

**To:** ASICS Corporation ([ajthurston@BryanCave.com](mailto:ajthurston@BryanCave.com))  
**Subject:** TRADEMARK APPLICATION NO. 76190823 - KEEP RUNNING - ASICS-KEEP R  
**Sent:** 8/18/2005 5:13:01 PM  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 76/190823  
**APPLICANT:** ASICS Corporation  
**CORRESPONDENT ADDRESS:**  
Adam J. Thurston  
Bryan Cave LLP  
Suite 300  
120 Broadway  
Santa Monica CA 90401-2386



**BEFORE THE  
TRADEMARK TRIAL  
AND APPEAL BOARD  
ON APPEAL**

**MARK:** KEEP RUNNING

**CORRESPONDENT'S REFERENCE/DOCKET NO:** ASICS-KEEP R

Please provide in all correspondence:

**CORRESPONDENT EMAIL ADDRESS:**  
[ajthurston@BryanCave.com](mailto:ajthurston@BryanCave.com)

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

The Office has reassigned this application to the undersigned-examining attorney.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

<b>Applicant:</b>	ASICS Corporation	:	BEFORE THE
<b>Trademark:</b>	KEEP RUNNING	:	TRADEMARK TRIAL
<b>Serial No:</b>	76/190823	:	AND
<b>Attorney:</b>	Adam J. Thurston	:	APPEAL BOARD

Address: Bryan Cave LLP  
Suite 300  
120 Broadway  
Santa Monica CA 90401-2386

: ON APPEAL

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### EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed a final determination of likelihood of confusion under Trademark Act Section 2 (d).

### STATEMENT OF FACTS

On January 8, 2001, applicant applied for the mark KEEP RUNNING for "athletic shoes" <sup>[1]</sup> in Class 25 with Serial No. 76/177,195. The mark was refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with Registration No. 2,616,316 for the mark KEEP WALKING, and design of a person walking, for "clothing, namely, shirts, suits, pants, slacks, jeans, shorts, sweaters, hosiery, socks, ties, belts, shoes, sneakers, sandals, slippers, scarves, gloves, skirts, blouses, blazers, jackets, coats, sport coats, raincoats, overcoats, t-shirts, warm-up suits, jogging suits, bathrobes, underwear, boxer shorts, nightgowns, pajamas, camisoles, aprons, vests, sweatshirts, swim suits, headbands, wrist bands, caps, hats, visors," in Class 25; and with Registration No. 2,682,152 for the mark KEEP WALKING for "clothing, namely, shirts, suits, pants, slacks, jeans, shorts, sweaters, hosiery, socks, ties, belts, scarves, gloves, skirts, blouses, blazers, jackets, coats, sport coats, raincoats, overcoats, t-shirts, warm-up suits, jogging suits, bathrobes, underwear, boxer shorts, nightgowns, pajamas, camisoles, aprons, vests, sweatshirts, swim suits, headbands, wrist bands, caps, hats, visors," in Class 25. The refusal was made final on March 15, 2004. A request for reconsideration filed on October 20, 2004 was denied. This appeal ensued.

## ISSUE

Whether there is a likelihood of confusion under Trademark Act Section 2(d) between the mark KEEP WALKING (typed-drawing) in Registration No. 2,682,152 for articles of clothing, in Class 25, and the mark KEEP WALKING and design in Registration No. 2,616,316 for articles of clothing including footwear, in Class 25,<sup>[2]</sup> and applicant's mark KEEP RUNNING in the current Serial No. 76/190,823 for athletic shoes, in Class 25.

## ARGUMENTS

There can be several factors considered in determining whether there is a likelihood of confusion under Section 2(d). *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). In this case, the following elements are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999).

Concerning the similarity of the marks, applicant's mark consists entirely of the wording KEEP RUNNING, and registrant's marks consist of KEEP WALKING and KEEP WALKING with the design of a well-dressed walking individual. The literal portions of both marks are similar in appearance and meaning. Furthermore, the record contains a dictionary entry comparing both terms ("run: a pace faster than a walk").<sup>[3]</sup> Running is a faster version of walking. When it comes to footwear, they identify the purpose of the goods, and the phrases KEEP WALKING and KEEP RUNNING are suggestive of the primordial activity of the wearer of athletic footwear. KEEP WALKING and KEEP RUNNING are alike inasmuch they are both directed instructions to the relevant customers. The syntax of the marks creates a sense of relationship and customers are wont to believe that the products under the marks are associated. The design component in one of registrant's marks does not obviate the similarity in this case. *In re Shell Oil Company*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993). The wording in

marks is phonetically and visually identical in one element and analogous in the other element. Considering the above, the relevant public would view the marks as confusingly similar upon encountering them in the same trade.

In comparing the registrant's and applicant's goods it becomes apparent that applicant and registrant are in the same trade. Registrant provides general clothing goods identified in Registration No. 2,682,152 (KEEP WALKING), and specifically footwear identified in Registration No. 2,616,316 (KEEP WALKING and design). Applicant's goods are athletic footwear. The decisions in the clothing field have held many different types of apparel to be related under Section 2(d). *Cambridge Rubber Co. v. Cluett, Peabody & Co., Inc.*, 286 F.2d 623, 128 USPQ 549 (C.C.P.A. 1961) ("WINTER CARNIVAL" for women's boots v. men's and boys' underwear); *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992) ("ELANCE" for underwear v. "ELAAN" for neckties); *In re Melville Corp.* 18 USPQ2d 1386 (TTAB 1991) ("ESSENTIALS" for women's pants, blouses, shorts and jackets v. women's shoes); *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985) ("NEWPORTS" for women's shoes v. "NEWPORT" for outer shirts); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397 (TTAB 1982) ("OMEGA" for hosiery v. trousers); *In re Cook United, Inc.*, 185 USPQ 444 (TTAB 1975) ("GRANADA" for men's suits, coats, and trousers v. ladies' pantyhose and hosiery); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400 (TTAB 1964) ("SLEEX" for brassieres and girdles v. slacks for men and young men).

Applicant states that its customers are sophisticated customers; however, the record is devoid of proof for this assertion. Nonetheless, sophisticated costumers in a particular field do not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). Though athletic footwear may occasionally be expensive, generally speaking they must be viewed as impulse purchase goods. Athletic footwear serves a basic utilitarian and aesthetic function that require intermittent but periodic purchases. In the end, applicant's and registrant's goods appeal to the same type of clientele: purchasers of clothing and footwear. Though applicant's footwear may be considered expensive at the present time; there are

no set limitations in either applicant's or registrant's identification on the purchase cost of the relevant goods. Price fluctuations on these types of products are common based on fashion trends and supply and demand considerations, and applicant's and registrant's goods may become more and/or less expensive in the course of time.

The examining attorney must determine whether there is a likelihood of confusion on the basis of the goods identified in the application and registration. If the cited registration describes the goods broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, it is presumed that the registration encompasses all goods of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). TMEP §1207.01(a)(iii).

Applicant argues that there have not been any instances of actual confusion; however, the test under Section 2(d) of the Trademark Act is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990).

Applicant references third party registrations to show dilution of marks that contain the word KEEP. The use of KEEP in other marks does not correlate in form or connotation with the marks at hand. Moreover, in a Trademark Act Section 2(d) analysis, the marks and the goods must be looked in their entireties; and third-party registrations, by themselves, are entitled to little weight on the question of likelihood of confusion. *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983).

#### CONCLUSION

For the foregoing reasons, the refusal to register on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), because of a likelihood of confusion for the reasons that applicant's mark and registrant's mark are similar and the goods and services move in the same trade channels,

should be affirmed.

Respectfully submitted,

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[1] As amended in the request for reconsideration filed August 22, 2004.

[2] Relevant International Class cited.

[3] See attached dictionary definition. TBMP Section 1208.04



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RUN

PRONUNCIATION: ˈrʌn

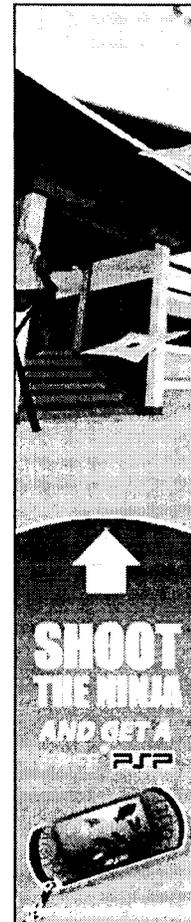
VERB Inflected forms: ran (ˈrʌn), run, run-ning, runs

INTRANSITIVE VERB 1a. To move swiftly on foot so that both feet leave the ground during each stride. b. To move at a fast gallop. Used of a horse. 2. To retreat rapidly; flee: seized the money and ran. 3a. To move without hindrance or restraint: dogs that always ran loose. b. To go or move about from place to place; roam: I am always running about, looking for my glasses. 4. To migrate, especially to move in a shoal in order to spawn. Used of fish. 5a. To move or go quickly; hurry: run for the police; ran for help. b. To go when in trouble or distress: He is always running to his lawyer. c. To make a short, quick trip or visit: ran next door to borrow a cup of sugar; ran down to the store. 6a. To take part in a race or contest: ran in the marathon; athletes who run for the gold medal. b. To compete in a race for elected office: ran for mayor. c. To finish a race or contest in a specified position: ran second. 7. To move freely, on or as if on wheels: The car ran downhill. The drawer runs on small bearings. 8. To be in operation: The engine is running. 9. To go back and forth especially on a regular basis; ply: The ferry runs every hour. 10. Nautical To sail or steer before the wind or on an indicated course: run before a storm. 11a. To flow, especially in a steady stream: Fresh water runs from the spring. Turn on the faucet and let the water run. b. To emit pus, mucus, or serous fluid: Pollen makes my nose run. c. To be wet or covered with a liquid: The street ran with blood. The mourners' eyes ran with tears. 12. To melt and flow: A hot flame will make the solder run. 13.

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To spread or dissolve, as dyes in fabric: *Colorfast garments are not supposed to run.* 14. To extend, stretch, or reach in a certain direction or to a particular point: *This road runs to the next town.* 15. To extend, spread, or climb as a result of growing: *Ivy ran up the wall.* 16. To spread rapidly: *disease that ran rampant.* 17a. To be valid in a given area: *The speed limit runs only to the town line.* b. To be present as a valid accompaniment: *Fishing rights run with ownership of the land.* 18. To unravel along a line: *Her stocking ran.* 19. To continue in effect or operation: *a lease with one year to run.* 20. To pass: *Days ran into weeks.* 21. To tend to persist or recur: *Stinginess seems to run in that family.* 22a. To accumulate or accrue: *The interest runs from the first of the month.* b. To become payable. 23. To take a particular form, order, or expression: *My reasoning runs thus. The report runs as follows.* 24. To tend or incline: *Their taste in art runs to the bizarre.* 25. To occupy or exist in a certain range: *The sizes run from small to large.* 26. To be presented or performed for a continuous period of time: *The play ran for six months.* 27. To pass into a specified condition: *We ran into debt.* 28. Informal To leave; depart: *Sorry, I have to run.*

TRANSITIVE  
VERB:

1a. To travel over on foot at a pace faster than a walk: *ran the entire distance.* b. To cause (an animal) to move quickly or rapidly: *We run our hunting dogs every morning.* 2. To allow to move without restraint. 3. To do or accomplish by or as if by running: *run errands.* 4. To hunt or pursue; chase: *dogs running deer.* 5. To bring to a given condition by or as if by running: *The toddlers ran me ragged.* 6. To cause to move quickly: *She ran her fingers along the keyboard.* 7a. To cause to compete in or as if in a race: *He ran two horses in the Kentucky Derby.* b. To present or nominate for elective office: *The party ran her for senator.* 8. To cause to move or progress freely. 9. To cause to function; operate: *run a machine.* 10. To convey or transport: *Run me into town. Run the garbage over to the dump.* 11. Football To attempt to advance (the ball) by carrying it. 12. To submit for consideration or review: *I'll run the idea by you before I write the proposal.* 13. Nautical To cause to move on a course: *We ran our boat into a cove.* 14a. To smuggle: *run guns.* b. To evade and pass through: *run a roadblock.* 15. To pass over or through: *run the rapids.* 16. To cause to flow: *run water into a tub.* 17. To stream with: *The fountains ran champagne.* 18. Metallurgy a. To melt, fuse, or smelt (metal). b. To mold or cast (molten metal): *run gold into ingots.* 19. To cause to extend or pass: *run a rope between the poles.* 20. To mark or trace on a surface: *run a pencil line between two points.* 21. To sew with a continuous line of stitches: *run a seam.* 22. To cause to unravel along a line: *She ran her stocking on a splinter.* 23a. To cause to crash or collide: *ran the car into a fence.* b. To cause to penetrate: *I ran a pin into my thumb.* 24. To continue to present or perform: *ran the film for a month.* 25. To publish in a periodical: *run an advertisement.* 26. To subject oneself or be subjected to: *run a risk.* 27. To have as an ongoing financial obligation: *run a deficit; run a tab.* 28. Games a. To score (balls or points) consecutively in billiards: *run 15 balls.* b. To clear (the table) in pool by consecutive scores. 29. To conduct or perform: *run an experiment.* 30. Computer Science To process or execute (a program or instruction). 31. To control, manage, or

process or execute (a program or instruction). 31. To control, manage, or direct: *ran the campaign by himself; a bureau that runs espionage operations.*

**NOUN** 1a. A pace faster than a walk. b. A fast gallop. Used of a horse. 2. An act of running. 3a. A distance covered by or as if by running. b. The time taken to cover such a distance: *It is a two minutes' run from the subway.* 4. A quick trip or visit: *a run into town.* 5a. Sports A running race: *the winner of the mile run.* b. A campaign for public office: *She managed his successful senatorial run.* 6. *abbr. R Baseball* A point scored by advancing around the bases and reaching home plate safely. 7. *Football* A player's attempt to carry the ball past or through the opposing team, usually for a specified distance: *a 30-yard run.* 8a. The migration of fish, especially in order to spawn. b. A group or school of fish ascending a river in order to spawn. 9. Unrestricted freedom or use: *I had the run of the library.* 10. A stretch or period of riding, as in a race or to the hounds. 11a. A track or slope along or down which something can travel: *a logging run.* b. Sports A particular type of passage down a hill or across country experienced by an athlete, especially a skier or bobsledder: *had two very good runs before the end of the day.* 12. Sports The distance a golf ball rolls after hitting the ground. 13a. A scheduled or regular route. b. The territory of a news reporter. 14a. A continuous period of operation, especially of a machine or factory. b. The production achieved during such a period: *a press run of 15,000 copies.* 15a. A movement or flow. b. The duration of such a flow. c. The amount of such a flow. 16. A pipe or channel through which something flows. 17. *Eastern Lower Northern U.S.* See **creek** (sense 1). 18. A fall or slide, as of sand or mud. 19. Continuous length or extent: *a five-foot run of tubing.* 20. *Geology* A vein or seam, as of ore or rock. 21. The direction, configuration, or lie: *the run of the grain in leather.* 22a. A trail or way made or frequented by animals. b. An outdoor enclosure for domestic animals or poultry: *a dog run; a turkey run.* 23a. A length of torn or unraveled stitches in a knitted fabric. b. A blemish caused by excessive paint flow. 24a. An unbroken series or sequence: *a run of dry summers.* b. *Games* A continuous sequence of playing cards in one suit. c. An unbroken sequence or period of performances or presentations, as in the theater. d. A successful sequence of actions, such as well-played shots or victories in a sport. e. *Music* A rapid sequence of notes; a roulade. f. A series of unexpected and urgent demands, as by depositors or customers: *a run on a bank.* 25. A sustained state or condition: *a run of good luck.* 26. A trend or tendency: *the run of events.* 27. The average type, group, or category: *The broad run of voters want the candidate to win.* 28. *Computer Science* An execution of a specific program or instruction. 29. *Nautical* The immersed part of a ship's hull abaft of the middle body. 30. *Slang* Diarrhea. Often used with *the*.

**ADJECTIVE** 1. Being in a melted or molten state: *run butter; run gold.* 2. Completely exhausted from running.

**PHRASAL VERBS** **run across** To find by chance; come upon. **run after** 1. To pursue; chase. 2. To seek the company or attention of for purposes of courting: *He finally*

*became tired of running after her.* **run against** 1. To encounter unexpectedly; run into. 2. To work against; oppose: *found public sentiment running against him.* **run along** To go away; leave. **run away** 1. To flee; escape. 2. To leave one's home, especially to elope. 3. To stampede. **run down** 1. To stop because of lack of force or power: *The alarm clock finally ran down.* 2. To make tired; cause to decline in vigor. 3a. To collide with and knock down: *a pedestrian who was run down by a speeding motorist.* b. Nautical To collide with and cause to sink. 4. To chase and capture: *Detectives ran down the suspects.* 5. To trace the source of: *The police ran down all possible leads in the case.* 6. To disparage: *Don't run her down; she is very talented.* 7. To go over; review: *run down a list once more.* 8. **Baseball** To put a runner out after trapping him or her between two bases. **run in** 1. To insert or include as something extra: *ran in an illustration next to the first paragraph.* 2. **Printing** To make a solid body of text without a paragraph or other break. 3. **Slang** To take into legal custody. 4. To pay a casual visit: *We ran in for an hour.* **run into** 1. To meet or find by chance: *ran into an old friend.* 2. To encounter (something): *ran into trouble.* 3. To collide with. 4. To amount to: *His net worth runs into seven figures.* **run off** 1. To print, duplicate, or copy: *ran off 200 copies of the report.* 2. To run away; elope. 3. To flow off; drain away. 4. To decide (a contest or competition) by a runoff. 5. To force or drive off (trespassers, for example). **run on** 1. To keep going; continue. 2. To talk volubly, persistently, and usually inconsequentially: *He is always running on about his tax problems.* 3. To continue a text without a formal break. **run out** 1. To become used up; be exhausted: *Our supplies finally ran out.* 2. To put out by force; compel to leave: *We ran him out of town.* 3. To become void, especially through the passage of time or an omission: *an insurance policy that had run out.* **run over** 1. To collide with, knock down, and often pass over: *The car ran over a child.* 2. To read or review quickly: *run over a speech before giving it.* 3. To flow over. 4. To go beyond a limit: *The meeting ran over by 30 minutes.* **run through** 1. To pierce: *The soldier was run through by a bayonet.* 2. To use up quickly: *She ran through all her money.* 3. To rehearse quickly: *Let's run through the first act again.* 4. To go over the salient points or facts of: *The crew ran through the preflight procedures. We ran through the witness's testimony before presenting it in court.* **run up** To make or become greater or larger: *ran up huge bills; run up the price of the company's stock.* **run with** 1. To keep company: *runs with a wild crowd.* 2. To take as one's own; adopt: "[He] was determined to run with the idea and go public before it had been researched" (Betty Cuniberti).

**IDIOMS:** **a run for (one's) money** Strong competition. **in the long run** In the final analysis or outcome. **in the short run** In the immediate future. **on the run** 1a. In rapid retreat: *guerrillas on the run after an ambush.* b. In hiding: *fugitives on the run.* 2. Hurrying busily from place to place: *executives always on the run from New York to Los Angeles.* **run a temperature (or fever)** To have a higher than normal body temperature. **run away with** 1a. To make off with hurriedly. b. To steal. 2. To be greater or bigger than others in (a performance, for example). **run foul (or afoul) of** 1. To run into; collide with: *a sloop that*

for example). **run foul** (or **afoul**) **of** 1. To run into; collide with: *a sloop that had run foul of the submerged reef*. 2. To come into conflict with: *a pickpocket who ran foul of the law*. **run in place** To go through the movements of running without leaving one's original position. **run interference** To deal with problems or difficult matters for someone else. **run off at the mouth** To talk excessively or indiscreetly. **run off with** To capture or carry off: *ran off with the state championship*. **run (one's) eyes over** To look at or read in a cursory manner. **run out of** To exhaust the supply of: *ran out of fuel*. **run out of gas** (or **steam**) *Slang* 1. To exhaust one's energy or enthusiasm. 2. To falter or come to a stop because of a lack of capital, support, or enthusiasm. **run out on** To abandon: *has run out on the family*. **run rings around** To be markedly superior to. **run scared** *Informal* To become intimidated or frightened. **run short** To become scanty or insufficient in supply: *Fuel oil ran short during the winter*. **run short of** To use up so that a supply becomes insufficient or scanty: *ran short of paper clips*. **run to earth** (or **ground**) To pursue and successfully capture: *Dogs ran the fox to earth*. *The police ran the terrorists to ground*.

**ETYMOLOGY:** Middle English *ermen*, *runnen*, from Old English *rinnan*, *eorman*, *earnan*, and from Old Norse *rinna*. See [rej-](#) in Appendix I.

**REGIONAL NOTE:** Terms for "a small, fast-flowing stream" vary throughout the eastern United States especially. Speakers in the eastern part of the Lower North (including Virginia, West Virginia, Delaware, Maryland, and southern Pennsylvania) use the word *run*. Speakers in the Hudson Valley and Catskills, the Dutch settlement areas of New York State, may call such a stream a *kill*. *Brook* has come to be used throughout the Northeast. Southerners refer to a *branch*, and throughout the northern United States the term is *creek*, a variant of *creek*.

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