

## Request for Reconsideration after Final Action

**The table below presents the data as entered.**

Input Field	Entered
<b>SERIAL NUMBER</b>	86282147
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 108
<b>MARK SECTION</b>	
<b>MARK</b>	<a href="http://tmng-al.uspto.gov/resting2/api/img/86282147/large">http://tmng-al.uspto.gov/resting2/api/img/86282147/large</a>
<b>LITERAL ELEMENT</b>	GIII
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>MARK STATEMENT</b>	The mark consists of standard characters, without claim to any particular font style, size or color.
<b>ARGUMENT(S)</b>	
See enclosed 86282147 Response to Office Action	
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_3812249122-20160502195000360610_.86282147_Response_to_Office_Action.pdf</a>
<b>CONVERTED PDF FILE(S) (6 pages)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\862\821\86282147\xml12\RFR0002.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\862\821\86282147\xml12\RFR0003.JPG</a>
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<b>ORIGINAL PDF FILE</b>	<a href="#">evi_3812249122-20160502195000360610_.Exhibit_A_.simmsfishing.com_shop_waders.html.pdf</a>
<b>CONVERTED PDF FILE(S) (2 pages)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\862\821\86282147\xml12\RFR0008.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\862\821\86282147\xml12\RFR0009.JPG</a>
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_3812249122-20160502195000360610_.Exhibit_B_Merriam-Webster_definition_of_insoles.pdf</a>
<b>CONVERTED PDF FILE(S) (1 page)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\862\821\86282147\xml12\RFR0010.JPG</a>
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_3812249122-20160502195000360610_.Exhibit_C_Merriam-Webster_definition_of_footwear.pdf</a>
<b>CONVERTED PDF FILE(S) (1 page)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\862\821\86282147\xml12\RFR0011.JPG</a>
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_3812249122-20160502195000360610_.Exhibit_D_Consent_to_Register.pdf</a>
<b>CONVERTED PDF FILE(S)</b>	

(2 pages)	<a href="\\TICRS\EXPORT16\IMAGEOUT16\862\821\86282147\xml12\RFR0012.JPG">\\TICRS\EXPORT16\IMAGEOUT16\862\821\86282147\xml12\RFR0012.JPG</a>
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DESCRIPTION OF EVIDENCE FILE	Response to office Action + Exhibits Exhibit A: a true and correct printout of content available at <a href="https://www.simmsfishing.com/shop/waders.html">https://www.simmsfishing.com/shop/waders.html</a> Exhibit B: Merriam-Webster, definition of "insoles." Exhibit C : Merriam-Webster definition of "footwear." Exhibit D: Consent to Register
<b>GOODS AND/OR SERVICES SECTION (018)(current)</b>	
INTERNATIONAL CLASS	018
DESCRIPTION	leather goods
FILING BASIS	Section 1(b)
<b>GOODS AND/OR SERVICES SECTION (018)(proposed)</b>	
INTERNATIONAL CLASS	018
<b>TRACKED TEXT DESCRIPTION</b>	
<del>leather goods</del> ; <a href="#">Leather goods, namely, agenda cases, all purpose sport bags, backpacks, briefcase-like portfolios, briefcases, briefcase-type portfolios, Credit card cases and holders, handbags, leather key chains, luggage tags, luggage, Makeup cases sold empty, messenger bags, purses, travel kits comprising travel cases, toiletry cases sold empty, tote bags, travel cosmetic cases sold empty, valises, wallets, all made of leather</a>	
<b>FINAL DESCRIPTION</b>	
Leather goods, namely, agenda cases, all purpose sport bags, backpacks, briefcase-like portfolios, briefcases, briefcase-type portfolios, Credit card cases and holders, handbags, leather key chains, luggage tags, luggage, Makeup cases sold empty, messenger bags, purses, travel kits comprising travel cases, toiletry cases sold empty, tote bags, travel cosmetic cases sold empty, valises, wallets, all made of leather;	
FILING BASIS	Section 1(b)
<b>GOODS AND/OR SERVICES SECTION (025)(current)</b>	
INTERNATIONAL CLASS	025
DESCRIPTION	clothing, headgear, footwear and accessories
FILING BASIS	Section 1(b)
<b>GOODS AND/OR SERVICES SECTION (025)(proposed)</b>	
INTERNATIONAL CLASS	025
<b>TRACKED TEXT DESCRIPTION</b>	
<del>clothing, headgear, footwear and accessories</del> ; <a href="#">Clothing, namely, tops, anoraks, Bermuda shorts, blazers, blouses, boleros, bottoms, capes, cardigans, coats, dresses, jackets, jeans, jogging outfits and suits, leather coats, leather jackets, outerwear, pants, parkas, ponchos, pullovers, quilted vests, raincoats, shawls, shirts, shorts, shrugs, skirts, slacks, sport coats, sport shirts, sportswear, suits, sweaters, sweatshirts, tank tops, topcoats, trousers, track jackets, t-shirts, turtlenecks, two-piece jacket and dress combinations, vests; headgear, namely, hats and caps; footwear, namely, shoes, boots, casual and dress shoes, sandals, slippers</a>	
<b>FINAL DESCRIPTION</b>	
Clothing, namely, tops, anoraks, Bermuda shorts, blazers, blouses, boleros, bottoms, capes, cardigans, coats, dresses, jackets, jeans, jogging outfits and suits, leather coats, leather jackets, outerwear, pants, parkas, ponchos, pullovers, quilted vests, raincoats, shawls, shirts, shorts, shrugs, skirts, slacks, sport coats, sport shirts, sportswear, suits, sweaters, sweatshirts, tank tops, topcoats, trousers, track jackets, t-shirts, turtlenecks, two-piece jacket and dress combinations, vests; headgear, namely, hats and caps; footwear, namely, shoes, boots, casual and dress shoes, sandals, slippers;	
FILING BASIS	Section 1(b)
<b>GOODS AND/OR SERVICES SECTION (035)(current)</b>	
INTERNATIONAL CLASS	035
DESCRIPTION	

wholesale services; retail store operations; design, manufacture and marketing in the fields of clothing, headgear, footwear, accessories and leather goods; administration of licensing

FILING BASIS Section 1(b)

**GOODS AND/OR SERVICES SECTION (035)(proposed)**

INTERNATIONAL CLASS 035

**TRACKED TEXT DESCRIPTION**

~~wholesale services; retail store operations; design, manufacture and marketing in the fields of clothing, headgear, footwear, accessories and leather goods; administration of licensing~~; [Wholesale distributorships featuring clothing, headgear, footwear, accessories and leather goods](#); [retail store services featuring clothing, headgear, footwear, clothing, accessories and leather goods](#); ~~design, manufacture and marketing in the fields of clothing, headgear, footwear, accessories and leather goods~~; [Commercial administration of the licensing of the goods and services of others](#); ~~administration of licensing~~

**FINAL DESCRIPTION**

Wholesale distributorships featuring clothing, headgear, footwear, accessories and leather goods; retail store services featuring clothing, headgear, footwear, clothing, accessories and leather goods; Commercial administration of the licensing of the goods and services of others;

FILING BASIS Section 1(b)

**GOODS AND/OR SERVICES SECTION (040)(current)**

INTERNATIONAL CLASS 040

DESCRIPTION manufacturing services

FILING BASIS Section 1(b)

**GOODS AND/OR SERVICES SECTION (040)(proposed)**

INTERNATIONAL CLASS 040

**TRACKED TEXT DESCRIPTION**

~~manufacturing services~~; [Manufacturing services for others in the field of clothing, headgear, footwear, clothing, accessories, and leather goods](#)

**FINAL DESCRIPTION**

Manufacturing services for others in the field of clothing, headgear, footwear, clothing, accessories, and leather goods;

FILING BASIS Section 1(b)

**GOODS AND/OR SERVICES SECTION (042)(current)**

INTERNATIONAL CLASS 042

**DESCRIPTION**

monitoring of the manufacture of clothing, headgear, footwear, accessories and leather goods

FILING BASIS Section 1(b)

**GOODS AND/OR SERVICES SECTION (042)(proposed)**

INTERNATIONAL CLASS 042

**TRACKED TEXT DESCRIPTION**

~~monitoring of the manufacture of clothing, headgear, footwear, accessories and leather goods~~; [Design for others in the fields of clothing, headgear, footwear, clothing accessories and leather goods](#); [monitoring and inspection of manufactured goods in the nature of clothing, headgear, footwear, clothing accessories and leather goods for quality control purposes](#)

**FINAL DESCRIPTION**

Design for others in the fields of clothing, headgear, footwear, clothing accessories and leather goods; monitoring and inspection of manufactured goods in the nature of clothing, headgear, footwear, clothing accessories and leather goods for quality control purposes;

FILING BASIS Section 1(b)

**SIGNATURE SECTION**

RESPONSE SIGNATURE	/Christopher Weimer/
SIGNATORY'S NAME	Christopher Weimer
SIGNATORY'S POSITION	Attorney of record, Texas bar member
SIGNATORY'S PHONE NUMBER	1 512 536 4553
DATE SIGNED	05/02/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Mon May 02 20:11:48 EDT 2016
TEAS STAMP	USPTO/RFR-XX.XXX.XX.XXX-2 0160502201148398643-86282 147-5501cac6b66b606d5df2f 02da399104bde7dba616b15ef ac2b72bf5fe68e91c7-N/A-N/ A-20160502195000360610

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PTO Form 1960 (Rev 10/2011)

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

### Request for Reconsideration after Final Action

#### To the Commissioner for Trademarks:

Application serial no. **86282147** GIII(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86282147/large>) has been amended as follows:

#### ARGUMENT(S)

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

See enclosed 86282147 Response to Office Action

#### EVIDENCE

Evidence in the nature of Response to office Action + Exhibits Exhibit A: a true and correct printout of content available at <https://www.simmsfishing.com/shop/waders.html> Exhibit B: Merriam-Webster, definition of "insoles." Exhibit C : Merriam-Webster definition of "footwear." Exhibit D: Consent to Register has been attached.

#### Original PDF file:

[evi\\_3812249122-20160502195000360610\\_.86282147\\_Response\\_to\\_Office\\_Action.pdf](#)

#### Converted PDF file(s) ( 6 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

#### Original PDF file:

[evi\\_3812249122-20160502195000360610\\_.Exhibit\\_A\\_.simmsfishing.com\\_shop\\_waders.html.pdf](#)

#### Converted PDF file(s) ( 2 pages)

[Evidence-1](#)

[Evidence-2](#)

#### Original PDF file:

[evi\\_3812249122-20160502195000360610\\_.Exhibit\\_B\\_Merriam-Webster\\_definition\\_of\\_insoles.pdf](#)

Converted PDF file(s) ( 1 page)

[Evidence-1](#)

Original PDF file:

[evi\\_3812249122-20160502195000360610\\_ . Exhibit C Merriam-Webster definition of footwear.pdf](#)

Converted PDF file(s) ( 1 page)

[Evidence-1](#)

Original PDF file:

[evi\\_3812249122-20160502195000360610\\_ . Exhibit D Consent to Register.pdf](#)

Converted PDF file(s) ( 2 pages)

[Evidence-1](#)

[Evidence-2](#)

## CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

**Current:** Class 018 for leather goods

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Proposed:**

**Tracked Text Description:** ~~leather goods~~; [Leather goods, namely, agenda cases, all purpose sport bags, backpacks, briefcase-like portfolios, briefcases, briefcase-type portfolios, Credit card cases and holders, handbags, leather key chains, luggage tags, luggage, Makeup cases sold empty, messenger bags, purses, travel kits comprising travel cases, toiletry cases sold empty, tote bags, travel cosmetic cases sold empty, valises, wallets, all made of leather](#)

Class 018 for Leather goods, namely, agenda cases, all purpose sport bags, backpacks, briefcase-like portfolios, briefcases, briefcase-type portfolios, Credit card cases and holders, handbags, leather key chains, luggage tags, luggage, Makeup cases sold empty, messenger bags, purses, travel kits comprising travel cases, toiletry cases sold empty, tote bags, travel cosmetic cases sold empty, valises, wallets, all made of leather;

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

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

**Current:** Class 025 for clothing, headgear, footwear and accessories

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Proposed:**

**Tracked Text Description:** ~~clothing, headgear, footwear and accessories~~; [Clothing, namely, tops, anoraks, Bermuda shorts, blazers, blouses, boleros, bottoms, capes, cardigans, coats, dresses, jackets, jeans, jogging outfits and suits, leather coats, leather jackets, outerwear, pants, parkas,](#)

[ponchos, pullovers, quilted vests, raincoats, shawls, shirts, shorts, shrugs, skirts, slacks, sport coats, sport shirts, sportswear, suits, sweaters, sweatshirts, tank tops, topcoats, trousers, track jackets, t-shirts, turtlenecks, two-piece jacket and dress combinations, vests; headgear, namely, hats and caps; footwear, namely, shoes, boots, casual and dress shoes, sandals, slippers](#)

Class 025 for Clothing, namely, tops, anoraks, Bermuda shorts, blazers, blouses, boleros, bottoms, capes, cardigans, coats, dresses, jackets, jeans, jogging outfits and suits, leather coats, leather jackets, outerwear, pants, parkas, ponchos, pullovers, quilted vests, raincoats, shawls, shirts, shorts, shrugs, skirts, slacks, sport coats, sport shirts, sportswear, suits, sweaters, sweatshirts, tank tops, topcoats, trousers, track jackets, t-shirts, turtlenecks, two-piece jacket and dress combinations, vests; headgear, namely, hats and caps; footwear, namely, shoes, boots, casual and dress shoes, sandals, slippers;

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

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

**Current:** Class 035 for wholesale services; retail store operations; design, manufacture and marketing in the fields of clothing, headgear, footwear, accessories and leather goods; administration of licensing

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Proposed:**

**Tracked Text Description:** ~~wholesale services; design, manufacture and marketing in the fields of clothing, headgear, footwear, accessories and leather goods; retail store operations; retail store services featuring clothing, headgear, footwear, clothing, accessories and leather goods; administration of licensing~~; [Wholesale distributorships featuring clothing, headgear, footwear, accessories and leather goods; retail store services featuring clothing, headgear, footwear, clothing, accessories and leather goods; Commercial administration of the licensing of the goods and services of others; administration of licensing](#)

Class 035 for Wholesale distributorships featuring clothing, headgear, footwear, accessories and leather goods; retail store services featuring clothing, headgear, footwear, clothing, accessories and leather goods; Commercial administration of the licensing of the goods and services of others;

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

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

**Current:** Class 040 for manufacturing services

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in

connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Proposed:**

**Tracked Text Description:** ~~manufacturing services~~; [Manufacturing services for others in the field of clothing, headgear, footwear, clothing, accessories, and leather goods](#)

Class 040 for Manufacturing services for others in the field of clothing, headgear, footwear, clothing, accessories, and leather goods;

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

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

**Current:** Class 042 for monitoring of the manufacture of clothing, headgear, footwear, accessories and leather goods

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Proposed:**

**Tracked Text Description:** ~~monitoring of the manufacture of clothing, headgear, footwear, accessories and leather goods~~; [Design for others in the fields of clothing, headgear, footwear, clothing accessories and leather goods](#); [monitoring and inspection of manufactured goods in the nature of clothing, headgear, footwear, clothing accessories and leather goods for quality control purposes](#)

Class 042 for Design for others in the fields of clothing, headgear, footwear, clothing accessories and leather goods; monitoring and inspection of manufactured goods in the nature of clothing, headgear, footwear, clothing accessories and leather goods for quality control purposes;

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /Christopher Weimer/ Date: 05/02/2016

Signatory's Name: Christopher Weimer

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

Signatory's Phone Number: 1 512 536 4553

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: 86282147

Internet Transmission Date: Mon May 02 20:11:48 EDT 2016

TEAS Stamp: USPTO/RFR-XX.XXX.XX.XXX-2016050220114839

8643-86282147-5501cac6b66b606d5df2f02da3

99104bde7dba616b15efac2b72bf5fe68e91c7-N

/A-N/A-20160502195000360610

## **I. REMARKS**

Applicant G-III Leather Fashions, Inc. (“Applicant”) hereby files this Request for Reconsideration to the Office Action dated October 30, 2015 (the “Office Action”), regarding Application Serial No. 86/282,147 (the “Application”).

In the Office Action, the Examining Attorney refuses registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), arguing that mark in the Application (“Applicant’s Mark”) creates a likelihood of confusion with the following U.S. Registration Nos.: 2971162, 3613626, 3619451, 3319347, 3857314 and 4398167 (the “Cited Marks”). In addition, the Examining Attorney requires that Applicant amend portions of the identification of goods and services claimed to be indefinite in classes 18, 25, 35, 40 & 42. As discussed further below, Applicant hereby responds to the Examining Attorney’s requested amendments and respectfully disagrees with the Examining Attorney’s refusal. Applicant therefore requests that the refusal be withdrawn and that the Application be approved for publication.

## **II. DISCUSSION**

### **A. Three of the Cited Marks Have Been Canceled and No Longer Present a Bar to Registration of Applicant’s Mark.**

As discussed below, since the issuance of the Office Action, some of the registrations for the Cited Marks have been canceled and therefore no longer present a bar to registration of Applicant’s Mark.

#### **1. U.S. Registration No. 2971162 Has Been Canceled.**

Global Gem Group Inc. owned a registration for the design shown here in connection with “jewelry” in class 14: . The mark was canceled as of Feb. 26, 2016 because the registrant did not file an acceptable declaration under Section 8. As a result of its cancellation, this prior registration should not present an obstacle to registration and Applicant therefore respectfully requests that the refusal be withdrawn with regard to U.S. Reg. No. 2971162.

#### **2. U.S. Registration No. 3613626 Has Been Canceled.**

Cintas Holdings LLC owned a registration for the mark AIR DISK G3 in connection with “footwear” in class 25. The mark was canceled as of December 4, 2015 because the registrant did not file an acceptable declaration under Section 8. As a result of its cancellation, this prior registration should not present an obstacle to registration and Applicant therefore respectfully requests that the refusal be withdrawn with regard to U.S. Reg. No. 3613626.

#### **3. U.S. Registration No. 3619451 Has Been Canceled.**

GEN3 Partners, Inc. owned a registration for the mark G3:ID in connection with various consulting and management services in class 35, educational services in class 41, and research and development services in class 42. The mark was canceled as of December 18, 2015 because the registrant did not file an acceptable declaration under Section 8. As a result of its

cancellation, this prior registration should not present an obstacle to registration and Applicant therefore respectfully requests that the refusal be withdrawn with regard to U.S. Reg. No. 3619451.

**B. The Remaining Cited Marks Should Not Prevent the Application from Proceeding to Registration.**

Of the Cited Marks, only U.S. Reg. Nos. 3319347, 3857314, and 4398167 remain. For the reasons below, Applicant submits that Applicant's Mark is not likely to cause confusion with these Cited Marks. Below, Applicant first addresses U.S. Reg. Nos. 3319347 and 3857314, which both cover specialized goods. Applicant then will address separately U.S. Reg. No. 4398167, which covers golf products in classes 18 and 28 in connection with a "GIIF" design.

**I. The Goods Covered by Applicant's Mark Differ from the Goods Offered Under U.S. Reg. Nos. 3319347 and 3857314 and the Marks Differ in their Commercial Impression.**

In determining likelihood of confusion under Section 2(d), the similarity or dissimilarity and nature of the goods offered under the marks must be considered. *See In re E.I. Du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Where the nature of the goods offered under two marks differ, there can be no likelihood of confusion between the marks. *See Clayton Mark & Co. v. Westinghouse Electric Corp.*, 356 F.2d 943 (Cust. & Pat. App. 1966) (marks not confusingly similar where goods offered under marks were not similar).

**a. U.S. Registration No. 3319347 Covers Different Goods and is Different in Appearance.**

Simms Fishing Products Corporation ("Simms") owns U.S. Reg. No. 3319347 (the "'347 Registration") for the design shown here in connection with "Fishing waders" in class 25: . The Examining Attorney has cited the '347 Registration as a bar to Applicant's originally proposed goods and services, namely "clothing" in class 25 and the "design, manufacture . . . in the field of clothing" in class 35. In light of the amendment to Applicant's designated goods and services in classes 25 and 35, discussed below, it can be readily observed that the existence of the '347 Registration on the Principal Register in connection with this specialized type of goods should not prevent Applicant's Mark from proceeding to registration.

Fishing waders are specialized fishing equipment used to stay dry when standing in high water. By contrast, Applicant seeks coverage for a variety of ordinary clothing items, none of which would be construed as specialized, waterproof gear. The ordinary consumer would not view "fishing waders" as clothing items in the same way one thinks of pants or footwear; nor would a consumer think that a manufacturer or designer of ordinary clothing would design or manufacture "fishing waders."

This fundamental difference in the goods at issue is apparent when viewing them, as evidenced by an image of Simms' waders from its website, attached hereto as Exhibit A (being a true and correct printout of content available at <https://www.simmsfishing.com/shop/waders.html>). As stated on this site, Simms offers

specialized goods directed at “professional guides and anglers.” Considering that the purposes and uses of the parties’ respective goods are wholly different, and that consumers are unlikely to encounter them in similar settings or in related channels of distribution, it is very unlikely that relevant consumers of the respective goods will believe there is any connection between the two companies, either with regard to the class 25 goods or the class 35 services at issue.

When the differences in the parties’ goods are coupled with the differences between the parties’ respective marks, this conclusion appears even more sound. As the Examiner is no doubt aware, in considering potential confusion between two marks, “[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000). Although a particular feature of a mark may be afforded greater weight in this consideration, the relevant inquiry must be into the “similarity or dissimilarity of the marks *in their entireties*.” *E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (emphasis added).

When viewed as a whole, Applicant’s Mark differs in important ways from the ‘347 Registration. Specifically, the design in the cited mark consists of the single letter, “G” together with the number “3” inside of an oval, which are combined to form Simms’ G3 logo design. By contrast, Applicant’s Mark consists of the letter “G” together with the letter “I”, repeated three times, to form the standard-character mark “GIII.” The visual impression created by the two marks is distinct, such that consumers of the parties’ respective goods are unlikely to believe there is a connection between the two companies based on encountering the two parties’ marks. Given these differences in the goods at issue and the overall appearance of the marks, Applicant respectfully submits that the ‘347 Registration should not present an obstacle to publication of Applicant’s Mark. However, Applicant remains willing to entertain amendments to its description of goods and services should the Examining Attorney deem them necessary.

*b. U.S. Registration No. 3857314 Covers Different Goods Than Those Applicant Intends to Offer and Differs in Appearance.*

Cintas Holdings LLC (“Cintas”) owns U.S. Registration No. 3857314 (the “‘314 Registration”) for the mark CINTAS G3 INSOLES in connection with “insoles for footwear” in class 25. The Examining Attorney has cited the ‘314 Registration as a bar to Applicant’s originally proposed goods and services, namely “footwear and accessories” in class 25, and the “design, manufacture . . . in the field of . . . footwear, accessories” in class 35. In light of the amendment to Applicant’s designated goods and services in classes 25 and 35, discussed below, the existence of Cintas’ Registration on the Principal Register in connection with these goods should not prevent Applicant’s Mark from proceeding to registration.

Cintas’ use of its CINTAS G3 INSOLES mark is limited to insoles, which are defined as “a loose thin strip placed inside a shoe for warmth or comfort.” Exhibit B – Merriam-Webster, definition of “insoles.” By contrast, Applicant proposes to amend its description of goods in class 25 in part to cover “footwear, namely, shoes, boots, casual and dress shoes, sandals, slippers.” Merriam-Webster defines “footwear” as “wearing apparel (as shoes or boots) for the

feet.” See Exhibit C – Merriam-Webster definition of “footwear.” These are not the same or even related goods.

There is no per se rule that goods or services sold in the same field or industry are similar or related for purposes of likelihood of confusion. See, e.g., *Cooper Industries, Inc. v. Repcoparts USA, Inc.*, 218 USPQ 81, 84 (TTAB 1983); *Lloyd’s Food Products, Inc. v. Eli’s, Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993) (reversing likelihood of confusion cancellation of LLOYD’S for barbecued meats based on LLOYD’s for restaurant services).

Here, the goods at issue are not identical, nor do they overlap. Although both goods may come into contact, in the sense that insoles can be used inside of footwear, it does not follow that a potential likelihood of confusion will arise among consumers by virtue of Applicant’s use of Applicant’s Mark on footwear. Moreover, purchasers of “insoles for footwear” are seeking to correct or augment something about the fit and feel of their footwear, as insoles function as an insert used, for example, to protect one’s heel or the sole of the foot. In doing so, these products serve an entirely different purpose than footwear itself.

Any potential likelihood of confusion between Applicant’s Mark and the ‘314 Registration is further mitigated by the differences between the parties’ respective marks. The ‘314 Registration is for the mark “CINTAS G3 INSOLES.” Consumers encountering this mark are likely to associate goods offered under this mark with the word “Cintas” as much or more than they will associate them with the “G3” element in the mark. Moreover, the phrase “Cintas G3 Insoles” signals to potential consumers a connection to the mark owner, Cintas, while also looking and sounding different from a standalone “G3” or “GIII” mark. In this registration, “Cintas” functions as the dominant element of the mark. Additionally, upon viewing the inclusion of “insoles” in the mark, consumers would not associate it with footwear, but rather with the separate and distinct good in connection with which it is registered: insoles.

The additional elements of Cintas’ mark must be considered as features that serve to distinguish the overall commercial impression that the mark makes. See, e.g., *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985) (“[L]ikelihood of confusion cannot be predicated on the dissection of a mark, that is, only on part of the mark.”). Taking together the differences in the goods at issue and the differences in the marks under consideration, Applicant respectfully submits that the ‘314 Registration should not prevent Applicant’s Mark from proceeding to registration. However, Applicant remains willing to entertain amendments to its description of goods and services should the Examining Attorney deem them necessary.

2. U.S. Registration No. 4398167 Should Not Prevent Applicant’s Mark from Proceeding to Registration.

Globeride, Inc. owns U.S. Registration No. 4398167 (the “‘167 Registration”) for the design shown here in connection with “boston bags for use in association with golf and sold through sporting goods stores” in class 18 and “golf clubs, golf bags, with or without wheels, golf gloves, golf balls” in class 28: **GIII**. The Examining Attorney has cited the ‘167 Registration in regards to Applicant’s attempt to register Applicant’s Mark in connection with

“leather goods” in class 18 and with “design, manufacture...in the fields of...leather goods” in class 35.

Globeride has expressly consented to the registration of Applicant’s Mark for these goods and services, as discussed below. The Consent to Register, attached hereto as Exhibit D, sets forth reasons why Globeride and Applicant believe no likelihood of confusion will exist. Furthermore, under the Consent to Register, the parties have agreed to take any steps the parties deem necessary to avoid any confusion that may arise.

As the Court of Appeals for the Federal Circuit has stated, consent agreements should be given great weight. *See, e.g., Bongrain Int’l (Amer.) Corp. v. Delice de France Inc.*, 1 U.S.P.Q.2d 1775, 1778 (Fed. Cir. 1987). The U.S.P.T.O. should refrain from substituting its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason. *Trademark Manual of Examining Procedure* § 1207.01(d)(viii) (hereinafter “TMEP”). Accordingly, an examining attorney is required to accord great weight to consent agreements under the theory that the parties who have executed the consent agreements are in the best position to know whether there is a likelihood of confusion in the marketplace. *See id.* Applicant respectfully submits that the Consent to Register in place obviates any potential likelihood of confusion, and therefore requests that the refusal to register based on the ‘167 Registration be withdrawn.

**C. Applicant’s Amendment to Identification of Goods and Services**

In the Office Action, the Examining Attorney states that the wording in the identification of Applicant’s goods and services must be clarified because they are indefinite. Accordingly, Applicant hereby requests that the descriptions in the Application be amended to read as set forth below. Although Applicant contends herein that no likelihood of confusion with the Cited Marks will result, Applicant additionally responds to the provision 2(d) refusal on the alternative ground that Applicant’s amendments to the identification of goods and services set forth herein removes any potential for a likelihood of confusion with the Cited Marks.

Class	Original Description	Proposed Amendment
18	leather goods	Leather goods, namely, agenda cases, all purpose sport bags, backpacks, briefcase-like portfolios, briefcases, briefcase-type portfolios, Credit card cases and holders, handbags, leather key chains, luggage tags, luggage, Makeup cases sold empty, messenger bags, purses, travel kits comprising travel cases, toiletry cases sold empty, tote bags, travel cosmetic cases sold empty, valises, wallets, all made of leather;
25	clothing, headgear, footwear and accessories	Clothing, namely, tops, anoraks, Bermuda shorts, blazers, blouses, boleros, bottoms, capes, cardigans, coats, dresses, jackets, jeans, jogging outfits and suits, leather coats, leather jackets, outerwear, pants, parkas, ponchos, pullovers, quilted vests, raincoats, shawls, shirts, shorts, shrugs, skirts, slacks, sport coats, sport shirts, sportswear, suits, sweaters, sweatshirts, tank tops, topcoats, trousers, track jackets, t-shirts, turtlenecks, two-piece jacket and dress combinations, vests;

		headgear, namely, hats and caps;  footwear, namely, shoes, boots, casual and dress shoes, sandals, slippers;
35	wholesale services;  retail store operations;  design, manufacture and marketing in the fields of clothing, headgear, footwear, accessories and leather goods;  administration of licensing	Wholesale distributorships featuring clothing, headgear, footwear, accessories and leather goods;  retail store services featuring clothing, headgear, footwear, clothing, accessories and leather goods;  Commercial administration of the licensing of the goods and services of others;
40	manufacturing services	Manufacturing services for others in the field of clothing, headgear, footwear, clothing, accessories, and leather goods;
42	monitoring of the manufacture of clothing, headgear, footwear, accessories and leather goods	Design for others in the fields of clothing, headgear, footwear, clothing accessories and leather goods;  monitoring and inspection of manufactured goods in the nature of clothing, headgear, footwear, clothing accessories and leather goods for quality control purposes;

### III. CONCLUSION

In light of the above, Applicant respectfully submits that Applicant has responded to the requested amendments and that Applicant's Mark is not likely to be confused with the Cited Marks and that the present application is in condition for publication. However, the Examining Attorney is requested to contact the undersigned by telephone if a conversation would assist in resolving any remaining issues or expedite publication.

In submitting this response, Applicant seeks to fully satisfy all outstanding requirements and resolve all outstanding refusals identified by the Examining Attorney. Further, Applicant simultaneously submits an appeal to the Trademark Trial and Appeal Board in order to preserve its rights. No additional filing fees are believed due with this response.

Dated: May 2, 2016





**G3 GUIDE PANT**

**\$499.95**

ADD TO COMPARE



**YKK**



**HEADWATERS CONVERTIBLE STOCKINGFOOT**

**\$399.95**

ADD TO COMPARE



**YKK**



**HEADWATERS STOCKINGFOOT**

**\$349.95**

ADD TO COMPARE



**YKK**



**WOMENS G3 GUIDE STOCKINGFOOT**

**\$499.95**

ADD TO COMPARE



**YKK**



**FREESTONE Z WADER**

**\$399.95**

ADD TO COMPARE



**FREESTONE WADER**

**\$249.95**

ADD TO COMPARE



**FREESTONE PANT**

**\$229.95**

ADD TO COMPARE



**WOMEN'S FREESTONE WADER**

**\$249.95**

ADD TO COMPARE



**KID'S GORE-TEX STOCKINGFOOT**

**\$199.95**

ADD TO COMPARE



**YKK**



SINCE 1828

MENU

Dictionary

insoles

# insole

noun | in·sole | \ˈin-,sōl\

## Simple Definition of INSOLE

Popularity: Bottom 20% of words

- : the bottom of the inside of a shoe
- : a thin piece of material that you put at the bottom of the inside of a shoe for comfort

Source: Merriam-Webster's Learner's Dictionary

## Full Definition of INSOLE

- : an inside sole of a shoe
- : a loose thin strip placed inside a shoe for warmth or comfort

See **insole** defined for English-language learners

See **insole** defined for kids

## First Known Use of INSOLE

circa 1861

<http://www.merriam-webster.com/dictionary/insoles>

## Rhymes with INSOLE

airhole, armhole, atoll, bankroll, beadroll,  
 bedroll, black hole, blackpoll, blowhole,  
 borehole, bunghole, cajole, catchpole,  
 charcoal, chuckhole, drole, console

Circa 1861



SINCE 1828

MENU

Dictionary

footwear

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footwear

noun | foot·wear | \-,wer\

## Simple Definition of FOOTWEAR

Popularity: Bottom 30% of words

: things (such as shoes and boots) that are worn on your feet

Source: Merriam-Webster's Learner's Dictionary

Examples: FOOTWEAR in a sentence

## Full Definition of FOOTWEAR

: wearing apparel (as shoes or boots) for the feet

See **footwear** defined for English-language learners

See **footwear** defined for kids

## Examples of FOOTWEAR in a sentence

sneakers, loafers, and other casual *footwear*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Application Serial No.: 86/282,147

Mark: GIII

Applicant: G-III Leather Fashions, Inc.

CONSENT TO REGISTER

1. Globberide, Inc. ("Globberide") located at 3-14-16, Maesawa, Higashi Kurume, Tokyo 203-8511 is the owner of United States Trademark Registration No. 4,398,167 for the mark and goods identified below:

Mark	Goods/International Class
	Boston bags for use in association with golf and sold through sporting goods stores, in International Class 18; and Golf clubs, golf bags, with or without wheels, golf gloves, golf balls, in International Class 28

hereinafter ("the Globberide Registration").

2. G-III Leather Fashions, Inc. ("GLF"), a New York corporation, with a business address located at 512 Seventh Avenue, New York, New York 10018, is the applicant of United States Trademark Application Serial No. 86/282,147 for the mark GIII (the "GLF Application"). The GLF Application covers various goods and services including the following: leather goods, in International Class 18; and design and manufacture in the field of leather goods (the "Specific Goods and Services").

3. The USPTO has refused registration of the GLF Application with respect to the Specific Goods and Services based on the Globberide Registration as covers the following goods: "Boston bags for use in association with golf and sold through sporting goods stores" (the "Cited Goods").

4. Globberide consents to GLF's registration of the mark GIII for the Specific Goods and Services based on the following provisions.

G.S.

5. The parties believe that there is no likelihood of confusion arising from GLF's use of its mark GIII for the Specific Goods and Services, on the one hand, and the use of the mark in the Globeride Registration for the Cited Goods, on the other hand.

6. The parties' belief that no likelihood of confusion exists is based on the fact that Globeride will confine its use of the subject mark of the Globeride Registration as concerns Boston bags sold in the United States to Boston bags for use in association with golf sold only through sporting goods stores.

7. The parties' belief that no likelihood of confusion exists is based on the fact that GLF will not use the subject mark of the GLF Application for the Cited Goods or for the design and manufacture of the Cited Goods and will not use GLF's mark in the stylization of the subject mark of the Globeride Registration.

8. The parties have agreed to take the steps necessary to avoid and eliminate any instances of confusion if such instance comes to the attention of either party.

For the reasons set forth above, the parties agree there is no likelihood of confusion arising from GLF's use of the subject mark of the GLF Application for the Specific Goods and Services and Globeride's use of the subject mark of the Globeride Registration for the Cited Goods.

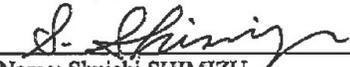
Date: August 4, 2015

G-III Leather Fashions, Inc.

  
Name: Wayne Miller  
Title: Chief operating officer

Date: July, 24, 2015

Globeride, Inc.

  
Name: Shuichi SHIMIZU  
Title: General Manager

S.S.