

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Examining Attorney: Zhaleh Delaney

Mark: ACHIEVE

Applicant: Basic Organics, Inc.

App. Number: 85/853,978

Filing Date: February 19, 2013

RESPONSE TO OFFICE ACTION

On February 19, Basic Organics, Inc. (“Applicant”) filed an intent-to-use trademark application seeking to register the mark ACHIEVE for *vitamin and mineral supplements* in Class 5 and *soy protein based drink mix* in Class 32. In a Non-Final Office action issued June 4, 2013, the Examiner has refused to register the mark, stating that there was a likelihood of confusion with the mark ACHIEVE ES, for *herbal and vitamin supplements in tablet form distributed by direct mail*, Registration No. 2,721,675 (“Cited Mark”). The Examiner has also required that the description of the goods be amended.

Amendment

The Examiner has stated that the wording “soy protein based drink mix” is unclear, and could represent nutritional products in Class 5. The Applicant requests the goods be amended as follows:

“Soy protein-based drink mixes for making soy-based beverages, not being milk substitutes or nutritional or dietary” (class 32)

“Protein-based drink mix; dietary supplement drink mixes, namely, soy protein based drink mixes” (class 5)

Likelihood of Confusion

The Examiner has refused registration of the Mark on the basis of likelihood of confusion with the mark ACHIEVE ES, for *herbal and vitamin supplements in tablet form distributed by direct mail*, Registration No. 2,721,675. The Section 9 Declaration of Use for the Cited Mark was due June 3, 2013 and the expiration of the grace period to file the Section 9 Declaration of Use was December 3, 2013. Because the registrant failed to file a Declaration of Use by December 3, 2013, the registration for ACHIEVE ES has expired. The Office will mark the registration as cancelled in due course. The registration of ACHIEVE ES is no longer a bar to registration of the Mark because

cancelled registrations cannot be cited against pending applications as a basis for a likelihood of confusion refusal. TMEP 1207.01 (“a refusal under §2(d) is normally based on the examining attorney’s conclusion that the applicant’s mark, as used on or in connection with the specified goods or services, so resembles a *registered* mark as to be likely to cause confusion.”).

Conclusion

The Applicant respectfully requests the Examiner enter the amendment to the description of the goods and withdraw the likelihood of confusion refusal because the registration for ACHIEVE ES has not been timely renewed and will be cancelled shortly.

In the alternative, the Applicant requests that the Examiner amend the goods and that the Application be suspending pending the Office marking the Cited Mark as cancelled.

Do not hesitate to contact Applicant’s Attorney with any further questions.

Date: December 4, 2013

Respectfully submitted,



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