

RESPONSE TO POST REGISTRATION OFFICE ACTION TO SECTION 7 REQUEST

Introduction

This is submitted in Response to the Office's Second Post Registration Office Action dated October 3, 2014. Registrant has supplied the Office with:

1. An acceptable color drawing;
2. An acceptable color and description of mark statement;
3. The requested fee of \$100;
4. A color specimen showing use of the proposed mark as amended and supported by the statement that **“The specimen was in use in commerce at least as early as the filing date of the Section 7 Amendment”**; and
5. An executed Declaration supporting the specimen and noted statement.

Registrant respectfully requests that the Trademark Office promptly grant its Section 7 Request for Correction.

Overview

Registrant, DAIICHI SANKYO COMPANY, LIMITED (“Registrant”), a joint stock company of Japan, registered the following mark with the U.S. Trademark Office (as currently listed with the Office):



BENICAR and Design, U.S. Trademark Reg. No. 2,782,636, for Pharmaceutical preparations for the treatment of cardiovascular diseases including high blood pressure [congestive heart failure, diabetic nephropathy, atherosclerosis, and stroke] in Class 5.

Registrant recently reviewed its registration records and discovered a previous oversight between the USPTO and its former attorney (when the mark registered on November 11, 2003). Registrant's mark, which registered in 2003, is clearly lined for the colors red and teal blue and the Description of Mark Statement clearly outlines the color within the mark. However, a typographical error and discrepancy exists within the Color Claim/Description of Mark Statement that contradicts this information. Specifically, the Description of Mark/Color Statement indicates the following:

Color is **not** claimed as a feature of the mark. IN THE SHADED AREAS, THE COLOR OF THE EXPANDING ARROW IN THE MARK IS RED, WHILE THE COLOR OF THE INCOMPLETE CONCENTRIC CIRCLES AND THE "BENICAR" IN THE MARK IS TEAL BLUE.

Thus, the color is clearly detailed as a feature in the lining of the registered mark and in the Description of Mark Statement, but the Color Claim/Description of Mark Statement inadvertently lists "Color is **not** claimed as a feature of the mark". The term "not" should not be listed, as color is of course claimed as a feature the mark. Accordingly, Registrant now files a Section 7 Request for Correction to have the inadvertent and improper term "**not**" removed so that the language properly reads, "Color is claimed as a feature of the mark. IN THE SHADED AREAS, THE COLOR OF THE EXPANDING ARROW IN THE MARK IS RED, WHILE THE COLOR OF THE INCOMPLETE CONCENTRIC CIRCLES AND THE "BENICAR" IN THE MARK IS TEAL BLUE."

As a result, Registrant filed a Section 7 Request for Correction on August 28, 2014 requesting that the Office correct and amend its TESS/TARR records to reflect the following change to the Color Claim/Description of Mark Statement (removal of "not"):

- "Color is claimed as a feature of the mark. IN THE SHADED AREAS, THE COLOR OF THE EXPANDING ARROW IN THE MARK IS RED, WHILE THE COLOR OF THE INCOMPLETE CONCENTRIC CIRCLES AND THE "BENICAR" IN THE MARK IS TEAL BLUE."

I. Post Registration Office Action No. 1

In connection with Registrant's Section 7 Request for Correction, the Office issued a Post Registration Office Action on September 25, 2014. Specifically, the Trademark Specialist indicated both via telephone and the respective Post Registration Office Action that Registrant's Color Claim/Description of Mark Statement can **only** be amended if a color drawing is submitted for the record. Thus, in order to have the Color Claim/Description of Mark Statement corrected, the Office required that the mark must be amended from having color lining to the actual color detailed in the registration (as required under current USPTO drawing rules).

Registrant filed an Office Action Response on October 2, 2014 that conformed to the Office's color drawing requirement by submitting a color drawing that appears in the record, namely:



Registrant inserted a corrective Color and Description of Mark Statement and requested that the Office correct its TESS/TARR records to reflect the following change (removal of "not"):

- “Color is claimed as a feature of the mark. IN THE SHADED AREAS, THE COLOR OF THE EXPANDING ARROW IN THE MARK IS RED, WHILE THE COLOR OF THE INCOMPLETE CONCENTRIC CIRCLES AND THE "BENICAR" IN THE MARK IS TEAL BLUE.”

II. Post Registration Office Action No. 2

The Office now issues a second Post Registration Office Action dated October 3, 2014 that seemingly makes new requirements. Specifically, the Office now requires that Registrant submits a fee of \$100.00 for its Section 7 Request, files a color specimen showing use of the proposed mark as amended, includes the statement that “**The specimen was in use in commerce at least as early as the filing date of the Section 7 Amendment**”, and supports its statement and specimen with a Declaration executed by an authorized individual.

Registrant now submits the following to meet the Office’s current requirements:

- The requested fee of \$100;
- A color specimen showing use of the proposed mark as amended in the form of labels for the registered goods; and
- A Declaration executed by an authorized individual supporting the specimen and including the required statement that “**The specimen was in use in commerce at least as early as the filing date of the Section 7 Amendment**”.

For goods, the Trademark Office accepts labels, tags, packaging, containers or point of sale displays containing the mark **or the mark directly affixed to the goods** as specimens since the *general consuming public* is readily exposed to such examples of use, regardless of whether they purchase the product (e.g., store shelves, point of sale displays in stores, etc.). Registrant’s labels are acceptable specimens of use.

Registrant respectfully requests that the Trademark Office promptly grants its Section 7 Request for Correction so that its TESS/TARR records to reflect the following change to the Color Claim/Description of Mark Statement (removal of “not”):

- “Color is claimed as a feature of the mark. IN THE SHADED AREAS, THE COLOR OF THE EXPANDING ARROW IN THE MARK IS RED, WHILE THE COLOR OF THE INCOMPLETE CONCENTRIC CIRCLES AND THE "BENICAR" IN THE MARK IS TEAL BLUE.”

III. Conclusion

To meet the Office’s requirements, Registrant has now provided for the record the following:

- An acceptable color drawing;

- An acceptable color and description of mark statement;
- The requested fee of \$100;
- A color specimen showing use of the proposed mark as amended and supported by the statement that “**The specimen was in use in commerce at least as early as the filing date of the Section 7 Amendment**”; and
- An executed Declaration supporting the specimen and noted statement.

Accordingly, Registrant respectfully requests that the Office withdraws its objection and approve its Section 7 Request for Correction.

The Trademark Specialist is urged to telephone the undersigned if this would expedite the maintenance approval of this registration.

Best Regards,

/Christopher S. Adkins/

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