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

Proceeding	91204507
Party	Defendant Hochschule Fresenius gemeinnützige GmbH
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Fresenius SE & Co. KGaA and
Fresenius Medical Care Deutschland GmbH
Opposers

v.

Opposition No. 91204507
Serial No. 79/070,045

Hochschule Fresenius gemeinnützige GmbH
Applicant

ANSWER

Applicant admits to the filing date, application number and publication information in the paragraph at the bottom of page 1 of the Notice of Opposition.

Applicant is without knowledge or information as to whether Fresenius SE & Co. KGaA and Fresenius Medical Care Deutschland GmbH believe they will be damaged by registration of the mark identified by trademark application Serial No. 79/070,045, at the bottom of page 1 of the Notice of Opposition and at the top of page 2 of the Notice of Opposition.

Applicant is without knowledge or information as to the address of Fresenius SE & Co. KGaA and as to whether it believes it will be damaged by registration of the Hochschule Fresenius mark identified by trademark application Serial No. 79/070,045, in the first full paragraph at the top of page 2 of the Notice of Opposition.

Applicant is without knowledge or information as to the address of Fresenius Medical Care Deutschland GmbH and as to whether it believes it will be damaged by registration of the Hochschule Fresenius mark identified by trademark application Serial No. 79/070,045, in the second full paragraph at the top of page 2 of the Notice of Opposition.

Applicant admits item 1 of the Notice of Opposition.

Applicant admits item 2 of the Notice of Opposition.

Applicant is without knowledge or information as to item 3 of the Notice of Opposition.

Applicant is without knowledge or information with respect to item 4. Applicant is without knowledge or information as to the existence of unrecorded information.

Applicant is without knowledge or information as to item 5 of the Notice of Opposition.

Applicant is without knowledge or information as to item 6 of the Notice of Opposition.

Applicant is without knowledge or information as to item 7 of the Notice of Opposition. It is unclear as to whether any such goodwill or consumer recognition relates to the goods which are the subject of the present Application.

Applicant is without knowledge or information with respect to item 8. Applicant is without knowledge or information as to the existence of unrecorded information.

Applicant is without knowledge or information as to item 9 of the Notice of Opposition.

Applicant is without knowledge or information as to item 10 of the Notice of Opposition.

Applicant is without knowledge or information as to item 11 of the Notice of Opposition. It is unclear as to whether any such goodwill or consumer recognition relates to the goods which are the subject of the present Application.

Applicant admits item 12 of the Notice of Opposition.

Applicant is without knowledge or information with respect to item 13. Applicant is without knowledge or information as to the existence of unrecorded information.

Applicant is without knowledge or information as to item 14 of the Notice of Opposition.

Applicant is without knowledge or information as to item 15 of the Notice of Opposition.

Applicant admits item 16 of the Notice of Opposition as the term "incontestable" is restricted and defined by law.

Applicant is without knowledge or information as to item 17 of the Notice of Opposition. It is unclear as to whether any such goodwill or consumer recognition relates to the goods which are the subject of the present Application.

Applicant admits item 18 of the Notice of Opposition.

Applicant admits item 19 of the Notice of Opposition.

Applicant admits item 20 of the Notice of Opposition.

Applicant admits item 21 of the Notice of Opposition.

Applicant denies item 22. "HOCHSCHULE" is a part of the mark as a whole and is not descriptive.

Applicant denies item 23.

The first word in the Applicant's mark is "Hochschule" which completely distinguishes the mark from any and all of "Fresenius and design", from "Fresenius Kabi and design" and from "Fresenius Medical Care" relied upon by the Opposer. During prosecution of the present Application, the Examiner had and considered all of the above cited marks. The Opposer has added nothing not already considered by the Examiner. There is no likelihood of confusion.

The marks are clearly distinguished by all of appearance, sound, meaning and connotation.

The finding of the Trademark Examiner that it was appropriate to submit the application to publication, in view of the very same marks as cited by the Opposer, was and is exactly correct.

Under *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973), the first factor requires examination of “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” When comparing the marks, “[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000). The Court of Appeals for the Federal Circuit has provided the following guidance for evaluating the marks: The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used. It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.

On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.

The mark under consideration is HOCHSCHULE FRESENIUS. This has a significantly different appearance, sound and suggestion than any of FRESENIUS and design, FRESENIUS MEDICAL CARE, and FRESENIUS KABI, cited by the Opposer.

Consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed Cir. 2005); see also *Mattel Inc. v. Funline Merch. Co.* 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“ it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

In the case of the present mark, "HOCHSCHULE" is the first word in the mark; whereas, in the case of the citations of the Opposer, in all cases, "FRESENIUS" is the first portion of the mark (except for "Fresenius and design where the horizontal bar design is the first portion of the mark followed by Fresenius.) The initial impression of the current mark is "HOCHSCULE" not "FRESENIUS". "HOCHSCULE" and "FRESENIUS" neither look nor sound alike. Further, if the English translation of

"HOCHSCHULE", i.e. "UNIVERSITY" is used, so that the current mark would be "UNIVERSITY FRESENIUS", "UNIVERSITY" would be the first word in the mark, which also neither looks nor sounds like "FRESENIUS".

The appearance and sounds of the marks are thus very different.

"UNIVERSITY" or its German language equivalent "HOCHSCHULE" are not descriptive, i.e. they do not describe any of the goods or services in the present trademark application. "HOCHSCHULE" and "UNIVERSITY", also do not "describe" a product or service. "HOCHSCHULE" and "UNIVERSITY" do, however, suggest that the source is a university, as opposed to a commercial entity, such as the Opposers, Fresenius SE & Co. KGaA and Fresenius Medical Care Deutschland GmbH. Nobody buying commercial product or services represented by the marks "FRESENIUS and design", "FRESENIUS MEDICAL CARE" and "FRESENIUS KABI" would expect the source to be a university. Conversely, nobody buying products or services represented by the mark "UNIVERSITY FRESENIUS" or "HOCHSCHULE FRESENIUS" would be likely to expect the goods or products to be from a source other than a university. The connotation and commercial impression of the marks are entirely different.

There is no likelihood of confusion.

The issue is not whether the respective marks themselves, or the goods or services offered under the marks, are likely to be confused but, rather, whether there is a likelihood of confusion as to the source or sponsorship of the goods or services because of the marks used thereon. *See, e.g., Paula Payne Prods. Co. v. Johnson's Pub'g Co., Inc.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973) (“[T]he question is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the goods they identify emanate from the same source”); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 16, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) (“...mistaken belief that [a good] is manufactured or sponsored by the same entity ... is precisely the mistake that Section 2(d) of the Lanham Act seeks to prevent”); *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) (“The degree of ‘relatedness’ must be viewed in the context of all the factors, in determining whether the services are sufficiently related that a reasonable consumer would be confused as to source or sponsorship.”); *In re Binion*, 93 USPQ2d 1531, 1534, 1535 (TTAB 2009); *In re Ass’n of the U.S. Army*, 85 USPQ2d 1264, 1267-68, 1270 (TTAB 2007); *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1429 (TTAB 1993).

In this case there is no likelihood of confusion, both because of the significant differences in the marks themselves because of the first word HOCHSCHULE in the

mark of the present application and because of the different source implication by the initial word "HOCHSCHULE" in the mark of the current application.

In more detail, the Opposer has cited FRESENIUS KABI, registration number 2699208; against the current "HOCHSCHULE FRESENIUS" trademark. This citation is improper. The cited mark is related to medical devices, pharmaceutical or dietetic preparations, medical care and medical services. Registration 2699208 includes the services of training in medical procedures and patient care, but nevertheless, like other cited marks, may be distinguished from the present "HOCHSCHULE FRESENIUS" mark. The marks differ in having significant words wherein the first word of the present mark is "HOCHSCHULE", not "FRESENIUS" and "FRESENIUS KABI" has an added word "KABI". Further, the marks are different in that that "FRESENIUS KABI" incorporates a source design. Again one would not look to a University to buy medical preparations and again the channels of trade are completely different.

Further, "HOCHSCHULE FRESENIUS" of the present application suggests a university source. Further there are two significant words that are different between "HOCHSCHULE FRESENIUS" and "FRESENIUS KABI", so that any expectation of confusion is unreasonable.

The Opposer has also cited FRESENIUS MEDICAL CARE, against the present "HOCHSCHULE FRESENIUS" mark. The cited "FRESENIUS MEDICAL CARE" mark, Registration number 2,302,398, is directed to pharmaceutical and medical products, medical apparatus and dialysis treatment. The current "HOCHSCHULE FRESENIUS" application includes none of these goods or services. The cited "FRESENIUS MEDICAL CARE" mark further includes the words "MEDICAL CARE", not in the "HOCHSCHULE FRESENIUS MARK". Further, the impression of the marks is entirely different. The first word of the present mark is "HOCHSCHULE" suggesting "University". The first word of "FRESENIUS MEDICAL CARE" in cited application 79649997 is the entirely different sounding and different appearing "FRESENIUS". "FRESENIUS MEDICAL CARE" contains nothing that would suggest a university source. The mark "HOCHSCHULE FRESENIUS" suggests a university in the first word of the mark and no person would look to a university for the goods or services covered by "FRESENIUS MEDICAL CARE". There is no likelihood of confusion.

The Opposer has cited “FRESENIUS and design”, Application number 79050568, registration number 3,771,611 against the present “HOCHSCHULE FRESENIUS” mark.

In reality, "education" provided by Fresenius SE & Co. KGaA would be in support of their commercial products, as contrasted with university services for the present application. The cited “FRESENIUS and design” is owned by a commercial entity; whereas, the present “HOCHSCHULE FRESENIUS” is owned by a university. The channels of trade are completely different.

In addition, the marks are significantly different. The first word seen when the present “HOCHSCHULE FRESENIUS” is viewed is “HOCHSCHULE”, meaning university, but the first word viewed with the “FRESENIUS and design” mark is a design pattern followed by “FRESENIUS”. The appearance, sound and impressions are entirely different. The cited “FRESENIUS” mark leaves no impression of a university source.

The trademark Examiner considered these citations in passing the present application to publication for opposition.

There is no likelihood of confusion.

Applicant denies item 24. There is no likelihood of confusion, as described above. The marks differ in appearance, sound, connotation and commercial impression as previously discussed. Further, the channels of trade are different and for the most part the goods and services in question are different. Applicant denies item 25 as previously discussed.

Applicant denies item 26 as previously discussed.

Applicant is without knowledge or information as to part one of multipart item 27 of the Notice of Opposition. Applicant is without knowledge or information as to part 2 of multipart item 27 of the Notice of Opposition. For reasons previously discussed, Applicant denies part 3 of multipart item 27 of the opposition.

For reasons previously discussed, Applicant denies item 28 of the opposition.

For reasons previously discussed, Applicant denies item 29 of the opposition.

For reasons previously discussed, Applicant denies item 30 of the opposition.

For reasons previously discussed, Applicant denies item 31 of the opposition.

Applicant denies item 32 of the opposition for reasons previously discussed, including prior use in the United States and prior use in Germany and elsewhere that is of benefit in the United States.

For reasons previously discussed, Applicant denies item 33 of the opposition.

For reasons previously discussed, Applicant denies item 34 of the opposition.

For reasons previously discussed, Applicant denies item 35 of the opposition.

Applicant is without knowledge or information as to item 36. Applicant has no information concerning possible unrecorded changes in status and title.

Applicant is without knowledge or information as to item 37. Applicant has no information concerning possible unrecorded changes in status and title.

Applicant is without knowledge or information as to item 38. Applicant has no information concerning possible unrecorded changes in status and title.

AFFIRMATIVE DEFENSES

1. Prior Use

Further, to the extent that any of the goods and services might be the same, Hochschule Fresenius gemeinnuetzige GmbH claims prior use in the United States and elsewhere.

2. Laches, Estoppel and Acquiescence

Both Fresenius SE & Co. KGaA and Fresenius Medical Care Deutschland GmbH have forgone any right of enforcement against Hochschule Fresenius gemeinnuetzige GmbH by reason of acquiescence, laches and estoppel because of concurrent use in Europe and especially in Germany, the location of the base trademark for the international application, for a period of over 150 years. During such time, Fresenius SE & Co. KGaA and Fresenius Medical Care Deutschland GmbH and predecessor companies have used marks containing "Fresenius" for commercial products and services; whereas, during that time Hochschule Fresenius gemeinnuetzige GmbH and predecessor companies has used the mark for educational services, educational periodicals and related matters. That further, the use by Hochschule Fresenius of a name and mark, containing "Fresenius" for educational services and related matters has long been open, notorious and well known in Germany and throughout the world. Application in the United States based upon the belatedly filed marks of Fresenius SE & Co. KGaA

and Fresenius Medical Care Deutschland GmbH, under such conditions, to belatedly attempt to restrict the use of a long used mark is inequitable and should be prohibited.

3. **Defendant In Any Case Is Entitled To Restricted Registration**

The goods and services of "HOCHSCHULE FRESENIUS" clearly do not overlap with either the cited "FRESENIUS KABI" or "FRESENIUS MEDICAL CARE" marks. The only goods and services that one in any way might consider overlapping with respect to "FRESENIUS and design" would have to relate only to educational services and to publications. In reality the description of goods and services of "FRESENIUS and design" with respect to educational services and publications are too broad because, in fact, they only include educational services and publications provided by commercial entities in relation to their commercial products; whereas, the goods of "HOCHSCHULE FRESENIUS" are "university and college education and university and college publications." Notwithstanding the assertion of the Applicant that there is no likelihood of confusion due to differences in appearance, sound, connotation and commercial impression, should there be a finding of likelihood of confusion, Applicant is still entitled to registration for "university and college education and university and college publications" , because likelihood of confusion would be non-existent. This is strongly supported by the concurrent use of marks in Germany and Europe without confusion for over 150 years where the Opposers used marks including FRESENIUS for commercial purposes and Applicant used marks containing FRESENIUS for "university and college education and university and college publications."

4. **Opposer's "FRESENIUS and design" mark should be restricted**

Opposer's "FRESENIUS and design" mark in International Class 41 should be restricted to "Non-university educational services, namely, providing seminars in the fields of nutrition, medical nutrition, extracorporeal blood purification, health, medical treatment and dialysis; health education information; nutrition and health education information; all related to urology, kidney disease and dialysis." Upon such restriction, in

accordance with Opposer's actual use, there would clearly be no likelihood of confusion as Applicant provides none of such services or goods as restricted.

Respectfully submitted,

/Michael L. Dunn/

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May 8, 2012
MLD/mjk

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

In the Matter of Trademark Application Serial No. 79/070045
Published: February 14, 2012

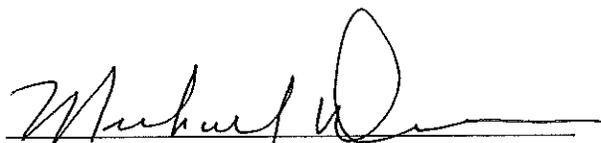
Fresenius SE & Co. KGaA)	
Fresenius Medical Care Deutschland GmbH)	
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Opposers,)	Opposition No. 91204507
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Hochschule Fresenius gemeinnuetzige GmbH)	
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Applicant.)	

CERTIFICATE OF SERVICE

I, Michael L. Dunn, counsel for Hochschule Fresenius gemeinnuetzige GmbH, do hereby certify that the Answer to the Notice of Opposition was served upon joint Opposers by placing a copy of same in the U.S. mail, postage prepaid, addressed as follows:

Scott D. Woldow
Smith Gambrell and Russell LLP
1130 Connecticut Avenue NW, Suite 1130
Washington, DC 20036

This 8th day of May, 2012



Michael L. Dunn