

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85283635
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION (no change)	
ARGUMENT(S)	
<p>In response to the Final Action issued January 31, 2012, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's Ser. No. 85/283635 – SCILEO on the ground that it is likely to be confused with Reg. Nos. 3314557 – SCIELE, 3332555 – SCIELE PHARMA, INC. & Design, and 3756644 – SCIELE PHARMA, INC. A SHINOGI COMPANY & Design, all owned by Shionogi Pharma, Inc. (the "Registrant").</p> <p>Attached is a Consent to Registration ("Consent") dated July 25, 2012 signed by Registrant's authorized signatory. The attached Consent shows that Applicant and Registrant have conferred regarding their respective use and registration of their respective SCIELO and SCIELE marks, and believe that confusion is not likely in view of the specific differences between the parties' marks and goods, the sophistication of the parties' purchasers, and the different circumstances in which the marks are and will be used. Because the parties have reached an agreement that they believe will avoid any likelihood of confusion, mistake, or deception, the Examining Attorney should withdraw the refusal to register Applicant's Mark.</p> <p>In cases such as this, examining attorneys are instructed to give "great weight" to a consent agreement. T.M.E.P. § 1207.01(d)(viii). The role of the Trademark Office is not to "deny registration if it feels there is, by its independent determination, any likelihood of confusion of any kind as between the mark sought to be registered and the prior registration, without regard to the desires, opinions, or agreements of the owner of the prior registration. . . ." <u>In re National Distillers and Chem. Corp.</u>, 132</p>	

U.S.P.Q. 271, 277 (C.C.P.A. 1962) (Rich, J., concurring). Rather, the Trademark Office “must count on the self-interest of trademark owners to do that.” In re Four Seasons Hotels Ltd., 26 U.S.P.Q.2d 1071, 1072 (Fed. Cir. 1993) (quoting In re National Distillers and Chem. Corp., 132 U.S.P.Q at 279).

Moreover, the United States Court of Appeals for the Federal Circuit has expressly recognized that it is improper for the Office to substitute its judgment for that of the mark owners. In Bongrain Int’l Corp. v. Delice de France, Inc., 1 U.S.P.Q.2d 1775 (Fed. Cir. 1987), the Federal Circuit stated:

We have often said, in trademark cases involving agreements reflecting parties’ views on the likelihood of confusion in the marketplace, that they are in a much better position to know the real life situation than bureaucrats or judges and therefore such agreements may, depending on the circumstances, carry great weight, as was held in DuPont....

It is possible to preserve the registrations, as the parties originally agreed to do, by accepting their reasonable appraisal of marketplace conditions, and agreeing with them that confusion does not and is not likely to exist. Section 2(d) should be construed *in pari materia* with the rest of the Act and the historical policies known to underlie it. Those policies were not served by the independent, misguided efforts of the board to take it upon itself to prove facts, quite unnecessarily and by reasoning entirely on its own, to establish a case of likelihood of confusion when not asked to do so.

Id. at 1778-79. The Bongrain rationale applies to the present facts. The parties have carefully assessed the conditions in the marketplace, and have determined that the coexistence of the respective marks is unlikely to confuse purchasers.

The attached Consent demonstrates that the parties’ marks are not likely to be confused. The parties, who are most familiar with the marketplace, have determined that the differences between their respective marks and goods, and circumstances of use will render confusion unlikely and will protect both parties’ interests.

In view of the arguments presented herein, Applicant respectfully requests that the instant application be promptly passed to publication.

EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	<u>evi_76748130-101012254 . SCIELO Consent Agreement.pdf</u>
CONVERTED PDF FILE(S) (2 pages)	<u>\\TICRS\EXPORT16\IMAGEOUT16\852\836\85283635\xml1\RFR0002.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT16\852\836\85283635</u>

	\xml1\RFR0003.JPG
DESCRIPTION OF EVIDENCE FILE	Consent to Registration Agreement
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Jaye S Campbell/
SIGNATORY'S NAME	Jaye S. Campbell
SIGNATORY'S POSITION	Associate Attorney of Record, DC Bar member
DATE SIGNED	07/30/2012
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Jul 30 10:14:46 EDT 2012
TEAS STAMP	USPTO/RFR-76.74.8.130-201 20730101446994523-8528363 5-49093af49ce4e229c98adb5 8d46f6e0cf3-N/A-N/A-20120 730101012254102

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To the Commissioner for Trademarks:

Application serial no. **85283635** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

In response to the Final Action issued January 31, 2012, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's Ser. No. 85/283635 – SCILEO on the ground that it is likely to be confused with Reg. Nos. 3314557 – SCIELE, 3332555 – SCIELE PHARMA, INC. & Design, and 3756644 – SCIELE PHARMA, INC. A SHINOGI COMPANY & Design, all owned by Shionogi Pharma, Inc. (the "Registrant").

Attached is a Consent to Registration (“Consent”) dated July 25, 2012 signed by Registrant’s authorized signatory. The attached Consent shows that Applicant and Registrant have conferred regarding their respective use and registration of their respective SCIELO and SCIELE marks, and believe that confusion is not likely in view of the specific differences between the parties’ marks and goods, the sophistication of the parties’ purchasers, and the different circumstances in which the marks are and will be used. Because the parties have reached an agreement that they believe will avoid any likelihood of confusion, mistake, or deception, the Examining Attorney should withdraw the refusal to register Applicant’s Mark.

In cases such as this, examining attorneys are instructed to give “great weight” to a consent agreement. T.M.E.P. § 1207.01(d)(viii). The role of the Trademark Office is not to “deny registration if it feels there is, by its independent determination, any likelihood of confusion of any kind as between the mark sought to be registered and the prior registration, without regard to the desires, opinions, or agreements of the owner of the prior registration. . . .” In re National Distillers and Chem. Corp., 132 U.S.P.Q. 271, 277 (C.C.P.A. 1962) (Rich, J., concurring). Rather, the Trademark Office “must count on the self-interest of trademark owners to do that.” In re Four Seasons Hotels Ltd., 26 U.S.P.Q.2d 1071, 1072 (Fed. Cir. 1993) (quoting In re National Distillers and Chem. Corp., 132 U.S.P.Q. at 279).

Moreover, the United States Court of Appeals for the Federal Circuit has expressly recognized that it is improper for the Office to substitute its judgment for that of the mark owners. In Bongrain Int’l Corp. v. Delice de France, Inc., 1 U.S.P.Q.2d 1775 (Fed. Cir. 1987), the Federal Circuit stated:

We have often said, in trademark cases involving agreements reflecting parties’ views on the likelihood of confusion in the marketplace, that they are in a much better position to know the real life situation than bureaucrats or judges and therefore such agreements may, depending on the circumstances, carry great weight, as was held in DuPont...

It is possible to preserve the registrations, as the parties originally agreed to do, by accepting their reasonable appraisal of marketplace conditions, and agreeing with them that confusion does not and is not likely to exist. Section 2(d) should be construed *in pari materia* with the rest of the Act and the historical policies known to underlie it. Those policies were not served by the independent, misguided efforts of the board to take it upon itself to prove facts, quite unnecessarily and by reasoning entirely on its own, to establish a case of likelihood of confusion when not asked to do so.

Id. at 1778-79. The Bongrain rationale applies to the present facts. The parties have carefully assessed the conditions in the marketplace, and have determined that the coexistence of the respective marks is

unlikely to confuse purchasers.

The attached Consent demonstrates that the parties' marks are not likely to be confused. The parties, who are most familiar with the marketplace, have determined that the differences between their respective marks and goods, and circumstances of use will render confusion unlikely and will protect both parties' interests.

In view of the arguments presented herein, Applicant respectfully requests that the instant application be promptly passed to publication.

EVIDENCE

Evidence in the nature of Consent to Registration Agreement has been attached.

Original PDF file:

[evi_76748130-101012254_SCIELO_Consent_Agreement.pdf](#)

Converted PDF file(s) (2 pages)

[Evidence-1](#)

[Evidence-2](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Jaye S Campbell/ Date: 07/30/2012

Signatory's Name: Jaye S. Campbell

Signatory's Position: Associate Attorney of Record, DC Bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85283635

Internet Transmission Date: Mon Jul 30 10:14:46 EDT 2012

TEAS Stamp: USPTO/RFR-76.74.8.130-201207301014469945

23-85283635-49093af49ce4e229c98adb58d46f

6e0cf3-N/A-N/A-20120730101012254102

CONSENT TO REGISTRATION AGREEMENT

Janssen R&D Ireland, an Ireland Corporation, having a principal address at Eastgate Village, Eastgate, Little Island Co. Cork, Ireland ("Janssen R&D") has applied to register with the Patent and Trademark Office ("PTO") the mark SCIELO, Ser. No. 85/283,635 for "human pharmaceuticals for the treatment of infectious-related disease, auto-immune and inflammatory diseases, cardiovascular diseases, central nervous system diseases and pain, dermatologic disorders, metabolic diseases, anti-viral diseases, oncologic diseases, respiratory diseases, ophthalmic diseases, muscle dystonias, wrinkles and smooth muscle disorders, gastro-intestinal diseases; Human pharmaceuticals for use as hemostatic agents" in Class 5.

Shionogi Pharma Inc., a Delaware corporation, having a principal address at Five Concourse Parkway, Suite 1800, Atlanta, Georgia ("Shionogi") has adopted and registered with the PTO the marks set out in Exhibit A hereto.

The parties have exchanged facts and information and believe that the coexistence of their respective marks is not likely to cause confusion in view of the specific differences between the parties' marks and goods, the sophisticated nature of the relevant purchasers and the different circumstances in which the marks are/will be used.

Shionogi hereby consents to the use and registration of the mark SCIELO by Janssen R&D for the goods identified in Ser. No. 85/283,635.

The parties agree to cooperate with one another in the unlikely event that instances of confusion may later arise and to take such steps as may be required to avoid any instances of actual confusion between the marks that may arise in the future.

SHIONOGI INC.

By: 

Name: Gregory Clarkie

Title: Associate General Counsel

Date: 25 July 2011

Exhibit A



1. Reg. No. 3756644 -- for house mark for a full line of pharmaceutical preparations, dietetic and nutritional substances for medical use and vitamins; prescription pharmaceutical preparations for humans, namely, pain medications, antihistamines, decongestants, eardrops, liquid antitussives, cardiovascular and cardiology medications, preparations for treating metabolic disorders, anticholinergics, preparations for treating gastroenterology conditions, preparations for treating neurology conditions including dementia, preparations for treating urinary tract infections, preparations for treating osteoporosis and preparations for treating women's health, prenatal vitamins and menstrual pain relief medications; pharmaceutical preparations for treating infectious diseases and immunological disorders, cancer and related chronic pain; registered on March 9, 2010; based on use in commerce since November 1, 2008;



2. Reg. No. 3332555 -- for house mark for a full line of pharmaceutical preparations, dietetic and nutritional substances for medical use and vitamins; prescription pharmaceutical preparations for humans, namely, pain medications, antihistamines, decongestants, eardrops, liquid antitussives, cardiovascular and cardiology medications, preparations for treating metabolic disorders, anticholinergics, preparations for treating gastroenterology conditions, preparations for treating neurology conditions including dementia, preparations for treating urinary tract infections, preparations for treating osteoporosis and preparations for treating women's health, prenatal vitamins and menstrual pain relief medications; registered on November 6, 2007; based on use in commerce since July 1, 2006; and
3. Reg. No. 3314557 – SCIELE for house mark for a full line of pharmaceutical preparations, dietetic and nutritional substances for medical use and vitamins; prescription pharmaceutical preparations for humans, namely, pain medications, antihistamines, decongestants, eardrops, liquid antitussives, cardiovascular and cardiology medications, preparations for treating metabolic disorders, anticholinergics, preparations for treating gastroenterology conditions, preparations for treating neurology conditions including dementia, preparations for treating urinary tract infections, preparations for treating osteoporosis and preparations for treating women's health, prenatal vitamins and menstrual pain relief medications; registered on October 16, 2007; based on use in commerce since July 1, 2006.