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

Proceeding	77438388
Applicant	K-Swiss Inc.
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Submission	Applicants Request for Remand and Amendment
Attachments	2011-01-17-NDG-Request for Remand.pdf ( 8 pages )(167088 bytes )
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Signature	/ndg-pto/
Date	01/17/2011

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

In re Application of:

K-Swiss Inc.

Serial No.: 77/438,388

Appeal Filed: May 17, 2010

Trademark: TUBES [Stylized]

Trademark Examining Attorney:  
Ronald E. DelGizzi  
Law Office 107

**REQUEST FOR REMAND AND STAY OF APPEAL TO ALLOW EXAMINING  
ATTORNEY TO RECONSIDER THE REFUSAL TO REGISTER  
BASED UPON NEW EVIDENCE**

Applicant respectfully requests the Trademark Trial and Appeal Board stay all action on the appeal and remand the file to the Examining Operation so that the Examining Attorney can consider new evidence.

The Examining Attorney refused registration to Applicant by refusing to respect the rights conferred on Applicant by virtue of its prior and senior registration. The Examining Attorney justified his action by taking a broad view of a junior registrant's registration. Applicant has now secured a consent agreement (a/k/a a co-existence agreement) from the junior registrant. Applicant submits that the Examining Attorney's prior broad interpretation of the junior registration, even if originally appropriate (which Applicant disputes), is no longer warranted.

Applicant requests remand so the Examining Attorney can consider the new evidence consisting of the co-existence agreement. A formal request for reconsideration to the Examining Attorney along with the Consent to Register (a/k/a a co-existence agreement) is attached.

In view thereof, Applicant requests a stay of these proceedings and remand of the file to the Examining Attorney for consideration of the new evidence. If, for some reason, this request for stay and remand is denied, Applicant respectfully requests that a further extension of two (2) months be granted for Applicant to submit its appeal brief.

Respectfully submitted,

Dated: January 17, 2011

By:   
Neil D. Greenstein  
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Attorneys for Applicant, K-Swiss Inc.

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

In re the Application of:

K-Swiss Inc.

Examining Attorney

Application Serial No.: 77438388

Ronald E. DelGizzi

Filed: April 2, 2008

Law Office 107

Mark: TUBES [Stylized]

**BOX RESPONSES**  
**NO FEE**

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Sir:

**APPLICANT'S REQUEST FOR RECONSIDERATION**

Applicant respectfully requests the Trademark Examining Attorney reconsider the final refusal to register the above-referenced mark in view of new evidence; namely, a co-existence agreement.

**REMARKS**

Applicant seeks registration of the mark:

**Tubes**

for shoes. The Trademark Examining Attorney has refused registration based on United States Trademark Registration No. 3,556,248, which is for the mark POWER TUBES for various highly specialized ski products. As previously noted, Applicant owns senior United States Trademark Registration No. 1,340,894 for the mark TUBES for "Boy's and Infant's Shoes."

Applicant submits that the present application should be allowed based on the various arguments previously made in this application. However, in addition, Applicant recently obtained a Consent to Register (a co-existence agreement) the present TUBES mark from the owner of junior Registration No. 3,556,248. A copy of that consent is submitted herewith.

In the co-existence agreement, the junior<sup>1</sup> Registrant (which is the basis for the Examining Attorney's refusal to register) agrees to limit its goods to very highly specialized ski products such as ski bindings, ski parts, and ski hardware. These items are highly unrelated to Applicant's goods in the instant application. Moreover, the junior Registrant agrees to take necessary actions to avoid any possible likelihood of confusion. While the Examining Attorney has to date refused to respect the rights conferred on Applicant by virtue of its senior registration by taking a broad view of the junior registrant's registration, such broad interpretation, even if originally appropriate (which Applicant disputes) can no longer be warranted or appropriate. Clearly, under these circumstances, the Examining Attorney can not and should not second guess commercial merchants in their respective industries.

Applicant requests that, in view of this consent (as well as in view of Applicant's other arguments), the present application should be allowed, *see In re Four Seasons Hotels Ltd.*, 26 USPQ2d 1071 (Fed. Cir. 1993); *In re N.A.D. Inc.*, 244 USPQ 969 (Fed. Cir. 1985); *In re SGS Tool Co.*, 24 USPQ2d 1382 (TTAB 1992); *Anthony's Pizza & Pasta International Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271 (TTAB 2009) ("Plaintiff's willingness to execute a coexistence agreement in a situation where it believed that the parties' different channels of trade would avoid confusion epitomizes the type of circumstance in which the Federal Circuit has encouraged such agreements." *citing Bongrain International (American) Corporation v. Delice de France Inc.*, 1

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<sup>1</sup> As the Examining Attorney has acknowledged, K-Swiss is the senior registrant but has continued his refusal to register based upon the junior registrant's registration.

USPQ2d 1775 (Fed. Cir. 1987)).

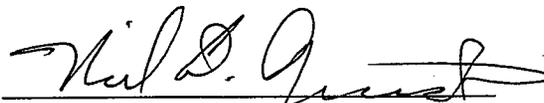
CONCLUSION

In view of the attached Consent as well as Applicant's other arguments in favor of registration, Applicant requests that the Trademark Examining Attorney reconsider the refusal to register and pass this application on to publication.

Respectfully submitted,

Dated: January 17, 2011

By:



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Attorneys for Applicant, K-Swiss Inc.

## CONSENT FOR K-SWISS TO REGISTER TUBES MARKS

This Agreement, effective as of the date first set forth below, is entered into by and between **K-Swiss Inc.**, a Delaware corporation, with its principal place of business at 31248 Oak Crest Drive, Westlake Village, California, 91361 ("K-Swiss"), and **Rottefella AS**, a Norway corporation, with its principal place of business at Industrivenien 1, 3490 Klorkkarstua, NORWAY ("Rottefella").

### RECITALS

A. K-Swiss is the owner of common law rights dating back to 1983, a federal trademark registration and federal trademark applications for its TUBES mark used in connection with footwear including:

Reg. No. 1,340,894 for the TUBES mark covering "shoes";

Appln. No. 77438388 for the TUBES (stylized) mark covering "shoes";

Appln. No. 85117779 for the TUBES mark covering "casual shoes"; and

Appln. No. 77942891 for the SUPER DUPER TUBES mark covering "shoes."

These applications and registration along with K-Swiss' common law rights in the TUBES marks and formatives thereof are referred to as the "K-Swiss TUBES Marks";

B. Rottefella is the owner of federal trademark registration number 3,787,616 for POWER TUBES, in connection with sports bags, leather shoulder belts, sports shoes, in particular winter sport shoes; articles of clothing, in particular clothing articles for winter sports, namely, pants, jackets, anoraks, ski trousers, ski suits, gloves, scarves, shirts, beanies, socks, caps, sports articles not included in other classes, in particular winter sports articles, namely, ski binding and their parts, sledges, skis, snowboards, ski poles, snow shoes, and (the "Rottefella POWER TUBES Registration");

C. Even though K-Swiss owns a senior registration for TUBES, Rottefella's application for POWER TUBES was permitted to register over K-Swiss' senior registration. Then in a reversal of position, the U.S. Patent and Trademark Office cited Rottefella's junior registration for POWER TUBES as a Section 2(d) bar to K-Swiss' Application No. 77438388; and

D. The parties believe that their respective marks can co-exist in the marketplace without a likelihood of confusion, provided that these marks are used in the manner and under the terms and conditions of this Agreement.

NOW, THEREFORE, the parties hereto agree as follows:

1. Rottefella agrees that it shall use the POWER TUBES mark only in connection with sports shoes, namely, snow ski boots, snow ski bindings, parts for snow ski boots, parts for snow ski bindings, other snow ski hardware, sledges, skis, snowboards, ski poles, snow shoes, and roller skis (the "Permitted POWER TUBES Goods") and that when using the POWER TUBES mark in connection the Permitted POWER TUBES goods, on behalf of itself or through any third party, the terms POWER and TUBES shall be used in close proximity and in comparable size, color, font, and such use shall never in any way emphasize the term TUBES more than the term POWER.

2. Rottefella consents to K-Swiss' use and/or registration of all TUBES marks (including without limitation the K-Swiss TUBES Marks), and formatives (other than POWER TUBES in connection with the Permitted POWER TUBES Goods) in Classes 9, 18, 25 and 28, whether used alone or in a composite mark.

3. K-Swiss agrees that it shall not use the POWER TUBES mark in conjunction with the Permitted POWER TUBES Goods; provided, however, that if Rottefella abandons use of the POWER TUBES mark in any country then the obligations on K-Swiss as to the POWER TUBES mark required by this Agreement shall cease with respect to each such country.

4. K-Swiss and Rottefella agree to reasonably avoid any activity that might be likely to lead to confusion between their respective marks as used on their respective products. Should any instances of actual confusion nevertheless occur, the parties agree to undertake such steps as may be mutually determined to be necessary and reasonable in order to prevent recurrence of confusion.

IN WITNESS WHEREOF, each of the parties hereto has caused this Consent to be executed in duplicate by its duly authorized representative to be effective as of the 5<sup>th</sup> day of Jan, 2010.

K-SWISS INC.

Dated: Jan 5, 2011

By: [Signature]

Printed Name: STEVEN NICHOLS

Title: PRESIDENT

ROTTEFELLA AS

Dated: 23 Dec 2010

By: [Signature]

Printed Name: ØYVAR SVENDSEN

Title: Industrial x Product Designer