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of Response to Office Action ONLY.

Examining Attorney: BORSUK, ESTHER A.

Serial Number: 78/095807



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Ref.: 210210-102

In re Application of

Boom LLC

Serial No.: 78/095,807

Filed: November 29, 2001

Mark: **WHO'S THAT GIRL**

Law Office: 116

Examining Attorney:
Esther Borsuk

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

BOX RESPONSES
NO FEE

TRADEMARK DIVISION
03 APR -4 AM 9:30

REQUEST FOR RECONSIDERATION

MADAM:

Responding to Final Office Action dated August 27, 2002, the contents of which have been duly reviewed, applicant requests reconsideration of the application.

Please amend the identification of goods by deleting the identification in its entirety and substituting therewith the following:

MAKEUP AND COSMETIC PRODUCTS, NAMELY, FACIAL MAKEUP,
EYE MAKEUP AND FOUNDATION MAKEUP, COSMETIC PENCILS,

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on the date appearing below.

Signature: *Michael J. Brown*

Feb. 27, 2003
Date

Q

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ROUGE, MASKS, FOUNDATIONS, CONCEALERS, POWDER, BLUSHER,
EYE SHADOWS, EYE LINERS, EYE PENCILS, MASCARA, LIPSTICKS, LIP
BALM, LIP PENCILS, LIP GLOSS, PERFUME, COLOGNE, EAU DE
TOILETTE, EAU DE PARFUM, DEODORANTS, ANTIPERSPIRANTS,
PERSONAL DEODORANTS, SOAP, DEODORANT SOAP, SKIN SOAPS,
TOILET SOAP, LIQUID SOAP, SHAMPOO, CONDITIONERS, BUBBLE
BATH, BATH GEL, SHOWER GEL, NAIL ENAMEL, NAIL POLISH, BODY
LOTION, HAND CREAM, MOISTURIZERS, BODY POWDER, FACE
POWDER, BATH POWDER, SKIN LOTIONS, SKIN MOISTURIZERS

REMARKS

Identification of Goods

Applicant has further limited the identification of goods from the original, broader identification. In particular, "baby shampoo" has been deleted from the identification of goods, among other deletions.

Likelihood of Confusion

The Examining Attorney has refused registration of applicant's mark based upon a finding of confusing similarity, under Section 2(d) of the Trademark Act, with the following registered mark:

Trademark: WHO'S THAT GIRL!
Reg. No.: 1,701,129
Goods: Infant and children's apparel; namely, sweaters, skirts, slacks, shorts, swim wear, tee shirts, underwear, pajamas, robes, tops, shirts, blouses, shoes, newborn and infantwear, raincoats, scarves, hats, hoods, gloves, jackets, coats, ties, and belts.

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Likelihood of Confusion

The Examining Attorney asserted that the applicant's goods and the registrant's goods travel in the same channels of trade "because clothing for children and cosmetics originate from the same source and are marketed under the same marks." Applicant respectfully submits that the Examining Attorney's position merges Classes 3 and 25 into a single marketing category for all purposes without regard to the facts of the specific case.

The Examining Attorney identified 15 examples of marks where cosmetics and children's clothing appear together in the identification of goods. However, of these examples, all but one include some combination of men's and/or women's clothing with the children's clothing, rendering the examples inapplicable to the present situation. Applicant contends that the single remaining example (Reg. No. 2,437,468) is also primarily directed toward an adult market as the cosmetics in that registration include "non-medicated stretch mark cream." Further, as noted in the response filed on June 24, 2002, an electronic search conducted by applicant's counsel of all live records at the U.S. Patent and Trademark Office disclosed only 68 references where the goods included both cosmetics in Class 3 and clothing for children or infants in Class 25 (see Exhibit A of the June response). Applicant's search also showed that such marks included some form of adult clothing as well as children's clothing.

In the present application, applicant's goods are cosmetic products directed toward adults in Class 3. Registrant's goods are limited to apparel for infants and children in Class 25. Applicant submits that there is little likelihood that clothing sold exclusively for infants and

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children will travel in the same channels of trade or be marketed under the mark as cosmetic products for adults and therefore no likelihood of confusion between the two marks will occur. The channels of trade are in fact very distinct, with children's clothing typically located quite distant from adult cosmetics, even if sold in the same store. The commercial images and marketing for the respective goods are also distinct. Even if there is a marketing association between adult clothing and adult cosmetics, such an association cannot be assumed to exist between clothing for infants and children and cosmetics for adults.

In considering the Examining Attorney's assertion that the Applicant's goods and one of the registrants' goods travel in the same channels of trade, it has been recognized that similar marks can coexist for different types of wearing apparel. See, In re Shoe Works, Inc., 6 U.S.P.Q.2d 1890 (T.T.A.B. 1988) (no confusion between women's shoes and shorts and pants); A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc., 166 F.3d 191, 49 U.S.P.Q.2d 1493 (3d Cir. 1999) (MIRACLESUIT for swimwear not likely to be confused with MIRACLE BRA for lingerie); Clark & Freeman Corp. v. Heartland Co., 811 F.Supp. 137, 25 U.S.P.Q.2d 2030 (S.D.N.Y. 1993) (owner of mark for boots and shoes could not stop use of mark on shirts). The distinction between adult cosmetics and children's clothing is even greater than the distinction between different types of clothing and the above cited case law supports the registration of applicant's mark.

It is also noted that the present Examining Attorney has recently addressed the same issues in another application handled by the undersigned. In the application of Fu Da

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International Ltd. for the mark CLUELESS, Serial No. 78/037,287, the applicant's goods are children's clothing. The Examining Attorney withdrew a refusal to register the mark based on Reg. No. 2,037,895 for the mark CLUELESS for "cosmetics, namely concealers." Applicant submits that the issues in the CLUELESS application are nearly identical to the present refusal and accordingly, the refusal to register should be withdrawn.

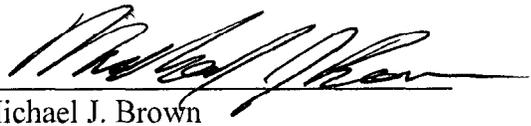
Applicant advises that a Notice of Appeal has been filed with respect to this application.

WHEREFORE, Applicant respectfully requests that the Examining Attorney reconsider the refusal to register the subject application and approve the application for publication in the *Official Gazette*.

Respectfully submitted,

Boom LLC

Dated: February 27, 2003

By: 

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