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

Proceeding	91197848
Party	Defendant Hawke & Company Outfitters LLC
Correspondence Address	JAY BEGLER ESQ NIESAR & VESTAL LLP 90 NEW MONTGOMERY STREET, NINTH FLOOR SAN FRANCISCO, CA 94105 UNITED STATES jbegler@nvlawllp.com
Submission	Motion for Summary Judgment
Filer's Name	Jay Begler
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Signature	/Jay Begler/
Date	08/29/2012
Attachments	Motion for Partial Summary Judgment August 29, 2012.pdf ( 26 pages )(912340 bytes )

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

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In the Matter of Application Serial No. 77969536



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Published in the *Official Gazette* of August 17, 2010

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Retail Royalty Company	
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Opposer	
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v.	
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Hawke & Company Outfitters LLC	
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Applicant	
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Opposition No. 91197848
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**APPLICANT'S MOTION FOR PARTIAL SUMMARY JUDGMENT**

Pursuant to 37 C.F.R. §§ 2.127 and 2.116 and Federal Rules of Civil Procedure 56, Applicant, Hawke & Company Outfitters, LLC (the "Applicant") hereby moves for partial Summary Judgment with respect to Opposer's trademarks, identified below, and relied upon in its Notice of Opposition as a basis for claiming a likelihood of confusion with Applicant's trademark. It is Applicant's position that as matter of law, there can be no likelihood of confusion between the Applicant's mark and said marks.

**FACTUAL AND PROCEDURAL BACKGROUND**

On August 17, 2011, the Applicant's trademark was published for opposition.



The goods covered by said application were: "Jackets, shirts, pants, swimwear, socks, hats, belts and scarves".

Said mark was opposed by Opposer on December 15, 2009. Alleging likelihood of confusion, Opposer cited the trademarks set forth below. Applicant has denied the essential allegations of the Notice of Opposition. The Discovery Period in this Opposition is set to close on December 12<sup>th</sup>.

**Marks cited by Opposer in its Notice of Opposition**

<b>Trademark</b>	<b>Registration Number/Date</b>	<b>Goods Services</b>	<b>Disclaimers</b>
AMERICAN EAGLE OUTFITTERS	2086693 August 12, 1997	IC 025. Clothing; namely, outerwear; namely, coats, vests, parkas, and anoraks, pants, jeans, shorts, sweaters, shirts, underwear, neckwear, headwear, belts, hosiery, skirts, jackets, blazers, footwear, fleecewear; namely, fleece sweatshirts and fleece jackets.  IC 042. Retail clothing store services.	Outfitters Disclaimed
AMERICAN EAGLE OUTFITTERS	2050115 April 8, 1997	IC 025. Footwear, slippers, leather and rubber boots, and insoles.	Outfitters Disclaimed
AMERICAN EAGLE OUTFITTERS	3888496 December	IC 035. Retail store services and online retail store services in the field of	Outfitters Disclaimed

	14, 2010	clothing, clothing accessories, footwear and headwear, and bags.	
 <p><b>This registration has been cancelled but Opposer may claim common law rights in it.</b></p>	2856574  June 22, 2004	IC 025. Jeans, denim pants, denim shorts, denim skirts, denim jackets, denim vests	Outfitters Disclaimed

The above marks shall be referred to collectively herein as the AMERICAN EAGLE OUTFITTERS marks. Opposer has also asserted two common law marks and a registered mark covering an eagle design, registration No. 3878197. These marks are not part of this motion. It is believed that if the Applicant's Motion is granted with respect to the AMERICAN EAGLE OUTFITTERS trademarks the issues for discovery and testimony will be narrowed and the case will proceed on a more cost efficient basis.

### ARGUMENT

The seminal and governing decision on the factors ("DuPont Factors") to be considered in a likelihood of confusion analysis is In re E. I. du Pont de Nemours & Co., 476 F.2d 1357 (C.C.P.A. 1973). DuPont and cases that follow make clear, however, that not all factors need be considered for a disposition in each case and that the correct approach is to accord appropriate weight to the most relevant factors. Indeed, a single factor can be dispositive on a confusion issue. See e.g.: Opryland USA, Inc. v. Great Am. Music Show, 970 F.2d 847, 850 (Fed. Cir. 1992). It is well established, moreover, that a single DuPont Factor such as the difference between the marks

themselves can be sufficient to grant Summary Judgment. See Kellogg Co. v. Pack'Em Enterprises, Inc., 21 USPQ2d 1142 (Fed. Cir. 1991) (there is "no reason why, in a particular case, a single *duPont* factor may not be dispositive"); Champagne Louis Roederer, SA v. Delicato Vineyards, 47 USPQ2d 1459 (Fed. Cir. 1998) ("one *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks"); Truescents LLC v. Ride Skin Care, LLC, 81 USPQ2d 1334 (TTAB 2006) ("Simply put, the dissimilarity between the marks is dispositive in this case").

In the case at hand the differences between the AMERICAN EAGLE OUTFITTERS marks and Applicant's mark are so great and so obvious that the Board should grant summary judgment as matter of law.

**AMERICAN EAGLE OUTFITTERS MARKS**

v.



Taken as a whole the respective marks of the parties convey obvious and significant differences in appearance, sound, meaning and commercial impression. The sole link between the marks is the descriptive word "Outfitter." While Opposer utilizes the plural "Outfitters" and Applicant uses the singular "Outfitter," for purposes of this motion Applicant concedes these terms are identical. As disclosed in the file histories of the Applications for both the AMERICAN EAGLE OUTFITTERS marks and Applicant's marks, the Examining attorney required disclaimers of Outfitters because "outfitters" was judged to be merely descriptive. See Exhibit One, the Opposer's registration certificates showing such disclaimers. While clearly not binding on the Board, the Examining Attorney's rationale in requiring Opposer to disclaim "Outfitters" with respect to Application SN 77679197 (Exhibit 2) well articulated the nature of "Outfitters" as used by Opposer, Applicant and in fact many other clothiers:

*As explained previously, the term "OUTFITTERS" is a term commonly used among retailers and other entities like the applicant that produce clothing, clothing accessories, footwear, headwear, bags, jewelry, perfume, cosmetics, and*

*other similar products that consumers wear. The term is thus merely descriptive, if not generic, for the applicant's kind of services. Entities that make or sell products worn by consumers are known as "outfitters," and whether consumers patron the applicant's store services to buy clothing to wear, jewelry to wear, cosmetics to wear, or perfume to wear, they will merely perceive the term "OUTFITTERS" in the applicant's mark to be a common term that does not indicate source, but rather merely describes the nature of the retail services.*

*"Many other entities that provide similar retail services and products similar to those carried by the applicant describe and identify themselves as "outfitters." The attached third-party registrations are a mere sample of the hundreds of such examples, and in the great majority of those cases, the Trademark Office has only granted registration with the applicant's agreement to disclaim use of the term "outfitters," and acknowledge that the term is merely descriptive or generic. The applicant itself owns several such registrations wherein the term "OUTFITTERS" is disclaimed for goods or retail services featuring personal care products (U.S. Registration No. 2344282), perfume (U.S. Registration No. 2393861), cosmetic bags (U.S. Registration No. 3490875), jewelry (U.S. Registration No. 1916360), as well as clothing, footwear, and headwear (U.S. Registration Nos. 2050115, 2086693, 2856574)."*

Several examples of such uses are attached hereto in Exhibit 3.

Obviously, the disclaimed portion alone cannot be the basis for finding a likelihood of confusion. See Section of the TMEP 1213:

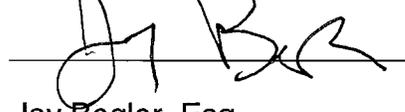
"The significance of a disclaimer is conveyed in the following statement:

As used in trade mark registrations, a disclaimer of a component of a composite mark amounts merely to a statement that, in so far as that particular registration is concerned, ***no rights are being asserted in the disclaimed component standing alone***, but rights are asserted in the composite; and the particular registration represents only such rights as flow from the use of the composite mark. *Sprague Electric Co. v. Erie Resistor Corp.*, 101 USPQ 486, 486-87 (Comm'r Pats. 1954)." (Emphasis ours)

Since the only similarity whatsoever in the respective composite marks in this case is the disclaimed "Outfitters" and the marks as a whole are different in every aspect, sound, appearance, commercial impression, the Board should find no likelihood of confusion as a matter of law with Applicant's mark. For the foregoing reasons, Applicant respectfully requests that its Motion For Partial

Summary Judgment be granted and that the opposition with respect to said AMERICAN EAGLE OUTFITTERS be dismissed.

Respectfully submitted,



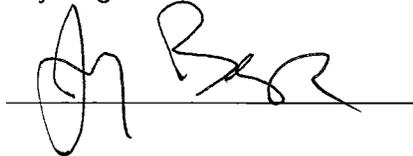
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**CERTIFICATE OF SERVICE**

The undersigned states that a copy of the foregoing Motion for Summary Judgment was served by first class mail, postage prepaid and via email upon counsel for Opposer this 29<sup>th</sup> day of August, 2012:

Laura Miller, Esq.  
Kilpatrick Townsend & Stockton LLP  
1001 West Fourth Street  
Winston-Salem, NC 27101-2400

Jay Begler



**EXIHIBIT ONE**  
**OPPOSER'S REGISTRATION CERTIFICATES**

Int. Cls.: 25 and 42

Prior U.S. Cls.: 39 and 101

Reg. No. 2,086,693

**United States Patent and Trademark Office**

Registered Aug. 12, 1997

**TRADEMARK  
SERVICE MARK  
PRINCIPAL REGISTER**

**AMERICAN EAGLE OUTFITTERS**

RETAIL COMMERCE COMPANY (NEVADA CORPORATION)  
300 SOUTH FOURTH STREET  
LAS VEGAS, NV 89101, BY ASSIGNMENT  
AND ASSIGNMENT FROM RETAIL VENTURES, INC. (PENNSYLVANIA CORPORATION) WARRENDALE, PA 15095

FOR: CLOTHING; NAMELY, OUTERWEAR; NAMELY, COATS, VESTS, PARKAS, AND ANORAKS, PANTS, JEANS, SHORTS, SWEATERS, SHIRTS, UNDERWEAR, NECKWEAR, HEADWEAR, BELTS, HOSIERY, SKIRTS, JACKETS, BLAZERS, FOOTWEAR, FLEECEWEAR; NAMELY, FLEECE SWEATSHIRTS AND FLEECE JACKETS, IN CLASS 25 (U.S. CL. 39).

FIRST USE 10-0-1977; IN COMMERCE 10-0-1977.

FOR: RETAIL CLOTHING STORE SERVICES, IN CLASS 42 (U.S. CL. 101).

FIRST USE 10-0-1977; IN COMMERCE 10-0-1977.

OWNER OF U.S. REG. NO. 1,597,199.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICAN" AND "OUTFITTERS", APART FROM THE MARK AS SHOWN.

SER. NO. 74-367,208, FILED 3-11-1993.

ROBERT C. CLARK JR., EXAMINING ATTORNEY

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,050,115

**United States Patent and Trademark Office**

Registered Apr. 8, 1997

**TRADEMARK  
PRINCIPAL REGISTER**

**AMERICAN EAGLE OUTFITTERS**

RETAIL ROYALTY COMPANY (NEVADA  
CORPORATION)  
300 SOUTH FOURTH STREET  
LAS VEGAS, NV 89101, BY ASSIGNMENT, AS-  
SIGNMENT AND ASSIGNMENT FROM  
RETAIL VENTURES, INC. (PENNSYLVANIA  
CORPORATION) WARRENDALE, PA 15095

FOR: FOOTWEAR, SLIPPERS, LEATHER  
AND RUBBER BOOTS, AND INSOLES, IN  
CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 8-0-1983; IN COMMERCE  
8-0-1983.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "OUTFITTERS", APART FROM  
THE MARK AS SHOWN.

SER. NO. 74-482,528, FILED 1-24-1994.

ROBERT C. CLARK JR., EXAMINING ATTOR-  
NEY

# United States of America

United States Patent and Trademark Office

AMERICAN EAGLE OUTFITTERS

**Reg. No. 3,888,496**

RETAIL ROYALTY COMPANY (NEVADA CORPORATION)  
101 CONVENTION DRIVE  
LAS VEGAS, NV 89109

**Registered Dec. 14, 2010**

**Int. Cl.: 35**

FOR: RETAIL STORE SERVICES AND ONLINE RETAIL STORE SERVICES IN THE FIELD OF CLOTHING, CLOTHING ACCESSORIES, FOOTWEAR AND HEADWEAR, AND BAGS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

**SERVICE MARK**

FIRST USE 0-0-1977; IN COMMERCE 5-0-1998.

**PRINCIPAL REGISTER**

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,597,199, 2,191,681 AND OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "OUTFITTERS", APART FROM THE MARK AS SHOWN.

SER. NO. 77-679,197, FILED 2-26-2009.

CORY BOONE, EXAMINING ATTORNEY



*David J. Kyffers*

Director of the United States Patent and Trademark Office

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,856,574

United States Patent and Trademark Office

Registered June 22, 2004

TRADEMARK  
PRINCIPAL REGISTER



RETAIL ROYALTY COMPANY (NEVADA CORPORATION)  
101 CONVENTION CENTER DRIVE  
LAS VEGAS, NV 89109

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "OUTFITTERS" AND "EST. 1977",  
APART FROM THE MARK AS SHOWN.

FOR: JEANS, DENIM PANTS, DENIM SHORTS,  
DENIM SKIRTS, DENIM JACKETS, DENIM VESTS,  
IN CLASS 25 (U.S. CLS. 22 AND 39).

SN 76-480,046, FILED 1-3-2003.

FIRST USE 2-15-2003; IN COMMERCE 2-15-2003.

MIDGE BUTLER, EXAMINING ATTORNEY

**EXHIBIT TWO**

**OFFICE ACTION DATED DECEMBER 3, 2009 FOR SERIAL NUMBER 77679197**

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**To:** Retail Royalty Company ([usptodock@whepatent.com](mailto:usptodock@whepatent.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 77679197 - AMERICAN EAGLE OUTFITTERS - RVI-1295/135  
**Sent:** 12/3/2009 7:09:45 PM  
**Sent As:** ECOM104@USPTO.GOV  
**Attachments:** [Attachment - 1](#)  
[Attachment - 2](#)  
[Attachment - 3](#)  
[Attachment - 4](#)  
[Attachment - 5](#)  
[Attachment - 6](#)  
[Attachment - 7](#)  
[Attachment - 8](#)  
[Attachment - 9](#)

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 77/679197

**MARK:** AMERICAN EAGLE OUTFITTERS

**\*77679197\***

**CORRESPONDENT ADDRESS:**

SARAH OTTE GRABER  
WOOD, HERRON & EVANS LLP  
441 VINE ST  
STE 2700  
CINCINNATI, OH 45202-2814

**RESPOND TO THIS ACTION:**

<http://www.uspto.gov/teas/eTEASpageD.htm>

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** Retail Royalty Company

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

RVI-1295/135

**CORRESPONDENT E-MAIL ADDRESS:**

[usptodock@whepatent.com](mailto:usptodock@whepatent.com)

**OFFICE ACTION**

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

**ISSUE/MAILING DATE: 12/3/2009**

**THIS IS A FINAL ACTION.**

This Office Action is sent in response to the applicant's most recent correspondence, dated November 25, 2009. In the correspondence, the applicant contests a requirement issued by the examining attorney in an Office Action sent on May 27, 2009. The examiner had required the applicant to disclaim a term from its mark. The applicant's arguments against the requirement are not successfully persuasive, for the reasons set forth below. Therefore, the refusal to register is maintained herein and made final.

**Disclaimer Required**

Applicant must disclaim the descriptive wording "OUTFITTERS" apart from the mark as shown because it merely describes and identifies the nature of the applicant's services. See 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a).

The applicant seeks to register the mark "AMERICAN EAGLE OUTFITTERS" for retail store services featuring a variety of products, including clothing, footwear, headwear, cosmetics, personal care products, jewelry, and bags. The examiner previously required that the applicant disclaim "OUTFITTERS" from its mark because the term is not registrable on the Principal Register. The term is generic for, or at least very highly descriptive of, entities that produce the kinds of goods sold in the applicant's stores as well as of entities providing the retail services. The examiner provided multiple dictionary definitions establishing the descriptive/generic significance of "outfitter" to mean "haberdasher", or one who makes clothing (outfits), or as identifying retail businesses that sell clothing and equipment for hikers, hunters, and so forth. The applicant's services clearly fall within the scope of these definitions, making the services those typical of "OUTFITTERS."

The examiner also included other registrations – including some of the applicant's own older registrations for the same mark – showing that businesses are routinely required to disclaim the term "OUTFITTERS" as merely descriptive or generic. The applicant has accepted this requirement in previous applications, and must do so again. The term alone has not acquired distinctiveness, nor could not, given its generic or highly descriptive meaning.

Finally, the third-party registrations also demonstrate that many other entities use "OUTFITTERS" in similar fashion, and thus that the applicant would be given undue advantage over other parties if it were allowed exclusive right to use the term apart from its mark as shown.

In its response, the applicant makes two key arguments against the requirement of a disclaimer. First, the applicant argues that the third-party registrations are not necessarily conclusive on the issue of descriptiveness, but must be taken into consideration case-by-case. This argument is correct, but the examiner nevertheless finds the term "OUTFITTERS" to be descriptive/generic based on the overwhelming evidence in this particular case. First, third-party registrations featuring the same or similar goods and/or services as applicant's goods and/or services are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on a showing of acquired distinctiveness, or registered on the Supplemental Register. See *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1564-65, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006).

In this case, there are dozens of registered marks for related goods and services wherein the term

“OUTFITTER[S]” is disclaimed or otherwise not registered on the Principal Register. This evidence clearly weighs against the applicant’s arguments. Furthermore, the copious evidence in the form of dictionary definitions again shows that the term “OUTFITTER” could never be distinctive for services of the kind provided by the applicant.

Concerning the third-party registrations, the applicant included evidence to argue that the Trademark Office does not treat the term “OUTFITTERS” consistently as non-distinctive. It is true that the term is not disclaimed in the registered mark for “OUTFITTERS FOR THE GREAT OUTDOORS.” However, that mark appears to be a unitary slogan, wherein the repetition of the prefix “out” creates an overall impression that would be rendered inoperable should a disclaimer sever the phrase. The only other relevant evidence provided by applicant of a registration for a mark containing “OUTFITTER” for retail of apparel is canceled and dead, and thus not relevant to this case. On the whole, the record overwhelmingly supports the examiner’s conclusion that the term is descriptive or generic for such services.

~~The examiner also notes that a term that was once arbitrary or suggestive may lose its distinguishing and origin-denoting characteristics through use in a descriptive sense over a period of time, and come to be regarded by the purchasing public as nothing more than a descriptive designation. *In re Digital Research, Inc.*, 4 USPQ2d 1242, 1243 (TTAB 1987); *In re Int’l Spike, Inc.*, 190 USPQ 505, 507 (TTAB 1976). Thus, trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence in the record at the time registration is sought. *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1344, 213 USPQ 9, 18 (C.C.P.A. 1982); *In re Thunderbird Prods. Corp.*, 406 F.2d 1389, 1391, 160 USPQ 730, 732 (C.C.P.A. 1969). The older decisions of other examiners, especially for marks not used for services related to those in this case, are thus not controlling in this case. The record strongly supports the examiner’s findings.~~

The applicant’s other arguments against the refusal directly concern the alleged distinctiveness of the term “OUTFITTERS.” First, the applicant argues that the term is “arbitrary” as applied to its goods and services. This argument is not persuasive. The dictionary evidence, as well as use by third-parties, clearly demonstrates that businesses that make and sell apparel and other products of the kind marketed by the applicant are known as “outfitters.” An arbitrary term is one that bears no relation to the underlying goods/services. The applicant’s term expressly applies to its business.

The applicant next argues that the whole mark is unitary, and that consumers would not dissect the mark. This argument is not persuasive. A unitary mark is one that by its combination creates a new impression that transcends the impression created by the individual terms comprising the mark. The applicant’s mark, while a combination of terms, creates no new meaning, sound, or appearance that transcends the individual meanings, sounds, and appearances of the individual terms.

Finally, the applicant relies on its extensive use of the whole mark to argue that consumers would view the mark as a whole. This argument is not persuasive. While the applicant has shown extensive use, the examiner has shown that such use has not been exclusive, at least as far as “OUTFITTERS” goes. The applicant – if it claims exclusive use – has not successfully policed others from using the term for related services. Furthermore, the extensive use the applicant relies upon, as demonstrated by other registrations, specifically undercuts the applicant’s arguments in this case. This is because the other registrations contain disclaimers of “OUTFITTERS,” which are tacit admissions that the applicant does not enjoy exclusive rights to use this term apart from the mark as a whole. Finally, even if consumers expect to see “OUTFITTERS” with the rest of the “AMERICAN EAGLE” mark, it does not necessarily follow that the whole mark is inherently distinctive. Consumers also likely expect to see “NIKE SHOES,” “APPLE

COMPUTERS,” or a host of other registered marks alongside generic or descriptive words, even where those other entities do not enjoy exclusive rights over the descriptive or generic terms.

In conclusion, the record strongly supports the examiner’s findings that the term “OUTFITTERS” is merely descriptive or generic when considered in the context of the applicant’s services. Such terms are not registrable on the Principal Register. The applicant must disclaim exclusive rights to use the term apart from the mark as shown.

The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements, or combinations thereof. 15 U.S.C. §1056(a). A “disclaimer” is a statement added to the record that states that the applicant does not claim exclusive rights, separate and apart from the entire mark, to an unregistrable component of a mark whether it be wording or design. TMEP §1213. A disclaimer does not affect the appearance of the applied-for mark because the disclaimed matter is not physically removed. *See* TMEP §1213.10.

Under Trademark Act Section 2(e), the Office can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods and/or services. 15 U.S.C. §1052(e). Thus, the Office may require an applicant to disclaim a portion of a mark that, when used in connection with the goods and/or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). *See* TMEP §§1213, 1213.03. Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).

The computerized printing format for the Office’s *Trademark Official Gazette* requires a standardized format for a disclaimer. TMEP §1213.08(a)(i). The following is the standard format used by the Office:

- No claim is made to the exclusive right to use “OUTFITTERS” apart from the mark as shown.

TMEP §1213.08(a)(i); *see In re Owatonna Tool Co.*, 231 USPQ 493 (Comm’r Pats. 1983).

### **RESPONDING TO A FINAL OFFICE ACTION**

If applicant does not respond within six months of the mailing date of this final Office Action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office Action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

/Cory Boone/

Trademark Examining Attorney  
Law Office 104  
Phone: 571.270.1510  
Fax: 571.270.2510  
cory.boone@uspto.gov

**RESPOND TO THIS ACTION:** Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

**EXHIBIT THREE**

**DESCRIPTIVE USES OF OUTFITTERS BY CLOTHING COMPANIES**

# URBAN OUTFITTERS

FREE SHIPPING & FREE RETURNS! [\\*Details](#)

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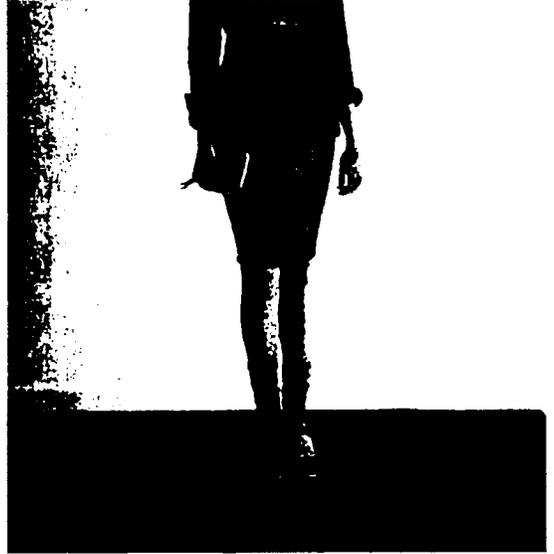


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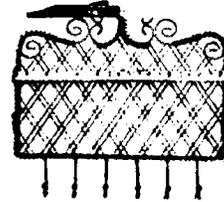
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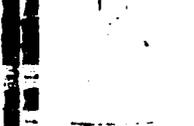
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