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

Proceeding	85250061
Applicant	Kimsaprincess Inc., Khlomoney Inc. and 2Die4Kourt
Applied for Mark	DASH
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Submission	Applicants Request for Remand and Amendment
Attachments	Request to Remand and Request to Amend Application.pdf (5 pages)(15467 bytes)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Mark: DASH

Class: 35

Serial No.: 85/250061

Filing Date: February 23, 2011

**REQUEST TO REMAND AND
REQUEST TO AMEND APPLICATION**

Applicants hereby respectfully requests that the above-referenced application (“Application”) be remanded to the examining attorney so that the examining attorney may consider an amendment of the recitation of services claimed in the Application.

REQUEST TO REMAND THE APPLICATION

The Trademark Trial and Appeal Board Manual of Procedure (TBMP”) states:

If an applicant that has filed a timely appeal to the Board files an amendment to its application more than six months after the issuance of the final action, or the second refusal on the same ground(s), or the repeated requirement from which the appeal was taken, the Board will treat the amendment as a request for remand.

...

Such a request will be granted upon a showing of good cause.

...

If the request for remand is granted, the Board will suspend proceedings with respect to the appeal and remand the application to the examining attorney for consideration of the amendment.

TBMP 1205.01. Applicants believe that they have good cause to request a remand, namely, for the examining attorney to consider an amendment of the Application. *Id* (“Good cause will generally be found, for example, when the amendment is an attempt to comply with a requirement, such as an amendment to the identification of goods or services in response to a requirement for an acceptable identification, or when the amendment will obviate a ground for

refusal, such as an amendment to the Supplemental Register or an amendment to assert a Trademark Act § 2(f).”) Here, the amendment to the Application is an attempt to obviate a ground for refusal, namely, a refusal based on Trademark Act § 2(d) and a likelihood of confusion with Registration Number 2670119 for “eyewear, namely, eyeglasses, eyeglass frames, sunglasses and eyeglass cases”. As set out in greater detail below, the Applicants wish to explicitly exclude the goods claimed in Registration Number 2670119 from its Application so as to address the examining attorney’s concerns regarding similarity of such goods with the Applicants’ services.

Applicants did not file an amendment of the Application at the time the Request for Reconsideration and Notice of Appeal were filed because Registration Number 2670119 was soon entering its tenth (10th) year of registration and, with the possibility of the cited registration being cancelled, the Applicants wished to preserve their rights and determine whether an amendment was needed. A Section 8 and 9 Affidavit for Registration Number 2670119 was in fact recently filed, and therefore, the Applicants are now requesting an amendment.

REQUEST TO AMEND THE APPLICATION

The Applicants wish to offer the following amendment to its recitation of services for the Application:

Class 35: Retail store services featuring apparel, footwear, and fashion accessories, **but excluding, eyewear, namely, eyeglasses, eyeglass frames, sunglasses and eyeglass cases**

By explicitly excluding the goods claimed in Registration Number 2670119 from the Applicants’ claimed services, the Applicants believe there can be no further doubt that there is a likelihood of confusion with Registration Number 2670119. The Applicants believe that any apparent overlap or similarity between the Applicants’ amended services and the goods set out in

Registration Number 2670119 have been significantly reduced, if not, removed. The amendment explicitly removing the goods claimed in Registration Number 2670119, coupled with the fact that the cited mark is heavily diluted and commercially weak and there is an evident difference in the commercial impression of the marks, i.e., the meaning of the Applicants' mark is a shorthand for KARDASHIAN, the Applicants do not believe that there is any likelihood of confusion with their mark and the mark claimed in Registration Number 2670119. In fact, the Board has held in numerous cases that there is no likelihood of confusion between identical or substantially similar marks for goods that much more similar. *See, e.g., In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1983) (No likelihood of confusion between parties' PLAYERS marks for shoes and men's underwear); *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126 (2d. Cir. 1979) (No likelihood of confusion between DRIZZLER for men's golf jackets and DRIZZLE for women's overcoats and raincoats); *H. Lubovsky, Inc. v. Espirit de Corp.*, 627 F.Supp.483, 228 USPQ 814 (SDNY 1986) (ESPIRIT on shoes was found to be strong enough to create confusion from use on shoes, but not on wearing apparel); *In re Shoe Works, Inc.*, 6 USPQ.2d 1890 (TTAB 1988) (no likelihood of confusion between PALM BAY women's shoes and PALM BAY shorts and pants).

CONCLUSION

Based on the foregoing, the Applicants respectfully request that: (i) the Board suspend the above-captioned appeal proceeding and remand the Application back to the examining attorney, and (ii) the examining attorney consider the amendment and reconsider withdrawing its refusal to register based on Registration Number 2670119. Applicants understand that if the requests are granted that there still remains a refusal to register based on another cited registration, namely, Registration Number 1807678, which the Applicants intend to address, if needed, in their Appeal Brief.

If, in the alternative, the Board finds that the Applicants have not shown sufficient good cause to remand the Application to the examining attorney, to preserve its rights, the Applicants request a thirty-day extension of time in which to file their Appeal Brief pursuant to TBMP1203.02(d). As grounds in support of this request, a thirty-day extension of time is necessary for Applicants to review the record in this matter and prepare their Appeal Brief in light of the Board's denial for remand and amendment of Application.

Dated: November 20, 2012

Respectfully submitted,
GORDON & SILVER, Ltd.

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically to the United States Patent and Trademark Office Trademark Trial and Appeal Board through its electronic filing system at <http://estta.uspto.gov> on November 20, 2012.

/Julie Gerhardt/
An employee of Gordon & Silver Ltd.