

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
RESPONSE TO OFFICE ACTION

Applicant, Chugai Seiyaku Kabushiki Kaisha (Chugai Pharmaceutical Co., Ltd.) hereby responds to the Office Action dated December 15, 2020, in which the U.S Patent and Trademark Office (“USPTO”) rejected the Allegation of Use filed on November 5, 2020, on the ground that Applicant’s specimen did not show Applicant’s Mark as actually used in commerce in connection with any of the services listed in Class 41. The Examiner concluded that “the specimen consists of a training guide to educate patients about to self-administer treatment. Educating someone about your own medication or treatment is not an education service.”

Applicant respectfully disagrees with the Examining Attorney’s decision. Applicant states that the specimen previously submitted properly showed that Applicant’s Mark was/is in use in commerce. Applicant asserts that the mark was displayed in the advertising of the services and that the services were rendered in commerce. Thus, Applicant’s submitted specimen is proper and shows use of the mark in commerce for the education services listed in Class 41. See TMEP § 901.01(2).

The Examining Attorney erroneously indicated that Applicant’s specimen consists of a training guide to educate patients. Applicant submits that the training guide was launched in the market to train doctors, nurse practitioners, nurses and/or in general all medical staff not patients. Page No. 10 (last page) of the training guide under “For Further Inquiries” includes phrases which delimit the relevant consumer in this case. For instance, it says “for other patient support resources call...” and “for more information about how ENSPRYNG treatment may help your patient with NMOSD visit...”

The above mentioned phrases clearly support that Applicant’s specimen is a doctor’s training guide which includes information about how to train patients so that they can administer the drug at home instead of having to come to the doctor’s office to get treatment.

Again, Applicant submits that Applicant’s Mark was used in commerce in connection with the services listed in Class 41, and that the training services listed in

Class 41 were available to train doctors not patients. Accordingly, Applicant respectfully requests that the USPTO approve the Statement of Use, and issue the certificate of registration in due course.