Attorney Ref. No. 31622.000

TRADEMARK LAW OFFICE 111
Serial No. 88/020,639
Mark: HYPERION MATERIALS & TECHNOLOGIES & Design

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of: :

Sandvik Hyperion AB :

Serial No.: 88/020,639 :

Filed: June 29, 2018 :

For Mark: HYPERION MATERIALS & TECHNOLOGIES & Design :
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RESPONSE TO OFFICE ACTION
Issued: October 25, 2018

Box: RESPONSES: NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Attention: Douglas M. Lee, Law Office 111

This is in response to the Office Action dated October 25, 2018.

ARGUMENT

Likelihood of Confusion

On June 29, 2018, Sandvik Hyperion AB ("Applicant") filed USPTO Application Serial No. 88/020,639 for the mark HYPERION MATERIALS & TECHNOLOGIES & Design ("Applicant's Mark") in Class 3, inter alia, for "sharpening preparations, namely, abrasive paste; polish powder; flexible abrasives; grinding preparations, namely, abrasive sand; rubbing cream, namely, polishing creams; corundum for use as an abrasive" ("Applicant's Goods").

The Trademark Examiner preliminary refused registration of the applied-for mark in Class 3 on the ground that the mark is likely to be confused with USPTO Registration No. 4218398 for the mark HYPERION in standard characters owned by Diamond Innovations, Inc

(“Diamond Innovations”) for abrasive preparations for polishing, lapping, sawing, or grinding in the aerospace, power generation, automotive, construction, renovation, electronic, glass, oil and gas, mineral exploration, mining, tool and die, stone and woodworking industries in International Class 3.

The Applicant, Sandvik Hyperion AB (“Sandvik Hyperion”) and Diamond Innovations are related companies each owned by the same parent company, Hyperion Materials and Technologies, LLC. The relationship between Sandvik Hyperion and Diamond Innovations obviates any likelihood of confusion because in the public’s mind the related companies constitute a single source. Moreover, as set forth in the attached consent agreement in **Exhibit A**, Diamond Innovations has specifically consented to the use and registration by Sandvik Hyperion of Applicant’s Mark for Applicant’s Goods.

The Court of Appeals for the Federal Circuit has indicated that consent agreements should be given great weight and the USPTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest. *In re Four Seasons Hotels Ltd.,* 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993). In *In re E.I. du Pont de Nemours & Co.,* 476 F.2d 1357, 1363, 177 USPQ 563, 568 (CCPA 1973), the Court of Customs and Patent Appeals stated: “[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. ... A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.” As such, the USPTO is required to give substantial weight to the parties’ consent agreement in determining the likelihood of confusion.

In view of being wholly-owned subsidiaries of the same company and the consent agreement executed by Sandvik Hyperion and Diamond Innovations, the likelihood of confusion objection should be withdrawn with respect to cited Registration No. 4218398 for the mark HYPERION.

Identfication of Goods in Class 7

The Applicant hereby amends the identification of goods in Class 7 as follows:

Class 7: POWER OPERATED METAL WORKING MACHINE TOOLS, NAMELY, MILLING, TURNING, BORING AND DRILLING TOOLS AND TOOL HOLDERS AND INSERTS FOR SUCH TOOLS; PARTS OF MACHINES, NAMELY, **MILLING, TURNING, BORING AND DRILLING TOOLS**, SHARPENING WHEELS, GRINDSTONES; ELECTRICAL GRINDING WHEEL ENGINES; STROPPING MACHINES; BLADE SHARPENING STROPPING MACHINES; **MACHINE PARTS, NAMELY**, MILLSTONES; CEMENTED CARBIDE CUTTING TOOLS; MACHINE TOOLS, namely, APERTURE KNIFE TOOLS

CONCLUSION

In view of the foregoing, Applicant requests that the likelihood of confusion refusal with respect to the cited registration be withdrawn, and the amendments to the identification of goods and services be entered and that the mark be passed on to publication.

Dated: New York, New York
December 18, 2018

Respectfully submitted,

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EXHIBIT A