

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85913125
LAW OFFICE ASSIGNED	LAW OFFICE 106
MARK SECTION (no change)	
ARGUMENT(S)	<p style="text-align: center;"><u>RESPONSE TO FINAL OFFICE ACTION</u></p> <p>This responds to the Final Office Action issued on August 27, 2014 wherein the Examining Attorney made final the refusal pursuant to Section 2(d) of the Trademark Act. Applicant notes with thanks the removal of the merely ornamental refusal.</p> <p>While Applicant still believes that there is no risk of confusion between the Applied-for Mark and the Cited Registrations and renews and reasserts all previous arguments, Applicant would like to resolve this remaining issue by providing a restriction to its goods description. Currently, the proposed identification of goods reads: “clothing, namely, caps, t-shirts.” Applicant offers to restrict the goods description as follows:</p> <p style="text-align: center;">Baseball related clothing, namely, caps, and t-shirts sold to promote the nostalgia of historic baseball teams that existed within Minor League Baseball.</p> <p>This proposed restriction indicates how and to whom the goods are sold. Applicant believes this restriction, coupled with its previous arguments in favor of co-existence, obviates the risk of confusion.</p> <p>As previously asserted, there is no per se rule of likelihood of confusion even as to identical marks in the same industry. <i>In re the Shoe Works, Inc.</i>, 6 U.S.P.Q.2d 1890, 1988 WL 252500 *2 (T.T.A.B. 1988). Instead, one must consider all relevant factors. Applicant respectfully reasserts that the Applied-for Mark has a different aural and visual impression than the Registered Marks, and therefore the Applied-for Mark imparts a different commercial impression.</p>

Once again, Applicant is not a newcomer, and there is no risk of adverse commercial impact upon the Registrant as evidenced by the long standing contemporaneous use between Applicant and the Cited Registrant. It is notable that for roughly forty-five (45) years, Applicant and Registrant have co-existed with each other in two different, but substantial, forms. The Cited Registrant alleges it has used BUFFS since 1934, which is during the time period wherein the Houston Buffs were an active Minor League Baseball Team. As such, the Houston Buffs, a Minor League Baseball club, co-existed with the Cited Registrant, a Division I University and athletic program, for twenty-seven (27) years. Moreover, the Houston Buffs have been a part of the Hometown Collection of Applicant for the past nineteen (19) years. In total, the respective team names and logos have co-existed with one another in the marketplace for over forty-five (45) years.

Applicant respectfully reasserts the arguments made in its responses dated December 10, 2013 and August 19, 2014 and offers the aforementioned restriction on its goods. Accordingly, Applicant asks that the Examining Attorney approve the Applied-for Mark for publication.

GOODS AND/OR SERVICES SECTION (current)

INTERNATIONAL CLASS	025
DESCRIPTION	Clothing, namely, caps, t-shirts
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 01/01/1995
FIRST USE IN COMMERCE DATE	At least as early as 01/01/1995

GOODS AND/OR SERVICES SECTION (proposed)

INTERNATIONAL CLASS	025
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TRACKED TEXT DESCRIPTION

~~Clothing, namely, caps, t-shirts~~; [Baseball related clothing, namely, caps, and t-shirts sold to promote the nostalgia of historic baseball teams that existed within Minor League Baseball](#)

FINAL DESCRIPTION

Baseball related clothing, namely, caps, and t-shirts sold to promote the nostalgia of historic baseball teams that existed within Minor League Baseball

FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 01/01/1995

FIRST USE IN COMMERCE DATE	At least as early as 01/01/1995
SIGNATURE SECTION	
RESPONSE SIGNATURE	/samantha m quimby/
SIGNATORY'S NAME	Samantha M. Quimby
SIGNATORY'S POSITION	Attorney of record, Ohio bar member
SIGNATORY'S PHONE NUMBER	614.559.7282
DATE SIGNED	02/27/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Feb 27 15:36:31 EST 2015
TEAS STAMP	USPTO/RFR-69.61.131.58-20 150227153631503914-859131 25-530d1d5e25a719ef91f86d f8c421b5de4a84740c21b956c 2a14e050ec9ce144-N/A-N/A- 20150227151559599427

**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **85913125** has been amended as follows:

ARGUMENT(S)

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

RESPONSE TO FINAL OFFICE ACTION

This responds to the Final Office Action issued on August 27, 2014 wherein the Examining Attorney made final the refusal pursuant to Section 2(d) of the Trademark Act. Applicant notes with thanks the removal of the merely ornamental refusal.

While Applicant still believes that there is no risk of confusion between the Applied-for Mark and the

Cited Registrations and renews and reasserts all previous arguments, Applicant would like to resolve this remaining issue by providing a restriction to its goods description. Currently, the proposed identification of goods reads: “clothing, namely, caps, t-shirts.” Applicant offers to restrict the goods description as follows:

Baseball related clothing, namely, caps, and t-shirts sold to promote the nostalgia of historic baseball teams that existed within Minor League Baseball.

This proposed restriction indicates how and to whom the goods are sold. Applicant believes this restriction, coupled with its previous arguments in favor of co-existence, obviates the risk of confusion.

As previously asserted, there is no per se rule of likelihood of confusion even as to identical marks in the same industry. *In re the Shoe Works, Inc.*, 6 U.S.P.Q.2d 1890, 1988 WL 252500 *2 (T.T.A.B. 1988). Instead, one must consider all relevant factors. Applicant respectfully reasserts that the Applied-for Mark has a different aural and visual impression than the Registered Marks, and therefore the Applied-for Mark imparts a different commercial impression.

Once again, Applicant is not a newcomer, and there is no risk of adverse commercial impact upon the Registrant as evidenced by the long standing contemporaneous use between Applicant and the Cited Registrant. It is notable that for roughly forty-five (45) years, Applicant and Registrant have co-existed with each other in two different, but substantial, forms. The Cited Registrant alleges it has used BUFFS since 1934, which is during the time period wherein the Houston Buffs were an active Minor League Baseball Team. As such, the Houston Buffs, a Minor League Baseball club, co-existed with the Cited Registrant, a Division I University and athletic program, for twenty-seven (27) years. Moreover, the Houston Buffs have been a part of the Hometown Collection of Applicant for the past nineteen (19) years. In total, the respective team names and logos have co-existed with one another in the marketplace for over forty-five (45) years.

Applicant respectfully reasserts the arguments made in its responses dated December 10, 2013 and August 19, 2014 and offers the aforementioned restriction on its goods. Accordingly, Applicant asks that the Examining Attorney approve the Applied-for Mark for publication.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Current: Class 025 for Clothing, namely, caps, t-shirts

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 01/01/1995 and first used in commerce at least as early as 01/01/1995 , and is now in use in such commerce.

Proposed:

Tracked Text Description: ~~Clothing, namely, caps, t-shirts;~~ [Baseball related clothing, namely, caps, and t-shirts sold to promote the nostalgia of historic baseball teams that existed within Minor League Baseball](#)

Class 025 for Baseball related clothing, namely, caps, and t-shirts sold to promote the nostalgia of historic baseball teams that existed within Minor League Baseball

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 01/01/1995 and first used in commerce at least as early as 01/01/1995 , and is now in use in such commerce.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /samantha m quimby/ Date: 02/27/2015

Signatory's Name: Samantha M. Quimby

Signatory's Position: Attorney of record, Ohio bar member

Signatory's Phone Number: 614.559.7282

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 filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85913125

Internet Transmission Date: Fri Feb 27 15:36:31 EST 2015

TEAS Stamp: USPTO/RFR-69.61.131.58-20150227153631503

914-85913125-530d1d5e25a719ef91f86df8c42

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