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Subject: U.S. TRADEMARK APPLICATION NO. 79076255 - EVER NEURO
PHARMA - NY2T10625100 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 79076255

MARK: EVER NEURO PHARMA



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: EVER Neuro Pharma GmbH

CORRESPONDENT'S REFERENCE/DOCKET NO:

NY2T10625100

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1021884

INTRODUCTION

The limited liability company, EVER Neuro Pharma GmbH (Applicant) has appealed the trademark examining attorney's final refusal to register the mark EVER NEURO PHARMA and design for (as amended) "Pharmaceutical preparations used for the treatment of central nervous system diseases and neurodegenerative diseases; Nutritional additives for medical purposes for use in foods and dietary supplements for human consumption" in International Class 005.

Registration was refused because the mark when used in connection with the aforementioned goods, is likely to cause confusion as to the source of the goods in U.S. Registration No. 3,329,636, NEUROPHARMA for use in association with "Pharmaceutical and veterinary preparations, in particular preparations for combating

neuron diseases; natural and synthetic bioactive preparations for application in the fields of human or animal medicine, namely, pharmaceutical and veterinary preparations acting on the central nervous system; intermediate pharmaceutical and veterinary preparations, namely, anaesthetic and analgesic ingredients sold as components of pharmaceutical and veterinary preparations acting on the central nervous system and for combating neuron diseases” in International Class 005 under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

Registration was also refused on the Principal Register pursuant to the Trademark Act, 15 U.S.C. §1056(a) for Applicant’s failure to provide the required disclaimer of “NEURO PHARMA.”

It is respectfully requested that the refusals to register be affirmed for the reasons set forth below.

STATEMENT OF THE FACTS

On October 22, 2009, Applicant applied for registration of the mark EVER NEURO PHARMA and design on the Principal Register by requesting an Extension of Protection from its International Registration for use with the goods (as amended) “Pharmaceutical preparations used for the treatment of central nervous system diseases and neurodegenerative diseases; Nutritional additives for medical purposes for use in foods and dietary supplements for human consumption” in International Class 005.

In the Office action dated February 2, 2010, registration of the mark was refused based on a likelihood of confusion with the mark in U.S. Registration No. 3,329,636 under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). Applicant was also required to (1) submit a color claim and mark description, (2) clarify particular wording

in the identification of goods and (3) submit a disclaimer of the wording “NEURO PHARMA.”

Applicant responded on July 30, 2010, by presenting arguments in support of registration, submitting a color claim and mark description, clarifying particular wording in the identification of goods and submitting a disclaimer of “NEURO” and “PHARMA.” The trademark examining attorney found Applicant’s arguments unpersuasive and continued and made final the refusal to register due to the likelihood of confusion with the registered mark. The trademark examining attorney determined that the submitted color claim and mark description were acceptable and the amended identification of goods was also acceptable. However, the trademark examining attorney found that Applicant’s disclaimer of “NEURO” and “PHARMA” was not acceptable and continued and made final the refusal to register due to Applicant’s failure to submit the required disclaimer.

In the subsequent request for reconsideration dated February 28, 2011, Applicant made additional arguments traversing the refusal. Furthermore, Applicant withdrew its disclaimer. The trademark examining attorney denied Applicant’s request for reconsideration, and maintained the refusal to register under Section 2(d) and for Applicant’s failure to provide the required disclaimer of “NEURO PHARMA.” Applicant filed a Notice of Appeal to the Trademark Trial and Appeal Board (TTAB or the Board) on February 28, 2011 and its appeal brief thereafter.

ISSUES ON APPEAL

There are two issues on appeal.

The first issue on appeal is whether Applicant’s mark EVER NEURO PHARMA and design for use in association with “Pharmaceutical preparations used for the treatment of central nervous system diseases and neurodegenerative diseases; Nutritional additives for medical purposes for use in foods and dietary supplements for human consumption,” is likely to cause confusion with the mark in U.S. TM Reg. No. 3,329,636 - NEUROPHARMA for use in association with “Pharmaceutical and veterinary preparations, in particular preparations for combating neuron diseases; natural and synthetic bioactive preparations for application in the fields of human or animal medicine, namely, pharmaceutical and veterinary preparations acting on the central nervous system; intermediate pharmaceutical and veterinary preparations, namely, anaesthetic and analgesic ingredients sold as components of pharmaceutical and veterinary preparations acting on the central nervous system and for combating neuron diseases,” under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

The second issue on appeal is whether a disclaimer of the wording “NEURO PHARMA” is required in the present application because the wording is descriptive of a characteristic or feature of the goods.

ARGUMENTS

I. THE MARKS ARE HIGHLY SIMILAR AND THE GOODS ARE IDENTICAL AND CLOSELY RELATED SUCH THAT THERE IS A LIKELIHOOD OF CONFUSION UNDER §2(D) OF THE TRADEMARK ACT, 15 U.S.C. §1052(D)

The Applicant seeks registration of the mark EVER NEURO PHARMA and design for goods consisting of “Pharmaceutical preparations used for the treatment of central nervous system diseases and neurodegenerative diseases; Nutritional additives for medical purposes for use in foods and dietary supplements for human consumption.”

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