

ESTTA Tracking number: **ESTTA535263**

Filing date: **04/30/2013**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	AstraZeneca AB		
Entity	Corporation	Citizenship	Sweden
Address	Vastra Malarehamnen 9 SÅrdertÅalje, SE-151 85 SWEDEN		

Attorney information	Cara M. Kearney AstraZeneca Pharmaceuticals LP 1800 Concord Pike, FOP3-634 Wilmington, DE 19850-5437 UNITED STATES chuck.saunders@astrazeneca.com,cara.kearney@astrazeneca.com,trademarks@astrazeneca.com,paula.wright@astrazeneca.com Phone:302.885.8802		
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Registrations Subject to Cancellation

Registration No	3265365	Registration date	07/17/2007
International Registration No.	NONE	International Registration Date	NONE
Registrant	SIGMA-TAU INDUSTRIE FARMACEUTICHE; RIUNITE S.p.A. Viale Shakespeare, 47 I-00144 ROMA, ITALY		

Goods/Services Subject to Cancellation

Class 005. All goods and services in the class are cancelled, namely: Pharmaceutical preparations for the prevention and treatment of disorders of the nervous system, the immune system, the cardiovascular system including diabetes and metabolic diseases, the respiratory system, the musculoskeletal system, the genitourinary system, for the treatment of inflammatory disorders, for use in dermatology, in haematology, in oncology in transplantation, in ophthalmology, for use in the gastroenterological areas and the prevention and treatment of ocular disorders or diseases, anti-infectives, pharmaceutical preparations treating bacterial-bases disease, antivirals, anti-biotics, antifungals, vaccines, diagnostic preparations for medical use

Grounds for Cancellation

Abandonment	Trademark Act section 14		
Registration No	3265369	Registration date	07/17/2007
International Registration No.	NONE	International Registration Date	NONE
Registrant	SIGMA-TAU INDUSTRIE FARMACEUTICHE RIUNITE S.p.A. Viale Shakespeare, 47 I-00144 ROMA		

	ITALY
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Goods/Services Subject to Cancellation

Class 005. All goods and services in the class are cancelled, namely: Pharmaceutical preparations for the prevention and treatment of disorders of the nervous system, the immune system, the cardiovascular system including diabetes and metabolic diseases, the respiratory system, the musculoskeletal system, the genitourinary system, for the treatment of inflammatory disorders, for use in dermatology, in haematology, in oncology in transplantation, in ophthalmology, for use in the gastroenterological areas and the prevention and treatment of ocular disorders or diseases, anti-infectives, pharmaceutical preparations treating bacterial-bases disease, antivirals, anti-biotics, [antifungals,] vaccines, diagnostic preparations for medical use

Grounds for Cancellation

Abandonment		Trademark Act section 14	
Registration No	3265370	Registration date	07/17/2007
International Registration No.	NONE	International Registration Date	NONE
Registrant	SIGMA-TAU INDUSTRIE FARMACEUTICHE; RIUNITE S.p.A. Viale Shakespeare, 47 I-00144 ROMA ITALY		

Goods/Services Subject to Cancellation

Class 005. All goods and services in the class are cancelled, namely: Pharmaceutical preparations for the prevention and treatment of disorders of the nervous system, the immune system, the cardiovascular system including diabetes and metabolic diseases, the respiratory system, the musculoskeletal system, the genitourinary system, for the treatment of inflammatory disorders, for use in dermatology, in haematology, in oncology in transplantation, in ophthalmology, for use in the gastroenterological areas and the prevention and treatment of ocular disorders or diseases, anti-infectives, pharmaceutical preparations treating bacterial-bases disease, antivirals, anti-biotics, antifungals, vaccines, diagnostic preparations for medical use

Grounds for Cancellation

Abandonment		Trademark Act section 14	
Registration No	3318596	Registration date	10/23/2007
International Registration No.	NONE	International Registration Date	NONE
Registrant	SIGMA-TAU INDUSTRIE FARMACEUTICHE; RIUNITE S.p.A. Viale Shakespeare, 47 I-00144 ROMA ITALY		

Goods/Services Subject to Cancellation

Class 005. All goods and services in the class are cancelled, namely: Pharmaceutical preparations for the prevention and treatment of disorders of the nervous system, the immune system, the cardiovascular system including diabetes and metabolic diseases, the respiratory system, the musculoskeletal system, the genitourinary system, for the treatment of inflammatory disorders, for use in dermatology, in haematology, in oncology in transplantation, in ophthalmology, for use in the gastroenterological areas and the prevention and treatment of ocular disorders or diseases, anti-

infectives, pharmaceutical preparations treating bacterial-bases disease, antivirals, anti-biotics, antifungals, vaccines, diagnostic preparations for medical use
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Grounds for Cancellation

Abandonment

Trademark Act section 14

Attachments

Consolidated Petition for Cancellation (v Sigma Tau).pdf (4 pages)(109092 bytes) Consolidated Petition for Cancellation_Exhibit A.pdf (7 pages)(67381 bytes) Consolidated Petition for Cancellation_Exhibit B.pdf (24 pages)(1812954 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature

/cmk/

Name

Cara M. Kearney

Date

04/30/2013

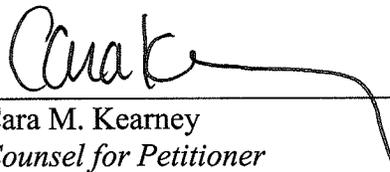
3. Upon information and belief, Respondent has not used in commerce any of the marks shown in the Sigma-Tau Registrations in connection with *all* of the goods covered by the registrations. This period of non-use spans more than three consecutive years.
4. Upon information and belief, Respondent has not used in commerce any of the marks shown in the Sigma-Tau Registrations in connection with *any* of the goods covered by the registrations. This period of non-use spans more than three consecutive years.
5. Upon information and belief, Respondent has never used any of the Sigma-Tau Registrations as a trademark in the United States.
6. Upon information and belief, Respondent never had the requisite bona fide intent to use the marks in the Sigma-Tau Registrations in the United States in connection with *any* of the goods covered by the registrations.
7. Upon information and belief, Respondent never had the requisite bona fide intent to use the marks in the Sigma-Tau Registrations in the United States in connection with *all* of the goods covered by the registrations.
8. Upon information and belief, Respondent has no intent to use the marks shown in the Sigma-Tau Registrations in connection with the goods covered by those registrations.
9. Upon information and belief, Respondent has abandoned the marks shown in each of the Sigma-Tau Registrations.

10. Petitioner will be damaged by the continuing registration of the Sigma-Tau Registrations because the registrations are blocking registration of Petitioner's Application.

WHEREFORE, Petitioner respectfully requests that its Consolidated Petition for Cancellation be sustained and that Registration Nos. 3265365, 3265369, 3265370, and 3318596 be cancelled.

Respectfully submitted,

ASTRAZENECA AB

By: 

Cara M. Kearney
Counsel for Petitioner

c/o AstraZeneca Pharmaceuticals LP
1800 Concord Pike
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Wilmington DE 19850-5437, USA
Tel +1 302 885 8802
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Date: April 30, 2013

CERTIFICATE OF SERVICE

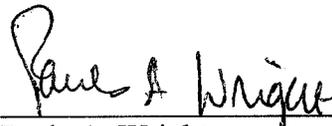
The undersigned certifies that a true copy of the foregoing was served on counsel for Registrant this 30th day of April by sending same via United States Postal Service, postage pre-paid, First Class Mail, addressed to:

Maury M Pepper III

Tepper & Eyster, PLLC

3724 Benson Drive

Raleigh, NORTH CAROLINA 27609



Paula A. Wright

EXHIBIT A

Trademark/Service Mark Application, Principal Register

Serial Number: 85501201

Filing Date: 12/21/2011

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85501201
MARK INFORMATION	
*MARK	GIMLIAND
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	GIMLIAND
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	AstraZeneca AB
*STREET	Vastra Malarehamnen 9
*CITY	Södertälje SE-151 85
*COUNTRY	Sweden
LEGAL ENTITY INFORMATION	
TYPE	aktiebolag (ab)
STATE/COUNTRY WHERE LEGALLY ORGANIZED	Sweden
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL	005

CLASS	
* IDENTIFICATION	Pharmaceutical preparations and substances
FILING BASIS	SECTION 1(b)
FILING BASIS	SECTION 44(d)
FOREIGN APPLICATION NUMBER	010509297
FOREIGN APPLICATION COUNTRY	European Community
FOREIGN FILING DATE	12/20/2011
INTENT TO PERFECT 44(d)	At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid of priority may be retained.
ATTORNEY INFORMATION	
NAME	Travis P. Boozer
ATTORNEY DOCKET NUMBER	102411/US
FIRM NAME	AstraZeneca Pharmaceuticals LP
INTERNAL ADDRESS	FOP3-414
STREET	1800 Concord Pike
CITY	Wilmington
STATE	Delaware
COUNTRY	United States
ZIP/POSTAL CODE	19850-5437
PHONE	302.885.5242
FAX	302.886.2952
EMAIL ADDRESS	trademarks@astrazeneca.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
OTHER APPOINTED ATTORNEY	Wm. Charles Saunders

CORRESPONDENCE INFORMATION

NAME	Travis P. Boozer
FIRM NAME	AstraZeneca Pharmaceuticals LP
INTERNAL ADDRESS	FOP3-414
STREET	1800 Concord Pike
CITY	Wilmington
STATE	Delaware
COUNTRY	United States
ZIP/POSTAL CODE	19850-5437
PHONE	302.885.5242
FAX	302.886.2952
EMAIL ADDRESS	trademarks@astrazeneca.com;travis.boozer@astrazeneca.com;paula.wright@astrazeneca.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes

FEE INFORMATION

NUMBER OF CLASSES	1
FEE PER CLASS	325
*TOTAL FEE DUE	325
*TOTAL FEE PAID	325

SIGNATURE INFORMATION

SIGNATURE	/tpb/
SIGNATORY'S NAME	Travis Pelham Boozer
SIGNATORY'S POSITION	Trademark Counsel
DATE SIGNED	12/21/2011

Trademark/Service Mark Application, Principal Register

Serial Number: 85501201

Filing Date: 12/21/2011

To the Commissioner for Trademarks:

MARK: GIMLIAND (Standard Characters, see [mark](#))

The literal element of the mark consists of GIMLIAND.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, AstraZeneca AB, a aktiebolag (ab) legally organized under the laws of Sweden, having an address of

Vastra Malarehamnen 9
Södertälje SE-151 85
Sweden

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 005: Pharmaceutical preparations and substances

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

Priority based on foreign filing: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services and asserts a claim of priority based on European Community application number 010509297, filed 12/20/2011. 15 U.S.C. Section 1126(d), as amended. INTENT TO PERFECT 44(d) : At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.

The applicant's current Attorney Information:

Travis P. Boozer and Wm. Charles Saunders of AstraZeneca Pharmaceuticals LP

FOP3-414
1800 Concord Pike
Wilmington, Delaware 19850-5437
United States

The attorney docket/reference number is 102411/US.

The applicant's current Correspondence Information:

Travis P. Boozer

AstraZeneca Pharmaceuticals LP

FOP3-414

1800 Concord Pike

Wilmington, Delaware 19850-5437

302.885.5242(phone)

302.886.2952(fax)

trademarks@astrazeneca.com;travis.boozer@astrazeneca.com;paula.wright@astrazeneca.com

(authorized)

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Declaration Signature

Signature: /tpb/ Date: 12/21/2011

Signatory's Name: Travis Pelham Boozer

Signatory's Position: Trademark Counsel

RAM Sale Number: 3438

RAM Accounting Date: 12/22/2011

Serial Number: 85501201

Internet Transmission Date: Wed Dec 21 16:06:32 EST 2011

TEAS Stamp: USPTO/BAS-156.70.222.30-2011122116063224

8088-85501201-490173a55fa20da64f90fde634

25113ef-DA-3438-20111221131455806019

GIMLIAND

EXHIBIT B

To: AstraZeneca AB (trademarks@astrazeneca.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85501201 - GIMLIAND - 102411/US
Sent: 3/31/2013 11:21:17 AM
Sent As: ECOM104@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)
[Attachment - 10](#)
[Attachment - 11](#)
[Attachment - 12](#)
[Attachment - 13](#)
[Attachment - 14](#)
[Attachment - 15](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 85501201

MARK: GIMLIAND

85501201

CORRESPONDENT ADDRESS:

Wm. Charles Saunders
AstraZeneca Pharmaceuticals LP
FOP3-318
1800 Concord Pike
Wilmington DE 19850-5437

CLICK HERE TO RESPOND TO THIS LETTER
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: AstraZeneca AB

CORRESPONDENT'S REFERENCE/DOCKET NO :

102411/US

CORRESPONDENT E-MAIL ADDRESS:

trademarks@astrazeneca.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 30 DAYS** OF THE ISSUE/MAILING DATE BELOW OR **WITHIN THE TIME REMAINING IN THE SIX-MONTH PERIOD FOR RESPOND TO THE PREVIOUS OFFICE ACTION DATED OCTOBER 30, 2012**, WHICHEVER IS LONGER.

ISSUE/MAILING DATE: 3/31/2013

This Office Action is sent following an examiner's amendment entered March 31, 2013, that resolved outstanding requirements regarding the applicant's identifications of goods. However, the amendments do not resolve the final refusal issued for this application under Trademark Act §2(d). Therefore, the refusal to register is maintained herein remains final.

Refusal under Trademark Act Section 2(d) – Likelihood of Confusion

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 3265365 ("GIMULA"), 3265369 ("GIMLEF"), 3265370 ("GIMLIV"), and 3318596 ("GIMLIF"), all owned by Sigma-Tau Industrie Farmaceutiche. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). In the seminal decision *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the court listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01.

Among these factors are the similarity of the marks as to appearance, sound, meaning, and overall commercial impression, relatedness of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.* However, not all the factors are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

Similarity of the Parties' Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services offered under applicant's and registrant's marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. See *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

In this case, the applicant's mark "GIMLIAND" creates a similar commercial impression to the cited registered marks "GIMULA", "GIMLEF", "GIMLIV", and "GIMLIF". The cited marks are all owned by the same registrant, and their similarities to each other essentially form a recognizable pattern "G-I-M-L" in the first few letters of each mark. The applicant's mark follows this same form and consumers encountering the applicant's mark in the same contexts as the registered marks are likely to mistakenly believe that the similar pattern in the applicant's mark means that it is related in source to the registered marks. In other words, the patterns in the registered marks form somewhat of a house mark, and the applicant's mark share strong similarities in sound and appearance to the registered marks as to this common pattern.

The examining attorney further notes that the form exhibited by the marks is particularly strong in the relevant field of products. The attached evidence from the Trademark Office database search program shows that the applicant's mark and the four registered marks are the only results for a search of pharmaceutical products featuring the letter pattern "G"- "I"- "Y"- "M"- "L". Thus, the registered marks are particularly distinctive in this field, or at least not weakened by another other similar marks. Therefore, it is more likely that consumers encountering the applicant's mark alongside the registered marks are likely to mistakenly associate the marks.

The examining attorney finally notes that The Trademark Trial and Appeal Board and its primary reviewing court have used a stricter standard to determine likelihood of confusion for pharmaceuticals or medicinal products due to the potential harm or serious consequences that could be caused if the public confused one drug or medicinal product for another. See *Glenwood Labs., Inc. v. Am. Home Prods. Corp.*, 455 F.2d 1384, 1386-87, 173 USPQ 19, 21-22 (C.C.P.A. 1972); *Schering Corp. v. Alza Corp.*, 207 USPQ 504, 509 (TTAB 1980); *Ethicon, Inc. v. Am. Cyanamid Co.*, 192 USPQ 647, 651-52 (TTAB 1976); TMEP §1207.01(d)(xii).

Although physicians and pharmacists are no doubt carefully trained to recognize differences in the characteristics of pharmaceuticals or medicinal products, they are not immune from mistaking similar

trademarks used on these goods. *See Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1305-06 (TTAB 2004); *Blansett Pharmacal Co. v. Carmrick Labs., Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992); *Schering Corp.*, 207 USPQ at 509. Thus, in this case where confusion could result in harm or other serious consequences to consumers, this potential harm is considered an additional relevant factor and a lesser degree of proof may be sufficient to establish a likelihood of confusion. *See Glenwood Labs., Inc.*, 455 F.2d at 1386-87, 173 USPQ at 21-22; *Schering Corp.*, 207 USPQ at 509; *Ethicon, Inc.*, 192 USPQ at 651-52; TMEP §1207.01(d)(xii).

Relatedness of the Parties' Goods

When analyzing an applicant's and registrant's goods and/or services for similarity and relatedness, the determination is based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *see* TMEP §1207.01(a)(iii).

All circumstances surrounding the sale of the goods and/or services are considered. These circumstances include the marketing channels, the identity of the prospective purchasers, and the degree of similarity between the marks and between the goods and/or services. *See Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386 (C.C.P.A. 1973); TMEP §1207.01. However, absent restrictions in an application and/or registration, the identified goods and/or services are presumed to travel in the same channels of trade to the same class of purchasers. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d at 1268, 62 USPQ2d at 1005. Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

The goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i). Rather, the respective goods and/or services need only be related in some manner or the conditions surrounding their marketing be such that they will be encountered by the same consumers under circumstances that would lead to the mistaken belief that the goods and/or services originate from the same source. *Gen. Mills Inc. v. Fage Dairy Processing Indus.*, 100 USPQ2d 1584, 1597 (TTAB 2012); TMEP §1207.01(a)(i); *see On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d at 1086, 56 USPQ2d at 1475; *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

The applicant produces pharmaceutical preparations used in a variety of fields of medicine, from oncology to cardiovascular issues to disorders of inflammation and infection. The cited registrant also produces pharmaceutical products, including those with particular purposes for the same types of systems and disorders as served by the applicant's goods, such as cardiovascular disorders, respiratory disorders, infections, oncology, and gastrointestinal disorders. Please see the attached Internet evidence showing the goods produced by the prior registrant.

The parties' goods are therefore identical, or at least very closely related in nature and purpose.

Consumers are very likely to encounter such similar products in the same market channels. Given the strong similarities between the parties' marks, consumers are likely to confuse the marks and mistake the underlying sources of such similar goods bearing the marks. Registration remains refused to prevent such confusion.

The applicant must also note the following.

Application Filed under Dual Bases – Option to Delete One

The application specifies both an intent to use basis under Trademark Act Section 1(b) and reliance on a foreign registration(s) under Section 44(e). See 15 U.S.C. §§1051(b), 1126(e); 37 C.F.R. §2.34(a)(2)-(3).

However, with the §44(e) basis perfected, the foreign registration alone may serve as a basis for obtaining a U.S. registration. See 37 C.F.R. §2.34(a)(3); TMEP §806.01(d). If applicant wants to rely solely on the foreign registration under Section 44(e) as the basis, applicant can request deletion of the Section 1(b) basis. See 37 C.F.R. §2.35(b)(1); TMEP §806.04.

Unless applicant indicates otherwise, this Office will presume that applicant is relying on both Sections 1(b) and 44(e). Thus, although the mark may be approved for publication, it will not register until an acceptable allegation of use has been filed for the goods and/or services based on Section 1(b).

RESPONDING TO A FINAL OFFICE ACTION

The Applicant must respond within thirty days of the date of issuance of this final Office Action or within the time remaining in the six-month period for responding to the previous Office Action dated October 30, 2012, whichever is longer, or the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond by providing one or both of the following:

- (1) A response that fully satisfies all outstanding requirements;
- (2) An appeal to the Trademark Trial and Appeal Board, with the appeal fee of \$100 per class.

37 C.F.R. §2.64(a); TMEP §714.04; see 37 C.F.R. §2.6(a)(18); TBMP ch. 1200.

In certain rare circumstances, an applicant may respond by filing a petition to the Director pursuant to 37 C.F.R. §2.63(b)(2) to review procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; see 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

/Cory Boone/
Cory Boone
Trademark Examining Attorney
Law Office 104
Phone: (571) 270-1510
Fax: (571) 270-2510
cory.boone@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please

wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

Print: Mar 31, 2013

79026977

DESIGN MARK

Serial Number

79026977

Status

REGISTERED

Word Mark

GIMULA

Standard Character Mark

Yes

Registration Number

3265365

Date Registered

2007/07/17

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

SIGMA-TAU INDUSTRIE FARMACEUTICHE; RIUNITE S.p.A. SOCIETA PER AZIONI
ITALY Viale Shakespeare, 47 I-00144 ROMA ITALY

Goods/Services

Class Status -- ACTIVE. IC 005. US 006 018 044 046 051 052. G & S:
Pharmaceutical preparations for the prevention and treatment of
disorders of the nervous system, the immune system, the
cardio-vascular system including diabetes and metabolic diseases, the
respiratory system, the musculoskeletal system, the genitourinary
system, for the treatment of inflammatory disorders, for use in
dermatology, in haematology, in oncology in transplantation, in
ophthalmology, for use in the gastroenterological areas and the
prevention and treatment of ocular disorders or diseases,
anti-infectives, pharmaceutical preparations treating bacterial-bases
disease, antivirals, anti-biotics, antifungals, vaccines, diagnostic
preparations for medical use.

Priority Date

2006/05/09

Filing Date

2006/05/31

Examining Attorney

HELLMAN, ELI

Attorney of Record

Maury M. Tepper, III (Christine S. Beaman, M. Christopher Bolen,
Kathryn M. Eyster, Jack B. Hicks, Sarah Anne Keefe, Fang Liu, Jeffrey
R. McFadden, C. Robert Rhodes, Randel S. Springer, Maury M. Tepper,
III, Mitchell A. Tuchman)

GIMMULA

Print: Mar 31, 2013

79027181

DESIGN MARK

Serial Number

79027181

Status

REGISTERED

Word Mark

GIMLEF

Standard Character Mark

Yes

Registration Number

3265369

Date Registered

2007/07/17

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

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anti-infectives, pharmaceutical preparations treating bacterial-bases
disease, antivirals, anti-biotics, [antifungals,] vaccines,
diagnostic preparations for medical use.

Priority Date

2006/05/09

Filing Date

Print: Mar 31, 2013

79027181

2006/05/31

Examining Attorney
KEARNEY, COLLEEN

Attorney of Record
Maury M. Tepper, III

GIMLEF

Print: Mar 31, 2013

79027182

DESIGN MARK

Serial Number

79027182

Status

REGISTERED

Word Mark

GIMLIF

Standard Character Mark

Yes

Registration Number

3318596

Date Registered

2007/10/23

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

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SIGMA-TAU INDUSTRIE FARMACEUTICHE; RIUNITE S.p.A. SOCIETA PER AZIONI
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preparations for medical use.

Priority Date

2006/05/09

Filing Date

2006/05/31

Examining Attorney

KEARNEY, COLLEEN

Attorney of Record

Maury M. Tepper, III (Christine S. Beaman, M. Christopher Bolen,
Kathryn M. Eyster, Jack B. Hicks, Sarah Anne Keefe, Fang Liu, Jeffrey
R. McFadden, C. Robert Rhodes, Randel S. Springer, Maury M. Tepper,
III, Mitchell A. Tuchman)

GIMILIF

Print: Mar 31, 2013

79027183

DESIGN MARK

Serial Number

79027183

Status

REGISTERED

Word Mark

GIMLIV

Standard Character Mark

Yes

Registration Number

3265370

Date Registered

2007/07/17

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

SIGMA-TAU INDUSTRIE FARMACEUTICHE; RIUNITE S.p.A. SOCIETA PER AZIONI
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ophthalmology, for use in the gastroenterological areas and the
prevention and treatment of ocular disorders or diseases,
anti-infectives, pharmaceutical preparations treating bacterial-bases
disease, antivirals, anti-biotics, antifungals, vaccines, diagnostic
preparations for medical use.

Priority Date

2006/05/09

Filing Date

2006/05/31

Examining Attorney

KEARNEY, COLLEEN

Attorney of Record

Maury M. Tepper, III (Christine S. Beaman, M. Christopher Bolen,
Kathryn M. Eyster, Jack B. Hicks, Sarah Anne Keefe, Fang Liu, Jeffrey
R. McFadden, C. Robert Rhodes, Randel S. Springer, Maury M. Tepper,
III, Mitchell A. Tuchman)

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What's the difference

between a disease affecting 300 and 300,000,000?





02.28.13

Sigma-Tau Pharmaceuticals Stands United with Patient Organizations on Rare Disease Day.



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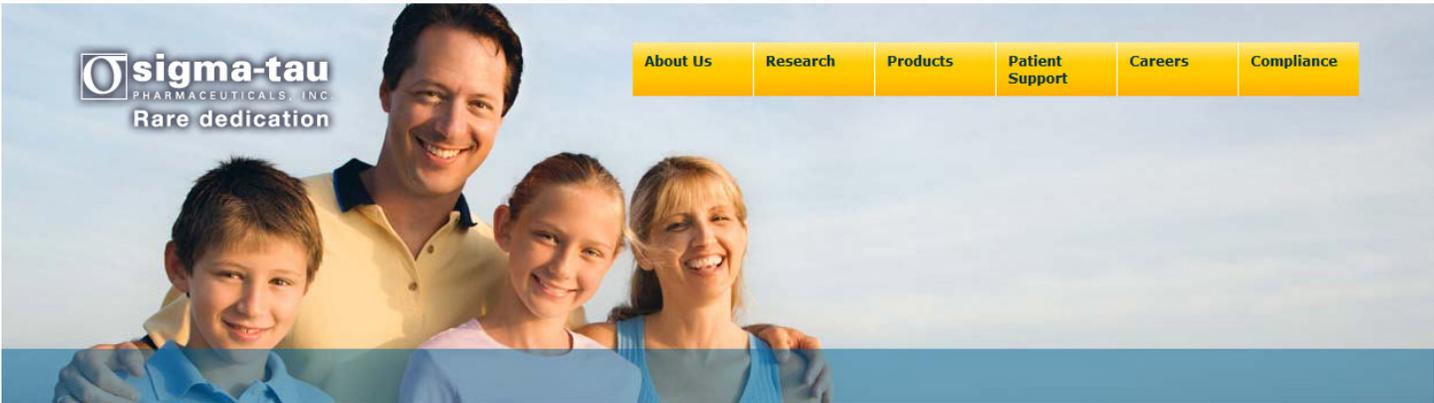
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Consumer Products

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Sigma-Tau Consumer Products, a division of Sigma-Tau Pharmaceuticals, Inc., is committed to producing high quality nonprescription medicines and dietary supplements that help to support the normal functions of your body.

ProXeed Plus®
VSL#3®

To: AstraZeneca AB (trademarks@astrazeneca.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85501201 - GIMLIAND - 102411/US
Sent: 3/31/2013 11:21:18 AM
Sent As: ECOM104@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **3/31/2013** FOR U.S. APPLICATION SERIAL NO. 85501201

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on “Documents.”

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **3/31/2013** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

Do NOT hit “Reply” to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the

ABANDONMENT of your application. For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.