fraud on the USPTO

10. Applicant admits the allegations of paragraph 10.
11. Applicant admits the allegations of paragraph 11.
12. Applicant admits the allegations of paragraph 12.
13. Applicant admits the allegations of paragraph 13.
14. Applicant admits the allegations of paragraph 14.
15. Applicant admits the allegations of paragraph 15.
16. Applicant admits the allegations of paragraph 15.
17. Applicant denies the allegations of paragraph 16.
18. Applicant denies the allegations of paragraph 17.
19. Applicant admits that the USPTO accepted and relied on the statements in the Application and supporting declaration in approving the Application for publication. Applicant denies the remaining allegations of paragraph 19.
20. Applicant denies the allegations of paragraph 20.

AFFIRMATIVE DEFENSES

21. Applicant further affirmatively alleges that as a result of its continuous substantial usage of its mark FERROSTAT since adoption, this mark is a valuable asset of Applicant and



carries considerable goodwill of its products marketed under the mark. Such goodwill and usage has made the mark distinctive to Applicant.

22. Applicant further affirmatively alleges that there is no likelihood of confusion, mistake or deception because, *inter alia*, Applicant's mark and the pleaded mark of Opposer are not confusingly similar.

23. Applicant further alleges that there is no likelihood of confusion, mistake or deception because Applicant's mark and the pleaded mark of Opposer are not confusingly similar. Any similarity, if at all, between Applicant's mark and the pleaded mark of Opposer derives from Opposer's syllabic division of the mark. This division results in a similarity in the portion "FERRO", which, upon information and belief, has been used and registered by numerous third party businesses to indicate Iron. Additionally, the ending of Applicant's mark has a different sound and meaning from that of Opposer's. Not only does Applicant's mark ending in "STAT" sound different than Opposer's ending "SAN," but the meaning of "STAT" is immediate or urgent, while the meaning of "SAN" is a title to denote a saint. Furthermore, while Opposer claims to have a dominant "A" vowel, Applicant has a dominant "T" consonant. As a result, Opposer cannot base its allegation of any similarity between its pleaded mark and the "FERRO" portion of Applicant's mark. Any trademark or service mark rights that Opposer may have are narrowly circumscribed to the goods or services indicated and any other use would not lead to a likelihood of confusion.

24. Applicant further affirmatively alleges that there is no likelihood of dilution of Opposer's mark by tarnishment because Opposer's mark is associated with inexpensive low quality products whereas Applicant's mark is associated with high quality products.



25. Applicant further affirmatively alleges that there is no likelihood of dilution by blurring because Opposer's and Applicant's marks are not sufficiently similar. Upon information and belief, there are numerous uses and registrations of third party marks with the "FERRO" formative. Neither Applicant nor Applicant's predecessors in interest intended any association with Opposer's mark. Additionally, upon information and belief, ordinary prospective purchasers of Applicant's products do not associate Applicant's and Opposer's marks.
26. Applicant has contracts for the manufacturing and marketing of products bearing the mark FERROSTAT and continues to actively use the mark in commerce.
27. Opposer's Attorney's allegations of fraud are legally baseless and constitute an abuse of process as they are unsupported by evidence in Opposer's possession prior to filing the present suit.
28. Opposer's allegations of fraud are legally baseless and constitute malicious prosecution as they are unsupported by evidence in Opposer's possession prior to filing the present suit.

WHEREFORE, Applicant prays that the Trademark Trial and Appeal Board deny the Opposition, permits the registration of Applicant's proposed mark in Application Serial Number 77905234 in the United States Patent and Trademark Office, sanctions Opposer's Attorney for abuse of process insofar as its baseless fraud allegations, finds Opposer's suit to constitute malicious prosecution, and grants Applicant compensation for its cost and reasonable Attorney fees incurred to defend Opposer's suit.



Respectfully submitted,

By: /Mario S. Golab/

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ATTORNEYS FOR APPLICANT



CERTIFICATE OF SERVICE

I hereby certify that the above and foregoing Answer to Amended Notice of Opposition with Affirmative Defenses was served upon Opposer by depositing a copy of same in the United States mail, first class postage prepaid, on this 19th day of October, 2010, addressed to:

B. Brett Heavner
Attorney for Opposer
Finnegan Henderson Farabow Garrett & Dunner
901 New York Avenue NW
Washington, DC 20001

Attorney for Opposer

By: _____/Mario S. Golab/_____

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