

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86480626
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION	
MARK FILE NAME	http://tmng-al.uspto.gov/resting2/api/img/86480626/large
LITERAL ELEMENT	GBC
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_17216192129-20160407172333226189_.GBC_request_for_reconsideration.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT16\IMAGEOUT16\864\806\86480626\xml9\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\864\806\86480626\xml9\RFR0003.JPG
DESCRIPTION OF EVIDENCE FILE	Legal argument
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	014
DESCRIPTION	
Necklaces; bracelets; rings; earrings; bangles; pendants; brooches; cufflinks; key chains as jewelry; charms	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	014
TRACKED TEXT DESCRIPTION	
Necklaces; Necklaces, bracelets, rings, earrings, bangles, pendants, brooches, cufflinks, key chains as jewelry, and charms sold in company owned retails stores and web site; bracelets; rings; earrings; bangles; pendants; brooches; cufflinks; key chains as jewelry; charms	
FINAL DESCRIPTION	
Necklaces, bracelets, rings, earrings, bangles, pendants, brooches, cufflinks, key chains as jewelry, and charms sold in company owned retails stores and web site	
FILING BASIS	Section 1(b)
SIGNATURE SECTION	
RESPONSE SIGNATURE	/MARK I. PEROFF/
SIGNATORY'S NAME	MARK I. PEROFF
SIGNATORY'S POSITION	ATTORNEY OF RECORD

SIGNATORY'S PHONE NUMBER	212-790-4601
DATE SIGNED	04/07/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Apr 07 17:35:48 EDT 2016
TEAS STAMP	USPTO/RFR-XXX.XX.XXX.XXX- 20160407173548671728-8648 0626-5509fbd574a2f654a977 f9aabc2bc9b7b664c198c7b33 aefef70b2c4c269a08f-N/A-N /A-20160407172333226189

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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. **86480626** GBC (Stylized and/or with Design, see <http://tmng-al.uspto.gov/resting2/api/img/86480626/large>) has been amended as follows:

EVIDENCE

Evidence in the nature of Legal argument has been attached.

Original PDF file:

[evi_17216192129-20160407172333226189_.GBC_request_for_reconsideration.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 014 for Necklaces; bracelets; rings; earrings; bangles; pendants; brooches; cufflinks; key chains as jewelry; charms

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: ~~Neeklaees; Necklaces, bracelets, rings, earrings, bangles, pendants, brooches, cufflinks, key chains as jewelry, and charms sold in company owned retails stores and web site; bracelets; rings; earrings; bangles; pendants; brooches; cufflinks; key chains as jewelry; charms~~

Class 014 for Necklaces, bracelets, rings, earrings, bangles, pendants, brooches, cufflinks, key chains as jewelry, and charms sold in company owned retails stores and web site

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: /MARK I. PEROFF/ Date: 04/07/2016

Signatory's Name: MARK I. PEROFF

Signatory's Position: ATTORNEY OF RECORD

Signatory's Phone Number: 212-790-4601

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: 86480626

Internet Transmission Date: Thu Apr 07 17:35:48 EDT 2016

TEAS Stamp: USPTO/RFR-XXX.XX.XXX.XXX-201604071735486

71728-86480626-5509fbd574a2f654a977f9aab

c2bc9b7b664c198c7b33aefef70b2c4c269a08f-

N/A-N/A-2016040717233226189

Request for Reconsideration

U.S. Trademark Application for GBC & Design

Serial No.: 86/480,626

The subject application has been refused on the ground that the mark sought to be registered is likely to cause confusion with the service mark GBC (Reg. No. 2,379,679) covering “wholesale distributorships featuring jewelry”. Applicant respectfully requests the Examiner to withdraw the refusal to register for the reasons set forth below.

As previously indicated, Applicant firmly believes that confusion as to source of origin of the respective products and services will not be likely to cause confusion due to the facts that the relevant class of purchasers of Applicant’s jewelry and the registrant’s wholesale distributorships featuring jewelry are different and the channels of trade through which the parties’ products and services are offered is not the same. Consequently, the parties’ marks will not be viewed by the same class of purchasers.

Applicant H & M Hennes & Mauritz operates a chain of retail stores in the U.S. and other countries in which it sells its private label line of clothing and personal accessories such as jewelry. Applicant’s jewelry is only sold in its owned wholly and operated retail stores and on its website. Applicant does not sell products manufactured by third parties in its stores or on its web site.

The registrant’s mark, on the other hand, is used to identify its wholesale jewelry distributorship services and is not used as a brand name on or for jewelry that is sold at retail to the average consumer. Therefore, the mark would only be viewed by wholesale distributors of jewelry and not the purchasing public.

In view of the foregoing, there is no chance that confusion as to the source of origin of the parties’ products and services could arise. As stated by Professor McCarthy in his treatise, “if one mark user sells exclusively at retail and the other exclusively to commercial buyers, then there may be little likelihood of confusion since no one buyer ever buys both products”.
4 McCarthy on Trademarks and Unfair Competition § 24:51 (4th ed.)

Since Applicant’s jewelry is only sold in its wholly owned and operated retail stores and web site, Applicant has amended the identification of goods of its application to limit the channels of trade through which its jewelry is sold, as follows:

“Necklaces, bracelets, rings, earrings, bangles, pendants, brooches, cufflinks, key chains as jewelry, and charms sold only in its company owned retail stores and web site”.

In view of the above, Applicant respectfully requests the Examiner to withdraw the refusal to register.

