

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : HSI Service Corp.
Serial No. : 78/172,835 Examiner James A. Rauen, Esq.
Filed : October 10, 2002 Law Office 103
Mark : CRITERION

Commissioner for Trademarks
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Arlington, VA 22202-3513

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ANNA JACOBSSON
Name
[Signature]
Signature

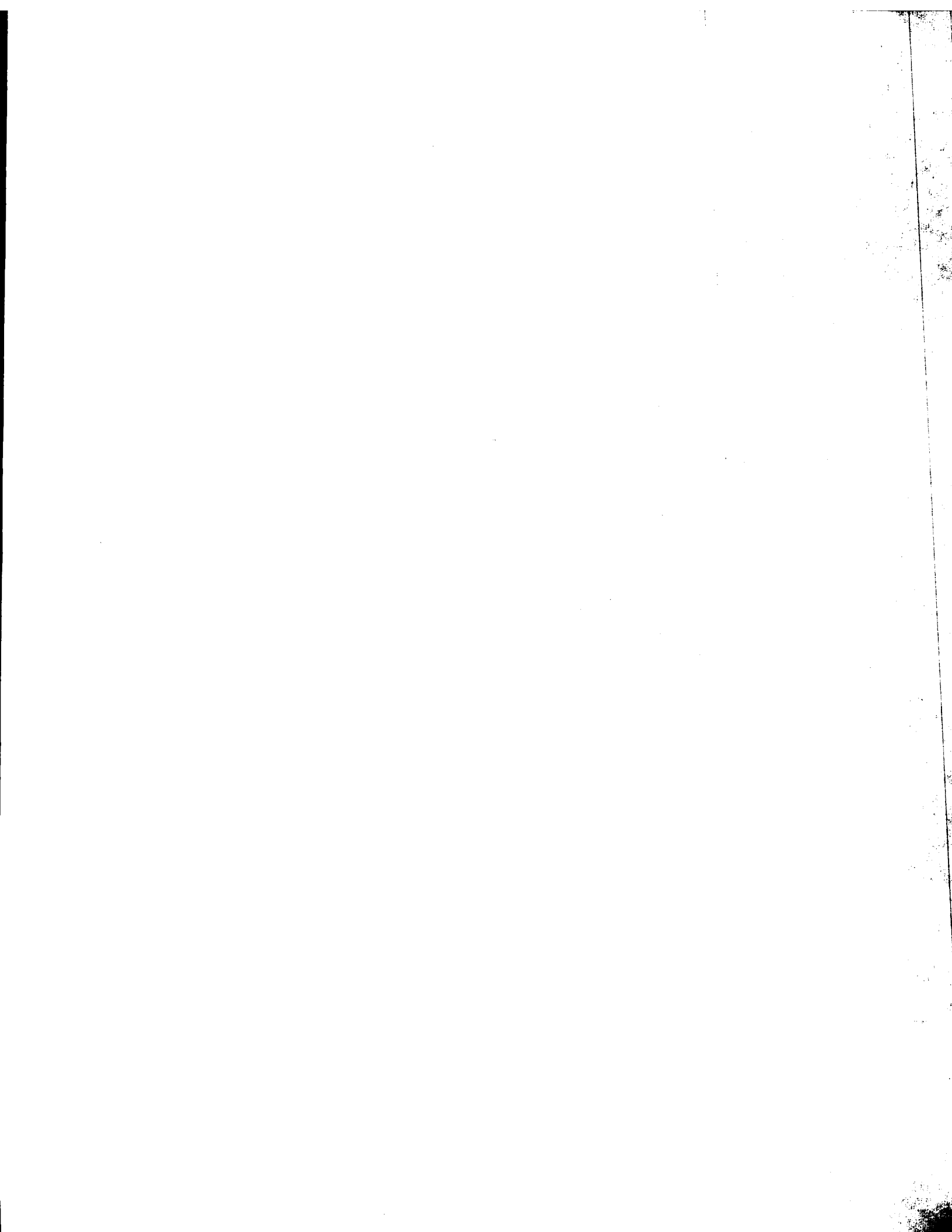
REQUEST FOR RECONSIDERATION

In response to the Office Action dated February 20, 2004 making final the refusal to register Applicant's mark on the ground that the mark, when used on the goods covered thereby, would likely cause confusion, or to cause mistake, or to deceive with respect to the cited U.S. Registration No. 2,528,119 for the mark CRITERION (the "Cited Mark"). Applicant respectfully disagrees with the Examining Attorney's conclusion and, pursuant to C.F.R. §2.64(b) and TMEP §715.03, requests that the application be reconsidered in view of the new evidence and arguments set forth below. Applicant has also concurrently submitted a Notice of Appeal, a copy of which is enclosed.

REMARKS

In response to the Examining Attorney's final refusal to register Application Serial No. 78/172,835, Applicant, as set forth below, submits new arguments and evidence, which supports a finding that no likelihood of consumer confusion, as to the source of the goods at issue, is likely to arise.

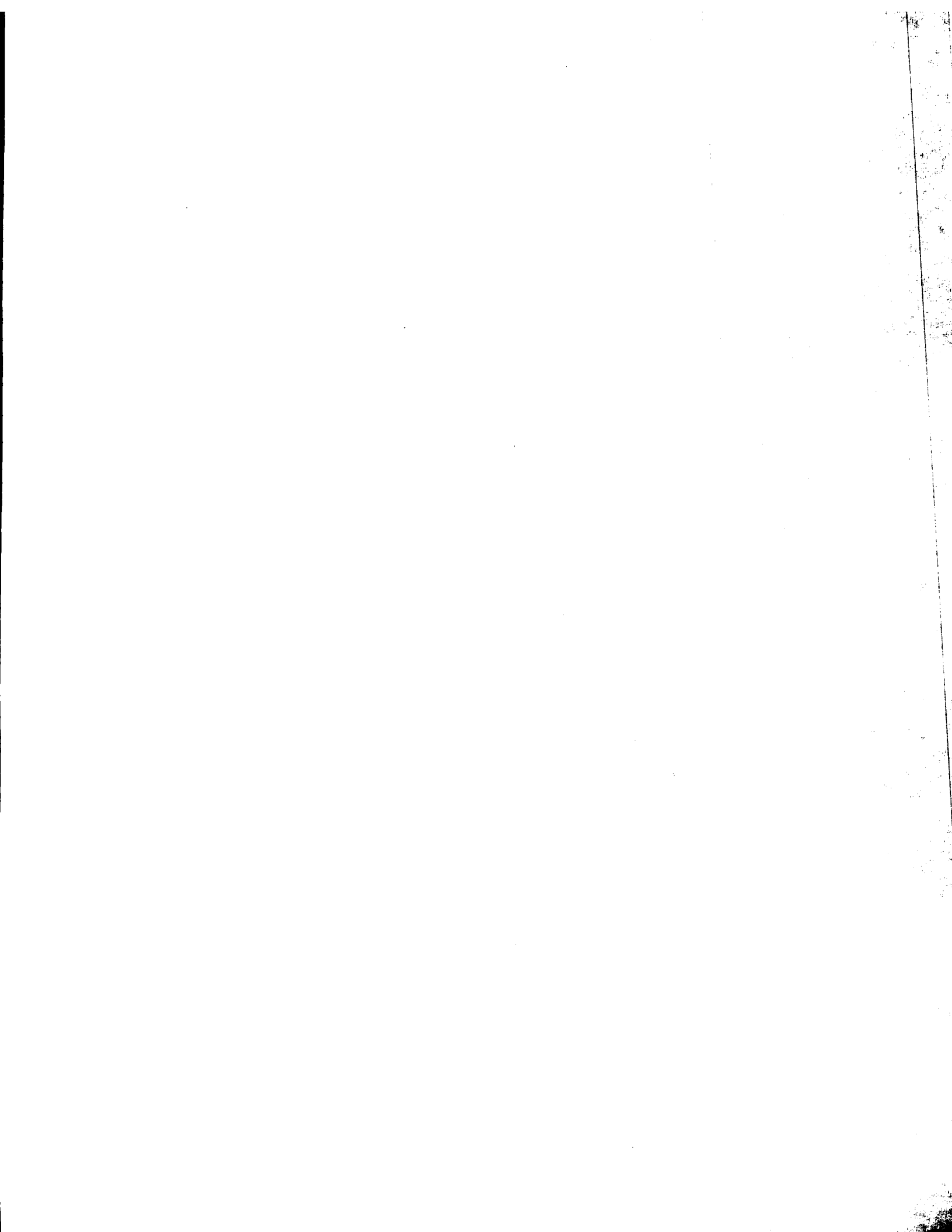




confusion (Exhibit B). Since consumers would have to access Applicant's website (www.henryschein.com) in order to view the goods, they would immediately be aware of the specific source from which the goods originate. Moreover, in order to actually purchase the goods, consumer would have to set up an account with Applicant, which would preclude any likelihood of consumer confusion. Similarly, consumers would be informed of the source of Applicant's goods when the goods appear in its mail order catalogs or promotional materials.

In any event, the goods at issue are substantially different and Applicant argues that based on the nature of the goods at issue consumer confusion as to the source is unlikely. Applicant's medical, dental and veterinary gloves are disposable one-time use infection control products used by healthcare professionals while Registrant's artificial respiratory apparatus and instruments are used in the field of respiratory treatment and therapy. Indeed even the owner of the Cited Mark does not believe that consumer confusion is likely between its respiratory apparatus and instruments and disposable infection control products. In Registrant's response to an Office Action dated October 29, 1999, they state that their products and disposable infection control products are "sufficiently distinct that it is highly unlikely consumers would believe there is any association between the respective sources" (Exhibit C). *See Id. at* §23:78 (evidence proving that the owner of the Cited Mark believes that there will be no likelihood of confusion is relevant). Furthermore, Registrant's statement that their products are sold via specialized distributors, together with the price differences and the fact that the prospective consumers are highly sophisticated and exercise a high standard of care in view of their specific needs, supports Applicant's contention that it is highly unlikely for consumer confusion, as to the source of the goods, to occur. *See Exhibit C*

Applicant has, as stated in its Amendment to Allege Use, used its mark since at least as early as March 1, 2003. For over a year the marks at issue have co-existed in the market without



any reported instances of consumer confusion. More importantly, a search of the Register shows that numerous CRITERION marks for a wide variety of goods co-exist, which indicates that consumers do not consider all goods bearing the CRITERION mark to originate from the same source. Also, while evidence that some companies sell or manufacture both gloves and apparatus or instruments related to respiratory therapy may have probative value in determining that such goods may emanate from a single source, Applicant contends that the surrounding circumstances in this case preclude a finding of likelihood of confusion.

Moreover, since the Cited Mark is allowed to co-exist with, in particular, a prior third-party registration, CRITERION Registration No. 799,609, for artificial teeth, Applicant respectfully requests that its CRITERION mark also should be able to do so. Applicant contends that its products are no more closely related to artificial respiratory apparatus and instruments than these products are to artificial teeth (Exhibit D).

CONCLUSION

For all the foregoing reasons, Applicant respectfully requests that the Examining Attorney reconsider the final refusal of Application Serial No. 78/172,835 in view of the new evidence and arguments submitted and that the CRITERION mark therefore be approved for publication.

Respectfully submitted,

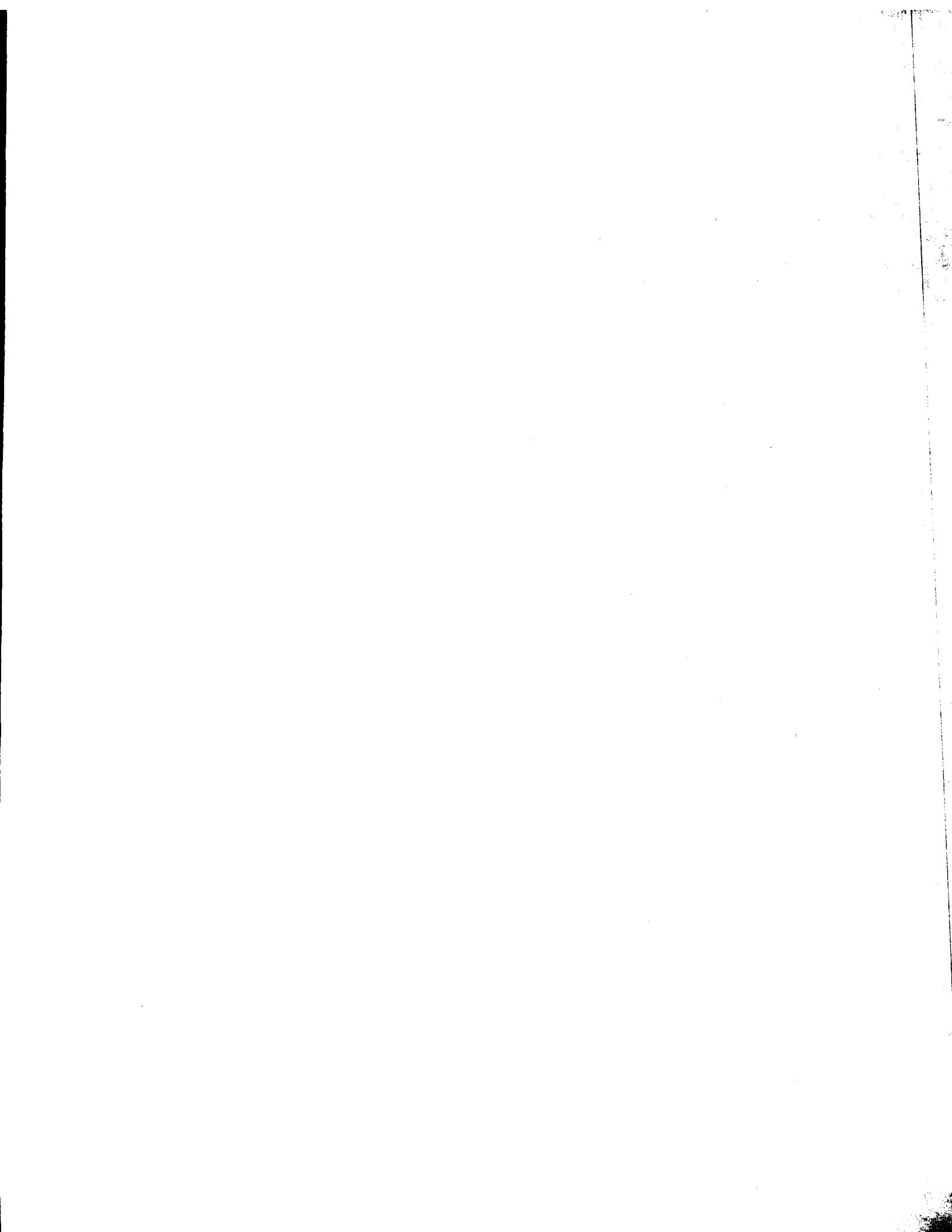
DONOVAN & YEE LLP
Attorneys for Applicant

By: _____

Marya Lenn Yee
Anna Jakobsson

Dated: 4/29/04

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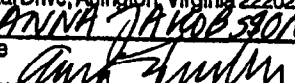
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ANNA JAKOBSSON
Name 
Signature

Commissioner for Trademarks
Box TTAB - FEE
2900 Crystal Drive
Arlington, Virginia 22202

Re: Client/Matter No. : 1003
Applicant : HSI Service Corp.
MARK : CRITERION

Madam:

Kindly file the enclosed papers indicated below. Please charge the fee, estimated to be \$100.00 and any deficiency or overpayment of the fee as estimated below to the undersigned attorney's Deposit Account No. 50-0357.

Ex Parte Appeal From Examiner of Trademarks

Respectfully submitted,

DONOVAN & YEE LLP

By: 

Marya Lena Yee
Anna Jakobsson
Attorney for Applicant

Estimated Fee: \$ 100.00

Dated: 4/29/07



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

Applicant : HSI Service Corp.
Serial No. : 78/172,835
Filed : October 10, 2002
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Name ANNA JAKOBSSON
[Signature]
Signature

EX PARTE APPEAL FROM EXAMINER OF TRADEMARKS

Commissioner for Trademarks
BOX TTAB - FEE
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Arlington, Virginia 22202

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Examiner of Trademarks, dated February 20, 2004, refusing registration of the above Mark.

Simultaneously herewith, Applicant has filed a Request for Reconsideration with the Examining Attorney.

Dated: 7/29/04

DONOVAN & YEE, LLP
Attorneys for Applicant

By: [Signature]
Marya Dehn Yee
Anna Jakobsson

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(212) 226-7700

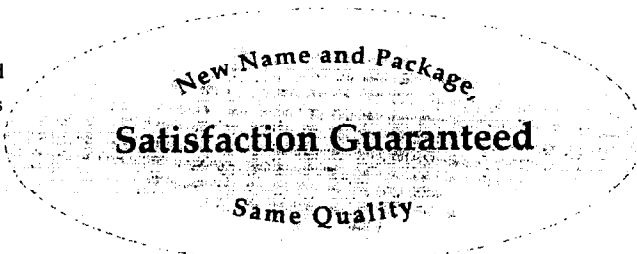


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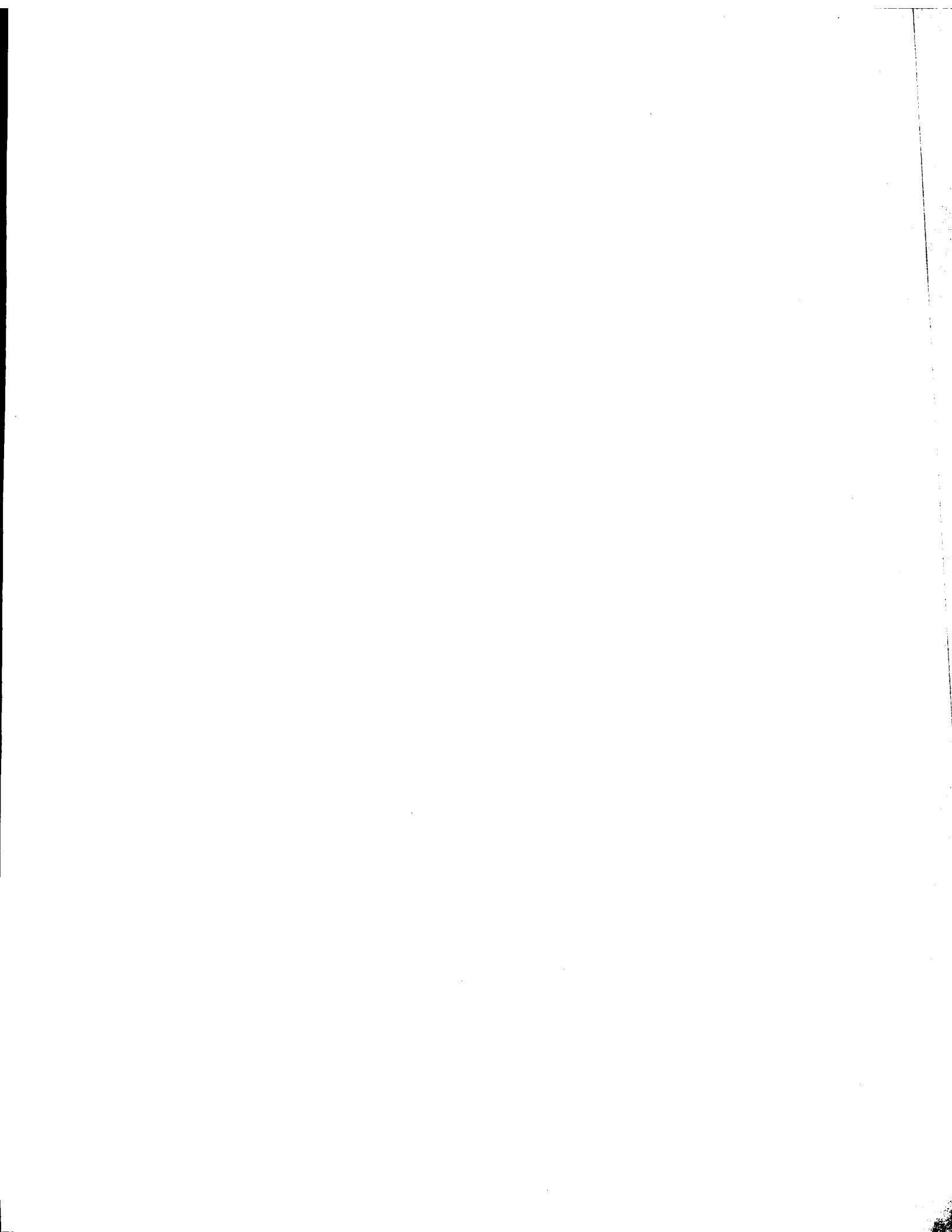
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