


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

Examining Attorney: MARTIN, EUGENIA  
Serial Number: 77/045814



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :  
GRUPO ANDREA, S.A. DE C.V. :  
Serial No. 77/045814 : Trademark Attorney  
Filed November 16, 2006 : Eugenia Martin  
For  : Law Office 114

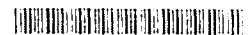
**REQUEST FOR RECONSIDERATION**

This is in response to the Office Action dated July 20, 2009, pertaining to the above referenced application wherein the Office refused registration of Applicant's mark in Class 16 because the specimens on file were not "goods in trade". There was no objection to the specimen in Class 25.

Applicant believes its mark is entitled to be registered and is simultaneously filing a notice of appeal. Nonetheless, Applicant requests that the Office reconsider the refusal to register in Class 16 for the following additional evidence and arguments.

***The Specimen Shows Actual Trademark Use and It Should Be Accepted***

A specimen must show the mark as used on or in connection with the goods in commerce, and the trademark may be affixed to the goods. TMEP § 904.03. The specimen Applicant submitted consists of excerpts from an actual pamphlet or catalog. Applicant's mark is imprinted directly on the goods and thus it meets the definition of trademark use set forth in Section 45 of the Trademark Act. Unlike the goods mentioned in the cases cited in the most



recent Office Action, Applicant actually sells products of the type shown in the specimen filed with the statement of use. Applicant's products contain high quality photography featuring attractive people and they are goods in trade sold to Applicant's customers.

Further evidence of the fact that Applicant actually sells its catalogs may be found in the sample price lists for Applicant's goods, which are attached as Exhibit A. These documents show that Applicant sells its catalogs in much the same way as the publisher of any other periodical publication.

***Applicant's Publications Are Not Merely Incidental to Its Goods***

The 1959 decision cited in the Office Action, *In re Douglas Aircraft Company, Inc.* 123 USPQ 271 (TTAB 1959), has no applicability to the facts at issue here. In that case, the Board refused registration of the mark AIRCOMB because the goods at issue were merely "**utterances or publications which are distributed as incidental** to these products." The board concluded that the marks at issue were not being used to identify and distinguish the Applicant's booklets from publications sold by others.

In this case, however, Applicant's catalogs are not "merely incidental" to Applicant's products. Rather, Applicant is selling catalogs that provide information regarding clothing and shoe styles. Those who buy Applicant's publications do not necessarily buy Applicant's clothing and footwear. Thus, Applicant's mark identifies Applicant's pamphlets or catalogs and distinguishes them from publications sold by others in the same manner that the marks SEARS, JCPENNEY or VICTORIA'S SECRET distinguish pamphlets or catalogs bearing those marks from products of others.

***That Applicant's Publications Show Products Offered for Sale Does Not Preclude Registration***

The fact that customers may order products advertised and displayed in publications sold by Applicant or others does not preclude issuance of registrations for marks used on these publications. In fact, the PTO has recognized on numerous prior occasions that a mark may be registered for publications displaying products offered for sale by the owner of the mark. Attached hereto as Exhibit B are but a few examples of the numerous registrations issued by the PTO for marks and goods of the same type used by Applicant.

Reg. No. 2,748,026 – SEARS CATALOG (“catalog” disclaimed) for catalogs featuring clothing, etc.

Reg. No. 3147476 – JCPENNEY HOME EDITION (“home edition” disclaimed) for a “catalog for home and household accessories.”

Reg. No. 1,908,042 – VICTORIA’S SECRET for mail order catalogs featuring clothing, etc.

The PTO has previously granted several registrations of this type to Applicant as well. For example, Applicant owns the following registrations, copies of which are attached hereto as Exhibit C.

Reg. No. 3357476 – MIA DE ANDREA for, among other things, printed catalogs in the field of women’s clothing etc.

Reg. No. 3518274 - COOL STAR – for a printed publication, namely, catalogues featuring footwear

Reg. No. 3415907 - FORASTERO for printed catalogs; informational flyers, and leaflets featuring footwear; and posters

In view of the foregoing, Applicant requests that its specimen be accepted, and that the mark be approved for registration.

GRUPO ANDREA, S.A. DE C.V.

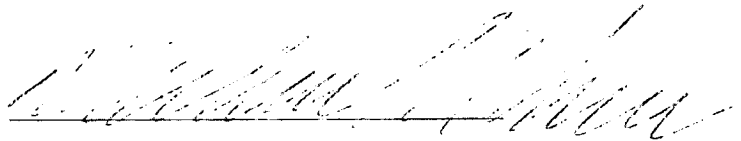
By 

Michael A. Grow  
Efrain Brito  
Arent Fox LLP  
1050 Connecticut Avenue, NW  
Washington, DC 20036  
(202) 857-6000

Attorney for Applicant

**CERTIFICATE OF MAILING**

It is hereby certified that the foregoing Request for reconsideration and exhibit (re S/N 77/045814) 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 January 20, 2010.



# **EXHIBIT A**



ANDREA  
En el nombre del ciseno®

Primavera Verano 2009

¡Te presentamos las opciones de paquetes  
que estabas esperando!

**3 Juegos de Catálogos  
de Calzado**

¡Recibe un  
vale Outlet por \$5.00!

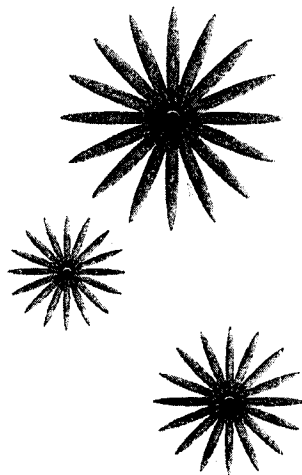
Adquiere tus

y

que **Andrea** te ofrece.

En la compra de cualquier paquete,  
te llevas la revista **ESTILO**  
de la temporada.

\*Hasta agotar existencias





Promociones válidas al 7 de febrero de 2009.  
Precios válidos sólo durante la preventa.

Elige el **paquete que más te convenga**  
o **adquiere tus catálogos en forma unitaria**  
y **aprovecha los excelentes descuentos**  
que tenemos para ti.



## Promociones de Preventa

¡Conoce **nuestros paquetes**  
y adquiere el que más  
te convenga!

### *Paquete* **Gana Más**

**3** Juegos de 8 Catálogos de Calzado  
**3** Catálogos Mía

**\$35.00**

Y Andrea te consiente con  
1 juego de 8 catálogos de calzado  
de \$6.00 cada uno.  
1 catálogo Andrea Rossi  
hasta agotar existencias.  
1 catálogo Mía de Andrea.

#### Precios de Catálogos al lanzamiento:

1 Juego de Catálogos de Calzado	\$15.00
1 Catálogo Andrea Rossi (hasta agotar existencia)	\$1.50
1 Catálogo Mía de Andrea	\$2.50

**FERRATO**  
Calzado para hombres

**FORSTERS**  
DE MÓJICO A TUS PIES.

**QUEX**

**TRAP**

**A Y**



# **EXHIBIT B**

Int. Cl.: 16

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, and 50

United States Patent and Trademark Office

Reg. No. 2,748,026

Registered Aug. 5, 2003

**TRADEMARK  
PRINCIPAL REGISTER**

**SEARS CATALOG**

SEARS, ROEBUCK AND CO. (NEW YORK CORPORATION)  
3333 BEVERLY ROAD  
HOFFMAN ESTATES, IL 60179

FOR: CATALOGS FEATURING CLOTHING, JEWELRY, FURNITURE, TOYS, FOOTWEAR, BEDDING, KITCHEN, BATH, AUTOMOTIVE, POWER AND HAND TOOLS, LAWN AND GARDEN, APPLIANCES, ELECTRONICS, AND RELATED ACCESSORIES FOR THE ABOVE-MENTIONED GOODS, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 7-0-2001; IN COMMERCE 7-0-2001.

OWNER OF U.S. REG. NOS. 1,529,006 AND 2,321,954.

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

SEC. 2(F).

SN 76-221,592, FILED 3-8-2001.

MICHAEL KEATING, EXAMINING ATTORNEY

Int. Cl.: 16

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38 and 50

Reg. No. 3,147,476

United States Patent and Trademark Office

Registered Sep. 26, 2006

TRADEMARK  
PRINCIPAL REGISTER

JCPENNEY HOME  
EDITION

J. C. PENNEY PRIVATE BRANDS, INC. (DELA-  
WARE CORPORATION)

LEGAL DEPT A1 MS: 1115

6501 LEGACY DRIVE

PLANO, TX 750243698

FOR: CATALOG FOR HOME AND HOUSEHOLD  
ACCESSORIES, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29,  
37, 38 AND 50).

FIRST USE 2-8-2004; IN COMMERCE 2-8-2004.

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

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

SER. NO. 78-374,307, FILED 2-26-2004.

ZACHARY BELLO, EXAMINING ATTORNEY

Int. Cls.: 3, 4, 9, 16, 20, 21, 22, 24, 25, 28 and 42

Prior U.S. Cls.: 1, 2, 4, 5, 6, 13, 15, 22, 23, 29, 30,  
32, 33, 36, 37, 38, 39, 40, 42, 50, 51, 52, 100 and 101 Reg. No. 1,908,042  
United States Patent and Trademark Office Registered Aug. 1, 1995

**TRADEMARK  
SERVICE MARK  
PRINCIPAL REGISTER**

**VICTORIA'S SECRET**

V SECRET CATALOGUE, INC. (DELAWARE CORPORATION)  
1105 NORTH MARKET STREET  
WILMINGTON, DE 19801

FOR: TOILET SOAPS, WASHING COMPOUNDS FOR USE WITH LINGERIE AND FINE WASHABLES, HAIR SHAMPOOS, SCENTED DRAWER SACHETS; PERSONAL FRAGRANCES, NAMELY COLOGNE, PERFUME, TOILET WATER, AND ESSENTIAL OILS FOR PERSONAL USE; BATH POWDER, NON-MEDICATED FOOT POWDER, AND BODY POWDER; AND PERSONAL CARE PREPARATIONS, NAMELY BATH, HAND AND BODY LOTIONS, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 6-12-1977; IN COMMERCE 6-12-1977.

FOR: CANDLES, IN CLASS 4 (U.S. CL. 15).

FIRST USE 6-12-1977; IN COMMERCE 6-12-1977.

FOR: PRERECORDED COMPACT DISCS AND AUDIO TAPES, BOTH FEATURING MUSIC, IN CLASS 9 (U.S. CL. 36).

FIRST USE 6-12-1977; IN COMMERCE 6-12-1977.

FOR: MAIL ORDER CATALOGS FEATURING CLOTHING, LINGERIE, AND TOILETRIES; BRIDAL GUEST BOOKS; CALENDARS, AND ADDRESS BOOKS, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 6-12-1977; IN COMMERCE 6-12-1977.

FOR: PICTURE FRAMES, HAND MIRRORS AND PILLOWS, IN CLASS 20 (U.S. CLS. 32 AND 50).

FIRST USE 6-12-1977; IN COMMERCE 6-12-1977.

FOR: PERFUME ATOMIZERS SOLD EMPTY; PERFUME BOTTLES SOLD EMPTY; NON-METAL DECORATIVE BOXES; HAIR COMBS AND HAIR BRUSHES; DECORATIVE TRAYS NOT OF PRECIOUS METAL; AND FLASKS SOLD EMPTY, IN CLASS 21 (U.S. CLS. 2, 13, 23, 29, 30, 33, 40 AND 50).

FIRST USE 6-12-1977; IN COMMERCE 6-12-1977.

FOR: MESH LINGERIE BAGS FOR WASHING LINGERIE AND CLOTH BAGS FOR LINGERIE STORAGE, IN CLASS 22 (U.S. CL. 2).

FIRST USE 6-12-1977; IN COMMERCE 6-12-1977.

FOR: WASH CLOTHS, TOWELS AND BEDDING, NAMELY COMFORTERS, PILLOW CASES, SHEETS, SHAMS, DUVETS, AND DUST RUFFLES, IN CLASS 24 (U.S. CL. 42).

FIRST USE 6-12-1977; IN COMMERCE 6-12-1977.

FOR: WOMEN'S AND MEN'S OUTERWEAR, UNDERWEAR AND NIGHTWEAR, NAMELY LINGERIE, ROBES, CAFTANS, KIMONOS, BOXER SHORTS, PAJAMAS, SHIRTS, PANTS, JEANS, DRESSES, SKIRTS, SWEATERS, JUMPSUITS, BODYSUITS, SWEATSHIRTS, JACKETS, T-SHIRTS, SCARVES, LEOTARDS, TIGHTS, SWIMSUITS, BEACH SHIRTS, HOSIERY, FOOTWEAR, IN CLASS 25 (U.S. CLS. 22 AND 39).

# **EXHIBIT C**

Int. Cls.: 16 and 25

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, 39, and 50

Reg. No. 3,357,476

United States Patent and Trademark Office

Registered Dec. 18, 2007

TRADEMARK  
PRINCIPAL REGISTER

*mia*  
de Andrea

GRUPO ANDREA, S.A. DE C.V. (MEXICO CORPORATION)  
BLVD. J. TORRES NO. 106  
FRACC. SAN JERONIMO  
LEON GTO, MEXICO 37148

FOR: PRINTED CATALOGS IN THE FIELD OF WOMEN'S CLOTHING AND UNDERWEAR; PRINTED STATIONERY; CARDBOARD BOXES; PRINTED ADVERTISING SIGNS OF PAPER OR CARDBOARD; PRINTED POSTERS; PRINTED CALENDARS; AND PAPER BAGS. IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 1-7-2006; IN COMMERCE 1-7-2006.

FOR: WOMEN'S WEARING APPAREL, NAMELY, NIGHTGOWNS, NEGLIGEEES, BATHING SUITS, BIKINIS, BRASSIERES, PAJAMAS, UNDERWEAR,

CORSETS AND BRAS. IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 1-7-2006; IN COMMERCE 1-7-2006.

OWNER OF U.S. REG. NOS. 2,740,879 AND 2,933,425.

THE NAME "MIA DE ANDREA" DOES NOT IDENTIFY A LIVING INDIVIDUAL.

THE MARK CONSISTS OF THE WORDS MIA DE ANDREA IN STYLIZED LETTERING.

SN 78-750,134, FILED 11-9-2005.

JEFF DEFORD, EXAMINING ATTORNEY

Int. Cls.: 16 and 25

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, 39, and 50

Reg. No. 3,518,274

United States Patent and Trademark Office

Registered Oct. 14, 2008

TRADEMARK  
PRINCIPAL REGISTER



GRUPO ANDREA S.A. DE C.V. (MEXICO CORPORATION)  
BLVD. JUAN ALONSO DE TORRES NO. 106, FRA  
CC. SAN JERONIMO;  
LEON, GUANAJUATO, C.P. 37204, MEXICO

FOR: PRINTED PUBLICATION, NAMELY, CATALOGS FEATURING FOOTWEAR, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 12-0-2006; IN COMMERCE 12-0-2006.

FOR: FOOTWEAR, NAMELY, SHOES, SHOE SOLES AND SHOE INSERTS FOR PRIMARILY

NON-ORTHOPEDIC PURPOSES. IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 12-0-2006, IN COMMERCE 12-0-2006.

OWNER OF U.S. REG. NO. 2,926,782.

THE MARK CONSISTS OF THE WORDS COOL STAR IN STYLIZED LETTERING AND A FLOWER DESIGN.

SN 78-784,613, FILED 1-4-2006.

SUE LAWRENCE, EXAMINING ATTORNEY



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**FORASTERO**

**Word Mark** FORASTERO  
**Translations** The foreign wording in the mark translates into English as "outsider".  
**Goods and Services** IC 016. US 002 005 022 023 029 037 038 050. G & S: Printed catalogs; informational flyers, and leaflets featuring footwear; and posters. FIRST USE: 20060800. FIRST USE IN COMMERCE: 20060800  
 IC 025. US 022 039. G & S: Footwear. FIRST USE: 20060800. FIRST USE IN COMMERCE: 20060800  
**Mark Drawing Code** (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM  
**Serial Number** 78797301  
**Filing Date** January 23, 2006  
**Current Filing Basis** 1A  
**Original Filing Basis** 1B  
**Published for Opposition** September 12, 2006  
**Registration Number** 3415907  
**Registration Date** April 22, 2008  
**Owner** (REGISTRANT) Grupo Andrea S.A. de C.V. CORPORATION MEXICO Blvd. Juan Alonso de Torres No. 106 Fracc. San Jeronimo Leon, Guanajuato, C.P. 37204 MEXICO



Attorney of Record Michael A. Grow  
Description of Mark Color is not claimed as a feature of the mark. The mark consists of the word "FORASTERO" in stylized lettering.  
Type of Mark TRADEMARK  
Register PRINCIPAL  
Live/Dead Indicator LIVE

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