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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	88015911
Applicant	HEALIOS K.K.
Applied for Mark	HEALIOS
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Submission	Applicants Request for Remand and Amendment
Attachments	Healios - 88015911 - Motion to Remand - 1-21-20 PDF.pdf(2766913 bytes)
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Date	01/21/2020

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Application Serial No. Subject of Ex Parte Appeal	88015911
Applicant	HEALIOS K.K.

MOTION TO REMAND

Further to Applicant’s Motion to Suspend for 30 Days, filed on January 13, 2020, and pursuant to 37 C.F.R. § 2.142(d) and TBMP Section 1207.02, Applicant Healios K.K. (“Applicant”) respectfully requests that the subject matter be remanded to the care of the Examining Attorney of the subject application for review of the attached “Trademark Coexistence and Consent Agreement” (“the Agreement”), recently executed by Applicant and the owner of cited Registration No. 4467941, Labrada Bodybuilding Nutrition, Inc. (“Labrada”). The Agreement was signed in counterparts, and the version signed by Labrada is attached hereto as Exhibit 1A; and the version signed by Applicant is attached hereto as Exhibit 1B. The Agreement may allow the Examining Attorney to withdraw the refusal based on likelihood of confusion under Section 2(d) of the Trademark Act, as the following guidance is set forth in TMEP Section 1207.01(d)(viii):

Thus, examining attorneys should give substantial weight to a proper consent agreement. When an applicant and registrant have entered into a credible consent agreement and, on balance, the other factors do not dictate a finding of likelihood of confusion, an examining attorney should not interpose his or her own judgment that confusion is likely.

Good Cause

Applicant submits that there is good cause for the Trademark Trial and Appeal Board (“the Board”) to grant the requested suspension because TBMP Section 1207.02 states:

In addition, because a consent agreement offered in response to a refusal to register under Trademark Act § 2(d), 15 U.S.C. § 1052(d), is inherently difficult and time-consuming to obtain, and may be highly persuasive of registrability [*Note 6 omitted*], the Board will grant a request to suspend and remand for consideration of a consent agreement if the request, accompanied by the consent agreement, is

filed at any time prior to the rendering of the Board's final decision on the appeal.

Conclusion

In light of the foregoing, Registrant respectfully contends that good cause exists for the granting of the present motion, and requests that the motion be granted, and that this matter be remanded to the Examining Attorney, for the review of the attached Agreement.

Respectfully submitted,

HEALIOS K.K.

Date: January 21, 2020

/M. Scott Alprin/

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Trademark Coexistence and Consent Agreement

This Trademark Coexistence and Consent Agreement (“Agreement”) is entered into as of the date of the latest valid signature by either party below (“Effective Date”), by and between HEALIOS K.K. (“Healios Japan”) a Japan corporation having an address of 2-4-1 Hamamatsucho Minato-ku, Tokyo Japan 105-6115, and Labrada Bodybuilding Nutrition, Inc. (“Labrada”), a Texas corporation having an address of 333 Northpark Central Drive Suite Z Houston Texas 77073.

WHEREAS, Healios Japan owns United States Trademark Application Serial No. **88015911** (“the Healios Application”), filed on June 26, 2018, for the mark “Healios” (“the Healios Japan Mark) for *“Cells for medical or clinical use; cells for medical or clinical use for treatment of diseases; stem cells for medical purposes; stem cells for veterinary purposes; surgical implants comprising living tissue grown from stem cells; biological tissue cultures for medical purposes; biological tissue cultures for veterinary purposes; biological preparations for the treatment of ophthalmic, central nervous, respiratory, or cardiovascular disease; biological preparations for veterinary purposes for the treatment of cancer, liver disease and immune system related disease; diagnostic preparations for medical and veterinary use; diagnostic reagents for medicinal use; veterinary diagnostic reagents; adjuvants for medical purposes; cytostatics for medical purposes; pharmaceutical preparations for activating cellular function for the treatment of cancer, liver disease and immune system related disease; sanitary preparations for medical use; ophthalmic preparations; pharmaceutical preparations for the treatment of eye diseases and conditions; pharmaceutical preparations for ocular or intraocular surgery; collyrium; eye drops; pharmaceutical agents affecting the central nervous system; pharmaceutical preparations for the peripheral nervous system; cardiovascular agents for medical purposes; cardiovascular treatment preparations; cardiovascular pharmaceuticals; cardiovascular pharmaceutical preparations; respiratory stimulants; pharmaceutical products for treating respiratory diseases; pharmaceutical preparations for the treatment of immune system related diseases and disorders; anti-inflammatories; pharmaceutical agents affecting digestive organs; pharmaceutical agents for treating physically caused lesions; opotherapy preparations; organotherapy preparations; gene therapy products, namely, genetically engineered tissues for transplant purposes; surgical implants comprised of living tissues; pharmaceutical preparations and substances for the treatment of damaged skin and tissue; pharmaceutical preparations and substances for use in the fields of anesthesia, oncology, urology and gynecology”* in International Class 5 (“the Healios Japan Goods”).

WHEREAS, Labrada owns United States Trademark Registration No. **4467941** (“the Labrada Registration”), filed on September 13, 2012 and registered on January 14, 2014, for the mark “HEALIOS” (“the Labrada Mark”) for *“Dietary and nutritional supplements; Vitamin and mineral supplements for use as ingredients in the food and pharmaceutical industry”* in International Class 5 (“the Labrada Goods”).

WHEREAS, the Healios Japan Mark has been refused registration by an examining attorney of the USPTO on the basis of likelihood of confusion with the Labrada Mark.

WHEREAS, the parties are unaware of any instance of actual confusion resulting from their use of their respective marks in any country or territory;

WHEREAS, each party agrees to the use and registration the other party's above-mentioned mark in the United States and Japan, and both parties agree that, due to differences between the Healios Japan Goods and the Labrada Goods, the marks may coexist in the United States and Japan without confusion as to source amongst respective consumers or potential consumers.

WHEREAS, Healios Japan intends to market the Healios Japan Goods to medical institutions, pharmaceutical companies and academic institutions for the purpose of regenerative medicine, and whereas Healios Japan currently has no plans to sell any of the goods listed in the Labrada Registration.

WHEREAS, the Labrada Goods are currently marketed to cancer patients for the purpose of providing pain relief, and whereas Labrada currently has no plans to sell any of the goods listed in the Healios Japan Application.

NOW, THEREFORE, in consideration of the mutual promises and agreements contained in this Agreement, the parties agree to and acknowledge the following:

1. To the best of the parties' knowledge and based on their experiences in their respective industries and markets, no confusion is likely to arise from the parties' use and registration of their respective marks because the channels of trade of the respective parties are distinct from one another, and because the differences between the Healios Japan Goods and the Labrada Goods are sufficient to minimize the likelihood of confusion in the minds of relevant consumers.
2. The parties shall cooperate and communicate with each other as reasonably appropriate to avoid a likelihood of confusion between their respective marks. The parties shall not intentionally attempt to associate themselves, their marks, or their goods with the other party's marks and goods.
3. To the extent that one party becomes aware of any instance of consumer confusion involving the parties' marks, that party shall apprise the other party, and the parties shall take reasonable steps to abate such confusion.
4. For the foregoing reasons,
 - a. Labrada consents to the use and registration of the Healios Japan Mark by Healios Japan in the United States and Japan in connection with the Healios Japan Goods;
 - b. Healios Japan consents to the use and registration of the Labrada Mark by Labrada in the United States and Japan in connection with the Labrada Goods.
5. Each party represents and warrants to the other party that (i) it has the full power and authority to enter into this Agreement and to perform all of its obligations

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