

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Izon Science Limited)	
Filing Date:	June 4, 2009)	
Mark:	IZON)	Trademark Law Office 104
Class:	009, 042)	Examining Attorney
Serial No.:	77/751,792)	Heather A. Biddulph

RESPONSE TO OFFICE ACTION

This communication responds to the September 11, 2009 Office Action.

REMARKS

I. Identification of Goods and Services

The Examining Attorney states that the wording in the identification of goods and services for Applicant's mark, IZON ("Applicant's Mark") in International Classes 9 and 42, is indefinite and must be clarified because it is too broad. Accordingly, Applicant respectfully proposes to amend the identifications in Class 9 and Class 42 in order to clarify and narrow the scope of the identifications as follows:

Class 9: Analysis, sensing, measuring and control apparatus and instruments for scientific use, namely, nanoparticle analysis instruments in the nature of scanning ion occlusion spectroscopy platforms for the detection, precision counting and measurement of particles; control apparatus, namely, systems controlling apertures in the nature of resizable nanopores for the control of particles; pressure cells for controlling the flow of particles through nanopores; automated fluid controls, namely, software and hardware for controlling the application of fluids to the nanopores

Class 42: Scientific research and development in the field of the detection, precision counting and measurement of viruses and nanoparticles

Applicant notes that it has proposed amendments to its identifications of goods and services that result in identifications that are identical to those associated with the trademarks (also owned by Applicant) qViro (U.S. Ser. No. 77522487) and qNano (U.S. Ser. No. 77522506), both of which have been issued Notices of Allowance. Accordingly, Applicant respectfully submits that the

proposed amendments to the identifications in the instant application are sufficient to clarify and narrow the scope of the identifications.

II. Potential Likelihood of Confusion Refusal – 2(d)

The Examining Attorney has refused to register Applicant's Mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), because she believes that there maybe be a likelihood of confusion between Applicant's Mark and U.S. Registration Nos. 3645710, 3188278 and 3645716 ("Registrants' Marks"). Applicant respectfully submits that in light of its proposed amendments to the identifications of goods, Applicant's Mark does not pose a likelihood of confusion with Registrants' Marks because the goods offered by the respective parties are vastly different, move in different channels of trade, and are targeted to different end users.

The Examining Attorney largely based her decision to refuse registration on the notion that "[A]pplicant's identified goods are related to the Registrants' identified goods because [A]pplicant's broadly identified goods encompass the prior Registrants' more narrowly identified goods." As Applicant has proposed to amend the identifications to more narrowly identify the goods at issue, Applicant submits that the proposed identifications of goods do not encompass the Registrants' goods. The goods comprised by Applicant's identifications are primarily nanoparticle analysis instruments in the nature of scanning ion occlusion spectroscopy platforms. The goods comprised by the Registrants' identifications are primarily various forms of eyewear and associated accessories. Applicant respectfully submits that there can be no likelihood of confusion between complex scientific equipment in the field of nanoparticle research on one hand, and eyewear on the other hand. Applicant's goods are highly technical in nature, and move in channels of trade that consist of sophisticated end users with highly specialized expertise and that specially order such instruments for purposes of scientific research. This is in

stark contrast to the channels of trade in which eyewear and associated accessories move in, which consist of laymen end users and involve mass consumption of ordinary goods in common consumer venues.

Furthermore, although in the instant case, as the Examining Attorney maintains, Registrants' Marks are either identical or phonetically equivalent to Applicant's Mark, the vast competitive differences between the goods at issue eliminate any likelihood of confusion, as consumers would not encounter the goods comprised by Applicant's Mark and the Registrants' Marks together. Indeed, case law has borne out many instances in which identical marks are determined to not pose any likelihood of confusion when the goods comprised by the marks are different and are sold in different channels of trade. See, e.g., Dynamics Research Corp. v. Langenau Manufacturing Co., 704 F.2d 1575 (Fed. Cir. 1983) (affirming the TTAB's finding that there was no likelihood of confusion caused by identical marks because the parties sold entirely different products to different customers).

Pursuant to the foregoing, Applicant respectfully requests that the Examining Attorney reconsider her opinion and allow Applicant's Mark to be published for opposition purposes.

III. Prior Pending Application

The Examining Attorney has also noted that the filing date of the pending application bearing U.S. Serial No. 77077393 ("Pending Application") precedes Applicant's filing date, and that if the mark in the Pending Application were to register, Applicant's Mark may be refused registration because of a likelihood of confusion. Applicant respectfully notes that the Pending Application comprises goods that are largely identical to the goods comprised by the Registrants' Marks (eyewear), and moreover, that the owner of the Pending Application is also the owner of U.S. Registration No. 3188278, one of the cited Registrants' Marks. Applicant thus respectfully

submits that the arguments set forth above are equally applicable in this instance and accordingly, that there would be no likelihood of confusion between Applicant's Mark and the mark in the Pending Application, should it register.

CONCLUSION

For all of the foregoing reasons, Applicant respectfully submits that the present application is in condition for publication and registration, and such action is hereby requested.

Dated: March 10, 2010