

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	87155858
LAW OFFICE ASSIGNED	LAW OFFICE 122
MARK SECTION	
MARK	https://tmng-al.uspto.gov/resting2/api/img/87155858/large
LITERAL ELEMENT	INQUIRE
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.

ARGUMENT(S)

Pursuant to Section 715.03 of the Trademark Manual of Examining Procedure (“TMPEP”) and 37 C.F.R. § 2.62 (b) (3), 64 (b), Applicant Astellas US LLC (“Astellas” or “Applicant”) hereby requests that the Examining Attorney reconsider and withdraw her final refusal to register on the Principal Register Astellas’s mark INQUIRE (Serial No. 87/155,858). This Request for Reconsideration is being filed simultaneously with the filing with the Trademark Trial and Appeal Board (“TTAB”) of a Notice of Appeal of the Examining Attorney’s Final Office Action. Astellas’s INQUIRE application covers “medical and scientific research, namely, conducting clinical trials in the fields of antifungal preparations and infectious diseases; and provision of medical and scientific research information in the field of pharmaceuticals and clinical trials relating to antifungal preparations and infectious diseases,” in Class 42.

By amendment requested herein, Astellas hereby amends the description of services in its INQUIRE application to the following: “medical and scientific research, namely, conducting clinical trials in the fields of antifungal preparations and infectious diseases, namely, rare moulds; and provision of medical and scientific research information relating to said clinical trials for use by experts in the fields of pharmaceuticals and clinical trials and medical professionals,” in Class 42 (“Amended Services”).

The Examining Attorney has refused registration of Astellas’s INQUIRE mark on the ground that the mark, when used to identify the services covered by the subject application, is likely to be confused with the existing registration INQUIRELABS (Reg. No. 4888626) owned by Health One, Inc. Health One’s registration covers “medical testing for diagnostic or treatment purposes,” in Class 44.

In her Final Office Action, the Examining Attorney dismissed Astellas’s arguments that the marks INQUIRE and INQUIRELABS are not confusingly similar in light of (i) the presence of the term “Labs” in Health One’s mark, which sufficiently distinguishes Health One’s mark from Astellas’s mark; (ii) the weakness of the term “Inquire” when used to identify medical-related services as evidenced by third-party registrations as well as extensive use by third parties in connection with medical-related services; and (iii) the high level of sophistication and care that is exercised by those who would enroll in clinical trials for testing the efficacy of antifungal preparations for the treatment of serious infectious diseases.

This Request for Reconsideration seeks amendment of the description of services in Astellas’s INQUIRE application and addresses the Examining Attorney’s response to Astellas’s arguments as applied to the Amended Services.

A. Applicant’s Mark INQUIRE is Sufficiently Different from Health One’s INQUIRELABS Mark to Obviate Any Likelihood of Confusion.

Astellas respectfully submits that the Examining Attorney did not consider all relevant facts when she reiterated her position that the marks INQUIRE and INQUIRELABS are confusingly similar. The Examining Attorney’s failure to give any weight to the “Labs” portion of Health One’s mark INQUIRELABS and her continued focus solely on the “Inquire” element in Astellas’s and Health One’s respective marks reflects the same approach that the TTAB had used and that the Federal Circuit had chastised in *Packard Press, Inc. v. Hewlett-*

Packard Company, 227 F.3d 1352 (Fed. Cir. 2000). In that case, the TTAB had found that PACKARD PRESS and HEWLETT-PACKARD were confusingly similar solely because of the presence of the word “Packard” in both marks. The Federal Circuit reversed, finding that the TTAB had improperly dissected the marks when it considered only the “Packard” portion of both marks and “completely failed to consider the appearance and sound of the mark as a whole.” 227 F.3d at 1357. The Federal Circuit held that “[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.” *Id.* at 1357.

Consistent with the Federal Circuit’s test set forth in *Packard Press, Inc. v. Hewlett-Packard Company*, the PTO did not find the pending application for NquIRE (Serial No. 86/384,624) to be confusingly similar to Health One’s INQUIRELABS mark even though NquIRE sounds identical to INQUIRE and identifies medical services that are more closely related to those provided by Health One than are clinical trials for assessing the efficacy of pharmaceuticals for the treatment of rare moulds.

Astellas’s mark INQUIRE, when used to identify the Amended Services, conveys the meaning and commercial impression of investigating assessing the efficacy of pharmaceuticals for the treatment of rare moulds. Health One’s INQUIRELABS, on the other hand, conveys healthcare services rendered to individuals in the nature of medical and diagnostic testing by laboratories.

B. Health One’s Mark INQUIRELABS is Weak and is Entitled to a Narrow Scope of Protection.

In her Final Office Action, the Examining Attorney failed to consider any of the evidence of third-party use of INQUIRE and INQUIRE-formative marks that Astellas had filed with its April 10, 2017 Response to Office Action, which evidence demonstrates the weakness of Health One’s mark INQUIRELABS and the narrow scope of protection to which it is entitled. Exhibit B to that response listed examples of use of such marks that identify medical-related services along with evidence of such use. As the Examining Attorney noted in her Final Office Action, “the widespread use of the Internet in the United States suggests that Internet evidence may be probative of public perception in trademark examination.” Astellas hereby requests that the Examining Attorney consider such third-party evidence of INQUIRE and INQUIRE-formative marks as required by *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973).

C. Astellas’s and Health One’s Respective Services are Sufficiently Different to Obviate Any Likelihood of Confusion, Particularly in Light of the High Degree of Care and Sophistication Required in Connection with Astellas’s Amended Services.

Astellas’s Amended Services and Health One’s services are sufficiently different. Astellas’s INQUIRE mark identifies specific and limited scientific research services -- clinical trials for testing the efficacy of antifungal preparations for the treatment of rare moulds and providing medical and scientific research information relating to said clinical trials for use by experts in the fields of pharmaceuticals and clinical trials and medical professionals. Participants in the INQUIRE clinical trials are limited to patients who have been diagnosed with infections caused by certain rare moulds, which infections can be life-threatening and particularly in patients with underlying illnesses. In addition, Astellas’s INQUIRE mark identifies the provision of medical and scientific research information relating to said clinical trials for use by highly sophisticated and knowledgeable professionals who are highly unlikely to be confused as to the source of the clinical trials and clinical trial information provided by Astellas under the INQUIRE mark and the laboratory testing services available to individuals under Health One’s INQUIRELABS mark. Moreover, the likelihood that anyone who uses, or considers using, Health One’s INQUIRELABS laboratory services would be confused with Astellas’s INQUIRE clinical trial services and the provision of medical and scientific research information relating to such clinical trials is highly unlikely. Indeed, the number of such individuals who might use, or be aware of, Health One’s INQUIRELABS laboratory services and who (i) would be aware of Astellas’s services provided under its INQUIRE marks, and (ii) not highly sophisticated professionals in the pharmaceutical, clinical trials, or medical fields, is exceedingly low.

Accordingly, for the foregoing reasons, Astellas respectfully requests that the Examining Attorney accept the amendment of the description of services for its INQUIRE application and withdraw her refusal to register INQUIRE on the Principal Register.

GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	042
DESCRIPTION	
Medical and scientific research, namely, conducting clinical trials in the fields of antifungal preparations and infectious diseases; and provision of medical and scientific research information in the field of pharmaceuticals and clinical trials relating to antifungal preparations and infectious diseases	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	042
TRACKED TEXT DESCRIPTION	
Medical and scientific research, namely, conducting clinical trials in the fields of antifungal preparations and infectious diseases; medical and	

scientific research, namely, conducting clinical trials in the fields of antifungal preparations and infectious diseases, namely, rare moulds; and provision of medical and scientific research information in the field of pharmaceuticals and clinical trials relating to antifungal preparations and infectious diseases; and provision of medical and scientific research information relating to said clinical trials for use by experts in the fields of pharmaceuticals and clinical trials and medical professionals

FINAL DESCRIPTION

medical and scientific research, namely, conducting clinical trials in the fields of antifungal preparations and infectious diseases, namely, rare moulds; and provision of medical and scientific research information relating to said clinical trials for use by experts in the fields of pharmaceuticals and clinical trials and medical professionals

FILING BASIS

Section 1(b)

SIGNATURE SECTION

RESPONSE SIGNATURE

/KathleenGallagher-Duff/

SIGNATORY'S NAME

Kathleen Gallagher-Duff

SIGNATORY'S POSITION

Attorney of Record, member of the DC bar

SIGNATORY'S PHONE NUMBER

n/a

DATE SIGNED

10/25/2017

AUTHORIZED SIGNATORY

YES

CONCURRENT APPEAL NOTICE FILED

NO

FILING INFORMATION SECTION

SUBMIT DATE

Wed Oct 25 16:38:25 EDT 2017

TEAS STAMP

USPTO/RFR-XXX.XXX.XXX.XXX
-20171025163825707943-871
55858-510c5f84a42bd96b229
6ed581e3ce335814a0979219a
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N/A-20171025162345875112

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PTO Form 1960 (Rev 10/2011)
OMB No. 0651-0050 (Exp 09/20/2020)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **87155858** INQUIRE(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/87155858/large>) has been amended as follows:

ARGUMENT(S)

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

Pursuant to Section 715.03 of the Trademark Manual of Examining Procedure (“TMEP”) and 37 C.F.R. § 2.62 (b) (3), 64 (b), Applicant Astellas US LLC (“Astellas” or “Applicant”) hereby requests that the Examining Attorney reconsider and withdraw her final refusal to register on the Principal Register Astellas’s mark INQUIRE (Serial No. 87/155,858). This Request for Reconsideration is being filed simultaneously with the filing with the Trademark Trial and Appeal Board (“TTAB”) of a Notice of Appeal of the Examining Attorney’s Final Office Action. Astellas’s INQUIRE application covers “medical and scientific research, namely, conducting clinical trials in the fields of antifungal preparations and infectious diseases; and provision of medical and scientific research information in the field of pharmaceuticals and clinical trials relating to antifungal preparations and infectious diseases,” in Class 42.

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provision of medical and scientific research information relating to said clinical trials for use by experts in the fields of pharmaceuticals and clinical trials and medical professionals,” in Class 42 (“Amended Services”).

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Consistent with the Federal Circuit’s test set forth in *Packard Press, Inc. v. Hewlett-Packard Company*, the PTO did not find the pending application for Nquire (Serial No. 86/384,624) to be confusingly similar to Health One’s INQUIRELABS mark even though Nquire sounds identical to INQUIRE and identifies medical services that are more closely related to those provided by Health One than are clinical trials for assessing the efficacy of pharmaceuticals for the treatment of rare moulds.

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B. Health One’s Mark INQUIRELABS is Weak and is Entitled to a Narrow Scope of Protection.

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INQUIRELABS mark. Moreover, the likelihood that anyone who uses, or considers using, Health One's INQUIRELABS laboratory services would be confused with Astellas's INQUIRE clinical trial services and the provision of medical and scientific research information relating to such clinical trials is highly unlikely. Indeed, the number of such individuals who might use, or be aware of, Health One's INQUIRELABS laboratory services and who (i) would be aware of Astellas's services provided under its INQUIRE marks, and (ii) not highly sophisticated professionals in the pharmaceutical, clinical trials, or medical fields, is exceedingly low.

Accordingly, for the foregoing reasons, Astellas respectfully requests that the Examining Attorney accept the amendment of the description of services for its INQUIRE application and withdraw her refusal to register INQUIRE on the Principal Register.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 042 for Medical and scientific research, namely, conducting clinical trials in the fields of antifungal preparations and infectious diseases; and provision of medical and scientific research information in the field of pharmaceuticals and clinical trials relating to antifungal preparations and infectious diseases

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed:

Tracked Text Description: ~~Medical and scientific research, namely, conducting clinical trials in the fields of antifungal preparations and infectious diseases; and provision of medical and scientific research information in the field of pharmaceuticals and clinical trials relating to antifungal preparations and infectious diseases;~~ medical and scientific research, namely, conducting clinical trials in the fields of antifungal preparations and infectious diseases, namely, rare moulds; and provision of medical and scientific research information relating to said clinical trials for use by experts in the fields of pharmaceuticals and clinical trials and medical professionals

Class 042 for medical and scientific research, namely, conducting clinical trials in the fields of antifungal preparations and infectious diseases, namely, rare moulds; and provision of medical and scientific research information relating to said clinical trials for use by experts in the fields of pharmaceuticals and clinical trials and medical professionals

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /KathleenGallagher-Duff/ Date: 10/25/2017

Signatory's Name: Kathleen Gallagher-Duff

Signatory's Position: Attorney of Record, member of the DC bar

Signatory's Phone Number: n/a

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 owner's/holder'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 owner/holder in this matter: (1) the owner/holder 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 owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder'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 not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 87155858

Internet Transmission Date: Wed Oct 25 16:38:25 EDT 2017

TEAS Stamp: USPTO/RFR-XXX.XXX.XXX.XXX-20171025163825

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