

## RESPONSE TO OFFICE ACTION

The Examining Attorney has refused registration of applicant's proposed mark in connection with all goods listed in class 005 and certain goods in class 010 because of an alleged likelihood of confusion with goods in the marks in U.S. Reg. Nos. 4347021 and 4342924 (SKYLA).

### Class 005

In support of the refusal of the application in connection with all of the goods in class 005, the Examining Attorney asserts that "the goods are related because they are all pharmaceutical preparations." The Examining Attorney further asserts that the "Trademark Trial and Appeal Board and its primary reviewing court have used a stricter standard to determine likelihood of confusion for pharmaceuticals or medicinal products due to the potential harm or serious consequences that could be caused if the public confused one drug or medicinal product for another." The Examining Attorney further notes that "[a]lthough physicians and pharmacists are no doubt carefully trained to recognize differences in the characteristics of pharmaceuticals or medicinal products, they are not immune from mistaking similar trademarks used on these goods" and thus, "in this case where confusion could result in harm or other serious consequences to consumers, this potential harm is considered an additional relevant factor and a lesser degree of proof may be sufficient to establish a likelihood of confusion." Finally, the Examining Attorney asserts that "absent restrictions in an application and/or registration, the identified goods are 'presumed to travel in the same channels of trade to the same class of purchasers.'"

Applicant respectfully traverses these grounds of refusal for the reasons as follow.

Applicant first notes that the registrants listing of goods in class 005 is narrow, namely, "pharmaceuticals, namely, hormonal preparations." Thus, the registrant's listing in class

005 does not cover all pharmaceuticals, but rather pharmaceuticals that are hormonal preparations.

Moreover, a “pharmaceutical” is a medicinal drug. Thus, registrant’s listed goods are hormonal preparations for medicinal purpose.

As amended, Applicant’s goods in class 005 do not include any pharmaceutical preparations, let alone hormonal preparations for medicinal purpose. To the contrary, Applicant’s goods in class 005 are for testing, analysis, diagnostic or monitoring purposes.

As there are no drugs or medicinal products listed in the present application, Applicant respectfully submits the “stricter standard to determine likelihood of confusion for pharmaceuticals or medicinal products” and potential for “harm or other serious consequences” referred to in the Office Action do not apply in this case.

Moreover, Applicant notes that the relevant channels of trade are “all normal channels of trade **for those goods.**” *In re Southern Belle Frozen Foods Inc.*, 48 U.S.P.Q. 2d 1849, 1850 (TTAB 1998) [emphasis added]. Given the significant differences in the nature of the goods, Applicant submits that there is no basis for presuming that they would travel in the same channels of trade.

Therefore, in light of 1) the differences between the Applicant’s goods in class 005 as amended and registrant’s own listing of goods, and 2) the high standard of care that would be exercised by the purchaser of the goods of both, Applicant submits that the relevant public would not mistakenly believe that they originate from or in some way are associated with or sponsored by the same producer on the basis of Applicant’s use of the proposed mark. Withdrawal of the refusal in connection with the goods in class 005 is respectfully requested.

Class 010

In support of the refusal of the application in connection with the goods “electromagnetic medical diagnostic imaging apparatus,” “medical diagnostic instruments for the analysis of body fluids,” “MRI diagnostic apparatus,” “sample preparation device for medical diagnostic uses,” and “ultrasonic medical diagnostic apparatus; ultrasound diagnostic apparatus; x-ray diagnostic apparatus” in class 010, the Examining Attorney asserts that “the goods are related cited registrant’s contraception device because they could be used to diagnose or detect fertility, conception, or pregnancy.” Moreover, the Examining Attorney asserts that “absent restrictions in an application and/or registration, the identified goods are ‘presumed to travel in the same channels of trade to the same class of purchasers.’”

Applicant respectfully traverses these grounds of refusal for the reasons as follow.

Applicant first notes that the registrant’s listing of goods in class 010 is narrow, namely, “medical device, namely, an intrauterine device for contraception.” Thus, the registrant’s listing in class 010 does not cover all medical devices, but rather medical devices that are intrauterine devices for contraception.

Applicant respectfully submits that there is a significant difference between, for example, an “electromagnetic medical diagnostic imaging apparatus,” which is for testing and diagnostic purpose in laboratory, and an intrauterine device for contraception, which is a contraception device implanted in a body of a patient. None of the goods at issue in the application are medical devices for implantation in a patient, let alone having to do with contraception.

Moreover, Applicant notes that the relevant channels of trade are “all normal channels of trade **for those goods.**” *In re Southern Belle Frozen Foods Inc.*, 48 U.S.P.Q. 2d 1849, 1850 (TTAB 1998) [emphasis added]. Given the significant differences in the nature of the goods, Applicant submits that there is no basis for presuming that they would travel in the same channels of trade.

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Therefore, in light of 1) the differences between the Applicant's goods at issue in class 010 and registrant's own listing of goods, and 2) the high standard of care that would be exercised by the purchaser of the goods of both, Applicant submits that the relevant public would not mistakenly believe that they originate from or in some way are associated with or sponsored by the same producer on the basis of Applicant's use of the proposed mark.

Finally, Applicant owns two registrations including the word "SKYLA" for electronic goods (U.S. Reg. Nos. 3803996 and 3845790). The goods at issue in the present application for the same mark are all electronic equipment. Thus, the USPTO has already determined that the mark SKLYA for "medical device, namely, an intrauterine device for contraception" (U.S. Reg. No. 4342924) can coexist with Applicant's use of the proposed mark in connection with electronics.

Withdrawal of the refusal in connection with the goods at issue in class 010 is respectfully requested.