

PTO Form 1957 (Rev 8/2005)

OMB Control #0651-0050 (Exp. 04/30/2006)

## Response to Office Action

**The table below presents the data as entered.**

Input Field	Entered
<b>SERIAL NUMBER</b>	78246819
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 115
<b>MARK SECTION (no change)</b>	
<b>ARGUMENT(S)</b>	
<b><u>REQUEST FOR RECONSIDERATION</u></b>	
<p>Applicant submits this Request for Reconsideration in response to the Office Action dated June 2, 2005 that issued herein. A Notice of Appeal is being filed contemporaneously with this Request.</p> <p>The Examining Attorney has made final a refusal to register the subject mark based on Reg. No. 2,843,001 for the mark POWDER &amp; Design for ?clothing, namely, underwear, undergarments, undershirts, underpants, thongs, t-shirts, pajamas, sleepwear, sleep shirts, socks, blouses, dresses, panties, pants, skirts, jackets, jeans, swimwear, sweatshirts, and hats, in class 25? (the ?cited mark?). Applicant respectfully requests reconsideration and withdrawal of this refusal for the reasons previously set forth in its Responses dated April 13, 2004 and April 21, 2005, and for the additional reasons set forth below.</p> <p>Applicant incorporates by reference all of the arguments made in its previous Responses. In addition, Applicant calls attention to the following third party registrations containing the word POWDER, copies of each of which were submitted with Applicant?s Response dated April 13, 2004:</p>	
<b>TRADEMARK</b>	<b>REG. NO./ APP. DATE/REG. DATE</b>
<b>GOODS/SERVICES (CLASS)</b>	
GOT POWDER?	2,759,084 11/09/02 09/02/03
	Shirts, jackets, pants, and hats (25)

POWDER ROOM	2,497,557	06/28/99	07/24/01	Sunglasses (9); watches (14); all purpose athletic bags (18); clothing and outerwear, namely, jackets, pants, skirts, dresses, swimsuits, shorts, shirts, sweatshirts, sport shirts, sweaters, socks, hats, caps, visors, gloves, mitts, shoes, boots, belts, footwear, headwear (25)
POWDER BLU	2,390,622	06/21/99	09/26/00	Clothing for men and women, namely, women's sweatsuits, sweatshirts and footwear, knits and women tops, bottoms, dresses, skirts, pants and shorts and men's sportswear, namely, pants, shirts, sweaters and shorts (25)
POWDER RIVER	2,267,688	09/18/97	08/03/99	Clothing, namely, shirts, blouses, dresses, skirts, shorts, jeans, pants, jackets, coats, hats, gloves, socks, scarves, belts, shoes, and boots for men, women, and children (25)
POWDER BANDIT	1,512,825	04/04/88	11/15/88	Clothing, namely skiwear and insulated scarves (25)

Each of the above POWDER marks has an earlier application filing date than that of the cited mark. Thus the Examining Attorney for the cited mark did not believe there to be any conflict between POWDER & Design alone and the two-word POWDER marks set forth above. Further, as shown in the attached printout from the TARR web server, there is no record of any oppositions being filed against the POWDER application. Moreover, as shown in the attached printout from the Trademark Trial and Appeal Board Inquiry System (TTABVUE), although the registrant of the cited mark claims a date of first use that is earlier than the date that rights were established (through use or ITU filing) for some of the marks in the above chart, there is no indication that the registrant of the cited mark has filed any oppositions against any marks containing POWDER. Where it is apparent that (1) the Examining Attorney in the application for the cited mark understood that POWDER is weak for clothing, and allowed the application for the cited mark over the prior-filed marks containing POWDER, (2) the prior applicants/registrants apparently did not believe any likelihood of confusion would exist with the cited mark, and (3) the registrant of the cited

mark did not believe any likelihood of confusion would exist between its mark and those POWDER marks with records showing junior rights, there is no basis for the subject application to be blocked by the prior registration for the distinguishable mark POWDER & Design where multiple marks containing the element POWDER are already on record. The rights to be accorded the cited mark cannot be so broad as to block Applicant's subsequent, distinguishable two-word mark containing the word POWDER.

In essence, what the Examining Attorney is arguing is that broader protection should be accorded to a later filed mark than would have been accorded to earlier marks. The Office has already established a track record that there is no likelihood of confusion between the five two-word marks of record and the cited mark. Likelihood of confusion does not arise simply because Applicant's filing date is subsequent to rather than prior to the cited mark. Moreover, there have been no radical changes in the marketplace to change the Office's position. The goods of the earlier registrations of record are either similar to the goods in the cited registration or related thereto. Had Applicant obtained a registration for SILKY POWDER prior to the issuance of the cited reference, it is submitted that it is unlikely that the cited mark would have been rejected over it. It probably would have been considered a two-word mark just as GOT POWDER would POWDER BLU, which were thought to be distinguishable from POWDER. For the same reason, SILKY POWDER is distinguishable from POWDER.

**REMARKS**

Having resolved all informalities raised by the Examining Attorney, Applicant respectfully requests reconsideration and withdrawal of the refusal of record and an early Notice of Publication.

<b>EVIDENCE SECTION</b>	
EVIDENCE FILE NAME	<u>\\TICRS\EXPORT8\IMAGEOUT8\782\468\78246819\xml1\RO A0002.JPG</u>
EVIDENCE FILE NAME	<u>\\TICRS\EXPORT8\IMAGEOUT8\782\468\78246819\xml1\RO A0003.JPG</u>

EVIDENCE FILE NAME	\\TICRS\EXPORT8\IMAGEOUT8\782\468 \78246819\xml1\RO_A0004.JPG
EVIDENCE FILE NAME	\\TICRS\EXPORT8\IMAGEOUT8\782\468 \78246819\xml1\RO_A0005.JPG
DESCRIPTION OF EVIDENCE FILE	TARR and TTABVUE website printouts
<b>SIGNATURE SECTION</b>	
RESPONSE SIGNATURE	/Laura J. Winston/
SIGNATORY NAME	Laura J. Winston
SIGNATORY POSITION	Attorney
SIGNATURE DATE	11/17/2005
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Thu Nov 17 12:39:27 EST 2005
TEAS STAMP	USPTO/ROA-207.124.139.115 -20051117123927059839-782 46819-320e423fcb3b71dfe9f b27294534d2b77-N/A-N/A-20 051117122354256223

PTO Form 1957 (Rev 8/2005)

OMB Control #0351-0050 (Exp. 04/30/2006)

## Response to Office Action

### To the Commissioner for Trademarks:

Application serial no. **78246819** has been amended as follows:

#### Argument(s)

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

#### REQUEST FOR RECONSIDERATION

Applicant submits this Request for Reconsideration in response to the Office Action dated June 2, 2005 that issued herein. A Notice of Appeal is being filed contemporaneously with this Request.

The Examining Attorney has made final a refusal to register the subject mark based on Reg.

No. 2,843,001 for the mark POWDER & Design for ?clothing, namely, underwear, undergarments, undershirts, underpants, thongs, t-shirts, pajamas, sleepwear, sleep shirts, socks, blouses, dresses, panties, pants, skirts, jackets, jeans, swimwear, sweatshirts, and hats, in class 25? (the ?cited mark?). Applicant respectfully requests reconsideration and withdrawal of this refusal for the reasons previously set forth in its Responses dated April 13, 2004 and April 21, 2005, and for the additional reasons set forth below.

Applicant incorporates by reference all of the arguments made in its previous Responses. In addition, Applicant calls attention to the following third party registrations containing the word POWDER, copies of each of which were submitted with Applicant?s Response dated April 13, 2004:

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POWDER BLU	2,390,622 06/21/99 09/26/00	Clothing for men and women, namely, women?s sweatsuits, sweatshirts and footwear, knits and women tops, bottoms, dresses, skirts, pants and shorts and men?s sportswear, namely, pants, shirts, sweaters and shorts (25)
POWDER RIVER	2,267,688 09/18/97 08/03/99	Clothing, namely, shirts, blouses, dresses, skirts, shorts, jeans, pants, jackets, coats, hats, gloves, socks, scarves, belts, shoes, and boots for men, women, and children (25)
POWDER BANDIT	1,512,825 04/04/88 11/15/88	Clothing, namely skiwear and insulated scarves (25)

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being filed against the POWDER application. Moreover, as shown in the attached printout from the Trademark Trial and Appeal Board Inquiry System (TTABVUE), although the registrant of the cited mark claims a date of first use that is earlier than the date that rights were established (through use or ITU filing) for some of the marks in the above chart, there is no indication that the registrant of the cited mark has filed any oppositions against any marks containing POWDER. Where it is apparent that (1) the Examining Attorney in the application for the cited mark understood that POWDER is weak for clothing, and allowed the application for the cited mark over the prior-filed marks containing POWDER, (2) the prior applicants/registrants apparently did not believe any likelihood of confusion would exist with the cited mark, and (3) the registrant of the cited mark did not believe any likelihood of confusion would exist between its mark and those POWDER marks with records showing junior rights, there is no basis for the subject application to be blocked by the prior registration for the distinguishable mark POWDER & Design where multiple marks containing the element POWDER are already on record. The rights to be accorded the cited mark cannot be so broad as to block Applicant's subsequent, distinguishable two-word mark containing the word POWDER.

In essence, what the Examining Attorney is arguing is that broader protection should be accorded to a later filed mark than would have been accorded to earlier marks. The Office has already established a track record that there is no likelihood of confusion between the five two-word marks of record and the cited mark. Likelihood of confusion does not arise simply because Applicant's filing date is subsequent to rather than prior to the cited mark. Moreover, there have been no radical changes in the marketplace to change the Office's position. The goods of the earlier registrations of record are either similar to the goods in the cited registration or related thereto. Had Applicant obtained a registration for SILKY POWDER prior to the issuance of the cited reference, it is submitted that it is unlikely that the cited mark would have been rejected over it. It probably would have been considered a two-word mark just as GOT POWDER would POWDER BLU, which were thought to be distinguishable from POWDER. For the same reason, SILKY POWDER is distinguishable from POWDER.

**REMARKS**

Having resolved all informalities raised by the Examining Attorney, Applicant respectfully requests reconsideration and withdrawal of the refusal of record and an early Notice of Publication.

**Evidence**

Evidence in the nature of TARR and TTABVUE website printouts has been attached.

Evidence-1

Evidence-2

Evidence-3

Evidence-4

**Response Signature**

Signature: /Laura J. Winston/ Date: 11/17/2005

Signatory's Name: Laura J. Winston

Signatory's Position: Attorney

Serial Number: 78246819

Internet Transmission Date: Thu Nov 17 12:39:27 EST 2005

TEAS Stamp: USPTO/ROA-207.124.139.115-20051117123927

059839-78246819-320e423feb3b71dfe9fb2729

4534d2b77-N/A-N/A-20051117122354256223

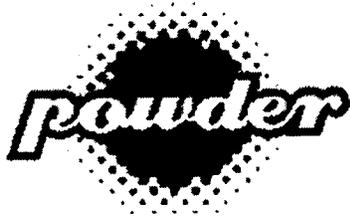
**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2005-10-11 10:10:08 ET**

**Serial Number: 78200085**

**Registration Number: 2843001**

**Mark**



**(words only): POWDER**

**Standard Character claim: No**

**Current Status: Registered.**

**Date of Status: 2004-05-18**

**Filing Date: 2003-01-04**

**Transformed into a National Application: No**

**Registration Date: 2004-05-18**

**Register: Principal**

**Law Office Assigned: LAW OFFICE 110**

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location: 900 -File Repository (Franconia)**

**Date In Location: 2004-06-03**

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. Powder

Chicago, IL 60661  
United States  
**Legal Entity Type:** Ltd Liab Jt St Co  
**State or Country Where Organized:** Illinois  
**Phone Number:** 310 569 0398

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**GOODS AND/OR SERVICES**

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**International Class:** 025  
clothing, namely, underwear, undergarments, undershirts, underpants, thongs, t-shirts, pajamas, sleepwear, sleep shirts, socks, blouses, dresses, panties, pants, skirts, jackets, jeans, swimwear, sweatshirts and hats  
**First Use Date:** 1999-07-01  
**First Use in Commerce Date:** 1999-08-01

**Basis:** 1(a)

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**ADDITIONAL INFORMATION**

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(NOT AVAILABLE)

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2004-05-18 - Registered - Principal Register  
2004-02-24 - Published for opposition  
2004-02-04 - Notice of publication  
2003-12-18 - Approved for Pub - Principal Register (initial exam)  
2003-11-14 - Communication received from applicant  
2003-11-14 - PAPER RECEIVED  
2003-11-13 - Communication received from applicant  
2003-11-14 - Email Received  
2003-06-06 - Non-final action e-mailed

**CORRESPONDENCE INFORMATION**

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**Correspondent**

Powder

500 West Madison Street Suite 2910

Chicago IL USA 60661

**Phone Number:** 310 569 0398

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All these words anywhere in a record:

Search proceeding number, application or registration number, parties, marks

Application or registration number:

Mark:

Party:

Other Party:

Correspondent:

PTO Form 2196 (Rev 09/04)

OMB Control #0851-0009 (Exp. 06/30/2005)

## Revocation of Attorney/Domestic Representative and/or Appointment of Attorney/Domestic Representative

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	78246819
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 115
<b>MARK SECTION</b>	
MARK	SILKY POWDER
<b>ATTORNEY SECTION</b>	
ORIGINAL ADDRESS	PAUL FIELDS AND AMY NELKIN DARBY & DARBY P. C. 6082/300K629 P.O. BOX 5257 NEW YORK, NY 10150-5257 212-753-6237 212-527-7700 tmdocket@darbylaw.com
<b>CORRESPONDENCE SECTION</b>	
ORIGINAL ADDRESS	PAUL FIELDS AND AMY NELKIN DARBY & DARBY P. C. 6082/300K629 P.O. BOX 5257 NEW YORK, NY 10150-5257 212-753-6237 212-527-7700 tmdocket@darbylaw.com
<b>NEW ATTORNEY ADDRESS</b>	
STATEMENT TEXT	By submission of this request, the undersigned REVOKES the power of attorney currently of record, as listed above, and hereby APPOINTS the following new attorney:
NAME	Laura J. Winston, Paul Fields, Andrew Baum, Robert S. Weisbein, Amy J. Benjamin, Eric Prager, Karin Segall, Randi S. Miller, Heather C. Wilde, Jonathan

	Matkowsky, Abigail R. Rubinstein and Kathryn Starnella
FIRM NAME	Darby & Darby P.C.
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PHONE	212-527-7700
FAX	212-527-7701
EMAIL	tmdocket@darbylaw.com
ATTORNEY AUTHORIZED TO COMMUNICATE VIA E-MAIL	YES
ATTORNEY DOCKET NUMBER	06082/300K629-US0
<b>NEW CORRESPONDENCE ADDRESS</b>	
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<b>SIGNATURE SECTION</b>	
SIGNATURE	/Laura J. Winston/
SIGNATORY NAME	Laura J. Winston

SIGNATORY DATE	11/17/2005
SIGNATORY POSITION	Attorney
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Thu Nov 17 16:02:50 EST 2005
TEAS STAMP	USPTO/RAA-207.124.139.115 -20051117160250891749-782 46819-3201521e0a42158ee65 ed1f73918848751-N/A-N/A-2 0051117152458237058