

Response to Post Registration Office Action

This filing responds to the Post Registration Office Action dated July 19, 2012.

The Section 8 Declaration of Use was refused with respect to the services listed in the trademark registration. The Declaration of Use was accepted in association with the goods listed in the Trademark Registration. The Examiner alleged that the specimen did not reference any of the services identified in Class 42. Applicant respectfully disagrees.

The services listed in Class 42 of the trademark registration are:

Scientific research; development of new technology for others in the field of chemicals; technology consultation and research in the field of chemicals; research in the field of chemical catalysts; research in the field of chemicals; research in the field of catalysts; research and development for new products for others; industrial chemical analysis.

The previously submitted specimen for Class 42 identifies an Evonik Ligand Kit for CX Coupling Reactions. Although the specimen identifies goods, it also identifies services in association with the goods. Please refer to the bottom of the specimen where “Technical Service” is identified under a bold heading. The services associated with the mark are identified as follows:

“Our team of scientists has experience in all areas of research including Life Science, Material Science, Chemical Synthesis, Chromatography, Analytical and many more.”

These are all areas of scientific research. “Scientific research” is the first service listed in the trademark specification for Class 42. These are also areas of services that will help the consumer “develop new technology in research in the field of chemical catalysts,” will enable the consumer

to conduct “research in the field of chemicals” and “research in the field of catalysts” as well as, “research and development for new products for others” and “industrial chemical analysis.”

As such, the specimen is acceptable for the Class 42 services. The Examiner may have merely overlooked these services as identified in the bottom of the specimen page. Applicant has now brought these services directly to the Examiner’s attention and respectfully requests approval of the trademark registration Declaration of Use for all identified goods and services.

Applicant also attaches two alternative specimens for the Examiner’s consideration. The substitute specimens identify promotional material for CX-Coupling services. This specimen identifies “solution services” and specifically mentions the “CataCXium” mark in association with “proprietary ligands on stock” for “fast turnaround of your project from screening to rapid scale-up as proof of concept.” These services identify “scientific research” association with chemical ligands, and assistance in the “development of new products” for others.

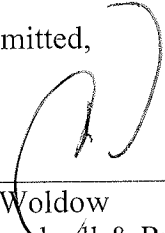
The second specimen identifies the cataCXium mark in association with “custom synthesis” services. The final page identifies services for [scientific] “research purposes.”

It is respectfully submitted that the original specimen of use for Class 42 was acceptable as submitted, especially in association with the foregoing explanations and clarifications. In the alternative, the attached specimens of use are acceptable. As such, Applicant earnestly solicits the Trademark Office Examining Attorney to accept the trademark Declaration of Use and withdraw the office action.

Respectfully submitted,

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