

ESTTA Tracking number: **ESTTA378528**

Filing date: **11/15/2010**

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

Proceeding	91196526
Party	Defendant Hughes-Medical, Corporation
Correspondence Address	DR MARIO S GOLAB INTELLECTUAL PROPERTY BUSINESS CONSULTAN 1413 SANTA CRUZ AVE CORAL GABLES, FL 33134-2257 UNITED STATES drgolab@themindharvesters.com
Submission	Motion to Amend/Amended Answer or Counterclaim
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Date	11/15/2010
Attachments	AMENDED ANSWER TO AMENDED NOTICE OF OPPOSITION.pdf (6 pages) (46167 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

AMENDED 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 16.

17. Applicant denies the allegations of paragraph 17.

18. Applicant denies the allegations of paragraph 18.

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. 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. 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 has contracts for the manufacturing and marketing of products bearing the mark FERROSTAT and continues to actively use the mark in commerce.

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.

Respectfully submitted,

By: /Mario S. Golab/

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CERTIFICATE OF SERVICE

I hereby certify that the above and foregoing Amended Answer to Amended Notice of Opposition with Affirmative Defenses was served upon Opposer by electronic mail to b.brett.heavner@finnegan.com and by depositing a copy of same in the United States mail, first class postage prepaid, on this 15th day of November, 2010, addressed to:

B. Brett Heavner
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