

From: Teng, Simon

Sent: 6/5/2014 8:39:35 AM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85892299 - SOUTH BEACH SWIMWEAR - N/A - Request for Reconsideration Denied - Return to TTAB - Message 1 of 17

\*\*\*\*\*

Attachment Information:

Count: 7

Files: tank.jpg, dsfxvxcv-01.jpg, dsfxvxcv-02.jpg, dsfxvxcv-03.jpg, dsfxvxcv-04.jpg, dsfxvxcv-05.jpg, 85892299.doc

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

**U.S. APPLICATION SERIAL NO.** 85892299

**MARK:** SOUTH BEACH SWIMWEAR



**CORRESPONDENT ADDRESS:**

STEVEN E EISENBERG

LIPSCOMB EISENBERG & BAKER PL

2 S BISCAYNE BLVD STE 3800

MIAMI, FL 33131-1809

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**APPLICANT:** Michael D. Mathes

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

SEisenberg@LEBFIRM.COM

**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 6/5/2014

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated November 19, 2013 are maintained and continue to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

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

Applicant argues that there are other "South Beach" locations in the United States, as such, it is not necessary that both marks conjure up the imagery of Miami Beach, Florida. This argument is unpersuasive. Registrant is located in Miami and is a Florida corporation. Applicant is also located in Miami and is a Florida corporation. Viewed in this context, it is unclear how a consumer would think of any other South Beach except for the South Beach located in Miami, Florida.

Next, applicant argues that because **SOUTH BEACH** is a geographic region this wording "should not be exclusive to anyone". Applicant has not provided a legal basis for this argument. The legal citations relate to a 2(e)(2) refusal. Here, the *sole* issue is a 2(d) refusal.

The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar* goods and/or services. See *Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982).

Here, applicant's reference to Reg. No. **4079318** is unpersuasive. **CLEVEANDER SOUTH BEACH** features the distinct element **CLEVEANDER**. As such, it does not show weakness of the term **SOUTH BEACH**. Applicant also provides examples of **LAGUNA BEACH**. These examples are also unpersuasive. The mark at issue is **SOUTH BEACH** and not **LAGUNA BEACH**.

Applicant argues that the burden is on the Examiner to show that the trade channels overlap. Applicant is incorrect. Put in another way, applicant argues that the Office must show that registrant's goods are sold in "private sector stores". Not so. Here, both parties IDs are unrestricted as to trade channels.

Finally, applicant has amended it's ID to the following:

- Class 25: Swimsuits; Swimwear excluding T-shirts, polo shirts, tank tops, hats, visors, aprons

The amended ID does not obviate this refusal.

The evidence of record still shows the goods of the respective parties are closely related. Further, in fact applicant does sell tank tops. *See attachments from applicant's website at <[http://www.southbeachswimwear.com/images/tank\\_rb.jpg](http://www.southbeachswimwear.com/images/tank_rb.jpg)>.*

In further support of this refusal, please note the following:

A. Companies selling both swimsuits and tank tops

1. <http://shop.nordstrom.com/> - Nordstrom
2. <http://www.kohls.com/> - Kohl's
3. <http://www.target.com/> - Target
4. <http://www.jcpenny.com/> - JCPenny

5. <http://www1.macys.com/> - Macy's

B. Companies selling both swimsuits and hats

1. <http://www.landsend.com/> - Land's End

2. <http://www.modcloth.com/> - ModCloth

3. <http://www.dillards.com/> - Dillard's

4. <http://www.speedousa.com/> - Speedo

5. <http://www.reyswimwear.com/> - Rey Swimwear

*See attached internet evidence.*

This evidence further supports that applicant's swimsuits/swimwear is closely related to registrant's tank tops and hats. Put in another way, the evidence of record shows numerous commercial entities selling *both* swimsuits/swimwear and tank tops or hats.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/Simon Teng/

Simon Teng

Trademark Examining Attorney

Law Office 105

(571) 272-4930

[simon.teng@uspto.gov](mailto:simon.teng@uspto.gov)



*Tank Dress/Suit*



# NORDSTROM

Want a **Personal Stylist**? It's fast, fun, free...and zero pressure. [Get started.](#)

**FREE SHIPPING. FREE RETURNS.**  
All the time. [See details.](#)

[Women](#) [Men](#) [Shoes](#) [Handbags](#) [Accessories](#) [Beauty](#) [Designers](#) [Juniors](#) [Kids](#) [Specialty](#) [Sale](#)

[Home](#) / [Women](#) / [Clothing](#) / [Swimsuits & Cover-Ups](#)  
[Father's Day Gifts](#) **POP-IN**

## Women's Swimsuits & Cover-Ups

### Swimsuits & Cover-Ups

- New Arrivals
- Swim Fit Guide
- Patriotic Swimwear & Accessories
- Mix & Match
- Little Black Swimsuits

#### Swimsuit Item

- One-Piece
- Two-Piece
- Cover-Ups
- Beach Accessories

#### Fit

- Create Curves
- D/DD+
- Enhance Bust
- Juniors
- Long Torso
- Minimize Bust
- Minimize Hips & Bottom
- Trim Tummy

#### Trends

- Sexy Swimsuits
- Graphic Print
- Sport Swim
- Crochet & Lace
- Deep into Blue

#### Featured Brands

- La Blanca
- Maaji
- Miraclesuit
- Robin Piccone
- Tommy Bahama

### the beach-ready life

Flattering swimsuits designed to address a specific goal.  
[SHOP: OUR SWIM GUIDE](#)



NARROW BY:

- Swimwear Item
- Size
- Color
- Price
- Brand
- Store Availability

SORT BY: **Featured**

1,451 ITEMS

PAGE 1 | 2 | 3 | 4 ... 15



Becca Crochet Rashguard  
\$64.00



Freya "Hello Sailor" Underwire Sweetheart Padded Bikini Top (DD-Cup & Up)  
Was: \$66.00  
**Now: \$44.22** 33% OFF  
★★★★☆ (28)



BCA Heather Stripe Tankini Top  
Was: \$36.00  
**Now: \$24.12** 33% OFF  
★★★★☆ (2)



Roxy "Sunset Stripes" Surfer Bikini Bottoms  
Was: \$40.00  
**Now: \$26.80** 33% OFF

**Tips & Tools**  
Swimsuit Fit Guide

**Special Sizes**  
Plus-Size Swimwear  
Maternity Swimwear

**More Ways to Shop**  
Sale  
Active, Yoga & Outdoor  
Sunglasses & Eyewear

**Popular Searches**

"cute bathing suits"  
"cute one piece bathing suits"



Profile by Gottex 'Starlet' Bandeau Swimsuit  
Was: \$128.00  
Now: \$85.76 33% OFF



Tommy Bahama 'Sailboat' Underwire Bikini Top  
Was: \$97.00  
Now: \$64.97 33% OFF



Elan Tie Waist Palazzo Pants  
Was: \$54.00  
Now: \$36.18 33% OFF  
★★★★☆ (1)



**NEW!**  
La Blanca 'Glamour' Tankini Top  
\$89.00  
★★★★☆ (66)



**NEW!**  
La Blanca Crochet Trim Cover-Up  
\$99.00  
★★★★☆ (34)



**NEW!**  
Freya 'Tootsie' Underwire Bikini Top (DD Cup & Up)  
\$64.00  
★★★★☆ (7)



**NEW!**  
Next 'Malibu' Zip One-Piece Swimsuit  
\$91.00  
★★★★☆ (14)



**NEW!**  
La Blanca 'Island Goddess' Shirred Halter Bikini Top  
\$57.00  
★★★★☆ (7)

La Blanca 'Island Goddess' Side Shirred Hipster Bikini

Tommy Bahama 'Pearl' One-Piece Swimsuit

Becca 'Color Code' Side Tie Bikini Bottoms

Becca 'Mayan' Halter Bikini Top

**NEW!**  
La Blanca 'Island Goddess' Side Shirred Hipster Bikini

**NEW!**  
Tommy Bahama 'Pearl' One-Piece Swimsuit

Becca 'Color Code' Side Tie Bikini Bottoms  
\$38.00

Becca 'Mayan' Halter Bikini Top  
\$68.00  
★★★★☆ (1)

side Shirred Hipster Bikini Bottoms  
\$49.00  
★★★★☆ (5)

piece Swimsuit  
\$128.00  
★★★★☆ (24)

\$38.00  
★★★★☆ (5)

★★★★★ (1)









Profile by Gottex 'Cabaret' Bandeau Swimsuit  
\$138.00  
★★★★★ (1)

La Blanca 'Gypsetter Lingerie' Maillot  
\$89.00  
★★★★☆ (4)

The Bikini Lab 'Marrow' Bikini Bottoms  
\$30.00  
★★★★★ (1)

The Bikini Lab 'Twist' Bandeau Bikini Top  
\$30.00  
★★★★☆ (1)









FELICITY & COCO High/Low Hem Jersey Tank Dress (Nordstrom Exclusive)  
\$68.00  
★★★★☆ (3)

Echo Sheer Poncho  
\$48.00  
★★★★☆ (3)

Becca Crochet Triangle Bikini Top  
\$48.00  
★★★★★ (2)

Becca Side Tie Crochet Bikini Bottoms  
\$44.00  
★★★★★ (1)









Hard Tail Twisty Back Maxi Dress (Online Only)  
\$135.00  
★★★★★ (1)

Robin Piccone 'Bianca' Mitered Stripe One-Piece Swimsuit  
\$138.00  
★★★★★ (7)

  
Becca Crochet Triangle Bikini Top  
\$48.00  
★★★★★ (3)

  
Becca Side Tie Crochet Bikini Bottoms  
\$44.00  
★★★★★ (1)

 [Becca Crochet Cover-U](#)

 [Robin Piccone 'Penelop](#)

 [FELICITY & COCO Ruff](#)

 [Magic Suit by Miraclesu](#)

  
Becca Crochet Cover-Up Pants  
\$72.00  
★★★★☆ (3)

Robin Piccone 'Penelope' Crochet Pareo  
\$48.00  
★★★★☆ (9)

FELICITY & COCO Ruffled Strapless Maxi Dress (Regular & Petite) (Nordstrom Exclusive)  
\$78.00  
★★★★★ (4)

  
Magic Suit by Miraclesuit® Ruched Bikini Bottoms  
\$68.00  
★★★★☆ (5)

 [La Blanca Skirted Hipst](#)

 [Topshop Plunge Bikini T](#)

 [La Blanca 'Island' Shirr](#)

 [Elan Stripe Convertible](#)

La Blanca Skirted Hipster Bikini Bottoms  
\$69.00  
★★★★★ (11)

  
**NEW!**  
Topshop Plunge Bikini Top  
\$26.00  
★★★★★ (2)

  
**NEW!**  
La Blanca 'Island' Shirred Hipster Bikini Bottoms  
\$55.00

  
**NEW!**  
Elan Stripe Convertible Bias Cut Cover-Up Maxi Dress  
\$68.00  
★★★★☆ (26)

 [La Blanca 'Channel Isla](#)

 [Echo Sheer Poncho](#)

 [Miraclesuit&#174; Criss](#)

 [Next 'Malibu' Zip One-P](#)

**NLW!**  
La Blanca 'Channel Islands'  
Twist Tankini Top  
\$85.00

Echo Sheer Poncho  
\$48.00

Miraclesuit® Crisscross One-  
Piece Swimsuit  
\$170.00

Next 'Malibu' Zip One-Piece  
Swimsuit  
\$91.00

 L Space 'Estella - Rock

 L Space 'BFF - Rock the

 Elan Strappy Flutter Tie

 Tommy Bahama 'Malibu

L Space 'Estella - Rock the  
Boat' Metallic Stripe Bikini  
Bottoms  
\$77.00

L Space 'BFF - Rock the Boat'  
Metallic Stripe Halter Bikini Top  
\$86.00

Elan Strappy Flutter Tiered  
Dress  
\$48.00

Tommy Bahama 'Malibu  
Medallion' Side Shirred Hipster  
Bikini Bottoms  
\$63.00

 Trina Turk 'Sombbrero' C

 W Swimwear 'Fire & Ice

 DKNY 'Mesh Splice' Ma

 Tommy Bahama 'Wover

Trina Turk 'Sombbrero' Cover-  
Up Maxi Dress  
\$154.00

  
W Swimwear 'Fire & Ice' Ikat  
Halter One-Piece Swimsuit  
\$70.00

  
DKNY 'Mesh Splice' Maillot  
\$100.00

Tommy Bahama 'Woven  
Medallion' High/Low Cover-Up  
Boyfriend Shirt  
\$98.00

 Becca 'Mesh Tech' Fron

 W Swimwear 'Fire & Ice

 The Bikini Lab 'Marrow'

 Elan Scoop Neck Cover