

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Trademark Application of

**The Ritz Hotel**

Serial No.: 78/122,284

Filed: April 17, 2002

Mark: RITZ PARIS

Attorney: **Christine C. Blomquist**  
Law Office: **104**

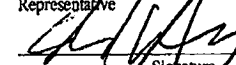
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September 22, 2010

(Date of Deposit)

Edward M. Weisz

Name of applicant, assignee or Registered Representative



Signature

September 22, 2010

Date of Signature

Box RESPONSES  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**RESPONSE TO FINAL OFFICE ACTION/WITH NOTICE OF APPEAL**

S I R:

This paper is submitted in response to the Office Action dated March 24, 2010 and is accompanied by a copy of a Notice of Appeal, the original of which is being submitted concurrently to the Trademark Trial and Appeal Aboard, and a Consent to Registration Agreement.

Applicant contends that the Examining Attorney should deem the enclosed Consent to Registration Agreement a sufficient and proper basis for withdrawal of the outstanding Section 1(d) refusal to register Applicant's mark, RITZ PARIS, over the cited registrations of RITZ, (Registration Nos. 2,288,326 and 3,333,061). Applicant and the owner of the cited registrations

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have long been concurrent registrants of their respective marks for a wide range of goods, and have encountered absolutely *no* evidence of actual confusion in the marketplace as between their respective goods. As expressly stated in the Consent to Registration Agreement submitted herewith, which has been executed by both parties, it is their considered judgment that confusion between their respective marks, for the goods of the application and cited registrations is *not* likely to occur.

Section 1207.01(d)(viii) of the Trademark Manual of Examining Procedure ("TMEP") makes it clear that such consent agreements are entitled to great weight and represent highly persuasive evidence on the question of confusing similarity between (and, thus, the concurrent registrability of) two marks.

"The examining attorney should give great weight to a proper consent agreement. The examining attorney should not interpose his or her own judgment concerning likelihood of confusion when an applicant and registrant have entered into a *credible* consent agreement and, *on balance*, the other factors do not dictate a finding of likelihood of confusion."

"The Court of Appeals for the Federal Circuit has made it clear that consent agreements should be given great weight, and that the USPTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other factors clearly dictate a finding of likelihood of confusion." [citations omitted]

The same Section of the TMEP additionally quotes the court's statement in *E.I. du Pont de Nemours, & Co.*, 476 F.2d 1357, 1363, 177 USPQ 563, 568 (C.C.P.A. 1973), that

"[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not."

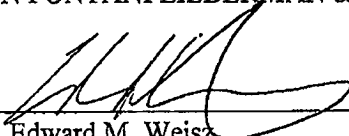
As such, Applicant believes and contends that, in view of the enclosed Consent to Registration Agreement in which the owner of the cited Section 2(d) registrations, and Applicant herein, have agreed that their respective marks for their respective goods are not likely to be confused, and have further agreed that in the event of any actual confusion in the marketplace, the parties will "cooperate and take further action to eliminate the cause of such confusion in a timely, responsible and commercially appropriate manner", the Section 2(d) refusal to register Applicant's RITZ PARIS mark over the cited registrations of RITZ should properly be withdrawn.

In the event that any fees or charges are required at this time in connection with this appeal or the instant request for suspension, or otherwise in connection with Applicant's application, such fees or charges may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Withdrawal of the Section 2(d) refusal of the subject application, and prompt passage of Applicant's mark to publication in the Official Gazette, are accordingly solicited.

Respectfully submitted,  
COHEN PONTANI LIEBERMAN & PAVANE LLP

By

  
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Dated: September 22, 2010

## CONSENT TO REGISTRATION

SHEN MANUFACTURING COMPANY, INC., a Pennsylvania corporation having a place of business at 40 Portland Road, West Conshohocken, Pennsylvania 19428 ("Registrant"), which is the owner of U.S. Trademark Registration No. 2,288,326 issued Oct. 26, 1999 of the mark "RITZ" for "laundry bags" in International Class 022 and for "dish cloths, kitchen towels, bathroom towels, ironing board pads and covers, toaster covers, place mats, napkins, pot holders, oven mitts, and barbecue mitts" in International Class 024, and of U.S. Trademark Registration No. 3,333,061 issued November 13, 2007 of the mark "RITZ" for "ironing board pads and covers" in International Class 021, for "tablecloths and beach towels" in International Class 024, and for "bathrobes" in International Class 025 (collectively "Registrant's Registrations" of "Registrant's Marks" for "Registrant's Goods"), hereby expressly and in good faith consents to registration in the United States of the mark "RITZ PARIS" ("Applicant's Mark"), which is the subject of pending U.S. Trademark Application Serial No. 78/122,284, filed April 17, 2002, of THE RITZ HOTEL, LIMITED ("Applicant"), for "covers for cushions; bed linens; blankets; throws; bedspreads" in International Class 024 ("Applicant's Goods").

Registrant's consent is based on Registrant's good faith belief that Registrant's Marks for Registrant's Goods are not likely to be confused with Applicant's Mark for Applicant's Goods, and *vice versa*, at least because of the differences in fact between Registrant's Marks and Applicant's Mark, the differences in the ways in which Registrant's and Applicant's respective goods are and/or will be marketed and sold under their respective marks, and the ways in which the public and intended purchasers of Registrant's and Applicant's respective goods naturally view and differentiate the respective marks and the respective goods of Registrant and Applicant as to source or origin based, at least in part, on the ways in which Registrant's and Applicant's respective goods are and/or will be marketed and sold.

Registrant and Applicant have further agreed that in the event that any confusion unexpectedly occurs among the public, Registrant and Applicant will cooperate and undertake further action to eliminate the cause of such confusion in a timely, responsible and commercially appropriate manner and to carry out the spirit and intent of this Consent to Registration Agreement.

Shen Manufacturing Company, Inc.

Dated: September 9, 2010

By: 

Name: Robert M. Steidle  
Title: Vice President

THE RITZ HOTEL, LIMITED

Dated: September 15, 2010

By: 

Frank Klein  
President