

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79131650
LAW OFFICE ASSIGNED	LAW OFFICE 116
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The examining attorney refused registration in view of the following registrations, all featuring the term ORIENT EXPRESS:</p> <p>3,259,698 3,577,866 3,676,783</p> <p>Applicant has amended the identification of goods to minimize the likelihood of confusion and requests reconsideration of the refusal in view of the amendment to the identification of goods.</p> <p><u>U.S. Registration No. 3,259,698</u></p> <p>Applicant has deleted the following items from the application that the examining attorney identified as the source of possible confusion:</p> <p>“furniture, mirrors, picture frames...armchairs; seats” in International Class 20 and “the bringing together, for the benefit of others of a variety of goods, excluding the transport thereof, namely...furniture...permitting clients to see and to buy these products in retail stores or in department stores, in a general catalog of goods or on a Web site or on television or any other form of electronic telecommunication media.”</p> <p>The remaining goods in International Class 20 are sufficiently distinct from the cited registration to avoid confusion.</p> <p><u>U.S. Registration No. 3,577,866</u></p> <p>Applicant has deleted the following items from the application that the examining attorney identified as the source of possible confusion:</p> <p>“coffee, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, edible ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice for refreshment; sandwiches, pizzas; pancakes; biscuits; cakes;</p>	

rusks; sugar confectionery; chocolate; beverages based on cocoa, coffee, chocolate”

The remaining goods in International Class 30 are sufficiently distinct from the cited registration to avoid confusion.

U.S. Registration No. 3,676,783

Applicant has deleted International Class 3 from the Application, which was identified as the source of possible confusion.

GOODS AND/OR SERVICES SECTION (003)(class deleted)

GOODS AND/OR SERVICES SECTION (008)(no change)

GOODS AND/OR SERVICES SECTION (009)(no change)

GOODS AND/OR SERVICES SECTION (011)(no change)

GOODS AND/OR SERVICES SECTION (012)(no change)

GOODS AND/OR SERVICES SECTION (014)(no change)

GOODS AND/OR SERVICES SECTION (016)(no change)

GOODS AND/OR SERVICES SECTION (018)(no change)

GOODS AND/OR SERVICES SECTION (020)(current)

INTERNATIONAL CLASS	020
---------------------	-----

DESCRIPTION

Furniture, mirrors, picture frames; works of art made of wood, wax, plaster, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum, substitutes for all these materials or of plastic; coat hangers; cushions; armchairs; seats; boxes of wood or plastic

GOODS AND/OR SERVICES SECTION (020)(proposed)

INTERNATIONAL CLASS	020
---------------------	-----

TRACKED TEXT DESCRIPTION

~~Furniture, mirrors, picture frames; works of art made of wood, wax, plaster, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum, substitutes for all these materials or of plastic; coat hangers; cushions; armchairs; seats; boxes of wood or plastic~~
mattresses, mattress pads, bed bases, headboards, and bed arms;

FINAL DESCRIPTION

mattresses, mattress pads, bed bases, headboards, and bed arms

GOODS AND/OR SERVICES SECTION (021)(no change)

GOODS AND/OR SERVICES SECTION (024)(current)

INTERNATIONAL CLASS	024
---------------------	-----

DESCRIPTION

Bed blankets; bed linen; household linen; table linen, not of paper; Tablecloths of textiles; Sanitary, disposable and table napkins of textile or paper, bath linen (except clothing), traveling rugs

GOODS AND/OR SERVICES SECTION (024)(proposed)

INTERNATIONAL CLASS 024

TRACKED TEXT DESCRIPTION

Bed blankets; bed linen; household linen; table linen, not of paper; Tablecloths of textiles; ~~Sanitary, disposable and table napkins of textile or paper, bath linen (except clothing), traveling rugs~~; [bath linen, except clothing, traveling rugs](#)

FINAL DESCRIPTION

Bed blankets; bed linen; household linen; table linen, not of paper; Tablecloths of textiles; bath linen, except clothing, traveling rugs

GOODS AND/OR SERVICES SECTION (025)(no change)

GOODS AND/OR SERVICES SECTION (026)(no change)

GOODS AND/OR SERVICES SECTION (028)(current)

INTERNATIONAL CLASS 028

DESCRIPTION

Games, namely, action, arcade, board, building, card, dice, manipulative, memory, parlor, party, role playing, tabletop, target, trading toys; Toys, namely, construction, drawing, educational, learning, action, infant, inflatable, mechanical, musical, pet, pull, plush, push, punching, ride on, squeeze, stacking toys; miniature toy trains Christmas tree decorations excluding lighting and confectionery; card or board games, parlor games

GOODS AND/OR SERVICES SECTION (028)(proposed)

INTERNATIONAL CLASS 028

TRACKED TEXT DESCRIPTION

~~Games, namely, action, arcade, board, building, card, dice, manipulative, memory, parlor, party, role playing, tabletop, target, trading toys~~; [Games, namely, action, arcade, board, building, card, dice, manipulative, memory, parlor, party, role playing, tabletop, target, trading card games](#); ~~; Toys, namely, construction, drawing, educational, learning, action, infant, inflatable, mechanical, musical, pet, pull, plush, push, punching, ride on, squeeze, stacking toys~~; [Toys, namely, construction, drawing, educational, learning, action, infant, inflatable, mechanical, musical, pet, pull, plush, push, punching, ride on, squeeze, stacking toys](#); miniature toy trains Christmas tree decorations excluding lighting and confectionery; card or board games, parlor games

FINAL DESCRIPTION

Games, namely, action, arcade, board, building, card, dice, manipulative, memory, parlor, party, role playing, tabletop, target, trading card games; Toys, namely, construction, drawing, educational, learning, action, infant, inflatable, mechanical, musical, pet, pull, plush, push, punching, ride on, squeeze, stacking toys; miniature toy trains Christmas tree decorations excluding lighting and confectionery; card or board games, parlor games

GOODS AND/OR SERVICES SECTION (029)(no change)**GOODS AND/OR SERVICES SECTION (030)(current)**

INTERNATIONAL CLASS 030

DESCRIPTION

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, edible ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice for refreshment; sandwiches, pizzas; pancakes; biscuits; cakes; rusks; sugar confectionery; chocolate; beverages based on cocoa, coffee, chocolate or tea

GOODS AND/OR SERVICES SECTION (030)(proposed)

INTERNATIONAL CLASS 030

TRACKED TEXT DESCRIPTION

~~Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee;~~ Tea; ~~flour and preparations made from cereals, bread, pastry and confectionery, edible ices;~~ beverages based on tea; ~~honey, treacle;~~ ~~yeast, baking-powder;~~ ~~salt, mustard;~~ ~~vinegar, sauces (condiments);~~ ~~spices;~~ ~~ice for refreshment;~~ ~~sandwiches, pizzas;~~ ~~pancakes;~~ ~~biscuits;~~ ~~cakes;~~ ~~rusks;~~ ~~sugar confectionery;~~ ~~chocolate;~~ ~~beverages based on cocoa, coffee, chocolate or tea~~

FINAL DESCRIPTION Tea; beverages based on tea

GOODS AND/OR SERVICES SECTION (032)(no change)**GOODS AND/OR SERVICES SECTION (033)(no change)****GOODS AND/OR SERVICES SECTION (034)(no change)****GOODS AND/OR SERVICES SECTION (035)(class deleted)****GOODS AND/OR SERVICES SECTION (038)(no change)****GOODS AND/OR SERVICES SECTION (041)(current)**

INTERNATIONAL CLASS 041

DESCRIPTION

Cultural activities; entertainment information; publication of books; lending of books; videotape film production; rental of motion pictures; rental of sound recordings; rental of video cassette recorders or of radio and television sets; photography services; organization and conducting of colloquiums, conferences or congresses; organization of exhibitions for cultural or educational purposes; booking of seats for shows; gambling services; publication of electronic books and journals on-line

GOODS AND/OR SERVICES SECTION (041)(proposed)

INTERNATIONAL CLASS 041

TRACKED TEXT DESCRIPTION

~~Cultural activities;~~ Organizing and conducting cultural activities; entertainment information; publication of books; lending of books; videotape film production; rental of motion pictures; rental of sound recordings; rental of video cassette recorders or of radio and television sets; photography services;

~~organization and conducting of colloquiums, conferences or congresses;~~ [organization and conducting of educational colloquiums, conferences or congresses;](#) organization of exhibitions for cultural or educational purposes; booking of seats for shows; gambling services; publication of electronic books and journals on-line

FINAL DESCRIPTION

Organizing and conducting cultural activities; entertainment information; publication of books; lending of books; videotape film production; rental of motion pictures; rental of sound recordings; rental of video cassette recorders or of radio and television sets; photography services; organization and conducting of educational colloquiums, conferences or congresses; organization of exhibitions for cultural or educational purposes; booking of seats for shows; gambling services; publication of electronic books and journals on-line

GOODS AND/OR SERVICES SECTION (044)(no change)

SIGNATURE SECTION

RESPONSE SIGNATURE	/AIC/
SIGNATORY'S NAME	Andy I. Corea
SIGNATORY'S POSITION	Attorney of Record, Connecticut Bar Member
SIGNATORY'S PHONE NUMBER	203-324-6155
DATE SIGNED	08/18/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Mon Aug 18 11:27:52 EDT 2014
TEAS STAMP	USPTO/RFR-65.51.38.130-20 140818112752382803-791316 50-500c71f249ca974df5b9a9 4533028fa4aa891dc8ace0819 b16ccc4d9a5fb4553-N/A-N/A -20140818100920496263

**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **79131650** has been amended as follows:

ARGUMENT(S)

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

The examining attorney refused registration in view of the following registrations, all featuring the term ORIENT EXPRESS:

3,259,698

3,577,866

3,676,783

Applicant has amended the identification of goods to minimize the likelihood of confusion and requests reconsideration of the refusal in view of the amendment to the identification of goods.

U.S. Registration No. 3,259,698

Applicant has deleted the following items from the application that the examining attorney identified as the source of possible confusion:

“furniture, mirrors, picture frames...armchairs; seats” in International Class 20 and “the bringing together, for the benefit of others of a variety of goods, excluding the transport thereof, namely...furniture...permitting clients to see and to buy these products in retail stores or in department stores, in a general catalog of goods or on a Web site or on television or any other form of electronic telecommunication media.”

The remaining goods in International Class 20 are sufficiently distinct from the cited registration to avoid confusion.

U.S. Registration No. 3,577,866

Applicant has deleted the following items from the application that the examining attorney identified as the source of possible confusion:

“coffee, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, edible ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice for refreshment; sandwiches, pizzas; pancakes; biscuits; cakes; rusks; sugar confectionery; chocolate; beverages based on cocoa, coffee, chocolate”

The remaining goods in International Class 30 are sufficiently distinct from the cited registration to avoid confusion.

U.S. Registration No. 3,676,783

Applicant has deleted International Class 3 from the Application, which was identified as the source of possible confusion.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant hereby deletes the following class of goods/services from the application.

Class 003 for Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; make-up and make-up

remover; lipstick; beauty masks; shaving preparations; bath salts, incense sticks, wax leather preservatives; leather preservative creams

Applicant hereby deletes the following class of goods/services from the application.

Class 035 for Advertising; business management; business administration; direct mail advertising using leaflets, prospectuses, printed matter, samples; arranging newspaper subscriptions for others; arranging of telecommunication service subscriptions for others; Advertising and commercial information services, namely, promoting the goods and services of others ; Information services , namely providing consumer information and related news in the field of consumer goods and services of other offered on board mass transport vehicles, with said information and news provided via computer communication electronically, and by telephone; business management and organization consultancy; organization of exhibitions for commercial or advertising purposes; on-line advertising on a computer network; rental of advertising time on all communication media; publication of advertising texts; rental of advertising space; dissemination of advertisements; public relations, the bringing together, for the benefit of others of a variety of goods, excluding the transport thereof, namely, perfumery and cosmetics, cutlery, optical apparatus, apparatus for the recording and reproduction of sound and images, apparatus for lighting, jewelry, stationery and writing materials, articles of leatherware, furniture, tableware and toiletry accessories, fabric, bed and household linen, clothing, footwear, headgear, lace and embroidery, games and playthings, foodstuffs and beverages, smokers' articles, permitting clients to see and to buy these products in retail stores or in department stores, in a general catalog of goods or on a Web site or on television or any other form of electronic telecommunication media

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

Current: Class 020 for Furniture, mirrors, picture frames; works of art made of wood, wax, plaster, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum, substitutes for all these materials or of plastic; coat hangers; cushions; armchairs; seats; boxes of wood or plastic
Original Filing Basis:

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~Furniture, mirrors, picture frames; works of art made of wood, wax, plaster, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum, substitutes for all these materials or of plastic; coat hangers; cushions; armchairs; seats; boxes of wood or plastic~~; mattresses, mattress pads, bed bases, headboards, and bed arms

Class 020 for mattresses, mattress pads, bed bases, headboards, and bed arms

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

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

Current: Class 024 for Bed blankets; bed linen; household linen; table linen, not of paper; Tablecloths of textiles; Sanitary, disposable and table napkins of textile or paper, bath linen (except clothing), traveling rugs

Original Filing Basis:

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: Bed blankets; bed linen; household linen; table linen, not of paper; Tablecloths of textiles; ~~Sanitary, disposable and table napkins of textile or paper, bath linen (except clothing), traveling rugs;~~ bath linen, except clothing, traveling rugs

Class 024 for Bed blankets; bed linen; household linen; table linen, not of paper; Tablecloths of textiles; bath linen, except clothing, traveling rugs

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

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

Current: Class 028 for Games, namely, action, arcade, board, building, card, dice, manipulative, memory, parlor, party, role playing, tabletop, target, trading toys; Toys, namely, construction, drawing, educational, learning, action, infant, inflatable, mechanical, musical, pet, pull, plush, push, punching, ride on, squeeze, stacking toys; miniature toy trains Christmas tree decorations excluding lighting and confectionery; card or board games, parlor games

Original Filing Basis:

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~Games, namely, action, arcade, board, building, card, dice, manipulative, memory, parlor, party, role playing, tabletop, target, trading toys;~~ Games, namely, action, arcade, board, building, card, dice, manipulative, memory, parlor, party, role playing, tabletop, target, trading card games; ; ~~Toys, namely, construction, drawing, educational, learning, action, infant, inflatable, mechanical, musical, pet, pull, plush, push, punching, ride on, squeeze, stacking toys;~~ Toys, namely, construction, drawing, educational, learning, action, infant, inflatable, mechanical, musical, pet, pull, plush, push, punching, ride on, squeeze, stacking toys; miniature toy trains Christmas tree decorations excluding lighting and confectionery; card or board games, parlor games

Class 028 for Games, namely, action, arcade, board, building, card, dice, manipulative, memory, parlor, party, role playing, tabletop, target, trading card games; Toys, namely, construction, drawing, educational, learning, action, infant, inflatable, mechanical, musical, pet, pull, plush, push, punching, ride on, squeeze, stacking toys; miniature toy trains Christmas tree decorations excluding lighting and confectionery; card or board games, parlor games

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

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

Current: Class 030 for Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, edible ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice for refreshment; sandwiches, pizzas; pancakes; biscuits; cakes; rusks; sugar confectionery; chocolate; beverages based on cocoa, coffee, chocolate or tea

Original Filing Basis:

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; Tea; flour and preparations made from cereals, bread, pastry and confectionery, edible ices; beverages based on tea; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice for refreshment; sandwiches, pizzas; pancakes; biscuits; cakes; rusks; sugar confectionery; chocolate; beverages based on cocoa, coffee, chocolate or tea~~

Class 030 for Tea; beverages based on tea

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

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

Current: Class 041 for Cultural activities; entertainment information; publication of books; lending of books; videotape film production; rental of motion pictures; rental of sound recordings; rental of video cassette recorders or of radio and television sets; photography services; organization and conducting of colloquiums, conferences or congresses; organization of exhibitions for cultural or educational purposes; booking of seats for shows; gambling services; publication of electronic books and journals on-line
Original Filing Basis:

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~Cultural activities; Organizing and conducting cultural activities;~~ entertainment information; publication of books; lending of books; videotape film production; rental of motion pictures; rental of sound recordings; rental of video cassette recorders or of radio and television sets; photography services; ~~organization and conducting of colloquiums, conferences or congresses;~~ organization and conducting of educational colloquiums, conferences or congresses; organization of exhibitions for cultural or educational purposes; booking of seats for shows; gambling services; publication of electronic books and journals on-line

Class 041 for Organizing and conducting cultural activities; entertainment information; publication of books; lending of books; videotape film production; rental of motion pictures; rental of sound recordings; rental of video cassette recorders or of radio and television sets; photography services; organization and conducting of educational colloquiums, conferences or congresses; organization of exhibitions for cultural or educational purposes; booking of seats for shows; gambling services; publication of electronic books and journals on-line

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /AIC/ Date: 08/18/2014

Signatory's Name: Andy I. Corea

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

Signatory's Phone Number: 203-324-6155

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: 79131650

Internet Transmission Date: Mon Aug 18 11:27:52 EDT 2014

TEAS Stamp: USPTO/RFR-65.51.38.130-20140818112752382

803-79131650-500c71f249ca974df5b9a945330

28fa4aa891dc8ace0819b16ccc4d9a5fb4553-N/

A-N/A-20140818100920496263