

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85400196
LAW OFFICE ASSIGNED	LAW OFFICE 103
MARK SECTION (no change)	
ADDITIONAL STATEMENTS SECTION	
DISCLAIMER	No claim is made to the exclusive right to use SHEER apart from the mark as shown.
MISCELLANEOUS STATEMENT	
MISCELLANEOUS FILE NAME(S)	
ORIGINAL PDF FILE	mis-7420612230-201503220_.CALVIN_KLEIN_SHEER_BEAUTY_RFR.pdf
CONVERTED PDF FILE(S) (3 pages)	\\TICRS\EXPORT16\IMAGEOUT16\854\001\85400196\xml1\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\854\001\85400196\xml1\RFR0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\854\001\85400196\xml1\RFR0004.JPG
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Paul W. Garrity/
SIGNATORY'S NAME	Paul W. Garrity
SIGNATORY'S POSITION	Attorney of Record; New York State bar member
SIGNATORY'S PHONE NUMBER	212-653-8700
DATE SIGNED	10/03/2012
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO

FILING INFORMATION SECTION

SUBMIT DATE	Wed Oct 03 20:25:01 EDT 2012
TEAS STAMP	USPTO/RFR-74.206.122.30-2 0121003202501717952-85400 196-4907a95b94c3a82a6c283 4746ae83103252-N/A-N/A-20 121003201503220605

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. **85400196** has been amended as follows:

ADDITIONAL STATEMENTS

Disclaimer

No claim is made to the exclusive right to use SHEER apart from the mark as shown.

Miscellaneous Statement

Original PDF file:

[mis-7420612230-201503220 . CALVIN KLEIN SHEER BEAUTY RFR.pdf](#)

Converted PDF file(s) (3 pages)

[Miscellaneous File1](#)

[Miscellaneous File2](#)

[Miscellaneous File3](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Paul W. Garrity/ Date: 10/03/2012

Signatory's Name: Paul W. Garrity

Signatory's Position: Attorney of Record; New York State bar member

Signatory's Phone Number: 212-653-8700

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: 85400196

Internet Transmission Date: Wed Oct 03 20:25:01 EDT 2012

TEAS Stamp: USPTO/RFR-74.206.122.30-2012100320250171

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)	Examining Attorney:
)	
Calvin Klein Trademark Trust)	Gene V.J. Maciol, II
)	
Serial No.: 85/400,196)	Trademark Law Office: 103
)	
Filed: August 17, 2011)	
)	
For: CALVIN KLEIN SHEER)	
BEAUTY)	

REQUEST FOR RECONSIDERATION

Hon. Asst. Comm. For Trademarks
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

This Request for Reconsideration concerns the Final Office Action mailed on April 12, 2012 (the "Final Office Action").

The Examining Attorney has issued a final refusal to register Applicant's mark CALVIN KLEIN SHEER BEAUTY in International Class 3 on the grounds that Applicant has failed to provide a proper disclaimer statement for the mark.

Applicant herein requests reconsideration of the Examining Attorney's of final refusal.

I. ARGUMENT

In its Response to the Examiner's Amendment/Priority Action, Applicant stated that "No claim is made to the exclusive right to use SHEER apart from the mark as shown." In the Final Office Action, the Examining Attorney required that "Applicant must insert a disclaimer of 'Sheer Beauty' in the application because it is merely descriptive when used in conjunction with the goods." Applicant respectfully submits that requiring a disclaimer of the joint term "Sheer Beauty" is not supported by either the Examining Attorney's proffered evidence, or by registered third party marks incorporating both the terms "Sheer" and "Beauty."

First, Applicant notes that in past registrations and applications for SHEER BEAUTY BODY COLLECTION (US Reg. No. 2126352) and SHEER BEAUTY COLLECTION (Serial No. 75042498) (with a Notice of Publication issued) in Class 3, there was no requirement to

disclaim the joint term “Sheer Beauty” to achieve registration. For the Examining Attorney to now require a disclaimer for the term “Sheer Beauty” is contrary to past precedent as applied to other parties with Class 3 applications.

Second, the Examining Attorney has not identified any evidence, in either the Final Office Action or the Examiner’s Amendment/Priority Action, of third party marks with the term “Sheer Beauty” disclaimed. All the third party marks cited in such evidence have *either* the term “Beauty” *or* the term “Sheer” disclaimed. None of the cited marks disclaim the term “Sheer Beauty.” Indeed, Applicant’s own search of SHEER BEAUTY marks has identified only a *single* live registration incorporating the joint term. It is respectfully submitted that this single registration – which is not even in Class 3 – evidences that the joint term SHEER BEAUTY is not a common term, let alone a term which immediately conveys information as to the qualities, features or characteristics of Applicant’s goods with a “degree of particularity.” *See Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1204-05 (TTAB 1981).

Ultimately, “Sheer Beauty” is not a commonly understood descriptive term such that a disclaimer for that joint term is necessary. The evidence proffered by the Examining Attorney arguably shows that the terms “Sheer” and “Beauty” are employed in the cosmetics industry. However, the Examining Attorney’s evidence does not adequately demonstrate that the joint term “Sheer Beauty” is 1) prevalent, or 2) even a real term. Indeed, upon review, none of the Examining Attorney’s cited third party registrations or website screenshots employ the term “Sheer Beauty”; rather, they all only use *either* “Beauty” *or* “Sheer” in connection with cosmetics or beauty products. Therefore, Applicant should not be required to disclaim “Sheer Beauty” for the applied-for mark.

II. DISCLAIMER STATEMENT

No claim is made to the exclusive right to use “Sheer” apart from the mark as shown.

III. CONCLUSION

Applicant respectfully submits that the objection to Applicant’s CALVIN KLEIN SHEER BEAUTY mark should be withdrawn.

DATED: October 3, 2012

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By /Paul W. Garrity/

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