

04-28-2003

U.S. Patent & TMOfo/TM Mail Rcpt. Dt. #40

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

63 JUL-3 10 51 3

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G.D. Searle & Co.

Opposer,

Opposition No.: 118,621

v.

Ser. No.: 75/498,497

BioMarine Ltd.

Mark: SEARX

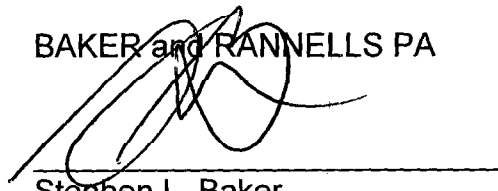
Applicant.
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**MOTION TO SUSPEND AND FOR APPROVAL OF AMENDMENT TO THE
PRESENTATION OF APPLICANT'S MARK PURSUANT TO TBMP 605.03(b)**

The parties have reached a tentative settlement contingent upon the Applicant filing a request to amend the presentation of its mark, and upon the acceptance of the amendment by the USPTO. A copy of the executed Settlement Agreement is annexed as Exhibit 1. Annexed as Exhibit 2 is a request to amend the presentation of the mark as required by the Settlement Agreement.

Respectfully submitted,

BAKER and RANNELLS PA




Stephen L. Baker
Attorney for Applicant
626 North Thompson Street
Raritan, New Jersey 08869
908-722-5640

Dated: April 23, 2003

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the MOTION TO SUSPEND AND FOR APPROVAL OF AMENDMENT TO THE PRESENTATION OF APPLICANT'S MARK PURSUANT TO TBMP 605.03(b) in re G.D. Searle. v. BioMarine Ltd. Opposition No. 118,621 was forwarded by first class postage pre-paid mail by depositing the same with the U.S. Postal Service on this 23rd day of April, 2003 to the attorneys for the Opposer at the following addresses:

FULBRIGHT & JAWORSKI L.L.P.
Attn: J. Paul Williamson
801 Pennsylvania Avenue, NW
Washington, D.C. 20004



Stephen L. Baker

DATED: April 23, 2003

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202.

Date of deposit: April 23, 2003

Name of Applicant, Assignee,
or Registered Representative: Stephen L Baker

Signature: _____

Date of Signature: April 23, 2003

SETTLEMENT AGREEMENT

This Agreement is made by and between G.D. SEARLE & CO., a Delaware corporation, having a place of business at 5200 Old Orchard Road, Skokie, Illinois 60077 ("Searle") and BIOMARINE LTD., a Wyoming corporation, having a place of business at 794 Sunrise Blvd., Mt. Bethel, Pennsylvania 18343 ("Biomarine"). Collectively, Searle and Biomarine shall be known as "the Parties".

WHEREAS, Biomarine is the owner of pending U.S. Appln. No. 75/498497, filed on June 9, 1998, for the mark SEARX for use in connection with food supplements ("Biomarine's Application" or "Biomarine's Mark");

WHEREAS, Searle is the owner of various marks which consist of or incorporate the mark SEARLE for pharmaceutical products (the "SEARLE Marks");

WHEREAS, Searle filed Opposition No. 118,621 before the Trademark Trial and Appeal Board of the United States Patent and Trademark Office against registration of Biomarine's Mark, and the opposition is pending;

WHEREAS, the Parties wish to settle disputed issues relating to the use and registration of Biomarine's Mark;

NOW, THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged, the Parties agree as follows:

1. Within ten (10) business days after execution hereof, Biomarine agrees to file with the Trademark Office a request for Amendment of Biomarine's Mark to a stylized form, which consists of a hyphen and italicized lettering, namely, in the form of SEA-Rx (Stylized), as

shown on the attached Exhibit A hereto. Searle agrees to provide its consent to such amendment, if necessary.

2. Biomarine shall always display Biomarine's Mark in the form shown on Exhibit A, which includes the hyphen between the letters "A" and "R", initial capital letters "S" and "R" in larger font than the other letters, and the letter "X" in lower case. When Biomarine's Mark is displayed in color, Biomarine shall always display Biomarine's Mark in the Logo form shown on the attached Exhibit A, which shall always be in the Pantone colors of Reflex Blue with a white outline and PMS 326 green gradient background.

3. Upon receipt of confirmation that Biomarine has filed the Amendment pursuant to Paragraph 1 above, Searle will file a Withdrawal of Opposition, subject to acceptance of the Amendment by the Trademark Office. Biomarine agrees to provide its consent to the Withdrawal of Opposition.

4. The parties agree that so long as Biomarine complies with the terms herein, confusion is not likely between the respective marks SEA-Rx and the SEARLE Marks.

5. SEARLE, its subsidiaries, affiliates, assignees, licensees, agents, registered users and representatives, agree that for as long as Biomarine uses Biomarine's Mark, as amended, pursuant to the terms of this Agreement, Searle will not oppose any application for Biomarine's Mark, as amended, provided that the goods covered by Biomarine's Mark are not pharmaceutical products in the nature of drugs.

6. Biomarine, its subsidiaries, affiliates, assignees, licensees, agents, registered users and representatives, acknowledge Searle's prior rights in the SEARLE Marks and agrees that Biomarine will not do any act or thing to interfere with Searle's use or enjoyment of the SEARLE Marks.

7. In the event that a third party believes the respective marks are owned by or affiliated with the other party, and such belief is communicated to the other party, that party agrees to notify the owning party and to take reasonable steps to be agreed upon by the parties to correct any such mistake and to alleviate any such future mistakes.

8. This Agreement shall be binding upon the undersigned Parties as well as their related companies, subsidiaries, successors, assigns, licensees, and legal representatives upon execution by both parties through the signatures of the undersigned representatives, and the signatures of the undersigned representatives shall constitute a warranty of their authority to enter into this Agreement and bind the party being represented.

9. The recitals set forth above shall be deemed to be incorporated within this Agreement as if fully set forth herein, and this Agreement shall be interpreted in light of such recitals; any captions or headings contained herein are for convenient reference only and are not a part hereof.

10. This Agreement shall be without term and shall only be terminated by consent in writing by both parties.


11. This Agreement contains the entire agreement between the Parties hereto, and supersedes all previous oral or written agreements regarding the subject matter herein. This Agreement may be modified only in a writing signed by both Parties.

12. This Agreement shall be effective in all countries and territories throughout the world and is governed by the laws of the State of New Jersey.

13. If any provision of this Agreement is held to be illegal, invalid or unenforceable under any law, rule or regulation, such provision shall be fully severable and this Agreement shall be construed and enforced as if such illegal, invalid or enforceable provision had never comprised a part hereof. The remaining provisions of this Agreement shall remain in full force and effect and shall not be affected by the illegal, invalid or unenforceable provision by its severance herefrom.

14. This Agreement shall be executed in duplicate originals and shall be effective as of the date of the last signature of the parties hereto.

G.D. SEARLE & CO.

By: 
Name: Carl W. Battle
Title: Attorney-in-Fact
Dated: September 26, 2001

BIOMARINE LTD.


By: 
Name: OLAV E. SANDNES
Title: President
Dated: 12 November 2001

EXHIBIT A

Revised Logo, January 12, 2001



*Logo prints Reflex Blue with white outline,
PMS 326 green gradient background.*

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

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G.D. Searle & Co.

Opposer,

Opposition No.: 113,923

v.

Ser. No.: 75/375,046

BioMarine Ltd.

Mark: SEARX

Applicant.
-----X

**MOTION TO FOR APPROVAL OF AMENDMENT TO THE PRESENTATION OF
APPLICANT'S MARK PURSUANT TO TBMP 605.03(b)**

Background: On January 11, 2000, application Ser. No. 75/375,046 was published for opposition. Thereafter G.D. Searle & Co. filed the captioned opposition. The parties have now reached a Settlement Agreement that is contingent upon the USPTO allowing an amendment to the presentation of the applicant's mark.

The applicant applied to register SEARX in block letters. Paragraph 1 of the Settlement Agreement (copy attached as Exhibit 1 to MOTION TO SUSPEND AND FOR APPROVAL OF AMENDMENT TO THE PRESENTATION OF APPLICANT'S MARK PURSUANT TO TBMP 605.03(b)) requires the applicant to request an amendment of applicant's mark to a stylized form, which consists of a hyphen and italicized lettering, namely, in the form of *SEA-RX*.

The mark as sought to be amended creates the same impression as the original mark. In fact, the specimens submitted with the application show the mark in exactly the same form as provided for in the Settlement Agreement. In other words, the Trademark Examining Attorney did not find that the mark as applied for to be inconsistent with the mark as shown on the specimen. If the Trademark Examining Attorney had made that determination either the specimen would have been rejected or the applicant would have been required to amend the presentation of its mark.

The amendment is not a material alteration of the mark and should be allowed. See In re Umax Data System, Inc., 40 USPQ2d, 1539 (Comm'r Pats. 1996) as well as Ex Parte Petersen and Pegau Baking Co., 100 USPQ2d (Comm'r Pats. 1953).

In the Petersen case, the registered mark consisted of the words PETER PAN enclosed with a fluted oval design and designs of two leaves near the perimeter of the oval. The mark was amended by deleting the fluted oval design (with the new presentation being in a stylized form of rectangle) as well as the two leaves. The Applicant herein is requesting a much less drastic amendment (i.e. Nothing material is being added or deleted; rather a form of punctuation (a "-" or dash) is being inserted and the block letters are being italicized.

In re Larios S.A. (TTAB) 35 USPQ2d 1214 (3/30/1995) the requested amendment involved terms having plainly different meanings, nevertheless the Board disagreed with the Examining Attorney's assertion that "the terms create different and distinct connotations when viewed in light of the whole mark [s]," and allowed the requested amendment. Citing a prior decision, the Board held at page 1217:

The Board, in Visa International Service Association v. Life-Code Systems, Inc., 220 USPQ 740, 743-44 (TTAB 1983), articulated the following test for determining whether a change in a mark constitutes a material alteration thereof:

The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application.

The material alteration test, as is apparent from the above, is not quite as rigorous as the substantially exact representation standard and thus allows for a bit more leeway or flexibility with respect to permissible change in a mark and the concomitant amendment of the drawing thereof.

The amendment to presentation of the mark as a hyphenated word would not require republication of the mark. Anyone who might have originally objected to the mark as sought amended would also have objected to marks as published.

The necessity of republication is the primary consideration (described as the "general test" in TMEP §1609.02(a)) in deciding upon whether to allow an amendment and in determining whether a proposed amendment is a "material alteration" of the mark. See, the report on the Hearings on *H.R. 4744, 76th Congress, 1st Session*, at page 66, wherein Commission Frazer stated at p. 67:

I think that the Patent Office could be relied upon to exercise wise discretion as to whether an amendment required republication. If it did require republication, I think it is tantamount to a new application and the trademark should be so treated.

Since the proposed amended mark would not require republication, Applicant's request should be granted. If the requested is granted, Applicant will immediately submit a formal drawing, a request that the opposition terminated and that the Application move allowed to a submitted with its Renewal Application should be accepted.

Respectfully submitted,

Baker & Rannells

By: 

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