

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Bracco Diagnostics Inc.  
Serial No. : 88/581,615  
Trademark : CARDIOTEC  
International Classes : 5

**RESPONSE TO OFFICE ACTION**

Applicant Bracco Diagnostics Inc. ("Bracco") respectfully submits this Response to the Non-Final Office Action dated November 22, 2019 (the "Office Action") issued against Application Serial No. 88/581,615 ("Bracco's 2019 CARDIOTEC Application") for the mark CARDIOTEC ("Applicant's CARDIOTEC Mark").

**REMARKS**

The Office Action refuses registration of Bracco's 2019 CARDIOTEC Application on the basis of potential likelihood of confusion with: (1) U.S. Registration No. 4929579 (issued from U.S. Application Serial No. 79157578) for the mark SCHWARZER CARDIOTEC (the "Schwarzer Mark") owned by Schwarzer Cardiotek Gmbh ("Schwarzer"); and (2) U.S. Registration No. 4912013 (issued from U.S. Application Serial No. 86439828) for the mark CARDIOTECH (the "Raine Mark") owned by Raine Industries Inc. ("Raine") (the Schwarzer Mark and the Raine Mark collectively, the "Cited Marks").

As detailed below, Bracco respectfully submits that there is no likelihood of confusion between Bracco's CARDIOTEC Mark and the Cited Marks. Indeed, both Schwarzer and Raine agree with this assessment, as noted in the Consents to Registration of Bracco's CARDIOTEC Mark provided by Schwarzer and Raine.

**A. History of Bracco's CARDIOTEC Mark**

The history of Bracco's CARDIOTEC Mark goes back almost 40 years, when Bracco acquired rights in the mark CARDIOTEC from E.R. Squibb & Sons, Inc. Bracco's earliest

registration for CARDIOTEC (by way of assignment from E.R. Squibb recorded at Reel/Frame 1213/0138) was U.S. Reg. No. 1279584 issued May 29, 1984 (“Bracco’s 1984 CARDIOTEC Registration”). Bracco’s 1984 CARDIOTEC Registration claimed a first use date of August 6, 1982, and covered *a pharmaceutical preparation-namely, a cardiac imaging agent* (the “Bracco Goods”), i.e. the same goods covered by Bracco’s 2019 CARDIOTEC Application. After many years of use of CARDIOTEC in connection with the Bracco Goods, and maintenance of the 1984 CARDIOTEC Registration for several decades, the 1984 CARDIOTEC Registration was not renewed in 2014.

Bracco filed U.S. Application Serial No. 86458322 for the CARDIOTEC Mark on November 19, 2014 (“Bracco’s 2014 CARDIOTEC Application”). Bracco’s 2014 CARDIOTEC Application also covered *pharmaceutical preparations, namely, a cardiac imaging agent*, i.e. the same Bracco Goods covered by both Bracco’s 1984 CARDIOTEC Registration that stood for 30 years and by Bracco’s 2019 CARDIOTEC Application that is the subject of this Office Action.

#### **B. Schwarzer and Raine Consents to Bracco’s CARDIOTEC Mark**

The Schwarzer Mark and the Raine Mark were both initially cited against Bracco’s 2014 CARDIOTEC Application. In light of the differences in the parties’ marks and goods, as well as the sophistication of the consumers, and the absence of any actual confusion (particularly given Bracco’s prior long term use of CARDIOTEC), Schwarzer and Raine each agreed that confusion between the Bracco Mark, the Schwarzer Mark and the Raine Mark (respectively) was unlikely to occur. Schwarzer and Raine each provided consents to registration of the Bracco Mark, which Bracco submitted to the PTO in support of its Response to Office Action. A copy of such filing is attached here as Exhibit A, and all arguments made in Exhibit A are incorporated by reference into this response.

The PTO withdrew its objections to Bracco's 2014 CARDIOTEC Application, and a Notice of Allowance was issued. Bracco's 2014 CARDIOTEC Application expired three years after allowance. Bracco's 2019 CARDIOTEC Application was subsequently filed.

**C. Distinctions and Consents for Bracco's 2019 CARDIOTEC Application**

The mark and goods covered by Bracco's 2019 CARDIOTEC Application are identical to the mark and goods covered by Bracco's 2014 CARDIOTEC Application (as well as Bracco's 1984 CARDIOTEC Registration).

Confusion continues to be unlikely between the Bracco Mark and the Schwarzer Mark and Raine Mark for the reasons explained in Exhibit A. The consents to registration provided by Schwarzer and Raine submitted in support of Bracco's 2014 CARDIOTEC Application (see Exhibit A) also apply equally to Bracco's 2019 CARDIOTEC Application.

**CONCLUSION**

In view of the foregoing, it is requested that the objections to Bracco's 2019 CARDIOTEC Application be withdrawn, and that Bracco's 2019 CARDIOTEC Application be permitted to proceed to publication.

Thank you.