

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Medical Consulting Network, Inc.

Serial No. : 88/252,671



Mark :

Filing Date : January 7, 2019

Examining Attorney : Elle Marino

RESPONSE TO OFFICE ACTION

In response to the Office Action dated September 2, 2019 (the “Office Action”), applicant Medical Consulting Network, Inc. (“Applicant”) has prepared the following remarks with respect to its application for the mark MD & Design (“Pending Application”).

Likelihood of Confusion Refusal

The Examiner has refused to register the Pending Application, specifically for Classes 9, 35, and 42, due to a likelihood of confusion with three separate standard character trademark registrations for DMD, registration nos. 4922872, 4826969, and 5257265 (the “Cited Trademarks”).

Applicant respectfully disagrees that there is a likelihood of confusion with the Cited Trademarks, due to the fact that Applicant’s trademark is actually MD and not DMD. The Applicant opines that the original source of this error was an incorrect design code assigned at the time of filing. (See Exhibit A – the Design Code Notice showing DMD). Applicant did not notice the error until after the Office Action was issued. Applicant’s subsequent filing for MD & Design serial no. 88/484,383 covering Class 3 and 5 goods, was correctly coded (See Exhibit B – the Design Code Notice showing MD).

A review of the USPTO record and the application as filed shows that the trademark was filed as MD and correctly described within the filing as MD. (See Exhibit C – USPTO record and initial application as filed). For the Examiner’s convenience, see page 6 of Exhibit C for corresponding highlighted portion as referenced below. The Pending Application as filed shows

consistent use of MD rather than DMD. The mark and the literal element of the mark are both described as “MD.” In the description of the design, the first part of the mark is described as “a reverse D shape,” and is explicitly not referred to as “the letter D.” The subsequent description then makes explicit reference to the “letter M” and the “letter D.” The first “shape” was clearly never intended to represent an actual letter.

Also supporting the assertion that the mark is MD and not DMD, is that the letters MD stand for “Marijuana Doctors.” This is evidenced by the specimens of record that were submitted in support of Classes 9, 35, 42, and 44, where the domain name www.marijuanadoctors.com” is clearly seen at the top of each specimen and there are references to “Marijuana Doctors.” See Exhibit C.

Finally, as mentioned above, Applicant is also the owner an identical trademark application for MD (Serial No. 88/484,383) (See Exhibit D). The newer MD application serial no. 88/484,383 was correctly coded and appears as MD within a trademark search (See Exhibit E for results of a USPTO search for all trademarks owned by Applicant).

Since the trademark is actually MD rather than DMD, due to the miscoding of the letters in the Application, Applicant respectfully requests that the Examiner update the record to reflect the correct mark and correspondingly withdraw the likelihood of confusion refusal. The marks MD and DMD are sufficiently different as not to be confusingly similar. Applicant also owns registration no. 4562783 for MD MarijuanaDoctors.com & Design, which was registered on July 8, 2014, predating all 3 of the Cited Registrations (See Exhibit F).

The MD MarijuanaDoctors.com & design is consistent with the Applicant’s rights to MD, and should also support the assertion that there is no likelihood of confusion between the Pending Application and the Cited Registrations.

CSA Refusal and Information About Services Required

The Examiner has refused registration with respect to Classes 9 and 35 based on what appears to Applicant as a misunderstanding as to what services Applicant provides. In addition, the Examiner has requested additional information to assist with the evaluation of the application.

Specifically, the Examiner stated that applicant's Class 35 services include an on-line shopping mall that the Examiner assumed to sell products containing marijuana. Based on a recent business decision, Applicant has removed the shopping mall from its website. As such the refusal for Class 35 should be moot. The Examiner further noted that Applicant's specimen for its mobile application contained an "Order Online" tab, but Applicant affirmatively states that this link is not functional, and that it does not sell any products containing THC in a level inconsistent with the 2018 Farm Bill because it is not licensed by any state to do so.

Applicant submits that the answers to the below questions are sufficient to remove the Examiner's objection to the Class 9 and 35 goods and services on the basis of noncompliance with the Controlled Substances Act.

1. Do any of applicant's identified services involve the possession, sale, distribution or provision (even as samples) of marijuana, cannabis, hemp, marijuana-based, cannabis-based or hemp-based preparations, or marijuana, cannabis or hemp-based extracts or derivatives which are derived from any part of the plant Cannabis sativa L? If yes, please specify all relevant services and what they entail.

None of the identified services involve the possession, sale, distribution or provision of any of the aforementioned items derived from Cannabis sativa L.

2. Do applicant's websites or software allow or otherwise enable consumers to purchase marijuana, cannabis, hemp, marijuana-based, cannabis-based or hemp-based preparations, or marijuana, cannabis or hemp-based extracts or derivatives which are derived from any part of the plant Cannabis sativa L? If yes, please specify the services and what they entail.

No, Applicant's websites and software do not enable medical marijuana patients to purchase any of the aforementioned products. Applicant's websites and software allow state-licensed marijuana dispensaries to provide information about their products, and medical marijuana patients can make an inquiry to said state-licensed marijuana dispensaries. From that point forward, Applicant has no role in the interaction between such medical marijuana patients and the state-licensed medical marijuana dispensaries, i.e. Applicant does not process payments or fill orders for medical marijuana.

3. Do applicant's telemedicine services provide the consumer with or allow consumers to purchase any marijuana, cannabis, hemp, marijuana-based, cannabis-based or hemp-based preparations, or marijuana, cannabis or hemp-based extracts or derivatives which are derived from any part of the plant Cannabis sativa L?

No, Applicant's telemedicine services do not have this feature.

4. Upon information and belief, do applicant's services comply with the Controlled Substances Act?

Yes, upon information and belief, Applicant's services comply with the Controlled Substances Act.