

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86141892
LAW OFFICE ASSIGNED	LAW OFFICE 113
MARK SECTION (no change)	
ARGUMENT(S)	
<p style="text-align: center;">IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD</p> <p>Mark: KASPER Applicant: Jones Investment Co., assigned to Jones Apparel (US) LLC Serial No.: 86141892 Filing Date: December 12, 2013 Examining Attorney: Marynell Wilson Law Office: 113</p> <p>To: Commissioner for Trademarks P.O. Box 1451 Alexandria, VA 22313-1451</p> <p style="text-align: center;">BRIEF ON APPEAL</p> <p>Applicant respectfully submits this Brief on Appeal in support of its appeal of the decision from the examining attorney's final refusal to pass Applicant's mark on to publication.</p> <p>Applicant requests that that Board over turn the Examining Attorney's final refusal which concluded that the mark KASPER is primarily merely a surname and that Applicant claims of acquired distinctiveness fail since Applicant's registrations are for clothing, not jewelry.</p> <p>Applicant respectfully submits that the Examining Attorney did not accord the proper weight to the notoriety of the KASPER mark in the apparel world and the relevance of the relatedness of the goods. Because the KASPER mark is so well known, in the fashion context the mark is not primarily merely a surname, and the mark should be passed to publication.</p> <p>1. <u>The Jewelry Goods at Issue are Related to Applicant's Clothing Registrations</u></p> <p>The name and mark KASPER is extremely well known in the fashion world. KASPER is "the world's</p>	

largest women's suit manufacturer, [and] designs, markets, sources, manufactures, and distributes women's career and special occasion suits, sportswear, and dresses." International Directory of Company Histories, Vol. 40, St. James Press, 2001.

In today's fashion market, it is well settled that clothing designers license their names for a wide variety of goods. In re Vetements Weill, 2005 WL 3175160 (T.T.A.B. Nov. 18, 2005) (citing Nina Ricci, S.A.R.L. v. E.T.F. Enterprises, Inc., 889 Fed. 1070 (1989).), Applicant's predecessor in interest did just that: "The company also grants licenses for the manufacture and distribution of certain other products under the Anne Klein, Kasper, and Nipon names, including women's watches, jewelry, footwear, coats, eyewear, and swimwear, and men's apparel." International Directory of Company Histories, Vol. 40, St. James Press, 2001 Applicant's registrations for its ANNE KLEIN and JNY brands also illustrate that point: Reg. No. 3948083 for JNY for jewelry and Reg. No. 1684843 for JNY for clothing; Reg. No. 311522 for AK ANNE KLEIN for clothing and Reg. No. 311520 for AK ANNE KLEIN for jewelry.

In addition, the TTAB has stated on a number of occasions that jewelry and clothing are related goods. See In Re Disney Enterprises, Inc., 2009 WL 4085598 (T.T.A.B. Aug. 12, 2009)(affirming refusal to register TIANA for numerous clothing items based on Likelihood of confusion with TIAN a for jewelry based in part on the position that jewelry is related to women's clothing); In re U.S. Vision, Inc., 2009 WL 1067299 (T.T.A.B. Marc. 31, 2009)("Consumers would expect that sunglasses and clothing or jewelry identified by virtually identical or similar marks emanate from the same source."); In re Kevin Baghard, 2009 WL 1017279 (T.T.A.B. Marc 26, 2009)(affirming refusal to register WILD2WATCH for jewelry and clothing based on likelihood of confusion with WILDWATCHING for clothing based, in part, on their party registrations showing the relatedness of various goods, including clothing and jewelry); In Re Aktieselskabet af 21.november 2001, 2008 WL 1741882 (Mar. 31, 2008)(there is a significant relationship between the registrant's clothing items and applicant's International Class 14 and 18 goods).

Courts are like-minded. See Brown v. Quiniou, 744 F. Supp. 463 (S.D.N.Y. 1990). "it is settled that women's apparel is commercially related to cosmetics, toiletries and the like, which are deemed complimentary products to clothing. . . . The Court discerns no principled reason to exclude jewelry from the family of women's apparel, cosmetics and other beauty aids. Jewelry undoubtedly is of equivalent importance of those products in rating a desired appearance. The items are typically advertised in the same media and frequently are available in the same stores. To overlook jewelry's place among these products would be disingenuous."

Therefore, it should be clear, based on the law and the particular brand at issue, that the goods in the prior registrations are related such that distinctiveness of the famous KASPER Brand will transfer to the goods in the instant application.

2, The Fame of the Kasper Mark Renders it More than a Surname

As demonstrated above, the KASPER name and mark is famous in the apparel industry and among consumers. See, e.g., International Directory of Company Histories, Vol. 40, St. James Press, 2001 (Kasper, is "the world's largest women's suit manufacturer, [and] designs, markets, sources, manufactures, and distributes women's career and special occasion suits, sportswear, and dresses."). See also Edgaronline, Kasper A.S.L. Ltd. Annual Report (Kasper "is one of the leading women's branded apparel companies in the United States."); Ask.com ("Kasper is well-known in the fashion industry . . ."); Ezine Articles, Addison, Jane, "Kasper Suits are Elegant and Classy for the Woman in the Business World."

Where a mark has acquired secondary meaning, it is not considered to be primarily merely a surname. 2 McCarthy on Trademarks, Section 13:28. As amply demonstrated herein, the KASPER name and mark is well known in the apparel industry and thus has acquired secondary meaning.

For all of the forgoing reasons, the KASPER mark for jewelry should be passed to publication.

CONCLUSION

In view of the foregoing, Applicant respectfully requests that the Board reverse the decision of the Examining Attorney and Pass Applicant' KAPSER mark on to publication.

Dated: December 8, 2014

Respectfully submitted,

Jones Apparel (US) LLC

By: /nancy m. dodderidge/ _____

Nancy Dodderidge

Assistant General Counsel

SIGNATURE SECTION

RESPONSE SIGNATURE	/nancy m. dodderidge/
SIGNATORY'S NAME	Nancy M. Dodderidge
SIGNATORY'S POSITION	Assistant General Counsel
SIGNATORY'S PHONE NUMBER	914 640-6422
DATE SIGNED	12/08/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO

FILING INFORMATION SECTION

SUBMIT DATE	Mon Dec 08 15:30:29 EST 2014
TEAS STAMP	USPTO/RFR-12.149.8.201-20 141208153029927457-861418 92-50033843bc091986451b58 9da507182c8f66944ba271de4 c39febd62efe7254e63-N/A-N /A-20141208152708006784

To the Commissioner for Trademarks:

Application serial no. **86141892** has been amended as follows:

ARGUMENT(S)

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

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Mark: KASPER

Applicant: Jones Investment Co., assigned to Jones Apparel (US) LLC

Serial No.: 86141892

Filing Date: December 12, 2013

Examining Attorney: Marynell Wilson

Law Office: 113

To: Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

BRIEF ON APPEAL

Applicant respectfully submits this Brief on Appeal in support of its appeal of the decision from the examining attorney's final refusal to pass Applicant's mark on to publication.

Applicant requests that that Board over turn the Examining Attorney's final refusal which concluded that the mark KASPER is primarily merely a surname and that Applicant claims of acquired distinctiveness fail since Applicant's registrations are for clothing, not jewelry.

Applicant respectfully submits that the Examining Attorney did not accord the proper weight to the notoriety of the KASPER mark in the apparel world and the relevance of the relatedness of the goods. Because the KASPER mark is so well known, in the fashion context the mark is not primarily merely a surname, and the mark should be passed to publication.

1. The Jewelry Goods at Issue are Related to Applicant's Clothing Registrations

The name and mark KASPER is extremely well known in the fashion world. KASPER is "the world's largest women's suit manufacturer, [and] designs, markets, sources, manufactures, and distributes women's career and special occasion suits, sportswear, and dresses." International Directory of Company Histories, Vol. 40, St. James Press, 2001.

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Dated: December 8, 2014

Respectfully submitted,

Jones Apparel (US) LLC

By: /nancy m. dodderidge/ _____

Nancy Dodderidge

Assistant General Counsel

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /nancy m. dodderidge/ Date: 12/08/2014

Signatory's Name: Nancy M. Dodderidge

Signatory's Position: Assistant General Counsel

Signatory's Phone Number: 914 640-6422

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

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

Serial Number: 86141892

Internet Transmission Date: Mon Dec 08 15:30:29 EST 2014

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