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

Proceeding	91196900
Party	Defendant Acella Pharmaceuticals, LLC
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Date	07/14/2011
Attachments	07142011 Motion On Consent to Amend and Withdraw with Proposed Amendment.pdf ( 8 pages )(198577 bytes )

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

In the matter of Application Serial. No. 77/893,681  
TM: XOLAFIN

NOVARTIS AG	)	
	)	
Opposer,	)	
	)	Opposition No. 91196900
v.	)	
	)	
ACELLA PHARMACEUTICALS, LLC	)	
	)	
Applicant.	)	

**MOTION ON CONSENT TO AMEND APPLICATION AND, IF ACCEPTED, TO  
WITHDRAW THE OPPOSITION ON CONSENT**

Pursuant to 37 C.F.R. § 2.133(a) and Rule 514 of the Trademark Trial and Appeal Board Manual of Procedure, Applicant respectfully requests entry of the Amendment attached hereto as Exhibit A requesting that the above-captioned application be amended by changing the first letter of the mark from an “X” to a “Z,” such that the mark is amended to: ZOLAFIN.

It is respectfully submitted that this amendment does not constitute a material alteration of the mark and would not require republication of the application.

This amendment is made pursuant to an Agreement between Applicant and Opposer, who has consented to this amendment. If the amendment is approved by the Board, Opposer, with Applicant’s consent, requests that the opposition be withdrawn without prejudice.

**CONCLUSION**

Applicant respectfully requests that this request to amend the application be granted in its entirety, and that, upon amendment, the opposition be withdrawn with prejudice.

Respectfully submitted,

MILLER & MARTIN PLLC

Date: 7/14/11

By: Charles W. Forlidas

Charles W. Forlidas  
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Julia A. Yun  
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CONSENTED TO:

TEPPER & EYSTER, PLLC  
*Attorneys for Opposer*

By: 

Maury M. Tepper, III  
3724 Benson Drive  
Raleigh, NC 27609  
919-861-8903

Date: 7/14/11

**CERTIFICATE OF ELECTRONIC FILING**

I hereby certify that the preceding Motion on Consent to Amend Application and, If Accepted, to Withdraw the Opposition on Consent is being electronically filed with the United States Patent Office through its ESTTA electronic filing system on this 14<sup>th</sup> day of July, 2011.

By: Charles W. Forlidas  
Charles W. Forlidas

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Motion on Consent to Amend Application and, If Accepted, to Withdraw the Opposition on Consent has been served on Opposer's attorney by mailing a copy thereof via First Class Mail, postage prepaid, on this 14<sup>th</sup> day of July, 2011 addressed as follows:

Maury M. Tepper, III  
Tepper & Eyster, PLLC  
3724 Benson Drive  
Raleigh, NC 27609

By: Charles W. Forlidas  
Charles W. Forlidas

**EXHIBIT A**

**TO MOTION ON CONSENT TO AMEND APPLICATION AND, IF ACCEPTED, TO  
WITHDRAW THE OPPOSITION ON CONSENT**

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In the matter of Application Serial. No. 77/893,681  
TM: XOLAFIN

NOVARTIS AG	)	
	)	
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	)	
ACELLA PHARMACEUTICALS, LLC	)	
	)	
Applicant.	)	

**AMENDMENT TO APPLICATION INVOLVED IN**  
**INTER PARTES PROCEEDING**

Applicant requests that the application be amended to delete the present drawing of the mark and to replace it as follows:

ZOLAFIN

**REMARKS**

As part of the settlement of this matter, Applicant has agreed with Opposer to amend the present application to change the spelling of the mark from XOLAFIN to the phonetic equivalent, ZOLAFIN, in order to further distinguish the mark from Opposer's cited marks.

Opposer has consented to the present amendment and has consented to its registration upon entry.

Applicant respectfully submits that this amendment is not a material alteration of the marks as originally filed. After the amendment, the mark creates essentially the same commercial impression as before the amendment and would not require republication.

The Board has held that amendment of an application to match the display of FREEDOM STONE as two words in the specimen was not a material alteration because the commercial impression of the mark depended upon the literal terms and not on the form of display. *In re: Innovative Companies, LLC*, 88 U.S.P.Q.2d 1095 (T.T.A.B. 2008) (following *Paris Glove of Canada, Ltd. v. SBC/Sporto Corp.*, 84 U.S.P.Q.2d 1856 (T.T.A.B. 2007) (no material alteration in amending mark registered as two words, AQUA STOP, displayed on two lines, to a single word displayed in semicircular form)).

This is in contrast to the Board's rejection of the change from TACILESENSE in the original drawing to add the missing letter "T," resulting in the mark TACTILESENSE. *In re: Who? Vision Systems Inc.*, 57 U.S.P.Q.2 1211 (T.T.A.B. 2000). There the Board held that the two words had "distinctly different commercial impressions" because TACTILESENSE looks like a combination of the words TACTILE and SENSE which would have meaning in use as a mark for fingerprint imaging systems, whereas TACILESENSE is a gibberish word with no meaning. *Id.*

In the present case both XOLAFIN and ZOLAFIN are gibberish words without any defined meaning. Therefore, the change from one phonetic equivalent to another using obscure, end-of-the-alphabet letters, does not create a different commercial impression. Here, the primary commercial impression created is the sound of the word because it has no meaning. The requested amendment does nothing to change the sound of the word, despite the substitution of letters.

Thus, the present case is distinguishable from *In re: Who? Vision Systems* and more akin to *In re: Innovative Companies* and the *Paris Glove* case and the amendment should not be considered to be a material alteration of the mark.

Accordingly, as amended and supplemented with these remarks, Applicant believes the present application stands in proper form for issuance. Such favorable action is respectfully requested.

Respectfully submitted,

MILLER & MARTIN PLLC

Date: 7/14/11

By: Charles W. Forlidas

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