

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	87218360
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION	
MARK	https://tmng-al.uspto.gov/resting2/api/img/87218360/large
LITERAL ELEMENT	PAKSCAN
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)	
Please see the remarks and the exhibit attached in the evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_7010273244-20190930185102813888_ . Remarks in Response to Office action for filing .pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT17\IMAGEOUT17\872\183\87218360\xml15\RFR0002.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\872\183\87218360\xml15\RFR0003.JPG
ORIGINAL PDF FILE	evi_7010273244-20190930185102813888_ . Exhibit A.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT17\IMAGEOUT17\872\183\87218360\xml15\RFR0004.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\872\183\87218360\xml15\RFR0005.JPG
DESCRIPTION OF EVIDENCE FILE	Remarks and Exhibit
ATTORNEY SECTION (current)	
NAME	B. Anna McCoy
ATTORNEY BAR MEMBERSHIP NUMBER	NOT SPECIFIED
YEAR OF ADMISSION	NOT SPECIFIED
U.S. STATE/ COMMONWEALTH/ TERRITORY	NOT SPECIFIED
FIRM NAME	McCoy Russell LLP
INTERNAL ADDRESS	Suite 600
STREET	806 SW Broadway
CITY	Portland
STATE	Oregon

POSTAL CODE	97205
COUNTRY	US
PHONE	5034594141
FAX	5034594142
EMAIL	TMmail@ahmrt.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
DOCKET/REFERENCE NUMBER	WYN16410
ATTORNEY SECTION (proposed)	
NAME	B. Anna McCoy
ATTORNEY BAR MEMBERSHIP NUMBER	XXX
YEAR OF ADMISSION	XXXX
U.S. STATE/ COMMONWEALTH/ TERRITORY	XX
FIRM NAME	McCoy Russell LLP
INTERNAL ADDRESS	Suite 600
STREET	806 SW Broadway
CITY	Portland
STATE	Oregon
POSTAL CODE	97205
COUNTRY	United States
PHONE	9712718020
FAX	9712718021
EMAIL	TMmail@mccrus.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
DOCKET/REFERENCE NUMBER	WYN16410
OTHER APPOINTED ATTORNEY	John D. Russell, Xiaohong Ding, Donald Lewis
CORRESPONDENCE SECTION (current)	
NAME	B. ANNA MCCOY
FIRM NAME	McCoy Russell LLP
INTERNAL ADDRESS	Suite 600
STREET	806 SW Broadway
CITY	Portland
STATE	Oregon
POSTAL CODE	97205
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AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
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AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
DOCKET/REFERENCE NUMBER	WYN16410
SIGNATURE SECTION	
RESPONSE SIGNATURE	/B. Anna McCoy/
SIGNATORY'S NAME	B. Anna McCoy
SIGNATORY'S POSITION	Attorney for Applicant, Oregon Bar Member
SIGNATORY'S PHONE NUMBER	9712718020
DATE SIGNED	09/30/2019
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Sep 30 21:34:46 EDT 2019
TEAS STAMP	USPTO/RFR-XX.XXX.XX.XXX-2 0190930213446891460-87218 360-610d9322b117fdfa37e5c 22effc6ffdefa96134a867d16 74ab7cf2f433186b6ef3-N/A- N/A-20190930204526464398

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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. **87218360** PAKSCAN(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/87218360/large>) has been amended as follows:

ARGUMENT(S)

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

Please see the remarks and the exhibit attached in the evidence section.

EVIDENCE

Evidence in the nature of Remarks and Exhibit has been attached.

Original PDF file:

[evi_7010273244-20190930185102813888_.Remarks_in_Response_to_Office_action_for_filing_.pdf](#)

Converted PDF file(s) (2 pages)

[Evidence-1](#)

[Evidence-2](#)

Original PDF file:

[evi_7010273244-20190930185102813888_.Exhibit_A.pdf](#)

Converted PDF file(s) (2 pages)

[Evidence-1](#)

[Evidence-2](#)

The applicant's current attorney information: B. Anna McCoy. B. Anna McCoy of McCoy Russell LLP, is located at

Suite 600
806 SW Broadway
Portland, Oregon 97205
US

The docket/reference number is WYN16410.

The phone number is 5034594141.

The fax number is 5034594142.

The email address is TMmail@ahmrt.com

The applicants proposed attorney information: B. Anna McCoy. Other appointed attorneys are John D. Russell, Xiaohong Ding, Donald Lewis. B. Anna McCoy of McCoy Russell LLP, is a member of the XX bar, admitted to the bar in XXXX, bar membership no. XXX, and the attorney(s) is located at

Suite 600
806 SW Broadway
Portland, Oregon 97205
United States

The docket/reference number is WYN16410.

The phone number is 9712718020.

The fax number is 9712718021.

The email address is TMmail@mccrus.com

B. Anna McCoy submitted the following statement: The attorney of record is an active member in good standing of the bar of the highest court of a U.S. state, the District of Columbia, or any U.S. Commonwealth or territory.

The applicant's current correspondence information: B. ANNA MCCOY. B. ANNA MCCOY of McCoy Russell LLP, is located at

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806 SW Broadway
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US

The docket/reference number is WYN16410.

The phone number is 971-271-8020.

The fax number is 971-271-8021.

The email address is TMmail@mccrus.com; mercer@mccrus.com; mccooy@mccrus.com; meng@mccrus.com; penfield@mccrus.com

The applicants proposed correspondence information: B. Anna McCoy. B. Anna McCoy of McCoy Russell LLP, is located at

Suite 600
806 SW Broadway
Portland, Oregon 97205
United States

The docket/reference number is WYN16410.

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SIGNATURE(S)

Request for Reconsideration Signature

Signature: /B. Anna McCoy/ Date: 09/30/2019

Signatory's Name: B. Anna McCoy

Signatory's Position: Attorney for Applicant, Oregon Bar Member

Signatory's Phone Number: 9712718020

The signatory has confirmed that he/she is a U.S.-licensed attorney who is an active member in good standing of the bar of the highest court of a U.S. state (including the District of Columbia and any U.S. Commonwealth or territory); 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.-licensed attorney not currently associated with his/her company/firm previously represented the owner/holder in this matter: the owner/holder has revoked their power of attorney by a signed revocation or substitute power of attorney with the USPTO; the USPTO has granted that attorney's withdrawal request; the owner/holder has filed a power of attorney appointing him/her in this matter; or the owner's/holder's appointed U.S.-licensed attorney 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.

Mailing Address: B. ANNA MCCOY
McCoy Russell LLP
Suite 600
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Portland, Oregon 97205

Mailing Address: B. Anna McCoy
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Serial Number: 87218360

Internet Transmission Date: Mon Sep 30 21:34:46 EDT 2019

TEAS Stamp: USPTO/RFR-XX.XXX.XX.XXX-2019093021344689

1460-87218360-610d9322b117fdfa37e5c22eff

c6ffdefa96134a867d1674ab7cf2f433186b6ef3

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Rotork PLC
Application No. : 87/218,360
Filed : October 27, 2016
Mark : PAKSCAN
International Class : 009, 037
Examining Attorney : Caroline E. Wood
Law Office : 110
Docket No. : WYN16410
Date : September 30, 2019

Request for Reconsideration

This response is being submitted in reply to the final Office Action dated April 1, 2019. Applicant thanks the Examining Attorney for diligent examination of this application. In the final Office action mailed April 1, 2019, the Examining Attorney maintained the partial refusal of registration of the applied-for mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) and TMEP §§1207.01 et seq. based on an assertion that Applicant's mark, when used on the recited goods "data recording and analysis software" in class 9, is likely to be confused with the registered mark in U.S. Reg. No. 1502864 owned by Mitutoyo Corporation for the recited goods "computer software programs sold in conjunction with computer-controlled coordinate measuring machines for analysis of measurement data" in class 9.

In response, Applicant hereby submits a Letter of Consent (Exhibit A) executed by Applicant and Mitutoyo Corporation for the subject application. As provided in the Letter of Consent, Applicant and Mitutoyo Corporation believe that there is no likelihood of confusion or conflict in regards to Applicant's use of PAKSCAN for the goods and services recited in the subject application and Mitutoyo Corporation's use of SCANPAK for the goods recited in the cited registration, based on the following factors: (1) differences in the parties' respective marks, PAKSCAN and SCANPAK; (2) differences in the parties' respective goods and services in the valve actuator and flow control industry versus the precision metrology industry; and (3) differences in the specific trade channels and target consumer audience. Therefore, as provided in the Letter

of Consent, Mitutoyo Corporation consents to registration of the subject application for the goods and services recited therein.

The Federal Circuit has indicated that consent agreements should be given great weight, and that the USPTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other relevant factors clearly dictate a finding of likelihood of confusion. *See, e.g., In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993); *see also* TMEP 1207.01(d) (viii). In light of the executed Letter of Consent that outlines specific reasons why the parties believe there is no likelihood of confusion, Applicant respectfully requests that the partial refusal based on U.S. Reg. No. 1502864 be withdrawn.

Applicant believes the application is now in condition for allowance and forwarding of the application to publication for the purpose of opposition is respectfully requested. The Examining Attorney is encouraged to telephone the undersigned if a telephonic interview would be helpful to a prompt publication of the application.

Respectfully Submitted,

B. Anna McCoy

McCoy Russell LLP

LETTER OF CONSENT

Rotork PLC, a public limited company organized under the laws of the United Kingdom, with offices located at Rotork House, Brassmill Lane, Bath, BA13JQ UNITED KINGDOM ("Rotork"), owns the following application:

Mark: PAKSCAN

Ser. No.: 87/218,360

Class 9: Measuring, detecting, signalling and monitoring instruments, indicators and controllers, namely electronic devices; electric and electronically controlled valves for controlling gas or fluids; electric control and regulating valves for monitoring, controlling and regulating fluid and gas flow; solenoid valves; automatically actuated valves; control valves for the pressure and flow of fluid and gas; remote control apparatus for effecting the automatic opening and closure of valves and actuators; gauges namely pressure, level and vacuum gauges; sensors and detectors namely pressure sensors; monitoring sensors namely for monitoring the pressure and flow or fluid and gas; monitoring sensors of the positioning of machine actuators and valves; modulating sensors for monitoring fluid and gas; electric switches and binary switches for controlling pressure, delta pressure, temperature, humidity, gases, mists, vapor and dust; electric switch boxes; electronic regulators for monitoring and controlling gas pressure and fluid flow; safety and releasable electric locking devices; electric relays; pneumatic relays; electrical transducers; parts of the mentioned above appliances, devices and instruments; electric data processing equipment, in particular apparatus for the input, transmission, storage and output of data; Data processing programs and software; integrated circuits and semiconductors; junction sleeves for electric cable; holders for electric coils; choking coils for use in electrical apparatus; electrical sockets;

electric plugs; electric switches; electric control panels; electromagnetic coils; connections for electric lines; computer hardware and software for effecting the automatic opening and closure of valves and actuators; computer hardware and software for processing and monitoring machine actuators and valves; monitoring system, comprised of computer monitors, alarms and sensors, for remote control safety apparatus; monitoring system comprised of computer monitors, alarms and sensors for process and network maintenance; monitoring system comprised of computer monitors, alarms and sensors for remote control data analysis software; data recording and analysis software; monitoring system comprised of computer monitors, alarms and sensors for data recording and analysis software; remote control alert system; monitoring system comprised of computer monitors, alarms and sensors for remote control alert system; electric actuator for communication; monitoring system comprised of computer monitors, alarms and sensors for actuator communication technology

Class 37: Maintenance, installation and repair of control and fail safe apparatus and installations, including valves, motorized valves and light mechanisms for use in pipelines and channels, particularly in the chemical, petrochemical, water and waste and power generating industries, control and fail safe apparatus and installations for industrial processes, electronic assemblies, computer hardware for monitoring and controlling industrial processes, control apparatus and installations including electrical/electronic means for controlling the operating of moveable equipment and mechanisms, including valves, motorized valves and light mechanisms for use in pipelines and channels, and of parts and fittings for the aforesaid goods

Rotork is entering an amendment to Ser. No. 87/218,360 as to the following goods in class 9: “Measuring, detecting, signalling and monitoring instruments, indicators and controllers, namely electronic devices in the nature of devices for monitoring, controlling, and regulating the flow of fluid, gas and powders”

Mitutoyo Corporation, a corporation organized under the laws of Japan, with offices located at 20-1, Sakado 1-Chome, Takatsu-ku, Kawasaki, JAPAN (“Mitutoyo”), owns the following registration:

Mark: SCANPAK

Reg. No.: 1,502,864

Class 9: Computer software programs sold in conjunction with computer-controlled coordinate measuring machines for analysis of measurement data

The parties believe that there is no likelihood of confusion or conflict between the parties’ registration of the marks listed above, based in part on differences in the parties’ respective marks, differences in the parties’ respective goods and services in the valve actuator and flow control industry versus the precision metrology industry, and the differences in the specific channels of trade and consumer audience to which each party markets and sells its services.

Mitutoyo consents to Rotork’s registration of the mark shown in Ser. Nos. 87/218,360 for the goods and services recited therein.

Mitutoyo Corporation

/

By: Haruo Tsuruoka

Name: Haruo Tsuruoka

Title: Executive Officer

Date: March 11, 2019