

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85431897
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION	
MARK	GATSBY SALON
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
<p>OFFICE ACTION RESPONSE GATSBY SALON Applicant, the Gatsby, Inc., makes the following response to this Office Action issued in connection with Serial No. 85431897 for the Gatsby Salon Mark. I. BACKGROUND The Gatsby, Inc. (?Gatsby Salon?) operates a luxury beauty salon located in Green Brook, New Jersey https://gatsbysalon.com/. A copy of the home pages of the referenced website is attached as Exhibit 1. Gatsby Salon was established in 1976 by Daniel Gianfrancesco. When he passed away in 1998, his wife Gayle Giacomo took over the business and has been continuously running the business. The Gatsby Salon provides a full array of salon services, offering hair design services, hair cutting and styling, sophisticated hair coloring services, manicures and pedicures, and waxing, among other services. In addition, as many such full service salons, the Gatsby Salon offers makeup application services for weddings and other special events. The Gatsby Salon was the subject of a television show on the Style Network entitled ?Jerseylicious?. Although the Gatsby Salon had been using its trademark for many years, Gatsby Salon filed a federal trademark registration for ?Gatsby Salon?, Serial No. 85431897 (?Salon Application?) on September 26, 2011. The Salon Application was filed in Class 44 with the following service description: Hair salon services; hair cutting services; nail care services; pedicure services; body waxing services; makeup application services; consultation services in the field of makeup application; eyebrow threading services.? On September 11, 2012, the Examining Attorney issued a Suspension Notice with regard to the Salon Application, in light of a prior application for ?GG Gatsby?, Application Serial No. 85424959. (?GG Gatsby Application?) The GG Gatsby Application was later abandoned on October 15, 2015. On April 6, 2016, after the abandonment of the GG Gatsby Application, the Examining Attorney issued a Final Action removing the Salon Application from suspension. However, the Examining Attorney affirmed the denial of registration of the ?Salon Registration? under Section 2(d), claiming a likelihood of confusion between the Salon Application and two previously registered marks. Those two previously registered marks are: ? Trademark Registration No. 2340526. This registration is owned by Mandom Corporation in Class 3 for certain hair and skin products (?Mandom Registration?); and ? Trademark Registration No. 3735513. This registration is owned by Komodidad Distributors, Inc. in Class 35 for the trademark ?Gatsby? (?Gatsby Registration?). The website is based in Puerto Rico and Komodidad distributes products in Puerto Rico and Venezuela. Gatsby is an online website for retail services for clothing under the following services description: Retail services in the nature of merchandise distribution centers accessible to registered customers featuring articles of clothing, shoes, handbags, fashion and leather accessories, costume jewelry and cosmetics; retail store services featuring articles of clothing, shoes, handbags, fashion and leather accessories, costume jewelry and cosmetics. That website is located at http://www.shopgatsby.com/. A copy of the home pages of the referenced website is attached as Exhibit 2. II. CONSENT DECREE WITH MANDOM CORPORATION The Examiner first rejected the Salon Application in light of the Mandom Registration. (Registration No. 2340526) Gatsby Salon has disputed that there is a likelihood of confusion between the Gatsby Salon Application and the Mandom Registration in light of the differences in the classes of goods and services (Class 3 vs. Class 44), the difference in the marketplace for those services (one location salon vs. website) and the appearance of the marks. However, in the interest of avoiding concerns of a conflict between the competing marks, Gatsby Salon and Mandom have entered into a consent agreement which is attached as Exhibit 3. In that Consent Agreement, Mandom agrees that the Salon Application and the Mandom Registration are not likely to be confused. Mandom then consents to the registration of the Salon Application, subject to certain limitations on use by Gatsby Salon, upon an amendment to the description of goods and services as described in the Consent Agreement. An executed coexistence agreement between an applicant and the owner of a cited registration filed in response to a refusal to register under Section 2(d) is persuasive evidence of no likelihood of confusion. See, e.g., In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563, (C.C.P.A. 1973); In re Donnay International, Societe Anonyme, 31 U.S.P.Q.2d 1953, 1994 WL 515456 (T.T.A.B. 1994). Clorox Co. v. Sterling Winthrop, Inc., 117 F.3d 50, 43 U.S.P.Q.2d 1161, 1997 WL 349899 (2nd Cir. 1997). (Coexistence agreements are valid and favored under the law.); In re Loew's Theatres, Inc., 197 U.S.P.Q. 183, 186, 1977 WL 22634</p>	

(T.T.A.B. 1977) (A consent to registration and each party's agreement to remain clear of each other's marketing and trade channels are "weighty evidence" that there is no likelihood of confusion, mistake or deception of purchasers.) In light of the filing of the Consent Agreement, Gatsby Salon asks the Examining Attorney to reverse the likelihood of confusion finding with regard to the Mandom Registration.

III. COMPARISON OF THE GATSBY REGISTRATION AND THE SALON APPLICATION SHOWS THERE IS NO LIKELIHOOD OF CONFUSION.

The Examiner also rejected the Salon Application under Section 2 (d) based upon a likelihood of confusion between the Gatsby Registration and the Salon Application. As the Examiner correctly notes, the standard for determining likelihood of confusion between two trademarks is detailed in Dupont, 476 F.2d at 1361. There is no mechanical test for determining likelihood of confusion, and "each case must be decided on its own facts." Id. In Dupont, the court listed a series of 13 criteria for examining attorneys to consider when determining whether two similar marks may coexist on the Register. Id. The Court does not consider these factors in isolation; rather, it examines them "in the context of the marks as a whole as they are encountered by consumers in the marketplace." Beer Nuts, Inc. v. Clover Club Foods Co., 805 F.2d 920, 925, 231 U.S.P.Q. 913 (10th Cir. 1986); Sally Beauty Company, Inc. v. Beautyco, Inc., 304 F.3d 964, 972, 64 U.S.P.Q.2d 1321, 2002 WL 2005902 (10th Cir. 2002); King of the Mountain Sports, Inc. v. Chrysler Corp., 185 F.3d 1084, 1090, 51 U.S.P.Q.2d 1349, 1999 WL 527486 (10th Cir. 1999). In the Office Action, the Examining Attorney concluded that the two most relevant DuPont factors related to the current Salon Application are (a) the similarities of the Applied for Mark and the Registered Mark in their appearance, sound, connotation and commercial impression and; (b) The goods and/or services are related in some manner; For the reasons set forth below, the evidence and case law demonstrate that there is not a likelihood of confusion between the Salon Application and the Gatsby Registration and that the two can coexist on the Principal Register.

A. The Salon Application and the Gatsby Registration are distinguishable in appearance and commercial impression. The first basis cited by the Examining Attorney for refusal to register the Salon Application in light of the Gatsby Registration is that the two marks "Gatsby Salon" vs. "Gatsby" are sufficiently similar in appearance to create a similar commercial impression. The Examining Attorney concluded that the only difference between the Gatsby Salon mark and Gatsby Registration is the addition of the descriptive term "SALON". In looking at a likelihood of confusion between marks, the examiner is required to consider the differences in: (1) sight, (2) sound, and (3) meaning of each mark. Beer Nuts, 805 F.2d at 925; USA Network v. Gannett Co., 584 F. Supp. 195, 199, 223 U.S.P.Q. 678 (D. Colo. 1984). Each mark should be considered in its entirety as it is encountered in the marketplace. Beer Nuts, 805 F.2d at 925. It is correct that the Salon Application and the Registered Mark are similar in that they both include the word "Gatsby". However, both the courts and the TTAB have concluded that even though two trademarks have some visual similarities, there is not a likelihood of confusion between the marks. That is true even in cases where there are very subtle distinctions between marks. For instance, in the case of The Nautilus Group, Inc. vs. Savvier, Inc., 427 F. Supp.2d 990, 79 U.S. P.Q.2d 1850, 2006 WL 1016218 (W.D. Wash. 2006), Nautilus owned the trademark Bowflex for exercise equipment. Id. at 992. Savvier was the exclusive licensee of the mark Bodyflex. Id. Nautilus sued claiming there was a likelihood of confusion between the two marks. Id. at 994. The court noted that the greatest similarity between the two names was the spelling because both started with "bo" and ended with "flex." Id. at 996. Nevertheless, the court held there was not a likelihood of confusion even though there was only a two letter difference between the Bowflex Mark and the Bodyflex Mark, and even though both were used in the context of exercise equipment. Id. at 999. In this case, the Gatsby Registration and the Salon Application differ in that the "Gatsby Salon" mark is a multi- word mark, as opposed to a single word mark. Multi word marks should be viewed in their whole and not as mere components. See, California Cooler, Inc. vs. Loretto Winery, Ltd., 774 F.2d 1451, 1455, 227 U.S.P.Q. 808, (9th Cir. 1985). Likewise, based upon the analysis in the case of In re Conti, 220 U.S.P.Q. 745, 1983 WL 51893 (T.T.A.B. 1983) the marks are distinguishable. In Conti, the TTAB held that "Shear Perfection" for a beauty salon would not be confused with "Sheer Performance" for leg makeup even though the only difference between the two marks was one letter. Id. at *1. That one letter difference changed the commercial impression of the marks because "shear" suggested a hair salon, while sheer suggested light. Id. Finally, a review of the prosecution history of the trademark registration for "Globe Salon", U.S. Registration No. 2813439 ("Globe Salon Proceeding") is directly on point and shows that the Gatsby Registration and the Salon Application are distinguishable in sight, sound and meaning. A copy of a portion of the pleadings from the Globe Salon Proceeding are attached as Exhibit 4. In the Globe Salon proceeding, the applicant applied for a trademark for "Globe Salon" in Class 42. Another company had previously received a registration in Class 3 for "Globe" for men's toiletries. The Examining Attorney initially refused registration of the "Globe Salon" application, finding a likelihood of confusion between the Cited Mark for "Globe" in the sale of cosmetic goods in Class 3 and the applied for mark "Globe Salon" in Class 42. However, upon filing its response to the Office Action, the applicant was able to overcome the initial finding of likelihood of confusion in light of the fact that when comparing the "Globe" registration and the "Globe Salon" application there was a difference in sight, sound and meaning. The Applicant emphasized that Globe had a meaning of strength, while the word Salon had a meaning of a place to go to be taken care of. Therefore, the Applicant argued that the addition of the use Salon in addition to Globe was sufficient to overcome the concerns regarding the similarity of the marks. The exact same reasoning applies in this case. The word "Gatsby" suggests the male character from F. Scott Fitzgerald's novel, The Great Gatsby. However, by adding the word "Salon" to the word "Gatsby", the commercial impression completely changes since the emphasis is now on the location to go for relaxation services. For these same reasons, Gatsby Salon asks the examiner to find that there are sufficient differences between the Gatsby Registration and the Salon Application to avoid a likelihood of confusion.

B. A Comparison Of The Descriptions of Services Between the Salon Application And the Gatsby Registration In addition to its finding of a similarity between the Salon Application and the Gatsby Registration, the Examiner also concluded that there is a likelihood of confusion because the goods and services because they are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. Specifically, the examiner noted that personal care services (such as those identified by the Applicant) are frequently offered under the same mark, and in the same channels of trade as personal care products and retail stores such as those specified in the cited registrations. However, the Gatsby Registration is in Class 35 for a website for: Retail services in the nature of merchandise distribution centers accessible to registered customers featuring articles of clothing, shoes, handbags, fashion and leather accessories, costume jewelry and cosmetics; retail store services featuring articles of clothing, shoes, handbags, fashion and leather accessories, costume jewelry and cosmetics. Apparently, the examiner found the services to be related because of the reference to cosmetics in

the Gatsby Registration. However, a visit to the website for the Gatsby Registration shows that Gatsby is selling clothing, shoes and accessories on its website. See, <http://www.shopgatsby.com/>. The only similarity between the services offered under the two competing marks is that "Gatsby Salon" offers makeup application services, while the "Gatsby" website mark includes the word "cosmetics". However, as can be seen at the Gatsby website, although the registration includes cosmetics, there is no mention of cosmetics on the website. Ultimately, it is extremely unlikely that a consumer would be confused between a Gatsby branded website based in Puerto Rico and a New Jersey hair salon. As noted in the Globe Salon Proceeding by the Applicant, customers for hair salon services such as those offered by the Gatsby Salon are sophisticated consumers as they take great care in the selection and care of beauty services. The decision of choosing a hair salon is very local and very personal. In light of the importance of an individual's salon choice, consumers are simply not going to be confused between the Gatsby Salon and the Gatsby clothing website. For these reasons, Applicant respectfully requests that the Examining Attorney approve the Applied for Mark for "Gatsby Salon" publication in the Official Gazette.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_981444972-20161006224309524088_.Exhibit_1.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT17\IMAGEOUT17\854\318\85431897\xml1\RFR0002.JPG
ORIGINAL PDF FILE	evi_981444972-20161006224309524088_.Exhibit_2.pdf
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ORIGINAL PDF FILE	evi_981444972-20161006224309524088_.Exhibit_3.pdf
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ORIGINAL PDF FILE	evi_981444972-20161006224309524088_.Exhibit_4.pdf
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	\\TICRS\EXPORT17\IMAGEOUT17\854\318\85431897\xml1\RFR0032.JPG
DESCRIPTION OF EVIDENCE FILE	Exhibit 1: Website Screen Shot Exhibit 2: Website Screen Shot Exhibit 3: Consent Agreement Exhibit 4: Globe Salon Prosecution Pleadings
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	044
DESCRIPTION	
hair salon services; hair cutting services; nail care services; pedicure services; body waxing services; makeup application services; consultation services in the field of makeup application; eyebrow threading services	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 03/00/1977
FIRST USE IN COMMERCE DATE	At least as early as 03/00/1977
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	044
TRACKED TEXT DESCRIPTION	
hair salon services; hair cutting services; nail care services; pedicure services; body waxing services; makeup application services; consultation services in the field of makeup application; eyebrow threading services; the foregoing specifically excluding services provided from a location outside the State of New Jersey.	
FINAL DESCRIPTION	
hair salon services; hair cutting services; nail care services; pedicure services; body waxing services; makeup application services; consultation services in the field of makeup application; eyebrow threading services; the foregoing specifically excluding services provided from a location outside the State of New Jersey.	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 03/00/1977
FIRST USE IN COMMERCE DATE	At least as early as 03/00/1977
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Linda Emery/
SIGNATORY'S NAME	Linda C. Emery
SIGNATORY'S POSITION	Attorney of Record, Wisconsin bar member
SIGNATORY'S PHONE NUMBER	414-287-1274
DATE SIGNED	10/06/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	

SUBMIT DATE	Thu Oct 06 23:19:24 EDT 2016
TEAS STAMP	USPTO/RFR-XX.XXX.XX.XX-20 161006231924145527-854318 97-570dbb3bed3a90ea163f53 5eafd211819d39255ae3a75bb 4e7a485b567d1b32d-N/A-N/A -20161006224309524088

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OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **85431897** GATSBY SALON(Standard Characters, see) has been amended as follows:

ARGUMENT(S)

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

OFFICE ACTION RESPONSE GATSBY SALON Applicant, the Gatsby, Inc., makes the following response to this Office Action issued in connection with Serial No. 85431897 for the Gatsby Salon Mark. I. BACKGROUND The Gatsby, Inc. (?Gatsby Salon?) operates a luxury beauty salon located in Green Brook, New Jersey <https://gatsbysalon.com/>. A copy of the home pages of the referenced website is attached as Exhibit 1. Gatsby Salon was established in 1976 by Daniel Gianfrancesco. When he passed away in 1998, his wife Gayle Giacomo took over the business and has been continuously running the business. The Gatsby Salon provides a full array of salon services, offering hair design services, hair cutting and styling, sophisticated hair coloring services, manicures and pedicures, and waxing, among other services. In addition, as many such full service salons, the Gatsby Salon offers makeup application services for weddings and other special events. 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filing of the Consent Agreement, Gatsby Salon asks the Examining Attorney to reverse the likelihood of confusion finding with regard to the Mandom Registration. III. COMPARISON OF THE GATSBY REGISTRATION AND THE SALON APPLICATION SHOWS THERE IS NO LIKELIHOOD OF CONFUSION. The Examiner also rejected the Salon Application under Section 2 (d) based upon a likelihood of confusion between the Gatsby Registration and the Salon Application. As the Examiner correctly notes, the standard for determining likelihood of confusion between two trademarks is detailed in Dupont, 476 F.2d at 1361. There is no mechanical test for determining likelihood of confusion, and "each case must be decided on its own facts." Id. In Dupont, the court listed a series of 13 criteria for examining attorneys to consider when determining whether two similar marks may coexist on the Register. Id. 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For instance, in the case of The Nautilus Group, Inc. vs. Savvier, Inc., 427 F. Supp.2d 990, 79 U.S. P.Q.2d 1850, 2006 WL 1016218 (W.D. Wash. 2006), Nautilus owned the trademark Bowflex for exercise equipment. Id. at 992. Savvier was the exclusive licensee of the mark Bodyflex. Id. Nautilus sued claiming there was a likelihood of confusion between the two marks. Id. at 994. The court noted that the greatest similarity between the two names was the spelling because both started with "bo" and ended with "flex." Id. at 996. Nevertheless, the court held there was not a likelihood of confusion even though there was only a two letter difference between the Bowflex Mark and the Bodyflex Mark, and even though both were used in the context of exercise equipment. Id. at 999. In this case, the Gatsby Registration and the Salon Application differ in that the "Gatsby Salon" mark is a multi- word mark, as opposed to a single word mark. Multi word marks should be viewed in their whole and not as mere components. See, California Cooler, Inc. vs. Loretto Winery, Ltd., 774 F.2d 1451, 1455, 227 U.S.P.Q. 808, (9th Cir. 1985). Likewise, based upon the analysis in the case of In re Conti, 220 U.S.P.Q. 745, 1983 WL 51893 (T.T.A.B. 1983) the marks are distinguishable. In Conti, the TTAB held that "Shear Perfection" for a beauty salon would not be confused with "Sheer Performance" for leg makeup even though the only difference between the two marks was one letter. Id. at *1. That one letter difference changed the commercial impression of the marks because "shear" suggested a hair salon, while sheer suggested light. Id. Finally, a review of the prosecution history of the trademark registration for "Globe Salon", U.S. Registration No. 2813439 ("Globe Salon Proceeding") is directly on point and shows that the Gatsby Registration and the Salon Application are distinguishable in sight, sound and meaning. A copy of a portion of the pleadings from the Globe Salon Proceeding are attached as Exhibit 4. In the Globe Salon proceeding, the applicant applied for a trademark for "Globe Salon" in Class 42. Another company had previously received a registration in Class 3 for "Globe" for men's toiletries. The Examining Attorney initially refused registration of the "Globe Salon" application, finding a likelihood of confusion between the Cited Mark for "Globe" in the sale of cosmetic goods in Class 3 and the applied for mark "Globe Salon" in Class 42. However, upon filing its response to the Office Action, the applicant was able to overcome the initial finding of likelihood of confusion in light of the fact that when comparing the "Globe" registration and the "Globe Salon" application there was a difference in sight, sound and meaning. The Applicant emphasized that Globe had a meaning of strength, while the word Salon had a meaning of a place to go to be taken care of. Therefore, the Applicant argued that the addition of the use Salon in addition to Globe was sufficient to overcome the concerns regarding the similarity of the marks. The exact same reasoning applies in this case. The word "Gatsby" suggests the male character from F. Scott Fitzgerald's novel, The Great Gatsby. However, by adding the word "Salon" to the word "Gatsby", the commercial impression completely changes since the emphasis is now on the location to go for relaxation services. For these same reasons, Gatsby Salon asks the examiner to find that there are sufficient differences between the Gatsby Registration and the Salon Application to avoid a likelihood of confusion. B. A Comparison Of The Descriptions of Services Between the Salon Application And the Gatsby Registration In addition to its finding of a similarity between the Salon Application and the Gatsby Registration, the Examiner also concluded that there is a likelihood of confusion because the goods and services because they are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. Specifically, the examiner noted that personal care services (such as those identified by the Applicant) are frequently offered under the same mark, and in the same channels of trade as personal care products and retail stores such as those specified in the cited registrations. However, the Gatsby Registration is in Class 35 for a website for: Retail services in the nature of merchandise distribution centers accessible to registered customers featuring articles of clothing, shoes, handbags, fashion and leather accessories, costume jewelry and cosmetics; retail store services featuring articles of clothing, shoes, handbags, fashion and leather accessories, costume jewelry and cosmetics. Apparently, the examiner found the services to be related because of the reference to cosmetics in the Gatsby Registration. However, a visit to the website for the Gatsby Registration shows that Gatsby is selling clothing, shoes and accessories on its website. See, <http://www.shopgatsby.com/>. The only similarity between the services offered under the two competing marks is that "Gatsby Salon" offers makeup application services, while the "Gatsby" website mark includes the word "cosmetics". However, as can be seen at

the Gatsby website, although the registration includes cosmetics, there is no mention of cosmetics on the website. Ultimately, it is extremely unlikely that a consumer would be confused between a Gatsby branded website based in Puerto Rico and a New Jersey hair salon. As noted in the Globe Salon Proceeding by the Applicant, customers for hair salon services such as those offered by the Gatsby Salon are sophisticated consumers as they take great care in the selection and care of beauty services. The decision of choosing a hair salon is very local and very personal. In light of the importance of an individual's salon choice, consumers are simply not going to be confused between the Gatsby Salon and the Gatsby clothing website. For these reasons, Applicant respectfully requests that the Examining Attorney approve the Applied for Mark for "Gatsby Salon" publication in the Official Gazette.

EVIDENCE

Evidence in the nature of Exhibit 1: Website Screen Shot Exhibit 2: Website Screen Shot Exhibit 3: Consent Agreement Exhibit 4: Globe Salon Prosecution Pleadings has been attached.

Original PDF file:

[evi_981444972-20161006224309524088_ . Exhibit 1.pdf](#)

Converted PDF file(s) (1 page)

[Evidence-1](#)

Original PDF file:

[evi_981444972-20161006224309524088_ . Exhibit 2.pdf](#)

Converted PDF file(s) (1 page)

[Evidence-1](#)

Original PDF file:

[evi_981444972-20161006224309524088_ . Exhibit 3.pdf](#)

Converted PDF file(s) (4 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

Original PDF file:

[evi_981444972-20161006224309524088_ . Exhibit 4.pdf](#)

Converted PDF file(s) (25 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

[Evidence-9](#)

[Evidence-10](#)

[Evidence-11](#)

[Evidence-12](#)

[Evidence-13](#)

[Evidence-14](#)

[Evidence-15](#)

[Evidence-16](#)

[Evidence-17](#)

[Evidence-18](#)

[Evidence-19](#)

[Evidence-20](#)

[Evidence-21](#)

[Evidence-22](#)

[Evidence-23](#)

[Evidence-24](#)

[Evidence-25](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Current: Class 044 for hair salon services; hair cutting services; nail care services; pedicure services; body waxing services; makeup application services; consultation services in the field of makeup application; eyebrow threading services

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 03/00/1977 and first used in commerce at least as early as 03/00/1977 , and is now in use in such commerce.

Proposed:

Tracked Text Description: hair salon services; hair cutting services; nail care services; pedicure services; body waxing services; makeup application services; consultation services in the field of makeup application; eyebrow threading services; [the foregoing specifically excluding services provided from a location outside the State of New Jersey.](#)

Class 044 for hair salon services; hair cutting services; nail care services; pedicure services; body waxing services; makeup application services; consultation services in the field of makeup application; eyebrow threading services; the foregoing specifically excluding services provided from a location outside the State of New Jersey.

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 03/00/1977 and first used in commerce at least as early as 03/00/1977 , and is now in use in such commerce.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Linda Emery/ Date: 10/06/2016

Signatory's Name: Linda C. Emery

Signatory's Position: Attorney of Record, Wisconsin bar member

Signatory's Phone Number: 414-287-1274

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 owner's/holder'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 owner/holder in this matter: (1) the owner/holder 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 owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder'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: 85431897

Internet Transmission Date: Thu Oct 06 23:19:24 EDT 2016

TEAS Stamp: USPTO/RFR-XX.XXX.XX.XX-20161006231924145

527-85431897-570dbb3bed3a90ea163f535eafd

211819d39255ae3a75bb4e7a485b567d1b32d-N/

A-N/A-20161006224309524088

EXHIBIT 1

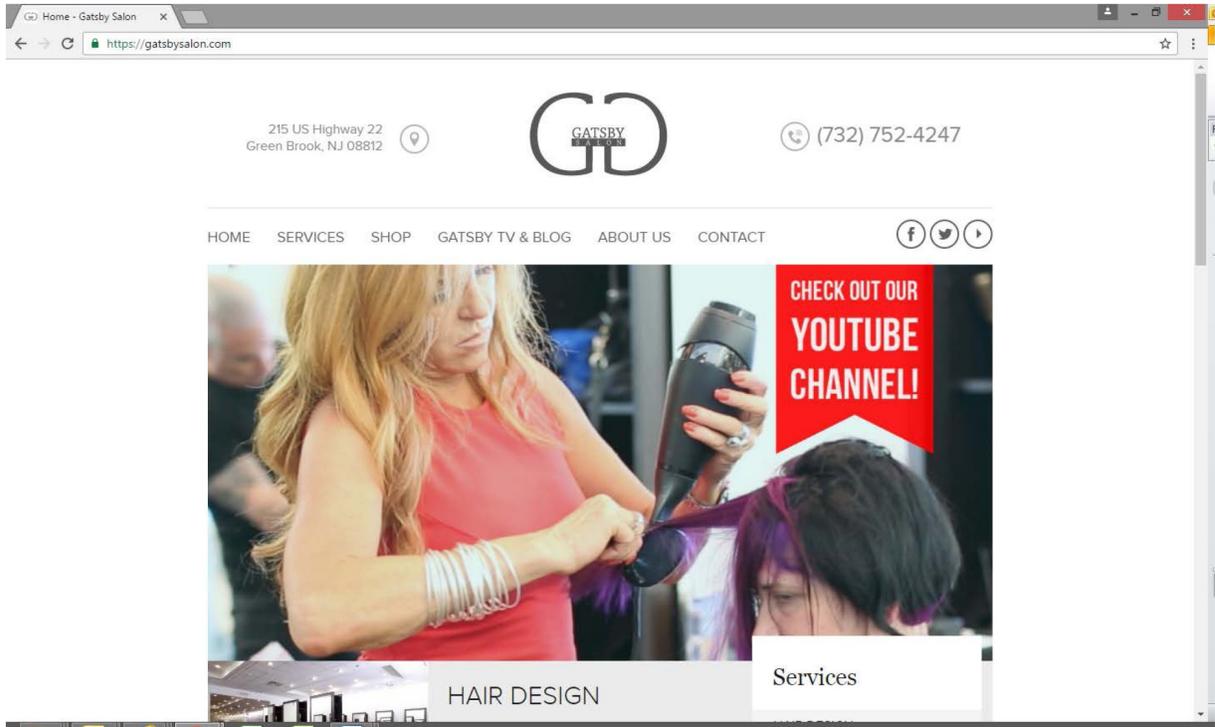


EXHIBIT 2

www.shopgatsby.com/ x

www.shopgatsby.com/contentviewrm.aspx?PagelD=7

GATSBY

free shipping EN TODAS LAS ÓRDENES CON LA COMPRA DE \$75 O MÁS.

Home | FAQ | Mi cuenta | Shopping bag | Regístrate

WHAT'S NEW
50% OFF
FALL IS IN THE AIR
STOP AND STARE
JEANS
TOPS
BOTTOMS
SHORTS
DRESSES & ROMPERS
ACCESSORIES
SHOES
SALE

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& UP
ESTILOS SELECCIONADOS



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click aqui ▶

gatsby **BLOG**

f e t p t

Vendedores Independientes Gatsby | Email updates | Sobre nosotros | Contáctanos | Site corporativo | Tiendas

CONSENT AGREEMENT

THIS CONSENT AGREEMENT ("Agreement") is entered into on this 15th day of March, 2016 (the "Effective Date") by and between **MANDOM CORPORATION**, a Japanese corporation located at 5-12, Juniken-cho, Chuo-ko Osaka, Japan ("Registrant"), and **THE GATSBY, INC.**, a New Jersey corporation located at 215 US Highway 22, Green Brook, New Jersey 08812, United States ("Applicant").

WHEREAS, Registrant is the owner of the trademark GATSBY, U.S. Trademark Registration No. 2,340,526, for the following goods in International Class 3: Perfumes, eau de cologne, personal deodorants, hair pomade, lip pomade, hair conditioner, hair setting foam and gel, face wash foam, skin lotion, skin milk, skin cream, lip stick and lip gloss, anti-perspirant, shampoo, and soap (the "Registered Mark");

WHEREAS, Applicant has filed U.S. Trademark Application Serial No. 85,431,897 (the "Application") for GATSBY SALON, for the following services in International Class 44: "hair salon services; hair cutting services; nail care services; pedicure services; body waxing services; makeup application services; consultation services in the field of makeup application; eyebrow threading services" ("Applicant's Mark");

WHEREAS, by Office Action dated January 20, 2012, the Trademark Office has issued a refusal to register Applicant's Mark on the grounds that there is a likelihood of confusion with the Registered Mark;

WHEREAS, Registrant and Applicant are parties to that certain Settlement and Coexistence Agreement dated September 23, 2015 (the "Coexistence Agreement"), whereby Applicant has voluntarily agreed to amend the Application to narrow the scope of the services covered by the Applicant's Mark and to limit Applicant's use of Applicant's Mark in commerce;

WHEREAS, the parties wish by this Agreement to avoid marketplace confusion resulting from the coexistence of their respective marks and to avoid any further dispute;

NOW, THEREFORE, in consideration of the mutual agreements hereinafter set forth, the parties hereto do hereby agree as follows:

1. Consent to Applicant's Use of Applicant's Mark. Registrant hereby consents to Applicant's use and registration of Applicant's Mark in connection with hair salon services, hair cutting services, nail care services, pedicure services, body waxing services, makeup application services, consultation services in the field of makeup application, and eyebrow threading services, provided the foregoing services are not provided from a location outside of the State of New Jersey. Registrant agrees that Applicant may continue to utilize the domain name: gatsbysalon.com, provided that the content of any website published at said domain name be limited to the provision of the aforementioned services in the State of New Jersey. For purposes of clarity, Applicant may use the "GATSBY SALON" name for trade shows, marketing events, promotional events, publication relations campaigns and on-line or television marketing outside the State of New Jersey, so long as any services using the name "GATSBY SALON" are only provided in the State of New Jersey.

2. Consent to Registrant's Use and Registrations of the Registered Mark. Applicant hereby consents to Registrant's use and registration of the Registered Mark in connection with the goods covered by the Registered Mark.

3. Restriction of Applicant's Mark. Applicant specifically agrees to limit its use of Applicant's Mark to the amended services listed in Paragraph 4 below and specifically agrees not to use Applicant's Mark in connection with services provided from a location outside of the State of New Jersey.

4. Amendment of Applicant's Services. Within ten (10) days following execution of this Agreement, Applicant shall file an amendment to the description of services for Applicant's Mark, which amended description shall read as follows: "hair salon services, hair cutting services, nail care services, pedicure services, body waxing services, makeup application services, consultation services in the field of makeup application, and eyebrow threading services; the foregoing specifically excluding services provided from a location outside of the State of New Jersey".

5. No Likelihood of Confusion; Avoidance of Confusion. The parties agree that, upon completion of Applicant's obligations under this Agreement, there is no likelihood of confusion between the source of the Registrant's goods and Applicant's services. In the event that either party becomes aware of any actual confusion or mistake occurring as a result of their use of their respective marks, the parties agree to communicate the factual background regarding such an issue, cooperate to take steps to correct the cause of confusion or mistake, and prevent any such future confusion or mistake.

6. Consent to Applicant's Application. Registrant agrees that it will not object to Applicant's pending application Serial No. 85,431,897, provided the amendment set forth in Paragraph 4 above is approved by the Trademark Office and Applicant is in compliance with its obligations under this Agreement.

7. Binding Effect. This Agreement shall inure to the benefit of and be binding upon the parties and their respective successors, assigns and licensees.

8. Coexistence Agreement. This Agreement may not be modified, waived or extended unless in writing, signed by the party sought to be bound. To the extent there are any inconsistencies between the Coexistence Agreement and this Agreement, the Coexistence Agreement shall control.

9. Authority. The parties each represent and warrant that (a) it has full power and authority to execute, deliver and perform this Agreement; and (b) the individual executing this Agreement on behalf of such party has been properly authorized and empowered to enter into this Agreement by and on behalf of such party.

10. Severability. The possible invalidity of individual provisions of this Agreement does not invalidate the Agreement as a whole. If any provision of this Agreement is found to be void, invalid or unenforceable, then the other provisions of this Agreement shall remain in full

force and effect and the parties shall replace the void, invalid or unenforceable provision with a valid and enforceable provision that has the effect nearest to that of the provision to be replaced.

11. Scope. This Agreement and the rights, duties, and obligations of the parties hereunder, shall apply throughout the United States.

12. Counterparts. This Agreement may be executed in two or more counterparts, each of which, when so executed and delivered, shall be deemed an original, and all counterparts, when taken together, will constitute one and the same Agreement. Signatures sent by facsimile or electronic communication will be deemed to be original signatures for all purposes.

IN WITNESS WHEREOF, the undersigned have executed this Consent Agreement as of the Effective Date.

REGISTRANT

APPLICANT

MANDOM CORPORATION

THE GATSBY, INC.

By:  _____

By: _____

Name: Tatsuyoshi Kitamura

Name: Gayle Giacomo

Its: Director and Managing Executive Officer

Its: President

25839398_1.DOCX

force and effect and the parties shall replace the void, invalid or unenforceable provision with a valid and enforceable provision that has the effect nearest to that of the provision to be replaced.

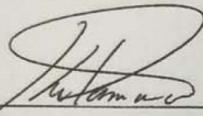
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REGISTRANT

MANDOM CORPORATION

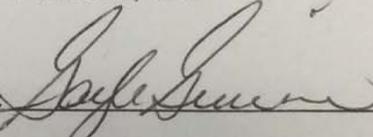
By:  _____

Name: Tatsuyoshi Kitamura

Its: Director and Managing Executive Officer

APPLICANT

THE GATSBY, INC.

By:  _____

Name: Gayle Giacomo

Its: President

25839398_1.DOCX

In the present instance, the proposed mark is **GLOBE SALON** for "beauty salon services." The marks in the first cited registration is **GLOBE** for "perfumes; bath soap, toilet soap; deodorant; after shave lotion; shave cream; skin care products; namely, moisturizer; and bath products; namely, shower gel and shampoo, all for men." The mark in the second cited registration is **GLOBAL SALON** with additional wording and a design, for "hairdressing salon services."

Comparing the marks, the applicant's mark is virtually identical to the mark in the first cited registration. Likewise, the applicant's mark is also quite similar in meaning and commercial impression to the mark in the second cited registration as well. As similarity in either sound appearance, meaning or commercial impression alone is sufficient to find a likelihood of confusion, the marks are confusingly similar. *In re Mack*, 197 USPQ 755 (TTAB 1977).

Turning to the respective description of goods and services, the examining attorney must still consider the commercial relationship between the goods or services of the respective parties carefully to determine whether there is a likelihood of confusion. *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983). The goods of the parties however, need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Additionally, it is well settled that confusion is likely to occur from the use of similar marks for goods on the one hand and for services involving those goods on the other hand. *Safety-Kleen Corp. v. Dresser Indus.*, 186 USPQ 476, 480 (CCPA 1975) (cleaning equipment components and cleaning apparatus leasing services); *In re H.J. Seiler Co.*, 129 USPQ 347 (CCPA 1961).

Here, the applicant's services involve the good offered in the first cited registration. In addition, "beauty aids" and "salon services" often emanate from the same source under the same mark. See *U.S. Registration No. 2427380*

Next, the services of both the applicant and those enumerated in the second cited registration are virtually identical. As such, the services are likely to be encountered, advertised and offered in the same trade channels. Thus, a consumer or patron is likely to believe that the services emanate from the same source. Likewise, the applicant could be perceived as the source of the registrant's services; the registrant could be perceived as the source of the applicant's services.

Further, where the goods or services of the respective parties are closely related or identical, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *ECI Division of E Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980).

In closing, the examining attorney must finally resolve any doubt regarding a likelihood of confusion in favor of the prior registrant and against the applicant. *In re Hyper Shoppes (Ohio)*,

Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). Accordingly, confusion is likely in both instances and the mark is refused registration under Section 2(d) of the Trademark Act.

RESPONSE:

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

INFORMALITIES:

The applicant must also respond to the following issue.

DISCLAIMER:

Trademark Act Section 6(a), 15 U.S.C. Section 1056(a), states that the Commissioner may require the applicant to disclaim an unregistrable component of a mark. Trademark Act Section 2(e), 15 U.S.C. Section 1052(e), bars the registration of a mark which is merely descriptive or deceptively misdescriptive, or primarily geographically descriptive or deceptively misdescriptive of the goods. Therefore, the Commissioner may require the disclaimer of a portion of a mark which, when used in connection with the goods or services, is merely descriptive or deceptively misdescriptive, or primarily geographically descriptive or deceptively misdescriptive. If an applicant does not comply with a disclaimer requirement, the examining attorney may refuse registration of the entire mark. TMEP section 1213.01(b).

Here, the word "SALON" is highly descriptive in relation to the applicant's "beauty salon services." Therefore, the applicant must insert a disclaimer of SALON in the application. Trademark Act Section 6, 15 U.S.C. Section 1056; TMEP sections 1213 and 1213.09(a)(i).

A properly worded disclaimer should read as follows:

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

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.



Brian Brown
Trademark Attorney
Law Office 105
(703) 308-9105 Ext. 178

*** User: bbrown1 *** Serial Number: 74073072 *** 4/27/01 3:04:26 PM ***

[Typed Drawing]

Mark

GLOBE

Goods and Services

IC 003. US 051 052. G & S: perfumes; bath soap, toilet soap; deodorant; after shave lotion; shave cream; skin care products; namely, moisturizer; and bath products; namely, shower gel and shampoo, all for men

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

74073072

Filing Date

June 27, 1990

Publication for Opposition Date

July 30, 1991

Registration Number

1661385

Registration Date

October 22, 1991

Owner Name and Address

(REGISTRANT) Parfums Rochas SOCIETE ANONYME FRANCE 33, rue Francois ler
Paris 75008 FRANCE

Section 44 Indicator

SECT44

Priority Date

May 18, 1990

Type of Mark

TRADEMARK

Register

PRINCIPAL

Affidavit Text

SECT 15. SECT 8 (6-YR).

Live Dead Indicator

LIVE

Attorney of Record

Lawrence E. Apolzon

*** Search: 5 *** Document Number: 646 ***

*** User: bbrown1 *** Serial Number: 75002735 *** 4/29/01 12:22:05 PM ***



Mark

GLOBAL YELLOW STRAWBERRY HAIR SALONS

Goods and Services

IC 042. US 100 101. G & S: hairdressing salon services. FIRST USE:
19930301. FIRST USE IN COMMERCE: 19930301

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code

260108 260120 260121 260502 261113 261120 261121

Serial Number

75002735

Filing Date

October 10, 1995

Publication for Opposition Date

February 25, 1997

Registration Number

2062671

Registration Date

May 20, 1997

Owner Name and Address

(REGISTRANT) Yellow Strawberry, Inc. CORPORATION FLORIDA 1007 East Las
Olas Blvd. Fort Lauderdale FLORIDA 33301

Assignment Recorded

ASSIGNMENT RECORDED

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HAIR SALONS" APART FROM
THE MARK AS SHOWN

Type of Mark

SERVICE MARK

Register

PRINCIPAL

*** Search: 4 *** Document Number: 1 ***

(cont)

*** User: bbrown1 *** Serial Number: 75002735 ***

Live Dead Indicator
LIVE

Attorney of Record
John H. Oltman

*** Search: 4 *** Document Number: 1 ***

THALASSOTHYS

Mark

THALASSOTHYS

Goods and Services

IC 003. US 001 004 006 050 051 052. G & S: Toilet soaps; bath and shower products, namely, bath and shower gel, bath soap, bath oil, bath pearls, hair shampoos, skin soap, bath foam; non-medicated bath salts; bath and shower preparations containing algae, namely, bath and shower gel, bath soap, bath oil, bath pearls, hair shampoos, skin soap, bath foam; perfume; eau de toilette; eau de parfum; lipstick; eye make-up; facial make-up; foundation make-up; make-up remover; body powder; face powder; nail polish; essential oils for personal use; aromatherapy essential oils for personal use as a tonic or for relaxing, slimming or relieving congestion; body oil; massage oil; body and face cream; hand cream; nighttime skin cream; massage cream for body and face; skin cleansing cream for body and face; mask for body; cream and cleanser for body and face; exfoliating preparations for body and face; exfoliating marine salts; slimming cream and gel; refreshing cream for heavy legs; cream and gel for busts; cosmetic algae wraps; cosmetic marine mud wraps; cosmetic mineral mud wraps; non-medicated body and face care preparations for soaking and cleansing, namely, algae extract, mineral and marine mud, marine salts, sea water, thermal water, and spring water preparations; non-medicated hair care preparations; hair lotions and dentrifices. FIRST USE: 19990215. FIRST USE IN COMMERCE: 19990301

IC 042. US 100 101. G & S: beauty care services, namely, beauty salons, manicuring, massage, skin care salons, cosmetic and color analysis, and physical fitness consultations. FIRST USE: 19990215. FIRST USE IN COMMERCE: 19990301

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75594387

Filing Date

November 24, 1998

Filed ITU

FILED AS ITU

Publication for Opposition Date

January 25, 2000

Registration Number

*** Search: 12 *** Document Number: 124 ***

(cont)

*** User: bbrown1 *** Serial Number: 75594387 ***
2427380

Registration Date
February 6, 2001

Owner Name and Address
(REGISTRANT) SOTHYS CORPORATION FRANCE 128, rue du Faubourg Saint-Honore
75008 PARIS FRANCE

Prior Registration(s)
0935468;1140159

Type of Mark
TRADEMARK. SERVICE MARK

Register
PRINCIPAL

Live Dead Indicator
LIVE

Attorney of Record
John S. Egbert

*** Search: 12 *** Document Number: 124 ***

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Cultural Development Company, Inc.
Serial No. : 76/191,685
Filed : 1/2/01
Mark : GLOBE SALON
Examining Attorney : Brian Brown
Law Office : 105

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, 2900 Crystal Drive, Arlington, VA 22202, on

7/6/01
(Date)
Claudia Ferrer

RESPONSE TO OFFICE ACTION

Assistant Commissioner for Trademarks
Box Responses – Law Office 105
ATTN: Brian Brown
2900 Crystal Drive
Box Responses-No Fee
Arlington, VA 22202

RESPONSE

Dear Mr. Brown:

This communication is responsive to the Office Action dated April 30, 2001.

Applicant respectfully submits its analysis regarding likelihood of confusion between Applicant's mark and Registration Nos. 1661385 and 2062671. Furthermore, Applicant requests that the record be amended to modify Applicant's Disclaimer.

I. Background

The GLOBE SALON is a high fashion salon catering to women, located in Las Vegas, Nevada. The salon provides a full line of services including hair styling, manicures

Mark : GLOBE SALON
Serial No. : 76/191685

and pedicures. The principals of Applicant, Cultural Development Company, have extensive experience in operating upscale women's salons, and through the Cultural Development Company have owned and operated this salon for approximately one year.

II. Likelihood of Confusion

The Examiner has rejected the mark as being likely to be confused with another registration. Likelihood of confusion requires that confusion be probable, not simply possible. See, *HMH Publishing Co. v. Brincat*, 183 USPQ 141, 144 (9th Cir. 1974); *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 136 USPQ 508, 518 (9th Cir.) cert. denied, 374 U.S. 830, 37 USPQ 913 (1963); *J.B. Williams Co. v. Le Conte Cosmetics, Inc.*, 186 USPQ 317, 319 (9th Cir. 1975). In the present case, there is no likelihood of confusion between the cited mark and Applicant's mark; confusion is not probable.

**A. Analysis of differences between Applicant's GLOBE SALON mark and
Registration 1,661,385 for GLOBE.**

There is no likelihood of confusion between Applicants mark and Registration 1,661,385 since the services offered by Applicant are different from the services offered by the Registrant; the characteristics of the prospective purchasers and the degree of care they exercise tend to eliminate confusion; the methods of marketing and channels of distribution are different, and the marks themselves carry different connotations.

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B. Differing Services and Products Offered

Applicant respectfully urges that the services offered by Applicant are quite different from the products offered in the cited registration. Where the services offered are closely related there is less protection than where the services are different. See, e.g., *In re August Storck KG*, 218 USPQ 823 (TTAB 1983), *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978), *Guardian Products Co. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

Applicant urges that the services are not the same because beauty salon services are not the same as products consisting of men's toiletries and perfumes. It is clear that the cited registration is not in the same class. The GLOBE SALON application is for International Class 42 while the GLOBE registration is for International Class 03. Applicant's GLOBE SALON provides hair styling, manicure and pedicure services primarily for women. Applicant is not currently seeking the GLOBE SALON mark as a registration for men's products; indeed there is no current application for use of the GLOBE SALON mark for any product at all. Further, Applicant believes that it is unlikely that the markets for men's perfume and salon services will cross-over.

The GLOBE mark by contrast is owned by Rochas, a French manufacturer of perfumes. Registrant's GLOBE mark is used exclusively for men's products, primarily men's perfume, and possibly men's toiletries. To the applicant's best knowledge, the Registrant has never engaged in any business other than manufacturing goods; has

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not applied for any marks in connection with beauty services and has not announced any plans to do so.

Since beauty salon services are different from men's perfume and toiletry products, there is no similarity between the services offered by Applicant's beauty salon and Registrant's men's products. See, e.g., *Lloyd's Food Products Inc. v. Eli's Inc.*, 25 USPQ 2d 2027 (Fed. Cir. 1993) (the court stated that a service mark is different from a mark for goods... and thus denied a petition to cancel LLOYD'S for food *products* where a prior registration was for LLOYD'S for restaurant *services*).

Even when products are related in nature, but directed at different sexes, the courts have found products are dissimilar and unlikely to cause consumer confusion. Thus, in *McGregor-Doniser, Inc. v. Drizzle, Inc.*, 599 F.2d 1126 (2d Cir. 1979), the court found there to be no likelihood of confusion between women's overcoats and raincoats bearing the DRIZZLE mark and men's golf jackets bearing the DRIZZLER mark.

The same principle applies in the instant case. The GLOBE mark is used for products designed and marketed exclusively to men, while GLOBE SALON markets its services primarily to women. In order to find a likelihood of confusion, the potential customer would need to be confused as to both what he was buying (a service versus a product) and to what sex the sale was targeted (female versus male). A purchase based on such confusion is highly unlikely, because the GLOBE SALON does not sale men's products and GLOBE does not sell beauty services. In addition as discussed below, the characteristics of the prospective purchasers and the degree of care they exercise would

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tend to minimize any such confusion.

Since the services offered by the Applicant differ significantly from the products offered by the Registrant, there is no likelihood of confusion.

C. Characteristics of the prospective purchasers and the degree of care they exercise tend to eliminate confusion.

Applicant respectfully submits that the characteristics of the prospective purchasers tend to eliminate the likelihood of confusion. The characteristics of the prospective purchaser is a factor to be considered in determining the likelihood of confusion. *See, In re E.I. DuPont de Nemours & Co.*, 476 f.2d 1357, 177 USPQ 563 (CCPA 1973); Confusion is less likely if the relevant buyer market is made of discriminating purchasers. *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126 (2d Cir 1979). Even where goods are not expensive, courts have sometimes elevated the reasonably prudent-buyer standard based on the nature of certain buyers. *First Nat'l Bank v. First Nat'l Bank, South Dakota*, 153 F.3d 885 (8th Cir. 1998).

Great care is taken by customers of beauty salons in the selection and use of beauty services. A woman's own self image and the image others have of her are so critical to consumers that women frequently develop an ongoing personal and professional relationship with the beauticians who style their hair. These women select a beauty salon on the basis of personal referrals, location and familiarity with the individual stylist. Only rarely do they change beauticians, and a customer may keep the same stylist for decades. Such decisions are very personal and cannot be classified as impulse moves.

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Such discriminating buyers of beauty services are extremely unlikely to select their beauticians on the basis of men's toiletries and perfumes. In fact, it is logical a discriminating woman who was aware of the GLOBE brand and its men's products would be dissuaded from entrusting her beauty care to a brand or establishment committed solely to men's products. As to any confusion that might arise as to a salon customer purchasing product for herself that she falsely believes originated with the salon, the lack of any GLOBE SALON products or GLOBE products for women would effectively prevent such a purchase.

Moreover, cologne and perfumes are expensive items of personal cache. Consumers of such products are not likely to erroneously associate the pen's perfume brand with a differently named salon.

Because of the care taken in the selection process, the likelihood of confusion is greatly reduced.

D. Methods of Marketing and Channels of Distribution

Applicant respectfully submits that the methods of marketing and channels of distribution employed by the applicant differ significantly from that utilized by the registrant of the GLOBE mark, thus tending to eliminate customer confusion. Methods of marketing and channels of distribution are factors to be considered in determining likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563. If the goods of one party are sold to one class of buyers in a different marketing context than the

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goods of another seller, the likelihood that a single group of buyers will be confused by similar trademarks is less than if both parties sold their goods through the same channel of distribution. McCarthy et al. *McCarthy On Trademarks And Unfair Competition* § 24:51 at 24-77 (2001).

Applicant believes registrant's primary use of the GLOBE mark is for the sale of men's perfume. Specifically, applicant has located in about 50 distributors of GLOBE men's perfume, but no distributors for any other GLOBE product. Perfume is generally distributed through specialty stores, department stores and drug stores. Research by applicant has disclosed that registrant uses these traditional marketing channels. Applicant is not aware of the distribution of GLOBE brand toiletries or perfumes through beauty salons and believes salons will not generally sell products distributed through mass retailers, due to the inability of the salons to support pricing structures in the face of retail outlet competition. Moreover, perfumes in particular are rarely sold in salons.

By contrast GLOBE SALON necessarily has its company salon as its only source of distribution. The personal nature of services offered by the Applicant dictates that such services cannot be distributed in the same fashion as Registrant's products, but even when related goods are distributed in differing marketing channels, the courts have found no likelihood of confusion. See, *Paul Sachs Originals Co. v. Sachs*, 325 F.2d 212 (9th Cir. 1963) (No likelihood of customer confusion when girls' dresses and women's dresses sold to different customers in different stores.); *Field Enterprises Educational Corp. v. Cove Industries, Inc.*, 297 F.Supp. 989 (E.D.N.Y. 1969) (Different channels of encyclopedia

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distribution: door to door sales versus department store sales.) In *Estee Lauder, Inc. v. Gap, Inc.*, 108 F.3d 1503 (2d Cir. 1997) the court distinguished marketing channels by the characteristics of the customers and the location of sales. Plaintiff sold its personal care products only through prestige retail stores while defendant sold to a younger group of buyers through its own "Gap Old Navy" stores. The court found that while customers could overlap, the difference in locations and target market were sufficient to prevent likelihood of confusion.

In the instant case, while the customer base could theoretically overlap, there is no commonality of location or target market. Registrant sells its personal care products designed exclusively for men through retail outlets unconnected to Applicant. Applicant, on the other hand, targets female customers and only delivers its services through its own salon. Because of the difference in target markets and distribution channels, the likelihood of customer confusion is reduced.

E. The GLOBE SALON and GLOBE Marks Signify Different Meanings

There are significant differences between meaning conveyed by the Applicant's use of the GLOBE SALON mark, and the cited registration of GLOBE. The mark GLOBE standing alone brings forth connotations of a planet or a rock body in space standing resolute to the challenges of time. This image of strength and virility is consistent with the image registrant sought for its men's only line of products.

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Applicant's mark in contrast is a multi-word mark. This is important because multi-word marks should be viewed as a whole, not as mere components. See, *California Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F. 2d 1451, 1455, 227 USPQ 808, 810 (9th Cir. 1985), *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F. 2d 1005, 1007, 212 USPQ 233,,234 (CCPA 1981). Thus, in a multi-word mark, the whole mark must be read in order to determine how consumers might emphasize certain terms.

Applicant's GLOBE SALON mark includes the word "salon", which is absent from the registered mark and is used to identify a comfortable place to relax and be pampered. The salon designation identifies the establishment to the public as a place to obtain hair styling services, manicures and pedicures, and catch up on the latest gossip. Salon particularly denotes an establishment with services catering to a fashionable clientele. *Random House Unabridged Dictionary* 1694 (2d ed. 1993). The Globe portion of the mark speaks of diversity, internationality and unity. The Globe portion of the mark is like a call to the women of the world to unite.

Consumers will be easily alerted to any use of the GLOBE and GLOBE SALON marks outside of their intended product lines. Using the masculine GLOBE mark would be inconsistent with a high-end beauty salon for women, as would using the feminine GLOBE SALON mark for men's products. Since the marks signify different meanings, there is no likelihood of confusion.

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F. Analysis of differences between Applicant's GLOBE SALON word mark and Registration 2062671 for GLOBAL YELLOW STRAWBERRY HAIR SALON mark for design plus word, letters, and /or numbers.

There is no likelihood of confusion between Applicant's mark and Registration 2,062,671 since the marks themselves are substantially different and; the characteristics of the prospective purchasers and the degree of care they exercise tend to eliminate confusion.

G. The GLOBE SALON mark and the GLOBAL YELLOW STRAWBERRY HAIR SALON design mark are not similar in appearance, sound, connotation or commercial impression.

There are significant differences between the appearance, sound, connotation and commercial impressions of the GLOBE SALON mark and the cited registration for GLOBAL YELLOW STRAWBERRY HAIR SALONS. Both applicant's mark as well as the cited marks are multi-word marks. This is important because multi-word marks should be viewed as a whole, not as mere components. *See, California Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F. 2d 1451, 1455, 227 USPQ 808, 810 (9th Cir. 1985), *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F. 2d 1005, 1007, 212 USPQ 233, 234 (CCPA 1981). Greater weight is given to the dominant feature in determining if there is likelihood of confusion. *In re National Data Corp.*, 224 USPQ 749 (Fed. Cir. 1985), *Tektronix, Inc. v. Daktronics, Inc.*, 534 F. 2d 915, 189 USPQ 693 (CCPA 1976), *In re J.M. Originals, Inc.*, 6 USPQ2nd 1393 (TTAB 1988).

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Thus, in a multi-word mark, the whole mark must be read in order to determine how consumers might emphasize certain terms.

Looking at the GLOBAL YELLOW STRAWBERRY HAIR SALON mark (the "YELLOW STRAWBERRY" mark), it is clear the dominant feature of the mark is the centrally located "YELLOW STRAWBERRY" portion. This portion is separated from the other portions of the mark by its central location and its distinctive "neon sign" font. To a customer this treatment identifies the YELLOW STRAWBERRY portion of the mark as the source of goods, the word SALON identifies the type of service provided, the word HAIR limits the type of services offered and GLOBAL is an adjective identifying the alleged geographical territory of the company. The identification of YELLOW STRAWBERRY as the source of the services is further buttressed by the name of the owner of the mark, Yellow Strawberry, Inc. See, registration record 2,062,671. Additionally, the YELLOW STRAWBERRY mark has a unique design with the words superimposed over a triangle within a Chevrolet emblem shape, creating an easily recognized mark.

In contrast, an examination of applicant's GLOBE SALON mark discloses the mark is entirely different in appearance sound, connotation and commercial impression from the YELLOW STRAWBERRY mark. The mark is simply a two-word name: GLOBE SALON. Unlike the cited YELLOW STRAWBERRY registered mark, there is no separation of the parts of the mark by font or by placement on the design. The source to the consumer is the entire GLOBE SALON name. The word GLOBE is used as part of a compound noun identifying the source as opposed to the use of the word GLOBAL as an adjective to

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identify an alleged geographical limit of service for the Registrant. The source in this case, GLOBE SALON is entirely different from the source portion appearing in the cited registered mark, which is "YELLOW STRAWBERRY".

Further, there is no limitation on salon services in the GLOBE SALON mark, which is consistent with its service philosophy of offering a full line of styling, manicure and pedicure services in contrast to the limitation of Yellow Strawberry Inc. offering only hair services. Both designations are entirely appropriate as they serve to distinguish, to the consumer, the different sources of services as well as products offered.

As to the salon portion of the mark, the GLOBE SALON mark uses the word "Salon" in its singular form whereas the YELLOW STRAWBERRY mark uses the word "Salons" in the plural form. This is in keeping with the impression Yellow Strawberry, Inc. is trying generate of having a worldwide presence, and is in contrast to the simple use of identifying the GLOBE SALON establishment by the Applicant. Moreover, Yellow Strawberry, Inc. makes no claim to exclusive use of "hair salons" apart from use in its mark and applicant makes no claim to exclusive use of the word "salon" apart from use in its mark.

Regarding word placement, in applicants mark, GLOBE is directly adjacent to SALON, while in the YELLOW STRAWBERRY mark there are three words, "YELLOW STRAWBERRY HAIR" between GLOBAL and SALONS. This separation and insertion of additional words creates an entirely different appearance, sound, and commercial impression. No one is likely to confuse the simple two word GLOBE SALON with the five word GLOBAL YELLOW STRAWBERRY HAIR SALONS mark. Even if a consumer were to

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shorten the lengthy registration, they would retain the dominant characteristics in the abbreviated name and possibly call the establishment the "Yellow Strawberry" eliminating any similarity to applicant's mark.

Finally, the cited registration is for a design plus words, letters and/or numbers. See, registration number 2062671. While the YELLOW STRAWBERRY registration has used a distinctive Chevrolet emblem inscribed with a triangle, three different fonts including a neon sign font, a script font and a block letter font, the applicant's registration seeks none of these design features and no use of similar features is anticipated. Applicant has not applied for a design mark, but the mere GLOBAL SALON word mark. Consumers can easily distinguish the marks based on overall appearance of the design.

The GLOBE SALON mark is not similar in appearance, sound, connotation or commercial impression to the YELLOW STRAWBERRY mark and no likelihood of confusion exists between the two marks.

III. Characteristics of the prospective purchasers and the degree of care they exercise tend to eliminate confusion.

Applicant respectfully submits that the characteristics of the prospective purchasers tend to eliminate the likelihood of confusion. The characteristics of the prospective purchaser is a factor to be considered in determining the likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563 (1973). Confusion is less likely if the relevant buyer market is made of discriminating purchasers. *McGregor-Doniger, Inc. v. Drizzle, Inc.*,

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599 F.2d 1126 (2d Cir 1979). Even where goods are not expensive, courts have sometimes elevated the reasonably prudent-buyer standard based on the nature of certain buyers. *First Nat'l Bank v. First Nat'l Bank, South Dakota*, 153 F.3d 885 (8th Cir. 1998).

As discussed above, great care is taken by customers of beauty salons in the selection and use of beauty services. The selection of a beauty salon is on the basis of personal referrals, location and familiarity with the individual stylist. Based on these considerations, it is extremely unlikely that a customer would be confused about even similar names and expect to find her hair stylist in another building. Such confusion, if it exists at all, is even further reduced or eliminated when the names on the buildings are dissimilar as noted above or located in different parts of the country as appears to be the instant case.

Due to the discriminating characteristics of the customers in the selection of their personal service stylists and the degree of care they exercise, consumer confusion is reduced or eliminated.

III. Conclusion

The consumer is unlikely to be confused by the GLOBE SALON mark when compared to either the GLOBE mark or the GLOBAL YELLOW STRAWBERRY HAIR SALON mark. The products or services of the GLOBE SALON mark differ significantly from the GLOBE mark and the characteristics of the prospective purchasers and the degree of care they exercise along with the different methods of marketing and channels of

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distribution tend to eliminate confusion. Similarly, the differences is the GLOBE SALON mark and the GLOBAL YELLOW STRAWBERRY HAIR SALON mark are so different in terms of appearance, sound, connotation and commercial impression that there is no likelihood of confusion between the marks, and the characteristics of the prospective customers and the degree of care they exercise tend to eliminate confusion. For these reasons Applicant respectfully submits there is no likelihood of confusion between Applicant's mark and the cited registrations.

IV. Disclaimer

Applicant requests that the Application be amended to include the following disclaimer, in accordance with Examiner's recommendation:

PRINT | No claim is made to the exclusive right to use SALON apart from the mark as shown. | **PRINT**

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Based on the foregoing, Applicant respectfully requests that this Application is in condition for prompt publication and favorable action is requested.

Respectfully submitted,

QUIRK & TRATOS

Dated: July 19, 2001

By: 

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Via First Class Mail: GLOBESAL 00-02.TM

Kindly acknowledge receipt of the following documents by affixing the Patent and Trademark Office stamp hereon and returning:

Response to Office Action, for Cultural Development Company, Inc., a Nevada Corporation, for the mark GLOBE SALON filed July 19, 2001, Serial No.: 76/191,685 in International Class 42.

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