From: Hetzel, Dannean

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Subject: U.S. TRADEMARK APPLICATION NO. 86738436 - NIKKEN - 8047.312 - Request for Reconsideration Denied - Return to TTAB

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

U.S. APPLICATION SERIAL NO. 86738436

MARK: NIKKEN

CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

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APPLICANT: Nikken International, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

8047.312

CORRESPONDENT E-MAIL ADDRESS:

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 12/22/2016

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The refusal under Section 2(d) with respect to U.S. Reg. Nos. 2030997, 2030996, and 4244835 is maintained. The amended identification of services refusal is also maintained. The substitute specimen submitted is acceptable and that refusal is now withdrawn. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

Section 2(d) Refusal

In applicant's request for reconsideration, applicant submitted evidence of ownership by assignment for U.S. Reg. Nos. 1603794, 1600646, 1603792, and 1599463. Thus, the refusal under Section 2(d) now only applies to U.S. Reg. Nos. 2030997, 2030996, and 4244835. Applicant submitted arguments in favor of registration; however, the examining attorney is not persuaded.

Applicant first argued that the cited marks created a different commercial impression from applicant's mark. Specifically, applicant stated that the descriptive elements EPA CAP and DHS CAP, were the dominant elements of registrant's marks in U.S. Reg. Nos. 2030997 and 2030996. Resp. at 5. The examining attorney respectfully disagrees. These marks are similar to applicant's mark because they share the identical word NIKKEN. The terms EPA CAP and DHA CAP are both disclaimed in registrant's marks making NIKKEN the dominant element. Because this dominant element is identical to registrant's mark, they create a similar overall commercial impression. And in U.S. Reg. No. 4244835, registrant's mark is literally identical.

Applicant next asserted the goods and services were not related and submitted evidence of actual use registrants' goods and applicant's services. Applicant also argued that registrants' goods are not featured in applicant's services. Resp. at 7-9. The examining attorney is not persuaded by this argument. First, applicant's services feature registrant's goods in U.S. Reg. Nos. 2030997 and 2030996, namely supplements. And in U.S. Reg. No. 4244835, registrant provides food seasonings and applicant's services feature groceries and food. Thus, the goods in the cited registrations all appear in applicant's services. Moreover, applicant's extrinsic evidence of use is not persuasive in this argument. When analyzing an applicant's and registrant's goods and/or services for similarity and relatedness, that 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).

Identification of Goods Requirement

The amended identification of services remains unacceptable because it exceeds the scope of the original wording. In the May 26, 2016 Final Office action, applicant was advised that the original

wording limited the business information services to being provided on computer networks and global communication networks as well as being limited to small businesses. In applicant's request for reconsideration, applicant failed to include these limitations to the business information services.

Guidelines

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

/Dannean J Hetzel/

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