

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

MINORONZONI S.R.L.

Serial No. 76/576871

Filed February 20, 2004

For TOSCA BLU & Design

REQUEST TO DIVIDE


Pursuant to Rule 2.87(a) of the Trademark Rules of Practice, Applicant hereby requests that the above referenced application be divided into two separate applications. Specifically, Applicant requests that the description of goods in its pending application be amended to read as follows:

all purpose carrying bags; handbags; suitcases; rucksacks; wallets; purses; briefcases; document holders made of leather and imitation leather; gentlemen's handbags; trunks; animal skins and hides; leather; articles made of leather, namely, purses, wallets, handbags, key cases and all-purpose carrying bags; parasols; beach umbrellas; umbrellas; walking sticks; harnesses; saddlery in Class 18.

Applicant further requests that the remaining goods in its application be listed in a new application and that the description of goods therein read as follows:

clothing for men, women and children, namely jackets, belts, pants, skirts, and footwear made of leather; shirts; blouses; skirts; suits; jackets; trousers; shorts; sports jerseys; T-shirts; pajamas; stockings; singlets; corsets; suspenders; underpants; brassieres; underwear; hats; headscarves; neckties; overcoats; topcoats; swimsuits; tracksuits; windcheaters; ski pants; belts; fur scarves; fur cuffs, fur collars; scarves; gloves; dressing gowns; footwear, slippers, shoes, footwear for sports, boots and sandals.

TECH/527397.1

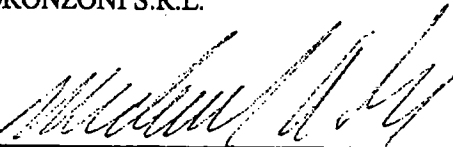

09-17-2007

U.S. Patent & TMO/TM Mail Rpt. Dt. #72

A check in the amount of \$100 is enclosed for the filing fee pertaining to this request to divide. Any additional fees that may be required are to be charged to Deposit Account No. 01-2300.

MINORONZONI S.R.L.

By



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Date

2.7.07

Attorney for Applicant

****Please place on Upper Right Corner****
****of Response to Office Action ONLY.****

Examining Attorney: KIM, YONG

Serial Number: 76/578871

IN THE UNITED STATES PATENT

In re Application of	:	
MINORONZONI S.R.L.	:	Examining Attorney
Serial No. 76/576,871	:	Yong Oh (Richard) Kim
Filed February 20, 2004	:	Law Office 115
For TOSCA BLU & Design	:	

REQUEST FOR RECONSIDERATION

This is in response to the Office Action dated March 7, 2007, wherein the Office issued a final refusal to register Applicant's mark in Class 18 and 25 under Section 2(d) of the Trademark Act on the ground that it is allegedly confusingly similar to the mark identified in Reg. No. 2,310,504, TOSCA for Class 18 goods. The Office withdrew as moot the refusal based on Reg. No. 2,335,814, TOSKA for Class 25 goods, as this latter registration was recently cancelled.

Applicant is submitting with this request for reconsideration a petition to divide the application, together with a check in the amount of \$100 to cover the fee for the petition to divide. Any additional fee that is required should be charged to Deposit Account No. 01-2300. Applicant is also filing a notice of appeal.

Applicant respectfully requests reconsideration of the refusal to register in light of the following argument.

ARGUMENT

Applicant originally sought registration of the mark TOSCA BLU & Design for the following products:

All purpose carrying bags; handbags; suitcases; rucksacks; wallets; purses; briefcases; document holders made of leather and imitation leather; gentlemen's handbags; trunks; animal skins and hides; leather; articles made of leather, namely, purses, wallets, handbags, key cases and all-purpose carrying bags; parasols; beach umbrellas; umbrellas; walking sticks; harnesses; saddlery", in Int. Class 18; and

Clothing for men, women and children, namely jackets, belts, pants, skirts, and footwear made of leather; shirts; blouses; skirts; suits; jackets; trousers; shorts; sports jerseys; T-shirts; pajamas; stockings; singlets; corsets; suspenders; underpants; brassieres; underwear; hats; headscarves; neckties; overcoats; topcoats; swimsuits; tracksuits; windcheaters; ski pants; belts; fur scarves; fur cuffs, fur collars; scarves; gloves; dressing gowns; footwear, slippers, shoes, footwear for sports, boots and sandals", in Int. Class 25.

The Office has made final the refusal to register Applicant's mark in both Classes 18 and 25 under Section 2(d) of the Trademark Act on the ground that it is allegedly confusingly similar to the mark identified in the following registration which covers only Class 18 goods:

Reg. No. 2,310,504 TOSCA for "bags, namely, handbags, purses, clutches, carry-on bags, tote bags, traveling bags, luggage, leather shopping bags, mesh shopping bags, drawstring pouches, and felt pouches" in Int. Class 18,

Applicant is submitting a petition to divide its application into an application for goods in Class 18 and an application for goods in Class 25.

Applicant respectfully request reconsideration of the refusal in view of the following argument.

A. There Is No Likelihood Of Confusion With Respect To Applicant's Goods In Class 25 In View Of The Weakness Of The Cited Mark, The Differences In The Goods And The Differences In The Marks

There is no likelihood of confusion between Applicant's mark and the cited mark because the Office has already recognized that the cited mark is weak and entitled only to a narrow scope of protection, and the marks and goods are different.

In evaluating likelihood of confusion, all the relevant factors must be examined and weighed. *In re Du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (CCPA 1073).

The mark in the cited registration No. 2,310,504 TOSCA for various kinds of handbags in Class 18 has coexisted for years on the Principal Register and in the marketplace with the virtually identical mark TOSKA, identified in Reg. No. 2,335,814, for various women's and children's clothing items. Although the TOSKA registration is cancelled, the office concluded that there was no likelihood of confusion between the marks TOSCA for handbags and TOSKA for clothing when it allowed registration to issue for both marks. The marks TOSCA and TOSKA are identical in sound, and virtually identical in appearance, the only difference being the letter K instead of the letter C. The fact that the cited mark TOSCA for goods in Class 18 and the virtually identical mark TOSKA for clothing were both registered on the Principal Register clearly demonstrates that the Office and both registrants believed that these two virtually identical marks could coexist on the Register and in the marketplace without creating any likelihood of confusion. Thus, if the cited mark TOSCA can coexist with the mark TOSKA for goods in Class 25, it can coexist with Applicant's mark TOSCA BLU & design in the divided application in Class 25.

The coexistence of these registrations and the evidence of third-party use of the mark TOSCA for clothing shows that the cited mark deserves only an extremely narrow scope of protection and that no confusion is likely between the cited mark and the mark in Applicant's divided application in Class 25. *In re Dayco Products-Eagle Motive, Inc.*, 9 U.S.P.Q.2d 1910 (TTAB 1988). *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 U.S.P.Q. 108 (CCPA 1974). Thus, the weakness of the cited mark, combined with the

differences in the marks and in the goods, make any confusion between the cited mark and Applicant's divided application in Class 25 highly unlikely.

B. There Is No Likelihood Of Confusion With Respect To Applicant's Goods In Class 18

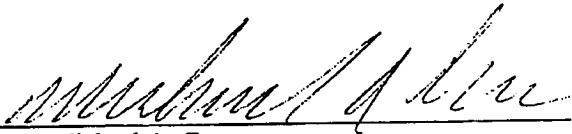
Applicant respectfully contends that no confusion is likely between the mark in its divided application in Class 18, and the cited mark. As already explained in Applicant's previous response, no confusion is likely in view of the weakness of the cited mark. In further support of its position, Applicant is submitting a declaration of Applicant's officer Giacomo Ronzoni, attesting to the fact that although Applicant's mark has been used in commerce since at least as early as 2005 to the present in connection with products in Classes 25 and 18, the owner of the cited registration has never objected to such use, and Applicant is unaware of any instance of confusion resulting from the use of its mark. *See*, Exhibit A.

CONCLUSION

For the foregoing reasons, the refusal to register Applicant's mark should be withdrawn and Applicant's mark should be approved for publication.

MINORONZONI S.R.L.

By



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Attorneys for Applicant

Date

9-7-07

CERTIFICATE OF MAILING

It is hereby certified that the attached Request for reconsideration and exhibit, petition to divide and check (re S/N 76/576,871) are being deposited with the U.S. Postal Service addressed to the Hon. Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313 marked first class mail, postage prepaid, on September 7, 2007.

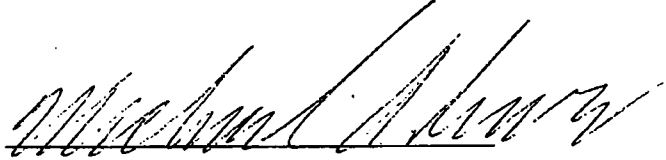
A handwritten signature in cursive script, appearing to read "Michael A. Henry", is written over a horizontal line.

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

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Serial No. 76/576871

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For TOSCA BLU & Design

DECLARATION

The undersigned declares that (s)he is authorized to execute this declaration; that the facts set forth in this declaration are true; that all statements made of his/her own knowledge are true; that all statements made on information and belief are believed to be true.

Having been warned that false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the U.S. Code and that such willful false statements may jeopardize the validity of this application or any registration resulting therefrom, the undersigned hereby affirms as follows.

- (1) Applicant's mark TOSCA BLU has been used continuously in commerce regulated by the Congress of the United States, in connection with the sale of goods described in the above identified application to companies in the United States from at least as early as 2005 to the present.
- (2) Since the date of first use until now, Applicant has received no objection from New Wealth Trading, Inc. of Los Angeles, California, the owner of record for Registration No. 2310504.
- (3) Applicant is not aware of any confusion resulting from the use of its mark.

- (4) Applicant is unaware of any instances of confusion between its mark and the mark shown in Registration No. 2310504.
- (5) Applicant believes its mark is not likely to cause confusion in view of the contemporaneous use of Applicant's mark on the goods identified in its application and the cited mark shown in Registration No. 2310504 on the goods identified therein, from at least as early as 2005, without objection or instances of confusion.

MINORONZONI S.R.L.

By *Giacomo Ronzoni*

Printed Name RONZONI GIACOMO

Title ADMINISTRATOR

Date AUGUST 23 2007