

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

Mark: VIREO

Applicant: Vireo Health, Inc.

Serial No.: 88332231

**I. Introduction**

The Office Action issued December 17, 2019 refuses registration of the mark VIREO (the “**Mark**” or “**Applicant’s Mark**”) on the grounds that applicant does not have a bona fide intent to lawfully use the identified goods, citing the Controlled Substances Act and the Food, Drug and Cosmetic Act. Applicant has provided an amended goods description with this Response that Applicant believes addresses the Examining Attorney’s concern and obviates this refusal.

The Office Action also refuses registration of Applicant’s Mark under Section 2(d) of the Trademark Act on the ground that it is likely to be confused with the prior registration for VIREO owned by Vireo Systems Inc. (Reg. No. 5084848) (the “**Cited Mark**”). Applicant respectfully submits arguments that there is no likelihood of confusion between its Mark and the Cited Mark and requests that the refusal be withdrawn and the Applicant’s Mark moved to publication.

Finally, the Office Action identifies a prior-pending application as a potential conflict for Applicant’s Mark. The prior-pending application is VIREO (App. No. 88275498) owned by Vireo Products, LLC (the “**Prior-Filed Application**”). Because this application is now abandoned, Applicant requests that the Examining Attorney withdraw this citation.

**II. Amendment to Identification of Goods and Services**

Applicant respectfully requests that the identification of goods in the subject application be amended and additional classes added to read follows:

Class 5: *remove*

**Class 35:** medical cannabis resources, **namely, providing consumer information in the field of medical cannabis**

**Class 41:** medical cannabis resources, **namely, providing information, news and commentary in the field of current events relating to medical cannabis**

**Class 42:** medical cannabis resources, **namely, providing medical and scientific research information on patient benefits and therapeutic innovations in the field of medical cannabis**

**Class 44:** medical cannabis resources **in the nature of medical information, consultancy and advisory services regarding therapeutic and medicinal uses of cannabis**; providing online health and wellness information in the field of cannabis and cannabis-derived products

Applicant has submitted the appropriate fee along with this Response.

### **III. Applicant's Amended Services Are Legal**

The Examining Attorney refused registration on the grounds that Applicant's identified goods and services may be unlawful under the Controlled Substances Act (CSA) and the Food, Drug and Cosmetic Act (FDCA). Applicant believes that its services, as amended, do not violate either Act and are legal. As such, Applicant has a bona fide intent to lawfully use the applied-for mark in commerce with respect to the identified services. Applicant respectfully requests that the Sections 1 and 45 refusals citing the CSA and FDCA be withdrawn.

### **IV. There is No Likelihood of Confusion Under Section 2(d) Between Applicant's Mark and the Cited Mark**

The Office Action identifies the following *DuPont* likelihood of confusion factors as the most relevant: similarity of the marks and relatedness of the goods and/or services. Applicant submits that there is no likelihood of confusion between Applicant's Mark and the Cited Mark.

Vireo Systems Inc. ("**Registrant**") has registered its mark for use in connection with:

**Class 5:** Dietary supplements, nutritional supplements, homeopathic supplements, anti-inflammatories, analgesics; Homeopathic supplements for women to promote pH balance, Nutritional and homeopathic supplements for flexibility, endurance and mobility; Dietary supplements for pets, nutritional supplements for pets, homeopathic supplements for pets, anti-inflammatories and analgesics for pets; and

**Class 39:** Bottling of capsules and powders; bottling services; packing and bottling services; packing and bottling services, namely, tube filling and sealing, bottling and sealing cream; packing services; packing, crating and warehousing services; delivery and storage of goods; climate controlled storage of goods; warehousing storage; shipping of goods; packing services in the nature of encapsulation of nutritional supplements, amino acids, and dietary supplements for others; packing and bottling services in the nature of custom labeling of nutritional supplements, amino acids, and dietary supplements; private label packaging services, namely, custom labeling of nutritional supplements, amino acids, and dietary supplements for others; and

**Class 40:** Custom blending of nutritional supplements, amino acids, dietary supplements, and health products; custom blending, namely, custom manufacture of nutritional supplements, amino acids, and dietary supplements for others.

Applicant's services, as amended, consist of medical cannabis resources and information in **Classes 35, 41, 42, and 44**. These services are completely unconnected to Registrant's Class 5, 39, and 40 goods and services. Because Applicant's services are unrelated to Registrant's goods and services, confusion is neither likely nor probable. Applicant requests that the refusal be withdrawn.

## **V. The Cited Prior-Filed Application is Abandoned**

The Examining Attorney cited pending application Serial No. 88275498 for VIREO as a possible bar to registration. This pending application was issued an Office Action on September 25, 2019, to which the applicant Vireo Products, LLC failed to respond. The application was abandoned on April 7, 2020 and no longer presents a potential conflict. *See* printout from Trademark Status & Document Retrieval (TSDR) attached as **Exhibit A**. Accordingly, Applicant requests that the Examining Attorney withdraw this possible citation.

## **VI. Conclusion**

Given the differences in the nature of the goods and services at issue, there is no likelihood of confusion between Applicant's Mark and the Cited Mark. Moreover, Applicant's identified services, as amended, are legal under the CSA and FDCA. Accordingly, Applicant respectfully requests that the refusals be withdrawn and that Applicant's Mark be approved for publication.