

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85262306
LAW OFFICE ASSIGNED	LAW OFFICE 101
MARK SECTION (no change)	
ARGUMENT(S)	
<p>This Request for Reconsideration is being filed in view of the Final Office Action forwarded to Applicant's attorneys of record on January 6, 2012, wherein the Examining Attorney indicated that, after carefully considering the Applicant's arguments in favor of registration, the arguments were found by her to be unpersuasive. Therefore, the refusal to register the design and word mark SAGA under Trademark Act Section 2(d) has been made final. Applicant respectfully disagrees with the Examining Attorney's belief that there is a likelihood of confusion between the Applicant's design and word mark SAGA for "Beach cover-ups; Beach coverups; Beachwear; Swimwear," and Registrant's word mark SAGA for "Wearable garments and clothing not comprised in whole, or in part, of fur, namely, jackets, pants, ski-suits, shirts, hats, bandannas, sweatshirts and hooded sweatshirts, all for use in winter sports, including but not limited to, skiing and snowboarding." In this Request for Reconsideration, Applicant first notes that it hereby incorporates by reference Applicant's previous response to the previous Office Action. In view of the Final Office Action, Applicant addresses more particularly the Examining Attorney's remarks in the Final Action and requests reconsideration of the refusal to register. It is believed that additional evidence is needed to support a determination that no likelihood of confusion exists between Applicant's design and word mark SAGA and Registrant's word mark SAGA. The Examining Attorney must use a two-step process in which she must analyze each case to determine whether there is a likelihood of confusion. First, she must look at the marks themselves for similarities in appearance, sound, connotation, and commercial impression. In re E.I. du Pont de Nemours & Co., 177 U.S.P.Q. 563 (1973). In comparing the marks themselves for similarities in appearance, sound, connotation, and commercial impression, the marks are not highly similar because of the Applicant's highly personal, distinct appearance, connotation, and commercial appearance. The marks have significantly different appearances, based on the unique design elements in Applicant's mark. Applicant's mark consists of stylized text of the word SAGA, topped by a pair of apparently metallic gold sails of a sailboat. The gold sails instantly convey to consumers an impression of luxury, wealth, and water, in addition to the impression of a voyage that the word SAGA implies. Moreover, Applicant takes great care to convey to consumers the personal significance of the sailboat and word SAGA. As the newly- submitted evidence shows, SAGA was the name of the sailboat owned by the parents of one of Applicant's members. Creating such a personal connection between the word SAGA and Applicant's members gives consumers the unique commercial impression of purchasing goods from a highly personalized boutique specializing in beach- or swim- related goods. The second step for the Examining Attorney in analyzing each case is to compare the goods or services to determine if they are related, or if the activities surrounding their</p>	

marketing are such that confusion as to origin is likely. In re August Storck KG, 218 U.S.P.Q. 823 (1983). In comparing the goods of Applicant with Registrant to determine if they are related, or if the activities surrounding their marketing are such that confusion as to origin is likely, Applicant's goods are significantly different from Registrant's as to warrant registration. Applicant offers consumers swim-related apparel with an emphasis on fashion rather than athletic performance. Registrant offers consumers apparel related to an entirely different, specialized segment of the apparel market-winter sports. Registrant's focus on winter sports implies that Registrant is more concerned with functional clothing, where Applicant is clearly focused on fashion and aesthetics. Applicant's marketing efforts are also very focused and distinct from Registrant's. Applicant describes in the "About" section of its website that it intends to appeal to the "modern jetsetting woman, inspiring her to travel the beautiful world, and to fully experience life within it." Applicant clearly intends to market women who appreciate swimwear created from imported Italian fabric, who love design and color, and who entertain exotic dreams of foreign travel. On the other hand, Registrant, in the newly-submitted "Contact" page of its website, acknowledges that because it has roots in the states of Montana, Oregon, and Utah, its company is inspired by the Mountain-West lifestyle, and focuses on functionality and performance. The unique nature of Applicant's goods and marketing activities should prevent any likelihood of confusion. Applicant believes that Applicant's mark is entitled to registration on the Principal Register. Applicant respectfully requests that the Examining Attorney reconsider her refusal of registration and allow publication of this mark. A Notice of Appeal has been filed concurrently with this Request to Reconsider the refusal of registration. Applicant requests that the appeal proceedings be suspended pending reconsideration by the Examining Attorney. Respectfully submitted, /Veronique Kherian/ Special Counsel Higa & Gipson, LLP 55 New Montgomery St. Suite 510 San Francisco, CA 94105 Tel: (415) 692-6520 Fax: (415) 692-6522

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	<u>evi_107313660-163004041 . About-SAGA Swimwear.pdf</u>
CONVERTED PDF FILE(S) (1 page)	<u>\\TICRS\EXPORT16\IMAGEOUT16\852\623\85262306 \xml2\RFR0002.JPG</u>
ORIGINAL PDF FILE	<u>evi_107313660-163004041 . Contact-SAGA Outerwear.pdf</u>
CONVERTED PDF FILE(S) (5 pages)	<u>\\TICRS\EXPORT16\IMAGEOUT16\852\623\85262306 \xml2\RFR0003.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT16\852\623\85262306 \xml2\RFR0004.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT16\852\623\85262306 \xml2\RFR0005.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT16\852\623\85262306 \xml2\RFR0006.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT16\852\623\85262306 \xml2\RFR0007.JPG</u>
DESCRIPTION OF EVIDENCE FILE	Screenshots of "About" section of Applicant's website and "Contact" section of Registrant's website.

SIGNATURE SECTION	
RESPONSE SIGNATURE	/Veronique Kherian/
SIGNATORY'S NAME	Veronique Kherian
SIGNATORY'S POSITION	Attorney of Record, California Bar Member
SIGNATORY'S PHONE NUMBER	(415) 692-6520
DATE SIGNED	07/05/2012
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Jul 05 16:49:18 EDT 2012
TEAS STAMP	USPTO/RFR-107.3.136.60-20 120705164918517443-852623 06-490f86ebf1ea6486f2c4a7 13869fc10fea-N/A-N/A-2012 0705163004041451

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **85262306** has been amended as follows:

ARGUMENT(S)

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

This Request for Reconsideration is being filed in view of the Final Office Action forwarded to Applicant's attorneys of record on January 6, 2012, wherein the Examining Attorney indicated that, after carefully considering the Applicant's arguments in favor of registration, the arguments were found by her to be unpersuasive. Therefore, the refusal to register the design and word mark SAGA under Trademark Act Section 2(d) has been made final. Applicant respectfully disagrees with the Examining Attorney's belief that there is a likelihood of confusion between the Applicant's design and word mark SAGA for "Beach cover-ups; Beach coverups; Beachwear; Swimwear," and Registrant's word mark SAGA for "Wearable garments and clothing not comprised in whole, or in part, of fur, namely, jackets, pants, ski-suits, shirts, hats, bandannas, sweatshirts and hooded sweatshirts, all for use in winter sports, including but not limited to, skiing and snowboarding." In this Request for Reconsideration, Applicant first notes that it hereby incorporates by reference Applicant's previous response to the previous Office

Action. In view of the Final Office Action, Applicant addresses more particularly the Examining Attorney's remarks in the Final Action and requests reconsideration of the refusal to register. It is believed that additional evidence is needed to support a determination that no likelihood of confusion exists between Applicant's design and word mark SAGA and Registrant's word mark SAGA. The Examining Attorney must use a two-step process in which she must analyze each case to determine whether there is a likelihood of confusion. First, she must look at the marks themselves for similarities in appearance, sound, connotation, and commercial impression. In re E.I. du Pont de Nemours & Co., 177 U.S.P.Q. 563 (1973). In comparing the marks themselves for similarities in appearance, sound, connotation, and commercial impression, the marks are not highly similar because of the Applicant's highly personal, distinct appearance, connotation, and commercial appearance. The marks have significantly different appearances, based on the unique design elements in Applicant's mark. Applicant's mark consists of stylized text of the word SAGA, topped by a pair of apparently metallic gold sails of a sailboat. The gold sails instantly convey to consumers an impression of luxury, wealth, and water, in addition to the impression of a voyage that the word SAGA implies. Moreover, Applicant takes great care to convey to consumers the personal significance of the sailboat and word SAGA. As the newly-submitted evidence shows, SAGA was the name of the sailboat owned by the parents of one of Applicant's members. Creating such a personal connection between the word SAGA and Applicant's members gives consumers the unique commercial impression of purchasing goods from a highly personalized boutique specializing in beach- or swim-related goods. The second step for the Examining Attorney in analyzing each case is to compare the goods or services to determine if they are related, or if the activities surrounding their marketing are such that confusion as to origin is likely. In re August Storck KG, 218 U.S.P.Q. 823 (1983). In comparing the goods of Applicant with Registrant to determine if they are related, or if the activities surrounding their marketing are such that confusion as to origin is likely, Applicant's goods are significantly different from Registrant's as to warrant registration. Applicant offers consumers swim-related apparel with an emphasis on fashion rather than athletic performance. Registrant offers consumers apparel related to an entirely different, specialized segment of the apparel market-winter sports. Registrant's focus on winter sports implies that Registrant is more concerned with functional clothing, where Applicant is clearly focused on fashion and aesthetics. Applicant's marketing efforts are also very focused and distinct from Registrant's. Applicant describes in the "About" section of its website that it intends to appeal to the "modern jetsetting woman, inspiring her to travel the beautiful world, and to fully experience life within it." Applicant clearly intends to market women who appreciate swimwear created from imported Italian fabric, who love design and color, and who entertain exotic dreams of foreign travel. On the other hand, Registrant, in the newly-submitted "Contact" page of its website, acknowledges that because it has roots in the states of Montana, Oregon, and Utah, its company is inspired by the Mountain-West lifestyle, and focuses on functionality and performance. The unique nature of Applicant's goods and marketing activities should prevent any likelihood of confusion. Applicant believes that Applicant's mark is entitled to registration on the Principal Register. Applicant respectfully requests that the Examining Attorney reconsider her refusal of registration and allow publication of this mark. A Notice of Appeal has been filed concurrently with this Request to Reconsider the refusal of registration. Applicant requests that the appeal proceedings be suspended pending reconsideration by the Examining Attorney. Respectfully submitted, /Veronique Kherian/ Special Counsel Higa & Gipson, LLP 55 New Montgomery St. Suite 510 San Francisco, CA 94105 Tel: (415) 692-6520 Fax: (415) 692-6522

EVIDENCE

Evidence in the nature of Screenshots of "About" section of Applicant's website and "Contact" section of Registrant's website. has been attached.

Original PDF file:

[evi_107313660-163004041_ . About-SAGA_Swimwear.pdf](#)

Converted PDF file(s) (1 page)

[Evidence-1](#)

Original PDF file:

evi_107313660-163004041 . Contact-SAGA Outerwear.pdf

Converted PDF file(s) (5 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Evidence-5

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Veronique Kherian/ Date: 07/05/2012

Signatory's Name: Veronique Kherian

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

Signatory's Phone Number: (415) 692-6520

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 not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85262306

Internet Transmission Date: Thu Jul 05 16:49:18 EDT 2012

TEAS Stamp: USPTO/RFR-107.3.136.60-20120705164918517

443-85262306-490f86ebf1ea6486f2c4a713869

fc10fea-N/A-N/A-20120705163004041451

Let the adventure begin...

[Home](#)

[Collection](#)

[About](#)

[Contact](#)

[Stores](#)

[Shop](#)

[Blog](#)

The Story

"Michelle and I met in 2008

while working at the same bar. We bonded from the discovery that between us, we owned nearly 200 bathing suits. When we both left, we remained friends, but something was missing in our lives and we both knew it. Randomly one day, she asked me if I was interested in becoming her business partner. She had this idea - this yearning - to design great swimsuits."

- SAGA Sales and Marketing Director, Alex McCauley

"Driving across the San Mateo bridge,

thinking about the endings and beginnings of our lives, I thought of the name SAGA, and it struck me as I looked out at the water. My parents used to own a sailboat named Saga, which they sailed across the Pacific Ocean on. I called Alex and at that moment, we both knew that it was the perfect beginning to our epic tale, our journey, our saga. That was the moment when our dreams turned in to possibilities."

- SAGA Designer, Michelle Byrnes

The Brand

Saga is an American luxury

swimwear brand, and a journey of adventure, spirit and wanderlust.

We design for the modern jetsetting woman, inspiring her to travel the beautiful world, and to fully experience life within it. From one season to the next, LAX to NRT, our swimsuits carry her free spirit from her flight to the beach, and beyond. At SAGA, we are defining a new era of worldwide mobility, with adventure at the epicentre of it.

Manufactured in Los Angeles, California, with fabrics imported from Italy, SAGA swimsuits are cutting edge modern, hinting at the exotic stories of the world. We are in love with color, form, and connecting our customer to the energy of her lifestyle, the inimitable quality of true spirit she possesses, and the world around her. Style is a reflection of the selves we project onto the world, and ours believes in inspiring epic tales of love, life, and adventure.

At SAGA, it is not the destination that matters, but the journey we take to get there. And we dress women for the journey.

Let the adventure begin.



[\(http://www.sagaouterwear.com/\)](http://www.sagaouterwear.com/)

Premium Outerwear Since 2005.

Contact

Since our 2005 introduction, we have aspired to create premium products using only quality materials and innovative design. With the highest level of respect for the professionals and customers that depend on our brand, all of our gear maintains a focus on function and performance. Our outerwear and apparel is custom-built to satisfy the most demanding and active teams in snow. Having roots in Montana, Oregon, and Utah, we are inspired by the Mountain-West lifestyle. From the field to the office, our advantage is being the end users of the products we develop. As our brand evolves, we strive to offer the collections that run as deep as the community that has become Saga.

Saga Outerwear Shipping Address

2904 S West Temple
Salt Lake City, UT 84115
USA

Email

- General Contact & Sales Inquiries: contact@sagaouterwear.com (<mailto:contact@sagaouterwear.com>)
- Current & Existing Orders: orderissues@sagaouterwear.com (<mailto:orderissues@sagaouterwear.com>)
- Returns & Exchanges: returns@sagaouterwear.com (<mailto:returns@sagaouterwear.com>)

For dealer inquiries, please contact distribution@sagaouterwear.com (<mailto:distribution@sagaouterwear.com>) with the name and description of your store and a list of other brands you carry.

We place a higher priority on email. We pride our Brand on answering emails and resolving any and all issues as soon as they arise. All emails are generally answered within 2 business days.

Online Chat

Quick and easy questions/concerns are best answered through our online chat. Online chat hours are 11am to 1pm & 4pm to 6pm MST Monday-Friday.

In-Store Help

For Salt Lake City/Surrounding Utah Area customers, please feel free to come down to our warehouse store ([Saga Suppliers West \(http://www.sagaouterwear.com/locations/saga-store/\)](http://www.sagaouterwear.com/locations/saga-store/)) for any questions or concerns. We are more than happy to help you in person. Don't be shy!

Social Media

(<http://www.facebook.com/sagaouterwear>) (<http://www.twitter.com/sagaouterwear>) (<http://www.instagram.com/sagaouterwear>) (<http://www.youtube.com/sagaouterwear>)

[October 2011 \(/2011/10/\)](#)
[September 2011 \(/2011/09/\)](#)
[August 2011 \(/2011/08/\)](#)
[July 2011 \(/2011/07/\)](#)
[June 2011 \(/2011/06/\)](#)
[May 2011 \(/2011/05/\)](#)
[April 2011 \(/2011/04/\)](#)
[March 2011 \(/2011/03/\)](#)
[February 2011 \(/2011/02/\)](#)
[January 2011 \(/2011/01/\)](#)
[December 2010 \(/2010/12/\)](#)
[November 2010 \(/2010/11/\)](#)
[October 2010 \(/2010/10/\)](#)
[September 2010 \(/2010/09/\)](#)
[August 2010 \(/2010/08/\)](#)
[July 2010 \(/2010/07/\)](#)
[June 2010 \(/2010/06/\)](#)
[May 2010 \(/2010/05/\)](#)
[April 2010 \(/2010/04/\)](#)
[March 2010 \(/2010/03/\)](#)
[February 2010 \(/2010/02/\)](#)
[January 2010 \(/2010/01/\)](#)
[December 2009 \(/2009/12/\)](#)
[November 2009 \(/2009/11/\)](#)
[October 2009 \(/2009/10/\)](#)
[September 2009 \(/2009/09/\)](#)
[August 2009 \(/2009/08/\)](#)
[July 2009 \(/2009/07/\)](#)
[June 2009 \(/2009/06/\)](#)
[May 2009 \(/2009/05/\)](#)

Help

[My Account \(http://shop.sagaouterwear.com/account/login\)](http://shop.sagaouterwear.com/account/login)

[Contact \(/about/contact/\)](#)

[Shipping \(/about/shipping/\)](#)

[Returns & Exchanges \(/about/returns-and-exchanges/\)](#)

[Warranty \(/about/warranty/\)](#)

[Pre-Order \(/about/pre-order/\)](#)

[FAQ \(/about/faq/\)](#)

Saga Fast Food Club

Enter your Email to Join

GO

Saga Outerwear

Like 22,102 people like this. Be the first of your friends.

Follow @SagaOuterwear 3,402 followers

+29 Recommend this on Google

[Saga Outerwear on Tumblr](#)

© 2005 - 2012 Saga Outerwear, LLC. All Rights Reserved.