

From: Maciol, Gene

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Subject: U.S. TRADEMARK APPLICATION NO. 85250061 - DASH - N/A - Request
for Reconsideration Denied - Return to TTAB

Attachment Information:

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85250061

MARK: DASH



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Kimsaprincess Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 7/20/2012

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated December 21, 2012 are maintained and continue to be final. *See* TMEP §§715.03(a), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues.

Specifically, applicant argues that his mark should be allowed to register because the registered mark is and entitled to a narrow scope of protection. Applicant bases this argument upon the fact that there are numerous third party registrations containing either the term or letter combination DASH. The examining attorney disagrees.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d).

The following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. See *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); TMEP §§1207.01 et seq.

In the present case, none of Applicant's submitted third party registrations show use of a similar mark for similar goods and/or services as the cited registrations. Instead, all of Applicant's registrations submitted to show the relative dilution of the cited registered marks are for unrelated goods and services and/or contain additional wording that alters the primary meaning and commercial impression of the wording/letter combination DASH. For example, U.S. Registration Nos. 3683931, 2131161, 3809136, 3914068, 4141664, 4118734, 4119281, 4052567, 4023715, 3319698, 3955871, 3751990, 4042342, 3533508, and 4073016, for related goods and/or services, all contain additional wording that alters the commercial impression or meaning of the shared wording DASH. The additional wording serves to sufficiently distinguish each mark from one another in the mind of the average consumer. However, no such distinction exists between Applicant's mark and the cited registered marks. Instead, Applicant's and Registrants' marks are entirely comprised of the wording DASH, by itself.

Moreover, prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Int'l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994).

Applicant also argues that his mark has a different commercial impression than the cited registered mark such that it should be allowed to register. The examining attorney disagrees.

In the present case, the marks are literally identical. Both are entirely comprised of the term DASH. As such the marks share a similar sound, meaning, and commercial impression. Applicant's assertion that his mark refers to karDASHian is unfounded. The mark is not karDASHian, it is DASH. Moreover, even if the average consumer could make the gigantic leap that DASH refers to karDASHian, nothing prevents the average consumer from making the same conclusion for registered marks. The Trademark Act not only guards against the misimpression that the senior user is the source of the junior user's goods and/or services, but it also protects against "reverse confusion," that is, the junior user is the source of the senior user's goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *Fisons Horticulture, Inc. v. Vigoro Indust., Inc.*, 30 F.3d 466, 474-75, 31 USPQ2d 1592, 1597-98 (3d Cir. 1994); *Banff, Ltd. v. Federated Dep't Stores, Inc.*, 841 F.2d 486, 490-91, 6 USPQ2d 1187, 1190-91 (2d Cir. 1988).

Applicant also argues that the goods and services are sufficiently dissimilar such that his mark should be allowed to register. The examining attorney disagrees.

That the goods and/or services of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods and/or services, but likelihood of confusion as to the source or sponsorship of those goods and/or services. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01.

In the present case, the previously attached evidence clearly shows that Applicant's retail services are closely related to Registrants' goods. Applicant's retail store services feature Registrants' clothing and fashion accessory eyewear such that consumers may be under the false belief that Applicant's services are affiliated with or somehow sponsored by a Registrant.

Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §§715.03, 715.03(a), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

/V.J./
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