

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77411069
LAW OFFICE ASSIGNED	LAW OFFICE 109
MARK SECTION (no change)	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_9824922916-140653519_._Request_for_Reconsideraton_8-27-10.pdf
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DESCRIPTION OF EVIDENCE FILE	Request for Reconsideration response including amended descriptions of goods and service with restricted channels of trade
GOODS AND/OR SERVICES SECTION (006)(current)	
INTERNATIONAL CLASS	006
DESCRIPTION	Metal key chains
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (006)(proposed)	
INTERNATIONAL CLASS	006
TRACKED TEXT DESCRIPTION	
Metal key chains; <u>Metal key chains for sale through Applicant's museum stores, both in the museum itself and online</u>	

FINAL DESCRIPTION

Metal key chains for sale through Applicant's museum stores, both in the museum itself and online

FILING BASIS Section 1(b)

GOODS AND/OR SERVICES SECTION (009)(current)

INTERNATIONAL CLASS 009

DESCRIPTION decorative magnets, sunglasses and cases therefor

FILING BASIS Section 1(b)

GOODS AND/OR SERVICES SECTION (009)(proposed)

INTERNATIONAL CLASS 009

TRACKED TEXT DESCRIPTION

~~decorative magnets, sunglasses and cases therefor;~~ decorative magnets, sunglasses and cases therefor for sale through Applicant's museum stores, both in the museum itself and online

FINAL DESCRIPTION

decorative magnets, sunglasses and cases therefor for sale through Applicant's museum stores, both in the museum itself and online

FILING BASIS Section 1(b)

GOODS AND/OR SERVICES SECTION (018)(current)

INTERNATIONAL CLASS 018

DESCRIPTION

Beach bags, tote bags, back packs, cinch sacks, ruck sacks, and book bags

FILING BASIS Section 1(b)

GOODS AND/OR SERVICES SECTION (018)(proposed)

INTERNATIONAL CLASS 018

TRACKED TEXT DESCRIPTION

~~Beach bags, tote bags, back packs, cinch sacks, ruck sacks, and book bags;~~ Beach bags, tote bags, back packs, cinch sacks, ruck sacks, and book bags for sale through Applicant's museum stores, both in the museum itself and online

FINAL DESCRIPTION

Beach bags, tote bags, back packs, cinch sacks, ruck sacks, and book bags for sale through Applicant's

museum stores, both in the museum itself and online

FILING BASIS Section 1(b)

GOODS AND/OR SERVICES SECTION (025)(current)

INTERNATIONAL CLASS 025

DESCRIPTION

Men's, women's and children's clothing and sportswear namely, sweatshirts, sweat pants, sweat shorts, shirts, bathing suits, dresses, blouses, skirts, beach cover-ups, sandals, socks, headbands, caps, hats, visors, wet suits, jackets and ponchos

FILING BASIS Section 1(b)

GOODS AND/OR SERVICES SECTION (025)(proposed)

INTERNATIONAL CLASS 025

TRACKED TEXT DESCRIPTION

~~Men's, women's and children's clothing and sportswear namely, sweatshirts, sweat pants, sweat shorts, shirts, bathing suits, dresses, blouses, skirts, beach cover-ups, sandals, socks, headbands, caps, hats, visors, wet suits, jackets and ponchos; Men's, women's and children's clothing and sportswear namely, sweatshirts, sweat pants, sweat shorts, shirts, bathing suits, dresses, blouses, skirts, beach cover-ups, sandals, socks, headbands, caps, hats, visors, wet suits, jackets and ponchos for sale through Applicant's museum stores, both in the museum itself and online~~

FINAL DESCRIPTION

Men's, women's and children's clothing and sportswear namely, sweatshirts, sweat pants, sweat shorts, shirts, bathing suits, dresses, blouses, skirts, beach cover-ups, sandals, socks, headbands, caps, hats, visors, wet suits, jackets and ponchos for sale through Applicant's museum stores, both in the museum itself and online

FILING BASIS Section 1(b)

GOODS AND/OR SERVICES SECTION (035)(current)

INTERNATIONAL CLASS 035

DESCRIPTION

Retail gift shop services and on-line retail gift shop services featuring clothing and accessories; beach and surf gear; sporting and recreational goods, equipment and accessories; toys and games; household goods; stationery products, greeting cards, postcards, note cards, books and publications, posters, calendars, planners, journals; and novelty and souvenir items and gifts

FILING BASIS Section 1(b)

GOODS AND/OR SERVICES SECTION (035)(proposed)

INTERNATIONAL CLASS 035

TRACKED TEXT DESCRIPTION

~~Retail gift shop services and on-line retail gift shop services featuring clothing and accessories;~~ Retail gift shop services and on-line retail gift shop services through Applicant's museum stores, featuring clothing and accessories; beach and surf gear; sporting and recreational goods, equipment and accessories; toys and games; household goods; stationery products, greeting cards, postcards, note cards, books and publications, posters, calendars, planners, journals; and novelty and souvenir items and gifts

FINAL DESCRIPTION

Retail gift shop services and on-line retail gift shop services through Applicant's museum stores, featuring clothing and accessories; beach and surf gear; sporting and recreational goods, equipment and accessories; toys and games; household goods; stationery products, greeting cards, postcards, note cards, books and publications, posters, calendars, planners, journals; and novelty and souvenir items and gifts

FILING BASIS Section 1(b)

GOODS AND/OR SERVICES SECTION (041)(no change)

SIGNATURE SECTION

RESPONSE SIGNATURE /lnk/

SIGNATORY'S NAME Lisa N. Kaufman

SIGNATORY'S POSITION Attorney of record

DATE SIGNED 08/27/2010

AUTHORIZED SIGNATORY YES

CONCURRENT APPEAL NOTICE FILED YES

FILING INFORMATION SECTION

SUBMIT DATE Fri Aug 27 14:30:17 EDT 2010

TEAS STAMP USPTO/RFR-98.249.229.16-2
0100827143017640826-77411
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100827140653519229

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **77411069** has been amended as follows:

EVIDENCE

Evidence in the nature of Request for Reconsideration response including amended descriptions of goods and service with restricted channels of trade has been attached.

Original PDF file:

evi_9824922916-140653519_._Request_for_Reconsideraton_8-27-10.pdf

Converted PDF file(s) (5 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Evidence-5

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 006 for Metal key chains

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Metal key chains;~~ Metal key chains for sale through Applicant's museum stores, both in the museum itself and onlineClass 006 for Metal key chains for sale through Applicant's museum stores, both in the museum itself and online

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 009 for decorative magnets, sunglasses and cases therefor

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~decorative magnets, sunglasses and cases therefor;~~ decorative magnets, sunglasses and cases therefor for sale through Applicant's museum stores, both in the museum itself and onlineClass 009 for decorative magnets, sunglasses and cases therefor for sale through Applicant's museum stores, both in the museum itself and online

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 018 for Beach bags, tote bags, back packs, cinch sacks, ruck sacks, and book bags
Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Beach bags, tote bags, back packs, cinch sacks, ruck sacks, and book bags;~~
Beach bags, tote bags, back packs, cinch sacks, ruck sacks, and book bags for sale through Applicant's museum stores, both in the museum itself and online Class 018 for Beach bags, tote bags, back packs, cinch sacks, ruck sacks, and book bags for sale through Applicant's museum stores, both in the museum itself and online

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 025 for Men's, women's and children's clothing and sportswear namely, sweatshirts, sweat pants, sweat shorts, shirts, bathing suits, dresses, blouses, skirts, beach cover-ups, sandals, socks, headbands, caps, hats, visors, wet suits, jackets and ponchos
Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Men's, women's and children's clothing and sportswear namely, sweatshirts, sweat pants, sweat shorts, shirts, bathing suits, dresses, blouses, skirts, beach cover-ups, sandals, socks, headbands, caps, hats, visors, wet suits, jackets and ponchos;~~
Men's, women's and children's clothing and sportswear namely, sweatshirts, sweat pants, sweat shorts, shirts, bathing suits, dresses, blouses, skirts, beach cover-ups, sandals, socks, headbands, caps, hats, visors, wet suits, jackets and ponchos for sale through Applicant's museum stores, both in the museum itself and online Class 025 for Men's, women's and children's clothing and sportswear namely, sweatshirts, sweat pants, sweat shorts, shirts, bathing suits, dresses, blouses, skirts, beach cover-ups, sandals, socks, headbands, caps, hats, visors, wet suits, jackets and ponchos for sale through Applicant's museum stores, both in the museum itself and online

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 035 for Retail gift shop services and on-line retail gift shop services featuring clothing and accessories; beach and surf gear; sporting and recreational goods, equipment and accessories; toys and

games; household goods; stationery products, greeting cards, postcards, note cards, books and publications, posters, calendars, planners, journals; and novelty and souvenir items and gifts

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Retail gift shop services and on-line retail gift shop services featuring clothing and accessories;~~ Retail gift shop services and on-line retail gift shop services through Applicant's museum stores, featuring clothing and accessories; beach and surf gear; sporting and recreational goods, equipment and accessories; toys and games; household goods; stationery products, greeting cards, postcards, note cards, books and publications, posters, calendars, planners, journals; and novelty and souvenir items and gifts Class 035 for Retail gift shop services and on-line retail gift shop services through Applicant's museum stores, featuring clothing and accessories; beach and surf gear; sporting and recreational goods, equipment and accessories; toys and games; household goods; stationery products, greeting cards, postcards, note cards, books and publications, posters, calendars, planners, journals; and novelty and souvenir items and gifts

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /lnk/ Date: 08/27/2010

Signatory's Name: Lisa N. Kaufman

Signatory's Position: Attorney of record

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 filing a Notice of Appeal in conjunction with this Request for Reconsideration.

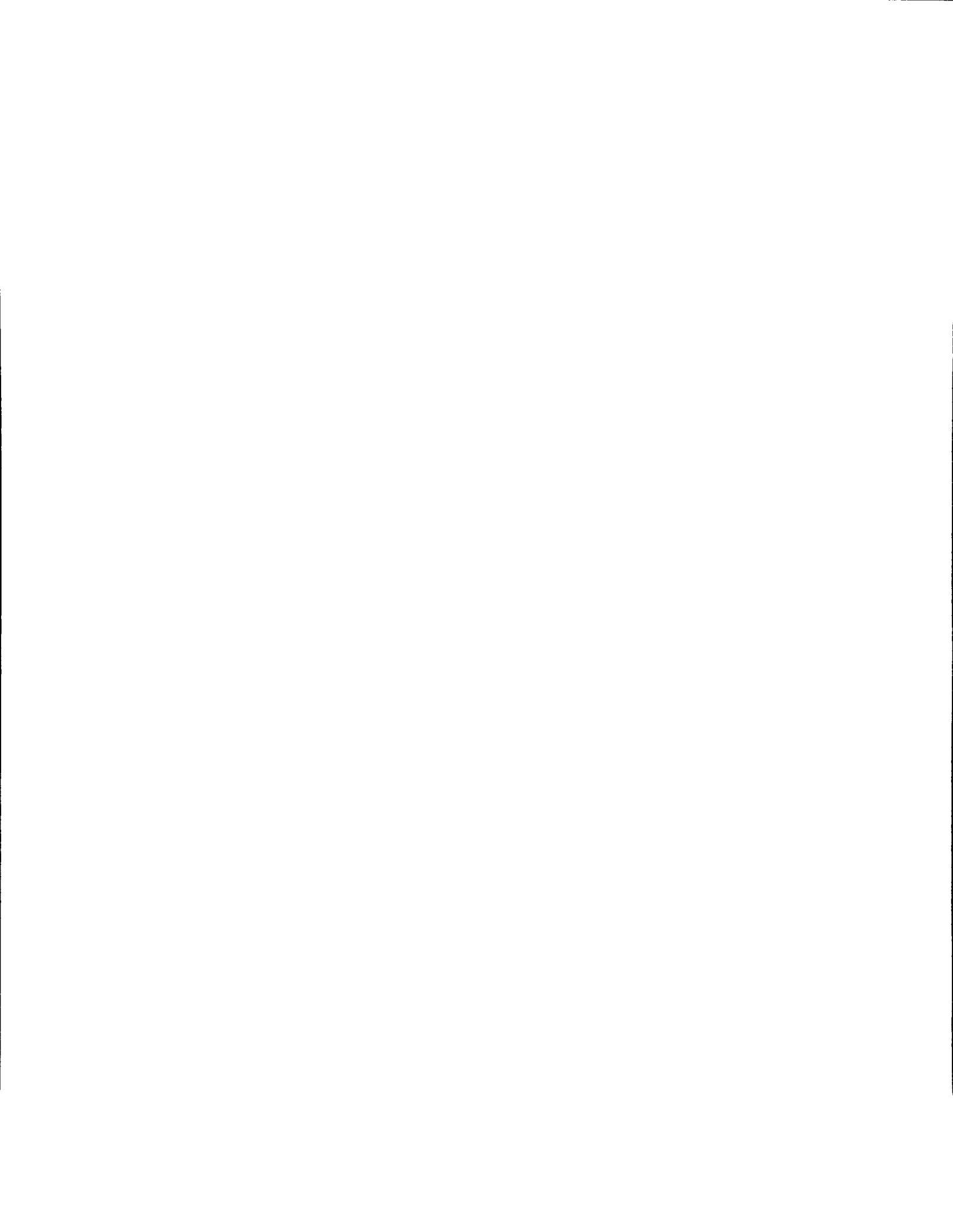
Serial Number: 77411069

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TEAS Stamp: USPTO/RFR-98.249.229.16-2010082714301764

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Ron Jon Surf Shop of Fla., Inc.

Serial No.: 77/411069

Law Office: 109

Attorney: Wendy B. Goodman

Mark: **THE STOKED**

REQUEST FOR RECONSIDERATION

This letter is written in response to the final Office Action mailed February 28, 2010.

AMENDMENTS

Please amend the descriptions of the following classes of goods and services to read as follows:

Metal key chains for sale through Applicant's museum stores, both in the museum itself and online, in International Class 6;

Decorative magnets, sunglasses and cases therefor for sale through Applicant's museum stores, both in the museum itself and online, in International Class 9;

Beach bags, tote bags, back packs, cinch sacks, ruck sacks, and book bags for sale through Applicant's museum stores, both in the museum itself and online, in International Class 18;

Men's, women's and children's clothing and sportswear namely, sweatshirts, sweat pants, sweat shorts, shirts, bathing suits, dresses, blouses, skirts, beach cover-ups, sandals, socks, headbands, caps, hats, visors, wet suits, jackets and ponchos for sale through Applicant's museum stores, both in the museum itself and online, in International Class 25;

Retail gift shop services and on-line retail gift shop services through Applicant's museum stores, featuring clothing and accessories; beach and surf gear; sporting and recreational goods, equipment and accessories; toys and games; household goods; stationery products, greeting

cards, postcards, note cards, books and publications, posters, calendars, planners, journals; and novelty and souvenir items and gifts, in International Class 35

THE INTERNATIONAL CLASS 41 SERVICES REMAIN AS MUSEUM SERVICES.

REMARKS

Before filing this Response, on August 18, 2010, Applicant's attorney attempted to reach the Examining Attorney and in fact, left a voice mail message requesting a return call to discuss proposed amendments to the descriptions of the goods for the channels of trade. It appears, however, that the Examining Attorney had been away from the Office for a period of time and was unable to return the undersigned's call before this response was due. Applicant had hoped to resolve this matter by means of an Examiner's Amendment.

As indicated in the Amendments Section, Applicant has now limited its description of goods in Classes 6, 9, 18, 25 and 35 (the classes at issue for the Section 2(d) refusals) by restricting its channels of trade for sales through its store in its museum, both its bricks and mortar store and its online museum store.

Under Section 2(d) of the Trademark Act, The Examining Attorney had cited 3 registered marks for the word **STOKED** owned by two different parties as a bar to the registration of Applicant's mark. U.S. Trademark Registration No. 2,822,074 for the mark **STOKED** is owned by Tim Winged, dba Stoked Sportswear for clothing (hereinafter the "074 Registration") and U.S. Trademark Registration No. 3,331,656, also for the mark **STOKED**, is owned by Revelations Perfume and Cosmetics, Inc. for cosmetics (hereinafter the "656 Registration").

Registration No. 3,545,367 is also owned by Revelations Perfume and Cosmetics, Inc for lipstick cases and holders; ankle bracelets, bracelets, charms, chokers, earrings, identification bracelets, jewelry chains, necklaces, pendants, rings, watches; and all-purpose carrying bags, backpacks, beach bags, change purses, clutch purses, daypacks, duffel bags, evening handbags, fanny packs, handbags, key cases, make-up bags sold empty, multi-purpose purses, overnight bags and cases, pocketbooks, purses, rucksacks, satchels, shoulder bags, tote bags, waist packs. In her final office action, the Examining Attorney curiously withdrew the Section 2(d) refusal based on No. 3,331, 656, but maintained her refusal based on the other two registrations.

Applicant maintains its position that there is no likelihood of confusion. The cited marks consist of two registrations **for the identical mark owned by two different parties** which have been permitted to register by the USPTO and co-exist with one another. Applicant reiterates that its mark is a **different** mark which will be sold in different channels of trade through its museum shop and not through usual retail trade channels.

Because Applicant's mark will be used in conjunction with a museum devoted to surfing and the goods set forth in the application are now limited to sales through its actual and online museum store, any alleged likelihood of confusion will be obviated due to these restricted channels of trade. The channels of trade for Applicant's products and services are totally unrelated to the channels of trade for the registrants' marks which are presumed to be the normal commercial channels for those goods. Under these circumstances, no likelihood of confusion exists. *See, e.g., In re Shipp*, 4 USPQ 2d 1174 (TTAB 1987) [**PURITAN** for laundry and dry cleaning services not likely to cause confusion with **PURITAN** for commercial dry cleaning

machine filter sold to dry cleaning professionals]; *Local Trademarks, Inc. V. Handy Boys, Inc.*, 16 USQ2d 1156 (TTAB 1990) [**LITTLE PLUMBER** liquid drain opener for consumers not likely to cause confusion with opposer's **LITTLE PLUMBER** for advertising agency services for professional plumbing contractors due to the different channels of sale].

Further reinforcing Applicant's position that there is no likelihood of confusion under these circumstances is the connotation in the surfing industry of the phrase Applicant will be using as its trademark. Applicant's museum will be devoted to the sport of surfing. In surfing terminology the term "stoked" means "condition of being amped, wound up or just full of enthusiasm. Example: *"I'm stoked. I just got tubed!"* Definition obtained from the *RIPTIONARY* found online at <http://www.riptionary.com> on September 12, 2008. In the context of applicant's goods and services, the mark's sport specific connotation will serve to further distinguish it from the cited marks. Each case must be decided on the basis of all relevant factors, in determining likelihood of confusion, including the goods or services upon which they are used and the marketing environment in which consumers encounter them. *In re Bigelow, Inc.*, 199 USPQ 38, 40 (TTAB 1978). Here, in the "practicalities of the commercial world", purchasers will not be confused as to the source of the respective parties' goods and services. *In re Massey-Ferguson, Inc.*, 222 USPQ 367, 368 (TTAB 1983).

Applicant's mark, being a different mark from the cited marks, cannot adversely impact the cited marks any more than the cited marks already adversely impact each other commercially. Again Applicant stresses that its mark, **THE STOKED**, creates a different commercial

impression from the cited marks **STOKED** which consist of a single word used as an action verb. The former mark consisting of two words, functions as a noun, creating the impression of the name of something rather than doing something. The marks at issue, being different in appearance and connotation, create a different overall commercial, preventing any likelihood of confusion. Here, the use of the word **THE** in conjunction with the term **STOKED** is significant because it changes the commercial impression of the phrase from a verb, an action word, to a noun, the name of the thing and is enough to avoid likelihood of confusion, especially in light of Applicant's now delineated and restrictive channels of trade. Thus taking into consideration all the relevant factors, Applicant's mark, **THE STOKED**, when viewed as a whole, is distinctive and will denote origin solely in Applicant.

Accordingly, based on the above arguments, Applicant respectfully requests the Examining Attorney to withdraw her Section 2(d) refusals, to grant this request for reconsideration and to pass the mark to publication. Should the Examining Attorney wish to discuss this further, she is requested to telephone the undersigned. In the event that the Examining Attorney denies this Request for Reconsideration, Applicant is simultaneously filing its Notice of Appeal.

Respectfully submitted,
s_ /lnk/ _____
Lisa N. Kaufman
Attorney for Applicant
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Cooper City, FL 33026
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LNKTM@hotmail.com