

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85184163
LAW OFFICE ASSIGNED	LAW OFFICE 105
MARK SECTION (no change)	
ARGUMENT(S)	
<p>I. <u>Amendment to the Identified Goods</u></p> <p>Please delete all of the class 25 goods. Namely, please delete: “Motorcycle clothing and apparel, namely, motorcycle gloves, motorcycle pants, motorcycle boots, and motorcycle jackets.”</p> <p>Please amend the classification of goods currently listed in class 18 (Luggage specially adapted for use on motorcycles) to class 12.</p> <p>II. <u>Likelihood of Confusion Under 15 U.S.C. §1052(d) over Reg. No. 3,943,095</u></p> <p>Applicants’ mark has been found confusingly similar under §2(d) to U.S. Reg. No. 3,943,095 for the mark “VITTORIA SEDICI” used on:</p> <p>CLOTHING, NAMELY, UNDERWEAR, CHEMISES, CAMISOLES, UNDERSHIRTS, UNDERPANTS, T-SHIRTS, SPORT-JERSEYS, SPORT-SHIRTS, TROUSERS, JEANS, SHORTS, TRACKSUITS, BATHING SUITS, BATH ROBES, PAJAMAS, COATS, OVERCOATS, RAINCOATS, WAISTCOATS, JACKETS, HEAVY-JACKETS, KNITWEAR, NAMELY, KNIT DRESSES, KNIT FACE MASKS, KNIT TOPS, SWEATERS, PULLOVERS, SWEATSHIRTS, SHIRTS, BLOUSES, OVERALLS, DRESSES, SKIRTS, SUITS, SPORTS SUITS, STOCKINGS, SOCKS, TIGHTS, SUSPENDERS, TIES, GLOVES, SHOULDER WRAPS, SHAWLS, VEILS, SCARVES, FOULARDS, NECKERCHIEFS AND POCKET KERCHIEFS; HEADGEAR, NAMELY, HATS, CAPS, SWEAT BANDS, HEADBANDS, VISORS, BANDANNAS; WAIST BELTS, SASHES FOR WEAR, CLOTHING ITEMS, NAMELY, ADHESIVE POCKETS THAT MAY BE AFFIXED DIRECTLY TO THE INSIDE OF CLOTHING FOR STORAGE AND SAFEKEEPING OF PERSONAL ITEMS; FOOTWEAR.</p> <p>Applicants have deleted the class 25 goods (Motorcycle clothing and apparel, namely, motorcycle gloves, motorcycle pants, motorcycle boots, and motorcycle jackets) from the application.</p> <p>Applicants have canceled the recitation of clothing and apparel in the hope that the remaining</p>	

goods relating to motorcycle helmets and motorcycle luggage will be allowed.

In particular, it is respectfully submitted that there would be no confusion between clothing on the one hand, and motorcycle helmets and motorcycle luggage on the other. Regarding the internet websites submitted by the Examining Attorney, only some of those websites show motorcycle helmets, and only some of those websites show motorcycle luggage. It is respectfully submitted that those websites that do show helmets and/or luggage only show motorcycle clothing.

Given the nature of the websites showing motor cycle helmets and luggage, and given the nature of the prior registrant's clothing, it is respectfully submitted that a consumer would not be confused into believing applicant's motorcycle helmets and clothing are those of the prior registrant.

The prior registrant uses the mark on high end clothing such as cashmere. Attached hereto is a screenshot from the Vittoria Sedici website. Additionally, the owner of the mark, MAGLIFICIO ROSSELLA DI SPREAFICO ROSSELLA, has a website under which it sells its goods such as those under the Vittoria Sedici mark: <http://www.maglificiorossella.it>. Applicants respectfully invite the Examiner Attorney to visit that website. It is clear from the look and feel of that website consumers for the registrants goods would not confuse those goods with those of applicants.

Applicants also respectfully submit that the sight sound and appearance of the respective marks would do not support a finding of confusing similarity on the grounds set forth in the prior response. Moreover, applicants note that the registrant's mark is a stylized mark. Applicant's mark is different in at least appearance on these grounds alone.

Re-classification of Goods

Pursuant to the Examiner's instructions, we have amended the classification of the goods currently listed in class 18 (Luggage specially adapted for use on motorcycles) to class 12. However, applicants maintain that that the goods "Luggage specially adapted for use on motorcycles" is properly classified in class 18. As noted in the prior response, TMEP §1401 sets forth the following description of goods for International Classes 12 and 18:

CLASS 12 (Vehicles)

Vehicles; apparatus for locomotion by land, air or water.

Explanatory Note

Includes, in particular:

- motors and engines for land vehicles;
- couplings and transmission components for land vehicles;
- air cushion vehicles.

Does not include, in particular:

- certain parts of vehicles (consult the Alphabetical List of Goods);
- railway material of metal (Cl. 06);
- motors, engines, couplings and transmission components other than for land vehicles (Cl. 07);
- parts of motors and engines (of all kinds) (Cl. 07).

As such, International Class 12 appears to be limited to machinery associated with vehicles.

On the other hand, International Class 18 sets forth:

CLASS 18
(Leather goods)

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Explanatory Note

This class includes mainly leather, leather imitations, travel goods not included in other classes and saddlery.

Does not include, in particular:

- clothing, footwear, headgear (consult the Alphabetical List of Goods).

Thus, it would appear that “luggage specially adapted for use on motorcycles” is appropriate to International Class 18.

Based on the amendments, it is respectfully requested that the present application be allowed. Applicants will concurrently file a Notice of Appeal for the remaining goods in International Classes 9 and 12.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this Response.

Respectfully submitted,

Date: October 30, 2012

By: /Brian I. Marcus/

Brian I. Marcus
Reg. No. 34,511

Vierra Magen Marcus & DeNiro LLP
685 Market Street, Suite 540
San Francisco, California 94105
(415) 369-9660 ext. 203

GOODS AND/OR SERVICES SECTION (009)(no change)

GOODS AND/OR SERVICES SECTION (018)(class deleted)

INTERNATIONAL CLASS

018

DESCRIPTION

Luggage specially adapted for use on motorcycles

FILING BASIS

Section 1(b)

GOODS AND/OR SERVICES SECTION (012)(class added)Original Class (018)

INTERNATIONAL CLASS

012

DESCRIPTION

Luggage specially adapted for use on motorcycles

FILING BASIS

Section 1(b)

GOODS AND/OR SERVICES SECTION (025)(class deleted)

INTERNATIONAL CLASS	025
DESCRIPTION	
Motorcycle clothing and apparel, namely, motorcycle gloves, motorcycle pants, motorcycle boots, and motorcycle jackets	
FILING BASIS	Section 1(b)
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Brian I. Marcus/
SIGNATORY'S NAME	Brian I. Marcus
SIGNATORY'S POSITION	Attorney of record, CA bar member
SIGNATORY'S PHONE NUMBER	415-369-9660
DATE SIGNED	10/30/2012
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Oct 30 19:34:53 EDT 2012
TEAS STAMP	USPTO/RFR-50.59.14.154-20 121030193453713304-851841 63-490319a67d05714bd40a22 9f6573efb2215-N/A-N/A-201 21030193141143692

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85184163** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

I. Amendment to the Identified Goods

Please delete all of the class 25 goods. Namely, please delete: “Motorcycle clothing and apparel, namely, motorcycle gloves, motorcycle pants, motorcycle boots, and motorcycle jackets.”

Please amend the classification of goods currently listed in class 18 (Luggage specially adapted for use on motorcycles) to class 12.

II. Likelihood of Confusion Under 15 U.S.C. §1052(d) over Reg. No. 3,943,095

Applicants' mark has been found confusingly similar under §2(d) to U.S. Reg. No. 3,943,095 for the mark "VITTORIA SEDICI" used on:

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Applicants have deleted the class 25 goods (Motorcycle clothing and apparel, namely, motorcycle gloves, motorcycle pants, motorcycle boots, and motorcycle jackets) from the application.

Applicants have canceled the recitation of clothing and apparel in the hope that the remaining goods relating to motorcycle helmets and motorcycle luggage will be allowed.

In particular, it is respectfully submitted that there would be no confusion between clothing on the one hand, and motorcycle helmets and motorcycle luggage on the other. Regarding the internet websites submitted by the Examining Attorney, only some of those websites show motorcycle helmets, and only some of those websites show motorcycle luggage. It is respectfully submitted that those websites that do show helmets and/or luggage only show motorcycle clothing.

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This class includes mainly leather, leather imitations, travel goods not included in other classes and saddlery.

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Thus, it would appear that "luggage specially adapted for use on motorcycles" is appropriate to International Class 18.

Based on the amendments, it is respectfully requested that the present application be allowed. Applicants will concurrently file a Notice of Appeal for the remaining goods in International Classes 9 and 12.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this Response.

Respectfully submitted,

Date: October 30, 2012

By: /Brian I. Marcus/

Brian I. Marcus
Reg. No. 34,511

Vierra Magen Marcus & DeNiro LLP
685 Market Street, Suite 540
San Francisco, California 94105
(415) 369-9660 ext. 203

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant hereby deletes the following class of goods/services from the application.

Class 018 for Luggage specially adapted for use on motorcycles

Applicant hereby deletes the following class of goods/services from the application.

Class 025 for Motorcycle clothing and apparel, namely, motorcycle gloves, motorcycle pants, motorcycle boots, and motorcycle jackets

Applicant hereby adds the following class of goods/services to the application:

New: Class 012 (Original Class: 018) for Luggage specially adapted for use on motorcycles

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Brian I. Marcus/ Date: 10/30/2012

Signatory's Name: Brian I. Marcus

Signatory's Position: Attorney of record, CA bar member

Signatory's Phone Number: 415-369-9660

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 applicant'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 applicant in this matter: (1) the applicant 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 applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant'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 filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85184163

Internet Transmission Date: Tue Oct 30 19:34:53 EDT 2012

TEAS Stamp: USPTO/RFR-50.59.14.154-20121030193453713

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