

## **RESPONSE TO OFFICE ACTION**

H Design & HORIZON

Serial No. 88/324,922

In this Response to the Examining Attorney's Office Action, Applicant HZNP Ltd. ("Applicant") hereby submits a Letter of Consent with Horizon Pharma USA, Inc. ("Horizon Pharma") and further amends the goods covered by Class 016. With the narrowed application and the Letter of Consent, there are no longer concerns about Trademark Act Section 2(d) confusion, and Applicant respectfully requests that the Examining Attorney allow the application to proceed to publication.

In the Office Action dated May 15, 2019, the Examining Attorney refused to register Applicant's mark "H Design & HORIZON" ("Applied-for Mark") stating that there was a likelihood of confusion for the following classes and identifications of goods:

- Class 005 – House mark for pharmaceutical preparations for the treatment of pain, inflammation, gastrointestinal disorders, rare and orphan diseases
- Class 016 – Printed medical publications, namely, reports, manuals, brochures, newsletters, leaflets

Pursuant to Trademark Act section 2(d), the Examining Attorney cited the following registrations and stated that the Applied for Mark is likely to cause confusion with these registrations:

Registration Nos. 3,967,638 (HORIZON PHARMA) and 4,938,004 (HORIZON PLAN)

- Class 005 – Pharmaceutical preparations and substances for the treatment of pain, inflammation and gastrointestinal disorder
- Class 016 – Printed pamphlets, brochures, booklets, handouts, forms, and worksheets in the field of end-of-life care, including advance directives, living wills, hospice care, palliative care, durable medical powers of attorney, and physician orders for life-sustaining treatment

The HORIZON PHARMA registration is owned by Horizon Pharma. Applicant HZNP Ltd and Horizon Pharma entered a consent agreement that Horizon Pharma agrees that Applicant may register the Applied-for Mark and also both parties agree to take all reasonable steps to avoid confusion in the marketplace or eliminate confusion in the marketplace if there is any such confusion, as attached. TMEP §1207.01(d)(viii). Furthermore, Horizon Pharma and Applicant are related companies.

In addition, Applicant requests the amendment of its identification of goods as follows:

- Class 016 – Printed medical publications, namely, reports, manuals, brochures, newsletters, leaflets in the field of medical issues, medical procedures, and disease symptoms

Further, Applicant respectfully does not believe there is any likelihood of confusion between the Applied-for Mark and the HORIZON PLAN mark. The HORIZON PLAN registration is owned by a non-profit corporation, WellSpan Health of New Jersey (“WellSpan”). WellSpan manages a network of hospitals, clinics, and physicians. *See* Ex. 1 (<https://www.bloomberg.com/profile/company/3440277Z:US>); *see also* Ex. 2 (<https://www.wellspan.org/about/>). WellSpan has used the “HORIZON PLAN” mark in commerce since 2015. Upon information and belief, WellSpan does not claim to offer or actually offer any publication relating to the pharmaceutical goods and services. In addition, WellSpan does not operate by providing publication about any medical issues, medical procedures, and disease symptoms.

In contrast, Applicant HZNP Ltd is the parent company of Horizon Pharma, a new kind of biopharmaceutical company that challenges industry norms and believes in patient benefits. *See* Ex. 3 (<https://www.horizonpharma.com/company/about-us>). Horizon Pharma’s (and its affiliated companies’) main goal is to improve patients’ lives by identifying and developing accessible medicines that address unmet needs. *See id.* Neither Horizon Pharma nor Applicant offer any publications related to an end-of-life care whatsoever. Horizon Pharma and its affiliates have been using trademarks with a “horizon” element since 2011.

Although the Examining Attorney argues that HORIZON is the dominant portion of both the cited marks and the Applied-for Mark, and that the addition of a design element “does not obviate the similarity of the marks in the case,” this fails to take account of Horizon Pharma’s incontestable mark, HORIZON PHARMA. *See* Ex. 4. In addition, such an argument implies that no one other than WellSpan could own a trademark with any “horizon” element in any printed materials, which, according to Trademark Office records, cannot be true. *See e.g.*, Ex. 5 (Reg. No. 5374138 (“FUTURE HORIZONS INC.” for Printed books in the field of autism and asperger's syndrome owned by Future Horizons, Inc.)); Ex. 6 (Reg. No. 5393811 (“HORIZON” for Publications, namely, magazines featuring articles related to musculoskeletal care, research and education owned by Hospital for Special Surgery); Ex. 7 (Reg. No. 5293834 (“NEW HORIZONS GYN CANCER RESEARCH FUND CHASING THE CURE FOR OVARIAN & UTERINE CANCER ONE STEP AT A TIME GOG and Design” owned by The Gynecologic Oncology Group). Moreover, given the multiple health-related uses of similar “horizon” marks for health-related services across similar markets and channels, customers know to distinguish among such marks.

Nevertheless, to further distinguish Applied-for Mark from the cited Registration and to eliminate any confusion (no matter how unlikely), Applicant requests the acceptance of the proposed amendment of goods identified above to clarify that its goods relate only to medical and pharmaceutical goods and services and not to end of life goods more broadly.

Overall, this narrowing of goods resolves any likelihood of confusion (though Applicant disputes any exists in the first instance). Applicant respectfully requests that the Examining Attorney allow the application to proceed to publication.