

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77370042
LAW OFFICE ASSIGNED	LAW OFFICE 114
MARK SECTION (no change)	
ARGUMENT(S)	
<u>Request for Reconsideration</u>	
<p>The Applicant's mark is comprised of the coined term "MANWEAR." Applicant's goods are identified in the Application as:</p> <p>IC 016 - Men's accessories, namely, money clips, folders used as travel organizers and memo holders</p> <p>IC 018 - Men's accessories namely, briefcase-type portfolios, tote bags, compartment bags, namely all purpose carrying bags with multiple compartments; Men's small leather goods namely, wallets, key chains, travel kits in the nature of shaving bags, travel bags, luggage, business card cases</p> <p>IC 025 - Men's clothing, namely, coats, jackets, vests, sweaters, t-shirts, shirts, jerseys, shorts, parkas, pullovers, wind-jackets, pants, raincoats; sportswear, namely, sweatsuits, leisure suits, jeans, sport jackets, overalls; underwear, namely, short and long sleeve tee-shirts, long johns, briefs, boxers; Men's leather clothing, namely, coats, jackets, vests, shorts, parkas, pants, raincoats; Men's fashion accessories, namely, ties, socks, caps, gloves, belts, wristband, watch wristband, hats, shoes and scarves</p> <p>The Office Action, dated November 6, 2008, states that the Examiner refuses registration of Applicant's mark in Class 25 only because the proposed mark is merely descriptive of a feature or characteristic of the Applicant's goods. The Applicant respectfully requests reconsideration of the refusal of registration, and requests the Examiner to consider the following.</p> <p>A. Request to divide application.</p> <p>The Applicant has, concurrently with the filing of this Request for Reconsideration, filed a Request To Divide the subject Application into the following two applications:</p> <p>(1) Application Serial No. 77/370,042: Filing Date January 11, 2008; Goods: IC 025. - Men's clothing, namely, coats, jackets, vests, sweaters, t-shirts, shirts, jerseys, shorts, parkas, pullovers, wind-jackets, pants, raincoats; sportswear, namely, sweatsuits, leisure suits, jeans, sport jackets,</p>	

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(2) New Application (Serial No. to be assigned): Filing Date January 11, 2008; Goods: IC 016 - Men's accessories, namely, money clips, folders used as travel organizers and memo holders and

IC 018. - Men's accessories namely, briefcase-type portfolios, tote bags, compartment bags, namely all purpose carrying bags with multiple compartments; Men's small leather goods namely, wallets, key chains, travel kits in the nature of shaving bags, travel bags, luggage, business card cases

As the Office Action did not refuse registration in Classes 16 and 18, the Applicant request approval of the newly created application for publication.

B. The Mark is not merely descriptive.

The Examiner has commented that the proposed mark is merely descriptive of a feature or characteristic of the Applicant's goods. The Applicant submits that the evidence of record does not establish that the mark MANWEAR is merely descriptive.

The courts and TTAB have used the following three-part test to determine descriptiveness: (1) is the mark used as the name of the goods or services, (2) does the mark immediately tell the potential purchaser only what the goods or services are or what their function, characteristics or uses are, and (3) is the mark in common usage as a description of the goods or services? *Ex parte Heatube Corporation*, 109 USPQ 423 (CCPA 1956).

Under this test, the Applicant's MANWEAR mark is not merely descriptive of the Applicant's goods, because the words "MANWEAR" (1) are not used as the name of the goods, (2) do not convey the immediate idea or a readily understood meaning of those goods, and (3) are not in common usage as a description of the goods. Each of these points is supported by the evidence of record.

(1) MANWEAR is not used as the name of the Applicant's goods. The evidence made of record shows this.

(a) One component of the evidence made of record by the Examiner demonstrates that the term "menswear" is a recognized term for male clothing. This evidence, consisting of 213 internet articles and websites, fails to show even one instance where "manwear" is used, much less used as the name for male clothing. The evidence does not show use of the mark as the name for the Applicant's goods.

(b) A second component of the evidence consists of dictionary definitions of the words "man" and "wear." The Applicant does not dispute these definitions. However, the combination of these terms is not used as a name for the Applicant's goods. The combination "manwear," to the extent it conveys any meaning, has a unique non-descriptive meaning. See, TMEP § 1209.03(d): "However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods. See *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE held not merely descriptive of bakery products); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool)." The evidence does not show use of the mark as the name for the Applicant's goods.

(c) A third component of the Examiner's evidence consists of a listing of entries from the Trademark ID Manual. This contains entries for terms such as eyewear, footwear, beachwear, headwear, infantwear, etc. There is no entry for "manwear" (in fact there is no entry for "menswear" either). The evidence does not show use of the mark as the name for the Applicant's goods.

(d) A fourth component of the evidence consists of several pages from the internet showing limited use of the term "manwear" in websites of foreign companies. The Applicant does not dispute the fact that material from the internet is accepted as competent evidence. What the Applicant does dispute is the probative effect of this particular evidence, namely none. "Use of a mark in a foreign country does not give rise to rights in the United States if the goods or services are not sold or rendered in the United States. *Buti v. Impresa Perosa S.R.L.*, 139 F.3d 98, 45 USPQ2d 1985 (2nd Cir. 1998); *Mother's Restaurants Inc. v. Mother's Bakery, Inc.*, 498 F. Supp. 847, 210 USPQ 207 (W.D.N.Y. 1980); *Linville v. Rivard*, 41 USPQ2d 1731 (TTAB 1996), *aff'd*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Aktieselskabet af 21. November 2001 v. Fame Jeans Inc.*, 77 USPQ2d 1861 (TTAB 2006)." TMEP § 901.03. If foreign usage cannot create use in commerce, then it similarly cannot show that a term is used as the name of goods or services in the United States. Further, the same English word can have completely different understood meanings in different English-speaking countries. As a result, evidence that a small number of foreign companies use the term "manwear" is not evidence that this is used as the name of the Applicant's goods in the United States.

(e) The final component of the evidence are pages from the websites momcentral.com and gabsmash.blogspot.com. The momcentral.com evidence is an article titled "Where Have All the Mommies Gone?...Long Time Passing" from June 22, 2006, in which the following textual matter appears: "When I think of Jessica Simpson's very public divorce from Nick Lachey, I immediately think of her father, Joe Simpson, a former preacher, who now walks the red carpets behind his daughter, wearing slick, metrosexual manwear, smiling from ear to ear, fully enjoying what his daughter's success has afforded him." The gabsmash.blogspot.com evidence is a posting from October 9, 2005 regarding "Tim & Faith" in which the following comment is posted by a person identified only as "x": "His jeans look like metrosexual manwear not country singer gear." The Applicant submits that these entries wholly fail to show that "manwear" is used as the name of the Applicant's goods.

(2) The Applicant's MANWEAR mark does not immediately tell the potential purchaser only what the goods or services are or what their function, characteristics or uses are.

(a) The 213 internet articles and websites show use of terms including "menswear" and "men wear" The term "manwear" does not appear in any of these articles, so they cannot show that "manwear" immediately tells potential purchasers what the Applicant's goods are.

(b) The dictionary definitions of the words "man" and "wear" similarly fail to show that "manwear" immediately tells potential purchasers what the Applicant's goods are. The combination of the terms "man" and "wear," being immediately distinguishable from the commonly-used term "menswear," creates a unitary mark with a unique, nondescriptive meaning, and does not immediately tell potential purchasers what the Applicant's goods are.

(c) The listing of entries from the Trademark ID Manual similarly fails to show that "manwear" immediately tells potential purchasers what the Applicant's goods are, as the manual contains no entry for "manwear."

(d) Limited use of the term "manwear" in websites of foreign companies does not show that "manwear" immediately tells potential purchasers what the Applicant's goods are. As stated above, these items are not relevant to demonstrate the understanding of a potential purchaser of the Applicant's goods in the United States. This evidence does not immediately tell potential purchasers what the Applicant's goods are.

(e) The momcentral.com and gabsmash.blogspot.com articles do not show that "manwear" immediately tells potential purchasers what the Applicant's goods are. An internet search that produces only two textual non-service mark usages of the Applicant's mark shows that the term is very rarely used and fails to demonstrate that the mark immediately informs potential purchasers of the goods provided.

(3) The Applicant's mark MANWEAR is not in common usage as a description of the Applicant's goods.

(a) The 213 internet articles and websites do not include any uses of the term "manwear." The Applicant submits that this evidence effectively proves that "manwear" is NOT in common usage.

(b) The dictionary definitions separately define the terms "man" and "wear" but there is no definition for the composite term "manwear." This indicates that the term "manwear" is not in common usage.

(c) To the extent it has any relevance, the absence of a Trademark ID Manual entry for "manwear" supports the proposition that "manwear" is not in common usage. If it were a commonly used term for a category of goods or services, it is likely that the Manual would contain a listing.

(d) Limited use of the term "manwear" in websites of foreign companies does not show that "manwear" is in common usage in the US. This is self-evident from that fact that these are foreign as opposed to domestic uses of the term.

(e) The momcentral.com and gabsmash.blogspot.com articles do not show that "manwear" is in common usage in the US. An internet search that produces only two textual non-service mark usages of the Applicant's mark shows that the term is very rarely used. The Applicant submits that this evidence effectively proves that "manwear" is NOT in common usage.

The Applicant's mark MANWEAR is a suggestive mark as used for the Applicant's clothing goods. A suggestive mark is one in which requires imagination, thought or perception on the part of a person in order to reach a conclusion as to the nature of the goods or services. *See In re Shutt's*, 217 USPQ 363 (TTAB 1983). The Applicant's MANWEAR mark is clearly suggestive in that it requires imagination, thought or perception to determine that this mark refers to clothing products.

For the above reasons, Applicant respectfully requests the Examining Attorney to withdraw the refusal of registration and register the MANWEAR mark in Class 25.

ADDITIONAL STATEMENTS SECTION

MISCELLANEOUS STATEMENT

The Applicant has, concurrently with the filing of this Request for Reconsideration, filed a Request to Divide Application Ser. No. 77370042, with the Class 25 goods remaining in this application and the Class 14 and Class 18 goods placed in a new application. The Applicant has,

	concurrently with the filing of this Request for Reconsideration, filed an Appeal of the Examiner's refusal of registration in Class 25.
PAYMENT SECTION	
NUMBER OF CLASSES	2
FEE PER CLASS	325
TOTAL FEES DUE	650
SIGNATURE SECTION	
DECLARATION SIGNATURE	The filing Attorney has elected not to submit the signed declaration, believing no supporting declaration is required under the <i>Trademark Rules of Practice</i> .
RESPONSE SIGNATURE	/James A. Wahl/
SIGNATORY'S NAME	James A. Wahl
SIGNATORY'S POSITION	Attorney of Record, Minnesota Bar Member
DATE SIGNED	05/06/2009
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Wed May 06 17:50:16 EDT 2009
TEAS STAMP	USPTO/RFR-75.146.153.249- 20090506175016725830-7737 0042-4309de11657c299f4fbd e6fca5b7aaf838a-CC-3784-2 0090506174142958529

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **77370042** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Request for Reconsideration

The Applicant's mark is comprised of the coined term "MANWEAR." Applicant's goods are identified in the Application as:

IC 016 - Men's accessories, namely, money clips, folders used as travel organizers and memo holders

IC 018 - Men's accessories namely, briefcase-type portfolios, tote bags, compartment bags, namely all purpose carrying bags with multiple compartments; Men's small leather goods namely, wallets, key chains, travel kits in the nature of shaving bags, travel bags, luggage, business card cases

IC 025 - Men's clothing, namely, coats, jackets, vests, sweaters, t-shirts, shirts, jerseys, shorts, parkas, pullovers, wind-jackets, pants, raincoats; sportswear, namely, sweatsuits, leisure suits, jeans, sport jackets, overalls; underwear, namely, short and long sleeve tee-shirts, long johns, briefs, boxers; Men's leather clothing, namely, coats, jackets, vests, shorts, parkas, pants, raincoats; Men's fashion accessories, namely, ties, socks, caps, gloves, belts, wristband, watch wristband, hats, shoes and scarves

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FEE(S)

Fee(s) in the amount of \$650 is being submitted.

SIGNATURE(S)

Declaration Signature

I hereby elect to bypass the submission of a signed declaration, because I believe a declaration is not required by the rules of practice. I understand that the examining attorney could still, upon later review, require a signed declaration.

Request for Reconsideration Signature

Signature: /James A. Wahl/ Date: 05/06/2009

Signatory's Name: James A. Wahl

Signatory's Position: Attorney of Record, Minnesota Bar Member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

RAM Sale Number: 3784

RAM Accounting Date: 05/07/2009

Serial Number: 77370042

Internet Transmission Date: Wed May 06 17:50:16 EDT 2009

TEAS Stamp: USPTO/RFR-75.146.153.249-200905061750167

25830-77370042-4309de11657c299f4fbde6fca

5b7aaf838a-CC-3784-20090506174142958529

RAM SALE NUMBER: 3784
RAM ACCOUNTING DATE: 20090507

INTERNET TRANSMISSION DATE:

2009/05/06

SERIAL NUMBER:

77/370042

Description	Fee Code	Transaction Date	Fee	Number Of Classes	Total Fees Paid
New App	7001	2009/05/06	325	2	650