

T DAB

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

AMERICAN HONDA MOTOR CO. INC.,)

Opposer,)

v.)

Opposition No. 121,151

TBC CORPORATION,)

Applicant.)



03-15-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #78

NOTICE OF RELIANCE

Pursuant to Rule 2.122(e), Applicant hereby gives its Notice of Reliance on the following records of the U.S. Patent and Trademark Office ("PTO"):

Application/registration file for U.S. trademark registration no. 2,282,187,
Applicant's Exhibit 18;

Application/registration file for U.S. trademark registration no. 2,363,335,
Applicant's Exhibit 19;

Application/registration file for U.S. trademark registration no. 2,285,785,
Applicant's Exhibit 20;

Application/registration file for U.S. trademark registration no. 2,582,475,
Applicant's Exhibit 21;

Application file for application serial no. 78/359,569, Applicant's Exhibit 22;

Application file for application serial no. 76/306,798, Applicant's Exhibit 23;

Application file for application serial no. 76/351,833, Applicant's Exhibit 24;

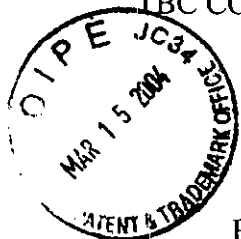
U.S. registration no. 2,637,198, Applicant's Exhibit 25;

U.S. registration no. 2,792,453, Applicant's Exhibit 26;

U.S. registration no. 1,355,210, Applicant's Exhibit 27;

U.S. registration no. 2,482,400, Applicant's Exhibit 28;

U.S. registration no. 2,439,088, Applicant's Exhibit 29;



U.S. registration no. 1,276,878, Applicant's Exhibit 30;

U.S. registration no. 1,848,178, Applicant's Exhibit 31;

U.S. registration no. 1,277,972, Applicant's Exhibit 32;

U.S. registration no. 1,276,876, Applicant's Exhibit 33;

U.S. registration no. 1,489,233, Applicant's Exhibit 34;

Cancellation no. 26,171 American Honda Motor Co., Inc. v. Warnaco, Inc.,
Applicant's Exhibit 35.

The foregoing PTO records are relevant to the issues of alleged likelihood of confusion and dilution.

Subject to its objections on grounds of relevancy and otherwise as to admissibility, if and only if Opposer's Exhibit 1 to its January 14, 2004 Notice of Reliance is admitted into evidence in this opposition, Applicant gives notice of its reliance on the following *additional* records for Opposition No. 91125235, omitted (although long previously filed) from Opposer's Exhibit 1.

June 10, 2003 TTAB Order; Applicant's Motion to Suspend; September 20,
2003 TTAB Order suspending opposition, Applicant's Exhibit 36.

These documents are submitted to correct and complete the record regarding this file, bearing on the issue of the significance, relevance, and/or probative weight, if any, of Opposer's January 14, 2004 Notice of Reliance and the exhibits submitted therewith.

Respectfully submitted,

TBC CORPORATION

BY:



Marsha G. Gentner
JACOBSON HOLMAN PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004
(202) 638-6666

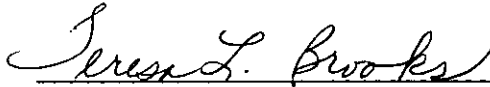
Date: March 15, 2004

ATTORNEYS FOR APPLICANT

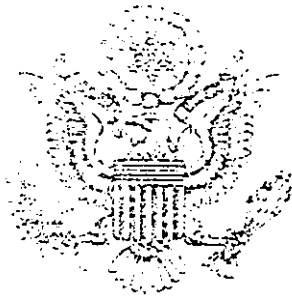
CERTIFICATE OF SERVICE

I hereby certify that on the 15th day of March, 2004, a copy of the foregoing NOTICE OF RELIANCE was served on Opposer by mailing same, first class and postage pre-paid, to the following counsel:

Anthony L. Fletcher, Esquire
Stacy J. Grossman, Esquire
Fish and Richardson, P.C.
45 Rockefeller Plaza
Suite 2800
New York, New York 10111



The United States of America



CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office, that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks, and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are a part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



L. Todd Pichman

Acting Commissioner of Patents and Trademarks

APPLICANT'S
EXHIBIT

18

HON 000015

Maintenance Requirements

Section 8: This registration will be cancelled after six (6) years by the Commissioner of Patents and Trademarks, *UNLESS, before the end of the sixth year following the date of registration shown on this certificate*, the registrant files in the U.S. Patent and Trademark Office an affidavit of continued use as required by Section 8 of the Trademark Act of 1946, 15 U.S.C. §1058, as Amended. **It is recommended that the Registrant contact the Patent and Trademark Office approximately five years after the date shown on this registration to determine the requirements and fees for filing a Section 8 affidavit that are in effect at that time.** Currently a fee and a specimen showing how the mark is used in commerce are required for *each* international class of goods and/or services identified in the certificate of registration and both must be enclosed with the affidavit.

Section 9: This registration will expire by law after ten (10) years, *UNLESS, before the end of the tenth year following the date of registration shown on this certificate*, the registrant files in the U.S. Patent and Trademark Office an application for renewal of the registration as required by Section 9 of the Trademark Act of 1946, 15 U.S.C. §1059, as Amended. **It is recommended that the Registrant contact the Patent and Trademark Office approximately nine years after the date shown on this registration to determine the requirements and fees for filing a Section 9 application for renewal that are in effect at that time.** Currently a fee and a specimen showing how the mark is used in commerce are required for *each* international class of goods and/or services identified in the certificate of registration and both must be enclosed with the application for renewal.

UNITED STATES DEPARTMENT OF COMMERCE
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513
Aug 19, 1999

NOTICE OF ACCEPTANCE OF STATEMENT OF USE

DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD LLP
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

TM109

ATTORNEY
REFERENCE NUMBER:

21929-213

SERIAL NUMBER: 75/976238
MARK: SHADOW AMERICAN CLASSIC EDITION
OWNER: HONDA GIKEN KOGYO

The statement of use filed in regard to the above-identified application has been accepted. This acceptance signifies that the statement of use is accepted in all respects and that the mark is entitled to be registered. Accordingly, the registration will issue in due course barring any extraordinary circumstances.

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Box ITU - FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: David N. Makous, Reg. 29,559

Date Mailed: 5/25/99

Express Mail No. EF 740 580 157 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
Honda Giken Kogyo Kabushiki)	
Kaisha (Honda Motor Co., Ltd.))	
Serial No. 75/976238)	
Filed: April 2, 1996)	
Int'l Classes: 14, 18)	
Mark: SHADOW AMERICAN)	Docket No. 21929-213
CLASSIC EDITION)	

Assistant Commissioner of Patents and Trademarks
Box ITU - FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

STATEMENT OF USE UNDER
37 C.F.R. 2.88 WITH DECLARATION

Applicant, Honda Giken Kogyo Kabushiki Kaisha, requests registration of the above-identified trademark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. § 1051 et seq., as amended).

Applicant is using the mark in commerce in connection with the goods identified in the Notice of Allowance dated June 2, 1998, issued relative to this application.

The mark was first used with the goods in International Class 14 at least as early as November 1995; was first used in interstate commerce at least as early as April 1996; and is now in use in such commerce with these goods.

The trademark is used with the goods in International Class 14 by placing the mark on advertisements, marketing and promotional materials, and in other ways customary in the trade. Three (3) specimens showing the mark as used in International Class 14 in commerce is submitted with this Statement of Use.

The mark was first used with the goods in International Class 18 at least as early as June 1995; was first used in interstate commerce at least as early as June 1995; and is now in use in such commerce with these goods.

The trademark is used with the goods in International Class 18 by placing the mark on the goods, and in other ways customary in the trade. Three (3) specimens showing the mark as used in International Class 18 in commerce are submitted with this Statement of Use.

Please acknowledge receipt of our Statement of Use by affixing hereon the
Patent and Trademark Office date stamp and return this card to our office.
In re application of:

Mark:	SHADOW AMERICAN CLASSIC EDITION
Applicant:	Honda Giken Kogyo Kabushiki Kaisha
Int'l. Classes:	14, 28
Our File No.:	21929-213
Mailed:	May 25, 1999

99LA-48290.1

HON 000020

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

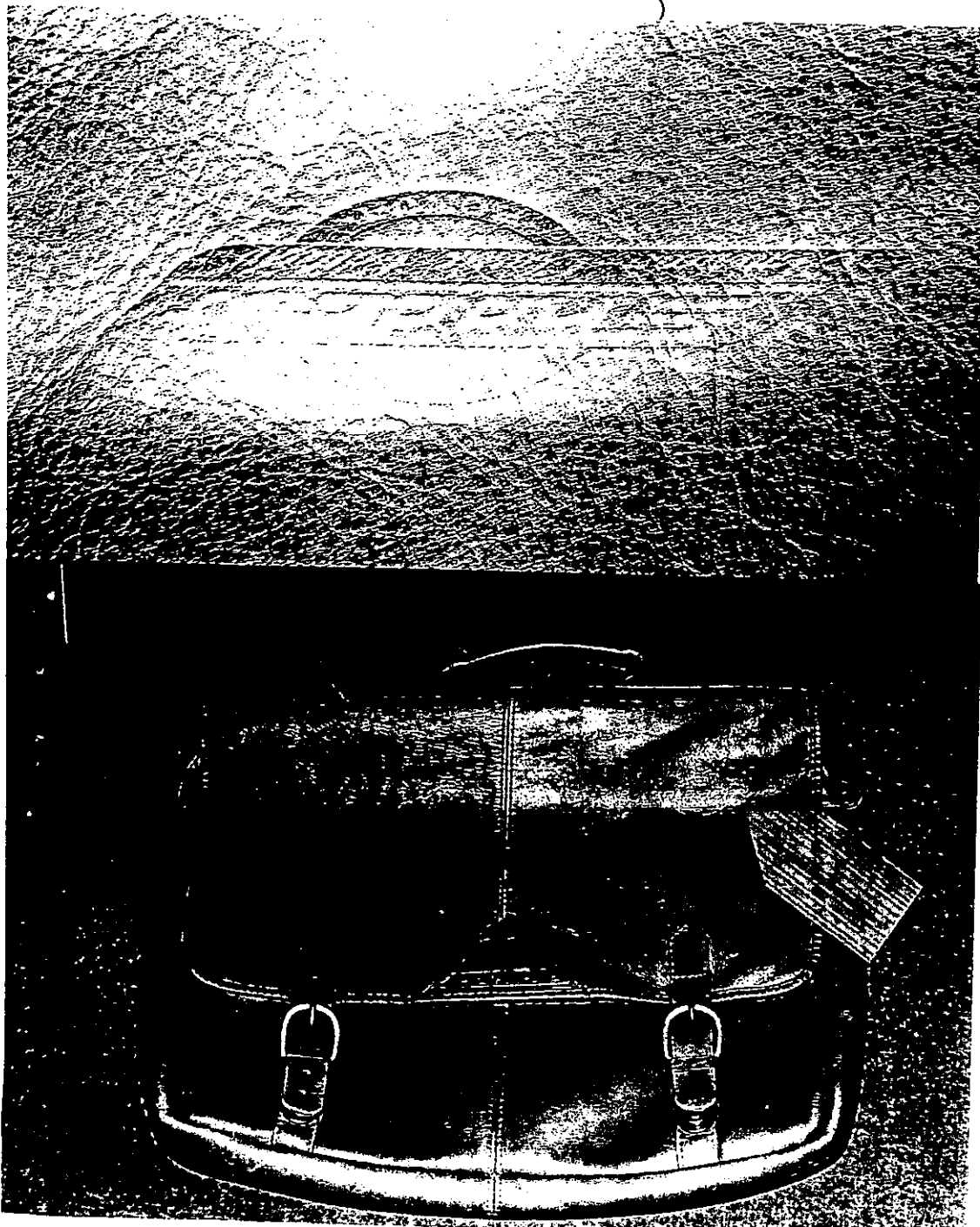
Applicant: Honda Giken Kogyo)
Kabushiki Kaisha)
(Honda Motor Co.,)
Ltd.))

Serial No.: 75/076238

Filed: April 2, 1996

Int'l Classes: 14, 18

Mark: SHADOW AMERICAN
CLASSIC EDITION



HON 000021

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Honda Giken Kogyo)
Kabushiki Kaisha)
(Honda Motor Co.,)
Ltd.))

Serial No.: 75/276238)

Filed: April 2, 1996)

Int'l Classes: 14, 18)

Mark: SHADOW AMERICAN
CLASSIC EDITION)



(Specimen Int'l Class 14)

LEWIS, D'AMATO, BRISBOIS & WISGARD

COST ADVANCE TICKET
CHECK REQUEST

No 101679

1. ☒ Check—date needed 5-13-99

2. ☐ Direct expense—

150

151

152

153

☐ Overtime Dinner
Reimbursement

☐ Mileage

☐ Miscellaneous

☒ Filing Fee

154

155

157

☐ Witness Fee

☐ Deposition

☐ Reproduction

☐ Firm expense

Acct. use — G. L. No.

CLASSIC EDITION ☐ Client's advance check

3. Client and file name Honda Trademark: SHADOW AMERICAN

Client and matter No.: 21929-110

4. Payee or vendor: Assistant Commissioner of Patents & Trademarks

Amount \$ 300.00

5. Mailing address (if applicable): 2900 Crystal Drive, Arlington VA 22202

6. Reference on remittance advice: Filing fee re Statement of Use for SHADOW AMERICAN CLASSIC EDITION

7. Explanation for billing purposes:

"

"

"

"

"

"

"

"

8. Disposition of check

☐ Mail

Auth. by Marga Una Vanzandt

Name

Number

Signature

Date 5/12/99

☒ Return to Marga

Instructions:

(1) Original to date processing/numeric copy

(2) Second copy (yellow) attached to invoice to accounting

(3) Third copy (pink) retain in attorney's file

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

ATTORNEYS

221 NORTH FIDELITY STREET

SUITE 1200

LOS ANGELES, CALIFORNIA 90012

(213) 250-1800

This document is printed with a void background and
artificial watermark on the reverse. Hold at angle to view.

LOS ANGELES DOWNTOWN
REGIONAL OFFICE
IMPERIAL BANK
LOS ANGELES, CALIFORNIA 90012

CHECK NO.

DATE 05/13/99

189131

PAY

\$*****200 DOLLARS AND 00/100***

ASSISTANT COMMISSIONER OF
PATENT & TRADEMARK
BOX 170
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513

TO THE
ORDER
OF

DRAFT VOID 180 DAYS FROM DATE ISSUED

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

\$ *****200.00

⑈189131⑈ ⑆122201444⑆ ⑈07⑈098 723⑈

HON 000024

POST OFFICE TO ADDRESSEE



EF740580157US

MAILING COPY

INTERNATIONAL SHIPMENTS ONLY <input type="checkbox"/> Business Papers <input type="checkbox"/> Merchandise <small>Customs forms and commercial invoice may be required. See Pub 273 and International Mail Manual</small>		DELIVERY (POSTAL USE ONLY) Delivery Attempt Mo. Day Time AM PM Employee Signature Delivery Attempt Mo. Day Time AM PM Employee Signature Date of Delivery Mo. Day Time AM PM Employee Signature Signature of Addressee or Agent Name - Please Print	
CUSTOMER USE ONLY P.O. ZIP Date in Mo. Day Yr. Time in AM PM Weight No. Delivery Day of Delivery <input type="checkbox"/> Next <input type="checkbox"/> Second <input type="checkbox"/> Flat Rate Envelope Postage Return Receipt C.O.D. Total Postage & Fees		<input type="checkbox"/> WARRANTY OF SIGNATURE (Domestic Only) I warrant delivery to the person named, or to the person named as addressee or the addressee's agent (if in the judgment of the delivery employee the article can be delivered at a secure location) and I authorize the delivery employee to sign that the shipment was delivered and understand that the signature of the delivery employee will constitute valid proof of delivery. <input type="checkbox"/> NO DELIVERY <input type="checkbox"/> WEEKEND <input type="checkbox"/> HOLIDAY	

METHOD OF PAYMENT: Express Mail Corporate Acct. No. Federal Agency Acct. No. or Postal Service Acct. No.		FROM: (PLEASE PRINT) David N. Makous, Esq. Lewis, D'Amato, Bratisbois & Bisgaard 221 N. Figueroa St., Ste. 1200 Los Angeles, CA 90012	
TO: (PLEASE PRINT) Assistant Commissioner of Patents and Trademarks BOX 110- FEE 2900 Crystal Drive Arlington, VA 22202-3513		PHONE 21929-110 and 21929-213	

PLEASE PRESS HARD

YOU ARE MAKING 3 COPIES

LABEL 11-B 11/93

For Pickup or Tracking Call 1-800-222-1811

HON 000025

Please acknowledge receipt of our Statement of Use by affixing hereon the
Patent and Trademark Office date stamp and return this card to our office.
In re application of:

Mark:

SHADOW AMERICAN CLASSIC EDITION
Honda Giken Kogyo Kabushiki Kaisha

Applicant:

14, 28

Int'l. Classes:

21929-213

Our File No.:

May 25, 1999

Mailed:



05-26-1999

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #54

99LA-48290.1

HON 000026

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

SAN DIEGO OFFICE
SUITE 800
550 WEST "C" STREET
SAN DIEGO, CALIFORNIA 92101-3540
TELEPHONE (619) 233-1006

COSTA MESA OFFICE
SUITE 1400
650 TOWN CENTER DRIVE
CENTER TOWER BUILDING
COSTA MESA, CALIFORNIA 92626-1925
TELEPHONE (714) 545-9200

SAN FRANCISCO OFFICE
SUITE 1900
601 CALIFORNIA STREET
SAN FRANCISCO, CALIFORNIA 94108-2805
TELEPHONE (415) 362-2580

MARGA UMA VANZANDT
DIRECT DIAL (213) 680-6048
E-MAIL: VANZANDT@LD88.COM

LAWYERS
SUITE 1200
221 NORTH FIGUEROA STREET
LOS ANGELES, CALIFORNIA 90012-2601

TELEPHONE (213) 250-1800
TELEX: 194508

May 24, 1999

INLAND EMPIRE OFFICE
TRI-CITY CORPORATE CENTRE
SUITE 600
650 EAST HOSPITALITY LANE
SAN BERNARDINO, CALIFORNIA 92408-3508
TELEPHONE (909) 387-1130

SACRAMENTO OFFICE
SUITE 200
2500 VENTURE OAKS WAY
SACRAMENTO, CALIFORNIA 95833-3500
TELEPHONE (916) 564-5400

FACSIMILES:
LOS ANGELES: (213) 250-7900
SAN DIEGO: (619) 233-8627
COSTA MESA: (714) 850-1030
SAN FRANCISCO: (415) 434-0882
SAN BERNARDINO: (909) 387-1138
SACRAMENTO: (916) 564-5444

VIA EXPRESS MAIL

Assistant Commissioner of Patents
and Trademarks
Box Trademark Application
2900 Crystal Drive
Arlington, Virginia 22202-3513

Dear Sir or Madam:

Enclosed please find: (1) Amendment to Delete Goods,
and return postcard; and (2) a Statement of Use, a check for the
filing fee, and a return postcard, for the following trademark
application:

Applicant:	Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.)
Mark:	SHADOW AMERICAN CLASSIC EDITION
Classes:	14, 18
Docket No.:	21929-213
Filing Fee:	\$200

Please date stamp the postcards and return to our
office upon receipt of this correspondence.

Very truly yours,

Marga Uma VanZandt

Marga Uma VanZandt
Paralegal to David N. Makous, of
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

Enclosures

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Box ITU, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: David N. Makous
David N. Makous, Reg. 29,559

Date Mailed: 5/25/99

Express Mail No. EF 740 580 15745

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
Honda Giken Kogyo Kabushiki)	
Kaisha (Honda Motor Co., Ltd.)	
Serial No. 75/976238)	
Filed: April 2, 1996)	
Int'l Classes: 18, 26)	
Mark: SHADOW AMERICAN)	Docket No. 21929-213
CLASSIC EDITION)	

Assistant Commissioner of Patents and Trademarks
Box ITU
2900 Crystal Drive
Arlington, Virginia 22202-3513

AMENDMENT TO DELETE GOODS
UNDER 37 C.F.R. § 2.77

Pursuant to 37 C.F.R. § 2.77, Applicant Honda Giken Kogyo Kabushiki Kaisha amends the identification of goods cited in the Notice of Allowance dated July 29, 1997, to delete goods as follows:

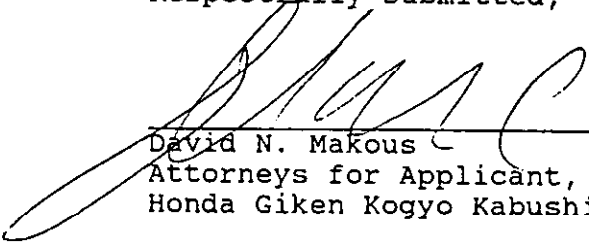
In International Class 18, delete "wallets, purses, keyfobs, fannypacks, cases, billfolds, and backpacks" from the identification of goods. The resulting identification of goods is as follows:

Int'l Class 18: "Leather goods, namely, bags."

In International Class 26, for "fancy goods, namely belt buckles and patches for clothing," please delete the entire class from this application.

Respectfully Submitted,

Dated: May 12, 1999



David N. Makous
Attorneys for Applicant,
Honda Giken Kogyo Kabushiki Kaisha

David N. Makous, Esq.
LEWIS, D'AMATO, BRISBOIS & BISGAARD
221 North Figueroa Street, Suite 1200
Los Angeles, California 90012
Telephone No. (213) 250-1800
Facsimile No. (213) 250-7900

Please acknowledge receipt of our Amendment to Delete Goods by affixing hereon the Patent and Trademark Office date stamp and return this card to our office. In re application of:

Mark: SHADOW AMERICAN CLASSIC EDITION
Applicant: Honda Giken Kogyo Kabushiki Kaisha
Int'l. Classes: 14, 28
Our File No.: 21929-213
Mailed: May 25, 1999



05-26-1999

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #54

007 A-28702 1

HON 000030

UNITED STATES DEPARTMENT OF COMMERCE
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513
Dec 23, 1998

NOTICE OF APPROVAL OF EXTENSION REQUEST

DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD LLP
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

TM109

ATTORNEY
REFERENCE NUMBER:

21929-213
PTO

SERIAL NUMBER: 75/976238
MARK: SHADOW AMERICAN CLASSIC EDITION
OWNER: HONDA GIKEN KOGYO
EXTENSION REQUEST NUMBER: 1

NOTICE OF ALLOWANCE DATE: Jun 9, 1998

THE ABOVE NUMBERED EXTENSION REQUEST FOR FILING A STATEMENT OF USE HAS BEEN APPROVED BY THIS OFFICE.

THE APPLICANT HAS UNTIL Jun 9, 1999 TO FILE A STATEMENT OF USE OR ANOTHER EXTENSION REQUEST. THE APPLICANT CAN FILE A TOTAL OF FIVE EXTENSION REQUESTS NOT TO EXCEED 36 MONTHS FROM THE NOTICE OF ALLOWANCE DATE.

IF THERE ARE ANY QUESTIONS REGARDING THIS NOTICE, PLEASE CONTACT THE TRADEMARK ASSISTANCE CENTER AT (703)308-9000.

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

SAN DIEGO OFFICE

SUITE 800
550 WEST "C" STREET
SAN DIEGO, CALIFORNIA 92101-3540
TELEPHONE (619) 233-1006

COSTA MESA OFFICE

SUITE 1400
850 TOWN CENTER DRIVE
CENTER TOWER BUILDING
COSTA MESA, CALIFORNIA 92626-1925
TELEPHONE (714) 545-9200

SAN FRANCISCO OFFICE

SUITE 1900
601 CALIFORNIA STREET
SAN FRANCISCO, CALIFORNIA 94108-2805
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LAWYERS

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221 NORTH FIGUEROA STREET
LOS ANGELES, CALIFORNIA 90012-2601
TELEPHONE (213) 250-1800
TELEX: 194508

INLAND EMPIRE OFFICE

TRI-CITY CORPORATE CENTRE
SUITE 600
650 EAST HOSPITALITY LANE
SAN BERNARDINO, CALIFORNIA 92408-3508
TELEPHONE (909) 387-1130

SACRAMENTO OFFICE

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2500 VENTURE OAKS WAY
SACRAMENTO, CALIFORNIA 95833-3500
TELEPHONE (916) 564-5400

FACSIMILES:

LOS ANGELES: (213) 250-7900
SAN DIEGO: (619) 233-8627
COSTA MESA: (714) 850-1030
SAN FRANCISCO: (415) 434-0882
SAN BERNARDINO: (909) 387-1138
SACRAMENTO: (916) 564-5444

December 1, 1998

MARGA UMA VANZANDT
DIRECT DIAL (213) 680-6048
E-MAIL: VANZANDT@LD88.COM

EF740588460US

VIA U.S. EXPRESS MAIL

Assistant Commissioner of Patents
and Trademarks
Box ITU
2900 Crystal Drive
Arlington, Virginia 22202-3513

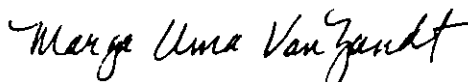
Dear Sir or Madam:

Enclosed is a First Request for Extension of Time to
File Statement of Use, a postcard and our check to cover the
filing fee, as follows:

Applicant:	Honda Giken Kogyo Kabushiki Kaisha
Mark:	SHADOW AMERICAN CLASSIC EDITION
Classes:	14, 18, 26
S/N:	75/976238
Docket No.:	21929-213
Filing Fee:	\$300.00

Please date stamp the postcard and return it to our
office upon receipt of this correspondence.

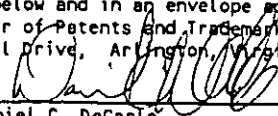
Very truly yours,



Marga Uma Vanzandt
Paralegal to David N. Makous, of
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

Enclosures

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Box 1TU, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: 
Daniel C. DeCarlo

Date Mailed: 12-1-98

Express Mail No. EF 740 588 460 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)
Honda Giken Kogyo Kabushiki)
Kaisha (Honda Motor Co., Ltd.))
Serial No.: 75/976238)
Int'l Class: 14, 18, 26)
Mark: SHADOW AMERICAN)
CLASSIC EDITION) Our Docket No. 21929-213

Assistant Commissioner of Patents and Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

FIRST REQUEST FOR EXTENSION OF TIME
UNDER 37 C.F.R. § 2.89 TO FILE
STATEMENT OF USE

Sir:

Applicant requests a six-month extension of time to file the Statement of Use under 37 C.F.R. § 2.89. Applicant has a continued bona fide intention to use the mark in commerce in connection with the goods identified in the Notice of Allowance in the above-identified application.

This is the first request for an Extension of Time following the mailing of the Notice of Allowance dated June 9, 1998.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this First Request For Extension of Time To File a Statement of Use on behalf of the applicant; he believes the applicant to be entitled to use the mark sought to be registered; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Executed this 30th day of November 1998, at Torrance, California.

Honda Giken Kogyo Kabushiki Kaisha
(Honda Motor Co., Ltd.)

By: 

Mr. Atsuyoshi Hyogo
Director, Honda Motor Co., Ltd.

David N. Makous, Esq.
Lewis, D'Amato, Brisbois & Bisgaard
221 No. Figueroa St., Ste. 1200
Los Angeles, California 90012
Telephone: (213) 250-1800

ENDOR NO 16142 ASSISTANT COMMISSIONER OF PATENT & TRADE MARK CHECK NO. 181552

INVOICE DATE	INVOICE NO.	DESCRIPTION	DISB CODE	VOUCHER NO.	ACCOUNT NO. / FILE NO.	AMOUNT
12/01/98	120324	TIME EXTENSION	5	472775	21929-213	300.00

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP
ATTORNEYS
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TOTAL AMOUNT 300.00

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ATTORNEYS
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application of:

Mark:	SHADOW AMERICAN CLASSIC EDITION
Applicant:	Honda Giken Kogyo Kabushiki Kaisha
S/N:	75/976238
Int'l. Classes:	14, 18, 26
Our File No.:	21929-213
Mailed:	December 1, 1998

OR IT A-BACAT I

HON 000036

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FROM: (PLEASE PRINT) David N. Makous, Esq. Lewis, D'Amato, Brisbois & Bisgaard LLP 221 N. Figueroa St., Ste. 1200 Los Angeles, CA 90012 21929-110, 213	TO: (PLEASE PRINT) Assistant Commissioner of Patents & Trademarks Box ITU 2900 Crystal Drive Arlington, VA 22202-3513
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Mark:	SHADOW AMERICAN CLASSIC EDITION
Applicant:	Honda Giken Kogyo Kabushiki Kaisha
S/N:	75/976238
Int'l. Classes:	14, 18, 26
Our File No.:	21929-213
Mailed:	December 1, -



12-01-1998

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David M. Marcus, Esq.
Levin, DiVito, Arisano &
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221 N. Figueroa St., Ste. 1010
Los Angeles, CA 90012

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NOTICE OF ALLOWANCE

21929-213

(NOTE: If any data on this notice is incorrect, please submit a written request for correction of the NOA to: Assistant Commissioner for Trademarks, Box 17U, 2900 Crystal Drive, Arlington, VA 22202-3513. Please include the serial number of your application on ALL correspondence with the PTO. 15 U.S.C. 1063(b)(2))

ISSUE DATE OF NOA: Jun 9, 1998

12/9/98

DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD LLP
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

**** IMPORTANT INFORMATION: 6 MONTH DEADLINE ****

To avoid ABANDONMENT of this application, either a "Statement of Use" (a.k.a. "Allegation of Use") or a "Request for Extension of Time to File a Statement of Use" (a.k.a. "Extension Request") and the appropriate fee(s) must be received in the PTO within six months of the issue date of this Notice of Allowance (NOA). Failure to do so will result in the ABANDONMENT of this application.

Please note that both the "Statement of Use" and "Extension Request" have many legal requirements, including fees. These requirements are explained in the PTO booklet "Basic Facts About Trademarks", which can be obtained upon request at (703)308-9000. In addition, there are printed forms contained in this booklet (for "Statements of Use" and "Extension Requests") for your use.

The following information should be reviewed for accuracy:

SERIAL NUMBER: 75/976238
MARK: SHADOW AMERICAN CLASSIC EDITION
OWNER: HONDA GIKEN KOGYO KABUSHIKI KAISHA
2-1-1 Minami-Aoyama, Minato-Ku
Tokyo 107, JAPAN

GOODS/SERVICES BY INTERNATIONAL CLASS

014-jewelry

018-leather goods, namely, wallets, purses, keyfobs, fannypacks, cases, billfolds, bags, and backpacks

026-fancy goods, namely, belt buckles and patches for clothing

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

HON 000041



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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Feb 13, 1998

21929-21
PTO

NOTICE OF PUBLICATION UNDER 12(a)

- | | |
|---|--|
| 1. Serial No.:
75/976,238 | 2. Mark:
SHADOW, AMERICAN CLASSIC EDITION |
| 3. International Class(es):
14, 18, 26 | |
| 4. Publication Date:
Mar 17, 1998 | 5. Applicant:
HONDA GIKEN KOGYO |

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a notice of allowance pursuant to section 13(b) of the Statute.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained at \$38.00 each for domestic orders, or at \$47.50 each for foreign orders from:

The Superintendent of Documents
U.S. Government Printing Office
PO Box 371954
Pittsburgh, PA 15250-7954
Phone: (202)512-1800

By direction of the Commissioner.

HON 000042

71767-713

I hereby certify that this correspondence is being deposited with the United States Postal Service "First Class Mail" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: Laura B. Kaliser
Laura B. Kaliser
Date Mailed: 12/5/97

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	HONDA GIKEN KOGYO)	Examining Attorney:
	KABUSHIKI KAISHA)	Jacqueline A. Lavine
)	
Mark:	SHADOW AMERICAN CLASSIC)	Law Office 109
	EDITION)	
)	
Serial No.:	75/976238)	
)	

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

RESPONSE TO OFFICE ACTION

Applicant has received and reviewed the Office Action dated June 13, 1997, and hereby responds thereto.

REMARKS

Applicant agrees to accept the Examiner's request without prejudice that Applicant disclaim the phrase "AMERICAN CLASSIC EDITION" apart from the mark as shown.

Accordingly, Applicant requests that the mark be published
for opposition.

Respectfully submitted,

LEWIS, D'AMATO, BRISBOIS & BISGAARD

by 

David N. Makous

LEWIS, D'AMATO, BRISBOIS & BISGAARD
221 North Figueroa Street, Suite 1200
Los Angeles, California 90012
Telephone No. (213) 250-1800
Facsimile No. (213) 250-7900

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Applicant:	H-D MICHIGAN, INC.
Mark:	SHADOW AMERICAN CLASSIC EDITION
S/N:	75/976238
File No.:	21929-213
Mailed:	December 5, 1997

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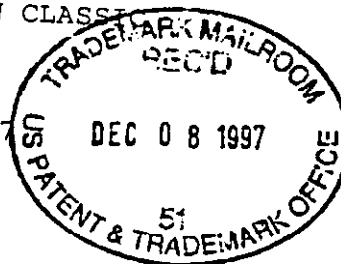
Applicant:
Mark:

H-D MICHIGAN, INC.
SHADOW AMERICAN CLASS
EDITION

S/N:
File No.:
Mailed:

75/976238
21929-213

December 5, 1997



HON 000046

C

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

SERIAL NO. 75/976238 HONDA GIKEN KOGYO		APPLICANT ETC	PAPER NO.
MARK SHADOW AMERICAN CLASSIC EDITION		ADDRESS: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513	
ADDRESS David N. Makous LEWIS, D'AMATO, BRISBOIS & BISGAARD, LLP 221 N. Figueroa Street, Suite 1200 Los Angeles, CA 90012	ACTION NO. 02	If no fees are enclosed, the address should include the word "Box Responses - No Fee"	
	MAILING DATE 06/13/97	Please provide in all correspondence:	
	REF. NO. 12/13/97	1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Office number. or telephone number and ZIP code.	

FORM PTO-1525 (5-90)

U.S. DEPT. OF COMM. PAT. & TM OFFICE

TRADEMARK LAW OFFICE 109

Serial Number: 75/976238

Mark: SHADOW AMERICAN CLASSIC EDITION

Please Place on Upper Right Corner

**of Response to Office Action ONLY **

IVED WITHIN 6

ABANDONMENT.

has been enclosed.

Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 759/762358

The Request to Divide is complete and applicant's response mailed on March 31, 1997 has been received and entered. Applicant's arguments have been received and considered. The refusal based on Geographic misdescriptiveness is withdrawn as the goods are made in America. The Section 2(d) Refusals are withdrawn due to the new description of goods.

Fees

The request for appropriate fees is repeated and made FINAL. Applicant has not paid sufficient fees. Applicant originally paid for only one class but had applied for goods in six international classes. Since the division, this application now contains three classes and only one fee. Applicant must pay \$245 per class. An additional \$490 is required.

Disclaimer Request

The Request for a disclaimer of the phrase AMERICAN CLASSIC EDITION is repeated and continued. Applicant argues that only AMERICAN and EDITION need to be disclaimed because the term CLASSIC is not used in relation to motorcycles. Enclosed are excerpts from the Lexis/Nexis Research Database showing that the term AMERICAN CLASSIC is used in relationship to motorcycles.

HON 000047

See the Story No. 16, *Petersen Publishing Company Hot Rod*, October 1995 where it states; "Honda was blatant in its Harley copying. The "American Classic Edition" pretty much spells it out, don't you think?"

See also Story No. 1 *Waikato Times*, January 31, 1997 where it states in pertinent part: "American classic motorcycles made before 1976."

Story No. 3, *St. Petersburg Times*, July 4, 1996, where it states in part: "...although the Harley-Davidson motorcycles is an American classic,..."

Story No. 7; *The Dallas Morning News*, April 15, 1996; where it states; "Connoisseurs have compared the lighters to such other American classics as Levi jeans and Harley Davidson motorcycles."

Story No. 10; *USA Today*, May 26, 1995 where it states; "...a display of American classic cars and motorcycles,..."

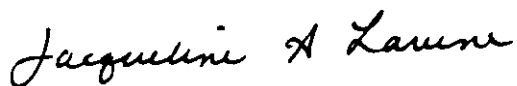
Story No. 11, *The National Law Journal*, May 15, 1995; where it states in part; "...motorcycles as all-American classics..."

Story No. 19, *The San Diego Union-Tribune*, September 10, 1994, where it states in part, "...has built a motorcycle that lives up to its name. It truly is an American Classic."

Additional stories are enclosed to further substantiate this evidence. See also the dictionary definition of Classic which is enclosed from *Websters II, New Riverside Dictionary* where it states "3. Something typical or traditional".

Accordingly, the request for the disclaimer of the entire phrase and the request for appropriate fees is repeated and made FINAL.

Please note that the only appropriate responses to a final action are either (1) compliance with the outstanding requirements, if feasible, or (2) filing of an appeal to the Trademark Trial and Appeal Board. 37 C.F.R. Section 2.64(a). If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. Section 2.65(a).



Jacqueline A. Lavine
Senior Attorney, Law Office 109
(703) 308-9109 Ext. 145
(703) 308-7194 FAX

MAIL-IT REQUESTED: JUNE 12, 1997

10083K

CLIENT: JAL
LIBRARY: NEWS
FILE: ALLNWS

YOUR SEARCH REQUEST AT THE TIME THIS MAIL-IT WAS REQUESTED:
AMERICAN CLASSIC EDITION

NUMBER OF STORIES FOUND WITH YOUR REQUEST THROUGH:
LEVEL 1... 30

LEVEL 1 PRINTED

THE SELECTED STORY NUMBERS:
16,24

DISPLAY FORMAT: KWIC

MULTIPLE DOCUMENTS ON A PAGE

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ARLINGTON VIRGINIA 22202-3600

*****05046*****

HON 000050

LEVEL 1 - 16 OF 30 STORIES

Copyright 1995 Information Access Company, a Thomson Corporation
Company

ASAP

Copyright 1995 Petersen Publishing Company
Hot Rod

October, 1995

SECTION: Vol. 48 ; No. 10 ; Pg. 106; ISSN: 0018-6031

LENGTH: 2333 words

HEADLINE: Rising sons: riding impressions of four cruisers not built in Milwaukee; motorcycles; includes related article

BYLINE: Kinnan, Rob

BODY:

... so we had four HOT ROD staffers spend quality time on each one. Honda supplied the 1100cc Shadow American Classic Edition, Kawasaki gave us the Vulcan 1500, Suzuki provided an Intruder 1400, and from Yamaha came a Virago 1100. As we ...

... narrower bars that make lane-splitting easier.

The Honda is a different story, however. Honda was blatant in its Harley copying. The "American Classic Edition" pretty much spells it out, don't you think? This bike had 98 percent of four-wheeled-vehicle drivers and probably ...

LEVEL 1 - 24 OF 30 STORIES

Copyright 1995 The Daily Yomiuri
The Daily Yomiuri

January 23, 1995, Monday

SECTION: Pg. 5

LENGTH: 307 words

HEADLINE: New Products

BODY:

... Harley-esque cruiser powered by an 1,099cc V-twin liquid-cooled engine.

The low, sleek motorcycle has been dubbed the "American Classic Edition" since it was created at Honda's California design studio and is assembled at the

HON 000051

The Daily Yomiuri, January 23, 1995

company's factory in Marysville, Ohio.

The ...

HON 000052

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HON 000053

MAIL-IT REQUESTED: JUNE 12, 1997

10083K

CLIENT: JAL
LIBRARY: NEWS
FILE: ALLNWS

YOUR SEARCH REQUEST AT THE TIME THIS MAIL-IT WAS REQUESTED:
AMERICAN CLASSIC W/8 MOTORCYCLE*

NUMBER OF STORIES FOUND WITH YOUR REQUEST THROUGH:
LEVEL 1... 27

LEVEL 1 PRINTED

THE SELECTED STORY NUMBERS:
1,3,7,9-12,19,22,23,24

DISPLAY FORMAT: KWIC

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*****05204*****

HON 000054

LEVEL 1 - 1 OF 27 STORIES

Copyright 1997 Waikato & King Country Press Limited
Waikato Times (Hamilton)

January 31, 1997

SECTION: FEATURES; MOTORING; Pg. 36

LENGTH: 218 words

HEADLINE: World champs to race at classic extravaganza

BODY:

... more than 250 machines for the two-day festival for British, European and American classic motorcycles made before 1976.

The organisers say the the festival is the biggest of its kind in the Southern ...

LEVEL 1 - 3 OF 27 STORIES

Copyright 1996 Times Publishing Company
St. Petersburg Times

July 4, 1996, Thursday, 0 South Pinellas Edition

SECTION: FOOD; Taste; THE NIBBLER; Pg. 1D

LENGTH: 819 words

HEADLINE: A new twist on surf and turf

BYLINE: CHRIS SHERMAN

DATELINE: CLEARWATER

BCDY:

... 50. And that 22,000 of them, helped win a war.

There's not as much history at Renegade Cafe, although the Harley-Davidson motorcycle is an American classic, revered and revved up with patriotic fervor by many long before it became a restaurant theme.

The cafe is ...

HON 000055

LEVEL 1 - 7 OF 27 STORIES

Copyright 1996 The Dallas Morning News
THE DALLAS MORNING NEWS

April 15, 1996, Monday, HOME FINAL EDITION

SECTION: TODAY; Pg. 8C

LENGTH: 292 words

HEADLINE: 300 million Zippos: Does that strike up a flicker of interest?

BYLINE: PRNewswire

DATELINE: BRADFORD, Pa.

BODY:

... 70,000 Zippos a day isn't enough. After 64 years we're hotter than ever."

Connoisseurs have compared the lighters to such other American classics as Levi jeans and Harley Davidson motorcycles. Collectors the world over publish newsletters about Zippos. The British percussion/dance troupe Stomp has an entire number ...

LEVEL 1 - 9 OF 27 STORIES

Copyright 1996 News & Record (Greensboro, NC)
News & Record (Greensboro, NC)

February 5, 1996, Monday, ALL EDITIONS

SECTION: TRIAD/STATE, Pg. B1, DOWN THE ROAD / IN ASHEBORO

LENGTH: 859 words

HEADLINE: ASHEBORO DINER RUNS IN CYCLES

BYLINE: BEN FELLE, Staff Writer

DATELINE: ASHEBORO

BODY:

... But we don't just attract Harley riders. We want to attract people who are interested in the sport of riding."

The Richs' American Classic Motorcycle Co. museum - featuring Harley treasures from cycles and leather jackets to combs and coins - has been attracting tourists since it opened ...

HON 000056

LEVEL 1 - 10 OF 27 STORIES

Copyright 1995 Gannett Company, Inc.
USA TODAY

May 26, 1995, Friday, INTERNATIONAL EDITION

SECTION: NEWS; Pg. 2A

LENGTH: 1117 words

HEADLINE: Diplomatic corps seeks minorities / Africa gets most black ambassadors

BYLINE: Evelyn Tan Powers

BODY:

... Duxford, England, hosts American theme days on May 28 and May 29. In addition to a display of American classic cars and motorcycles, many of the historic aircraft based at Duxford will give exhibition flights. Call: (01223) 835000, ext. 214.

...

NOTES: LIVING OVERSEAS; Helping inform U.S.citizens overseas

LEVEL 1 - 11 OF 27 STORIES

Copyright 1995 The New York Law Publishing Company
The National Law Journal

May 15, 1995

SECTION: EXHIBIT A; On Trial; Pg. A10

LENGTH: 1550 words

HEADLINE: Bike Gang Is Called an International Racket

BYLINE: BY LINDA GIBSON, SPECIAL TO THE NATIONAL LAW JOURNAL

DATELINE: TAMPA, FLA.

BODY:

... Susan C. Bucklew sustained.

Attorney Richard Cox, representing defendant Charles "Tattoo" Schwarz, described Harley-Davidson motorcycles as all-American classics and said his client was drawn to the club by "his common interest in these rare and beautiful machines." Also, Mr. Schwarz was "seeking brotherhood with ...

HON 000057

LEVEL 1 - 12 OF 27 STORIES

Copyright 1995 News & Record (Greensboro, NC)
News & Record (Greensboro, NC)

April 21, 1995, Friday, ALL EDITIONS

SECTION: TRIAD/STATE, Pg. B1, NEWS TO USE

LENGTH: 81 words

HEADLINE: RIDE SET TO BOOST CYCLE AWARENESS

BODY:

Rides will begin in Asheville, Charlotte and Wilmington. Locally, the rides will stop at 10 a.m. at American Classic Motorcycles on U.S. 64 in Asheboro, and at 11:30 a.m. at TA Truck Stop, exit 138 off ...

LEVEL 1 - 19 OF 27 STORIES

Copyright 1994 The San Diego Union-Tribune
The San Diego Union-Tribune

September 10, 1994, Saturday

SECTION: AUTO; Ed. 1,2,3,4,5,6,7; Pg. AUTO-2

LENGTH: 784 words

HEADLINE: Move over, Harley, Honda's come up with a classic

BYLINE: C.J. MANGEN

Staff Writer C.J. MANGEN is a copy editor at the Union-Tribune and a motorcycle enthusiast. He bought his first bike -- a Honda CT-70 -- at age 12, and has been riding ever since. He competes in motocross at Southern California tracks, and also enjoys exploring back-country roads aboard

BODY:

... first allotment of American Classics, and early indications are that customers will do the same.

Honda, despite its Japanese roots, has built a motorcycle that lives up to its name. It truly is an American Classic.

1995 Honda Shadow American Classic Edition Engine type: 1099cc liquid-cooled

V-twin Transmission: Five- ...

HON 000058

LEVEL 1 - 22 OF 27 STORIES

Copyright 1994 News & Record (Greensboro, NC)
News & Record (Greensboro, NC)

March 17, 1994, Thursday, CITY EDITION

SECTION: TRIAD/STATE, Pg. BG5

LENGTH: 235 words

HEADLINE: 1,500 N.C. MOTORCYCLISTS TO MEET IN ASHEBORO IN '95

BYLINE: SCOT, SOLOMON

DATELINE: ASHEBORO

BODY:

. . . center of activity will be Randolph County, with events scheduled at the N.C. Zoo, the Richard Petty Museum, the Seagrove potteries and the American Classic Motorcycle Museum in Asheboro.

In addition, a motorcycle race is planned for Caraway Speedway.

"We're not talking motorcycle gangs here," Gusler said. "These are attorneys, accountants, doctors - ...

LEVEL 1 - 23 OF 27 STORIES

Copyright 1993 Investor's Business Daily, Inc.
Investor's Business Daily

August 11, 1993

SECTION: Companies In The News; Pg. 36

LENGTH: 811 words

HEADLINE: Custom Chrome Gets A Great Ride With Harley-Davidson

BYLINE: By John A. Jones, Investor's Daily

BODY:

As the American classic Harley-Davidson motorcycles grow ever more popular, Custom Chrome Inc. rides along with the boom by supplying parts and accessories for them.

Last ...

HON 000059

LEVEL 1 - 24 OF 27 STORIES

Copyright 1992 Chicago Tribune Company
Chicago Tribune

November 8, 1992, Sunday, FINAL EDITION

SECTION: TRANSPORTATION; Pg. 1; ZONE: CN

LENGTH: 823 words

HEADLINE: Down to the nuts and bolts
From airplanes to tractors he's restored 'em all

BYLINE: Story by William Sluis

BODY:

... busy. Not only did he rebuild the Caterpillar tractor and semi-trailer truck, but he also began work on the Indian Four motorcycle, another American classic.

He received the motorcycle, whose main bearings were damaged, from a friend. The company that built the Indian had stopped production soon after Horner's model was made, ...

HON 000060

WEBSTER'S II
New Riverside
University
Dictionary

HON 000061

clarion (klár'ē-on) *n.* [ME *clarion* < OFr. *clarion* < Med. Lat. *claro* < Lat. *clarus*, clear.] 1. A medieval trumpet with a clear, shrill tone. 2. The sound made by a clarion or a sound resembling it. —*adj.* Shrill and clear < heard the clarion call to arms >

clarionet (klár'ē-on-ēt) *n.* var. of CLARINET.

clarity (klár'ē-ē) *n.* [ME *clerte*, brightness < OFr. *clarte* < Lat. *claritas*, clearness < *clarus*, clear.] The quality or state of being clear: LUCIDITY.

clarkia (klár'ē-ē) *n.* [NLat. *Clarkia*, genus name, after William Clark (1770-1838).] A plant of the genus *Clarkia* of western North America, bearing red, purple, or pink flowers.

clary (klár'ē) *n.* pl. -ies. [ME *clare*, pearly < Med. Lat. *sclarea* and partly < OE *claria*.] A European plant of the genus *Salvia*, esp. *S. sclarea*, an aromatic herb with bluish-white flowers.

clash (kláš) *v.* *clashed*, *clashing*, *clashes*. [imit.] —*vi.* 1. To collide with a loud, harsh noise. 2. To conflict < members of Congress clashing over the budget > —*vt.* To strike together with a harsh, metallic noise. —*n.* 1. A loud, resounding metallic noise, as that made by two objects colliding. 2. A state of disharmony or disagreement. 3. An often heated argument.

clasmatocyte (kláš-mát'ē-sít) *n.* [Gk. *klasma*, *klasmátos*, fragment < *klan*, to break > + *-tē*.] Histocyte. —*clasmatocyte* (-sít'ē) *adj.*

clasp (klásp) *n.* [ME *clasp*, prob. of OE orig.] 1. A fastening, as a book, used to hold two parts or objects together. 2. a. An embrace; hug. b. A grip or grasp of the hand. 3. A small metal bar attached to a military decoration indicating the action for which it was awarded. —*vt.* *clasped*, *clasping*, *clasps*. 1. To fasten with or as if with a clasp. 2. To hold in a tight grasp: EMBRACE. 3. To grip firmly in or with the hand. —*clasper* *n.*

clasper (kláš'par) *n.* A modified part of the pelvic fin of male elasmobranch fishes that aids sperm transmission during copulation.

clasp knife *n.* A pocketknife with a folding blade.

class (klás) *n.* [Fr. *classe* < Lat. *classis*, class of citizens.] 1. a. A set, group, collection, or configuration containing members having or believed to have at least one attribute in common: EXM. b. Statistics. An interval in a frequency distribution. 2. A division by quality, grade, or rank. 3. a. A social stratum whose members share similar political, economic, and cultural characteristics. b. Social rank, esp. high rank. 4. a. A group of alumni or students graduated in the same year. b. A group of students studying the same subject. c. The period during which such a group meets. 5. a. Biol. A taxonomic category ranking below a phylum and above an order. b. A subdivision of a larger group. 6. a. A grade of mail. b. The quality of accommodation on a public vehicle < travel tourist class > 7. Slang. Great style or quality < a violinist with class > —*vt.* *classified*, *classifying*, *classifies*. To arrange, group, or rate according to qualities or characteristics: CLASSIFY.

* *SYMS:* CLASS, CATEGORY, CLASSIFICATION, ORDER, SET *n.* core meaning: a subdivision of a larger group < the class of concertgoers who enjoy chamber music >

word history: *Class* is from Latin *classis*, "a division of the Roman people." *Classis* had an adjective, *classicus*, that originally meant "belonging to a class" but later meant "belonging to the highest-ranking class" from which the sense "first-class, superior" developed. English *classic* and *classical* are derived from *classicus* in the more general sense. Because the ancient Greek and Roman authors were considered models of excellence and were universally studied in schools and universities throughout Europe until recent times, the terms *classic* and *classical* came to be associated first with ancient Greek and Roman literature of all degrees of excellence and then with anything pertaining to ancient Greece or Rome.

class action *n.* A lawsuit in which the plaintiff or plaintiffs bring suit both on their own behalf and on behalf of others who have the same claim against the defendant.

class-conscious (kláš'kón-shés) *adj.* Aware of belonging to a specific socioeconomic class. —*class-consciousness* *n.*

classic (kláš'ik) *adj.* 1. Being of the highest class or rank. 2. a. Serving as an outstanding representative of a kind: MODEL. b. Well-known and typical < a classic Western with ambushes and shootouts > 3. Having lasting significance or recognized worth. 4. CLASSICAL. 5. Of or in accordance with established principles and methods in the arts and sciences. 6. Of lasting literary or historical significance. —*n.* 1. An artist, author, or work gen. held to be of the highest rank or excellence. 2. A literary work of ancient Greece or Rome. 3. Something typical or traditional.

classical (kláš'ik-ál) *adj.* 1. a. Of or relating to the culture of ancient Greece and Rome, esp. the art, architecture, and literature. b. Relating to or versed in studies of antiquity. 2. a. Relating to or designating European music of the latter half of the 18th cent. b. Designating music in the educated European tradition. 3. Standard and authoritative < classical methods of building construction > 4. Of or relating to nonrelativistic or nonquantum physics < classical mechanics > —*classicality* (-kláš'ik-ē-ē) *n.* —*classicality* *adv.*

classicism (kláš'ik-sizm) *n.* 1. Aesthetic attitudes and principles based on the culture, art, and literature of ancient Greece and Rome and characterized by emphasis on form, simplicity, proportion, and

restrained emotion. 2. Classical scholarship. 3. A Greek expression or idiom.

classificat (kláš'ik-sist) *n.* A specialist in or student of classification.

classification (kláš'ik-sif-ik-ā-shān) *n.* 1. The act of classifying. 2. Biol. The systematic grouping of organisms based on shared characteristics or traits: TAXONOMY.

classified advertisement *n.* A usual, brief printed in a newspaper or magazine along with other category.

classify (kláš'ik-sif) *vt.* -fied, -fying, -fies. 1. To range according to class or category. 2. To designate (ment) as secret and available only to such: —*classifiedly* *adv.* —*classifiedness* *n.*

classis (kláš'is) *n.* pl. -ses (-ēz) [Lat., class of emerging body of pastors and elders in certain Reformed jurisdictions over local churches. 2. The union governed by a classis.]

class mark *n.* Statistics. MARK. 22.

classmate (kláš'mát) *n.* A member of the same class.

classroom (kláš'róm) *n.* A room in which classes are held.

classy (kláš'ē) *adj.* -ier, -iest. Slang. Elegant: a paint job > —*classiness* *n.*

clast (klást) *n.* [Gk. *klastos*, broken < *klan*, to fragment.]

clastic (kláš'tik) *adj.* [Gk. *klastos*, broken < *klan*, to separate into parts or having removable sections (tomical model) > 2. Geol. Made up of fragments: —*clastic* *n.*

clathrate (kláš'trát) *adj.* [Lat. *clathratus*, p. part. furnish with a lattice < Gk. *klathron*, door bar < *klathro*, lattice in structure or appearance. 2. C. ing to inclusion complexes in which molecules or completely enclosed within the crystal structure or clathrate compound.

clatter (kláš'tar) *v.* -tered, -tering, -ters. [ME *clater* < *clater* < Gk. *klathron*, door bar < *klathro*, lattice in structure or appearance. 2. C. ing to inclusion complexes in which molecules or completely enclosed within the crystal structure or clathrate compound.

clavate (kláš'vát) *adj.* [NLat. *clavatus* < Lat. *clava*, one end thickened: CLUB-SHAPED. —*clavately* *adv.*

clavate (kláš'vát) *v.* Archaic. var. p. of CLAVE.

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clavate (kláš'vát) *v.* Archaic. var. p. of CLAVE.

HON 000062

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SEND TO: COLE, JACQUELINE
 U.S. DEPARTMENT OF COMMERCE
 PTO - TRADEMARK
 2900 CRYSTAL DRIVE
 7TH FLOOR, LAW OFFICE 11
 ARLINGTON, VIRGINIA 22202-3600

HON 000063

21929-110
PTD

UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513

TO: David N. Makous
Lewis, D'Amato, Brisbois, & Bisgaard, LLP
221 N. Figueroa Street, Suite 1200
Los Angeles, CA 90012

DATE: June 6, 1997

FROM: April Lueders, Legal Assistant
Intent to Use/Divisional Unit

SUBJECT: Divisional Applications

APPLICANT: Honda Giken Kogyo

MARK: SHADOW AMERICAN CLASSIC EDITION

This letter is to confirm that the divisional request filed on March 31, 1997, has been completed.

The goods and/or services in International Class(es) 14, 18, & 26 have been placed in the newly created (child serial number 75/ 976238) application. The goods and/or services that are in International class (es) 16, 25, & 28 remain in the original (parent serial number 74/082470) application.

↓ 5

If you have any other questions or concerns, please feel free to call ITU at (703) 308-9500 ext. 144.

HON 000064

FILING RECEIPT FOR TRADEMARK DIVISIONAL APPLICATION

Page 01 of 01

21929-110
PTO New

Receipt of the divisional application request and filing fee is acknowledged for the MARK identified below. The divisional application has been given the DATE OF FILING of its corresponding PARENT SERIAL NUMBER set forth below. Further processing of the divisional application will occur in accordance with the standard procedure of the Patent and Trademark Office. When inquiring about the divisional application, include the SERIAL NUMBER, DATE OF FILING, OWNER NAME and MARK.

David N. Makous
LEWIS, D'AMATO, BRISBOIS & BISGAARD, LLP
221 N. Figueroa Street, Suite 1200
Los Angeles, CA 90012

ATTORNEY
REFERENCE NUMBER

PLEASE REVIEW THE ACCURACY OF THE FILING RECEIPT DATA.

A request for correction to the filing receipt should be submitted within 30 days to the following address: ASSISTANT COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VIRGINIA 22202-3513. The correspondence should be marked to the attention of the Office of Trademark Program Control. The Patent and Trademark Office will review the request and make corrections when appropriate.

SERIAL NUMBER: 75/976238 PARENT SERIAL NUMBER: 75/082470
FILING DATE: Apr. 2, 1996
REGISTER: Principal
LAW OFFICE: 109
MARK: SHADOW AMERICAN CLASSIC EDITION
MARK TYPE(S): Trademark
DRAWING TYPE: Words, letters, or numbers in typed form
FILING BASIS: Sect. 1(b) (Intent to Use)

ATTORNEY: David N. Makous

DOMESTIC REPRESENTATIVE: David N. Makous

OWNER: HONDA GIKEN KOGYO KABUSHIKI KAISHA (JAPAN, Corporation)
2-1-1 Minami-Aoyama, Minato-Ku
Tokyo 107, JAPAN

FOR: jewelry
INT. CLASS: 014

FOR: leather goods
INT. CLASS: 018

FOR: fancy goods
INT. CLASS: 026

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

HON 000065

I hereby certify that this correspondence is being deposited with the United States Postal Service "First Class Mail" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: _____

Laura B. Kaiser

Date Mailed: _____

3/27/97

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: HONDA GIKEN KOGYO
KABUSHIKI KAISHA

) Examining Attorney:
) Jacqueline A. Lavine
)

) Law Office 109
)

Mark: SHADOW AMERICAN CLASSIC
EDITION

Serial No.: 75/082470

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

REQUEST TO DIVIDE APPLICATION

AND AMEND

Pursuant to the Trademark Manual of Examining Procedure §1105.06 and 37 CFR §2.87, Applicant respectfully requests this application be divided as follows:

Please divide out Classes 14, 18 and 26 into one application and publish for opposition.

Pursuant to the Office Action dated October 1, 1996,

DATA97LA: 23795.1

HON 000066

Applicant responds as follows:

1. Please change the designation of goods in Class 18 to read in full:

"Leather goods, namely wallets, purses, keyfobs, fannypacks, cases, billfolds, bags, and backpacks."

2. Please change the designation of goods in Class 26 to read in full:

"Fancy goods, namely belt buckles and patches for clothing."

3. Applicant declines to accept the entire disclaimer.

Applicant agrees to disclaim "AMERICAN" and "EDITION", apart from the mark as shown. SHADOW AMERICAN CLASSIC EDITION is a unique moniker as applied to the goods derived from the motorcycle and has no particular meaning to the public. It is not descriptive of the goods. Please see the attached NEXIS search in which we found no usages of any combinations of this mark in association with motorcycles. The consuming public is not likely to associate this phrase ("American Classic Edition") as descriptive of motorcycles; rather, as discussed below, it suggests a brand new model of a traditional large displacement motorcycle for which there may have been many manufacturers (over 80) in the last 100 years.

4. Applicant's mark is not geographically deceptively misdescriptive.

The Examining Attorney has refused registration because the

mark is "primarily geographically deceptively misdescriptive".

Applicant disagrees as the mark SHADOW AMERICAN CLASSIC EDITION does not expressly state nor impliedly state that the motorcycle is "made in America". It simply suggests that the motorcycle is comprised of uncertain traditional elements of large displacement motorcycles.

As stated in In re House of Windsor, Inc., 221 USPQ 53, 55 (TTAB 1983), "Where the mark comprises a geographical term but the geographical meaning of the term is minor, obscure, remote or unconnected with the goods, the mark is treated as an arbitrary one and registration is permitted..."

Applicant's goods relate to a specific Honda motorcycle model of the same name, and however are not an "American Classic", they are a new "edition" of the Honda SHADOW motorcycle, that combines uncertain traditional elements of motorcycles such that it may suggest a classic type of motorcycle previously sold by Honda and others in the United States.

The SHADOW is a widely recognized Honda motorcycle model that has been sold by Honda for eighteen years (see attached Registration and brochure). Nothing in the mark implies that it is made in America.

Nonetheless, without waiving the above objection, Applicant confirms that the goods described in this application are in fact made in the United States.

Accordingly, Applicant requests that the § 2(e)(3) objection be withdrawn, and the mark be published for opposition.

Enclosed is the \$100.00 fee for one application.

Respectfully submitted,

LEWIS, D'AMATO, BRISBOIS & BISGAARD

by 

David N. Makous

LEWIS, D'AMATO, BRISBOIS & BISGAARD

221 North Figueroa Street, Suite 1200

Los Angeles, California 90012

Telephone No. (213) 250-1800

Facsimile No. (213) 250-7900

I hereby certify that this correspondence is being deposited with the United States Postal Service "First Class Mail" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: David N. Makous, Reg. 29,559

Date Mailed: _____



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	HONDA GIKEN KOGYO)	Examining Attorney:
	KABUSHIKI KAISHA)	Jacqueline A. Lavine
)	
)	Law Office 109
Mark:	SHADOW AMERICAN CLASSIC)	
	EDITION)	
)	
Serial No.:	<u>759716238</u>)	
)	

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

RESPONSE TO OFFICE ACTION

Applicant has received and reviewed the Office Action dated October 1, 1996, and hereby responds thereto.

AMENDMENT

Please amend the application as follows:

1. Please delete classes 14, 18 and 26 per the Request to Divide Application.

HON 000070

DATA97LA: 23802.1

L7-8-93 9123415
11-1-93

2. Please change the designation of goods in Class 16 to read in full:

"Printed matter in the nature of publications to be distributed to purchasers of Honda motorcycles."

3. Please change the designation of goods in Class 25 to read in full:

"Clothing, namely shirts, sweatshirts, sweaters, jackets, vests, pants, bandannas, belts, hats, gloves, footwear, sold through authorized Honda motorcycle dealers."

4. Please change the designation of goods in Class 28 to read in full:

"Replicas of the SHADOW AMERICAN CLASSIC EDITION motorcycle and accessories therefor sold by Applicant and its authorized dealers."

REMARKS

I.

Applicant declines to accept the entire disclaimer.

Applicant agrees to disclaim "AMERICAN" and "EDITION", apart from the mark as shown. SHADOW AMERICAN CLASSIC EDITION is a unique moniker as applied to the goods derived from the motorcycle and has no particular meaning to the public. It is not descriptive of the goods. Please see the attached NEXIS search in which we found no usages of any combinations of this mark in association with motorcycles. The consuming public is not likely to associate this phrase ("American Classic Edition")

as descriptive of motorcycles; rather, as discussed below, it suggests a brand new model of a traditional large displacement motorcycle for which there may have been many manufacturers (over 80) in the last 100 years.

II.

Applicant's mark is not geographically deceptively misdescriptive.

The Examining Attorney has refused registration because the mark is "primarily geographically deceptively misdescriptive".

Applicant disagrees as the mark SHADOW AMERICAN CLASSIC EDITION does not expressly state nor impliedly state that the motorcycle is "made in America". It simply suggests that the motorcycle is comprised of uncertain traditional elements of large displacement motorcycles.

As stated in In re House of Windsor, Inc., 221 USPQ 53, 55 (TTAB 1983), "Where the mark comprises a geographical term but the geographical meaning of the term is minor, obscure, remote or unconnected with the goods, the mark is treated as an arbitrary one and registration is permitted..."

Applicant's goods relate to a specific Honda motorcycle model of the same name, and however are not an "American Classic", they are a new "edition" of the Honda SHADOW motorcycle, that combines uncertain traditional elements of motorcycles such that it may suggest a classic type of motorcycle previously sold by Honda and others in the United States.

The SHADOW is a widely recognized Honda motorcycle model that has been sold by Honda for eighteen years (see attached Registration). Nothing in the mark implies that it is made in America.

Nonetheless, without waiving the above objection, Applicant confirms that the goods described in this application are in fact made in the United States.

III.

Section 2(d) objections

The Examining Attorney has further refused registration because Applicant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 1,043,492; 1,645,004; 236,950; 1,624,940; 1,604,839; 1,348,246; 1,720,106; and 1,780,427 as to be likely to cause confusion, or to cause mistake, or to deceive.

A. Class 25: The owner of cited reference mark No. 1,624,940 has abandoned its registration

The § 8 affidavit was due for Reg. No. 1,624,940, on November 27, 1996. As of March 3, 1997, the Patent and Trademark Office advised us that it has not received any such affidavit and the registration will soon be declared abandoned. (see attached Declaration of Laura B. Kaliser).

B. Class 25: The owner of cited reference mark No. 236,950 has abandoned its registration

Upon Applicant's information and belief, cited mark No. 236,950 is no longer in use by the owner (see attached Declaration of Laura B. Kaliser). Applicant has therefore filed a Petition for Cancellation of this mark, a copy of which is attached hereto.

C. Class 16: Applicant's mark is not confusingly similar to the cited reference mark Nos. 1,645,004 and 1,043,492

Applicant's mark SHADOW AMERICAN CLASSIC EDITION is not likely to be confused with the mark THE SHADOW, Reg. No. 1,645,004 for "posters, lithographs, comic books, and graphic novels" and Reg. No. 1,043,492 for "novels in paperback form".

When the goods of a cited mark are "not identical or competitive, and are not related or marketed in such a way that they would be encountered by the same people in situations that could create the incorrect assumption that all goods come from the same source . . . even where the marks are identical, confusion is not likely." TMEP §1207.01 (citing In re Unilever Ltd., 222 USPQ 981, 983 (T.T.A.B. 1984)).

The goods of cited mark are based on THE SHADOW, a plainly known and recognizable fictitious character in stories. Applicant's goods are based on the Honda motorcycle - SHADOW AMERICAN CLASSIC EDITION. As discussed earlier, the motorcycle is an edition of the widely known Honda SHADOW motorcycle. The

mark SHADOW has been in use by Honda for eighteen years (see attached registration).

Applicant's goods consist of publications to be distributed only to purchasers of Honda motorcycles through direct mail or through authorized Honda dealerships. This is a narrow and specialized trade channel greatly differing from traditional newsstands and magazine racks. There is no likelihood of confusion.

D. Class 28: Applicant's goods are unrelated to the goods identified in the cited marks in this extremely crowded class and therefore not likely to cause confusion.

The Examining Attorney has cited the following marks as being confusingly similar to Applicant's mark:

1. SHADOW - for "baseball gloves", Reg. No. 1,780,427
2. SHADOW - for "snow skiing device having a single runner and a seat intended for use by paraplegics, a water skiing device having a single ski and a seat intended for use by paraplegics, and stationary trainers for wheelchairs" Reg. No. 1,720,106
3. SHADOW - for "children's ride-on bouncing horse toys", Reg. No. 1,604,839
4. SHADOW - for "golf clubs and golf club shafts", Reg. No. 1,348,246

The above marks are totally unrelated to Applicant's mark, SHADOW AMERICAN CLASSIC EDITION, for replicas of Honda's SHADOW AMERICAN CLASSIC EDITION motorcycle. As the above identical marks have been allowed in the same class, the consuming public is understood to be able to differentiate these many unrelated products. Therefore, on the basis of the dissimilarity of the goods, there is no likelihood of confusion.

Accordingly, Applicant requests that the § 2(d) objection be withdrawn, and the mark be published for opposition.

Respectfully submitted,

LEWIS, D'AMATO, BRISBOIS & BISGAARD

by 

David N. Makous

LEWIS, D'AMATO, BRISBOIS & BISGAARD
221 North Figueroa Street, Suite 1200
Los Angeles, California 90012
Telephone No. (213) 250-1800
Facsimile No. (213) 250-7900

Int. Cl.: 16

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

Reg. No. 2,363,335

United States Patent and Trademark Office

Registered June 27, 2000

**TRADEMARK
PRINCIPAL REGISTER**

SHADOW AERO

HONDA GIKEN KOGYO KABUSHIKI KAISHA
(JAPAN CORPORATION)
2-1-1 MINAMI-AOYAMA
MINATO-KU, TOKYO 107, JAPAN

MOTORCYCLES, POSTERS, AND DECALS, IN
CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND
50).

FIRST USE 12-0-1997; IN COMMERCE 12-0-1997.

FOR: PAPER GOODS AND PRINTED MATTER,
NAMELY, MAGAZINES, PAMPHLETS, BROCHURES,
NEWSLETTERS AND BOOKS ON THE SUBJECT OF

SN 75-979,264, FILED 2-23-1998.

NICHOLAS ALTREE, EXAMINING ATTORNEY

**APPLICANT'S
EXHIBIT**

19

HON 000077

The United States of America



CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office; that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks; and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



J. Todd Ichni

Commissioner of Patents and Trademarks

HON 000078

Requirements for Maintaining a Federal Trademark Registration

SECTION 8: AFFIDAVIT OF CONTINUED USE

The registration shall remain in force for 10 years, except that the registration shall be canceled for failure to file an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. §1058, upon the expiration of the following time periods:

- i) At the end of 6 years following the date of registration.
- ii) At the end of each successive 10-year period following the date of registration.

Failure to file a proper Section 8 Affidavit at the appropriate time will result in the cancellation of the registration.

SECTION 9: APPLICATION FOR RENEWAL

The registration shall remain in force for 10 years, subject to the provisions of Section 8, except that the registration shall expire for failure to file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. §1059, at the end of each successive 10-year period following the date of registration.

Failure to file a proper Application for Renewal at the appropriate time will result in the expiration of the registration.

No further notice or reminder of these requirements will be sent to the Registrant by the Patent and Trademark Office. It is recommended that the Registrant contact the Patent and Trademark Office approximately one year before the expiration of the time periods shown above to determine the requirements and fees for the filings required to maintain the registration.

UNITED STATES DEPARTMENT OF COMMERCE
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513
May 16, 2000

NOTICE OF ACCEPTANCE OF STATEMENT OF USE

DAVID N MAKOUS
LEWIS DAMATO BRISBOIS & BISGAARD
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012-2646

TM109

ATTORNEY
REFERENCE NUMBER:

21929-168

367

SERIAL NUMBER: 75/979264
MARK: SHADOW AERO
OWNER: HONDA GIKEN KOGYO KABUSHIKI KAISHA

The statement of use filed in regard to the above-identified application has been accepted. This acceptance signifies that the statement of use is accepted in all respects and that the mark is entitled to be registered. Accordingly, the registration will issue in due course barring any extraordinary circumstances.

HON 000080

CV

FILING RECEIPT FOR TRADEMARK DIVISIONAL APPLICATION

Receipt of the divisional application request and filing fee is acknowledged for the MARK identified below. The divisional application has been given the DATE OF FILING of its corresponding PARENT SERIAL NUMBER set forth below. Further processing of the divisional application will occur in accordance with the standard procedure of the Patent and Trademark Office. When inquiring about the divisional application, include the SERIAL NUMBER, DATE OF FILING, OWNER NAME and MARK.

DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

ATTORNEY
REFERENCE NUMBER
21929-168

367

PLEASE REVIEW THE ACCURACY OF THE FILING RECEIPT DATA.

A request for correction to the filing receipt should be submitted within 30 days to the following address: ASSISTANT COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VIRGINIA 22202-3513. The correspondence should be marked to the attention of the Office of Trademark Program Control. The Patent and Trademark Office will review the request and make corrections when appropriate.

SERIAL NUMBER: 75/979264
FILING DATE: Feb 23, 1998
REGISTER: Principal
LAW OFFICE: 109
MARK: SHADOW AERO
MARK TYPE(S): Trademark
DRAWING TYPE: Words, letters, or numbers in typed form
FILING BASIS: Sect. 1(b) (Intent to Use)

PARENT SERIAL NUMBER: 75/438791

ATTORNEY: DAVID N MAKOUS

DOMESTIC REPRESENTATIVE: LEWIS D'AMATO BRISBOIS & BISGAARD

OWNER: HONDA GIKEN KOGYO KABUSHIKI KAISHA (JAPAN, Corporation)
2-1-1 Minami-Aoyama
Minato-Ku, Tokyo 107, JAPAN

FOR: Paper goods and printed matter, namely, magazines, pamphlets, brochures, newsletters and books on the subject of motorcycles, posters, and decals

INT. CLASS: 016

FIRST USE: Dec 1997

USE IN COMMERCE: Dec 1997

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

HON 000081



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

David N. Makous
Lewis D'Amato Brisbois & Bisgaard
221 N. Figueroa St. Ste. 1200
Los Angeles, CA 90012

Rev. No. 1
April 3, 2000

RE: Serial Number: 75/979264
Applicant: Honda Giken Kogyo Kabushiki
Kaisha
Mark: SHADOW AERO

Dear Sir or Madam:

This letter is to confirm that the divisional request filed on November 18, 1999 has been completed. The goods and/or services in use in commerce as indicated by the Statement of Use have been placed in the newly created (child serial number 75/979264) application. The goods and/or services that are not in use remain in the original (parent serial number 75/438791) application. Any further extensions of time or Statements of Use should be filed in the original serial number.

NOTE: The reason for this procedure is that more than one child application may be created from the parent file and the ITU/Divisional Unit prefers to photocopy from original papers. If you have any other questions or concerns, please feel free to call ITU.

Richard Roy

Richard Roy
Paralegal Specialist
ITU/Divisional Unit
(703) 308-9500 Ext. 114

HON 000082

I hereby certify that this correspondence is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" service under 37 CFR § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Box ITU - FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: 
David N. Makous

Express Mail No.: EG 153 628 210 US

Date Mailed: 11-12-99

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	HONDA GIKEN KOGYO)	
	KABUSHIKI KAISHA)	
Mark:	SHADOW AERO)	
Serial No.:	75\438,791)	
Filing Date:	February 23, 1998)	
Int'l Cl.:	16)	Docket No. 21929-168
<hr/>)	

Assistant Commissioner of Patents and Trademarks
Box ITU - FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

**STATEMENT OF USE UNDER
37 C.F.R. 2.88 WITH DECLARATION**

Applicant, Honda Giken Kogyo Kabushiki Kaisha, requests registration of the above-identified trademark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. § 1051 et seq., as amended).

Applicant is using the mark in commerce in connection with paper goods and printed matter, identified in the Notice of Allowance dated July 6, 1999, issued relative to this application.

The mark was first used with the goods in International Class 16 at least as early as December 1997; was first used in interstate commerce at least as early as December 1997; and is now in use in such commerce with these goods.

The trademark is used with the goods in International Class 16 by placing the mark on the goods, and in other ways customary in the trade. Three (3) specimens showing the mark as used in International Class 16 in commerce is submitted with this Statement of Use.


The fee prescribed by Section 2.6(a)(3) is enclosed herewith.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any resulting

registration, declares that he is properly authorized to execute this Statement of Use on behalf of the Applicant; he believes the Applicant to be the owner of the trademark sought to be registered; the trademark is now in use in commerce; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Dated: November 5, 1999

By: _____


Mr. Atsuyoshi Hyogo
Director, Honda Motor Co., Ltd.

David N. Makous, Esq.
Daniel C. DeCarlo, Esq.
Lewis, D'Amato, Brisbois & Bisgaard
221 No. Figueroa St., Ste. 1200
Los Angeles, California 90012
Telephone: (213) 250-1800
Facsimile: (213) 250-7900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Honda Giken Kogyo)	
	Kabushiki Kaisha (Honda)	
	Motor Co., Ltd.))	
)	
Serial No.:	75/438791)	
)	
Filed:	February 23, 1998)	
)	
Int'l Class:	16)	
)	
Mark:	SHADOW AERO)	Docket No. 21929-168
)	

(Specimen Int'l Class 16)

1 9 9 8

1999 VT1100C3 Service Manual Conversion Stickers

The 1998 VT1100C3 Service Manual can be used to service and maintain the '99 VT1100C3.

- Apply the 1998-99 front cover and spine stickers to your 1998 VT1100C3 Service Manual(s) so that the stickers show 1998-99 in both places.
- Apply the '99 part number sticker over the old number on the lower left corner of the rear cover.

MSV 8233 (9809)

1998-99

1998-99

1998-99

1998-99

61MBH01

61MBH01

SERVICE MANUAL

HON 000087

HOW TO USE THIS MANUAL

This service manual describes the service procedures for the VT1100C3.

Follow the Maintenance Schedule (Section 3) recommendations to ensure that the vehicle is in peak operating condition and the emission levels are within the standards set by the U.S. Environmental Protection Agency and California Air Resources Board.

Performing the first scheduled maintenance is very important. It compensates for the initial wear that occurs during the break-in period.

Sections 1 and 3 apply to the whole motorcycle. Section 2 describes procedures for removal/installation of components that may be required to perform service described in the following sections.

Sections 4 through 19 describe parts of the motorcycle, grouped according to location.

Find the section you want on this page, then turn to the table of contents on the first page of the section.

Most sections start with an assembly or system illustration, service information and troubleshooting for the section. The subsequent pages give detailed procedures.

If you don't know the source of the trouble, go to section 21, Troubleshooting.

ALL INFORMATION, ILLUSTRATIONS, DIRECTIONS AND SPECIFICATIONS INCLUDED IN THIS PUBLICATION ARE BASED ON THE LATEST PRODUCT INFORMATION AVAILABLE AT THE TIME OF APPROVAL FOR PRINTING. HONDA MOTOR CO., LTD. RESERVES THE RIGHT TO MAKE CHANGES AT ANY TIME WITHOUT NOTICE AND WITHOUT INCURRING ANY OBLIGATION WHATEVER. NO PART OF THIS PUBLICATION MAY BE REPRODUCED WITHOUT WRITTEN PERMISSION. THIS MANUAL IS WRITTEN FOR PERSONS WHO HAVE ACQUIRED BASIC KNOWLEDGE OF MAINTENANCE ON HONDA MOTORCYCLES, MOTOR SCOOTERS OR ATVS.












HONDA MOTOR CO., LTD.
SERVICE PUBLICATION OFFICE

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SYMBOLS

The symbols used throughout this manual show specific service procedures. If supplementary information is required pertaining to these symbols, it would be explained specifically in the text without the use of the symbols.

	Replace the part(s) with new one(s) before assembly.
	Use recommended engine oil, unless otherwise specified.
	Use molybdenum oil solution (mixture of the engine oil and molybdenum grease in a ratio of 1 : 1).
	Use multi-purpose grease (Lithium based multi-purpose grease NLGI #2 or equivalent).
	Use molybdenum disulfide grease (containing more than 3 % molybdenum disulfide, NLGI #2 or equivalent). Example: Molykote® BR-2 plus manufactured by Dow Corning, U.S.A. Multi-purpose M-2 manufactured by Mitsubishi Oil, Japan
	Use molybdenum disulfide paste (containing more than 40 % molybdenum disulfide, NLGI #2 or equivalent). Example: Molykote® G-n paste manufactured by Dow Corning, U.S.A. Honda Moly 60 (U.S.A. only) Rocol ASP manufactured by Rocol Limited, U.K. Rocol Paste manufactured by Sumico Lubricant, Japan
	Use silicone grease.
	Apply a locking agent. Use a middle strength locking agent unless otherwise specified.
	Apply sealant.
	Use DOT 4 brake fluid. Use the recommended brake fluid unless otherwise specified.
	Use Fork or Suspension Fluid.

ENDOR NO. 16142 ASSISTANT COMMISSIONER OF PATENT & TRADE CHECK NO. 198587

INVOICE DATE	INVOICE NO.	DESCRIPTION	DISB CODE	VOUCHER NO.	ACCOUNT NO. / FILE NO.	AMOUNT
11/11/99	135831	STATEMENT OF USE	5	512976	21929-168	100.00
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP ATTORNEYS (213) 250-1800						TOTAL AMOUNT 100.00

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP
ATTORNEYS

221 NORTH FIGUEROA STREET
SUITE 1200
LOS ANGELES, CALIFORNIA 90012
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LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

TO THE
ORDER
OF

⑈ 198587 ⑈ ⑈ 12220144⑈

⑈ 07 098 723 ⑈

HON 000090

Please acknowledge receipt of our Statement of Use by affixing hereon the Patent and Trademark Office date stamp and return this card to our office. In re application of:

Mark: SHADOW AERO
Applicant: Honda Giken Kogyo Kabushiki Kaisha
Serial No.: 75/738,791
Our File No.: 21929-168 12
Mailed: November 11, 1999
mzy

HON 000091

Please acknowledge receipt of our Statement of Use by affixing hereon the Patent and Trademark Office date stamp and return this card to our office. In re application of:

Mark: SHADOW AERO
Applicant: Honda Giken Kogyo Kabushiki Kaisha
Serial No.: 75/738,791
Our File No.: 21929-168 12
Mailed: November 11, 1999
mz



11-13-1999

U.S. Patent & TMO/TM Mail Rpt Dt. #40

HON 000092

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail" service under 37 CFR § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner for Trademarks, Attn: Box ITU, 2900 Crystal Drive, Arlington VA 22202-3513

by: David N. Makous

Date Mailed: EG 153 62 11-12-99

Express Mail No. EG 153 628 210 US

EG153628210US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)

Honda Giken Kogyo Kabushiki Kaisha)
(Honda Motor Co., Ltd.))

Serial No. 75/438791)

Filed: February 23, 1998)

Int'l Classes: 14, 16, 18, 25, 28)

Mark: SHADOW AERO)

Docket No.
21929-168

Assistant Commissioner for Trademarks
Box ITU
2900 Crystal Drive
Arlington, Virginia 22202-3513

REQUEST TO DIVIDE APPLICATION UNDER 37 CFR § 2.87
AND
DELETION OF GOODS UNDER 37 CFR § 2.77

Pursuant to the Trademark Manual of Examining Procedure § 1105.06 and 37 C.F.R.

§ 2.87, Applicant respectfully requests that this application be divided as follows:

LA99_1:28287.1

HON 000093

Please divide out, into a separate application, the following goods in International Class 16: "Paper goods and printed matter, namely, magazines, pamphlets, brochures, newsletters and books on the subject of motorcycles, posters . . . and decals." A Statement of Use for these goods is enclosed herewith.

Applicant requests the deletion of goods under 37 CFR § 2.77 of the following goods in International Class 16: "Writing instruments, namely pens and pencils."

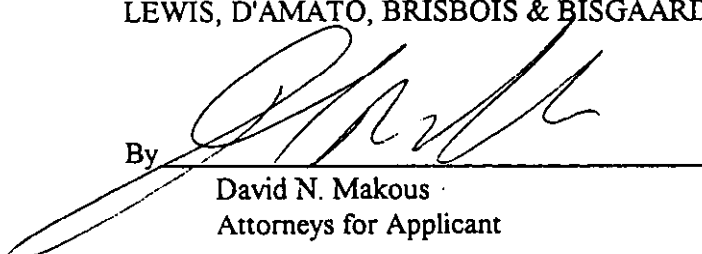
An extension of time to file the Statement of Use is enclosed herewith for the remaining classes cited in the original application (no. 75/438791): 014 - Jewelry; 018 - Leather goods, etc.; 025 - Clothing, etc.; 028 - Toys, etc.

The fee of \$100 for one new application (file wrapper) is enclosed.

Respectfully submitted,
LEWIS, D'AMATO, BRISBOIS & BISGAARD

Dated: November 11, 1999

By



David N. Makous
Attorneys for Applicant

DAVID N. MAKOUS
LEWIS, D'AMATO, BRISBOIS & BISGAARD
221 North Figueroa Street, Suite 1200
Los Angeles, California 90012
Telephone No. (213) 250-1800
Facsimile No. (213) 250-7900

LA99_1:28287.1

HON 000094

ENDOR NO. 16142 ASSISTANT COMMISSIONER OF PATENT & TRADE CHECK NO. 198588

INVOICE DATE	INVOICE NO.	DESCRIPTION	DISB. CODE	VOUCHER NO.	ACCOUNT NO. / FILE NO.	AMOUNT
11/11/99	135832	DIVIDE & DELETION REQUEST 5		512977	21929-168	100.00
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP ATTORNEYS (213) 250-1800						TOTAL AMOUNT 100.00

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

ATTORNEYS

221 NORTH FIGUEROA STREET

SUITE 1200

LOS ANGELES, CALIFORNIA 90012

(213) 250-1800

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1222

DATE 11/11/99

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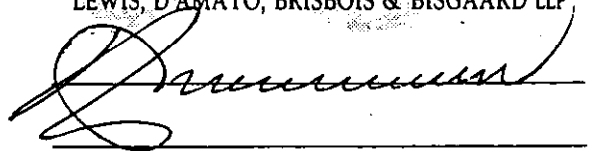
\$ *****100.00

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ASSISTANT COMMISSIONER OF
PATENT & TRADEMARK

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

TO THE
ORDER
OF



⑈198588⑈ ⑆122201444⑆

⑈07⑈098 723⑈

HON 000095

Please acknowledge receipt of our Request to Divide Application & Deletion of Goods by affixing hereon the Patent and Trademark Office date stamp and return this card to our office. In re application of:

Mark: SHADOW AERO
Applicant: Honda Giken Kogyo Kabushiki Kaisha
Serial No.: 75/738,791
Our File No.: 21929-168 ¹²
Mailed: November 12, 1999

HON 000096

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FROM: (PLEASE PRINT) David N. Makous, Esq. Lewis, D'Amato, Brisbois & Bisgaard LLP 221 N. Figueroa St., Ste. 1200 Los Angeles, CA 90012	TO: (PLEASE PRINT) Assistant Commissioner of Patents & Trademarks 2900 Crystal Drive BOX ITU - FEE Arlington, VA 22202-3513
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Mark: SHADOW AERO
Applicant: Honda Giken Kogyo Kabushiki Kaisha
Serial No.: 75/738,791
Our File No.: 21929-168 12
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MCC



11-13-1999

U.S. Patent & TMO/TM Mail Rcpt Dt. #40

HON 000098

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SAN DIEGO OFFICE
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650 WEST "C" STREET
SAN DIEGO, CALIFORNIA 92101
TELEPHONE (619) 233-1006

COSTA MESA OFFICE
SUITE 1400
650 TOWN CENTER DRIVE
CENTER TOWER BUILDING
COSTA MESA, CALIFORNIA 92626
TELEPHONE (714) 545-9200

SAN FRANCISCO OFFICE
SUITE 1400
ONE SANSOME STREET
SAN FRANCISCO, CALIFORNIA 94104
TELEPHONE (415) 382-2580

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PARALEGAL
DIRECT DIAL: (213) 680-6123
E-MAIL: QUINTERO@LDBB.COM

LAWYERS
SUITE 1200
221 NORTH FIGUEROA STREET
LOS ANGELES, CALIFORNIA 90012
TELEPHONE (213) 250-1800
WWW.LDBB.COM

INLAND EMPIRE OFFICE
TRI-CITY CORPORATE CENTRE
SUITE 800
650 EAST HOSPITALITY LANE
SAN BERNARDINO, CALIFORNIA 92408
TELEPHONE (909) 387-1130

SACRAMENTO OFFICE
SUITE 200
2500 VENTURE OAKS WAY
SACRAMENTO, CALIFORNIA 95833
TELEPHONE (916) 564-5400

FACSIMILES:
LOS ANGELES: (213) 250-7900
SAN DIEGO: (619) 233-8827
COSTA MESA: (714) 850-1030
SAN FRANCISCO: (415) 434-0882
SAN BERNARDINO: (909) 387-1138
SACRAMENTO: (916) 564-5444

OUR FILE NO.
21929-112

January 7, 2002

VIA U.S. EXPRESS MAIL

Assistant Commissioner of Patents
and Trademarks
Box ITU
2900 Crystal Drive
Arlington, Virginia 22202-3513

Dear Sir or Madam:

Enclosed is a Statement of Use, specimens, postcard and our check to cover the fee, as follows:

Applicant: Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.)
Mark: SHADOW
Serial No.: 75/082469
Int'l. Class: 16
Filing Fee: \$100.00

Please date stamp the postcard and return it to our office upon receipt of this correspondence.

Very truly yours,


Nancy Quintero

Paralegal to David N. Makous, of
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

LA2001:146828.1

HON 000099

I hereby certify that this correspondence is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" service under 37 CFR § 1.10 on the date indicated below and in an envelope addressed to Assistant Commissioner of Patents and Trademarks, Box ITU - FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: [Signature]

Express Mail No.:

EL802775941US

Date Mailed: January 7, 2002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
)	
Honda Giken Kogyo Kabushiki)	
Kaisha (Honda Motor Co., Ltd.))	
)	
Serial No. 75/082469)	
)	
Filed: April 2, 1996)	
)	Docket No.
Int'l Class: 16)	21929-112
)	
Mark: SHADOW)	
)	

Assistant Commissioner of Patents and Trademarks
Box ITU - FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

STATEMENT OF USE UNDER
37 C.F.R. 2.88 WITH DECLARATION

Applicant, Honda Giken Kogyo Kabushiki Kaisha, requests registration of the above-identified trademark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. § 1051 et seq., as amended).

Applicant is using the mark in commerce in connection with the goods associated with Class 16 as identified in the Notice of Allowance dated January 23, 2001, issued relative to this application.

The mark was first used with the goods "printed matter in the nature of publications to be distributed to purchasers of Honda motorcycles" in International Class 16 at least as early as September 2000; was first used in interstate commerce at least as early as September 2000; and is now in use in such commerce with these goods.

One (1) specimen showing the mark as used in International Class 16 and in commerce is submitted with this Statement of Use.

The fee prescribed by Section 2.6(a)(3) is enclosed herewith.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this Statement of Use on behalf of

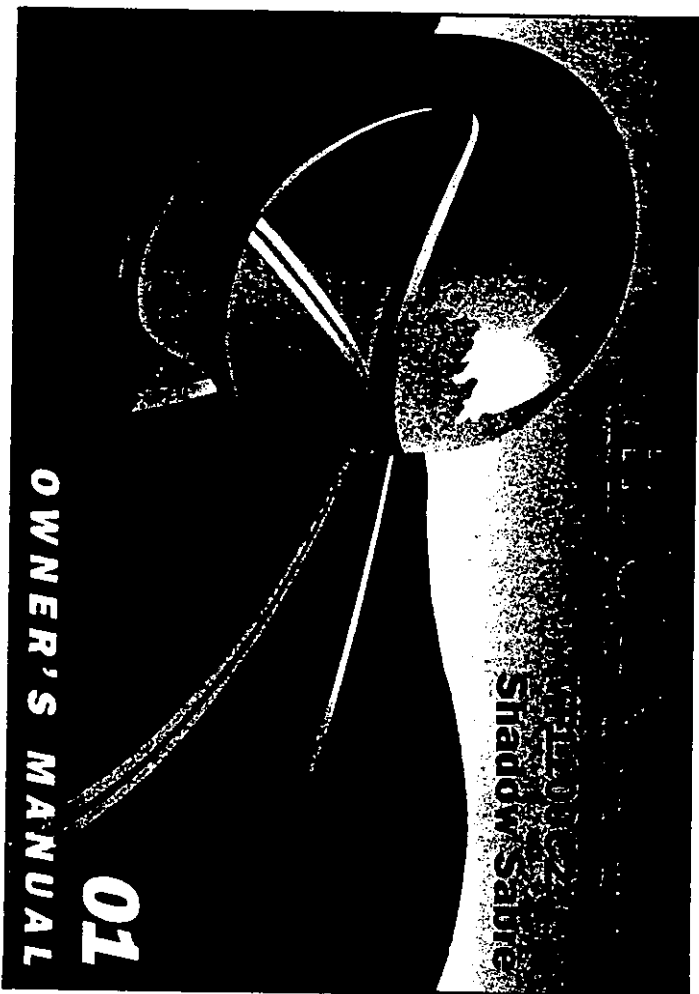
the Applicant; he believes the Applicant to be the owner of the trademark sought to be registered; the trademark is now in use in commerce; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Dated: January 2, 2002

By: 

Mr. Atsuyoshi Hyogo
Director, Honda Motor Co.,
Ltd.

David N. Makous, Esq.
Lewis, D'Amato, Brisbois & Bisgaard
221 No. Figueroa St., Ste. 1200
Los Angeles, California 90012
Telephone: (213) 250-1800
Facsimile: (213) 250-7900



Shadow Sabre

01
OWNER'S MANUAL

HON 000103

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
)	
Honda Giken Kogyo Kabushiki)	
Kaisha (Honda Motor Co., Ltd.))	
)	
Serial No. 75/082469)	
)	
Filed: April 2, 1996)	
)	Docket No.
Int'l Class: 16)	21929-112
)	
Mark: SHADOW)	
)	

(Specimen Int'l Class 16)

Please acknowledge receipt of our STATEMENT OF USE, FILING FEE by affixing hereon the Patent and Trademark Office date stamp and return this card to our office. In re application of:

Mark: SHADOW
Applicant: Honda Giken Kogyo Kabushiki Kaisha
Serial No.: 75/082469
Int'l. Class: 16
Our File No.: 21929-112
Mailed: January 7, 2002

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DATE 01/04/2002

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HON 000105

UNITED STATES DEPARTMENT OF COMMERCE
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513
Oct 23, 2001

21929-112
P10
C

NOTICE OF APPROVAL OF EXTENSION REQUEST

DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD LLP
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

TM109

ATTORNEY
REFERENCE NUMBER:

SERIAL NUMBER: 75/082469

MARK: SHADOW

OWNER: HONDA GIKEN KOGYO KABUSHIKI KAISHA

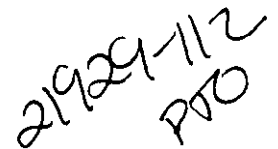
EXTENSION REQUEST NUMBER: 1

NOTICE OF ALLOWANCE DATE: Jan 23, 2001

THE ABOVE NUMBERED EXTENSION REQUEST FOR FILING A STATEMENT OF USE HAS BEEN APPROVED BY THIS OFFICE.

THE APPLICANT HAS UNTIL Jan 23, 2002 TO FILE A STATEMENT OF USE OR ANOTHER EXTENSION REQUEST. THE APPLICANT CAN FILE A TOTAL OF FIVE EXTENSION REQUESTS NOT TO EXCEED 36 MONTHS FROM THE NOTICE OF ALLOWANCE DATE.

IF THERE ARE ANY QUESTIONS REGARDING THIS NOTICE, PLEASE CONTACT THE TRADEMARK ASSISTANCE CENTER AT (703) 308-9000.



HON 000108

Please acknowledge receipt of our TRANSMITTAL LETTER ENCLOSING
FEES OWED by affixing hereon the Patent and Trademark Office date stamp
and returning it to our office. In re application of:

Applicant: Honda Giken Kogyo Kabushiki Kaisha

Mark: SHADOW

Classes: 25 & 28

Serial No.: 75/082469

Filed Date: April 2, 1996

File No.: 21929-112

Mailed: September 26, 2001



09-26-2001

U.S. Patent & TMO/TM Mail Rcpt Dt. #57

HON 000109



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INSURANCE COVERAGE LIMITS**

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HON 000110

Confirmation Report

21929-11.
PTO

Page : 001
Date & Time: Aug-16-01 10:31am
Line 1 : 213 680 5195
Machine ID : Lewis, D'Amato, Brisbois & Bisgard

Nbr.	Job	Date	Time	Duration	pgs To	Dept.nbr	Account	Comm. code	Status
561	683	Aug-16	10:24am	06/17	017 70387292583333333333			EC 502	OK TH

Jeff Turk
Mr. Fred Turner

This came out after for went

Page 881

Auto-Reply Facsimile Transmission



To: Fax Sender at 2136805195
From: United States Patent and Trademark Office

Fax information...

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SAN FRANCISCO (415) 434-0000
SAN JOSE (408) 550-1000
SACRAMENTO (916) 550-0000

TURNER LAW
213-680-3048

August 16, 2001

		Phone Number	Fax Number
To:	Mr. Fred Turner Assistant Commissioner of Patents and Trademarks ITU Division	(703) 308-9550 extension 219	(703) 872-9358
From:	Jeff Thir, Paralegal to David Makous	(213) 680-3048	
Pages:	17		
Re:	21929-112		

Message:

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COSTA MESA: (714) 850-1030
SAN FRANCISCO: (415) 434-0882
SAN BERNARDINO: (909) 387-1138
SACRAMENTO: (916) 564-5444

OUR FILE NO.
21929-112

August 16, 2001

VIA FACSIMILE (703) 872-9258

Mr. Fred Turner
Assistant Commissioner of Patents and Trademarks
Box ITU
2900 Crystal Drive
Arlington, Virginia 22202-3513

RE: Applicant: Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.)
Mark: SHADOW
Serial No.: 75/082469
Int'l. Classes: 16, 25 & 28
Our File: 21929-112

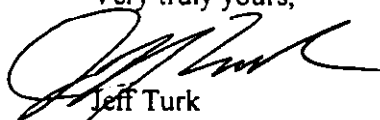
Dear Mr. Turner:

Pursuant to your telephone message of August 15, 2001, attached please find the following documents originally filed on July 19, 2001 with the USPTO:

1. Statement of Use with specimens for Classes 25 and 28;
2. First Extension of Time to File Statement of Use for Class 16;
3. Request to Divide Application; and
4. Stamped PTO Card

Please do not hesitate to advise if you have any more questions.

Very truly yours,



Jeff Turk
Paralegal to David N. Makous, of
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

770

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

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SAN FRANCISCO: (415) 434-0882
SAN BERNARDINO: (909) 387-1138
SACRAMENTO: (916) 584-5444

OUR FILE NO.
21629-112

July 18, 2001

VIA U.S. EXPRESS MAIL

Assistant Commissioner of Patents
and Trademarks
Box ITU
2900 Crystal Drive
Arlington, Virginia 22202-3513

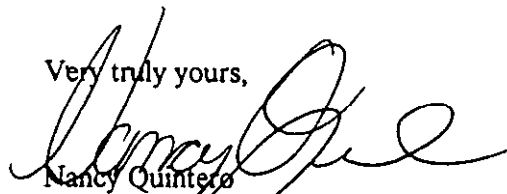
Dear Sir or Madam:

Enclosed is a Statement of Use, specimens, postcard and our check to cover the fee, as follows:

Applicant: Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.)
Mark: SHADOW
Serial No.: 75/082469
Int'l. Classes: 25 & 28
Filing Fee: \$200.00

Please date stamp the postcard and return it to our office upon receipt of this correspondence.

Very truly yours,


Nancy Quintero
Paralegal to David N. Makous, of
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

LA2001:77909.1

HON 000114

I hereby certify that this correspondence is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" service under 37 CFR § 1.10 on the date indicated below and in an envelope addressed to Assistant Commissioner of Patents and Trademarks, Box ITU - FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: David N. Makous
Express Mail No.: EJ194810325US
Date Mailed: 7/19/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
)	
Honda Giken Kogyo Kabushiki)	
Kaisha (Honda Motor Co., Ltd.))	
)	
Serial No. 75/082469)	
)	
Filed: April 2, 1996)	
)	Docket No.
Int'l Classes: 25 & 28)	21929-112
)	
Mark: SHADOW)	
)	

Assistant Commissioner of Patents and Trademarks
Box ITU - FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

STATEMENT OF USE UNDER
37 C.F.R. 2.88 WITH DECLARATION

Applicant, Honda Giken Kogyo Kabushiki Kaisha, requests registration of the above-identified trademark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. § 1051 et seq., as amended).

LA2001:72129.1

HON 000115

Applicant is using the mark in commerce in connection with the goods identified in the Notice of Allowance dated January 23, 2001, issued relative to this application.

The mark was first used with the goods "clothing, namely, shirts, sweatshirts, sweaters, jackets, vests, pants, bandannas, belts, hats, gloves, footwear, sold through authorized Honda motorcycle dealers" in International Class 25 at least as early as July 1995; was first used in interstate commerce at least as early as July 1995; and is now in use in such commerce with these goods.

One (1) specimen showing the mark as used in International Class 25 and in commerce is submitted with this Statement of Use.

The mark was first used with the goods "metallic and plastic replicas of the Shadow motorcycle sold by Honda and accessories therefor" in International Class 28 at least as early as February 1997; was first used in interstate commerce at least as early as February 1997; and is now in use in such commerce with these goods.

One (1) specimen showing the mark as used in International Class 28 and in commerce is submitted with this Statement of Use.

The fee prescribed by Section 2.6(a)(3) is enclosed herewith.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this Statement of Use on behalf of the Applicant; he believes the Applicant to be the owner of the trademark sought to be registered; the trademark is now in use in commerce; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Dated: July 16, 2001

By: 

Mr. Atsuyoshi Hyogo
Director, Honda Motor Co.,
Ltd.

David N. Makous, Esq.
Lewis, D'Amato, Brisbois & Bisgaard
221 No. Figueroa St., Ste. 1200
Los Angeles, California 90012
Telephone: (213) 250-1800
Facsimile: (213) 250-7900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)
)
Honda Giken Kogyo Kabushiki)
Kaisha (Honda Motor Co., Ltd.))
)
Serial No. 75/082469)
)
Filed: April 2, 1996)
)
Int'l Classes: 25 & 28) Docket No.
) 21929-112
)
Mark: SHADOW)
)



(Specimen Int'l Class 25)



HON 000119

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
)	
Honda Giken Kogyo Kabushiki)	
Kaisha (Honda Motor Co., Ltd.))	
)	
Serial No. 75/082469)	
)	
Filed: April 2, 1996)	
)	Docket No.
Int'l Classes: 25 & 28)	21929-112
)	
Mark: SHADOW)	
)	

(Specimen Int'l Class 28)

LA2001:72129.1

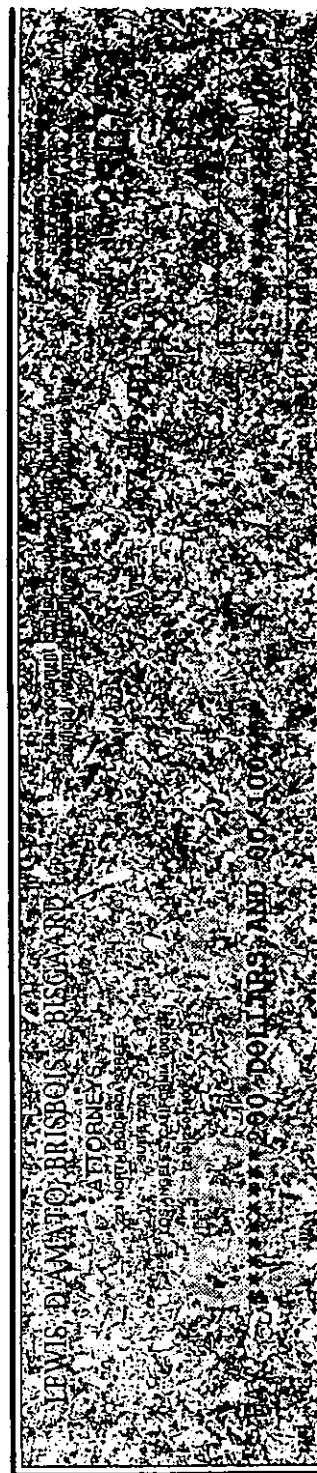
5

HON 000120

Please acknowledge receipt of our Statement of Use, First Request for Extension of Time to File a Statement of Use, and Request to Divide by affixing hereon the Patent and Trademark Office date stamp and return this card to our office. In re application of:

Mark: SHADOW
Applicant: Honda Giken Kogyo Kabushiki Kaisha
Serial No.: 75/082469
Int'l. Classes: 25 & 28
Our File No.: 21929-112
Mailed: July 14, 2001

HON 000121



I hereby certify that this correspondence is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" service under 37 CFR § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Box ITU - FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: David W. Makous

Express Mail No.: EJ194810325US

Date Mailed: July 19, 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
)	
Honda Giken Kogyo Kabushiki)	
Kaisha (Honda Motor Co., Ltd.))	
)	
Serial No. 75/082469)	
)	
Filed: April 2, 1996)	
)	
Int'l Class: 16)	Docket No.
)	21929-112
)	
Mark: SHADOW)	
)	

Assistant Commissioner of Patents and Trademarks
Box ITU - FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

FIRST REQUEST FOR EXTENSION OF TIME
UNDER 37 C.F.R. § 2.89 TO FILE
STATEMENT OF USE

Sir:

Applicant requests a six-month extension of time to file the Statement of Use under 37 C.F.R. § 2.89. Applicant has a continued bona fide intention to use the mark in commerce in connection with the goods in Class 16 as identified in the Notice of Allowance in the above-identified application.

LA2001:72685.1

HON 000122

This is the first request for an Extension of Time following the mailing of the Notice of Allowance dated January 23, 2001.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this First Request For Extension of Time To File a Statement of Use on behalf of the applicant; he believes the applicant to be entitled to use the mark sought to be registered; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Executed this 16th day of July 2001, at Torrance, California.

Honda Giken Kogyo Kabushiki Kaisha
(Honda Motor Co., Ltd.)

By: 
Mr. Atsuyoshi Hyogo
Director, Honda Motor Co., Ltd.

David N. Makous, Esq.
Lewis, D'Amato, Brisbois & Bisgaard LLP
221 No. Figueroa St., Ste. 1200
Los Angeles, California 90012
Telephone: (213) 250-1800
Facsimile: (213) 250-7900

LEWIS & CLARK PATENT & TRADEMARK
 ATTORNEY AT LAW
 150 DOLLARS AND 00/100
 ASSISTANT COMMISSIONER OF
 PATENT & TRADEMARK
 DATE 07/19/01
 CHECK NO. 230754
 LEWIS & CLARK PATENT & TRADEMARK
 ATTORNEY AT LAW
 150 DOLLARS AND 00/100
 ASSISTANT COMMISSIONER OF
 PATENT & TRADEMARK
 DATE 07/19/01
 CHECK NO. 230754

230754 1222201444 07098 723

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by: David N. Makous
Date Mailed: July 19, 2001
Express Mail No. EJ194810325US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
)	
Honda Giken Kogyo Kabushiki Kaisha)	
(Honda Motor Co., Ltd.))	
)	
Serial No. 75/082469)	Docket No.
)	21929-112
Filed: April 2, 1996)	
)	
Int'l Classes: 16, 25 & 28)	
)	
Mark: SHADOW)	
)	
)	

Assistant Commissioner for Trademarks
Box ITU
2900 Crystal Drive
Arlington, Virginia 22202-3513

REQUEST TO DIVIDE APPLICATION

Pursuant to the Trademark Manual of Examining Procedure §1105.06 and 37 C.F.R.

§2.87, Applicant respectfully requests that the above-identified application be divided as follows:

LA2001:77925.1

HON 000125

Applicant respectfully requests International Class 16 be divided out into a separate application, and, a Statement of Use for Classes 25 and 28 is enclosed herewith.

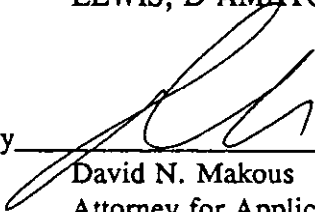
In addition, Applicant requests International Class 16 to be kept in the originally filed application, and, an extension of time to file a Statement of Use for said class is enclosed herewith.

Enclosed is the \$100.00 fee for the divisional.

Respectfully submitted,
LEWIS, D'AMATO, BRISBOIS & BISGAARD

Dated: July 18 2001

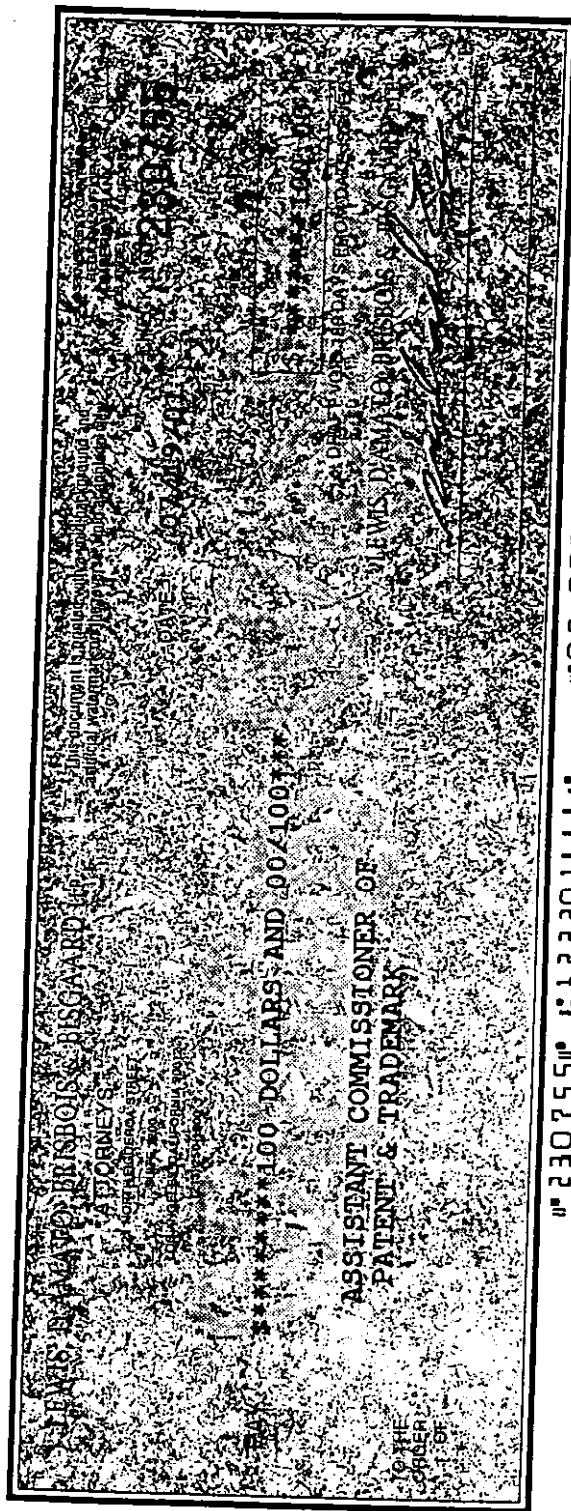
By


David N. Makous
Attorney for Applicant

DAVID N. MAKOUS
LEWIS, D'AMATO, BRISBOIS & BISGAARD
221 North Figueroa Street, Suite 1200
Los Angeles, California 90012
Telephone No. (213) 250-1800
Facsimile No. (213) 250-7900

LA2001:77925.1

HON 000126



112220144411 5550022 07098 72311

Please acknowledge receipt of our Statement of Use, ~~Not Request for~~
~~Extension of Time to File a Statement of Use, and Request to Divide by~~
affixing hereon the Patent and Trademark Office date stamp and return this
card to our office. In re application of:

Mark:	SHADOW
Applicant:	Honda Giken Kogyo Kabushiki Kaisha
Serial No.:	75/082469
Int'l. Classes:	25 & 28
Our File No.:	21929-112
Mailed:	July 19, 2001



07-19-2001

U.S. Patent & TMO/TM Mail Rpt Dt. #71

HON 000128

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SAN BERNARDINO: (909) 387-1138
SACRAMENTO: (916) 564-5444

OUR FILE NO.
21929-112

August 16, 2001

		Phone Number	Fax Number
To:	Mr. Fred Turner Assistant Commissioner of Patents and Trademarks ITU Division.	(703) 308-9550 extension 219	(703) 872-9258
From:	Jeff Turk, Paralegal to David Makous	(213) 680-5048	
Pages:	17		
Re:	21929-112		

Message:

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LA2001:6635.1

HON 000129

21929-112

Page 01 of 01

U.S. Patent and Trademark Office (PTO)
NOTICE OF ALLOWANCE

(NOTE: If any data on this notice is incorrect, please submit a written request for correction of the NOA to: Assistant Commissioner for Trademarks, Box 1TU, 2900 Crystal Drive, Arlington, VA 22202-3513. Please include the serial number of your application on ALL correspondence with the PTO 15 U.S.C. 1063(b)(2))

ISSUE DATE OF NOA: Jan 23, 2001

DAVID N MAKOUS
 LEWIS D'AMATO BRISBOIS & BISGAARD LLP
 221 N FIGUEROA ST STE 1200
 LOS ANGELES CA 90012

7/23/01
 1/23/01

**** IMPORTANT INFORMATION: 6 MONTH DEADLINE ****

To avoid ABANDONMENT of this application, either a "Statement of Use" (a.k.a. "Allegation of Use") or a "Request for Extension of Time to File a Statement of Use" (a.k.a. "Extension Request") and the appropriate fee(s) must be received in the PTO within six months of the issue date of this Notice Of Allowance (NOA) for those goods and/or services based on intent to use. Failure to do so will result in the ABANDONMENT of this application.

Please note that both the "Statement of Use" and "Extension Request" have many legal requirements, including fees. These requirements are explained in the PTO booklet "Basic Facts About Trademarks", which can be obtained upon request at (703)308-9000. In addition, there are printed forms contained in this booklet (for "Statements of Use" and "Extension Requests") for your use.

The following information should be reviewed for accuracy:

SERIAL NUMBER: 75/082469
 MARK: SHADOW
 OWNER: HONDA GIKEN KOGYO KABUSHIKI KAISHA
 2-1-1 Minami-Aoyama
 Minato-Ku
 Tokyo 107, JAPAN

This application has the following bases, but not necessarily for all listed goods/services:
 Section 1(a): NO Section 1(b): YES Section 44(e): NO

GOODS/SERVICES BY INTERNATIONAL CLASS

- 016-printed matter in the nature of publications to be distributed to purchasers of Honda motorcycles
- 025-clothing, namely, shirts, sweatshirts, sweaters, jackets, vests, pants, bandannas, belts, hats, gloves, footwear, sold through authorized Honda motorcycle dealers
- 028-metallic and plastic replicas of the Shadow motorcycle sold by Hondas and accessories therefor

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

HON 000130



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

Sep 29, 2000

21929-112

NOTICE OF PUBLICATION UNDER 12(a)

- | | |
|---|---|
| 1. Serial No.:
75/082,469 | 2. Mark:
SHADOW |
| 3. International Class(es):
16, 25, 28 | |
| 4. Publication Date:
Oct 31, 2000 | 5. Applicant:
HONDA GIKEN KOGYO KABUSHIKI KAISHA |

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a notice of allowance pursuant to section 13(b) of the Statute.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents
U.S. Government Printing Office
PO Box 371954
Pittsburgh, PA 15250-7954
Phone: (202)512-1800

By direction of the Commissioner.

HON 000131

Mark: SHADOW
Applicant: Honda Giken Kogyo Kabushiki Kaisha
S/N: 75/082469
Classes: 16, 25, 28
Cur File No.: 21929-112
Mailed: June 27, 2000

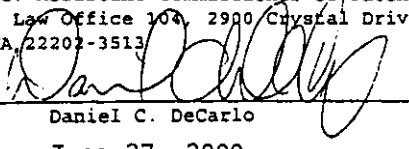
2 100000 200000 300000 400000 500000 600000 700000 800000 900000 1000000

06-30-2000

U.S. Patent & TMO/c/TM Mail Rep: D. #65

HON 000132

I hereby certify that this correspondence is being deposited with the United States Postal Service "First Class Mail" service under 37 CFR § 1.8 on the date indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Attention: Law Office 109, 2900 Crystal Drive, Arlington VA, 22202-3513

by: 
Daniel C. DeCarlo

Date Mailed: June 27, 2000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	HONDA GIKEN KOGYO)	Examining Attorney:
	KABUSHIKI KAISHA)	Jacqueline A. Lavine
	(Honda Motor Co., Ltd.))	
)	Law Office 109
Mark:	SHADOW)	
Serial No.:	75/082469)	
Class:	16, 25, 28)	
Filing Date:	April 2, 1996)	Our File No.: 21929-112
)	
)	

To the Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

RESPONSE TO OFFICE ACTION

APPLICANT REQUESTS THAT THIS MATTER BE REMOVED FROM THE

INACTIVE STATUS AND REACTIVATED FOR PROSECUTION.

This application was initially filed on April 2, 1996. The

application now concerns the goods as identified in Class 16, 25 and 28.

2. The Applicant filed a response to the Office Action of March 4, 1997.^{1/} The Examiner had previously cited the trademark registration SHADOW (Registration No. 236,950) as a block to applicant's efforts to register its mark in Class 25. As a consequence, Applicant filed a petition to cancel Registration No. 236,950 and as a result this matter was stayed pending the outcome of that petition to cancel.

3. The petition to cancel has since been withdrawn and as such it is requested that this matter be placed on active status and that the application be published for opposition.^{2/}

REGISTRATION NO. 236,950 DOES NOT CREATE A LIKELIHOOD OF CONFUSION.

Applicant will not repeat its arguments put forth in its original Response to Office Action filed on March 4, 1997. Concerning Registration No. 236,950 for SHADOW, a mark which the Examiner cited as a block, the owner of said mark, has agreed that there is no likelihood of confusion as between Applicant's proposed registration and the other registration. As such, there is no

^{1/} Attached hereto as Exhibit "A" is a true and accurate copy of Applicant's Response to Office Action filed on March 7, 1997.

^{2/} Attached hereto as Exhibit "B" is a true and accurate copy of "Petitioner's Notice of Withdrawal Petition to Cancel Without Prejudice."

likelihood of confusion as to Applicant's proposed mark and
Registration No. 236,950.

CONCLUSION

For the aforementioned reasons, Applicant contends that the
application is in condition to be published for opposition and
requests that the examiner so publish the mark.

Dated: June 27, 2000

Respectfully submitted,

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

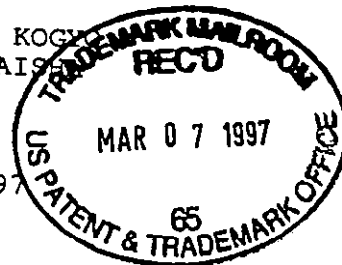
By: 

Daniel C. DeCarlo

Daniel C. DeCarlo, Esq.
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP
221 N. Figueroa Street, Suite 1200
Los Angeles, CA 90012 Telephone: (213) 250-1800

Please acknowledge receipt of our RESPONSE TO
OFFICE ACTION by affixing hereon the Patent
and Trademark Office date stamp and return
this card to our office. In re application
of:

Applicant: HONDA GIKEN KOGY
KABUSHIKI KAISHA
Mark: SHADOW
S/N: 75/082469
File No.: 21929-112
Mailed: March 4, 1997



HON 000136

21929-12

I hereby certify that this correspondence is being deposited with the United States Postal Service "First Class Mail" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: David M. Makous, Reg. 29,559
Date Mailed: 3/4/97

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: HONDA GIKEN KOGYO)	Examining Attorney:
KABUSHIKI KAISHA)	Jacqueline A. Lavine
)	
Mark: SHADOW)	Law Office 109
)	
Serial No.: 75/082469)	
)	

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

RESPONSE TO OFFICE ACTION

Applicant has received and reviewed the Office Action dated September 10, 1996, and hereby responds thereto.

AMENDMENT

Please amend the application as follows:

1. Please delete classes 14, 18 and 26 per the Request to Divide Application.

DAT97LA: 17373.1

HON 000137

2. Please change the designation of goods in Class 16 to read in full:

"Printed matter in the nature of publications to be distributed to purchasers of Honda motorcycles."

3. Please change the designation of goods in Class 25 to read in full:

"Clothing, namely shirts, sweatshirts, sweaters, jackets, vests, pants, bandannas, belts, hats, gloves, footwear, sold through authorized Honda motorcycle dealers."

4. Please change the designation of goods in Class 28 to read in full:

"Metallic and plastic replicas of the SHADOW motorcycle sold by Honda and accessories therefor."

REMARKS

The Examining Attorney has refused registration because Applicant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 1,043,492; 1,645,004; 236,950; 1,624,940; 1,604,839; 1,348,246; 1,720,106; and 1,780,427 as to be likely to cause confusion, or to cause mistake, or to deceive.

A. Class 25: The owner of cited reference mark No. 1,624,940 has abandoned its registration

The § 8 affidavit was due for Reg. No. 1,624,940, on November 27, 1996. As of March 3, 1997, the Patent and Trademark Office advised us that it has not received any such affidavit and the registration will soon be declared abandoned. (see attached Declaration of Laura B. Kaliser).

B. Class 25: The owner of cited reference mark No. 236,950 has abandoned its registration

Upon Applicant's information and belief, cited mark No. 236,950 is no longer in use by the owner (see attached Declaration of Laura B. Kaliser). Applicant is therefore filing a Petition for Cancellation of this mark along with this Response to Office Action.

C. Class 16: Applicant's mark is not confusingly similar to the cited reference mark Nos. 1,645,004 and 1,043,492

Applicant's mark SHADOW is not likely to be confused with the mark THE SHADOW, Reg. No. 1,645,004 for "posters, lithographs, comic books, and graphic novels" and Reg. No. 1,043,492 for "novels in paperback form".

When the goods of a cited mark are "not identical or competitive, and are not related or marketed in such a way that they would be encountered by the same people in situations that could create the incorrect assumption that all goods come from

the same source . . . even where the marks are identical, confusion is not likely." TMEP §1207.01 (citing In re Unilever Ltd., 222 USPQ 981, 983 (T.T.A.B. 1984)).

Applicant's goods consist of publications to be distributed only to purchasers of Honda motorcycles through direct mail or through authorized Honda dealerships. This is a narrow and specialized trade channel greatly differing from traditional newsstands and magazine racks. There is no likelihood of confusion.

D. Class 28: Applicant's goods are unrelated to the goods identified in the cited marks in this extremely crowded class and therefore not likely to cause confusion.

The Examining Attorney has cited the following marks as being confusingly similar to Applicant's mark:

1. SHADOW - for "baseball gloves", Reg. No. 1,780,427
2. SHADOW - for "snow skiing device having a single runner and a seat intended for use by paraplegics, a water skiing device having a single ski and a seat intended for use by paraplegics, and stationary trainers for wheelchairs" Reg. No. 1,720,106
3. SHADOW - for "children's ride-on bouncing horse toys", Reg. No. 1,604,839

4. SHADOW - for "golf clubs and golf club shafts",

Reg. No. 1,348,246

The above marks are totally unrelated to Applicant's mark, SHADOW, for replicas of Honda's SHADOW motorcycle. As the above identical marks have been allowed in the same class, the consuming public is understood to be able to differentiate these many unrelated products. Therefore, on the basis of the dissimilarity of the goods, there is no likelihood of confusion.

Accordingly, Applicant requests that the § 2(d) objection be withdrawn, and the mark be published for opposition.

Respectfully submitted,

LEWIS, D'AMATO, BRISBOIS & BISGAARD

by 

David N. Makous

LEWIS, D'AMATO, BRISBOIS & BISGAARD
221 North Figueroa Street, Suite 1200
Los Angeles, California 90012
Telephone No. (213) 250-1800
Facsimile No. (213) 250-7900

2. 229-112

I hereby certify that this correspondence is being deposited with the United States Postal Service "First Class Mail" service under 37 CFR § 1.8 on the date indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, 2900 Crystal Drive, Arlington VA 22202-3513

by: Daniel C. DeCarlo

Date Mailed: May 10, 2000

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

AMERICAN HONDA MOTOR CO.,)	Cancellation No. 26-171
INC.)	
)	Trademark: SHADOW
Petitioner,)	Registration No. 236,950
)	
vs.)	
)	
WARNACO, INC.,)	Our File No.: 21929-112
)	
Registrant.)	

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

PETITIONER'S NOTICE OF WITHDRAWAL OF PETITION TO

CANCEL WITHOUT PREJUDICE

Petitioner American Honda Motor Co., Inc., filed a Petition for Cancellation of the mark SHADOW, Registration No. 236,950. Pursuant

LA2000:34328.1

HON 000143

to 37 C.F.R. § 2.114(c), Petitioner hereby withdraws its Petition to
Cancel without prejudice.

Dated: May 8, 2000

Respectfully submitted,

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

By: 

Daniel C. DeCarlo

Daniel C. DeCarlo, Esq.
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP
221 N. Figueroa Street, Suite 1200
Los Angeles, CA 90012
(213) 250-1800

PROOF OF SERVICE

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

I am employed in the County of Los Angeles, State of California. I am over the age of 18 and not a party to the within action. My business address is 221 North Figueroa Street, Suite 1200, Los Angeles, California 90012.

On May 10, 2000, I served the foregoing document described as PETITIONER'S NOTICE OF WITHDRAWAL OF PETITION TO CANCEL WITHOUT PREJUDICE on all interested parties in this action by placing [X] a true copy [] the original thereof enclosed in sealed envelopes addressed as follows:

Beth Kotran, Esq.
Amster, Rothstein & Ebenstein
90 Park Avenue
New York, New York 10016

[X] (BY MAIL, 1013a, 2015.5 C.C.P.)

[X] I deposited such envelope in the mail at Los Angeles, California. The envelope was mailed with postage thereon fully prepaid.

[X] (STATE) I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed on May 10, 2000, at Los Angeles, California.


Julie Contreras

EXHIBIT A

CONSENT AGREEMENT

This agreement is entered into by and between Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.) (hereinafter "Honda"), a Japanese corporation with its principal offices at 2-1 Minami-Aoyama, Minato-Ku, Tokyo 107, Japan; Warnaco, Inc. a Delaware corporation with its principal offices at 90 Park Avenue, New York, New York 10016; and Warnaco U.S., Inc., a Delaware corporation with its principal offices at 470 Wheelers Farms Road, Milford, Connecticut 06460 (collectively or individually, "Warnaco").

A. Warnaco is the owner of the mark SHADOW (United States Registration No. 236,950 issued on December 27, 1927) for "corsets, girdles, brasiers, combination corset-bandeaux and combination girdle bandeaux."

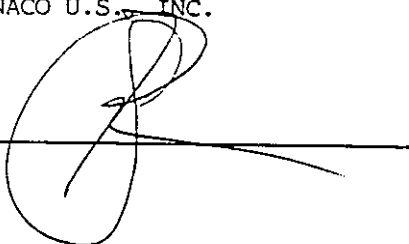
B. Honda is the applicant for the United States Trademark Application, Serial No. 75/082,469 filed April 2, 1996 for the trademark SHADOW for "jewelry" in Class 14; "printed matter in the nature of publications to be distributed to purchasers of Honda motorcycles" in Class 16; "leather goods" in Class 18; "clothing, namely shirts, sweatshirts, sweaters, jackets, vests, pants, bandannas, belts, hats, gloves, footwear, sold through Honda motorcycle dealers" in Class 25; "metallic and plastic replicas of the SHADOW motorcycle sold by Honda and accessories therefore" in Class 28.

C. After careful consideration, investigation and discussion, the parties agree that there is no likelihood of confusion between Honda's proposed usage and registration

of SHADOW as described in "B" above with the goods described in Warnaco's trademark registration (No. 236,950), identified in "A" above.

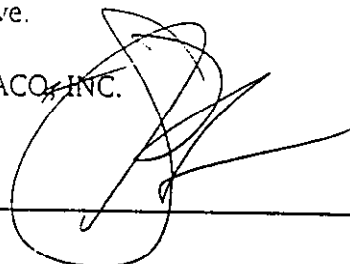
WARNACO U.S. INC.

By
Its:



WARNACO, INC.

By
Its:



HONDA, GIKEN, KOGYO, KABUSHIKI, KAISHA
(HONDA MOTOR COMPANY, LTD.)

By
Its:



cc:
Laura Cuddy, Esq.
Honda North America, Inc.
700 Van Ness Avenue
Building 300-2-ID
Torrance, CA 90501

LA2000:47830.1

HON 000148

Please acknowledge receipt of our Response to Office Action by affixing hereon the Patent and Trademark Office date stamp and return this card to our office. In re application of:

Mark: SHADOW

Applicant: Honda Giken Kogyo Kabushiki Kaisha

S/N: 75/082469

Classes: 16, 25, 28

Our File No.: 21929-112

Mailed: June 27, 2000

99LA-48290.1

HON 000149

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

2424-112

SERIAL NO.

APPLICANT

75/082469 HONDA GIKEN KOGYO KABUSHIKI KAISHA

MARK

SHADOW

ADDRESS

DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD LLP
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

ACTION NO.

02

MAILING DATE

06/13/97

REF. NO.

12/10/97

PAPER NO.

Assistant Commissioner
for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

If no fees are enclosed, the address should include the words "Box Responses - No Fee"

Please provide in all correspondence:

1. Filing Date, serial number, mark and Applicant's name.
2. Mailing date of this action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and ZIP code.

FORM PTO-1525 (5-90)

U.S. DEPT. OF COMM. PAT. & TM OFFICE

RE: Serial Number: 75/082469

☐ The examining attorney has searched the Office records and has found no similar registered mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01.

☒ 1. Action on this application is suspended pending the disposition of:

☒ Cancellation No(s) for Reg. No. 236,950

☐ Opposition No(s).

☐ Civil Action No(s).

☐ Concurrent Use No(s).

If the applicant is a party to the above proceeding, the applicant should advise the Examining Attorney of the outcome of the proceeding when it is terminated.

☐ Application Serial No(s).

Since applicant's effective filing date is subsequent to the effective filing date of the above-identified application(s), the latter, if and when it registers, may be cited against this application. See 37 C.F.R. §2.83. A copy of information relevant to this pending application(s) ☐ is attached ☐ was sent previously.

The applicant may request that the application be removed from suspension by presenting arguments related to the potential conflict between the relevant applications or other arguments related the ground for suspension. The applicant's election to present or not to present arguments at this time will not affect the applicant's right to present arguments later.

☐ 2. Action on this application is suspended pending receipt of a certification or certified copy of the registration in the country of origin of applicant. If the registration is in a foreign language, an English translation must be submitted. The certification or certified copy of the registration should be forwarded to the Examining Attorney as soon as possible. If the foreign application is abandoned, the Examining Attorney should be advised.

☐ 3. It is noted that an assignment involving this application is presently pending before the Office. Action is suspended on this application pending recordation of the assignment. This application will be removed from suspended status upon recordation of the assignment. Notification of recordation is normally done through Office channels. However, upon receipt of the reel and frame number of the assignment, applicant should advise the Examining Attorney. See 37 C.F.R. Part 3.

☐ 4. Action on this application is suspended for months until the Examining Attorney can determine whether the cited registration will be canceled under §8 or expire under §9. 37 C.F.R. 2.67.

☐ 5. The following refusals/requirements are continued:

Jacqueline A. Lavine

EXAMINING ATTORNEY NAME

Jacqueline A. Lavine
EXAMINING ATTORNEY SIGNATURE

109

LAW OFFICE

(703) 308-9109

PHONE

HON 000150

**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

SERIAL NO. 75/082469 HONDA GIKEN KOGYO KABUSHIKI KAISHA		PAPER NO. 21929-112
MARK SHADOW		ADDRESS: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 If no fees are enclosed, the address should include the word "Box Responses - No Fee." Please provide in all correspondence: 1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.
ADDRESS David N. Makous LEWIS, D'AMATO, BRISBOIS & BISGAARD, LLP 221 N. Figueroa Street, Suite 1200 Los Angeles, CA 90012	ACTION NO. 01	
	MAILING DATE 09/10/96	
REF. NO.		
FORM PTO-1525 (5-90) U.S. DEPT. OF COMM. PAT. & TM OFFICE		

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT.
For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 75/082469

The assigned examining attorney has reviewed the referenced application and determined the following.

Prior Registrations

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 1,043,492; 1,645,004; 0236,950; 1,624,940; 1,604,839; 1,348,246; 1,720,106 and 1,780,427 as to be likely to cause confusion, or to cause mistake, or to deceive. TMEP section 1207. See the enclosed registrations.

Registration Nos. 1,043,492 and 1,645,004 are cited against the goods in Class 16.

→ Registration Nos. 0236,950; 1,624,940 are cited against Class 25.

Registration Nos. 1,604,839; 1,348,246; 1,720,106 and 1,780,427 are cited against Class 28.

There are to be no confusingly similar marks for Classes 14, 18 and 26.

HON 000151

Prior Pending Applications

The examining attorney encloses information regarding pending Application Serial Nos. 75/083,260 and 75/083261. The filing dates of the referenced applications precede the applicant's filing date. There may be a likelihood of confusion between the applicant's mark and the referenced marks under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). If one or more of the referenced applications matures into a registration, the examining attorney may refuse registration in this case under Section 2(d). 37 C.F.R. Section 2.83; TMEP section 1208.01. This applies to the Class 25 goods only.

Possible Responses

The applicant may respond to the stated refusals by doing one of the following:

- (1) amending the application to delete the class to which the refusal pertains;
- (2) traversing the refusal of the combined application as a whole; or
- (3) filing a request to divide the application, so that the mark may be published for opposition in the class to which the refusal does not pertain (37 C.F.R. Section 2.87; TMEP sections 1105.06 and 1113.03).

Please note, however, that failure to respond to a refusal which pertains to fewer than all classes in an application will result in abandonment of the combined application in its entirety.

Informalities

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

Additional Fees required

The application identifies goods that may be classified in several international classes. Effective December 3, 1993, the filing fee is \$245.00 for each class. 37 C.F.R. Section 2.6(a)(1). Therefore, the applicant must either: (1) restrict the application to the number of classes covered by the fee already paid, or (2) pay the required fee for each additional class. 37 C.F.R. Section 2.86(b); TMEP sections 810.01 and 1113.01.

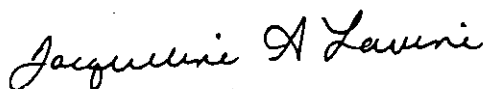
Identification of goods indefinite

The identification of goods is indefinite and requires amendment. Jewelry in Class 14 is acceptable. However, in all the other classes, applicant must specifically list each item using the common commercial name.

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. Section 2.71(b); TMEP section 804.09.

Therefore, the applicant may not amend to include any goods or services that are not within the scope of the goods and services recited in the present identification.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.



Jacqueline A. Lavine
Senior Attorney, Law Office 109
(703) 308-9109 Ext. 145
(703) 308-7194 FAX

NOTE: The Trademark Office is committed to improving the quality of our service. The Assistant Commissioner for Trademarks would like to have your comments and suggestions on ways we can improve the quality of the examination process. In the event there are any areas causing you recurrent problems, please let us know of them.

COMMENTS SHOULD NOT BE INCLUDED WITH THE RESPONSE TO AN OFFICE ACTION, BUT SHOULD BE SENT IN A SEPARATE COMMUNICATION TO THE FOLLOWING ADDRESS:

Office of Trademark Quality Review
c/o Commissioner of Patents and Trademarks
Washington, DC 20231.

Please note that this address differs from the mailing address for the response to this Office action.

*** User: EX817099 *** S 1 Number: 75083261 ***

Word Mark
SHADOW

Goods/Services
IC 025; US 022 039; G & S: footwear, namely snowboard boots

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75-083261

Filing Date
1996.04.03

Owner Name/Address
(APPLICANT) WILLIAM H. KAUFMAN INC. CORPORATION CANADA 410 King Street
West Kitchener, Ontario CANADA N2G 4J8

Section 44
SECT 44

Type of Mark
TRADEMARK

Register
PRINCIPAL

*** Search: 5 *** Document Number: 9 ***

HON 000154

*** User: EX817099 *** S 1 Number: 75083260 ***

Word Mark
SHADOW-BIO

Goods/Services
IC 025; US 022 039; G & S: footwear, namely snowboard boots

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75-083260

Filing Date
1996.04.03

Owner Name/Address
(APPLICANT) WILLIAM H. KAUFMAN INC. CORPORATION CANADA 410 King Street
West Kitchener, Ontario CANADA N2G 4J8

Section 44
SECT 44

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON 000155

*** Search: 5 *** Document Number: 10 ***

*** User: EX817099 *** Serial Number: 73687586 ***

Word Mark
SHADOWS

Goods/Services
IC 025; US 039; G & S: MEN'S AND LADIES' TEE-SHIRTS; LADIES' TANK TOPS,
SLACKS AND SHORTS, CARDIGANS, HATS; FIRST USE DATE: 1984.01.18; FIRST USE
IN COMMERCE: 1984.01.18

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-687586

Filing Date
1987.10.02

Registration Number
1624940

Registration Date
1990.11.27

Owner Name/Address
(REGISTRANT) IKEDA, SHAYNE INDIVIDUAL UNITED STATES 743-C WAIKAMULO ROAD
HONOLULU HAWAII 96817

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON 000156

*** Search: 5 *** Document Number: 164 ***

*** User: EX817099 *** S 1 Number: 71251252 ***

Word Mark
SHADOW

Goods/Services
IC 025; US 039; G & S: CORSETS, GIRDLES, BRASSIERES [, BANDEAUX,
COMBINATION CORSET-BRASSIERES, COMBINATION GIRDLE-BRASSIERES, COMBINATION
CORSET-BANDEAUX, AND COMBINATION GIRDLE-BANDEAUX]; FIRST USE DATE:
1926.11.01; FIRST USE IN COMMERCE: 1926.11.01

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
71-251252

Filing Date
1927.06.28

Change in Registration
CHANGE IN REGISTRATION HAS OCCURED

Registration Number
0236950

Registration Date
1927.12.27

Owner Name/Address
(REGISTRANT) WARNER BROTHERS COMPANY, THE CORPORATION CONNECTICUT 347
MADISON AVE. NEW YORK NEW YORK

Owner Name/Address
(LAST LISTED OWNER) WARNACO INC. CORPORATION BY CHANGE OF NAME FROM
DELAWARE 90 PARK AVENUE NEW YORK NEW YORK 10016

Type of Mark
TRADEMARK

Register
PRINCIPAL

Renewal
3RD RENEWAL 1987.12.27

*** Search: 5 *** Document Number: 198 ***

HON 000157

*** User: EX817099 *** S 1 Number: 73827363 ***

Word Mark
THE SHADOW

Goods/Services
IC 016; US 038; G & S: POSTERS, LITHOGRAPHS, COMIC BOOKS, AND GRAPHIC
NOVELS; FIRST USE DATE: 1940.03.00; FIRST USE IN COMMERCE: 1940.03.00

Goods/Services
IC 009; US 036; G & S: PRERECORDED AUDIO CASSETTE TAPES AND PHONOGRAPH
RECORDS FEATURING STORIES FROM RADIO PROGRAMS; FIRST USE DATE:
1972.00.00; FIRST USE IN COMMERCE: 1972.00.00

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-827363

Filing Date
1989.09.25

Registration Number
1645004

Registration Date
1991.05.21

Owner Name/Address
(REGISTRANT) ADVANCE MAGAZINE PUBLISHERS INC. CORPORATION NEW YORK 350
MADISON AVENUE NEW YORK NEW YORK 10017

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON 000158

*** Search: 7 *** Document Number: 141 ***

*** User: EX817099 *** Serial Number: 73038765 ***

Word Mark
THE SHADOW

Goods/Services
IC 016; US 038; G & S: NOVELS IN PAPERBACK FORM; FIRST USE: 1963.09.00;
FIRST USE IN COMMERCE: 1963.09.00

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-038765

Filing Date
1974.12.05

Registration Number
1043492

Registration Date
1976.07.13

Owner Name/Address
(REGISTRANT) CONDE NAST PUBLICATIONS INC., THE CORPORATION NEW YORK 350
MADISON AVE. NEW YORK NEW YORK 10017

Owner Name/Address
(LAST LISTED OWNER) ADVANCE MAGAZINE PUBLISHERS INC. CORPORATION NEW YORK
350 MADISON AVENUE NEW YORK NEW YORK 10017

Prior US Registration
0534805

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit
SECT 8.; SECT 15.; COMBINED SECT 8 AND SECT 15.

Renewal
1ST RENEWAL 1996.05.16

*** Search: 7 *** Document Number: 178 ***

HON 000159

SHADOW

Word Mark
SHADOW

Goods/Services
IC 028; US 022; G & S: baseball gloves; FIRST USE DATE: 1992.07.00; FIRST
USE IN COMMERCE: 1992.07.00

Mark Drawing Code
(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number
74-323342

Filing Date
1992.10.19

Registration Number
1780427

Registration Date
1993.07.06

Owner Name/Address
(REGISTRANT) GLOVESMITH, Inc. CORPORATION MISSOURI 20 Village Plaza Arnold
MISSOURI 63010

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON 000160

*** User: EX817099 *** Serial Number: 74141861 ***

Word Mark
SHADOW

Goods/Services
IC 012; US 019; G & S: wheelchairs, racing wheelchairs, and sports wheelchairs; FIRST USE DATE: 1981.02.19; FIRST USE IN COMMERCE: 1981.04.25

Goods/Services
IC 028; US 022; G & S: snow skiing device having a single runner and a seat intended for use by paraplegics, a water skiing device having a single ski and a seat intended for use by paraplegics, and stationary trainers for wheelchairs; FIRST USE DATE: 1988.01.21; FIRST USE IN COMMERCE: 1988.01.21

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
74-141861

Filing Date
1991.02.25

Registration Number
1720106

Registration Date
1992.09.29

Owner Name/Address
(REGISTRANT) Magic In Motion, Inc. CORPORATION WASHINGTON 20604 - 84th Avenue So. Kent WASHINGTON 98032

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON 000161

*** Search: 16 *** Document Number: 32 ***

*** User: EX817099 *** S-1 Number: 74003218 ***

Word Mark
SHADOW

Goods/Services
IC 028; US 022; G & S: CHILDREN'S RIDE-ON BOUNCING HORSE TOYS; FIRST USE:
1989.08.22; FIRST USE IN COMMERCE: 1989.08.22

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
74-003218

Filing Date
1989.11.16

Registration Number
1604839

Registration Date
1990.07.03

Owner Name/Address
(REGISTRANT) HEDSTROM CORP. CORPORATION ILLINOIS P.O. BOX 432 BEDFORD
PENNSYLVANIA 15522

Owner Name/Address
(LAST LISTED OWNER) HEDSTROM CORPORATION CORPORATION DELAWARE SUNNEYSIDE
ROAD, BOX 432 BEDFORD PENNSYLVANIA 15522

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit
SECT 8.; SECT 15.; COMBINED SECT 8 AND SECT 15.

*** User: EX817099 *** Serial Number: 73504102 ***

Word Mark
SHADOW

Goods/Services
IC 028; US 022; G & S: GOLF CLUBS AND GOLF CLUB SHAFTS; FIRST USE DATE:
1983.09.20; FIRST USE IN COMMERCE: 1983.09.20

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-504102

Filing Date
1984.10.16

Registration Number
1348246

Registration Date
1985.07.09

Owner Name/Address
(REGISTRANT) TI ACCLES AND POLLOCK LIMITED COMPANY UNITED KINGDOM PADDOCK
WORKS OLDBURY, WARLEY, WEST MIDLANDS ENGLAND

Owner Name/Address
(LAST LISTED OWNER) TI APOLLO LIMITED COMPANY ASSIGNEE OF UNITED KINGDOM

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit
SECT 8.; SECT 15.; COMBINED SECT 8 AND SECT 15.

21929-112
770

UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513

TO: David N. Makous
Lewis D'Amato Brisbois & Bisgaard LLP
221 N. Figueroa St. Ste. 1200
Los Angeles, CA 90012

DATE: June 6, 1997

FROM: Catherine Crush, Legal Assistant
Intent to Use/Divisional Unit

SUBJECT: Divisional Applications

APPLICANT: Honda Giken Kogyo Kabushiki Kaisha

MARK: SHADOW

This letter is to confirm that the divisional request filed on March 7, 1997 has been completed.

The goods and/or services in International Class(es) 14, 18, 26 have been placed in the newly created (child serial number 75/976234) application. The goods and/or services that are in International class (es) 16,25,28 remain in the original (parent serial number 74/082469) application.

If you have any other questions or concerns, please feel free to call ITU at (703) 308-9500 ext. 144.

HON 000164

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

2424-112

SERIAL NO. 75/082469 **APPLICANT** HONDA GIKEN KOGYO KABUSHIKI KAISHA

MARK

SHADOW

ADDRESS

DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD LLP
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

ACTION NO.

02

MAILING DATE

06/13/97

REF. NO.

12/10/97

PAPER NO.

**Assistant Commissioner
for Trademarks**
2900 Crystal Drive
Arlington, VA 22202-3513

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

Please provide in all correspondence:

1. Filing Date, serial number, mark and Applicant's name.
2. Mailing date of this action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and ZIP code.

FORM PTO-1525 (5-90)

U.S. DEPT. OF COMM. PAT. & TM OFFICE

RE: Serial Number: 75/082469

☐ The examining attorney has searched the Office records and has found no similar registered mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01.

☒ 1. Action on this application is suspended pending the disposition of:

☒ Cancellation No(s). for Reg. No. 236,950

☐ Opposition No(s).

☐ Civil Action No(s).

☐ Concurrent Use No(s).

If the applicant is a party to the above proceeding, the applicant should advise the Examining Attorney of the outcome of the proceeding when it is terminated.

☐ Application Serial No(s).

Since applicant's effective filing date is subsequent to the effective filing date of the above-identified application(s), the latter, if and when it registers, may be cited against this application. See 37 C.F.R. §2.83. A copy of information relevant to this pending application(s) ☐ is attached ☐ was sent previously.

The applicant may request that the application be removed from suspension by presenting arguments related to the potential conflict between the relevant applications or other arguments related the ground for suspension. The applicant's election to present or not to present arguments at this time will not affect the applicant's right to present arguments later.

☐ 2. Action on this application is suspended pending receipt of a certification or certified copy of the registration in the country of origin of applicant. If the registration is in a foreign language, an English translation must be submitted. The certification or certified copy of the registration should be forwarded to the Examining Attorney as soon as possible. If the foreign application is abandoned, the Examining Attorney should be advised.

☐ 3. It is noted that an assignment involving this application is presently pending before the Office. Action is suspended on this application pending recordation of the assignment. This application will be removed from suspended status upon recordation of the assignment. Notification of recordation is normally done through Office channels. However, upon receipt of the reel and frame number of the assignment, applicant should advise the Examining Attorney. See 37 C.F.R. Part 3.

☐ 4. Action on this application is suspended for months until the Examining Attorney can determine whether the cited registration will be canceled under §8 or expire under §9. 37 C.F.R. 2.67.

☐ 5. The following refusals/requirements are continued:

Jacqueline A. Lavine

EXAMINING ATTORNEY NAME

Jacqueline A. Lavine
EXAMINING ATTORNEY SIGNATURE

109

LAW OFFICE

(703) 308-9109

PHONE

HON 000165



U.S. DEPARTMENT OF COMMERCE

Patent and Trademark Office



SERIAL NO. 75/082469 **APPLICANT** HONDA GIKEN KOGYO KABUSHIKI KAISHA

PAPER NO. 21920-112

MARK
SHADOW

ADDRESS
Assistant Commissioner of Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
If no fees are enclosed, the address should include the words "Box 5."

ADDRESS
DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD LLP
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

ACTION NO.
02

MAILING DATE
04/15/97

REF. NO.

FORM PTO-1525 (5-90) U.S. DEPT. OF COMM. PAT. & TM OFFICE

TRADEMARK LAW OFFICE 109
Serial Number: 75/082469

[Mark: SHADOW

Please Place on Upper Right Corner

**of Response to Office Action ONLY **

look at this section first.

Please provide in all correspondence:

1. Filing date, serial number, mark, and applicant's name.
2. Mailing date of this Office action.
3. Your telephone number and ZIP code.

mining attorney's name and law office ber.

is suspended pending receipt of a f the registration in the country of reg ation is in a foreign language, an

Original application must be submitted. The certification or certified copy of the registration should be forwarded to the Examining Attorney as soon as possible. If the foreign application is abandoned, the Examining Attorney should be advised.

☒ 1. Action on this application is suspended pending the disposition of:

☒ Cancellation No(s). for Reg No 236,950

☐ Opposition No(s). _____

☐ Civil Action No(s). _____

☐ Concurrent Use No(s). _____

If the applicant is a party to the above proceeding, the applicant should advise the Examining Attorney of the outcome of the proceeding when it is terminated.

☐ Application Serial No(s). _____

☐ 3. It is noted that an assignment involving this application is presently pending before the Office. Action is suspended on this application pending recordation of the assignment. This application will be removed from suspended status upon recordation of the assignment. Notification of recordation is normally done through Office channels. However, upon receipt of the reel and frame number of the assignment, applicant should advise the Examining Attorney. See 37 C.F.R. Part 3.

☐ 4. Action on this application is suspended for _____ months until the Examining Attorney can determine whether the cited registration will be cancelled under §8 or expire under §9. 37 C.F.R. 2.67

☒ 5. The following refusals/requirements are continued:

Reg. No 1,624,940 will not be cancelled
until May of 1997, if no §8 is found.

Since applicant's effective filing date is subsequent to the effective filing date of the above-identified application(s), the latter, if and when it registers, may be cited against this application. See 37 C.F.R. §2.83. A copy of information relevant to this pending application(s) ☐ is attached ☐ was sent previously.

The applicant may request that the application be removed from suspension by presenting arguments related to the potential conflict between the relevant applications or other arguments related the ground for suspension. The applicant's election to present or not to present arguments at this time will not affect the applicant's right to present arguments later.

HON 000166

Jacqueline A Lavine
EXAMINING ATTORNEY SIGNATURE

109
LAW OFFICE

(703) 308-9109 Ext. 145
PHONE

JACQUELINE A. LAVINE
EXAMINING ATTORNEY' NAME

Please acknowledge receipt of our **REQUEST TO
DIVIDE APPLICATION** by affixing hereon the
Patent and Trademark Office date stamp and
return this card to our office. In re
application of:

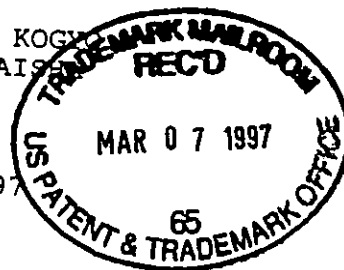
Applicant: HONDA GIKEN KOGYO
KABUSHIKI KAISHA
Mark: SHADOW
S/N: 75/082469
File No.: 21929-112
Mailed: March 4, 1997



HON 000167

Please acknowledge receipt of our RESPONSE TO
OFFICE ACTION by affixing hereon the Patent
and Trademark Office date stamp and return
this card to our office. In re application
of:

Applicant: HONDA GIKEN KOGYO
KABUSHIKI KAISHA
Mark: SHADOW
S/N: 75/082469
File No.: 21929-112
Mailed: March 4, 1997



HON 000168

21929-12

I hereby certify that this correspondence is being deposited with the United States Postal Service "First Class Mail" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: David R. Makous
David R. Makous, Reg. 29,559
Date Mailed: 3/4/97

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	HONDA GIKEN KOGYO)	Examining Attorney:
	KABUSHIKI KAISHA)	Jacqueline A. Lavine
)	
Mark:	SHADOW)	Law Office 109
)	
Serial No.:	75/082469)	
)	

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

RESPONSE TO OFFICE ACTION

Applicant has received and reviewed the Office Action dated September 10, 1996, and hereby responds thereto.

AMENDMENT

Please amend the application as follows:

1. Please delete classes 14, 18 and 26 per the Request to Divide Application.

DATA97LA: 17373.1

HON 000169

2. Please change the designation of goods in Class 16 to read in full:

"Printed matter in the nature of publications to be distributed to purchasers of Honda motorcycles."

3. Please change the designation of goods in Class 25 to read in full:

"Clothing, namely shirts, sweatshirts, sweaters, jackets, vests, pants, bandannas, belts, hats, gloves, footwear, sold through authorized Honda motorcycle dealers."

4. Please change the designation of goods in Class 28 to read in full:

"Metallic and plastic replicas of the SHADOW motorcycle sold by Honda and accessories therefor."

REMARKS

The Examining Attorney has refused registration because Applicant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 1,043,492; 1,645,004; 236,950; 1,624,940; 1,604,839; 1,348,246; 1,720,106; and 1,780,427 as to be likely to cause confusion, or to cause mistake, or to deceive.

A. Class 25: The owner of cited reference mark No. 1,624,940 has abandoned its registration

The § 8 affidavit was due for Reg. No. 1,624,940, on November 27, 1996. As of March 3, 1997, the Patent and Trademark Office advised us that it has not received any such affidavit and the registration will soon be declared abandoned. (see attached Declaration of Laura B. Kaliser).

B. Class 25: The owner of cited reference mark No. 236,950 has abandoned its registration

Upon Applicant's information and belief, cited mark No. 236,950 is no longer in use by the owner (see attached Declaration of Laura B. Kaliser). Applicant is therefore filing a Petition for Cancellation of this mark along with this Response to Office Action.

C. Class 16: Applicant's mark is not confusingly similar to the cited reference mark Nos. 1,645,004 and 1,043,492

Applicant's mark SHADOW is not likely to be confused with the mark THE SHADOW, Reg. No. 1,645,004 for "posters, lithographs, comic books, and graphic novels" and Reg. No. 1,043,492 for "novels in paperback form".

When the goods of a cited mark are "not identical or competitive, and are not related or marketed in such a way that they would be encountered by the same people in situations that could create the incorrect assumption that all goods come from

the same source . . . even where the marks are identical, confusion is not likely." TMEP §1207.01 (citing In re Unilever Ltd., 222 USPQ 981, 983 (T.T.A.B. 1984)).

Applicant's goods consist of publications to be distributed only to purchasers of Honda motorcycles through direct mail or through authorized Honda dealerships. This is a narrow and specialized trade channel greatly differing from traditional newsstands and magazine racks. There is no likelihood of confusion.

D. Class 28: Applicant's goods are unrelated to the goods identified in the cited marks in this extremely crowded class and therefore not likely to cause confusion.

The Examining Attorney has cited the following marks as being confusingly similar to Applicant's mark:

1. SHADOW - for "baseball gloves", Reg. No. 1,780,427
2. SHADOW - for "snow skiing device having a single runner and a seat intended for use by paraplegics, a water skiing device having a single ski and a seat intended for use by paraplegics, and stationary trainers for wheelchairs" Reg. No. 1,720,106
3. SHADOW - for "children's ride-on bouncing horse toys", Reg. No. 1,604,839

4. SHADOW - for "golf clubs and golf club shafts",
Reg. No. 1,348,246

The above marks are totally unrelated to Applicant's mark, SHADOW, for replicas of Honda's SHADOW motorcycle. As the above identical marks have been allowed in the same class, the consuming public is understood to be able to differentiate these many unrelated products. Therefore, on the basis of the dissimilarity of the goods, there is no likelihood of confusion.

Accordingly, Applicant requests that the § 2(d) objection be withdrawn, and the mark be published for opposition.

Respectfully submitted,

LEWIS, D'AMATO, BRISBOIS & BISGAARD

by 

David N. Makous

LEWIS, D'AMATO, BRISBOIS & BISGAARD
221 North Figueroa Street, Suite 1200
Los Angeles, California 90012
Telephone No. (213) 250-1800
Facsimile No. (213) 250-7900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	HONDA GIKEN KOGYO)	Examining Attorney:
	KABUSHIKI KAISHA)	Jacqueline A.
)	Levine
Mark:	SHADOW)	
)	Law Office 109
Serial No.:	75/082469)	
)	
)	

DECLARATION OF LAURA B. KALISER IN SUPPORT
OF APPLICANT'S RESPONSE TO OFFICE ACTION

I, Laura B. Kaliser declare as follows:

1. I am an attorney licensed to practice in the State of California, representing Applicant in this matter.

2. On March 3, 1997, I telephoned the Patent and Trademark Office Trademark Assistance Center and asked them if a § 8 affidavit (due November 11, 1996) had been filed for Reg. No. 1,624,940. The unidentified man responding to my request stated "no affidavit had been filed" and that the registration would most likely be declared abandoned.

3. On March 3, 1997, I telephoned the corporate offices of Warnaco Inc. and inquired as to whether the Trademark SHADOW was still in use by Warnaco (Reg. No. 236,950). The unidentified woman in the customer service department informed me that this mark was no longer in use.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or

DATA97LA: 17781.1

HON 000174

imprisonment, or both, under 18 U.S.C. 1001, declares that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Date: March____, 1997

By: _____
Laura B. Kaliser
Attorney for Applicant

Please acknowledge receipt of our **RESPONSE TO
OFFICE ACTION** by affixing hereon the Patent
and Trademark Office date stamp and return
this card to our office. In re application
of:

Applicant: HONDA GIKEN KOGYO
KABUSHIKI KAISHA

Mark: SHADOW

S/N: 75/082469

File No.: 21929-112

Mailed: March 4, 1997

HON 000176

21072

I hereby certify that this correspondence is being deposited with the United States Postal Service "First Class Mail" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: [Signature]
David N. Makous, Reg. 29,559
Date Mailed: 3/4/97

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	HONDA GIKEN KOGYO)	Examining Attorney:
	KABUSHIKI KAISHA)	Jacqueline A. Lavine
)	
)	Law Office 109
Mark:	SHADOW)	
)	
)	
Serial No.:	75/082469)	
)	

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

REQUEST TO DIVIDE APPLICATION

Pursuant to the Trademark Manual of Examining Procedure §1105.06 and 37 CFR §2.87, Applicant respectfully requests this application be divided as follows:

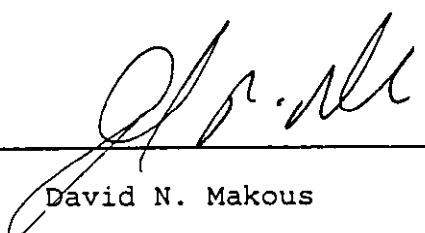
Please divide out Classes 14, 18 and 26 into one application and publish for opposition.

Enclosed is the \$100.00 fee for one application.

Respectfully submitted,

LEWIS, D'AMATO, BRISBOIS & BISGAARD

by



David N. Makous

LEWIS, D'AMATO, BRISBOIS & BISGAARD
221 North Figueroa Street, Suite 1200
Los Angeles, California 90012
Telephone No. (213) 250-1800
Facsimile No. (213) 250-7900

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

ATTORNEYS

221 NORTH FOURTH STREET
SUITE 1200
LOS ANGELES, CALIFORNIA 90012
(213) 250-1800

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LOS ANGELES, CALIFORNIA
1222

16-144

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152275

DATE

03/04/97

PAY

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\$

*****100.00
DRAFT VOID 180 DAYS FROM DATE ISSUED

TO THE
ORDER
OF

ASSISTANT COMMISSIONER OF
PATENT & TRADEMARK
BOX 17U
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

⑈152275⑈ ⑆12220144⑆

⑈07⑈098 723⑈

HON 000179

Please acknowledge receipt of our REQUEST TO
DIVIDE APPLICATION by affixing hereon the
Patent and Trademark Office date stamp and
return this card to our office. In re
application of:

Applicant: HONDA GIKEN KOGYO
KABUSHIKI KAISHA
Mark: SHADOW
S/N: 75/082469
File No.: 21929-112
Mailed: March 4, 1997

HON 000180

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

SERIAL NO. 75/082469 HONDA GIKEN KORYO KABUSHIKI KAISHA		PAPER NO. 2020-12
MARK SHADOW		ADDRESS: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 <small>If no fees are enclosed, the address should include the word "Box Responses - No Fee."</small> <small>Please provide in all correspondence:</small> 1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.
ADDRESS David N. Makous LENTZ, DIAMATO, BRISBOIS & BISGAARD, LLP 221 N. Figueroa Street, Suite 1200 Los Angeles, CA 90012	ACTION NO. 01	
MAILING DATE 09/10/98	REF. NO.	
<small>FORM PTO-1525 (5-90)</small> <small>U.S. DEPT. OF COMM. PAT. & TM OFFICE</small>		

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT.
For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 75/082469

The assigned examining attorney has reviewed the referenced application and determined the following.

Prior Registrations

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 1,043,492; 1,645,004; 0236,950; 1,624940 1,604,839; 1,348,246; 1,720,106 and 1,780,427 as to be likely to cause confusion, or to cause mistake, or to deceive. TMEP section 1207. See the enclosed registrations.

Registration Nos. 1,043,492 and 1,645,004 are cited against the goods in Class 16.

Registration Nos. 0236,950; 1,624940 are cited against Class 25.

Registration Nos. 1,604,839; 1,348,246; 1,720,106 and 1,780,427 are cited against Class 28.

There are to be no confusingly similar marks for Classes 14, 18 and 26.

HON 000181

Prior Pending Applications

The examining attorney encloses information regarding pending Application Serial Nos. 75/083,260 and 75/083261. The filing dates of the referenced applications precede the applicant's filing date. There may be a likelihood of confusion between the applicant's mark and the referenced marks under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). If one or more of the referenced applications matures into a registration, the examining attorney may refuse registration in this case under Section 2(d). 37 C.F.R. Section 2.83; TMEP section 1208.01. This applies to the Class 25 goods only.

Possible Responses

The applicant may respond to the stated refusals by doing one of the following:

- (1) amending the application to delete the class to which the refusal pertains;
- (2) traversing the refusal of the combined application as a whole; or
- (3) filing a request to divide the application, so that the mark may be published for opposition in the class to which the refusal does not pertain (37 C.F.R. Section 2.87; TMEP sections 1105.06 and 1113.03).

Please note, however, that failure to respond to a refusal which pertains to fewer than all classes in an application will result in abandonment of the combined application in its entirety.

Informalities

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

Additional Fees required

The application identifies goods that may be classified in several international classes. Effective December 3, 1993, the filing fee is \$245.00 for each class. 37 C.F.R. Section 2.6(a)(1). Therefore, the applicant must either: (1) restrict the application to the number of classes covered by the fee already paid, or (2) pay the required fee for each additional class. 37 C.F.R. Section 2.86(b); TMEP sections 810.01 and 1113.01.

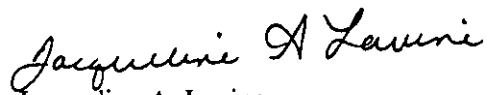
Identification of goods indefinite

The identification of goods is indefinite and requires amendment. Jewelry in Class 14 is acceptable. However, in all the other classes, applicant must specifically list each item using the common commercial name.

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. Section 2.71(b); TMEP section 804.09.

Therefore, the applicant may not amend to include any goods or services that are not within the scope of the goods and services recited in the present identification.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.



Jacqueline A. Lavine
Senior Attorney, Law Office 109
(703) 308-9109 Ext. 145
(703) 308-7194 FAX

NOTE: The Trademark Office is committed to improving the quality of our service. The Assistant Commissioner for Trademarks would like to have your comments and suggestions on ways we can improve the quality of the examination process. In the event there are any areas causing you recurrent problems, please let us know of them.

COMMENTS SHOULD NOT BE INCLUDED WITH THE RESPONSE TO AN OFFICE ACTION, BUT SHOULD BE SENT IN A SEPARATE COMMUNICATION TO THE FOLLOWING ADDRESS:

Office of Trademark Quality Review
c/o Commissioner of Patents and Trademarks
Washington, DC 20231.

Please note that this address differs from the mailing address for the response to this Office action.

*** User: EX817099 *** Ser Number: 75083261 ***

Word Mark
SHADOW

Goods/Services
IC 025; US 022 039; G & S: footwear, namely snowboard boots

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75-083261

Filing Date
1996.04.03

Owner Name/Address
(APPLICANT) WILLIAM H. KAUFMAN INC. CORPORATION CANADA 410 King Street
West Kitchener, Ontario CANADA N2G 4J8

Section 44
SECT 44

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON 000184

*** Search: 5 *** Document Number: 9 ***

*** User: EX817099 *** Se Number: 75083260 ***

Word Mark
SHADOW-BIO

Goods/Services
IC 025; US 022 039; G & S: footwear, namely snowboard boots

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75-083260

Filing Date
1996.04.03

Owner Name/Address
(APPLICANT) WILLIAM H. KAUFMAN INC. CORPORATION CANADA 410 King Street
West Kitchener, Ontario CANADA N2G 4J8

Section 44
SECT 44

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON 000185

*** Search: 5 *** Document Number: 10 ***

*** User: EX817099 *** Serial Number: 73687586 ***

Word Mark
SHADOWS

Goods/Services
IC 025; US 039; G & S: MEN'S AND LADIES' TEE-SHIRTS; LADIES' TANK TOPS,
SLACKS AND SHORTS, CARDIGANS, HATS; FIRST USE DATE: 1984.01.18; FIRST USE
IN COMMERCE: 1984.01.18

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-687586

Filing Date
1987.10.02

Registration Number
1624940

Registration Date
1990.11.27

Owner Name/Address
(REGISTRANT) IKEDA, SHAYNE INDIVIDUAL UNITED STATES 743-C WAIKAMULO ROAD
HONOLULU HAWAII 96817

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON 000186

*** Search: 5 *** Document Number: 164 ***

*** User: EX817099 *** Se Number: 71251252 ***

Word Mark
SHADOW

Goods/Services
IC 025; US 039; G & S: CORSETS, GIRDLES, BRASSIERES [, BANDEAUX,
COMBINATION CORSET-BRASSIERES, COMBINATION GIRDLE-BRASSIERES, COMBINATION
CORSET-BANDEAUX, AND COMBINATION GIRDLE-BANDEAUX]; FIRST USE DATE:
1926.11.01; FIRST USE IN COMMERCE: 1926.11.01

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
71-251252

Filing Date
1927.06.28

Change in Registration
CHANGE IN REGISTRATION HAS OCCURED

Registration Number
0236950

Registration Date
1927.12.27

Owner Name/Address
(REGISTRANT) WARNER BROTHERS COMPANY, THE CORPORATION CONNECTICUT 347
MADISON AVE. NEW YORK NEW YORK

Owner Name/Address
(LAST LISTED OWNER) WARNACO INC. CORPORATION BY CHANGE OF NAME FROM
DELAWARE 90 PARK AVENUE NEW YORK NEW YORK 10016

Type of Mark
TRADEMARK

Register
PRINCIPAL

Renewal
3RD RENEWAL 1987.12.27

HON 000187

*** Search: 5 *** Document Number: 198 ***

*** User: EX817099 *** Serial Number: 73827363 ***

Word Mark
THE SHADOW

Goods/Services
IC 016; US 038; G & S: POSTERS, LITHOGRAPHS, COMIC BOOKS, AND GRAPHIC
NOVELS; FIRST USE DATE: 1940.03.00; FIRST USE IN COMMERCE: 1940.03.00

Goods/Services
IC 009; US 036; G & S: PRERECORDED AUDIO CASSETTE TAPES AND PHONOGRAPH
RECORDS FEATURING STORIES FROM RADIO PROGRAMS; FIRST USE DATE:
1972.00.00; FIRST USE IN COMMERCE: 1972.00.00

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-827363

Filing Date
1989.09.25

Registration Number
1645004

Registration Date
1991.05.21

Owner Name/Address
(REGISTRANT) ADVANCE MAGAZINE PUBLISHERS INC. CORPORATION NEW YORK 350
MADISON AVENUE NEW YORK NEW YORK 10017

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON 000188

*** Search: 7 *** Document Number: 141 ***

*** User: EX817099 *** Serial Number: 73038765 ***

Word Mark
THE SHADOW

Goods/Services
IC 016; US 038; G & S: NOVELS IN PAPERBACK FORM; FIRST USE: 1963.09.00;
FIRST USE IN COMMERCE: 1963.09.00

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-038765

Filing Date
1974.12.05

Registration Number
1043492

Registration Date
1976.07.13

Owner Name/Address
(REGISTRANT) CONDE NAST PUBLICATIONS INC., THE CORPORATION NEW YORK 350
MADISON AVE. NEW YORK NEW YORK 10017

Owner Name/Address
(LAST LISTED OWNER) ADVANCE MAGAZINE PUBLISHERS INC. CORPORATION NEW YORK
350 MADISON AVENUE NEW YORK NEW YORK 10017

Prior US Registration
0534805

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit
SECT 8.; SECT 15.; COMBINED SECT 8 AND SECT 15.

Renewal
1ST RENEWAL 1996.05.16

HON 000189

*** Search: 7 *** Document Number: 178 ***

SHADOW

Word Mark
SHADOW

Goods/Services
IC 028; US 022; G & S: baseball gloves; FIRST USE DATE: 1992.07.00; FIRST
USE IN COMMERCE: 1992.07.00

Mark Drawing Code
(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number
74-323342

Filing Date
1992.10.19

Registration Number
1780427

Registration Date
1993.07.06

Owner Name/Address
(REGISTRANT) GLOVESMITH, Inc. CORPORATION MISSOURI 20 Village Plaza Arnold
MISSOURI 63010

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON 000190

*** User: EX817099 *** Se Number: 74141861 ***

Word Mark
SHADOW

Goods/Services
IC 012; US 019; G & S: wheelchairs, racing wheelchairs, and sports wheelchairs; FIRST USE DATE: 1981.02.19; FIRST USE IN COMMERCE: 1981.04.25

Goods/Services
IC 028; US 022; G & S: snow skiing device having a single runner and a seat intended for use by paraplegics, a water skiing device having a single ski and a seat intended for use by paraplegics, and stationary trainers for wheelchairs; FIRST USE DATE: 1988.01.21; FIRST USE IN COMMERCE: 1988.01.21

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
74-141861

Filing Date
1991.02.25

Registration Number
1720106

Registration Date
1992.09.29

Owner Name/Address
(REGISTRANT) Magic In Motion, Inc. CORPORATION WASHINGTON 20604 - 84th Avenue So. Kent WASHINGTON 98032

Type of Mark
TRADEMARK

Register
PRINCIPAL

*** User: EX817099 *** Se Number: 74003218 ***

Word Mark
SHADOW

Goods/Services
IC 028; US 022; G & S: CHILDREN'S RIDE-ON BOUNCING HORSE TOYS; FIRST USE:
1989.08.22; FIRST USE IN COMMERCE: 1989.08.22

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
74-003218

Filing Date
1989.11.16

Registration Number
1604839

Registration Date
1990.07.03

Owner Name/Address
(REGISTRANT) HEDSTROM CORP. CORPORATION ILLINOIS P.O. BOX 432 BEDFORD
PENNSYLVANIA 15522

Owner Name/Address
(LAST LISTED OWNER) HEDSTROM CORPORATION CORPORATION DELAWARE SUNNEYSIDE
ROAD, BOX 432 BEDFORD PENNSYLVANIA 15522

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit
SECT 8.; SECT 15.; COMBINED SECT 8 AND SECT 15.

HON 000192

*** Search: 16 *** Document Number: 38 ***

*** User: EX817099 *** Se Number: 73504102 ***

Word Mark
SHADOW

Goods/Services
IC 028; US 022; G & S: GOLF CLUBS AND GOLF CLUB SHAFTS; FIRST USE DATE:
1983.09.20; FIRST USE IN COMMERCE: 1983.09.20

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-504102

Filing Date
1984.10.16

Registration Number
1348246

Registration Date
1985.07.09

Owner Name/Address
(REGISTRANT) TI ACCLES AND POLLOCK LIMITED COMPANY UNITED KINGDOM PADDOCK
WORKS OLDBURY, WARLEY, WEST MIDLANDS ENGLAND

Owner Name/Address
(LAST LISTED OWNER) TI APOLLO LIMITED COMPANY ASSIGNEE OF UNITED KINGDOM

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit
SECT 8.; SECT 15.; COMBINED SECT 8 AND SECT 15.

HON 000193

*** Search: 16 *** Document Number: 43 ***

FILING 1 EIPT FOR TRADEMARK APPLIC ON

Page 01 of 01

Receipt on the DATE OF FILING of the application for registration and filing fees is acknowledged for the mark identified below. The DATE OF FILING is contingent upon the collection of any payment made by check or draft. Your application will be considered in the order in which it was received and you will be notified as to the examination thereof. Correspondence should be expected from the Patent and Trademark Office in approximately months. When inquiring about this application, include the SERIAL NUMBER, DATE OF FILING, OWNER NAME, and MARK.

06

David N. Makous
LEWIS, D'AMATO, BRISBOIS & BISGAARD, LLP
221 N. Figueroa Street, Suite 1200
Los Angeles, CA 90012

TMPRE

ATTORNEY
REFERENCE NUMBER

PLEASE REVIEW THE ACCURACY OF THE FILING RECEIPT DATA.

A request for correction to the notice of allowance should be submitted within 30 days to the following address: ASSISTANT COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VIRGINIA 22202-3313. The correspondence should be marked to the attention of the Office of Trademark Program Control. The Patent and Trademark Office will review the request and make corrections when appropriate.

SERIAL NUMBER: 75/082469**DATE OF FILING: 04/02/1996****MARK: SHADOW****MARK TYPE(S): TRADEMARK****DRAWING TYPE: WORDS, LETTERS, OR NUMBERS IN TYPED FORM****SECTION 1(A): NO****SECTION 1(B): YES****SECTION 44: NO****ATTORNEY: David N. Makous****OWNER NAME: HONDA GIKEN KOGYO KABUSHIKI KAISHA****OWNER ADDRESS: 2-1-1 Minami-Aoyama,
Minato-Ku
Tokyo 107
JAPAN****ENTITY: CORPORATION****CITIZENSHIP/DOMICILE: JAPAN****INTERNATIONAL CLASS****DATE OF FIRST USE****DATE OF FIRST USE IN COMMERCE****ONLY THOSE DATES OF USE AND CLASSES FILED UNDER SECTION 1(A) ARE LISTED****GOODS/SERVICES BY INTERNATIONAL CLASS**

014-jewelry
016-paper goods and printed matter
018-leather goods
025-clothing and footwear
026-fancy goods
028-toys and sporting goods

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED**HON 000194**

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Box ITU, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: David N. Makous, Reg. 29,559

Date Mailed: 5/25/99

Express Mail No. EF 740 580 157 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
Honda Giken Kogyo Kabushiki)	
Kaisha (Honda Motor Co., Ltd.)	
Serial No. 75/082470)	
Filed: April 2, 1996)	
Int'l Classes: 16, 25, 28)	
Mark: SHADOW AMERICAN)	Docket No. 21929-110
CLASSIC EDITION)	

Assistant Commissioner of Patents and Trademarks
Box ITU
2900 Crystal Drive
Arlington, Virginia 22202-3513

AMENDMENT TO DELETE GOODS
UNDER 37 C.F.R. § 2.77

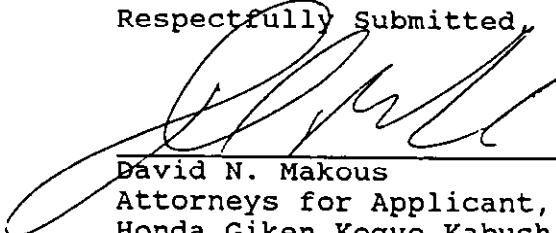
Pursuant to 37 C.F.R. § 2.77, Applicant Honda Giken Kogyo Kabushiki Kaisha amends the identification of goods cited in the Notice of Allowance dated July 29, 1997, to delete goods as follows:

Delete "sweatshirts, sweaters, jackets, vests, pants, bandannas, belts, gloves, and footwear" from the identification of goods. The resulting identification of goods is as follows:

Int'l Class 25: "Clothing, namely shirts and hats, sold through authorized motorcycle dealers"

Respectfully Submitted,

Dated: May 12, 1999



David N. Makous
Attorneys for Applicant,
Honda Giken Kogyo Kabushiki Kaisha

David N. Makous, Esq.
LEWIS, D'AMATO, BRISBOIS & BISGAARD
221 North Figueroa Street, Suite 1200
Los Angeles, California 90012
Telephone No. (213) 250-1800
Facsimile No. (213) 250-7900

Please acknowledge receipt of our Amendment to Delete Goods by affixing hereon the Patent and Trademark Office date stamp and return this card to our office. In re application of:

Mark:

Applicant:

Int'l. Classes:

Our File No.:

Mailed:

SHADOW AMERICAN CLASSIC EDITION

Honda Giken Kogyo Kabushiki Kaisha

16, 25, 28

21929-110

May 25, 1999

HON 000479

Please acknowledge receipt of our Amendment to Delete Goods by affixing hereon the Patent and Trademark Office date stamp and return this card to our office. In re application of:

Mark:	SHADOW AMERICAN CLASSIC EDITION
Applicant:	Honda Giken Kogyo Kabushiki Kaisha
Int'l. Classes:	16, 25, 28
Our File No.:	21929-110
Mailed:	May 25, 1999



05-26-1999

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #54

HON 000480

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By: David M. Makous, Reg. 29,559

Date Mailed: 5/25/99

Express Mail No. EF 740 580 157 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
)	
Honda Giken Kogyo Kabushiki)	
Kaisha (Honda Motor Co., Ltd.))	
)	
Serial No. 75/082470)	
)	
Filed: April 2, 1996)	
)	
Int'l Classes: 16, 25, 28)	
)	
Mark: SHADOW AMERICAN)	Docket No. 21929-110
CLASSIC EDITION)	
)	

Assistant Commissioner of Patents and Trademarks
Box ITU - FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

STATEMENT OF USE UNDER
37 C.F.R. 2.88 WITH DECLARATION

Applicant, Honda Giken Kogyo Kabushiki Kaisha, requests registration of the above-identified trademark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. § 1051 et seq., as amended).

Applicant is using the mark in commerce in connection with the goods identified in the Notice of Allowance dated June 2, 1998, issued relative to this application.

The mark was first used with the goods in International Class 16 at least as early as October 1996; was first used in interstate commerce at least as early as October 1996; and is now in use in such commerce with these goods.

The trademark is used with the goods in International Class 16 by placing the mark on advertisements, marketing and promotional materials, and in other ways customary in the trade. Three (3) specimens showing the mark as used in International Class 16 in commerce is submitted with this Statement of Use.

The mark was first used with the goods in International Classes 25 and 28 at least as early as April 1996; was first used in interstate commerce at least as early as April 1996; and is now in use in such commerce with these goods.

The trademark is used with the goods in International Classes 25 and 28 by placing the mark on the goods, and in other ways customary in the trade. Three (3) specimens showing the mark as used in International Classes 25 and 28 in commerce are submitted with this Statement of Use.

The fee prescribed by Section 2.6(a)(3) is enclosed herewith.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this Statement of Use on behalf of the Applicant; he believes the Applicant to be the owner of the trademark sought to be registered; the trademark is now in use in commerce; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Dated: May 19, 1999

By: A. Hyogo
Mr. Atsuyoshi Hyogo
Director, Honda Motor Co., Ltd.

David N. Makous, Esq.
Lewis, D'Amato, Brisbois & Bisgaard
221 No. Figueroa St., Ste. 1200
Los Angeles, California 90012
Telephone: (213) 250-1800
Facsimile: (213) 250-7900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Honda Giken Kogyo)
Kabushiki Kaisha)
(Honda Motor Co.,)
Ltd.))
Serial No.: 75/082470)
Filed: April 2, 1996)
Int'l Classes: 16, 25, 28)
Mark: SHADOW AMERICAN)
CLASSIC EDITION)

(Specimen Int'l Class 16)

99LA-44388.1

HON 000484

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Honda Giken Kogyo)
Kabushiki Kaisha)
(Honda Motor Co.,)
Ltd.))

Serial No.: 75/082470)

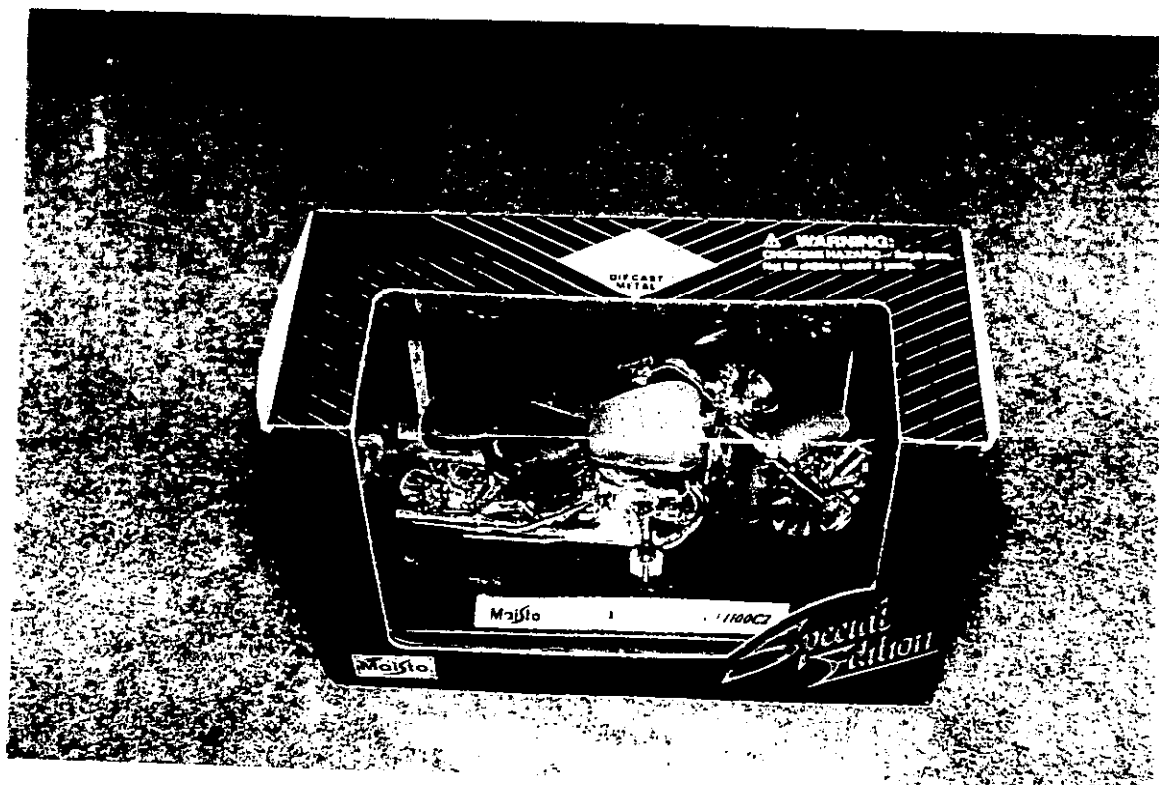
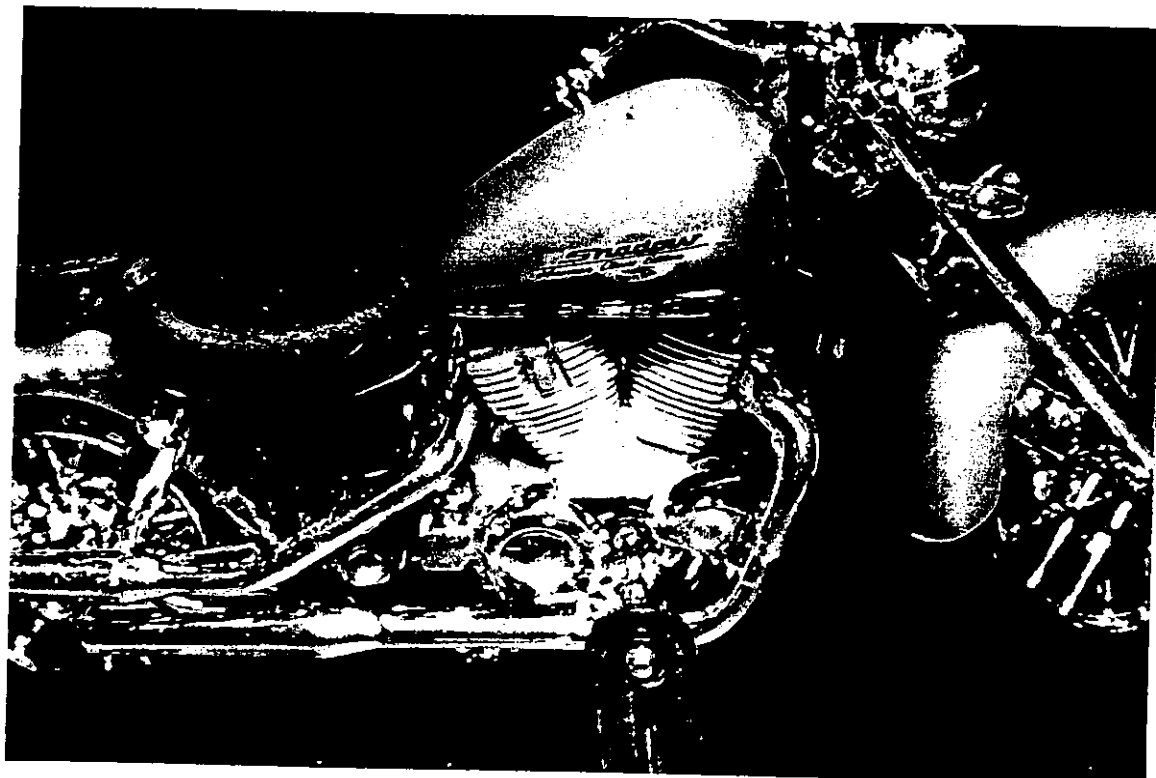
Filed: April 2, 1996)

Int'l Classes: 16, 25, 28)

Mark: SHADOW AMERICAN)
CLASSIC EDITION)



(Specimen Int'l Class 25)



HON 000486

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Honda Giken Kogyo)
Kabushiki Kaisha)
(Honda Motor Co.,)
Ltd.))
Serial No.: 75/082470)
Filed: April 2, 1996)
Int'l Classes: 16, 25, 28)
Mark: SHADOW AMERICAN)
CLASSIC EDITION)
_____)

(Specimen Int'l Class 28)

99LA-44388.1

HON 000487

Please acknowledge receipt of our Statement of Use by affixing hereon the
Patent and Trademark Office date stamp and return this card to our office.
In re application of:

Mark:	SHADOW AMERICAN CLASSIC EDITION
Applicant:	Honda Giken Kogyo Kabushiki Kaisha
Int'l. Classes:	16, 25, 28
Our File No.:	21929-110
Mailed:	May 25, 1999

99LA-48288.1

HON 000488

Please acknowledge receipt of our Statement of Use by affixing hereon the Patent and Trademark Office date stamp and return this card to our office.

In re application of:

Mark:

Applicant:

Int'l. Classes:

Our File No.:

Mailed:

SHADOW AMERICAN CLASSIC EDITION

Honda Giken Kogyo Kabushiki Kaisha

16, 25, 28

21929-110

May 25, 1999



05-26-1999

U.S. Patent & TMO/TM Mail Rpt Dt. #54

991A-48288.1

HON 000489

LEWIS, D'AMATO, BRISBOIS & BISGAARD

COST ADVANCE TICKET
CHECK REQUEST

161412

NY 87629

1. ☒ Check—date needed Today
2. ☐ Direct expense— 150 ☐ Overtime Dinner Reimbursement 151 ☐ Mileage 152 ☐ Miscellaneous 153 ☒ Filing Fee
- ☐ Firm expense 154 ☐ Witness Fee 155 ☐ Deposition 157 ☐ Reproduction ☐ Clients advance check
3. Client and file name Honda - Shadow Acctg. use - G. L. No. Client and matter No.: 21929-112
4. Payee or vendor: Asst. Commissioner of Patents & Trademark Amount \$ 245.00
5. Mailing address (if applicable): 2900 Crystal Dr., Arlington, VA 22202-3513
6. Reference on remittance advice: Filing fee for ITU Application
7. Explanation for billing purposes: Filing fee for ITU Application

8. Disposition of check ☐ Mail ☒ Return to Raffi A. Nahabedian Auth. by Raffi A. Nahabedian Signature [Signature] Number 1 Date 4/2/96

Instructions:

- (1) Original to data processing/numeric copy
(2) Second copy (yellow) attached to invoice to accounting
(3) Third copy (pink) retain in attorney's file

21929-112
COURT

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Commissioner of Patents and Trademarks, Box ITU, 2900 Crystal Drive, Arlington, Virginia 22202-3515

By: RMA

Raffi A. Nahabedian

Date Mailed: April 2, 1996

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
APPLICATION FOR REGISTRATION OF TRADEMARK ON PRINCIPAL REGISTER
[Intent-to-Use]

Applicant: HONDA GIKEN KOGYO)
KABUSHIKI KAISHA)
(Honda Motor Co., Ltd.))
Address: 2-1-1 Minami-Aoyama,)
Minato-Ku, Tokyo 107,)
JAPAN)
Mark: SHADOW)
I.C.: 14, 16, 18, 25, 26 & 28)

TO THE ASSISTANT COMMISSIONER OF PATENTS AND TRADEMARKS:

TRANSMITTAL LETTER

Enclosed herewith and pertaining to the above-described Intent-to-Use trademark application are the following documents/items:

1. Intent-to-Use Application for Registration of the mark SHADOW;
2. Drawing for the mark SHADOW in International Classes 14, 16, 18, 25, 26 & 28; and
3. A check in the amount of \$245.00.

DATED: April 2, 1996

Respectfully submitted,
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

By RMA

Raffi A. Nahabedian
Attorneys for Applicant

DATA96LA: 32245.1

HON 000196

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Box ITU, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: R. M. A. N.

Raffi A. Nahabedian

Date Mailed: APRIL 2, 1996

Express Mail No. EF086997170US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
APPLICATION FOR REGISTRATION OF TRADEMARK ON PRINCIPAL REGISTER
[INTENT-TO-USE]

Applicant:	HONDA GIKEN KOGYO)	Mark: SHADOW
	KABUSHIKI KAISHA)	
	(Honda Motor Co., Ltd.))	
Address:	2-1-1 Minami-Aoyama,)	I.C. 14, 16, 18,
	Minato-Ku, Tokyo 107,)	25, 26 & 28
	JAPAN)	
)	
)	

TO THE ASSISTANT COMMISSIONER OF PATENTS AND TRADEMARKS:

The above-identified Applicant, Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.), a Japanese corporation, requests registration of the mark shown in the accompanying drawing in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 1051 et seq., as amended), for the following services:

Int'l Class 14: "Jewelry"

DATA96LA: 16358.1

HON 000197

Int'l Class 16: "Paper goods and printed matter"

Int'l Class 18: "Leather goods"

Int'l Class 25: "Clothing and footwear"

Int'l Class 26: "Fancy goods"

Int'l Class 28: "Toys and sporting goods"

Applicant has a bona fide intention to use the mark in commerce in association with the above-identified goods (15 U.S.C. 1051(b), as amended).

The mark will be used by applying it to the goods themselves and in other ways customary in the trade.

DECLARATION

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this application on behalf of the applicant; he believes the applicant to be the owner of the trademark; to the best of his

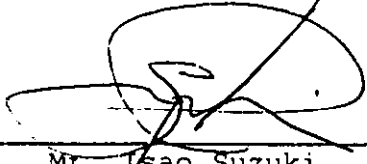
knowledge and belief no other persons, firm, corporation, or association has the right to use the above identified mark in commerce, either in the identical form or in such near resemblance thereto as may be likely, when applied to the goods or services of such other person, to cause confusion, or to cause mistake, or to deceive; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Applicant hereby appoints David N. Makous, Sarira D. Alexander, Raffi A. Nahabedian, and each member of the firm of Lewis, D'Amato, Brisbois & Bisgaard, 221 North Figueroa Street, Suite 1200, Los Angeles, California 90012, telephone number (213) 250-1800, its principal attorneys to prosecute this application, to transact all business in the Patent and Trademark Office in connection therewith, to receive notification of acceptance, and any certificate issued.

DESIGNATION OF DOMESTIC REPRESENTATIVE

Applicant hereby designates David N. Makous, a resident of the United States, at Lewis, D'Amato, Brisbois & Bisgaard, 221 North Figueroa Street, Suite 1200, Los Angeles, California 90012, as its domestic representative in all matters required by 15 U.S.C. §1051(e) and 37 C.F.R. §2.24.

Dated: April 1, 1996



Mr. Isao Suzuki
Director, Honda Motor Co., Ltd.

LEWIS, D'AMATO, BRISBOIS & BISGAARD, LLP
221 N. Figueroa Street, Suite 1200
Los Angeles, California 90012
(213) 250-1800

DRAWING
[INTENT-TO-USE]

Applicant: Honda Giken Kogyo Kabushiki Kaisha
(Honda Motor Co., Ltd.)

Address: 2-1-1 Minami-Aoyama
Minato-Ku, Tokyo 107,
JAPAN

Mark: SHADOW

Goods: "Jewelry" (Int'l Class 14)
"Paper goods and printed matter" (Int'l Class 16)
"Leather goods" (Int'l Class 18)
"Clothing and footwear" (Int'l Class 25)
"Fancy goods" (Int'l Class 26)
"Toys and sporting goods" (Int'l Class 28)

SHADOW

POST OFFICE TO ADDRESSEE EXPRESS MAIL EMS

EF086997170US

ORIGIN (POSTAL USE ONLY)

P.O. ZIP		Day of Delivery		Flat Rate Envelope	
		Next		Postage	
Date In		12 Noon		Return Receipt	
Mo. Day Yr.		Military		C.O.D.	
Time In		2nd Day		Total Postage & Fees	
11 AM		Int'l Agency Country Code			
Weight		As explained			
lbs. oz.		(C.O.D. Initials)			
The Delivery					

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SERVICE GUARANTEE AND LIMITS
ON THE INSURANCE COVERAGE

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METHOD OF PAYMENT:

Express Mail Corporate Acct No

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Postal Service Acct No

☐ WAIVER OF SIGNATURE (Domestic Only) I wish delivery to be made without obtaining the signature of the addressee or the addressee's agent (if in the judgment of the delivery employee, the article can be left in a secure location) and I authorize the delivery employee to sign that the shipment was delivered and understand that the signature of the delivery employee will constitute valid proof of delivery.

☐ NO DELIVERY

☐ WEEKEND ☐ HOLIDAY

Customer Signature

Address and other information for delivery.

Post Office

City

State

Zip

Country

Phone

Telex

Radio

Teletype

Facsimile

Other

LABEL 11-B 593

For Pickup or Tracking Call 1-800-222-1811


HON 000201

CUSTOMER COPY



Please acknowledge receipt of our INTENT-TO-USE APPLICATION and OUR CHECK IN THE AMOUNT OF \$245.00 by affixing hereon the Patent and Trademark Office date stamp and returning it to our office. In re application of:

Applicant: HONDA GIKEN KOGYO
KABUSHIKI KAISHA
(Honda Motor Co., Ltd.)
Address: 2-1-1 Minami-Aoyama, 2 1996
Minato-Ku, Tokyo 107,
JAPAN
Mark: SHADOW
Int'l Classes: 14, 16, 18, 25, 26 & 28
File No.: 21929-112
Mailed: April 2, 1996 75082469



Int. Cls.: 16, 25, and 28

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

Reg. No. 2,285,785

United States Patent and Trademark Office

Registered Oct. 12, 1999

**TRADEMARK
PRINCIPAL REGISTER**

SHADOW AMERICAN CLASSIC EDITION

HONDA GIKEN KOGYO KABUSHIKI KAISHA
(HONDA MOTOR CO., LTD.) (JAPAN CORPORATION)
2-1-1 MINAMI-AOYAMA, MINATO-KU
TOKYO 107, JAPAN

FOR: PRINTED MATTER IN THE NATURE OF PUBLICATIONS TO BE DISTRIBUTED TO PURCHASERS OF REGISTRANT'S MOTORCYCLES, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 10-0-1996; IN COMMERCE 10-0-1996.

FOR: CLOTHING, NAMELY, SHIRTS AND HATS, SOLD THROUGH AUTHORIZED MOTORCYCLE DEALERS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 4-0-1996; IN COMMERCE 4-0-1996.

FOR: REPLICAS OF THE REGISTRANT'S MOTORCYCLE AND ACCESSORIES THEREFOR SOLD BY REGISTRANT'S AND ITS AUTHORIZED DEALERS, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

FIRST USE 4-0-1996; IN COMMERCE 4-0-1996.

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

SN 75-082,470, FILED 4-2-1996.

JACQUELINE A. LAVINE, EXAMINING ATTORNEY

**APPLICANT'S
EXHIBIT**

20

HON 000472

The United States of America



CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office, that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks, and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are a part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



A handwritten signature in black ink, reading "J. Todd Pichini".

Acting Commissioner of Patents and Trademarks

HON 000473

Maintenance Requirements

Section 8: This registration will be cancelled after six (6) years by the Commissioner of Patents and Trademarks, *UNLESS, before the end of the sixth year following the date of registration shown on this certificate*, the registrant files in the U.S. Patent and Trademark Office an affidavit of continued use as required by Section 8 of the Trademark Act of 1946, 15 U.S.C. §1058, as Amended. **It is recommended that the Registrant contact the Patent and Trademark Office approximately five years after the date shown on this registration to determine the requirements and fees for filing a Section 8 affidavit that are in effect at that time.** Currently a fee and a specimen showing how the mark is used in commerce are required for *each* international class of goods and/or services identified in the certificate of registration and both must be enclosed with the affidavit.

Section 9: This registration will expire by law after ten (10) years, *UNLESS, before the end of the tenth year following the date of registration shown on this certificate*, the registrant files in the U.S. Patent and Trademark Office an application for renewal of the registration as required by Section 9 of the Trademark Act of 1946, 15 U.S.C. §1059, as Amended. **It is recommended that the Registrant contact the Patent and Trademark Office approximately nine years after the date shown on this registration to determine the requirements and fees for filing a Section 9 application for renewal that are in effect at that time.** Currently a fee and a specimen showing how the mark is used in commerce are required for *each* international class of goods and/or services identified in the certificate of registration and both must be enclosed with the application for renewal.

UNITED STATES DEPARTMENT OF COMMERCE
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513
Sep 2, 1999

21924-110

USPTO

PTO

U

NOTICE OF ACCEPTANCE OF STATEMENT OF USE

TM109

ATTORNEY
REFERENCE NUMBER:

DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD LLP
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

SERIAL NUMBER: 75/082470
MARK: SHADOW AMERICAN CLASSIC EDITION
OWNER: HONDA GIKEN KOGYO KABUSHIKI KAISHA (Hond)

The statement of use filed in regard to the above-identified application has been accepted. This acceptance signifies that the statement of use is accepted in all respects and that the mark is entitled to be registered. Accordingly, the registration will issue in due course barring any extraordinary circumstances.

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

SAN DIEGO OFFICE
SUITE 800
550 WEST "C" STREET
SAN DIEGO, CALIFORNIA 92101-3540
TELEPHONE (619) 233-1006

COSTA MESA OFFICE
SUITE 1400
650 TOWN CENTER DRIVE
CENTER TOWER BUILDING
COSTA MESA, CALIFORNIA 92626-1925
TELEPHONE (714) 545-9200

SAN FRANCISCO OFFICE
SUITE 1900
601 CALIFORNIA STREET
SAN FRANCISCO, CALIFORNIA 94108-2805
TELEPHONE (415) 382-2580

LAWYERS
SUITE 1200
221 NORTH FIGUEROA STREET
LOS ANGELES, CALIFORNIA 90012-2601
TELEPHONE (213) 250-1800
TELEX: 194508

INLAND EMPIRE OFFICE
TRI-CITY CORPORATE CENTRE
SUITE 600
650 EAST HOSPITALITY LANE
SAN BERNARDINO, CALIFORNIA 92408-3508
TELEPHONE (909) 387-1130

SACRAMENTO OFFICE
SUITE 200
2500 VENTURE OAKS WAY
SACRAMENTO, CALIFORNIA 95833-3500
TELEPHONE (916) 564-5400

FACSIMILES:
LOS ANGELES: (213) 250-7900
SAN DIEGO: (619) 233-8627
COSTA MESA: (714) 850-1030
SAN FRANCISCO: (415) 434-0882
SAN BERNARDINO: (909) 387-1138
SACRAMENTO: (916) 564-5444

May 24, 1999

MARGA UMA VANZANDT
DIRECT DIAL (213) 680-6048
E-MAIL: VANZANDT@LD88.COM

VIA EXPRESS MAIL

Assistant Commissioner of Patents
and Trademarks
Box Trademark Application
2900 Crystal Drive
Arlington, Virginia 22202-3513

EF740580157US

Dear Sir or Madam:

Enclosed please find (1) an Amendment to Delete Goods and return postcard; and (2) Statement of Use, a check for the filing fee, and return postcard, for the following trademark application:

Applicant: Honda Giken Kogyo Kabushiki Kaisha
(Honda Motor Co., Ltd.)
Mark: SHADOW AMERICAN CLASSIC EDITION
Classes: 16, 25, 28
Docket No.: 21929-110
Filing Fee: \$300

Please date stamp the postcards and return to our office upon receipt of this correspondence.

Very truly yours,

Marga Uma Vanzandt

Marga Uma Vanzandt
Paralegal to David N. Makous, of
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

Enclosures

LEWIS, D'AMATO, BRISBOIS & BISGAARD LP

ATTORNEYS

221 NORTH FIGUEROA STREET

SUITE 1200

LOS ANGELES, CALIFORNIA 90012

(213) 250-1800

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IMPERIAL BANK
LOS ANGELES, CALIFORNIA 1222

CHECK NO.

DATE 05/13/99

189120

PAY

\$*****300 DOLLARS AND 00/100****

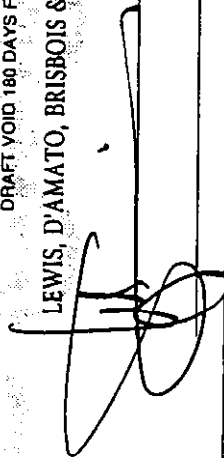
ASSISTANT COMMISSIONER OF
PATENT & TRADEMARK
BOX ITU
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513

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OF

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LEWIS, D'AMATO, BRISBOIS & BISGAARD LP



189120 12220144 107098 723

HON 000490

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EF 740580157US

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<input type="checkbox"/> INTERNATIONAL SHIPMENTS ONLY		P.O. ZIP	Day of Delivery <input type="checkbox"/> Next <input type="checkbox"/> Second	
<input type="checkbox"/> Business Papers		Date in Mo. Day Yr.	<input type="checkbox"/> 12 Noon <input type="checkbox"/> 3 PM	
<input type="checkbox"/> Merchandise		Time in Mo. Day Yr.	<input type="checkbox"/> Military <input type="checkbox"/> 2nd Day <input type="checkbox"/> 3rd Day	
Customs forms and commercial invoices may be required. See Pub 275 and International Mail Manual		Weight lbs oz	Init Alpha County Code	
<input type="checkbox"/> No Delivery <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday		Acceptance Clerk Initials		
		Postage \$		
		Flat Rate Envelope Postage Receipt		
		C.O.D.		
		Total Postage & Fees \$		

DELIVERY (POSTAL USE ONLY)

Delivery Attempt Mo. Day	Time <input type="checkbox"/> AM <input type="checkbox"/> PM	Employee Signature
Delivery Attempt Mo. Day	Time <input type="checkbox"/> AM <input type="checkbox"/> PM	Employee Signature
Date of Delivery Mo. Day	Time <input type="checkbox"/> AM <input type="checkbox"/> PM	Employee Signature
Signature of Addressee or Agent X		
Name - Please Print X		

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FROM: (PLEASE PRINT) PHONE		<input type="checkbox"/> WEEKEND <input type="checkbox"/> HOLIDAY Customer Signature	

David N. Makous, Esq.
Lewis, D'Amato, Bratisbois & Bisgaard
221 N. Figueroa St., Ste. 1200
Los Angeles, CA 90012

Assistant Commissioner of Patents
and Trademarks
BOX ITU-FEE
2900 Crystal Drive
Arlington, VA 22202-3513

21929-110 and 21929-213

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HON 000491

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UNITED STATES DEPARTMENT OF COMMERCE
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513
Dec 24, 1998

NOTICE OF APPROVAL OF EXTENSION REQUEST

DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD LLP
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

TM109

ATTORNEY
REFERENCE NUMBER:

219291-110
PTO

SERIAL NUMBER: 75/082470

MARK: SHADOW AMERICAN CLASSIC EDITION

OWNER: HONDA GIKEN KOGYO KABUSHIKI KAISHA (Honda)

EXTENSION REQUEST NUMBER: 1

NOTICE OF ALLOWANCE DATE: Jun 2, 1998

6/2/99

THE ABOVE NUMBERED EXTENSION REQUEST FOR FILING A STATEMENT OF USE HAS BEEN APPROVED BY THIS OFFICE.

THE APPLICANT HAS UNTIL Jun 2, 1999 TO FILE A STATEMENT OF USE OR ANOTHER EXTENSION REQUEST. THE APPLICANT CAN FILE A TOTAL OF FIVE EXTENSION REQUESTS NOT TO EXCEED 36 MONTHS FROM THE NOTICE OF ALLOWANCE DATE.

IF THERE ARE ANY QUESTIONS REGARDING THIS NOTICE, PLEASE CONTACT THE TRADEMARK ASSISTANCE CENTER AT (703)308-9000.

HON 000492

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

SAN DIEGO OFFICE
SUITE 800
550 WEST "C" STREET
SAN DIEGO, CALIFORNIA 92101-3540
TELEPHONE (619) 233-1006

COSTA MESA OFFICE
SUITE 1400
650 TOWN CENTER DRIVE
CENTER TOWER BUILDING
COSTA MESA, CALIFORNIA 92626-1925
TELEPHONE (714) 545-9200

SAN FRANCISCO OFFICE
SUITE 1900
801 CALIFORNIA STREET
SAN FRANCISCO, CALIFORNIA 94108-2805
TELEPHONE (415) 362-2580

LAWYERS
SUITE 1200
221 NORTH FIGUEROA STREET
LOS ANGELES, CALIFORNIA 90012-2601
TELEPHONE (213) 250-1800
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INLAND EMPIRE OFFICE
TRI-CITY CORPORATE CENTRE
SUITE 600
650 EAST HOSPITALITY LANE
SAN BERNARDINO, CALIFORNIA 92408-3508
TELEPHONE (909) 387-1130

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SUITE 200
2500 VENTURE OAKS WAY
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COSTA MESA: (714) 850-1030
SAN FRANCISCO: (415) 434-0882
SAN BERNARDINO: (909) 387-1138
SACRAMENTO: (916) 564-5444

December 1, 1998

MARGA UMA VANZANDT
DIRECT DIAL (213) 680-6048
E-MAIL: VANZANDT@LD88.COM

VIA U.S. EXPRESS MAIL

Assistant Commissioner of Patents
and Trademarks
Box ITU
2900 Crystal Drive
Arlington, Virginia 22202-3513

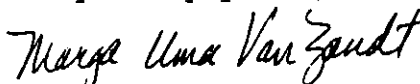
Dear Sir or Madam:

Enclosed is a First Request for Extension of Time to
File Statement of Use, a postcard and our check to cover the
filing fee, as follows:

Applicant:	Honda Giken Kogyo Kabushiki Kaisha
Mark:	SHADOW AMERICAN CLASSIC EDITION
Classes:	16, 25, 28
S/N:	75/082470
Docket No.:	21929-110
Filing Fee:	\$300.00

Please date stamp the postcard and return it to our
office upon receipt of this correspondence.

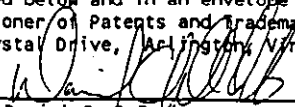
Very truly yours,



Marga Uma VanZandt
Paralegal to David N. Makous, of
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

Enclosures

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Box 17U, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: 
Daniel C. DeCarlo

Date Mailed: 12-1-98

Express Mail No. EF 740 588 460 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
)	
Honda Giken Kogyo Kabushiki)	
Kaisha (Honda Motor Co., Ltd.))	
)	
Serial No.: 75/082470)	
)	
Int'l Class: 16, 25, 28)	
)	
Mark: SHADOW AMERICAN)	
CLASSIC EDITION)	Our Docket No. 21929-110

Assistant Commissioner of Patents and Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

FIRST REQUEST FOR EXTENSION OF TIME
UNDER 37 C.F.R. § 2.89 TO FILE
STATEMENT OF USE

Sir:

Applicant requests a six-month extension of time to file the Statement of Use under 37 C.F.R. § 2.89. Applicant has a continued bona fide intention to use the mark in commerce in connection with the goods identified in the Notice of Allowance in the above-identified application.

This is the first request for an Extension of Time following the mailing of the Notice of Allowance dated June 2, 1998.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this First Request For Extension of Time To File a Statement of Use on behalf of the applicant; he believes the applicant to be entitled to use the mark sought to be registered; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Executed this 30th day of November 1998, at Torrance, California.

Honda Giken Kogyo Kabushiki Kaisha
(Honda Motor Co., Ltd.)

By: 

Mr. Atsuyoshi Hyogo
Director, Honda Motor Co., Ltd.

David N. Makous, Esq.
Lewis, D'Amato, Brisbois & Bisgaard
221 No. Figueroa St., Ste. 1200
Los Angeles, California 90012
Telephone: (213) 250-1800

ENDOR NO. 16142 ASSISTANT COMMISSIONER OF PATENT & TRADE

CHECK NO. 181553

INVOICE DATE	INVOICE NO.	DESCRIPTION	DISB. CODE	VOUCHER NO.	ACCOUNT NO. / FILE NO.	AMOUNT
12/01/98	120323	TIME EXTENSION	5	472776	21929-110	300.00
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP ATTORNEYS (213) 250-1800						TOTAL AMOUNT 300.00

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP
ATTORNEYS

221 NORTH FIGUEROA STREET

SUITE 1200

LOS ANGELES, CALIFORNIA 90012

(213) 250-1800

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LOS ANGELES, CALIFORNIA

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1222

DATE 12/01/98

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\$ *****300.00

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ORDER
OF

ASSISTANT COMMISSIONER OF
PATENT & TRADEMARK
BOX ITU
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

[Signature]

⑈181553⑈ ⑆122201444⑆

⑈07⑈098 723⑈

HON 000496

Please acknowledge receipt of our FIRST
REQUEST FOR EXTENSION OF TIME TO FILE
STATEMENT OF USE by affixing hereon the
Patent and Trademark Office date stamp and
return this card to our office. In re
application of:

Mark:	SHADOW AMERICAN CLASSIC EDITION
Applicant:	Honda Giken Kogyo Kabushiki Kaisha
S/N:	75/082470
Int'l. Classes:	16, 25, 28
Our File No.:	21929-110
Mailed:	December 1, 1998

POST OFFICE TO ADDRESSEE EXPRESS MAIL

EF740588460US

INTERNATIONAL SHIPMENTS ONLY

<input type="checkbox"/> Business Papers <input type="checkbox"/> Merchandise Customs forms and commercial invoices may be required. See Pub 273 and International Mail Manual.		P.O. ZIP P.O. No. _____ City _____ State _____ Zip _____	Day of Delivery <input type="checkbox"/> Next <input type="checkbox"/> Second <input type="checkbox"/> Third <input type="checkbox"/> Fourth <input type="checkbox"/> Fifth	<input type="checkbox"/> Flat Rate Envelope Postage \$ _____ Return Receipt <input type="checkbox"/>
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☐ **WARRANT OF SIGNATURE (Domestic Only):** I wish delivery to be made without obtaining the signature of the addressee or the addressee's agent (if in the judgment of the delivery employee, the article can be left in a secure location), and I authorize the delivery employee to sign that the shipment was delivered and understand that the signature of the delivery employee will constitute valid proof of delivery.

☐ **NO DELIVERY**
☐ WEEKEND ☐ HOLIDAY

Customer Signature _____

David N. Makous, Esq.
 Lewis, D'Amato, Briscoe &
 Bisgaard LLP
 221 N. Figueroa St., Ste. 1200
 Los Angeles, CA 90012
 21929-110, 213

Assistant Commissioner of
 Patents & Trademarks
 Box ITU
 2900 Crystal Drive
 Arlington, VA 22202-3513

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LEWIS, D'AMATO, BRISBOIS & BISGAARD

COST ADVANCE TICKET
CHECK REQUEST

16142

No 120323

1. ☒ Check—date needed 12-1-98

2. ☐ Direct expense—

150

☐ Overtime Dinner
Reimbursement

151

☐ Mileage

152

☐ Miscellaneous

153

☒ Filing Fee

154

☐ Witness Fee

155

☐ Deposition

157

☐ Reproduction

☐ Firm expense

Acctg. use — G. L. No.

01, 16, 25, 28

☐ Clients advance check

3. Client and file name Honda - Trademark re SHADOW AMER. Client and matter No.: 21929-110

4. Payee or vendor: Assistant Commissioner of Patents & Trademarks Amount \$ 300.00

5. Mailing address (if applicable): 2900 Crystal Drive, Arlington, VA 22022

6. Reference on remittance advice: Fee re First Request for Ext. of Time - 3 classes

7. Explanation for billing purposes: " " " " " "

8. Disposition of check

☐ Mail

Auth. by Marga Uma VanZandt

Name

Number

Signature

Date 1-1/30/98

☐ Return to Marga

Instructions:

- (1) Original to data processing/numeric copy
- (2) Second copy (yellow) attached to invoice to accounting
- (3) Third copy (pink) retain in attorney's file

Please acknowledge receipt of our **FIRST
REQUEST FOR EXTENSION OF TIME TO FILE
STATEMENT OF USE** by affixing hereon the
Patent and Trademark Office date stamp and
return this card to our office. In re
application of:

Mark:	SHADOW AMERICAN CLASSIC EDITION
Applicant:	Honda Giken Kogyo Kabushiki Kaisha
S/N:	75/082470
Int'l. Classes:	16, 25, 28
Our File No.:	21929-110
Mailed:	December :



12-01-1998

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #39

HON 000500

U.S. Patent and Trademark Office (PTO)

NOTICE OF ALLOWANCE

(NOTE: If any data on this notice is incorrect, please submit a written request for correction of the NOA to: Assistant Commissioner for Trademarks, Box ITU, 2900 Crystal Drive, Arlington, VA 22202-3513. Please include the serial number of your application on ALL correspondence with the PTO. 15 U.S.C. 1063(b)(2))

ISSUE DATE OF NOA: Jun 2, 1998

12-2-98

DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD LLP
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

**** IMPORTANT INFORMATION: 6 MONTH DEADLINE ****

To avoid ABANDONMENT of this application, either a "Statement of Use" (a.k.a. "Allegation of Use") or a "Request for Extension of Time to File a Statement of Use" (a.k.a. "Extension Request") and the appropriate fee(s) must be received in the PTO within six months of the issue date of this Notice Of Allowance (NOA). Failure to do so will result in the ABANDONMENT of this application.

Please note that both the "Statement of Use" and "Extension Request" have many legal requirements, including fees. These requirements are explained in the PTO booklet "Basic Facts About Trademarks", which can be obtained upon request at (703)308-9000. In addition, there are printed forms contained in this booklet (for "Statements of Use" and "Extension Requests") for your use.

The following information should be reviewed for accuracy:

SERIAL NUMBER: 75/082470
MARK: SHADOW AMERICAN CLASSIC EDITION
OWNER: HONDA GIKEN KOGYO KABUSHIKI KAISHA (Honda Motor Co., Ltd.)
2-1-1 Minami-Aoyama, Minato-Ku
Tokyo 107, JAPAN

GOODS/SERVICES BY INTERNATIONAL CLASS

- 016—printed matter in the nature of publications to be distributed to purchasers of registrant's motorcycles
- 025—clothing, namely, shirts, sweatshirts, sweaters, jackets, vests, pants, bandannas, belts, hats, gloves, footwear, sold through authorized motorcycle dealers
- 028—replicas of the registrant's motorcycle and accessories therefor sold by registrant's and its authorized dealers

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

HON 000501



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

Feb 7, 1998

21929-110
PTO

NOTICE OF PUBLICATION UNDER 12(a)

- | | |
|---|---|
| 1. Serial No.:
75/082,470 | 2. Mark:
SHADOW AMERICAN CLASSIC EDITION |
| 3. International Class(es):
16, 25, 28 | |
| 4. Publication Date:
Mar 10, 1998 | 5. Applicant:
HONDA GIKEN KOGYO KABUSHIKI KAISHA (Honda) |

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a notice of allowance pursuant to section 13(b) of the Statute.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained at \$38.00 each for domestic orders, or at \$47.50 each for foreign orders from:

The Superintendent of Documents
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Pittsburgh, PA 15250-7954
Phone: (202)512-1800

By direction of the Commissioner.

HON 000502

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

21929-110
PTO

APR 20 1998		PAPER NO.
75/082470 0000000 DAVID N MAKOUS LEWIS D'AMATO BRISBOIS & BISGAARD LL 221 N FIGUEROA ST STE 1200 LOS ANGELES CA 90012		ADDRESS: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 <small>If no fees are enclosed, the address should include the words "Box Responses - No Fee."</small> <small>Please provide in all correspondence.</small> 1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.

EXAMINER'S AMENDMENT

EXAMINING ATTORNEY		PERSON CALLED/INTERVIEWED	TELEPHONE NUMBER	
Nicholas K. D. Altree		David N. Makous	(213) 250-1800	
X	TELEPHONE CALL	INTERVIEW DATE	X	ATTORNEY
	PERSONAL INTERVIEW	April 6, 1998		APPLICANT

CALL RECORD/NOTES

OFFICE SEARCH: The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01.

RE: Serial Number 75/082470

In accordance with the authorization granted by the above Applicant or attorney, the application has been AMENDED as indicated below. No response is necessary unless there is an objection to the amendment.

IDENTIFICATION OF GOODS

The identification of goods in International Classes 16 is amended by deleting the word "Honda" and replacing it with "registrant's."

The identification of goods in International Class 25 is amended by deleting the word "Honda."

The identification of goods in International Class 28 is amended by deleting the phrase "SHADOW AMERICAN CLASSIC EDITION" and replacing it with "registrant's," and deleting the word "Applicant" and replacing it with "registrant."

If the applicant has any questions, please do not hesitate to contact the undersigned.



Nicholas K. D. Altree
Trademark Attorney
Law Office 109
(703) 308-9109, ext. 132

HON 000503

21471-110

I hereby certify that this correspondence is being deposited with the United States Postal Service "First Class Mail" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: Laura B. Kaliser
Laura B. Kaliser
Date Mailed: 12/5/97

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	HONDA GIKEN KOGYO)	Examining Attorney:
	KABUSHIKI KAISHA)	Jacqueline A. Lavine
)	
)	Law Office 109
Mark:	SHADOW AMERICAN CLASSIC)	
	EDITION)	
)	
Serial No.:	75/082470)	
)	

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

RESPONSE TO OFFICE ACTION

Applicant has received and reviewed the Office Action dated June 17, 1997, and hereby responds thereto.

REMARKS

Applicant agrees to accept the Examiner's request without prejudice that Applicant disclaim the phrase "AMERICAN CLASSIC EDITION" apart from the mark as shown.

2

DATA97LA: 104036.1

HON 000504

Applicant has enclosed the requested fee for three classes.

Accordingly, Applicant requests that the mark be published
for opposition.

Respectfully submitted,

LEWIS, D'AMATO, BRISBOIS & BISGAARD

by 

David N. Makous

LEWIS, D'AMATO, BRISBOIS & BISGAARD
221 North Figueroa Street, Suite 1200
Los Angeles, California 90012
Telephone No. (213) 250-1800
Facsimile No. (213) 250-7900

Please acknowledge receipt of our RESPONSE TO
OFFICE ACTION by affixing hereon the Patent
and Trademark Office date stamp and return
this card to our office. In re application
of:

Applicant: H-D MICHIGAN, INC.
Mark: KABUSHIKI KAISHA
S/N: 75/082470
File No.: 21929-110
Mailed: December 5, 1997

HON 000506

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११८

ETC

12/17/97

4. telephone number and ZIP code.

HON 000507

Disclaimer Request

The Request for a disclaimer of the phrase AMERICAN CLASSIC EDITION is repeated and continued. Applicant argues that only AMERICAN and EDITION need to be disclaimed because the term CLASSIC is not used in relation to motorcycles. Enclosed are excerpts from the Lexis/Nexis Research Database showing that the term AMERICAN CLASSIC is used in relationship to motorcycles.

See the Story No. 16, *Petersen Publishing Company Hot Rod*, October 1995 where it states; "Honda was blatant in its Harley copying. The "American Classic Edition" pretty much spells it out, don't you think?"

See also Story No. 1 *Waikato Times*, January 31, 1997 where it states in pertinent part: "American classic motorcycles made before 1976."

Story No. 3, *St. Petersburg Times*, July 4, 1996, where it states in part: "...although the Harley-Davidson motorcycles is an American classic,..."

Story No. 7; *The Dallas Morning News*, April 15, 1996; where it states; "Connoisseurs have compared the lighters to such other American classics as Levi jeans and Harley Davidson motorcycles."

Story No. 10; *USA Today*, May 26, 1995 where it states; "...a display of American classic cars and motorcycles,..."

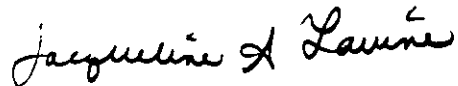
Story No. 11, *The National Law Journal*, May 15, 1995; where it states in part; "...motorcycles as all-American classics..."

Story No. 19, *The San Diego Union-Tribune*, September 10, 1994, where it states in part, "...has built a motorcycle that lives up to its name. It truly is an American Classic."

Additional stories are enclosed to further substantiate this evidence. See also the dictionary definition of Classic which is enclosed from *Websters II, New Riverside Dictionary* where it states "3. Something typical or traditional".

Accordingly, the request for the disclaimer of the entire phrase and the request for appropriate fees is repeated and continued. This application will be suspended pending the outcome of the cancellation proceeding once the disclaimer issue is resolved.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

A handwritten signature in cursive script that reads "Jacqueline A. Lavine".

Jacqueline A. Lavine
Senior Attorney, Law Office 109
(703) 308-9109 Ext. 145
(703) 308-7194 FAX

MAIL-IT REQUESTED: JUNE 12, 1997

10083K

CLIENT: JAL
LIBRARY: NEWS
FILE: ALLNWS

YOUR SEARCH REQUEST AT THE TIME THIS MAIL-IT WAS REQUESTED:
AMERICAN CLASSIC EDITION

NUMBER OF STORIES FOUND WITH YOUR REQUEST THROUGH:
LEVEL 1... 30

LEVEL 1 PRINTED

THE SELECTED STORY NUMBERS:
16,24

DISPLAY FORMAT: KWIC

MULTIPLE DOCUMENTS ON A PAGE

SEND TO: COLE, JACQUELINE
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PTO - TRADEMARK
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ARLINGTON VIRGINIA 22202-3600

*****05046*****

HON 000510

LEVEL 1 - 16 OF 30 STORIES

Copyright 1995 Information Access Company, a Thomson Corporation
Company

ASAP

Copyright 1995 Petersen Publishing Company
Hot Rod

October, 1995

SECTION: Vol. 48 ; No. 10 ; Pg. 106; ISSN: 0018-6031

LENGTH: 2333 words

HEADLINE: Rising sons: riding impressions of four cruisers not built in Milwaukee; motorcycles; includes related article

BYLINE: Kinnan, Rob

BODY:

... so we had four HOT ROD staffers spend quality time on each one. Honda supplied the 1100cc Shadow **American Classic Edition**, Kawasaki gave us the Vulcan 1500, Suzuki provided an Intruder 1400, and from Yamaha came a Virago 1100. As we ...

... narrower bars that make lane-splitting easier.

The Honda is a different story, however. Honda was blatant in its Harley copying. The "**American Classic Edition**" pretty much spells it out, don't you think? This bike had 98 percent of four-wheeled-vehicle drivers and probably ...

LEVEL 1 - 24 OF 30 STORIES

Copyright 1995 The Daily Yomiuri
The Daily Yomiuri

January 23, 1995, Monday

SECTION: Pg. 5

LENGTH: 307 words

HEADLINE: New Products

BODY:

... Harleyesque cruiser powered by an 1,099cc V-twin liquid-cooled engine.

The low, sleek motorcycle has been dubbed the "**American Classic Edition**" since it was created at Honda's California design studio and is assembled at the

HON 000511

The Daily Yomiuri, January 23, 1995

company's factory in Marysville, Ohio.

The ...

HON 000512

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*          3 PAGES          33 LINES          JOB  71389   10083K          *
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*          EEEEE          N   N          DDDD          *
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MAIL-IT REQUESTED: JUNE 12, 1997

10083K

CLIENT: JAL
LIBRARY: NEWS
FILE: ALLNWS

YOUR SEARCH REQUEST AT THE TIME THIS MAIL-IT WAS REQUESTED:
AMERICAN CLASSIC W/8 MOTORCYCLE*

NUMBER OF STORIES FOUND WITH YOUR REQUEST THROUGH:
LEVEL 1... 27

LEVEL 1 PRINTED

THE SELECTED STORY NUMBERS:
1,3,7,9-12,19,22,23,24

DISPLAY FORMAT: KWIC

MULTIPLE DOCUMENTS ON A PAGE

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*****05204*****

HON 000514

LEVEL 1 - 1 OF 27 STORIES

Copyright 1997 Waikato & King Country Press Limited
Waikato Times (Hamilton)

January 31, 1997

SECTION: FEATURES; MOTORING; Pg. 36

LENGTH: 218 words

HEADLINE: World champs to race at classic extravaganza

BODY:

... more than 250 machines for the two-day festival for British, European and American classic motorcycles made before 1976.

The organisers say the the festival is the biggest of its kind in the Southern ...

LEVEL 1 - 3 OF 27 STORIES

Copyright 1996 Times Publishing Company
St. Petersburg Times

July 4, 1996, Thursday, 0 South Pinellas Edition

SECTION: FOOD; Taste; THE NIBBLER; Pg. 1D

LENGTH: 819 words

HEADLINE: A new twist on surf and turf

BYLINE: CHRIS SHERMAN

DATELINE: CLEARWATER

BODY:

... 50. And that 22,000 of them, helped win a war.

There's not as much history at Renegade Cafe, although the Harley-Davidson motorcycle is an American classic, revered and revved up with patriotic fervor by many long before it became a restaurant theme.

The cafe is ...

LEVEL 1 - 7 OF 27 STORIES

Copyright 1996 The Dallas Morning News
THE DALLAS MORNING NEWS

April 15, 1996, Monday, HOME FINAL EDITION

SECTION: TODAY; Pg. 8C

LENGTH: 292 words

HEADLINE: 300 million Zippos: Does that strike up a flicker of interest?

BYLINE: PRNewswire

DATELINE: BRADFORD, Pa.

BODY:

... 70,000 Zippos a day isn't enough. After 64 years we're hotter than ever."

Connoisseurs have compared the lighters to such other American classics as Levi jeans and Harley Davidson motorcycles. Collectors the world over publish newsletters about Zippos. The British percussion/dance troupe Stomp has an entire number ...

LEVEL 1 - 9 OF 27 STORIES

Copyright 1996 News & Record (Greensboro, NC)
News & Record (Greensboro, NC)

February 5, 1996, Monday, ALL EDITIONS

SECTION: TRIAD/STATE, Pg. B1, DOWN THE ROAD / IN ASHEBORO

LENGTH: 859 words

HEADLINE: ASHEBORO DINER RUNS IN CYCLES

BYLINE: BEN FELLE, Staff Writer

DATELINE: ASHEBORO

BODY:

... But we don't just attract Harley riders. We want to attract people who are interested in the sport of riding."

The Richs' American Classic Motorcycle Co. museum - featuring Harley treasures from cycles and leather jackets to combs and coins - has been attracting tourists since it opened ...

HON 000516

LEVEL 1 - 10 OF 27 STORIES

Copyright 1995 Gannett Company, Inc.
USA TODAY

May 26, 1995, Friday, INTERNATIONAL EDITION

SECTION: NEWS; Pg. 2A

LENGTH: 1117 words

HEADLINE: Diplomatic corps seeks minorities / Africa gets most black ambassadors

BYLINE: Evelyn Tan Powers

BODY:

... Duxford, England, hosts American theme days on May 28 and May 29. In addition to a display of American classic cars and motorcycles, many of the historic aircraft based at Duxford will give exhibition flights. Call: (01223) 835000, ext. 214.

...

NOTES: LIVING OVERSEAS; Helping inform U.S.citizens overseas

LEVEL 1 - 11 OF 27 STORIES

Copyright 1995 The New York Law Publishing Company
The National Law Journal

May 15, 1995

SECTION: EXHIBIT A; On Trial; Pg. A10

LENGTH: 1550 words

HEADLINE: Bike Gang Is Called an International Racket

BYLINE: BY LINDA GIBSON, SPECIAL TO THE NATIONAL LAW JOURNAL

DATELINE: TAMPA, FLA.

BODY:

... Susan C. Bucklew sustained.

Attorney Richard Cox, representing defendant Charles "Tattoo" Schwarz, described Harley-Davidson motorcycles as all-American classics and said his client was drawn to the club by "his common interest in these rare and beautiful machines." Also, Mr. Schwarz was "seeking brotherhood with ...

HON 000517

LEVEL 1 - 12 OF 27 STORIES

Copyright 1995 News & Record (Greensboro, NC)
News & Record (Greensboro, NC)

April 21, 1995, Friday, ALL EDITIONS

SECTION: TRIAD/STATE, Pg. B1, NEWS TO USE

LENGTH: 81 words

HEADLINE: RIDE SET TO BOOST CYCLE AWARENESS

BODY:

Rides will begin in Asheville, Charlotte and Wilmington. Locally, the rides will stop at 10 a.m. at American Classic Motorcycles on U.S. 64 in Asheboro, and at 11:30 a.m. at TA Truck Stop, exit 138 off ...

LEVEL 1 - 19 OF 27 STORIES

Copyright 1994 The San Diego Union-Tribune
The San Diego Union-Tribune

September 10, 1994, Saturday

SECTION: AUTO; Ed. 1,2,3,4,5,6,7; Pg. AUTO-2

LENGTH: 784 words

HEADLINE: Move over, Harley, Honda's come up with a classic

BYLINE: C.J. MANGEN

Staff Writer C.J. MANGEN is a copy editor at the Union-Tribune and a motorcycle enthusiast. He bought his first bike -- a Honda CT-70 -- at age 12, and has been riding ever since. He competes in motocross at Southern California tracks, and also enjoys exploring back-country roads aboard

BODY:

... first allotment of American Classics, and early indications are that customers will do the same.

Honda, despite its Japanese roots, has built a motorcycle that lives up to its name. It truly is an American Classic.

1995 Honda Shadow American Classic Edition Engine type: 1099cc liquid-cooled

V-twin Transmission: Five- ...

LEVEL 1 - 22 OF 27 STORIES

Copyright 1994 News & Record (Greensboro, NC)
News & Record (Greensboro, NC)

March 17, 1994, Thursday, CITY EDITION

SECTION: TRIAD/STATE, Pg. BG5

LENGTH: 235 words

HEADLINE: 1,500 N.C. MOTORCYCLISTS TO MEET IN ASHEBORO IN '95

BYLINE: SCOT, SOLOMON

DATELINE: ASHEBORO

BODY:

. . . center of activity will be Randolph County, with events scheduled at the N.C. Zoo, the Richard Petty Museum, the Seagrove potteries and the American Classic Motorcycle Museum in Asheboro.

In addition, a motorcycle race is planned for Caraway Speedway.

"We're not talking motorcycle gangs here," Gusler said. "These are attorneys, accountants, doctors - . . .

LEVEL 1 - 23 OF 27 STORIES

Copyright 1993 Investor's Business Daily, Inc.
Investor's Business Daily

August 11, 1993

SECTION: Companies In The News; Pg. 36

LENGTH: 811 words

HEADLINE: Custom Chrome Gets A Great Ride With Harley-Davidson

BYLINE: By John A. Jones, Investor's Daily

BODY:

As the American classic Harley-Davidson motorcycles grow ever more popular, Custom Chrome Inc. rides along with the boom by supplying parts and accessories for them.

Last . . .

HON 000519

LEVEL 1 - 24 OF 27 STORIES

Copyright 1992 Chicago Tribune Company
Chicago Tribune

November 8, 1992, Sunday, FINAL EDITION

SECTION: TRANSPORTATION; Pg. 1; ZONE: CN

LENGTH: 823 words

HEADLINE: Down to the nuts and bolts
From airplanes to tractors he's restored 'em all

BYLINE: Story by William Sluis

BODY:

... busy. Not only did he rebuild the Caterpillar tractor and semi-trailer truck, but he also began work on the Indian Four motorcycle, another American classic.

He received the motorcycle, whose main bearings were damaged, from a friend. The company that built the Indian had stopped production soon after Horner's model was made, ...

HON 000520

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*          E       N  NN   D  D
*          E       N   N   D  D
*          EEEEE   N   N   DDDD
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HON 000521

WEBSTER'S II
New Riverside
University
Dictionary

HON 000522

clarion • claw hatchet

clarion (klār'ē-on) *n.* [ME *clarion* < OFr. *clarion* < Med. Lat. *clarion* < Lat. *clarus*, clear.] 1. A medieval trumpet with a clear, shrill tone. 2. The sound made by a clarion or a sound resembling it. —*adj.* Shrill and clear < heard the clarion call to arms >

clarionet (klār'ē-on-ēt) *n.* var. of **CLARINET**.

clarity (klār'ē-tē) *n.* [ME *clerus*, brightness < OFr. *clarte* < Lat. *claritas*, clearness < *clarus*, clear.] The quality or state of being clear: LUCIDITY.

clarkia (klār'kē-ə) *n.* [NLat. *Clarkia*, genus name, after William Clark (1770-1838).] A plant of the genus *Clarkia* of western North America, bearing red, purple, or pink flowers.

clary (klār'ē) *n.* pl. -ies. [ME *clare*, partly < Med. Lat. *sclarea* and partly < OE *slama*.] A European plant of the genus *Salvia*, esp. *S. sclarea*, an aromatic herb with bluish-white flowers.

clash (klāsh) *v.* **clashed**, **clashing**, **clashes**. [imit.] —*vt.* 1. To collide with a loud, harsh noise. 2. To conflict < members of Congress clashing over the budget > —*vi.* To strike together with a harsh, metallic noise. —*n.* 1. A loud, resounding metallic noise, as that made by two objects colliding. 2. A state of disharmony or disagreement. 3. An often heated argument.

class-mat-o-cyte (klāz-māt'ō-sīt) *n.* [Gk. *klasma*, *klasmōs*, fragment < *klān*, to break > + *-CYTE*.] Histocyte. —**class-mat-o-cytic** (-sīt'ik) *adj.*

clasp (klāsp) *n.* [ME *clasp*, prob. of OE orig.] 1. A fastening, as a hook, used to hold two parts or objects together. 2. a. An embrace; hug. b. A grip or grasp of the hand. 3. A small metal bar attached to a military decoration indicating the action for which it was awarded. —*vt.* **clasped**, **clasping**, **clasps**. 1. To fasten with or as if with a clasp. 2. To hold in a tight grasp: **EMBRACE**. 3. To grip firmly in or with the hand. —**clasper** *n.*

clasper (klāsp'ər) *n.* A modified part of the pelvic fin of male elasmobranch fishes that aids sperm transmission during copulation.

clasp knife *n.* A pocketknife with a folding blade.

class (klās) *n.* [Fr. *classe* < Lat. *classis*, class of citizens.] 1. a. A set, group, collection, or configuration containing members having or believed to have at least one attribute in common: **KIND**. b. Statistics. An interval in a frequency distribution. 2. A division by quality, grade, or rank. 3. a. A social stratum whose members share similar political, economic, and cultural characteristics. b. Social rank, esp. high rank. 4. a. A group of alumni or students graduated in the same year. b. A group of students studying the same subject. c. The period during which such a group meets. 5. a. Biol. A taxonomic category ranking below a phylum and above an order. b. A subdivision of a larger group. 6. a. A grade of mail. b. The quality of accommodation on a public vehicle < travel tourist class > 7. Slang. Great style or quality < a violinist with class > —*vt.* **classed**, **classing**, **class-es**. To arrange, group, or rate according to qualities or characteristics: **CLASSIFY**.

* **syns**: CLASS, CATEGORY, CLASSIFICATION, ORDER, SET *n.* core meaning: a subdivision of a larger group < the class of concertgoers who enjoy chamber music >

A word history: *Class* is from Latin *classis*, "a division of the Roman people." *Classis* had an adjective, *classicus*, that originally meant "belonging to a classis" but later meant "belonging to the highest-ranking classis," from which the sense "first-class, superior" developed. English *classic* and *classical* are derived from *classicus* in the more general sense. Because the ancient Greek and Roman authors were considered models of excellence and were universally studied in schools and universities throughout Europe until recent times, the terms *classic* and *classical* came to be associated first with ancient Greek and Roman literature of all degrees of excellence and then with anything pertaining to ancient Greece or Rome.

class action *n.* A lawsuit in which the plaintiff or plaintiffs bring suit both on their own behalf and on behalf of others who have the same claim against the defendant.

class-conscious (klās'kōn-shəs) *adj.* Aware of belonging to a specific socioeconomic class. —**class'-con-scious-ness** *n.*

class-ic (klās'ik) *adj.* 1. Being of the highest class or rank. 2. a. Serving as an outstanding representative of a kind: **MODEL**. b. Well-known and typical < a classic Western with ambushes and shootouts > 3. Having lasting significance or recognized worth. 4. **CLASSICAL** *la.* 1. Of or in accordance with established principles and methods in the arts and sciences. 2. Of lasting literary or historical significance. —*n.* 1. An artist, author, or work gen. held to be of the highest rank or excellence. 2. A literary work of ancient Greece or Rome. 3. Something typical or traditional.

class-ic-al (klās'ik-əl) *adj.* 1. a. Of or relating to the culture of ancient Greece and Rome, esp. the art, architecture, and literature. b. Relating to or versed in studies of antiquity. 2. a. Relating to or designating European music of the latter half of the 18th cent. b. Designating music in the educated European tradition. 3. Standard and authoritative < classical methods of building construction > 4. Of or relating to nonrelativistic or nonquantum physics < classical mechanics > —**class-ic-al-ly** (-kāl'ē-ē), **class-ic-al-ness** *n.* —**class-ic-al-ly** *adv.*

class-ic-ism (klās'ik-siz-əm) *n.* 1. Aesthetic attitudes and principles based on the culture, art, and literature of ancient Greece and Rome and characterized by emphasis on form, simplicity, proportion, and

restrained emotion. 2. Classical scholarship. 3. A Cretan expression or idiom.

class-ic-ist (klās'ik-sist) *n.* A specialist in or student of classical studies.

class-i-fi-ca-tion (klās'ē-fi-kā'shən) *n.* 1. The act of classifying. 2. Biol. The systematic grouping of organisms based on shared characteristics or traits: **TAXONOMY**.

classified advertisement *n.* A usu. brief printed in a newspaper or magazine along with other category.

class-i-fy (klās'ē-fi) *vt.* -fied, -fying, -fies. 1. To range according to class or category. 2. To designate as secret and available only to authorized persons. —**class-i-fi-able** *adj.* —**class-i-fi-er** *n.*

class-is (klās'is) *n.* pl. -ses (-ēz) [Lat. *class*, of clergy or body of pastors and elders in certain Reformed jurisdictions over local churches. 2. The church governed by a classis.]

class mark *n.* Statistics. **MARK** 12.

class-mate (klās'māt) *n.* A member of the same class.

class-room (klās'rōm) *n.* A room in which classes are held.

class-y (klās'ē) *adj.* -ier, -iest. Slang. Elegant: a paint job > —**class-i-ness** *n.*

clast (klāst) *n.* [Gk. *klastos*, broken < *klān*, to break.] A fragment of rock.

clastic (klās'tik) *adj.* [Gk. *klastos*, broken < *klān*, to break.] 1. Separable into parts or having removable sections (tectonics). 2. Geol. Made up of fragments of older rocks.

clath-rate (klāth'rāt) *adj.* [Lat. *clathratus*, p.p. of *clathrare*, to lattice < Gk. *klathron*, door bar < *klathra*, lattice.] Lattice-like in structure or appearance. 2. Cling to inclusion complexes in which molecules or ions are completely enclosed within the crystal structure of a clathrate compound.

clat-ter (klāt'ər) *v.* -tered, -tering, -ters. [ME *clatren*.] 1. To make a rattling sound. 2. To move with a rattling noise and rapidly: **CHATTER**. —*vi.* To cause a rattling sound. —*n.* 1. A rattling sound. 2. A loud disturbance. 3. Noisy talk: **CHATTER**. —**clat-ter-er** *n.*

clau-dic-a-tion (klō'di-kā'shən) *n.* [ME *claudicare* < *claudicare*, to limp < *claudus*, lame, son's walk: **LIMP**.]

clause (klōz) *n.* [ME < OFr. < Med. Lat. *clausa*, closed < Lat. *claudere*, to close.] 1. A group of words, and predicate and forming part of a compound or complex sentence. 2. A distinct article, stipulation, or provision in a contract.

clau-sal (klō'səl) *adj.*

clau-stral (klō'strəl) *adj.* var. of **CLOISTRAL**.

clau-tro-pho-bi-a (klō'strō-fō'bē-ə) *n.* [Lat. *claudere* (to close) + *-PHOBIA*.] Abnormal fear of being closed in.

clavate (klāv'āt) *adj.* [NLat. *clavatus* < Lat. *clava*, club < *clavus*, nail.] Shaped like a club.

clav-ele (klāv'ē-lē) *n.* [NLat. *clavicle* < Lat. *clavus*, nail.] A bone linking the sternum and the scapula.

clav-i-corn (klāv'ik-ōrn) *adj.* [NLat. *Clavicorn*.] Belonging to the suborder Polyphaga, with a club + Lat. *cornu*, horn.

clav-ier (klāv'ē-ər, klāv'ē-ē) *n.* [Fr. < OFr. *clavis*, key.] 1. A keyboard. 2. A stringed keyboard instrument with a soft sound produced by horizontal strings.

clav-i-cle (klāv'ik-ēl) *n.* [NLat. *clavicula* < Lat. *clavus*, nail.] A bone linking the sternum and the scapula.

clav-i-cul-a (klāv'ik'ul-ə) *adj.* —**clav-i-cul-ous** *adj.*

clav-i-corn (klāv'ik-ōrn) *adj.* [NLat. *Clavicorn*.] Belonging to the suborder Polyphaga, with a club + Lat. *cornu*, horn.

claw (klō) *n.* [ME *clawe* < OE *clawu*.] 1. A sharp, pointed, or hooked part of a vertebrate animal, esp. on the toe of a mammal, bird, or reptile. 2. A part of a chela, on the limb of a crustacean or other arthropod, terminating in such a structure. 3. Something resembling the cleft end of a hammerhead. 4. Bot. The narrow, pointed petals or sepals. —*vt.* & *vi.* **clawed**, **claw-ing**. To scratch or make digging or scratching movements with claws.

claw hammer *n.* 1. A hammer with one end fitted for removing nails. 2. A swallow-tailed coat.

claw hatchet *n.* A hatchet with one end of the head fitted for removing nails.

1 pat 1 pay 1r care 1 father 2 pet 2 be
1 tie 1r pier 2 pot 2 toe 2 paw, for c

I hereby certify that this correspondence is being deposited with the United States Postal Service "First Class Mail" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: _____

Laura B. Kaliser

Date Mailed: _____

3/27/97

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	HONDA GIKEN KOGYO)	Examining Attorney:
	KABUSHIKI KAISHA)	Jacqueline A. Lavine
)	
)	Law Office 109
Mark:	SHADOW AMERICAN CLASSIC)	
	EDITION)	
	976238)	
Serial No.:	75/082470)	

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

REQUEST TO DIVIDE APPLICATION
AND AMEND

Pursuant to the Trademark Manual of Examining Procedure §1105.06 and 37 CFR §2.87, Applicant respectfully requests this application be divided as follows:

Please divide out Classes 14, 18 and 26 into one application and publish for opposition.

Pursuant to the Office Action dated October 1, 1996,

DATA97LA: 23795.1

HON 000524

Applicant responds as follows:

1. Please change the designation of goods in Class 18 to read in full:

"Leather goods, namely wallets, purses, keyfobs, fannypacks, cases, billfolds, bags, and backpacks."

2. Please change the designation of goods in Class 26 to read in full:

"Fancy goods, namely belt buckles and patches for clothing."

3. Applicant declines to accept the entire disclaimer.

Applicant agrees to disclaim "AMERICAN" and "EDITION", apart from the mark as shown. SHADOW AMERICAN CLASSIC EDITION is a unique moniker as applied to the goods derived from the motorcycle and has no particular meaning to the public. It is not descriptive of the goods. Please see the attached NEXIS search in which we found no usages of any combinations of this mark in association with motorcycles. The consuming public is not likely to associate this phrase ("American Classic Edition") as descriptive of motorcycles; rather, as discussed below, it suggests a brand new model of a traditional large displacement motorcycle for which there may have been many manufacturers (over 80) in the last 100 years.

4. Applicant's mark is not geographically deceptively misdescriptive.

The Examining Attorney has refused registration because the

mark is "primarily geographically deceptively misdescriptive".

Applicant disagrees as the mark SHADOW AMERICAN CLASSIC EDITION does not expressly state nor impliedly state that the motorcycle is "made in America". It simply suggests that the motorcycle is comprised of uncertain traditional elements of large displacement motorcycles.

As stated in In re House of Windsor, Inc., 221 USPQ 53, 55 (TTAB 1983), "Where the mark comprises a geographical term but the geographical meaning of the term is minor, obscure, remote or unconnected with the goods, the mark is treated as an arbitrary one and registration is permitted..."

Applicant's goods relate to a specific Honda motorcycle model of the same name, and however are not an "American Classic", they are a new "edition" of the Honda SHADOW motorcycle, that combines uncertain traditional elements of motorcycles such that it may suggest a classic type of motorcycle previously sold by Honda and others in the United States.

The SHADOW is a widely recognized Honda motorcycle model that has been sold by Honda for eighteen years (see attached Registration and brochure). Nothing in the mark implies that it is made in America.

Nonetheless, without waiving the above objection, Applicant confirms that the goods described in this application are in fact made in the United States.

Accordingly, Applicant requests that the § 2(e)(3) objection be withdrawn, and the mark be published for opposition.

2/984-110

I hereby certify that this correspondence is being deposited with the United States Postal Service "First Class Mail" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: David N. Makous, Reg. 29,559

Date Mailed: 3-27-97

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	HONDA GIKEN KOGYO)	Examining Attorney:
	KABUSHIKI KAISHA)	Jacqueline A. Lavine
)	
Mark:	SHADOW AMERICAN CLASSIC)	Law Office 109
	EDITION)	
)	
Serial No.:	75/082470)	
)	

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

RESPONSE TO OFFICE ACTION

Applicant has received and reviewed the Office Action dated October 1, 1996, and hereby responds thereto.

AMENDMENT

Please amend the application as follows:

1. Please delete classes 14, 18 and 26 per the Request to Divide Application.

DATA97LA: 23802.1

HON 000527

2. Please change the designation of goods in Class 16 to read in full:

"Printed matter in the nature of publications to be distributed to purchasers of Honda motorcycles."

3. Please change the designation of goods in Class 25 to read in full:

"Clothing, namely shirts, sweatshirts, sweaters, jackets, vests, pants, bandannas, belts, hats, gloves, footwear, sold through authorized Honda motorcycle dealers."

4. Please change the designation of goods in Class 28 to read in full:

"Replicas of the SHADOW AMERICAN CLASSIC EDITION motorcycle and accessories therefor sold by Applicant and its authorized dealers."

REMARKS

I.

Applicant declines to accept the entire disclaimer.

Applicant agrees to disclaim "AMERICAN" and "EDITION", apart from the mark as shown. SHADOW AMERICAN CLASSIC EDITION is a unique moniker as applied to the goods derived from the motorcycle and has no particular meaning to the public. It is not descriptive of the goods. Please see the attached NEXIS search in which we found no usages of any combinations of this mark in association with motorcycles. The consuming public is not likely to associate this phrase ("American Classic Edition")

as descriptive of motorcycles; rather, as discussed below, it suggests a brand new model of a traditional large displacement motorcycle for which there may have been many manufacturers (over 80) in the last 100 years.

II.

Applicant's mark is not geographically deceptively misdescriptive.

The Examining Attorney has refused registration because the mark is "primarily geographically deceptively misdescriptive".

Applicant disagrees as the mark SHADOW AMERICAN CLASSIC EDITION does not expressly state nor impliedly state that the motorcycle is "made in America". It simply suggests that the motorcycle is comprised of uncertain traditional elements of large displacement motorcycles.

As stated in In re House of Windsor, Inc., 221 USPQ 53, 55 (TTAB 1983), "Where the mark comprises a geographical term but the geographical meaning of the term is minor, obscure, remote or unconnected with the goods, the mark is treated as an arbitrary one and registration is permitted..."

Applicant's goods relate to a specific Honda motorcycle model of the same name, and however are not an "American Classic", they are a new "edition" of the Honda SHADOW motorcycle, that combines uncertain traditional elements of motorcycles such that it may suggest a classic type of motorcycle previously sold by Honda and others in the United States.

The SHADOW is a widely recognized Honda motorcycle model that has been sold by Honda for eighteen years (see attached Registration). Nothing in the mark implies that it is made in America.

Nonetheless, without waiving the above objection, Applicant confirms that the goods described in this application are in fact made in the United States.

III.

Section 2(d) objections

The Examining Attorney has further refused registration because Applicant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 1,043,492; 1,645,004; 236,950; 1,624,940; 1,604,839; 1,348,246; 1,720,106; and 1,780,427 as to be likely to cause confusion, or to cause mistake, or to deceive.

A. Class 25: The owner of cited reference mark No. 1,624,940 has abandoned its registration

The § 8 affidavit was due for Reg. No. 1,624,940, on November 27, 1996. As of March 3, 1997, the Patent and Trademark Office advised us that it has not received any such affidavit and the registration will soon be declared abandoned. (see attached Declaration of Laura B. Kaliser).

B. Class 25: The owner of cited reference mark No. 236,950 has abandoned its registration

Upon Applicant's information and belief, cited mark No. 236,950 is no longer in use by the owner (see attached Declaration of Laura B. Kaliser). Applicant has therefore filed a Petition for Cancellation of this mark, a copy of which is attached hereto.

C. Class 16: Applicant's mark is not confusingly similar to the cited reference mark Nos. 1,645,004 and 1,043,492

Applicant's mark SHADOW AMERICAN CLASSIC EDITION is not likely to be confused with the mark THE SHADOW, Reg. No. 1,645,004 for "posters, lithographs, comic books, and graphic novels" and Reg. No. 1,043,492 for "novels in paperback form".

When the goods of a cited mark are "not identical or competitive, and are not related or marketed in such a way that they would be encountered by the same people in situations that could create the incorrect assumption that all goods come from the same source . . . even where the marks are identical, confusion is not likely." TMEP §1207.01 (citing In re Unilever Ltd., 222 USPQ 981, 983 (T.T.A.B. 1984)).

The goods of cited mark are based on THE SHADOW, a plainly known and recognizable fictitious character in stories. Applicant's goods are based on the Honda motorcycle - SHADOW AMERICAN CLASSIC EDITION. As discussed earlier, the motorcycle is an edition of the widely known Honda SHADOW motorcycle. The

mark SHADOW has been in use by Honda for eighteen years (see attached registration).

Applicant's goods consist of publications to be distributed only to purchasers of Honda motorcycles through direct mail or through authorized Honda dealerships. This is a narrow and specialized trade channel greatly differing from traditional newsstands and magazine racks. There is no likelihood of confusion.

D. Class 28: Applicant's goods are unrelated to the goods identified in the cited marks in this extremely crowded class and therefore not likely to cause confusion.

The Examining Attorney has cited the following marks as being confusingly similar to Applicant's mark:

1. SHADOW - for "baseball gloves", Reg. No. 1,780,427
2. SHADOW - for "snow skiing device having a single runner and a seat intended for use by paraplegics, a water skiing device having a single ski and a seat intended for use by paraplegics, and stationary trainers for wheelchairs" Reg. No. 1,720,106
3. SHADOW - for "children's ride-on bouncing horse toys", Reg. No. 1,604,839
4. SHADOW - for "golf clubs and golf club shafts", Reg. No. 1,348,246

The above marks are totally unrelated to Applicant's mark, SHADOW AMERICAN CLASSIC EDITION, for replicas of Honda's SHADOW AMERICAN CLASSIC EDITION motorcycle. As the above identical marks have been allowed in the same class, the consuming public is understood to be able to differentiate these many unrelated products. Therefore, on the basis of the dissimilarity of the goods, there is no likelihood of confusion.

Accordingly, Applicant requests that the § 2(d) objection be withdrawn, and the mark be published for opposition.

Respectfully submitted,

LEWIS, D'AMATO, BRISBOIS & BISGAARD

by 

David N. Makous

LEWIS, D'AMATO, BRISBOIS & BISGAARD
221 North Figueroa Street, Suite 1200
Los Angeles, California 90012
Telephone No. (213) 250-1800
Facsimile No. (213) 250-7900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	HONDA GIKEN KOGYO)	Examining Attorney:
	KABUSHIKI KAISHA)	Jacqueline A.
)	Levine
Mark:	SHADOW AMERICAN CLASSIC)	
	EDITION)	Law Office 109
)	
Serial No.:	75/082470)	
)	
)	

DECLARATION OF LAURA B. KALISER IN SUPPORT
OF APPLICANT'S RESPONSE TO OFFICE ACTION

I, Laura B. Kaliser declare as follows:

1. I am an attorney licensed to practice in the State of California, representing Applicant in this matter.
2. On March 3, 1997, I telephoned the Patent and Trademark Office Trademark Assistance Center and asked them if a § 8 affidavit (due November 11, 1996) had been filed for Reg. No. 1,624,940. The unidentified man responding to my request stated "no affidavit had been filed" and that the registration would most likely be declared abandoned.
3. On March 3, 1997, I telephoned the corporate offices of Warnaco Inc. and inquired as to whether the Trademark SHADOW was still in use by Warnaco (Reg. No. 236,950). The unidentified woman in the customer service department informed me that this mark was no longer in use.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or

DATA97LA: 24273.1

HON 000534

imprisonment, or both, under 18 U.S.C. 1001, declares that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Date: March 26, 1997

By: Laura B. Kaliser
Laura B. Kaliser
Attorney for Applicant

Please acknowledge receipt of our RESPONSE TO
OFFICE ACTION by affixing hereon the Patent
and Trademark Office date stamp and return
this card to our office. In re application
of:

Applicant:

HONDA GIKEN KOGYO
KABUSHIKI KAISHA
SHADOW AMERICAN CLASSIC
EDITION

Mark:

S/N:

75/082470

File No.:

21929-110

Mailed:

March 27, 1997

DATA97LA: 7606.1

HON 000536

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

SERIAL NO. 75/082470 HONDA GIKEN KOGYO ETC		PAPER NO. 202-1000
MARK SHADOW AMERICAN CLASSIC EDITION		ADDRESS: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 <small>If no fees are enclosed, the address should include the words "Box Responses - No Fee"</small> <small>Please provide in all correspondence:</small> <ol style="list-style-type: none">1. Filing Date, serial number, mark and Applicant's name.2. Mailing date of this Office action.3. Examining Attorney's name and Law Office number.4. Your telephone number and ZIP code.
ADDRESS David N. Makous EWIS, D'AMATO, BRISBOIS & BISGAARD, LLP 221 N. Figueroa Street, Suite 1200 Los Angeles, CA 90012	ACTION NO. 01	
	MAILING DATE 10/01/95	
REF. NO.		
<div style="display: flex; justify-content: space-between;"><div>FORM PTO-1525 (5-90)</div><div>U.S. DEPT. OF COMM. PAT. & TM OFFICE</div></div> <div style="display: flex; justify-content: space-between;"><div>TRADEMARK LAW OFFICE 10</div><div></div></div> <div>Serial Number: 75/082470</div> <div>Mark: SHADOW AMERICAN CLASSIC EDITION</div>		

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

**RECEIVED WITHIN 6
VOID ABANDONMENT.**

For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 75/082470

The assigned examining attorney has reviewed the referenced application and determined the following.

Geographically deceptively misdescriptive refusal

The examining attorney refuses registration on the Principal Register because the mark is primarily geographically deceptively misdescriptive. Trademark Act Section 2(e)(3), 15 U.S.C. Section 1052(e)(3); TMEP section 1210.06.

A mark which, when used on or in connection with the applicant's goods or services, is primarily geographically deceptively misdescriptive of them, is registrable upon a showing of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), only if it became distinctive of the goods or services in commerce before December 8, 1993, the date of the enactment of the North American Free Trade Agreement Implementation Act, Public Law 103-182, 107 Stat. 2057. Similarly, such a mark, capable of distinguishing the applicant's goods or services, may be registered on the Supplemental Register only if it has been in lawful use in commerce by the owner since before December 8, 1993.

Applicant's mark is SHADOW AMERICAN CLASSIC EDITION. This implies that the goods are made in America. However, applicant is a foreign corporation. If the primary significance of a mark is

HON 000537

to indicate a geographic location which is neither obscure nor remote and the applicant's services are performed, at least in part, in the location indicated, then the public is likely to believe that the geographic term identifies the place from which the services originate. *In re Chalk's International Airlines, Inc.*, 21 USPQ2d 1637 (TTAB 1991). The applicant must indicate specifically whether any aspect of the services will be rendered in, or will have any other connection with, the geographic location named in the mark. 37 C.F.R. Section 2.61(b).

The public is likely to believe that the applicant's goods originate in the place named in the mark. *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985). The applicant must explain where the goods will originate for the record. 37 C.F.R. Section 2.61(b).

Disclaimer Requirement

Should applicant prevail and overcome this refusal to registration, a disclaimer of AMERICAN CLASSIC EDITION will be required as that is a descriptive phrase.

Prior Registrations

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 1,043,492; 1,645,004; 0236,950; 1,624,940; 1,604,839; 1,348,246; 1,720,106 and 1,780,427 as to be likely to cause confusion, or to cause mistake, or to deceive. TMEP section 1207. See the enclosed registrations.

Registration Nos. 1,043,492 and 1,645,004 are cited against the goods in Class 16.

Registration Nos. 0236,950; 1,624,940 are cited against Class 25.

Registration Nos. 1,604,839; 1,348,246; 1,720,106 and 1,780,427 are cited against Class 28.

There are to be no confusingly similar marks for Classes 14, 18 and 26.

Prior Pending Applications

The examining attorney encloses information regarding pending Application Serial Nos. 75/083,260 and 75/083,261. The filing dates of the referenced applications precede the applicant's filing date. There may be a likelihood of confusion between the applicant's mark and the referenced marks under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). If one or more of the referenced applications matures into a registration, the examining attorney may refuse registration in this case under Section 2(d). 37 C.F.R. Section 2.83; TMEP section 1208.01. This applies to the Class 25 goods only.

Possible Responses

The applicant may respond to the stated refusals by doing one of the following:

- (1) amending the application to delete the class to which the refusal pertains;
- (2) traversing the refusal of the combined application as a whole; or
- (3) filing a request to divide the application, so that the mark may be published for opposition in the class to which the refusal does not pertain (37 C.F.R. Section 2.87; TMEP sections 1105.06 and 1113.03).

Please note, however, that failure to respond to a refusal which pertains to fewer than all classes in an application will result in abandonment of the combined application in its entirety.

Informalities

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

Additional Fees required

The application identifies goods that may be classified in several international classes. Effective December 3, 1993, the filing fee is \$245.00 for each class. 37 C.F.R. Section 2.6(a)(1). Therefore, the applicant must either: (1) restrict the application to the number of classes covered by the fee already paid, or (2) pay the required fee for each additional class. 37 C.F.R. Section 2.86(b); TMEP sections 810.01 and 1113.01.

Identification of goods indefinite

The identification of goods is indefinite and requires amendment. Jewelry in Class 14 is acceptable. However, in all the other classes, applicant must specifically list each item using the common commercial name.

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. Section 2.71(b); TMEP section 804.09. Therefore, the applicant may not amend to include any goods or services that are not within the scope of the goods and services recited in the present identification.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

Jacqueline A. Lavine
Jacqueline A. Lavine
Senior Attorney, Law Office 109
(703) 308-9109 Ext. 145
(703) 308-7194 FAX

NOTE: The Trademark Office is committed to improving the quality of our service. The Assistant Commissioner for Trademarks would like to have your comments and suggestions on ways we can improve the quality of the examination process. In the event there are any areas causing you recurrent problems, please let us know of them.

COMMENTS SHOULD NOT BE INCLUDED WITH THE RESPONSE TO AN OFFICE ACTION, BUT SHOULD BE SENT IN A SEPARATE COMMUNICATION TO THE FOLLOWING ADDRESS:

Office of Trademark Quality Review
c/o Commissioner of Patents and Trademarks
Washington, DC 20231.

Please note that this address differs from the mailing address for the response to this Office action.

*** User: EX817099 *** Ser . Number: 73038765 ***

Word Mark
THE SHADOW

Goods/Services
IC 016; US 038; G & S: NOVELS IN PAPERBACK FORM; FIRST USE: 1963.09.00;
FIRST USE IN COMMERCE: 1963.09.00

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-038765

Filing Date
1974.12.05

Registration Number
1043492

Registration Date
1976.07.13

Owner Name/Address
(REGISTRANT) CONDE NAST PUBLICATIONS INC., THE CORPORATION NEW YORK 350
MADISON AVE. NEW YORK NEW YORK 10017

Owner Name/Address
(LAST LISTED OWNER) ADVANCE MAGAZINE PUBLISHERS INC. CORPORATION NEW YORK
350 MADISON AVENUE NEW YORK NEW YORK 10017

Prior US Registration
0534805

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit
SECT 8.; SECT 15.; COMBINED SECT 8 AND SECT 15.

Renewal
1ST RENEWAL 1996.05.16

*** User: EX817099 *** Ser : Number: 73827363 ***

Word Mark

THE SHADOW

Goods/Services

IC 016; US 038; G & S: POSTERS, LITHOGRAPHS, COMIC BOOKS, AND GRAPHIC NOVELS; FIRST USE DATE: 1940.03.00; FIRST USE IN COMMERCE: 1940.03.00

Goods/Services

IC 009; US 036; G & S: PRERECORDED AUDIO CASSETTE TAPES AND PHONOGRAPH RECORDS FEATURING STORIES FROM RADIO PROGRAMS; FIRST USE DATE: 1972.00.00; FIRST USE IN COMMERCE: 1972.00.00

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

73-827363

Filing Date

1989.09.25

Registration Number

1645004

Registration Date

1991.05.21

Owner Name/Address

(REGISTRANT) ADVANCE MAGAZINE PUBLISHERS INC. CORPORATION NEW YORK 350 MADISON AVENUE NEW YORK NEW YORK 10017

Type of Mark

TRADEMARK

Register

PRINCIPAL

*** User: EX817099 *** Serial Number: 71251252 ***

Word Mark
SHADOW

Goods/Services
IC 025; US 039; G & S: CORSETS, GIRDLES, BRASSIERES [, BANDEAUX,
COMBINATION CORSET-BRASSIERES, COMBINATION GIRDLE-BRASSIERES, COMBINATION
CORSET-BANDEAUX, AND COMBINATION GIRDLE-BANDEAUX]; FIRST USE DATE:
1926.11.01; FIRST USE IN COMMERCE: 1926.11.01

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
71-251252

Filing Date
1927.06.28

Change in Registration
CHANGE IN REGISTRATION HAS OCCURED

Registration Number
0236950

Registration Date
1927.12.27

Owner Name/Address
(REGISTRANT) WARNER BROTHERS COMPANY, THE CORPORATION CONNECTICUT 347
MADISON AVE. NEW YORK NEW YORK

Owner Name/Address
(LAST LISTED OWNER) WARNACO INC. CORPORATION BY CHANGE OF NAME FROM
DELAWARE 90 PARK AVENUE NEW YORK NEW YORK 10016

Type of Mark
TRADEMARK

Register
PRINCIPAL

Renewal
3RD RENEWAL 1987.12.27

HON 000543

*** Search: 1 *** Document Number: 1 ***

*** User: EX817099 *** Ser : Number: 73687586 ***

Word Mark
SHADOWS

Goods/Services
IC 025; US 039; G & S: MEN'S AND LADIES' TEE-SHIRTS; LADIES' TANK TOPS,
SLACKS AND SHORTS, CARDIGANS, HATS; FIRST USE DATE: 1984.01.18; FIRST USE
IN COMMERCE: 1984.01.18

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-687586

Filing Date
1987.10.02

Registration Number
1624940

Registration Date
1990.11.27

Owner Name/Address
(REGISTRANT) IKEDA, SHAYNE INDIVIDUAL UNITED STATES 743-C WAIKAMULO ROAD
HONOLULU HAWAII 96817

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON 000544

*** Search: 5 *** Document Number: 164 ***

*** User: EX817099 *** Serial Number: 74003218 ***

Word Mark
SHADOW

Goods/Services
IC 028; US 022; G & S: CHILDREN'S RIDE-ON BOUNCING HORSE TOYS; FIRST USE:
1989.08.22; FIRST USE IN COMMERCE: 1989.08.22

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
74-003218

Filing Date
1989.11.16

Registration Number
1604839

Registration Date
1990.07.03

Owner Name/Address
(REGISTRANT) HEDSTROM CORP. CORPORATION ILLINOIS P.O. BOX 432 BEDFORD
PENNSYLVANIA 15522

Inner Name/Address
(LAST LISTED OWNER) HEDSTROM CORPORATION CORPORATION DELAWARE SUNNEYSIDE
ROAD, BOX 432 BEDFORD PENNSYLVANIA 15522

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit
SECT 8.; SECT 15.; COMBINED SECT 8 AND SECT 15.

HON 000545

*** Search: 2 *** Document Number: 1 ***

*** User: EX817099 *** Seri Number: 73504102 ***

Word Mark
SHADOW

Goods/Services
IC 028; US 022; G & S: GOLF CLUBS AND GOLF CLUB SHAFTS; FIRST USE DATE;
1983.09.20; FIRST USE IN COMMERCE: 1983.09.20

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-504102

Filing Date
1984.10.16

Registration Number
1348246

Registration Date
1985.07.09

Owner Name/Address
(REGISTRANT) TI ACCLES AND POLLOCK LIMITED COMPANY UNITED KINGDOM PADDOCK
WORKS OLDBURY, WARLEY, WEST MIDLANDS ENGLAND

Owner Name/Address
(LAST LISTED OWNER) TI APOLLO LIMITED COMPANY ASSIGNEE OF UNITED KINGDOM

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit
SECT 8.; SECT 15.; COMBINED SECT 8 AND SECT 15.

*** User: EX817099 *** Seri Number: 74141861 ***

Word Mark
SHADOW

Goods/Services
IC 012; US 019; G & S: wheelchairs, racing wheelchairs, and sports wheelchairs; FIRST USE DATE: 1981.02.19; FIRST USE IN COMMERCE: 1981.04.25

Goods/Services
IC 028; US 022; G & S: snow skiing device having a single runner and a seat intended for use by paraplegics, a water skiing device having a single ski and a seat intended for use by paraplegics, and stationary trainers for wheelchairs; FIRST USE DATE: 1988.01.21; FIRST USE IN COMMERCE: 1988.01.21

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
74-141861

Filing Date
1991.02.25

Registration Number
1720106

Registration Date
1992.09.29

Owner Name/Address
(REGISTRANT) Magic In Motion, Inc. CORPORATION WASHINGTON 20604 - 84th Avenue So. Kent WASHINGTON 98032

Type of Mark
TRADEMARK

Register
PRINCIPAL

SHADOW

Word Mark
SHADOW

Goods/Services
IC 028; US 022; G & S: baseball gloves; FIRST USE DATE: 1992.07.00; FIRST
USE IN COMMERCE: 1992.07.00

Mark Drawing Code
(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number
74-323342

Filing Date
1992.10.19

Registration Number
1780427

Registration Date
1993.07.06

Owner Name/Address
(REGISTRANT) GLOVESMITH, Inc. CORPORATION MISSOURI 20 Village Plaza Arnold
MISSOURI 63010

Type of Mark
TRADEMARK

Register
PRINCIPAL

*** User: EX817099 *** Ser . Number: 75083260 ***

Word Mark
SHADOW-BIO

Goods/Services
IC 025; US 022 039; G & S: footwear, namely snowboard boots

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75-083260

Filing Date
1996.04.03

Owner Name/Address
(APPLICANT) WILLIAM H. KAUFMAN INC. CORPORATION CANADA 410 King Street
West Kitchener, Ontario CANADA N2G 4J8

Section 44
SECT 44

Type of Mark
TRADEMARK

Register
PRINCIPAL

Word Mark
SHADOW

Goods/Services
IC 025; US 022 039; G & S: footwear, namely snowboard boots

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75-083261

Filing Date
1996.04.03

Owner Name/Address
(APPLICANT) WILLIAM H. KAUFMAN INC. CORPORATION CANADA 410 King Street
West Kitchener, Ontario CANADA N2G 4J8

Section 44
SECT 44

Type of Mark
TRADEMARK

Register
PRINCIPAL

FILING RECEIPT FOR TRADEMARK APPLICATION

Page 01 of 01

Receipt on the DATE OF FILING of the application for registration and filing fees is acknowledged for the mark identified below. The DATE OF FILING is contingent upon the collection of any payment made by check or draft. Your application will be considered in the order in which it was received and you will be notified as to the examination thereof. Correspondence should be expected from the Patent and Trademark Office in approximately months. When inquiring about this application, include the SERIAL NUMBER, DATE OF FILING, OWNER NAME, and MARK.

06

David N. Makous
LEWIS, D'AMATO, BRISBOIS & BISGAARD, LLP
221 N. Figueroa Street, Suite 1200
Los Angeles, CA 90012

TMPRE

ATTORNEY
REFERENCE NUMBER

PLEASE REVIEW THE ACCURACY OF THE FILING RECEIPT DATA.

A request for correction to the notice of allowance should be submitted within 30 days to the following address: ASSISTANT COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VIRGINIA 22202-3513. The correspondence should be marked to the attention of the Office of Trademark Program Control. The Patent and Trademark Office will review the request and make corrections when appropriate.

SERIAL NUMBER: 75/082470

DATE OF FILING: 04/02/1996

MARK: SHADOW AMERICAN CLASSIC EDITION

MARK TYPE(S): TRADEMARK

DRAWING TYPE: WORDS, LETTERS, OR NUMBERS IN TYPED FORM

SECTION 1(A): NO

SECTION 1(B): YES

SECTION 44: NO

ATTORNEY: David N. Makous

OWNER NAME: HONDA GIKEN KOGYO

KABUSHIKI KAISHA

OWNER ADDRESS: 2-1-1 Minami-Aoyama, Minato-Ku
Tokyo 107
JAPAN

ENTITY: CORPORATION

CITIZENSHIP/DOMICILE: JAPAN

INTERNATIONAL CLASS

DATE OF FIRST USE

DATE OF FIRST USE IN COMMERCE

ONLY THOSE DATES OF USE AND CLASSES FILED UNDER SECTION 1(A) ARE LISTED

GOODS/SERVICES BY INTERNATIONAL CLASS

014-jewelry
016-paper goods and printed matter
018-leather goods
025-clothing and footwear
026-fancy goods
028-toys and sporting goods

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

HON 000551

21929-110
COURT

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Commissioner of Patents and Trademarks, Box ITU, 2900 Crystal Drive, Arlington, Virginia 22202-3532

By: R. N. A.
Raffi A. Nahabedian

Date Mailed: April 2, 1996

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
APPLICATION FOR REGISTRATION OF TRADEMARK ON PRINCIPAL REGISTER
[Intent-to-Use]

Applicant: HONDA GIKEN KOGYO)
KABUSHIKI KAISHA)
(Honda Motor Co., Ltd.))
Address: 2-1-1 Minami-Aoyama,)
Minato-Ku, Tokyo 107,)
JAPAN)
Mark: SHADOW AMERICAN CLASSIC)
EDITION)
I.C.: 14, 16, 18, 25, 26 & 28)

TO THE ASSISTANT COMMISSIONER OF PATENTS AND TRADEMARKS:

TRANSMITTAL LETTER

Enclosed herewith and pertaining to the above-described Intent-to-Use trademark application are the following documents/items:

1. Intent-to-Use Application for Registration of the mark SHADOW AMERICAN CLASSIC EDITION;
2. Drawing for the mark SHADOW AMERICAN CLASSIC EDITION in International Classes 14, 16, 18, 25, 26 & 28; and
3. A check in the amount of \$245.00.

DATED: April 2, 1996

Respectfully submitted,
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

By R. N. A.
Raffi A. Nahabedian
Attorneys for Applicant

DATA96LA: 32257.1

HON 000552

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Box ITU, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: Raffi A. Nahabedian

Date Mailed: APR 2, 1996

Express Mail No. EF086997152US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
APPLICATION FOR REGISTRATION OF TRADEMARK ON PRINCIPAL REGISTER
[INTENT-TO-USE]

Applicant:	HONDA GIKEN KOGYO)	Mark: SHADOW AMERICAN
	KABUSHIKI KAISHA)	CLASSIC EDITION
	(Honda Motor Co., Ltd.))	
)	I.C.: 14, 16, 18,
)	25, 26 & 28
Address:	2-1-1 Minami-Aoyama,)	
	Minato-Ku, Tokyo 107,)	
	JAPAN)	
)	
)	

TO THE ASSISTANT COMMISSIONER OF PATENTS AND TRADEMARKS:

The above-identified Applicant, Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.), a Japanese corporation, requests registration of the mark shown in the accompanying drawing in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 1051 et seq., as amended), for the following goods:

Int'l Class 14: "Jewelry"

DATA96LA: 16323.1

HON 000553

Int'l Class 16: "Paper goods and printed matter"

Int'l Class 18: "Leather goods"

Int'l Class 25: "Clothing and footwear"

Int'l Class 26: "Fancy goods"

Int'l Class 28: "Toys and sporting goods"

Applicant has a bona fide intention to use the mark in commerce in association with the above-identified goods (15 U.S.C. 1051(b), as amended).

The mark will be used by applying it to the goods themselves and in other ways customary in the trade.

DECLARATION

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this application on behalf of the applicant; he believes the applicant to be the owner of the trademark; to the best of his

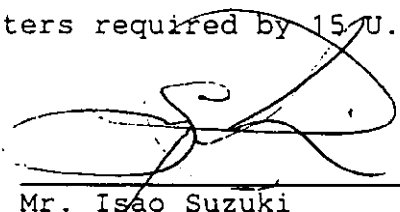
knowledge and belief no other persons, firm, corporation, or association has the right to use the above identified mark in commerce, either in the identical form or in such near resemblance thereto as may be likely, when applied to the goods or services of such other person, to cause confusion, or to cause mistake, or to deceive; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Applicant hereby appoints David N. Makous, Sarira D. Alexander, Raffi A. Nahabedian, and each member of the firm of Lewis, D'Amato, Brisbois & Bisgaard, 221 North Figueroa Street, Suite 1200, Los Angeles, California 90012, telephone number (213) 250-1800, its principal attorneys to prosecute this application, to transact all business in the Patent and Trademark Office in connection therewith, to receive notification of acceptance, and any certificate issued.

DESIGNATION OF DOMESTIC REPRESENTATIVE

Applicant hereby designates David N. Makous, a resident of the United States, at Lewis, D'Amato, Brisbois & Bisgaard, 221 North Figueroa Street, Suite 1200, Los Angeles, California 90012, as its domestic representative in all matters required by 15 U.S.C. §1051(e) and 37 C.F.R. §2.24.

Dated: April 1, 1996


Mr. Isao Suzuki
Director, Honda Motor Co., Ltd.

LEWIS, D'AMATO, BRISBOIS & BISGAARD, LLP
221 N. Figueroa Street, Suite 1200
Los Angeles, California 90012
(213) 250-1800

DRAWING
[INTENT-TO-USE]

Applicant: Honda Giken Kogyo Kabushiki Kaisha
(Honda Motor Co., Ltd.)

Address: 2-1-1 Minami-Aoyama
Minato-Ku, Tokyo 107,
JAPAN

Mark: SHADOW AMERICAN CLASSIC EDITION

Goods: "Jewelry" (Int'l Class 14)
"Paper goods and printed matter" (Int'l Class 16)
"Leather goods" (Int'l Class 18)
"Clothing and footwear" (Int'l Class 25)
"Fancy goods" (Int'l Class 26)
"Toys and sporting goods" (Int'l Class 28)

SHADOW AMERICAN CLASSIC EDITION

—1988 HONDA m/c Press Kit—

PRESS KIT

HON 000557

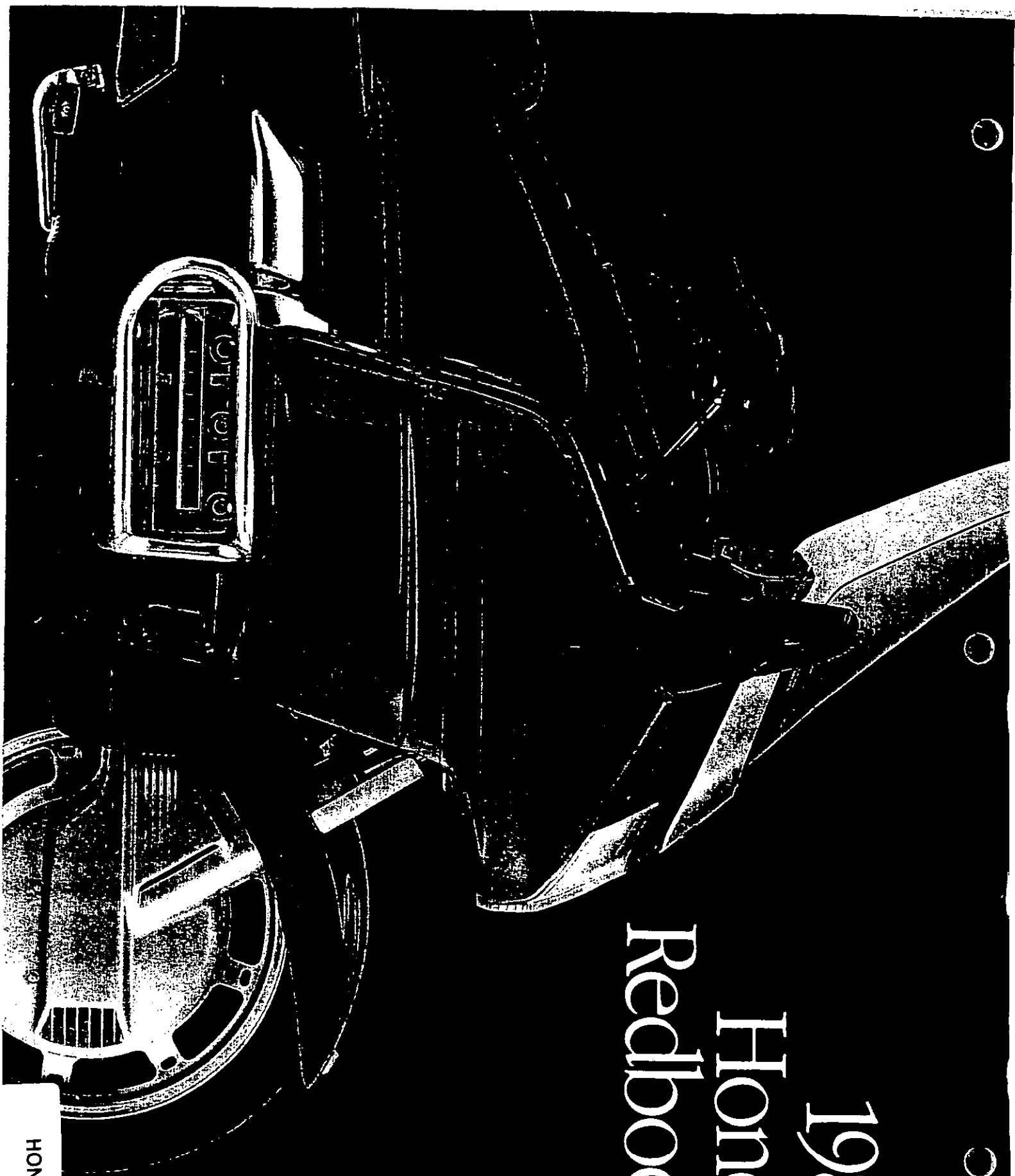
HONDA

HON 000558



000021505

1988 Honda Redbook



HON 000559

The United States of America



CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office; that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Director of the United States Patent and Trademark Office; and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law; and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



Director of the United States Patent and Trademark Office

APPLICANT'S
EXHIBIT
21

Requirements for Maintaining a Federal Trademark Registration

SECTION 8: AFFIDAVIT OF CONTINUED USE

The registration shall remain in force for 10 years, except that the registration shall be canceled for failure to file an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. §1058, upon the expiration of the following time periods:

- i) At the end of 6 years following the date of registration.
- ii) At the end of each successive 10-year period following the date of registration.

Failure to file a proper Section 8 Affidavit at the appropriate time will result in the cancellation of the registration.

SECTION 9: APPLICATION FOR RENEWAL

The registration shall remain in force for 10 years, subject to the provisions of Section 8, except that the registration shall expire for failure to file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. §1059, at the end of each successive 10-year period following the date of registration.

Failure to file a proper Application for Renewal at the appropriate time will result in the expiration of the registration.

No further notice or reminder of these requirements will be sent to the Registrant by the Patent and Trademark Office. It is recommended that the Registrant contact the Patent and Trademark Office approximately one year before the expiration of the time periods shown above to determine the requirements and fees for the filings required to maintain the registration.

Int. Cl.: 16

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

United States Patent and Trademark Office

Reg. No. 2,582,475

Registered June 18, 2002

TRADEMARK
PRINCIPAL REGISTER

SHADOW

HONDA GIKEN KOGYO KABUSHIKI KAISHA
(JAPAN CORPORATION)
2-1-1 MINAMI-AOYAMA
MINATO-KU
TOKYO 107, JAPAN

FIRST USE 9-0-2000; IN COMMERCE 9-0-2000.

SN 75-082,469, FILED 4-2-1996.

FOR: PRINTED MATTER IN THE NATURE OF
PUBLICATIONS TO BE DISTRIBUTED TO PUR-
CHASERS OF HONDA MOTORCYCLES, IN CLASS
16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

JACQUELINE A. LAVINE, EXAMINING ATTOR-
NEY

HON018518

UNITED STATES DEPARTMENT OF COMMERCE
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513
May 7, 2002

NOTICE OF ACCEPTANCE OF STATEMENT OF USE

DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD LLP
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

TM109

ATTORNEY
REFERENCE NUMBER:

21929-112

SERIAL NUMBER: 75/082469
MARK: SHADOW
OWNER: HONDA GIKEN KOGYO KABUSHIKI KAISHA

The statement of use filed in regard to the above-identified application has been accepted. This acceptance signifies that the statement of use is accepted in all respects and that the mark is entitled to be registered. Accordingly, the registration will issue in due course barring any extraordinary circumstances.

HON018519

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

SAN DIEGO OFFICE
SUITE 800
550 WEST "C" STREET
SAN DIEGO, CALIFORNIA 92101
TELEPHONE (619) 233-1008

COSTA MESA OFFICE
SUITE 1400
650 TOWN CENTER DRIVE
CENTER TOWER BUILDING
COSTA MESA, CALIFORNIA 92626
TELEPHONE (714) 546-9200

SAN FRANCISCO OFFICE
SUITE 1400
ONE SANSOME STREET
SAN FRANCISCO, CALIFORNIA 94104
TELEPHONE (415) 362-2550

NANCY QUINTERO
PARALEGAL
DIRECT DIAL: (213) 880-5123
E-MAIL: QUINTERO@LDBB.COM

LAWYERS
SUITE 1200
221 NORTH FIGUEROA STREET
LOS ANGELES, CALIFORNIA 90012
TELEPHONE (213) 250-1800
WWW.LDBB.COM

INLAND EMPIRE OFFICE
TRI-CITY CORPORATE CENTRE
SUITE 600
850 EAST HOSPITALITY LANE
SAN BERNARDINO, CALIFORNIA 92408
TELEPHONE (909) 387-1130

SACRAMENTO OFFICE
SUITE 200
2800 VENTURE OAKS WAY
SACRAMENTO, CALIFORNIA 95833
TELEPHONE (916) 564-5400

FACSIMILES:
LOS ANGELES: (213) 250-7900
SAN DIEGO: (619) 233-8827
COSTA MESA: (714) 850-1030
SAN FRANCISCO: (415) 434-0882
SAN BERNARDINO: (909) 387-1138
SACRAMENTO: (916) 564-5444

OUR FILE NO.:
21929-112

January 7, 2002

VIA U.S. EXPRESS MAIL

Assistant Commissioner of Patents
and Trademarks
Box ITU
2900 Crystal Drive
Arlington, Virginia 22202-3513

Dear Sir or Madam:

Enclosed is a Statement of Use, specimens, postcard and our check to cover the fee, as follows:

Applicant: Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.)
Mark: SHADOW
Serial No.: 75/082469
Int'l. Class: 16
Filing Fee: \$100.00

Please date stamp the postcard and return it to our office upon receipt of this correspondence.

Very truly yours,


Nancy Quintero

Paralegal to David N. Makous, of
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

I hereby certify that this correspondence is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" service under 37 CFR § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Box ITU - FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: [Signature]

Express Mail No.: **EL802775941US**

Date Mailed: January 7, 2002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
)	
Honda Giken Kogyo Kabushiki)	
Kaisha (Honda Motor Co., Ltd.))	
)	
Serial No. 75/082469)	
)	
Filed: April 2, 1996)	
)	Docket No.
Int'l Class: 16)	21929-112
)	
Mark: SHADOW)	
)	

Assistant Commissioner of Patents and Trademarks
Box ITU - FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

STATEMENT OF USE UNDER
37 C.F.R. 2.88 WITH DECLARATION

Applicant, Honda Giken Kogyo Kabushiki Kaisha, requests registration of the above-identified trademark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. § 1051 et seq., as amended).

Applicant is using the mark in commerce in connection with the goods associated with Class 16 as identified in the Notice of Allowance dated January 23, 2001, issued relative to this application.

The mark was first used with the goods "printed matter in the nature of publications to be distributed to purchasers of Honda motorcycles" in International Class 16 at least as early as September 2000; was first used in interstate commerce at least as early as September 2000; and is now in use in such commerce with these goods.

One (1) specimen showing the mark as used in International Class 16 and in commerce is submitted with this Statement of Use.

The fee prescribed by Section 2.6(a)(3) is enclosed herewith.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this Statement of Use on behalf of

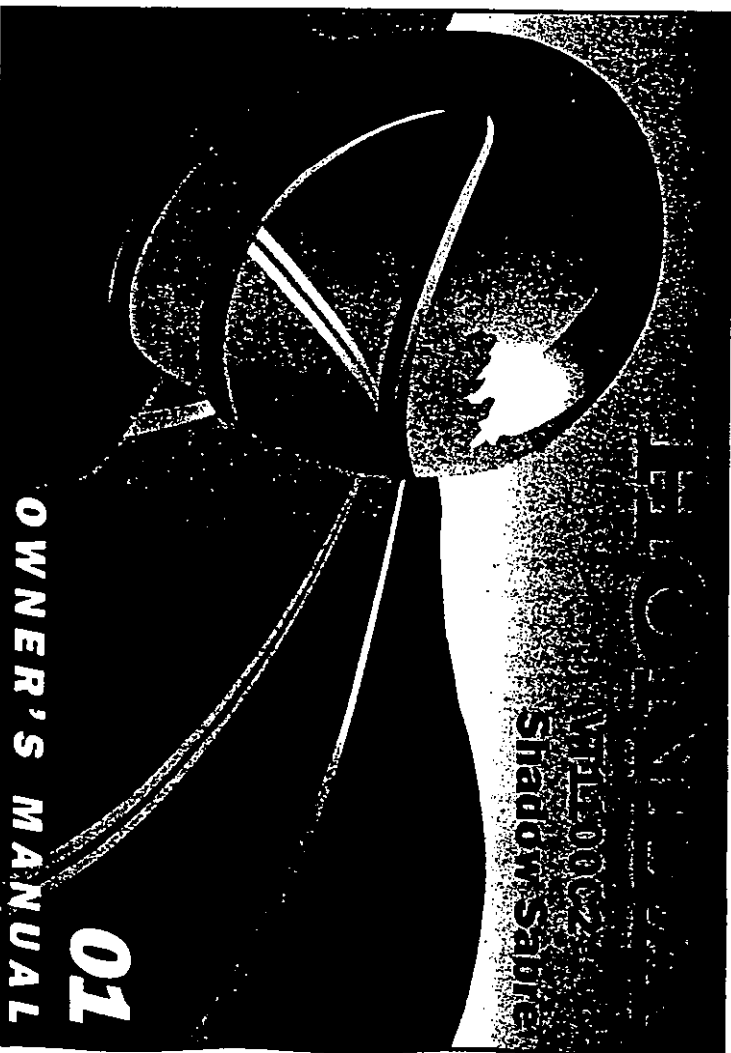
the Applicant; he believes the Applicant to be the owner of the trademark sought to be registered; the trademark is now in use in commerce; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Dated: January 2, 2002

By: 

Mr. Atsuyoshi Hyogo
Director, Honda Motor Co.,
Ltd.

David N. Makous, Esq.
Lewis, D'Amato, Brisbois & Bisgaard
221 No. Figueroa St., Ste. 1200
Los Angeles, California 90012
Telephone: (213) 250-1800
Facsimile: (213) 250-7900



OWNER'S MANUAL

01

Model 10002
Shadow Sable

HON018524

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
)	
Honda Giken Kogyo Kabushiki)	
Kaisha (Honda Motor Co., Ltd.))	
)	
Serial No. 75/082469)	
)	
Filed: April 2, 1996)	
)	Docket No.
Int'l Class: 16)	21929-112
)	
Mark: SHADOW)	
)	

(Specimen Int'l Class 16)

Please acknowledge receipt of our STATEMENT OF USE, FILING FEE by affixing hereon the Patent and Trademark Office date stamp and return this card to our office. In re application of:

Mark: SHADOW
Applicant: Honda Giken Kogyo Kabushiki Kaisha
Serial No.: 75/082469
Int'l. Class: 16
Our File No.: 21929-112
Mailed: January 7, 2002

99LA-48290.1

WARNING - Do not cash unless you can verify a color change - Rub Briskly to Verify

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

Comerica Bank-California
Los Angeles Downtown

CHECK NO. 238534

90-3752/1211

\$ *****100.00

DATE 01/04/2002

Draft valid 120 days from date issued
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

FOR THE ASSISTANT COMMISSIONER OF
ORDER PATENT AND TRADEMARK
OFFICE

Michael E.

238534 1/4/02 1:12 PM 1375221 1891462440

WARNING VERIFY WORD VALIDITY BY TOUCHING, RUBBING OR BREATHING ON.

HON018526

**COST ADVANCE TICKET
CHECK REQUEST**

140416

1. ☒ Check—date needed 01/04/02
2. ☐ Direct expense—
- 150 ☐ Overtime Dinner Reimbursement
- 151 ☐ Mileage
- 152 ☐ Miscellaneous
- 153 ☐ Filing Fee
- ☐ Firm expense
- 154 ☐ Witness Fee
- 155 ☐ Deposition
- 157 ☐ Reproduction
- ☐ Clients advance check
3. Client and file name. Honda North America, Inc. Client and matter No.: 21929-112
4. Payee or vendor: Assistant Commissioner of Patents and Trademarks Amount \$ 100.00
5. Mailing address (if applicable): _____
6. Reference on remittance advice: _____
7. Explanation for billing purposes: fee for filing statement of use for SHADW in class 16

8. Disposition of check

☐ Mail

Auth. by Nancy Quintero

Number

☒ Nancy O.; ext. 2285

Signature _____

Date.

1/4/02-

Instructions:

- (1) Original to data processing/numeric copy
(2) Second copy (yellow) attached to invoice to accounting
(3) Third copy (pink) retain in attorney's file

[illegible]

HON018527

UNITED STATES DEPARTMENT OF COMMERCE
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513
Oct 23, 2001

21929-112
P10
C

NOTICE OF APPROVAL OF EXTENSION REQUEST

TM109

ATTORNEY
REFERENCE NUMBER:

DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD LLP
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

SERIAL NUMBER: 75/082469

MARK: SHADOW

OWNER: HONDA GIKEN KOGYO KABUSHIKI KAISHA

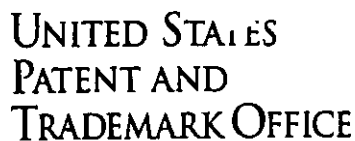
EXTENSION REQUEST NUMBER: 1

NOTICE OF ALLOWANCE DATE: Jan 23, 2001

THE ABOVE NUMBERED EXTENSION REQUEST FOR FILING A STATEMENT OF USE HAS BEEN APPROVED BY THIS OFFICE.

THE APPLICANT HAS UNTIL Jan 23, 2002 TO FILE A STATEMENT OF USE OR ANOTHER EXTENSION REQUEST. THE APPLICANT CAN FILE A TOTAL OF FIVE EXTENSION REQUESTS NOT TO EXCEED 36 MONTHS FROM THE NOTICE OF ALLOWANCE DATE.

IF THERE ARE ANY QUESTIONS REGARDING THIS NOTICE, PLEASE CONTACT THE TRADEMARK ASSISTANCE CENTER AT (703)308-9000.



Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
www.uspto.gov

David N. Makous
Lewis D'Amato Brisbois & Bisgaard, LLP
221 N. Figueroa Street
Suite 1200
Los Angeles, CA 90012

Rev. No. 1
September 1, 2001

RE: Serial Number: 75/082469
Applicant: Honda Giken Kogyo Kabushiki
Kaisha (Honda Motor Co., Ltd.)
Mark: **SHADOW**

Dear Mr. Makous

The Request to Divide the above identified trademark application has been received. For your information, the cost for processing a Request to Divide is \$100.00 for each new file created. If you want to divide some, but not all, of the goods or services in a class, a new application fee of \$325.00 must be submitted for each new application created, in addition to the \$100.00 divisional fee. For example, the fee for dividing within a class is \$425.00, a new application fee of \$325.00 plus a \$100.00 divisional fee.

When a divisional request is filed together with a Statement of Use (\$100 per class fee) and/or and Extension of Time to File a Statement of Use (\$150 per class), the fees for those documents must be filed with the Request to Divide.

Accordingly, an additional fee of ~~\$650.00~~ is required in order to process the Request to Divide. Please be advised that you have thirty days from the mailing date of this letter to file the outstanding fees. If the fee is not timely received, the divisional request will be denied and the file will be returned to its previous status.

Fredrick G. In

Frederick J. Turner
Paralegal Specialist
ITU/Divisional Unit
(703) 308-9550 ext. 219

15/1/07

9/11
1st meeting
2nd meeting
3rd meeting
4th meeting
5th meeting
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HON018529

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FEES OWED by affixing hereon the Patent and Trademark Office date stamp
and returning it to our office. In re application of:

Applicant: Honda Giken Kogyo Kabushiki Kaisha
Mark: SHADOW

Classes: 25 & 28

Serial No.: 75/082469

Filed Date: April 2, 1996

File No.: 21929-112

Mailed: September 26, 2001



09-26-2001

U.S. Patent & TMO/TM Mail Rcpt Dt #57

HON018530



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Mr. J. L. HARRIS
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HON018531

Confirmation Report

21929-112
PTO

Page : 001
Date & Time: Aug-16-01 10:31am
Line 1 : 213 680 5195
Machine ID : Lewis, D'Amato, Brisbois & Bisgard

Nbr.	Job	Date	Time	Duration	pgs To	Dept.nbr	Account	Comm. code	Status
551	683	Aug-16	10:24am	06/17	017	70387292583333333333		EC 502	OK TH

Jeff Turk
Mr. Fred Turner

HON018532

Auto-Reply Facsimile Transmission



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From: United States Patent and Trademark Office

Fax information...

Date Received: 8/16/01 1:32:15 PM [Eastern Daylight Time]
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SACRAMENTO (916) 444-0000

213-680-1000

August 16, 2001

		Phone Number	Fax Number
To:	Mr. Fred Turner Assistant Commissioner of Patents and Trademarks ITU Division	(703) 508-9550 extension 219	(703) 872-9258
From:	Jeff Turk, Paralegal to David Makous	(213) 680-5048	
Pages:	17		
Re:	21929-112		

Message:

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HON018533

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650 EAST HOSPITALITY LANE
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SACRAMENTO OFFICE
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FACSIMILES:
LOS ANGELES: (213) 250-7900
SAN DIEGO: (619) 233-8627
COSTA MESA: (714) 850-1030
SAN FRANCISCO: (415) 434-0882
SAN BERNARDINO: (909) 387-1138
SACRAMENTO: (916) 564-5444

OUR FILE NO.
21929-112

August 16, 2001

VIA FACSIMILE (703) 872-9258

Mr. Fred Turner
Assistant Commissioner of Patents and Trademarks
Box ITU
2900 Crystal Drive
Arlington, Virginia 22202-3513

RE: Applicant: Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.)
Mark: SHADOW
Serial No.: 75/082469
Int'l. Classes: 16, 25 & 28
Our File: 21929-112

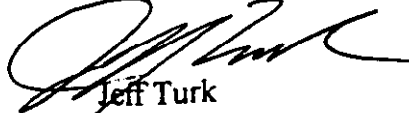
Dear Mr. Turner:

Pursuant to your telephone message of August 15, 2001, attached please find the following documents originally filed on July 19, 2001 with the USPTO:

1. Statement of Use with specimens for Classes 25 and 28;
2. First Extension of Time to File Statement of Use for Class 16;
3. Request to Divide Application; and
4. Stamped PTO Card

Please do not hesitate to advise if you have any more questions.

Very truly yours,



Jeff Turk
Paralegal to David N. Makous, of
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

770

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

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OUR FILE NO.
21629-112

July 18, 2001

VIA U.S. EXPRESS MAIL

Assistant Commissioner of Patents
and Trademarks
Box ITU
2900 Crystal Drive
Arlington, Virginia 22202-3513

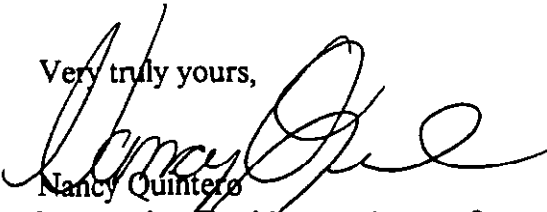
Dear Sir or Madam:

Enclosed is a Statement of Use, specimens, postcard and our check to cover the fee, as follows:

Applicant: Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.)
Mark: SHADOW
Serial No.: 75/082469
Int'l. Classes: 25 & 28
Filing Fee: \$200.00

Please date stamp the postcard and return it to our office upon receipt of this correspondence.

Very truly yours,


Nancy Quintero

Paralegal to David N. Makous, of
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

I hereby certify that this correspondence is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" service under 39 CFR § 1.10 on the date indicated below and in an envelope addressed to Assistant Commissioner of Patents and Trademarks, Box ITU - FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: David N. Makous
Express Mail No.: EJ194810325US
Date Mailed: 7/19/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
)	
Honda Giken Kogyo Kabushiki)	
Kaisha (Honda Motor Co., Ltd.))	
)	
Serial No. 75/082469)	
)	
Filed: April 2, 1996)	
)	
Int'l Classes: 25 & 28)	Docket No.
)	21929-112
)	
Mark: SHADOW)	
)	

Assistant Commissioner of Patents and Trademarks
Box ITU - FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

STATEMENT OF USE UNDER
37 C.F.R. 2.88 WITH DECLARATION

Applicant, Honda Giken Kogyo Kabushiki Kaisha, requests registration of the above-identified trademark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. § 1051 et seq., as amended).

Applicant is using the mark in commerce in connection with the goods identified in the Notice of Allowance dated January 23, 2001, issued relative to this application.

The mark was first used with the goods "clothing, namely, shirts, sweatshirts, sweaters, jackets, vests, pants, bandannas, belts, hats, gloves, footwear, sold through authorized Honda motorcycle dealers" in International Class 25 at least as early as July 1995; was first used in interstate commerce at least as early as July 1995; and is now in use in such commerce with these goods.

One (1) specimen showing the mark as used in International Class 25 and in commerce is submitted with this Statement of Use.

The mark was first used with the goods "metallic and plastic replicas of the Shadow motorcycle sold by Honda and accessories therefor" in International Class 28 at least as early as February 1997; was first used in interstate commerce at least as early as February 1997; and is now in use in such commerce with these goods.

One (1) specimen showing the mark as used in International Class 28 and in commerce is submitted with this Statement of Use.

The fee prescribed by Section 2.6(a)(3) is enclosed herewith.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this Statement of Use on behalf of the Applicant; he believes the Applicant to be the owner of the trademark sought to be registered; the trademark is now in use in commerce; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Dated: July 16, 2001

By: 

Mr. Atsuyoshi Kyogo
Director, Honda Motor Co.,
Ltd.

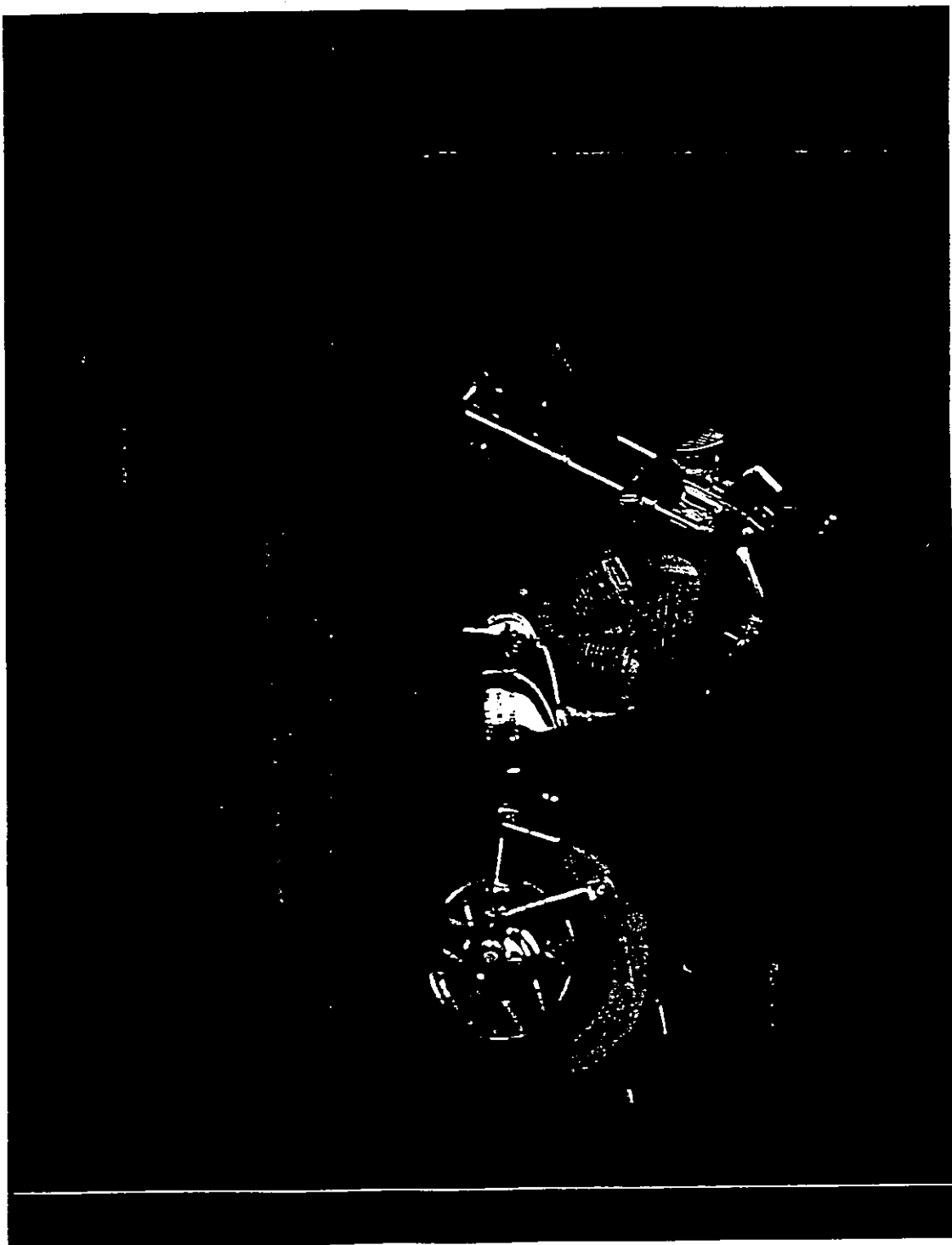
David N. Makous, Esq.
Lewis, D'Amato, Brisbois & Bisgaard
221 No. Figueroa St., Ste. 1200
Los Angeles, California 90012
Telephone: (213) 250-1800
Facsimile: (213) 250-7900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
)	
Honda Giken Kogyo Kabushiki)	
Kaisha (Honda Motor Co., Ltd.))	
)	
Serial No. 75/082469)	
)	
Filed: April 2, 1996)	
)	Docket No.
Int'l Classes: 25 & 28)	21929-112
)	
Mark: SHADOW)	
)	



(Specimen Int'l Class 25)



HON018540

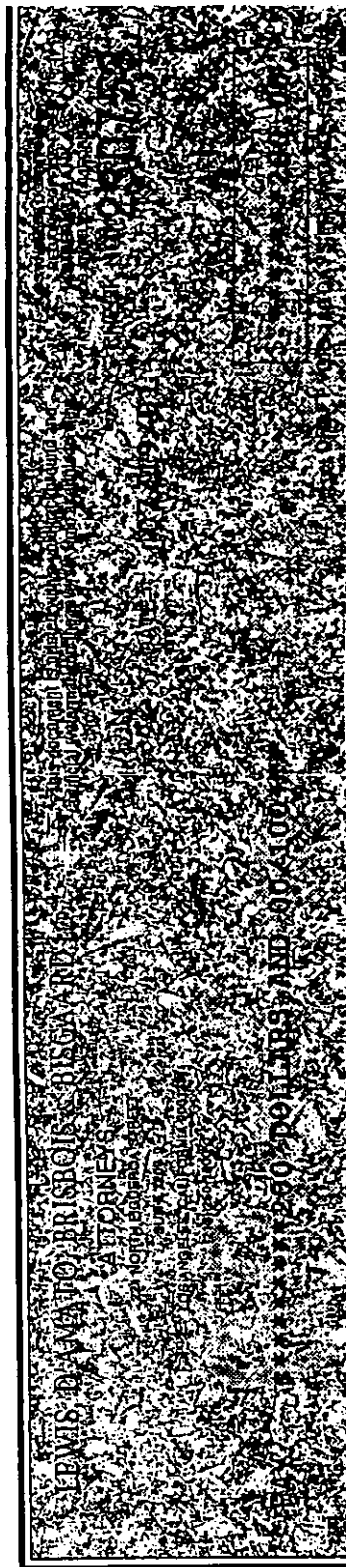
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
)	
Honda Giken Kogyo Kabushiki)	
Kaisha (Honda Motor Co., Ltd.))	
)	
Serial No. 75/082469)	
)	
Filed: April 2, 1996)	
)	Docket No.
Int'l Classes: 25 & 28)	21929-112
)	
Mark: SHADOW)	
)	

(Specimen Int'l Class 28)

Please acknowledge receipt of our Statement of Use, First Request for Extension of Time to File a Statement of Use, and Request to Divide by affixing hereon the Patent and Trademark Office data stamp and return this card to our office. In re application of:

Mark: SHADOW
Applicant: Honda Giken Kogyo Kabushiki Kaisha
Serial No.: 75/082469
Int'l. Classes: 25 & 28
Our File No.: 21929-112
Mailed: July 19, 2001



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By: David N. Makous
Express Mail No.: EJ194810325US
Date Mailed: July 19, 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
)	
Honda Giken Kogyo Kabushiki)	
Kaisha (Honda Motor Co., Ltd.))	
)	
Serial No. 75/082469)	
)	
Filed: April 2, 1996)	
)	Docket No.
Int'l Class: 16)	21929-112
)	
Mark: SHADOW)	
)	

Assistant Commissioner of Patents and Trademarks
Box ITU - FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

FIRST REQUEST FOR EXTENSION OF TIME
UNDER 37 C.F.R. § 2.89 TO FILE
STATEMENT OF USE

Sir:

Applicant requests a six-month extension of time to file the Statement of Use under 37 C.F.R. § 2.89. Applicant has a continued bona fide intention to use the mark in commerce in connection with the goods in Class 16 as identified in the Notice of Allowance in the above-identified application.

LA2001:72685.1

HON018543

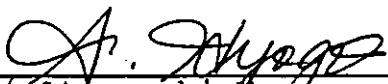
This is the first request for an Extension of Time following the mailing of the Notice of Allowance dated January 23, 2001.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this First Request For Extension of Time To File a Statement of Use on behalf of the applicant; he believes the applicant to be entitled to use the mark sought to be registered; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Executed this 16^m day of July 2001, at Torrance, California.

Honda Giken Kogyo Kabushiki Kaisha
(Honda Motor Co., Ltd.)

By: _____


Mr. Atsuyoshi Hyogo
Director, Honda Motor Co., Ltd.

David N. Makous, Esq.
Lewis, D'Amato, Brisbois & Bisgaard LLP
221 No. Figueroa St., Ste. 1200
Los Angeles, California 90012
Telephone: (213) 250-1800
Facsimile: (213) 250-7900

LINES, JAMES H. BRISBOIS, HIS WIFE, and
 ATTORNEYS
 200 NORTH CHICAGO STREET
 CHICAGO, ILL.

This document is submitted to the
 official valuation authority for
 valuation of the property herein
 described.

DATE: 107-119-701
 230154

150 DOLLARS, AND 00/100

ASSISTANT COMMISSIONER OF
 PATENT & TRADEMARK

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 WASHINGTON, D.C.

"07"098 723"

"230754" :122201444:

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by: David N. Makous
Date Mailed: July 19, 2001
Express Mail No. EJ19481032505

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
)	
Honda Giken Kogyo Kabushiki Kaisha)	
(Honda Motor Co., Ltd.))	
)	
Serial No. 75/082469)	Docket No.
)	21929-112
Filed: April 2, 1996)	
)	
Int'l Classes: 16, 25 & 28)	
)	
Mark: SHADOW)	
)	
)	

Assistant Commissioner for Trademarks
Box ITU
2900 Crystal Drive
Arlington, Virginia 22202-3513

REQUEST TO DIVIDE APPLICATION

Pursuant to the Trademark Manual of Examining Procedure §1105.06 and 37 C.F.R.

§2.87, Applicant respectfully requests that the above-identified application be divided as follows:

LA2001:77925.1

HON018546

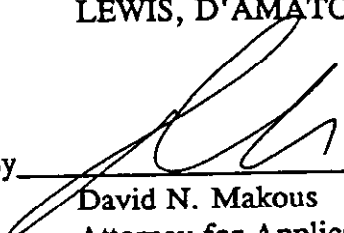
Applicant respectfully requests International Class 16 be divided out into a separate application, and, a Statement of Use for Classes 25 and 28 is enclosed herewith.

In addition, Applicant requests International Class 16 to be kept in the originally filed application, and, an extension of time to file a Statement of Use for said class is enclosed herewith.

Enclosed is the \$100.00 fee for the divisional.

Respectfully submitted,
LEWIS, D'AMATO, BRISBOIS & BISGAARD

Dated: July 18 2001

By 
David N. Makous
Attorney for Applicant

DAVID N. MAKOUS
LEWIS, D'AMATO, BRISBOIS & BISGAARD
221 North Figueroa Street, Suite 1200
Los Angeles, California 90012
Telephone No. (213) 250-1800
Facsimile No. (213) 250-7900

11° 230'55"	1212220444"	11° 07'00"98	72311°
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Please acknowledge receipt of our Statement of Use, ~~and~~ Request for Extension of Time to File a Statement of Use, and ~~Request to Divide~~ by affixing hereon the Patent and Trademark Office date stamp and return this card to our office. In re application of:

Mark:	SHADOW
Applicant:	Honda Giken Kogyo Kabushiki Kaisha
Serial No.:	75/082469
Int'l. Classes:	25 & 28
Our File No.:	21929-112
Mailed:	July 14, 2001



07-19-2001

U.S. Patent & TMO/TM Mail Rcpt Dt #71

HON018549

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TELEPHONE (415) 382-2580

JEFF M. TURK

PARALEGAL

DIRECT DIAL: (213) 680-5048

E-MAIL: TURK@LDBB.COM

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SAN BERNARDINO: (909) 387-1138

SACRAMENTO: (916) 564-5444

OUR FILE NO.
21929-112

PTO

August 16, 2001

Phone Number

Fax Number

To: Mr. Fred Turner
Assistant Commissioner of
Patents and Trademarks
ITU Division.

(703) 308-9550
extension 219

(703) 872-9258

From: Jeff Turk, Paralegal to
David Makous

(213) 680-5048

Pages: 17

Re: 21929-112

Message:

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21929-112

U.S. Patent and Trademark Office (PTO)
NOTICE OF ALLOWANCE

(NOTE: If any data on this notice is incorrect, please submit a written request for correction of the NOA to: Assistant Commissioner for Trademarks, Box 1TU, 2900 Crystal Drive, Arlington, VA 22202-3513. Please include the serial number of your application on ALL correspondence with the PTO. 15 U.S.C. 1063(b)(2))

ISSUE DATE OF NOA: Jan 23, 2001

DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD LLP
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

7/23/01
1/23/01

**** IMPORTANT INFORMATION: 6 MONTH DEADLINE ****

To avoid ABANDONMENT of this application, either a "Statement of Use" (a.k.a. "Allegation of Use") or a "Request for Extension of Time to File a Statement of Use" (a.k.a. "Extension Request") and the appropriate fee(s) must be received in the PTO within six months of the issue date of this Notice Of Allowance (NOA) for those goods and/or services based on intent to use. Failure to do so will result in the ABANDONMENT of this application.

Please note that both the "Statement of Use" and "Extension Request" have many legal requirements, including fees. These requirements are explained in the PTO booklet "Basic Facts About Trademarks", which can be obtained upon request at (703)308-9000. In addition, there are printed forms contained in this booklet (for "Statements of Use" and "Extension Requests") for your use.

The following information should be reviewed for accuracy:

SERIAL NUMBER: 75/082469
MARK: SHADOW
OWNER: HONDA GIKEN KOGYO KABUSHIKI KAISHA
2-1-1 Minami-Aoyama
Minato-Ku
Tokyo 107, JAPAN

This application has the following bases, but not necessarily for all listed goods/services:
Section 1(a): NO Section 1(b): YES Section 44(e): NO

GOODS/SERVICES BY INTERNATIONAL CLASS

016—printed matter in the nature of publications to be distributed to purchasers of Honda motorcycles

025—clothing, namely, shirts, sweatshirts, sweaters, jackets, vests, pants, bandannas, belts, hats, gloves, footwear, sold through authorized Honda motorcycle dealers

028—metallic and plastic replicas of the Shadow motorcycle sold by Hondas and accessories therefor

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

HON018551



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

Sep 29, 2000

21929-112

NOTICE OF PUBLICATION UNDER 12(a)

- | | |
|---|---|
| 1. Serial No.:
75/082,469 | 2. Mark:
SHADOW |
| 3. International Class(es):
16, 25, 28 | |
| 4. Publication Date:
Oct 31, 2000 | 5. Applicant:
HONDA GIKEN KOGYO KABUSHIKI KAISHA |

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a notice of allowance pursuant to section 13(b) of the Statute.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents
U.S. Government Printing Office
PO Box 371954
Pittsburgh, PA 15250-7954
Phone: (202) 512-1800

By direction of the Commissioner.

HON018552

Please acknowledge receipt of our **Response to Office Action** by affixing hereon the Patent and Trademark Office date stamp and return this card to our office. In re application of:

Mark: SHADOW
Applicant: Honda Giken Kogyo Kabushiki Kaisha
S/N: 75/082469
Classes: 16, 25, 28
Cur File No.: 21929-112
Mailed: June 27, 2000



06-30-2000

U.S. Patent & TMOs/TM Mail Rpt Dt. #66

HON018553

I hereby certify that this correspondence is being deposited with the United States Postal Service "First Class Mail" service under 37 CFR § 1.8 on the dated indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Attention: Law Office 109, 2900 Crystal Drive, Arlington VA, 22202-3513

by: _____

Daniel C. DeCarlo

Date Mailed: June 27, 2000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	HONDA GIKEN KOGYO)	Examining Attorney:
	KABUSHIKI KAISHA)	Jacqueline A. Lavine
	(Honda Motor Co., Ltd.))	
)	Law Office 109
Mark:	SHADOW)	
Serial No.:	75/082469)	
Class:	16, 25, 28)	
Filing Date:	April 2, 1996)	Our File No.: 21929-112
)	

To the Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

RESPONSE TO OFFICE ACTION

APPLICANT REQUESTS THAT THIS MATTER BE REMOVED FROM THE
INACTIVE STATUS AND REACTIVATED FOR PROSECUTION.

This application was initially filed on April 2, 1996. The

application now concerns the goods as identified in Class 16, 25 and 28.

2. The Applicant filed a response to the Office Action of March 4, 1997.^{1/} The Examiner had previously cited the trademark registration SHADOW (Registration No. 236,950) as a block to applicant's efforts to register its mark in Class 25. As a consequence, Applicant filed a petition to cancel Registration No. 236,950 and as a result this matter was stayed pending the outcome of that petition to cancel.

3. The petition to cancel has since been withdrawn and as such it is requested that this matter be placed on active status and that the application be published for opposition.^{2/}

REGISTRATION NO. 236,950 DOES NOT CREATE A LIKELIHOOD OF CONFUSION.

Applicant will not repeat its arguments put forth in its original Response to Office Action filed on March 4, 1997. Concerning Registration No. 236,950 for SHADOW, a mark which the Examiner cited as a block, the owner of said mark, has agreed that there is no likelihood of confusion as between Applicant's proposed registration and the other registration. As such, there is no

^{1/} Attached hereto as Exhibit "A" is a true and accurate copy of Applicant's Response to Office Action filed on March 7, 1997.

^{2/} Attached hereto as Exhibit "B" is a true and accurate copy of "Petitioner's Notice of Withdrawal Petition to Cancel Without Prejudice."

likelihood of confusion as to Applicant's proposed mark and
Registration No. 236,950.

CONCLUSION

For the aforementioned reasons, Applicant contends that the
application is in condition to be published for opposition and
requests that the examiner so publish the mark.

Dated: June 27, 2000

Respectfully submitted,

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

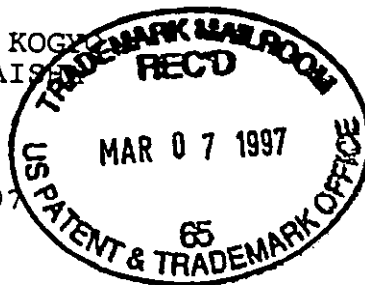
By: 

Daniel C. DeCarlo

Daniel C. DeCarlo, Esq.
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP
221 N. Figueroa Street, Suite 1200
Los Angeles, CA 90012 Telephone: (213) 250-1800

Please acknowledge receipt of our RESPONSE TO OFFICE ACTION by affixing hereon the Patent and Trademark Office date stamp and return this card to our office. In re application of:

Applicant: HONDA GIKEN KOGYO
KABUSHIKI KAISHA
Mark: SHADOW
S/N: 75/082469
File No.: 21929-112
Mailed: March 4, 1997



HON018557

21929-12

I hereby certify that this correspondence is being deposited with the United States Postal Service "First Class Mail" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: David M. Makous, Reg. 29,559

Date Mailed: 3/4/97

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	HONDA GIKEN KOGYO)	Examining Attorney:
	KABUSHIKI KAISHA)	Jacqueline A. Lavine
)	
)	Law Office 109
Mark:	SHADOW)	
)	
)	
Serial No.:	75/082469)	
)	

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

RESPONSE TO OFFICE ACTION

Applicant has received and reviewed the Office Action dated September 10, 1996, and hereby responds thereto.

AMENDMENT

Please amend the application as follows:

1. Please delete classes 14, 18 and 26 per the Request to Divide Application.

2. Please change the designation of goods in Class 16 to read in full:

"Printed matter in the nature of publications to be distributed to purchasers of Honda motorcycles."

3. Please change the designation of goods in Class 25 to read in full:

"Clothing, namely shirts, sweatshirts, sweaters, jackets, vests, pants, bandannas, belts, hats, gloves, footwear, sold through authorized Honda motorcycle dealers."

4. Please change the designation of goods in Class 28 to read in full:

"Metallic and plastic replicas of the SHADOW motorcycle sold by Honda and accessories therefor."

REMARKS

The Examining Attorney has refused registration because Applicant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 1,043,492; 1,645,004; 236,950; 1,624,940; 1,604,839; 1,348,246; 1,720,106; and 1,780,427 as to be likely to cause confusion, or to cause mistake, or to deceive.

A. Class 25: The owner of cited reference mark No. 1,624,940 has abandoned its registration

The § 8 affidavit was due for Reg. No. 1,624,940, on November 27, 1996. As of March 3, 1997, the Patent and Trademark Office advised us that it has not received any such affidavit and the registration will soon be declared abandoned. (see attached Declaration of Laura B. Kaliser).

B. Class 25: The owner of cited reference mark No. 236,950 has abandoned its registration

Upon Applicant's information and belief, cited mark No. 236,950 is no longer in use by the owner (see attached Declaration of Laura B. Kaliser). Applicant is therefore filing a Petition for Cancellation of this mark along with this Response to Office Action.

C. Class 16: Applicant's mark is not confusingly similar to the cited reference mark Nos. 1,645,004 and 1,043,492

Applicant's mark SHADOW is not likely to be confused with the mark THE SHADOW, Reg. No. 1,645,004 for "posters, lithographs, comic books, and graphic novels" and Reg. No. 1,043,492 for "novels in paperback form".

When the goods of a cited mark are "not identical or competitive, and are not related or marketed in such a way that they would be encountered by the same people in situations that could create the incorrect assumption that all goods come from

the same source . . . even where the marks are identical, confusion is not likely." TMEP §1207.01 (citing In re Unilever Ltd., 222 USPQ 981, 983 (T.T.A.B. 1984)).

Applicant's goods consist of publications to be distributed only to purchasers of Honda motorcycles through direct mail or through authorized Honda dealerships. This is a narrow and specialized trade channel greatly differing from traditional newsstands and magazine racks. There is no likelihood of confusion.

D. Class 28: Applicant's goods are unrelated to the goods identified in the cited marks in this extremely crowded class and therefore not likely to cause confusion.

The Examining Attorney has cited the following marks as being confusingly similar to Applicant's mark:

1. SHADOW - for "baseball gloves", Reg. No. 1,780,427
2. SHADOW - for "snow skiing device having a single runner and a seat intended for use by paraplegics, a water skiing device having a single ski and a seat intended for use by paraplegics, and stationary trainers for wheelchairs" Reg. No. 1,720,106
3. SHADOW - for "children's ride-on bouncing horse toys", Reg. No. 1,604,839

4. SHADOW - for "golf clubs and golf club shafts",

Reg. No. 1,348,246

The above marks are totally unrelated to Applicant's mark, SHADOW, for replicas of Honda's SHADOW motorcycle. As the above identical marks have been allowed in the same class, the consuming public is understood to be able to differentiate these many unrelated products. Therefore, on the basis of the dissimilarity of the goods, there is no likelihood of confusion.

Accordingly, Applicant requests that the § 2(d) objection be withdrawn, and the mark be published for opposition.

Respectfully submitted,

LEWIS, D'AMATO, BRISBOIS & BISGAARD

by 

David N. Makous

LEWIS, D'AMATO, BRISBOIS & BISGAARD
221 North Figueroa Street, Suite 1200
Los Angeles, California 90012
Telephone No. (213) 250-1800
Facsimile No. (213) 250-7900

21929-112

Please acknowledge receipt of our PETITIONER'S NOTICE
OF WITHDRAWAL OF PETITION TO CANCEL WITHOUT PREJUDICE
by affixing hereon the Patent and Trademark Office
date stamp and return this card to our office.

Mark: SHADOW
Registration No.: 236,950
Petitioner: American Honda Motor Co., Inc.
Cancellation No.: 26-171
Our File No.: 21929-112
Mailed: May 10, 2000



05-16-2000

U.S. Patent & TMO/TM Mail Rpt Dt #26

not a stamp

HON018563

21929-112

I hereby certify that this correspondence is being deposited with the United States Postal Service "First Class Mail" service under 37 CFR § 1.8 on the dated indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, 2900 Crystal Drive, Arlington VA 22202-3513

by: Daniel C. DeCarlo

Date Mailed: May 10, 2000

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

AMERICAN HONDA MOTOR CO.,)	Cancellation No. 26-171
INC.)	
)	Trademark: SHADOW
Petitioner,)	Registration No. 236,950
)	
vs.)	
)	
WARNACO, INC.,)	Our File No.: 21929-112
)	
Registrant.)	
<hr/>		

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

PETITIONER'S NOTICE OF WITHDRAWAL OF PETITION TO

CANCEL WITHOUT PREJUDICE

Petitioner American Honda Motor Co., Inc., filed a Petition for Cancellation of the mark SHADOW, Registration No. 236,950. Pursuant

to 37 C.F.R. § 2.114(c), Petitioner hereby withdraws its Petition to
Cancel without prejudice.

Dated: May 8, 2000

Respectfully submitted,

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

By: 

Daniel C. DeCarlo

Daniel C. DeCarlo, Esq.
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP
221 N. Figueroa Street, Suite 1200
Los Angeles, CA 90012
(213) 250-1800

PROOF OF SERVICE

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

I am employed in the County of Los Angeles, State of California. I am over the age of 18 and not a party to the within action. My business address is 221 North Figueroa Street, Suite 1200, Los Angeles, California 90012.

On May 10, 2000, I served the foregoing document described as PETITIONER'S NOTICE OF WITHDRAWAL OF PETITION TO CANCEL WITHOUT PREJUDICE on all interested parties in this action by placing ☒ a true copy ☐ the original thereof enclosed in sealed envelopes addressed as follows:

Beth Kotran, Esq.
Amster, Rothstein & Ebenstein
90 Park Avenue
New York, New York 10016

☒ (BY MAIL, 1013a, 2015.5 C.C.P.)

☒ I deposited such envelope in the mail at Los Angeles, California. The envelope was mailed with postage thereon fully prepaid.

☒ (STATE) I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed on May 10, 2000, at Los Angeles, California.


Julie Contreras

EXHIBIT A

CONSENT AGREEMENT

This agreement is entered into by and between Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.) (hereinafter "Honda"), a Japanese corporation with its principal offices at 2-1 Minami-Aoyama, Minato-Ku, Tokyo 107, Japan; Warnaco, Inc. a Delaware corporation with its principal offices at 90 Park Avenue, New York, New York 10016; and Warnaco U.S., Inc., a Delaware corporation with its principal offices at 470 Wheelers Farms Road, Milford, Connecticut 06460 (collectively or individually, "Warnaco").

A. Warnaco is the owner of the mark SHADOW (United States Registration No. 236,950 issued on December 27, 1927) for "corsets, girdles, brasiers, combination corset-bandeaux and combination girdle bandeaux."

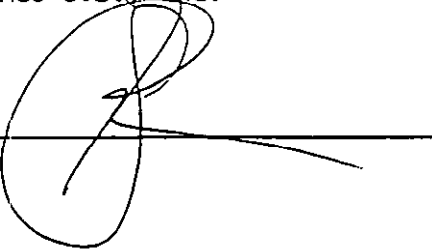
B. Honda is the applicant for the United States Trademark Application, Serial No. 75/082,469 filed April 2, 1996 for the trademark SHADOW for "jewelry" in Class 14; "printed matter in the nature of publications to be distributed to purchasers of Honda motorcycles" in Class 16; "leather goods" in Class 18; "clothing, namely shirts, sweatshirts, sweaters, jackets, vests, pants, bandannas, belts, hats, gloves, footwear, sold through Honda motorcycle dealers" in Class 25; "metallic and plastic replicas of the SHADOW motorcycle sold by Honda and accessories therefore" in Class 28.

C. After careful consideration, investigation and discussion, the parties agree that there is no likelihood of confusion between Honda's proposed usage and registration

of SHADOW as described in "B" above with the goods described in Warnaco's trademark registration (No. 236,950), identified in "A" above.

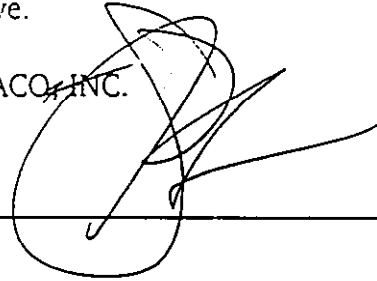
WARNACO U.S. INC.

By
Its:



WARNACO, INC.

By
Its:



HONDA, GIKEN, KOGYO, KABUSHIKI, KAISHA
(HONDA MOTOR COMPANY, LTD.)

By
Its:



cc:

Laura Cuddy, Esq.
Honda North America, Inc.
700 Van Ness Avenue
Building 300-2-ID
Torrance, CA 90501

Please acknowledge receipt of our Response to Office Action by affixing hereon the Patent and Trademark Office date stamp and return this card to our office. In re application of:

Mark: SHADOW

Applicant: Honda Giken Kogyo Kabushiki Kaisha

S/N: 75/082469

Classes: 16, 25, 28

Our File No.: 21929-112

Mailed: June 27, 2000

99LA-48290.1

HON018570

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

2124-112

SERIAL NO.

APPLICANT

75/082469 HONDA GIKEN KOGYO KABUSHIKI KAISHA

MARK

SHADOW

ADDRESS

DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD LLP
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

ACTION NO.

02

MAILING DATE

06/13/97

REF. NO.

12/10/97

PAPER NO.

Assistant Commissioner
for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

Please provide in all correspondence:

1. Filing Date, serial number, mark and Applicant's name.
2. Mailing date of this action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and ZIP code.

FORM PTO-1525 (5-90)

U.S. DEPT. OF COMM. PAT. & TM OFFICE

RE: Serial Number: 75/082469

☐ The examining attorney has searched the Office records and has found no similar registered mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01.

☒ 1. Action on this application is suspended pending the disposition of:

☒ Cancellation No(s) for Reg. No. 236,950

☐ Opposition No(s) _____

☐ Civil Action No(s) _____

☐ Concurrent Use No(s) _____

If the applicant is a party to the above proceeding, the applicant should advise the Examining Attorney of the outcome of the proceeding when it is terminated.

☐ Application Serial No(s) _____

Since applicant's effective filing date is subsequent to the effective filing date of the above-identified application(s), the latter, if and when it registers, may be cited against this application. See 37 C.F.R. §2.83. A copy of information relevant to this pending application(s) ☐ is attached ☐ was sent previously.

The applicant may request that the application be removed from suspension by presenting arguments related to the potential conflict between the relevant applications or other arguments related the ground for suspension. The applicant's election to present or not to present arguments at this time will not affect the applicant's right to present arguments later.

☐ 2. Action on this application is suspended pending receipt of a certification or certified copy of the registration in the country of origin of applicant. If the registration is in a foreign language, an English translation must be submitted. The certification or certified copy of the registration should be forwarded to the Examining Attorney as soon as possible. If the foreign application is abandoned, the Examining Attorney should be advised.

☐ 3. It is noted that an assignment involving this application is presently pending before the Office. Action is suspended on this application pending recordation of the assignment. This application will be removed from suspended status upon recordation of the assignment. Notification of recordation is normally done through Office channels. However, upon receipt of the reel and frame number of the assignment, applicant should advise the Examining Attorney. See 37 C.F.R. Part 3.

☐ 4. Action on this application is suspended for months until the Examining Attorney can determine whether the cited registration will be canceled under §8 or expire under §9. 37 C.F.R. 2.67.

☐ 5. The following refusals/requirements are continued:

Jacqueline A. Lavine

EXAMINING ATTORNEY NAME

Jacqueline A. Lavine
EXAMINING ATTORNEY SIGNATURE

109

LAW OFFICE

(703) 308-9109

PHONE

HON018571

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

SERIAL NO. 75/082469 HONDA GIKEN KOGYO KABUSHIKI KAISHA		PAPER NO. 21929-112
MARK SHADOW		ADDRESS: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 If no fees are enclosed, the address should include the word "Box Responses - No Fee." Please provide in all correspondence: 1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.
ADDRESS David N. Makous LEWIS, D'AMATO, BRISBOIS & BISGAARD, LLP 221 N. Figueroa Street, Suite 1200 Los Angeles, CA 90012	ACTION NO. 01	
	MAILING DATE 09/10/96	
REF. NO.		
FORM PTO-1525 (5-90) U.S. DEPT. OF COMM. PAT. & TM OFFICE		

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 75/082469

The assigned examining attorney has reviewed the referenced application and determined the following.

Prior Registrations

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 1,043,492; 1,645,004; 0236,950; 1,624,940; 1,604,839; 1,348,246; 1,720,106 and 1,780,427 as to be likely to cause confusion, or to cause mistake, or to deceive. TMEP section 1207. See the enclosed registrations.

Registration Nos. 1,043,492 and 1,645,004 are cited against the goods in Class 16.

→ Registration Nos. 0236,950; 1,624,940 are cited against Class 25.

Registration Nos. 1,604,839; 1,348,246; 1,720,106 and 1,780,427 are cited against Class 28.

There are to be no confusingly similar marks for Classes 14, 18 and 26.

HON018572

Prior Pending Applications

The examining attorney encloses information regarding pending Application Serial Nos. 75/083,260 and 75/083261. The filing dates of the referenced applications precede the applicant's filing date. There may be a likelihood of confusion between the applicant's mark and the referenced marks under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). If one or more of the referenced applications matures into a registration, the examining attorney may refuse registration in this case under Section 2(d). 37 C.F.R. Section 2.83; TMEP section 1208.01. This applies to the Class 25 goods only.

Possible Responses

The applicant may respond to the stated refusals by doing one of the following:

- (1) amending the application to delete the class to which the refusal pertains;
- (2) traversing the refusal of the combined application as a whole; or
- (3) filing a request to divide the application, so that the mark may be published for opposition in the class to which the refusal does not pertain (37 C.F.R. Section 2.87; TMEP sections 1105.06 and 1113.03).

Please note, however, that failure to respond to a refusal which pertains to fewer than all classes in an application will result in abandonment of the combined application in its entirety.

Informalities

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

Additional Fees required

The application identifies goods that may be classified in several international classes. Effective December 3, 1993, the filing fee is \$245.00 for each class. 37 C.F.R. Section 2.6(a)(1). Therefore, the applicant must either: (1) restrict the application to the number of classes covered by the fee already paid, or (2) pay the required fee for each additional class. 37 C.F.R. Section 2.86(b); TMEP sections 810.01 and 1113.01.

Identification of goods indefinite

The identification of goods is indefinite and requires amendment. Jewelry in Class 14 is acceptable. However, in all the other classes, applicant must specifically list each item using the common commercial name.

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. Section 2.71(b); TMEP section 804.09.

Therefore, the applicant may not amend to include any goods or services that are not within the scope of the goods and services recited in the present identification.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

Jacqueline A. Lavine

Jacqueline A. Lavine
Senior Attorney, Law Office 109
(703) 308-9109 Ext. 145
(703) 308-7194 FAX

NOTE: The Trademark Office is committed to improving the quality of our service. The Assistant Commissioner for Trademarks would like to have your comments and suggestions on ways we can improve the quality of the examination process. In the event there are any areas causing you recurrent problems, please let us know of them.

COMMENTS SHOULD NOT BE INCLUDED WITH THE RESPONSE TO AN OFFICE ACTION, BUT SHOULD BE SENT IN A SEPARATE COMMUNICATION TO THE FOLLOWING ADDRESS:

Office of Trademark Quality Review
c/o Commissioner of Patents and Trademarks
Washington, DC 20231.

Please note that this address differs from the mailing address for the response to this Office action.

*** User: EX817099 *** S 1 Number: 75083261 ***

Word Mark
SHADOW

Goods/Services
IC 025; US 022 039; G & S: footwear, namely snowboard boots

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75-083261

Filing Date
1996.04.03

Owner Name/Address
(APPLICANT) WILLIAM H. KAUFMAN INC. CORPORATION CANADA 410 King Street
West Kitchener, Ontario CANADA N2G 4J8

Section 44
SECT 44

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON018575

*** Search: S *** Document Number: 8 ***

*** User: EX817099 *** S 1 Number: 75083260 ***

Word Mark
SHADOW-BIO

Goods/Services
IC 025; US 022 039; G & S: footwear, namely snowboard boots

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75-083260

Filing Date
1996.04.03

Owner Name/Address
(APPLICANT) WILLIAM H. KAUFMAN INC. CORPORATION CANADA 410 King Street
West Kitchener, Ontario CANADA N2G 4J8

Section 44
SECT 44

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON018576

*** User: EX817099 *** Serial Number: 73687586 ***

Word Mark
SHADOWS

Goods/Services
IC 025; US 039; G & S: MEN'S AND LADIES' TEE-SHIRTS; LADIES' TANK TOPS,
SLACKS AND SHORTS, CARDIGANS, HATS; FIRST USE DATE: 1984.01.18; FIRST USE
IN COMMERCE: 1984.01.18

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-687586

Filing Date
1987.10.02

Registration Number
1624940

Registration Date
1990.11.27

Owner Name/Address
(REGISTRANT) IKEDA, SHAYNE INDIVIDUAL UNITED STATES 743-C WAIAKAMILO ROAD
HONOLULU HAWAII 96817

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON018577

*** Search: 5 *** Document Number: 164 ***

*** User: EX817099 *** S 1 Number: 71251252 ***

Word Mark
SHADOW

Goods/Services
IC 025; US 039; G & S: CORSETS, GIRDLES, BRASSIERES [, BANDEAUX,
COMBINATION CORSET-BRASSIERES, COMBINATION GIRDLE-BRASSIERES, COMBINATION
CORSET-BANDEAUX, AND COMBINATION GIRDLE-BANDEAUX]; FIRST USE DATE:
1926.11.01; FIRST USE IN COMMERCE: 1926.11.01

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
71-251252

Filing Date
1927.06.28

Change in Registration
CHANGE IN REGISTRATION HAS OCCURED

Registration Number
0236950

Registration Date
1927.12.27

Owner Name/Address
(REGISTRANT) WARNER BROTHERS COMPANY, THE CORPORATION CONNECTICUT 347
MADISON AVE. NEW YORK NEW YORK

Owner Name/Address
(LAST LISTED OWNER) WARNACO INC. CORPORATION BY CHANGE OF NAME FROM
DELAWARE 90 PARK AVENUE NEW YORK NEW YORK 10016 1300

Type of Mark
TRADEMARK

Register
PRINCIPAL

Renewal
3RD RENEWAL 1987.12.27

*** User: EX817099 *** S 1 Number: 73827363 ***

Word Mark

THE SHADOW

Goods/Services

IC 016; US 038; G & S: POSTERS, LITHOGRAPHS, COMIC BOOKS, AND GRAPHIC NOVELS; FIRST USE DATE: 1940.03.00; FIRST USE IN COMMERCE: 1940.03.00

Goods/Services

IC 009; US 036; G & S: PRERECORDED AUDIO CASSETTE TAPES AND PHONOGRAPH RECORDS FEATURING STORIES FROM RADIO PROGRAMS; FIRST USE DATE: 1972.00.00; FIRST USE IN COMMERCE: 1972.00.00

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

73-827363

Filing Date

1989.09.25

Registration Number

1645004

Registration Date

1991.05.21

Owner Name/Address

(REGISTRANT) ADVANCE MAGAZINE PUBLISHERS INC. CORPORATION NEW YORK 350 MADISON AVENUE NEW YORK NEW YORK 10017

Type of Mark

TRADEMARK

Register

PRINCIPAL

HON018579

*** User: EX817099 *** Serial Number: 73038765 ***

Word Mark
THE SHADOW

Goods/Services
IC 016; US 038; G & S: NOVELS IN PAPERBACK FORM; FIRST USE: 1963.09.00;
FIRST USE IN COMMERCE: 1963.09.00

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-038765

Filing Date
1974.12.05

Registration Number
1043492

Registration Date
1976.07.13

Owner Name/Address
(REGISTRANT) CONDE NAST PUBLICATIONS INC., THE CORPORATION NEW YORK 350
MADISON AVE. NEW YORK NEW YORK 10017

Owner Name/Address
(LAST LISTED OWNER) ADVANCE MAGAZINE PUBLISHERS INC. CORPORATION NEW YORK
350 MADISON AVENUE NEW YORK NEW YORK 10017

Prior US Registration
0534805

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit
SECT 8.; SECT 15.; COMBINED SECT 8 AND SECT 15.

Renewal
1ST RENEWAL 1996.05.16

*** User: EX817099 *** S 1 Number: 74323342 ***

SHADOW

Word Mark
SHADOW

Goods/Services
IC 028; US 022; G & S: baseball gloves; FIRST USE DATE: 1992.07.00; FIRST
USE IN COMMERCE: 1992.07.00

Mark Drawing Code
(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number
74-323342

Filing Date
1992.10.19

Registration Number
1780427

Registration Date
1993.07.06

Owner Name/Address
(REGISTRANT) GLOVESMITH, Inc. CORPORATION MISSOURI 20 Village Plaza Arnold
MISSOURI 63010

Type of Mark
TRADEMARK

Register
PRINCIPAL

*** User: EX817099 *** Serial Number: 74141861 ***

Word Mark
SHADOW

Goods/Services
IC 012; US 019; G & S: wheelchairs, racing wheelchairs, and sports wheelchairs; FIRST USE DATE: 1981.02.19; FIRST USE IN COMMERCE: 1981.04.25

Goods/Services
IC 028; US 022; G & S: snow skiing device having a single runner and a seat intended for use by paraplegics, a water skiing device having a single ski and a seat intended for use by paraplegics, and stationary trainers for wheelchairs; FIRST USE DATE: 1988.01.21; FIRST USE IN COMMERCE: 1988.01.21

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
74-141861

Filing Date
1991.02.25

Registration Number
1720106

Registration Date
1992.09.29

Owner Name/Address
(REGISTRANT) Magic In Motion, Inc. CORPORATION WASHINGTON 20604 - 84th Avenue So. Kent WASHINGTON 98032

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON018582

*** User: EX817099 *** Serial Number: 74003218 ***

Word Mark
SHADOW

Goods/Services
IC 028; US 022; G & S: CHILDREN'S RIDE-ON BOUNCING HORSE TOYS; FIRST USE:
1989.08.22; FIRST USE IN COMMERCE: 1989.08.22

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
74-003218

Filing Date
1989.11.16

Registration Number
1604839

Registration Date
1990.07.03

Owner Name/Address
(REGISTRANT) HEDSTROM CORP. CORPORATION ILLINOIS P.O. BOX 432 BEDFORD
PENNSYLVANIA 15522

Owner Name/Address
(LAST LISTED OWNER) HEDSTROM CORPORATION CORPORATION DELAWARE SUNNEYSIDE
ROAD, BOX 432 BEDFORD PENNSYLVANIA 15522

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit
SECT 8.; SECT 15.; COMBINED SECT 8 AND SECT 15.

HON018583

*** Search: 16 *** Document Number: 38 ***

*** User: EX817099 *** Serial Number: 73504102 ***

Word Mark
SHADOW

Goods/Services
IC 028; US 022; G & S: GOLF CLUBS AND GOLF CLUB SHAFTS; FIRST USE DATE:
1983.09.20; FIRST USE IN COMMERCE: 1983.09.20

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-504102

Filing Date
1984.10.16

Registration Number
1348246

Registration Date
1985.07.09

Owner Name/Address
(REGISTRANT) TI ACCLES AND POLLOCK LIMITED COMPANY UNITED KINGDOM PADDOCK
WORKS OLDBURY, WARLEY, WEST MIDLANDS ENGLAND

Owner Name/Address
(LAST LISTED OWNER) TI APOLLO LIMITED COMPANY ASSIGNEE OF UNITED KINGDOM

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit
SECT 8.; SECT 15.; COMBINED SECT 8 AND SECT 15.

21929-112
770

UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513

TO: David N. Makous
Lewis D'Amato Brisbois & Bisgaard LLP
221 N. Figueroa St. Ste. 1200
Los Angeles, CA 90012

DATE: June 6, 1997

FROM: Catherine Crush, Legal Assistant
Intent to Use/Divisional Unit

SUBJECT: Divisional Applications

APPLICANT: Honda Giken Kogyo Kabushiki Kaisha

MARK: SHADOW

This letter is to confirm that the divisional request filed on March 7, 1997 has been completed.

The goods and/or services in International Class(es) 14, 18, 26 have been placed in the newly created (child serial number 75/976234) application. The goods and/or services that are in International class (es) 16,25,28 remain in the original (parent serial number 74/082469) application.

If you have any other questions or concerns, please feel free to call ITU at (703) 308-9500 ext. 144.

HON018585

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

24124-112

SERIAL NO. 75/082469 APPLICANT HONDA GIKEN KOGYO KABUSHIKI KAISHA

MARK
SHADOW

ADDRESS
DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD LLP
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

ACTION NO.
02

MAILING DATE
06/13/97

REF. NO.
12/10/97

PAPER NO.

Assistant Commissioner
for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

Please provide in all correspondence:

1. Filing Date, serial number, mark and Applicant's name.
2. Mailing date of this action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and ZIP code.

FORM PTO-1525 (5-90)

U.S. DEPT. OF COMM. PAT. & TM OFFICE

RE: Serial Number: 75/082469

☐ The examining attorney has searched the Office records and has found no similar registered mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01.

☒ 1. Action on this application is suspended pending the disposition of:

☒ Cancellation No(s) for Reg. No. 236,950

☐ Opposition No(s).

☐ Civil Action No(s).

☐ Concurrent Use No(s).

If the applicant is a party to the above proceeding, the applicant should advise the Examining Attorney of the outcome of the proceeding when it is terminated.

☐ Application Serial No(s).

Since applicant's effective filing date is subsequent to the effective filing date of the above-identified application(s), the latter, if and when it registers, may be cited against this application. See 37 C.F.R. §2.83. A copy of information relevant to this pending application(s) ☐ is attached ☐ was sent previously.

The applicant may request that the application be removed from suspension by presenting arguments related to the potential conflict between the relevant applications or other arguments related the ground for suspension. The applicant's election to present or not to present arguments at this time will not affect the applicant's right to present arguments later.

☐ 2. Action on this application is suspended pending receipt of a certification or certified copy of the registration in the country of origin of applicant. If the registration is in a foreign language, an English translation must be submitted. The certification or certified copy of the registration should be forwarded to the Examining Attorney as soon as possible. If the foreign application is abandoned, the Examining Attorney should be advised.

☐ 3. It is noted that an assignment involving this application is presently pending before the Office. Action is suspended on this application pending recordation of the assignment. This application will be removed from suspended status upon recordation of the assignment. Notification of recordation is normally done through Office channels. However, upon receipt of the reel and frame number of the assignment, applicant should advise the Examining Attorney. See 37 C.F.R. Part 3.

☐ 4. Action on this application is suspended for months until the Examining Attorney can determine whether the cited registration will be canceled under §8 or expire under §9. 37 C.F.R. 2.67.

☐ 5. The following refusals/requirements are continued:

Jacqueline A. Lavine
EXAMINING ATTORNEY NAME

109
LAW OFFICE

(703) 308-9109
PHONE

Jacqueline A. Lavine
EXAMINING ATTORNEY SIGNATURE

HON018586



U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office



SERIAL NO. 75/082469 APPLICANT HONDA GIKEN KOGYO KABUSHIKI KAISHA

MARK
SHADOW

ADDRESS
DAVID N MAKOUS
LEWIS D'AMATO BRISBOIS & BISGAARD LLP
221 N FIGUEROA ST STE 1200
LOS ANGELES CA 90012

ACTION NO.
02

MAILING DATE
04/15/97

REF. NO.

PAPER NO. 21929-112

ADDRESS
Assistant Commissioner of Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
If no fees are enclosed, the address
should include the words "Box 5."

Please provide in all correspondence:

1. Filing date, serial number, mark, and applicant's name.
2. Mailing date of this Office action.
3. Your telephone number and ZIP code.

nining attorney's name and law office
ber.

is suspended pending receipt of a
f the registration in the country of
reg ation is in a foreign language, an

English translation must be submitted. The certification or
certified copy of the registration should be forwarded to the
Examining Attorney as soon as possible. If the foreign application
is abandoned, the Examining Attorney should be advised.

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presently pending before the Office. Action is suspended on this
application pending recordation of the assignment. This applica-
tion will be removed from suspended status upon recordation of
the assignment. Notification of recordation is normally done
through Office channels. However, upon receipt of the reel and
frame number of the assignment, applicant should advise the
Examining Attorney. See 37 C.F.R. Part 3.

☐ 4. Action on this application is suspended for _____ months
until the Examining Attorney can determine whether the cited
registration will be cancelled under §8 or expire under §9. 37
C.F.R. 2.67

☒ 5. The following refusals/requirements are continued:
Reg. No 1,624,940 will not be cancelled
Until May of 1997, if no §8 is found.

HON018587

Since applicant's effective filing date is subsequent to the effective filing date of the above-identified application(s), the latter, if and when it registers, may be cited against this application. See 37 C.F.R. §2.83. A copy of information relevant to this pending application(s) ☐ is attached ☐ was sent previously.

The applicant may request that the application be removed from suspension by presenting arguments related to the potential conflict between the relevant applications or other arguments related the ground for suspension. The applicant's election to present or not to present arguments at this time will not affect the applicant's right to present arguments later.

Jacqueline A Lavine
EXAMINING ATTORNEY SIGNATURE

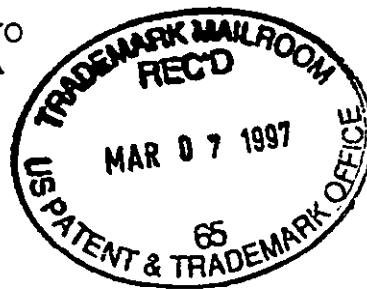
109
LAW OFFICE

(703) 308-9109 EXL 145
PHONE

JACQUELINE A. LAVINE
EXAMINING ATTORNEY NAME

Please acknowledge receipt of our REQUEST TO
DIVIDE APPLICATION by affixing hereon the
Patent and Trademark Office date stamp and
return this card to our office. In re
application of:

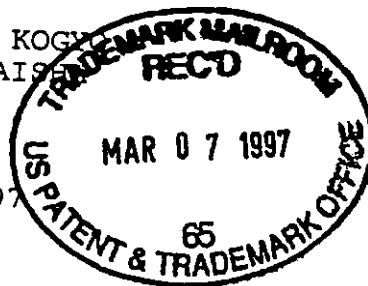
Applicant: HONDA GIKEN KOGYO
KABUSHIKI KAISHA
Mark: SHADOW
S/N: 75/082469
File No.: 21929-112
Mailed: March 4, 1997



HON018588

Please acknowledge receipt of our **RESPONSE TO OFFICE ACTION** by affixing hereon the Patent and Trademark Office date stamp and return this card to our office. In re application of:

Applicant: HONDA GIKEN KOGYO
KABUSHIKI KAISEI
Mark: SHADOW
S/N: 75/082469
File No.: 21929-112
Mailed: March 4, 1997



HON018589

21929-12

I hereby certify that this correspondence is being deposited with the United States Postal Service "First Class Mail" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: David M. Makous, Reg. 29,559
Date Mailed: 3/4/97

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	HONDA GIKEN KOGYO)	Examining Attorney:
	KABUSHIKI KAISHA)	Jacqueline A. Lavine
)	
)	Law Office 109
Mark:	SHADOW)	
)	
)	
Serial No.:	75/082469)	
)	

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

RESPONSE TO OFFICE ACTION

Applicant has received and reviewed the Office Action dated September 10, 1996, and hereby responds thereto.

AMENDMENT

Please amend the application as follows:

1. Please delete classes 14, 18 and 26 per the Request to Divide Application.

2. Please change the designation of goods in Class 16 to read in full:

"Printed matter in the nature of publications to be distributed to purchasers of Honda motorcycles."

3. Please change the designation of goods in Class 25 to read in full:

"Clothing, namely shirts, sweatshirts, sweaters, jackets, vests, pants, bandannas, belts, hats, gloves, footwear, sold through authorized Honda motorcycle dealers."

4. Please change the designation of goods in Class 28 to read in full:

"Metallic and plastic replicas of the SHADOW motorcycle sold by Honda and accessories therefor."

REMARKS

The Examining Attorney has refused registration because Applicant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 1,043,492; 1,645,004; 236,950; 1,624,940; 1,604,839; 1,348,246; 1,720,106; and 1,780,427 as to be likely to cause confusion, or to cause mistake, or to deceive.

A. Class 25: The owner of cited reference mark No. 1,624,940 has abandoned its registration

The § 8 affidavit was due for Reg. No. 1,624,940, on November 27, 1996. As of March 3, 1997, the Patent and Trademark Office advised us that it has not received any such affidavit and the registration will soon be declared abandoned. (see attached Declaration of Laura B. Kaliser).

B. Class 25: The owner of cited reference mark No. 236,950 has abandoned its registration

Upon Applicant's information and belief, cited mark No. 236,950 is no longer in use by the owner (see attached Declaration of Laura B. Kaliser). Applicant is therefore filing a Petition for Cancellation of this mark along with this Response to Office Action.

C. Class 16: Applicant's mark is not confusingly similar to the cited reference mark Nos. 1,645,004 and 1,043,492

Applicant's mark SHADOW is not likely to be confused with the mark THE SHADOW, Reg. No. 1,645,004 for "posters, lithographs, comic books, and graphic novels" and Reg. No. 1,043,492 for "novels in paperback form".

When the goods of a cited mark are "not identical or competitive, and are not related or marketed in such a way that they would be encountered by the same people in situations that could create the incorrect assumption that all goods come from

the same source . . . even where the marks are identical, confusion is not likely." TMEP §1207.01 (citing In re Unilever Ltd., 222 USPQ 981, 983 (T.T.A.B. 1984)).

Applicant's goods consist of publications to be distributed only to purchasers of Honda motorcycles through direct mail or through authorized Honda dealerships. This is a narrow and specialized trade channel greatly differing from traditional newsstands and magazine racks. There is no likelihood of confusion.

D. Class 28: Applicant's goods are unrelated to the goods identified in the cited marks in this extremely crowded class and therefore not likely to cause confusion.

The Examining Attorney has cited the following marks as being confusingly similar to Applicant's mark:

1. SHADOW - for "baseball gloves", Reg. No. 1,780,427
2. SHADOW - for "snow skiing device having a single runner and a seat intended for use by paraplegics, a water skiing device having a single ski and a seat intended for use by paraplegics, and stationary trainers for wheelchairs" Reg. No. 1,720,106
3. SHADOW - for "children's ride-on bouncing horse toys", Reg. No. 1,604,839

4. SHADOW - for "golf clubs and golf club shafts",
Reg. No. 1,348,246

The above marks are totally unrelated to Applicant's mark, SHADOW, for replicas of Honda's SHADOW motorcycle. As the above identical marks have been allowed in the same class, the consuming public is understood to be able to differentiate these many unrelated products. Therefore, on the basis of the dissimilarity of the goods, there is no likelihood of confusion.

Accordingly, Applicant requests that the § 2(d) objection be withdrawn, and the mark be published for opposition.

Respectfully submitted,

LEWIS, D'AMATO, BRISBOIS & BISGAARD

by 

David N. Makous

LEWIS, D'AMATO, BRISBOIS & BISGAARD
221 North Figueroa Street, Suite 1200.
Los Angeles, California 90012
Telephone No. (213) 250-1800
Facsimile No. (213) 250-7900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	HONDA GIKEN KOGYO)	Examining Attorney:
	KABUSHIKI KAISHA)	Jacqueline A.
)	Levine
Mark:	SHADOW)	
)	Law Office 109
Serial No.:	75/082469)	
)	
)	

DECLARATION OF LAURA B. KALISER IN SUPPORT
OF APPLICANT'S RESPONSE TO OFFICE ACTION

I, Laura B. Kaliser declare as follows:

1. I am an attorney licensed to practice in the State of California, representing Applicant in this matter.

2. On March 3, 1997, I telephoned the Patent and Trademark Office Trademark Assistance Center and asked them if a § 8 affidavit (due November 11, 1996) had been filed for Reg. No. 1,624,940. The unidentified man responding to my request stated "no affidavit had been filed" and that the registration would most likely be declared abandoned.

3. On March 3, 1997, I telephoned the corporate offices of Warnaco Inc. and inquired as to whether the Trademark SHADOW was still in use by Warnaco (Reg. No. 236,950). The unidentified woman in the customer service department informed me that this mark was no longer in use.

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or

imprisonment, or both, under 18 U.S.C. 1001, declares that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Date: March____, 1997

By: _____
Laura B. Kaliser
Attorney for Applicant

Please acknowledge receipt of our **RESPONSE TO**
OFFICE ACTION by affixing hereon the Patent
and Trademark Office date stamp and return
this card to our office. In re application
of:

Applicant: HONDA GIKEN KOGYO
KABUSHIKI KAISHA

Mark: SHADOW

S/N: 75/082469

File No.: 21929-112

Mailed: March 4, 1997

HON018597

21029-1

By: David N. Makous, Reg. 29,559
Date Mailed: 3/4/97

Date Mailed: 3/4/93

Applicant:	HONDA GIKEN KOGYO)	Examining Attorney:
	KABUSHIKI KAISHA)	Jacqueline A. Lavine
)	
)	Law Office 109
Mark:	SHADOW)	
)	
)	
Serial No.:	75/082469)	
)	

REQUEST TO DIVIDE APPLICATION

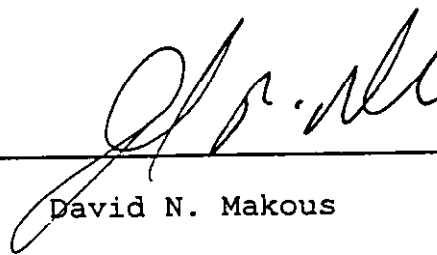
Please divide out Classes 14, 18 and 26 into one application and publish for opposition.

Enclosed is the \$100.00 fee for one application.

Respectfully submitted,

LEWIS, D'AMATO, BRISBOIS & BISGAARD

by

A handwritten signature in dark ink, appearing to read "D. N. Makous", is written over a horizontal line.

David N. Makous

LEWIS, D'AMATO, BRISBOIS & BISGAARD
221 North Figueroa Street, Suite 1200
Los Angeles, California 90012
Telephone No. (213) 250-1800
Facsimile No. (213) 250-7900

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

ATTORNEYS

221 NORTH FIGUEROA STREET

SUITE 1200

LOS ANGELES, CALIFORNIA 90012

(213) 250-1800

This document is printed with a void background and
artificial watermark on the reverse. Hold at angle to view.

LOS ANGELES DOWNTOWN

REGIONAL OFFICE

LOS ANGELES, CALIFORNIA

16-144

1222

CHECK NO. 152275

DATE

03/04/97

PAY

*****100 DOLLARS AND 00/100****

\$

*****100.00

DRAFT VOID 180 DAYS FROM DATE ISSUED

TO THE
ORDER
OF

ASSISTANT COMMISSIONER OF
PATENT & TRADEMARK

BOX 17U

2900 CRYSTAL DRIVE

ARLINGTON, VIRGINIA

22202-3513

LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

⑈152275⑈ ⑆12220144⑆

⑈07⑈098 723⑈

HON018600

Please acknowledge receipt of our REQUEST TO
DIVIDE APPLICATION by affixing hereon the
patent and Trademark Office date stamp and
return this card to our office. In re
application of:

Applicant: HONDA GIKEN KOGYO
KABUSHIKI KAISHA
SHADOW
Mark: 75/082469
S/N: 21929-112
File No.:
Mailed: March 4, 1997

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

SERIAL NO. 75/082469 HONDA GIKEN KOGYO KABUSHIKI KAISHA		PAPER NO. 21929-112
MARK SHADOW		ADDRESS: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 <small>If no fees are enclosed, the address should include the word "Box Responses - No Fee."</small> Please provide in all correspondence: <ol style="list-style-type: none">1. Filing Date, serial number, mark and Applicant's name.2. Mailing date of this Office action.3. Examining Attorney's name and Law Office number.4. Your telephone number and ZIP code.
ADDRESS David N. Makous LEWIS, D'AMATO, BRISBOIS & BISGAARD, LLP 221 N. Figueroa Street, Suite 1200 Los Angeles, CA 90012	ACTION NO. 01	
MAILING DATE 09/10/96		
REF. NO.		
<div style="display: flex; justify-content: space-between;">FORM PTO-1525 (5-90)U.S. DEPT. OF COMM. PAT. & TM OFFICE</div>		

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 75/082469

The assigned examining attorney has reviewed the referenced application and determined the following.

Prior Registrations

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 1,043,492; 1,645,004; 0236,950; 1,624940 1,604,839; 1,348,246; 1,720,106 and 1,780,427 as to be likely to cause confusion, or to cause mistake, or to deceive. TMEP section 1207. See the enclosed registrations.

Registration Nos. 1,043,492 and 1,645,004 are cited against the goods in Class 16.

Registration Nos. 0236,950; 1,624940 are cited against Class 25.

Registration Nos. 1,604,839; 1,348,246; 1,720,106 and 1,780,427 are cited against Class 28.

There are to be no confusingly similar marks for Classes 14, 18 and 26.

HON018602

Prior Pending Applications

The examining attorney encloses information regarding pending Application Serial Nos. 75/083,260 and 75/083261. The filing dates of the referenced applications precede the applicant's filing date. There may be a likelihood of confusion between the applicant's mark and the referenced marks under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). If one or more of the referenced applications matures into a registration, the examining attorney may refuse registration in this case under Section 2(d). 37 C.F.R. Section 2.83; TMEP section 1208.01. This applies to the Class 25 goods only.

Possible Responses

The applicant may respond to the stated refusals by doing one of the following:

- (1) amending the application to delete the class to which the refusal pertains;
- (2) traversing the refusal of the combined application as a whole; or
- (3) filing a request to divide the application, so that the mark may be published for opposition in the class to which the refusal does not pertain (37 C.F.R. Section 2.87; TMEP sections 1105.06 and 1113.03).

Please note, however, that failure to respond to a refusal which pertains to fewer than all classes in an application will result in abandonment of the combined application in its entirety.

Informalities

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

Additional Fees required

The application identifies goods that may be classified in several international classes. Effective December 3, 1993, the filing fee is \$245.00 for each class. 37 C.F.R. Section 2.6(a)(1). Therefore, the applicant must either: (1) restrict the application to the number of classes covered by the fee already paid, or (2) pay the required fee for each additional class. 37 C.F.R. Section 2.86(b); TMEP sections 810.01 and 1113.01.

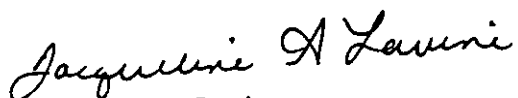
Identification of goods indefinite

The identification of goods is indefinite and requires amendment. Jewelry in Class 14 is acceptable. However, in all the other classes, applicant must specifically list each item using the common commercial name.

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. Section 2.71(b); TMEP section 804.09.

Therefore, the applicant may not amend to include any goods or services that are not within the scope of the goods and services recited in the present identification.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.



Jacqueline A. Lavine
Senior Attorney, Law Office 109
(703) 308-9109 Ext. 145
(703) 308-7194 FAX

NOTE: The Trademark Office is committed to improving the quality of our service. The Assistant Commissioner for Trademarks would like to have your comments and suggestions on ways we can improve the quality of the examination process. In the event there are any areas causing you recurrent problems, please let us know of them.

COMMENTS SHOULD NOT BE INCLUDED WITH THE RESPONSE TO AN OFFICE ACTION, BUT SHOULD BE SENT IN A SEPARATE COMMUNICATION TO THE FOLLOWING ADDRESS:

Office of Trademark Quality Review
c/o Commissioner of Patents and Trademarks
Washington, DC 20231.

Please note that this address differs from the mailing address for the response to this Office action.

HON018604

*** User: EX817099 *** Serial Number: 75083261 ***

Word Mark
SHADOW

Goods/Services
IC 025; US 022 039; G & S: footwear, namely snowboard boots

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75-083261

Filing Date
1996.04.03

Owner Name/Address
(APPLICANT) WILLIAM H. KAUFMAN INC. CORPORATION CANADA 410 King Street
West Kitchener, Ontario CANADA N2G 4J8

Section 44
SECT 44

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON018605

*** User: EX817099 *** Se Number: 75083260 ***

Word Mark
SHADOW-BIO

Goods/Services
IC 025; US 022 039; G & S: footwear, namely snowboard boots

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75-083260

Filing Date
1996.04.03

Owner Name/Address
(APPLICANT) WILLIAM H. KAUFMAN INC. CORPORATION CANADA 410 King Street
West Kitchener, Ontario CANADA N2G 4J8

Section 44
SECT 44

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON018606

*** User: EX817099 *** Serial Number: 73687586 ***

Word Mark
SHADOWS

Goods/Services
IC 025; US 039; G & S: MEN'S AND LADIES' TEE-SHIRTS; LADIES' TANK TOPS,
SLACKS AND SHORTS, CARDIGANS, HATS; FIRST USE DATE: 1984.01.18; FIRST USE
IN COMMERCE: 1984.01.18

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-687586

Filing Date
1987.10.02

Registration Number
1624940

Registration Date
1990.11.27

Owner Name/Address
(REGISTRANT) IKEDA, SHAYNE INDIVIDUAL UNITED STATES 743-C WAIKAMULO ROAD
HONOLULU HAWAII 96817

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON018607

*** User: EX817099 *** Serial Number: 71251252 ***

Word Mark
SHADOW

Goods/Services
IC 025; US 039; G & S: CORSETS, GIRDLES, BRASSIERES [, BANDEAUX,
COMBINATION CORSET-BRASSIERES, COMBINATION GIRDLE-BRASSIERES, COMBINATION
CORSET-BANDEAUX, AND COMBINATION GIRDLE-BANDEAUX]; FIRST USE DATE:
1926.11.01; FIRST USE IN COMMERCE: 1926.11.01

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
71-251252

Filing Date
1927.06.28

Change in Registration
CHANGE IN REGISTRATION HAS OCCURED

Registration Number
0236950

Registration Date
1927.12.27

Owner Name/Address
(REGISTRANT) WARNER BROTHERS COMPANY, THE CORPORATION CONNECTICUT 347
MADISON AVE. NEW YORK NEW YORK

Owner Name/Address
(LAST LISTED OWNER) WARNACO INC. CORPORATION BY CHANGE OF NAME FROM
DELAWARE 90 PARK AVENUE NEW YORK NEW YORK 10016

Type of Mark
TRADEMARK

Register
PRINCIPAL

Renewal
3RD RENEWAL 1987.12.27

HON018608

*** User: EX817099 *** Serial Number: 73827363 ***

Word Mark
THE SHADOW

Goods/Services
IC 016; US 038; G & S: POSTERS, LITHOGRAPHS, COMIC BOOKS, AND GRAPHIC
NOVELS; FIRST USE DATE: 1940.03.00; FIRST USE IN COMMERCE: 1940.03.00

Goods/Services
IC 009; US 036; G & S: PRERECORDED AUDIO CASSETTE TAPES AND PHONOGRAPH
RECORDS FEATURING STORIES FROM RADIO PROGRAMS; FIRST USE DATE:
1972.00.00; FIRST USE IN COMMERCE: 1972.00.00

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-827363

Filing Date
1989.09.25

Registration Number
1645004

Registration Date
1991.05.21

Owner Name/Address
(REGISTRANT) ADVANCE MAGAZINE PUBLISHERS INC. CORPORATION NEW YORK 350
MADISON AVENUE NEW YORK NEW YORK 10017

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON018609

*** User: EX817099 *** Serial Number: 73038765 ***

Word Mark
THE SHADOW

Goods/Services
IC 016; US 038; G & S: NOVELS IN PAPERBACK FORM; FIRST USE: 1963.09.00;
FIRST USE IN COMMERCE: 1963.09.00

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-038765

Filing Date
1974.12.05

Registration Number
1043492

Registration Date
1976.07.13

Owner Name/Address
(REGISTRANT) CONDE NAST PUBLICATIONS INC., THE CORPORATION NEW YORK 350
MADISON AVE. NEW YORK NEW YORK 10017

Owner Name/Address
(LAST LISTED OWNER) ADVANCE MAGAZINE PUBLISHERS INC. CORPORATION NEW YORK
350 MADISON AVENUE NEW YORK NEW YORK 10017

Prior US Registration
0534805

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit
SECT 8.; SECT 15.; COMBINED SECT 8 AND SECT 15.

Renewal
1ST RENEWAL 1996.05.16

SHADOW

Word Mark
SHADOW

Goods/Services
IC 028; US 022; G & S: baseball gloves; FIRST USE DATE: 1992.07.00; FIRST
USE IN COMMERCE: 1992.07.00

Mark Drawing Code
(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number
74-323342

Filing Date
1992.10.19

Registration Number
1780427

Registration Date
1993.07.06

Owner Name/Address
(REGISTRANT) GLOVESMITH, Inc. CORPORATION MISSOURI 20 Village Plaza Arnold
MISSOURI 63010

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON018611

*** User: EX817099 *** Se Number: 74141861 ***

Word Mark
SHADOW

Goods/Services
IC 012; US 019; G & S: wheelchairs, racing wheelchairs, and sports wheelchairs; FIRST USE DATE: 1981.02.19; FIRST USE IN COMMERCE: 1981.04.25

Goods/Services
IC 028; US 022; G & S: snow skiing device having a single runner and a seat intended for use by paraplegics, a water skiing device having a single ski and a seat intended for use by paraplegics, and stationary trainers for wheelchairs; FIRST USE DATE: 1988.01.21; FIRST USE IN COMMERCE: 1988.01.21

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
74-141861

Filing Date
1991.02.25

Registration Number
1720106

Registration Date
1992.09.29

Owner Name/Address
(REGISTRANT) Magic In Motion, Inc. CORPORATION WASHINGTON 20604 - 84th Avenue So. Kent WASHINGTON 98032

Type of Mark
TRADEMARK

Register
PRINCIPAL

HON018612

*** User: EX917099 *** Se Number: 74003218 ***

Word Mark
SHADOW

Goods/Services
IC 028; US 022; G & S: CHILDREN'S RIDE-ON BOUNCING HORSE TOYS; FIRST USE:
1989.08.22; FIRST USE IN COMMERCE: 1989.08.22

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
74-003218

Filing Date
1989.11.16

Registration Number
1604839

Registration Date
1990.07.03

Owner Name/Address
(REGISTRANT) HEDSTROM CORP. CORPORATION ILLINOIS P.O. BOX 432 BEDFORD
PENNSYLVANIA 15522

Owner Name/Address
(LAST LISTED OWNER) HEDSTROM CORPORATION CORPORATION DELAWARE SUNNEYSIDE
ROAD, BOX 432 BEDFORD PENNSYLVANIA 15522

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit
SECT 8.; SECT 15.; COMBINED SECT 8 AND SECT 15.

HON018613

*** User: EX817099 *** Se Number: 73504102 ***

Word Mark
SHADOW

Goods/Services
IC 028; US 022; G & S: GOLF CLUBS AND GOLF CLUB SHAFTS; FIRST USE DATE:
1983.09.20; FIRST USE IN COMMERCE: 1983.09.20

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
73-504102

Filing Date
1984.10.16

Registration Number
1348246

Registration Date
1985.07.09

Owner Name/Address
(REGISTRANT) TI ACCLES AND POLLOCK LIMITED COMPANY UNITED KINGDOM PADDOCK
WORKS OLDBURY, WARLEY, WEST MIDLANS ENGLAND

Owner Name/Address
(LAST LISTED OWNER) TI APOLLO LIMITED COMPANY ASSIGNEE OF UNITED KINGDOM

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit
SECT 8.; SECT 15.; COMBINED SECT 8 AND SECT 15.

HON018614

FILING 1 EIPT FOR TRADEMARK APPLIC ON

Page 01 of 01

05/15/96

Receipt on the DATE OF FILING of the application for registration and filing fees is acknowledged for the mark identified below. The DATE OF FILING is contingent upon the collection of any payment made by check or draft. Your application will be considered in the order in which it was received and you will be notified as to the examination thereof. Correspondence should be expected from the Patent and Trademark Office in approximately months. When inquiring about this application, include the SERIAL NUMBER, DATE OF FILING, OWNER NAME, and MARK.

06

David N. Makous
LEWIS, D'AMATO, BRISBOIS & BISGAARD, LLP
221 N. Figueroa Street, Suite 1200
Los Angeles, CA 90012

TMPRE

ATTORNEY
REFERENCE NUMBER

PLEASE REVIEW THE ACCURACY OF THE FILING RECEIPT DATA.

A request for correction to the notice of allowance should be submitted within 30 days to the following address: ASSISTANT COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VIRGINIA 22202-3513. The correspondence should be marked to the attention of the Office of Trademark Program Control. The Patent and Trademark Office will review the request and make corrections when appropriate.

SERIAL NUMBER: 75/082469

DATE OF FILING: 04/02/1996

MARK: SHADOW

MARK TYPE(S): TRADEMARK

DRAWING TYPE: WORDS, LETTERS, OR NUMBERS IN TYPED FORM

SECTION 1(A): NO

SECTION 1(B): YES

SECTION 44: NO

ATTORNEY: David N. Makous

OWNER NAME: HONDA GIKEN KOGYO KABUSHIKI KAISHA

OWNER ADDRESS: 2-1-1 Minami-Aoyama,
Minato-Ku
Tokyo 107
JAPAN

ENTITY: CORPORATION

CITIZENSHIP/DOMICILE: JAPAN

INTERNATIONAL CLASS

DATE OF FIRST USE

DATE OF FIRST USE IN COMMERCE

ONLY THOSE DATES OF USE AND CLASSES FILED UNDER SECTION 1(A) ARE LISTED

GOODS/SERVICES BY INTERNATIONAL CLASS

014-jewelry

016-paper goods and printed matter

018-leather goods

025-clothing and footwear

026-fancy goods

028-toys and sporting goods

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

HON018615

LEWIS, D'AMATO, BRISBOIS & BISGAARD

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3. Client and file name Honda. - Shadow Accg. use - G. L. No. 21929-112 Client and matter No.:
4. Payee or vendor: Asst. Commissioner of Patents & Trademark Amount \$ 245.00
5. Mailing address (if applicable): 2900 Crystal Dr., Arlington, VA 22202-3513
6. Reference on remittance advice: Filing fee for ITU Application
7. Explanation for billing purposes: Filing fee for ITU Application

8. Disposition of check ☐ Mail ☒ Return to Raffi A. Nahabedian

Auth. by Raffi A. Nahabedian Name Raffi A. Nahabedian Number 1 Signature [Signature] Date 4/2/96

- Instructions: (1) Original to data processing/numeric copy
(2) Second copy (yellow) attached to invoice to accounting
(3) Third copy (pink) retain in attorney's file

HON018616

21929-112
COURT

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Commissioner of Patents and Trademarks, Box ITU, 2900 Crystal Drive, Arlington, Virginia 22202-3510

By: RMAA
Raffi A. Nahabedian

Date Mailed: April 2, 1996

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
APPLICATION FOR REGISTRATION OF TRADEMARK ON PRINCIPAL REGISTER
[Intent-to-Use]

Applicant: HONDA GIKEN KOGYO)
KABUSHIKI KAISHA)
(Honda Motor Co., Ltd.))
Address: 2-1-1 Minami-Aoyama,)
Minato-Ku, Tokyo 107,)
JAPAN)
Mark: SHADOW)
I.C.: 14, 16, 18, 25, 26 & 28)

TO THE ASSISTANT COMMISSIONER OF PATENTS AND TRADEMARKS:

TRANSMITTAL LETTER

Enclosed herewith and pertaining to the above-described Intent-to-Use trademark application are the following documents/items:

1. Intent-to-Use Application for Registration of the mark SHADOW;
2. Drawing for the mark SHADOW in International Classes 14, 16, 18, 25, 26 & 28; and
3. A check in the amount of \$245.00.

DATED: April 2, 1996

Respectfully submitted,
LEWIS, D'AMATO, BRISBOIS & BISGAARD LLP

By

RMAA
Raffi A. Nahabedian
Attorneys for Applicant

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Box ITU, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: R. M. A. N.
Raffi A. Nahabedian

Date Mailed: APRIL 2, 1996

Express Mail No. EF086997170US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
APPLICATION FOR REGISTRATION OF TRADEMARK ON PRINCIPAL REGISTER
[INTENT-TO-USE]

Applicant:	HONDA GIKEN KOGYO)	Mark: SHADOW
	KABUSHIKI KAISHA)	
	(Honda Motor Co., Ltd.))	
)	I.C. 14, 16, 18,
)	25, 26 & 28
Address:	2-1-1 Minami-Aoyama,)	
	Minato-Ku, Tokyo 107,)	
	JAPAN)	
)	
)	

TO THE ASSISTANT COMMISSIONER OF PATENTS AND TRADEMARKS:

The above-identified Applicant, Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.), a Japanese corporation, requests registration of the mark shown in the accompanying drawing in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 1051 et seq., as amended), for the following services:

Int'l Class 14: "Jewelry"

Int'l Class 16: "Paper goods and printed matter"

Int'l Class 18: "Leather goods"

Int'l Class 25: "Clothing and footwear"

Int'l Class 26: "Fancy goods"

Int'l Class 28: "Toys and sporting goods"

Applicant has a bona fide intention to use the mark in commerce in association with the above-identified goods (15 U.S.C. 1051(b), as amended).

The mark will be used by applying it to the goods themselves and in other ways customary in the trade.

DECLARATION

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this application on behalf of the applicant; he believes the applicant to be the owner of the trademark; to the best of his


knowledge and belief no other persons, firm, corporation, or association has the right to use the above identified mark in commerce, either in the identical form or in such near resemblance thereto as may be likely, when applied to the goods or services of such other person, to cause confusion, or to cause mistake, or to deceive; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Applicant hereby appoints David N. Makous, Sarira D. Alexander, Raffi A. Nahabedian, and each member of the firm of Lewis, D'Amato, Brisbois & Bisgaard, 221 North Figueroa Street, Suite 1200, Los Angeles, California 90012, telephone number (213) 250-1800, its principal attorneys to prosecute this application, to transact all business in the Patent and Trademark Office in connection therewith, to receive notification of acceptance, and any certificate issued.

DESIGNATION OF DOMESTIC REPRESENTATIVE

Applicant hereby designates David N. Makous, a resident of the United States, at Lewis, D'Amato, Brisbois & Bisgaard, 221 North Figueroa Street, Suite 1200, Los Angeles, California 90012, as its domestic representative in all matters required by 15 U.S.C. §1051(e) and 37 C.F.R. §2.24.

Dated: April 1 , 1996



Mr. Isao Suzuki
Director, Honda Motor Co., Ltd.

LEWIS, D'AMATO, BRISBOIS & BISGAARD, LLP
221 N. Figueroa Street, Suite 1200
Los Angeles, California 90012
(213) 250-1800

DRAWING
[INTENT-TO-USE]

Applicant: Honda Giken Kogyo Kabushiki Kaisha
(Honda Motor Co., Ltd.)

Address: 2-1-1 Minami-Aoyama
Minato-Ku, Tokyo 107,
JAPAN

Mark: SHADOW

Goods: "Jewelry" (Int'l Class 14)
"Paper goods and printed matter" (Int'l Class 16)
"Leather goods" (Int'l Class 18)
"Clothing and footwear" (Int'l Class 25)
"Fancy goods" (Int'l Class 26)
"Toys and sporting goods" (Int'l Class 28)

SHADOW

POST OFFICE TO ADDRESSEE



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METHOD OF PAYMENT:	
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<input type="checkbox"/> WAIVER OF SIGNATURE (Domestic Only) I wish delivery to be made without obtaining the signature of the addressee or the addressee's agent (in the judgment of the delivery employee, the article can be left in a secure location) and I authorize the delivery employee to sign that the shipment was delivered and understand that the signature of the delivery employee will constitute valid proof of delivery.	
<input type="checkbox"/> NO DELIVERY	
<input type="checkbox"/> WEEKEND <input type="checkbox"/> HOLIDAY	
Customer Signature	

Name Address City State Zip	Name Address City State Zip
---	---

For Pickup or Tracking Call 1-800-222-1811

LABEL 11 B 593

HON018622

CUSTOMER COPY

Please acknowledge receipt of our INTENT-TO-USE APPLICATION and OUR CHECK IN THE AMOUNT OF \$245.00 by affixing hereon the Patent and Trademark Office date stamp and returning it to our office. In re application of:

Applicant: HONDA GIKEN KOGYO
KABUSHIKI KAISHA
(Honda Motor Co., Ltd.)

Address: 2-1-1 Minami-Aoyama, 2 1996
Minato-Ku, Tokyo 107,
JAPAN

Mark: SHADOW
Int'l Classes: 14, 16, 18, 25, 26 & 28

File No.: 21929-112
Mailed: April 2, 1996 75082469



HON018623

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-03-15 16:18:33 ET

Serial Number: 78359569

Registration Number: (NOT AVAILABLE)

Mark

SHADOW

(words only): SHADOW

Standard Character claim: Yes

Current Status: Newly filed application, not yet assigned to an examining attorney.

Date of Status: 2004-02-19

Filing Date: 2004-01-29

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 115

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 042 -NEW APPLICATION PROCESSING

Date In Location: 2004-02-19

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Pace American, Inc.

Address:

Pace American, Inc.
11550 Harter Drive

**APPLICANT'S
EXHIBIT**

22

Middlebury, IN 46540

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Indiana

GOODS AND/OR SERVICES

Trailers, Namely, Cargo Trailers and Automobile Hauling Trailers

International Class: 012

First Use Date: 1991-03-08

First Use in Commerce Date: 1991-03-08

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2004-02-09 - New Application Entered In Tram

CONTACT INFORMATION

Correspondent (Owner)

Terence J. Linn (Attorney of record)

Terence J. Linn

Van Dyke, Gardner, Linn & Burkhart, LLP

2851 Charlevoix Drive, S.E., P.O. Box 88

Grand Rapids, MI 49588-8695

Phone Number: (616) 975-5500

Fax Number: (616) 975-5505

Drawing Page

Date/Time Stamp: 01/29/2004 16:15:0



Serial Number: 78359569



Mark (USPTO-generated image for standard character

SHADOW

SHADOW

76-30

FILING DATE

August 29, 2001

ORIGINAL APPLICANT

AAI Corporation

GOODS/SERVICES (CLASS 010)

unmanned vehicles; launching equipment, (ETC)

FILING BASIS

ITU

ORIGINAL CORRESPONDENT

JOHN P. SHANNON

SHADOW

**APPLICANT'S
EXHIBIT**

23

SH

PRIN

LAW OFFI

Aisha Clarke

ATTORNEY ADVISOR:

76-30

Approved for Publication (Principal Register) (Signature/Date)

Aisha Clarke 10/02/02

Approved for Registration (Section 1(d)) (Signature/Date)

Approved for Registration (Supplemental Register) (Signature/Date)

**PUBLISHED
12/31/02**

NOA



Abandoned

(Date)

Entry

Date

Initials

NOV 2 2001

CPD

1. *Amata* MAY 14 2002
2. *Amata*
3. NOP
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8. *Amata* OCT - 3 2002
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- 10.
11. NOP
12. 12/31/02
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16. 12/02/03
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- 2/7/02
- NOV 31 2002
- 9-602 ✓

- CPD
- CP

DRAWING PAGE

Applicant's Name:	AAI Corporation
Applicant's Address:	P.O. Box 126 Hunt Valley, Maryland 21030-0126
Basis of Application:	Intent-to-Use
Description of Goods/Services:	"Unmanned vehicles; launching equipment, landing equipment, transporting equipment, control station, and video terminal and antenna for use with unmanned air vehicles" in International Class 9.
Attorney Reference:	13346-174132

Mark:



08-29-2001

U.S. Patent & TMO/TM Mail Rcpt Dt. #87

SHADOW

John P. Shannon
Venable, Baetjer, Howard & Civiletti, LLP
P.O. Box 34385
Washington, DC 20045-9998
Telephone: (202) 216-8163
Fax: (202) 962-8300

PUBLISHED
12/31/02

303983

-4-



76306798

TM

DRAWING PAGE

Applicant's Name:	AAI Corporation
Applicant's Address:	P.O. Box 126 Hunt Valley, Maryland 21030-0126
Basis of Application:	Intent-to-Use
Description of Goods/Services:	"Unmanned vehicles; launching equipment, landing equipment, transporting equipment, control station, and video terminal and antenna for use with unmanned air vehicles" in International Class 9.
Attorney Reference:	13346-174132

Mark:



08-29-2001

U.S. Patent & TMO/TM Mail Receipt #57

SHADOW

John P. Shannon
Venable, Baetjer, Howard & Civiletti, LLP
P.O. Box 34385
Washington, DC 20045-9998
Telephone: (202) 216-8163
Fax: (202) 962-8300

303983

76306798

TRADEMARK APPLICATION SERIAL NO. _____

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

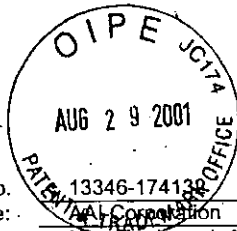
89/05/2001 SWILSON 00000089 76306798

01 FC:361

325.00 OP

99348

Venable Filing Number



August 29, 2001

Filing Date

Atty. Docket No.

13346-174133

Re:

Opposition

Application No.:

New Trademark Application

Filing Date:

Patent No.:

Issue Date

Trademark:

SHADOW

Trademark Reg. No:

Opposition/Cancellation No:

The following items were received from Venable
Washington, D.C., by the U.S. Patent & Trademark Office:

U.S. PTO FEES ENCLOSED

	Transmittal Letter	325.00	Filing Fee
	New U.S. Patent/Design/Application (___ pages of specification/claims)		
	Formal Drawings (___ Sheets)		Surcharge Fee
	Invention Declaration		
	National Stage Application		Additional Claim Fee
	Translation of International Application		
X	New U.S. TM Application w/Drawing Page		Recordation/Indexing Fee
	Rule 53(d) Continuation or Division Application		
	Rule 53(b) Continuation or Division		IDS Fee
	Application (in Duplicate) (attach copy of specifications, claims, drawings & declaration)		Extension Fee
	Priority Document-Cert. Copy of ___		
	Appln. # ___		Notice of Appeal Fee
	Date ___		
	Assignment w/ Cover Sheet		Brief on Appeal Fee
	IDS w/ PTO - 1449 (___ references)		
	Response		Oral Hearing Request Fee
	Amendment		
	Petition/Request for Extension of Time		Petition Fee
	Notice of Appeal		
	Appeal Brief (in triplicate)		Issue Fee
	Request for Oral Hearing		
	Confirmation of Hearing Petition		Maintenance Fee
	Issue Fee Transmittal		
	Certificate of Correction		TM Statement of Use
	Maintenance Fee Transmittal		
	TM Statement of Use		8 Affidavit Fee
	Declaration Under 8		
	Declaration Under 8 and 15		8 and 15 Affidavit
	TM renewal Application		
	Notice of Opposition		TM Renewal Application Fee
	Request for Corrected Filing Receipt		
	Terminal Disclaimer		Notice of Opposition Fee
			Terminal Disclaimer
		Fee:	325.00
		Check Number	

313472

VENABLE, BAETJER, HOWARD & CIVILETTI, LLP
Including professional corporations

1201 New York Avenue, N.W., Suite 1000
Washington, D.C. 20005-3917
(202) 962-4800, Fax (202) 962-8300
www.venable.com

OFFICES IN

WASHINGTON, D.C.
MARYLAND
VIRGINIA

VENABLE
ATTORNEYS AT LAW

John P. Shannon, Esq.
(202) 216-8163
jpshannon@venable.com

August 29, 2001

Honorable Assistant Commissioner
for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Attention: BOX ITU FEE

Re: New U.S. Trademark Application
Applicant: AAI Corporation
Mark: SHADOW
Our Ref.: 13346-174132

Dear Sir:

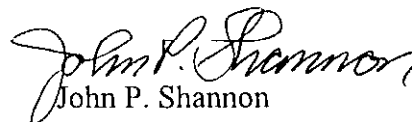
Submitted herewith, in support of the above-referenced matter, are the following:

- Application Under Section 1(b)
- Drawing Page
- Check in the amount of \$325.00
- Return self-addressed postcard

Please apply the submitted check in satisfaction of the requisite fee of \$325.00. If the check is missing or deficient, please charge Deposit Account No. 22-0261.

Please direct all communication regarding this application to the undersigned at the above address and phone number.

Respectfully submitted,


John P. Shannon

/ced
Enclosures

VENABLE, BAETJER, HOWARD & CIVILETTI, LLP
Including professional corporations

1201 New York Avenue, N.W., Suite 1000
Washington, D.C. 20005-3917
(202) 962-4800, Fax (202) 962-8300
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OFFICES IN

WASHINGTON, D.C.
MARYLAND
VIRGINIA



John P. Shannon, Esq.
(202) 216-8163
jpshannon@venable.com

August 29, 2001

Honorable Assistant Commissioner
for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Attention: BOX ITU FEE

Re: New U.S. Trademark Application
Applicant: AAI Corporation
Mark: SHADOW
Our Ref.: 13346-174132

Dear Sir:

Submitted herewith, in support of the above-referenced matter, are the following:

- Application Under Section 1(b)
- Drawing Page
- Check in the amount of \$325.00
- Return self-addressed postcard

Please apply the submitted check in satisfaction of the requisite fee of \$325.00. If the check is missing or deficient, please charge Deposit Account No. 22-0261.

Please direct all communication regarding this application to the undersigned at the above address and phone number.

Respectfully submitted,


John P. Shannon

/ced
Enclosures

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/306798

ACTION NO: 1

APPLICANT: AAI Corporation

CORRESPONDENT ADDRESS:

JOHN P. SHANNON
BAETJER, HOWARD & CIVILETTI, LLP
PO BOX 34385
WASHINGTON DC 20043-4385

RETURN ADDRESS:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
ecom105@uspto.gov

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

MARK: SHADOW

CORRESPONDENT'S REFERENCE/DOCKET NO: 13346-174132

MAILING DATE: October 29, 2001

CORRESPONDENT EMAIL ADDRESS:

N/A

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Mailing date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and ZIP code.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE. *You may respond via regular mail to the return address listed above, or via e-mail to the e-mail return address listed above.*

If this office action is being sent by regular mail, a label has been enclosed. To respond by regular mail, please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Examining Attorney's name and the serial number in the upper right corner of your response.

*To respond by email please clearly state the applicant's name, mark, serial number, Law Office and Examining Attorney in the body of the response. Also, e-mail responses must (1) include the entire response as e-mail text, not as an attachment; (2) **list the serial number in the "Subject" line;** (3) be signed electronically (using the same method accepted for an initial application filed electronically - the signatory must enter any combination of alpha/numeric characters that has been specifically adopted to serve the function of the signature, preceded and followed by the forward slash (/) symbol. Acceptable "signatures" could include: /john doe/; /jd/; and /123-4567/. (See 64 FR 33056, 33062 (June 21, 1999))); (4) include any specimens or evidence in JPG or GIF format only, and (5) address every issue raised.*

RE: Serial Number: 76/306798 SHADOW

The assigned examining attorney has reviewed the referenced application and determined the following.

No Conflicting Mark Noted

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01.

Identification of Goods

The identification of goods is unacceptable as indefinite because it fails to identify the goods with enough specificity for the Office to classify them. TMEP section 804. The applicant may adopt any or all of the following identifications, if accurate:

Computerized unmanned [indicate type, e.g., air, land] vehicles in Class 9;

Launching equipment, namely [indicate type, e.g., skeet, clay, firearm] target launchers in **Class 28**;

Launching equipment, namely [indicate type, e.g., rocket, grenade] launchers in **Class 13**;

Airplane parts, namely, landing gear in Class 12;

Transporting equipment, namely pneumatic transporters in Class 7;

Transporting equipment, namely metal containers for the storage and transportation of goods in Class 6;

Computerized control station, video terminal, and antenna for use with computerized unmanned [indicate type, e.g., air, land] vehicles in Class 9.

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. Section 2.71(a); TMEP section 804.09. Therefore, the applicant may not amend to include any goods that are not within the scope of goods set forth in the present identification.

The *Acceptable Identification of Goods and Services Manual* sets out acceptable language for identifying goods and services of various types. The listing is by no means exhaustive but is intended to serve as a guide to examining attorneys in acting on applications and to the public in preparing applications. Utilizing identification language from the Manual may enable trademark owners to avoid problems relating to indefiniteness with respect to the goods or services identified in their applications for registration; however, applicants should note that they must assert actual use in commerce or a bona fide intent to use the mark in commerce for the goods or services specified. TMEP Section 804.04.

The applicant should use the listings located in this database exactly as worded, if possible. Please note that use by the applicant of parenthesis within an identification of the goods is unacceptable as indefinite. With regard to those listings in the Office's database that include terms within parenthesis and/or brackets, the applicant must set forth the term(s) that specifically cover the applicant's goods or services. As always, any identification of goods or recitation of services the applicant chooses to adopt should 1) accurately describe the applicant's goods or services; 2) be

placed in the correct class of goods or services; and 3) list only those goods or services within the scope of those included in the original application.

The *Acceptable Identification of Goods and Services Manual* may be purchased, along with other trademark information, in a CD-ROM format from the Office of Electronic Information Products Development of the Patent and Trademark Office ((703) 306-2600). See notice at 1190 TMOG 67 (Sept. 17, 1996). The Manual is also available on the PTO's "homepage" on the Internet, which can be accessed at <http://www.uspto.gov>, and in hardcopy on a subscription basis from the Government Printing Office.

Additional Classes


If the applicant prosecutes this application as a combined, or multiple-class, application, the applicant must comply with each of the following.

- (1) The applicant must list the goods by international class with the classes listed in ascending numerical order. TMEP section 1113.01.
- (2) The applicant must submit a filing fee for each international class of goods not covered by the fee already paid. 37 C.F.R. Sections 2.6(a)(1) and 2.86(b); TMEP sections 810.01 and 1113.01. Effective January 10, 2000, the fee for filing a trademark application is \$325 for each class. This applies to classes added to pending applications as well as to new applications filed on or after that date.

Response

No set form is required for response to this Office action. The applicant must respond to each point raised. The applicant should simply set forth the required changes or statements and request that the Office enter them. The applicant must sign the response. In addition to the identifying information required at the beginning of this letter, the applicant should provide a telephone number to speed up further processing.

If the applicant has any questions or needs assistance in responding to this office action, please telephone the assigned examining attorney.



Idri Aisha Clarke

Trademark Attorney, Law Office 105

Phone: (703) 308-9105 Ext. 174

Fax: (703) 872-9825

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	AAI Corporation
Description of Applicant:	A Maryland Corporation
Applicant's Address:	P.O. Box 126 Hunt Valley, Maryland 21030-0126
Mark:	SHADOW
Class:	09
Attorney Reference:	13346-174132

BOX ITU FEE

Honorable Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

APPLICATION UNDER SECTION 1(b)

Sir:

Applicant requests registration of the mark shown in the accompanying drawing in the U.S. Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946, as amended, 15 U.S.C. § 1051 *et seq.*

Applicant has a *bona fide* intention to use the trademark in commerce in the United States on or in connection with the goods stated below, Section 1(b) of the Lanham Act, as amended, 15

U.S.C. § 1051(b):

computerized

"Unmanned vehicles; launching equipment, landing equipment, transporting equipment, control station, and video terminal and antenna for use with unmanned air vehicles," in International Class 9.

*28 sheet
namely target launchers,
grenade launchers,
airplane land:*

DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this application on behalf of the applicant; he believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. § 1051(b), he believes applicant to be entitled to use such mark in commerce; to the best of his knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

POWER OF ATTORNEY

Applicant hereby appoints Mark Harrison, John P. Shannon, Janet F. Satterthwaite, Marcia A. Auberger, Andrew D. Price, Jacqueline L. Patt and John W. McGlynn all members of the bar of the District of Columbia, state of Maryland, or Commonwealth of Virginia, and the law firm of Venable, Baetjer, Howard & Civiletti, LLP, and all having the address 1201 New York Avenue, NW, Suite 1000, Washington DC, 20005, as applicant's attorneys with full powers of association, substitution and revocation, to transact all business in the U.S. Patent and Trademark Office associated with the present application, to prosecute the present application, and to receive the certificate of registration. Please address all correspondence as follows:

John P. Shannon
Venable, Baetjer, Howard & Civiletti, LLP
P.O. Box 34385
Washington, DC 20045-9998

Respectfully signed this 31st day of July, 2001.

AAI CORPORATION

By: Robert W. Worthing
(signature)

Name: Robert W. Worthing
(print)

Title: Vice President, General Counsel & Secretary
(print)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	AAI Corporation
Description of Applicant:	A Maryland Corporation
Applicant's Address:	P.O. Box 126 Hunt Valley, Maryland 21030-0126
Mark:	SHADOW
Class:	09
Attorney Reference:	13346-174132

BOX ITU FEE

Honorable Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

APPLICATION UNDER SECTION 1(b)

Sir:

Applicant requests registration of the mark shown in the accompanying drawing in the U.S. Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946, as amended, 15 U.S.C. § 1051 *et seq.*

Applicant has a *bona fide* intention to use the trademark in commerce in the United States on or in connection with the goods stated below, Section 1(b) of the Lanham Act, as amended, 15 U.S.C. § 1051(b):

“Unmanned vehicles; launching equipment, landing equipment, transporting equipment, control station, and video terminal and antenna for use with unmanned air vehicles,” in International Class 9.

DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this application on behalf of the applicant; he believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. § 1051(b), he believes applicant to be entitled to use such mark in commerce; to the best of his knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

POWER OF ATTORNEY

Applicant hereby appoints Mark Harrison, John P. Shannon, Janet F. Satterthwaite, Marcia A. Auberger, Andrew D. Price, Jacqueline L. Patt and John W. McGlynn all members of the bar of the District of Columbia, state of Maryland, or Commonwealth of Virginia, and the law firm of Venable, Baetjer, Howard & Civiletti, LLP, and all having the address 1201 New York Avenue, NW, Suite 1000, Washington DC, 20005, as applicant's attorneys with full powers of association, substitution and revocation, to transact all business in the U.S. Patent and Trademark Office associated with the present application, to prosecute the present application, and to receive the certificate of registration. Please address all correspondence as follows:

John P. Shannon
Venable, Baetjer, Howard & Civiletti, LLP
P.O. Box 34385
Washington, DC 20045-9998

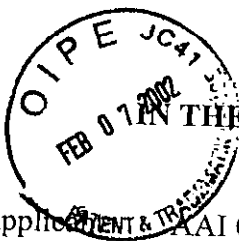
Respectfully signed this 31st day of July, 2001.

AAI CORPORATION

By: Robert W. Worthing
(signature)

Name: Robert W. Worthing
(print)

Title: Vice President, General Counsel & Secretary
(print)



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: XAI Corporation

Serial No.: 76/306,798

Mark: SHADOW

Filed: August 29, 2001

Examining Attorney: Idi Aisha Clarke

Law Office: 105

Attorney Reference: 13346-174132

BOX NO FEE

Honorable Assistant Commissioner for Trademarks

2900 Crystal Drive

Arlington, Virginia 22202-3513

U.S. Patent & TMO/TM Mail Rpt. Dt. #57
02-07-2002

RESPONSE

Sir:

This is in response to the Office Action dated October 29, 2001.

Identification of Goods

Applicant respectfully requests that the present identification of goods be amended to read as follows:

"Computerized unmanned air vehicles; computerized control station, video terminal, and antenna for use with computerized unmanned air vehicle," in International Class 9.

REMARKS

Given the foregoing response and amendment, it is respectfully submitted that Applicant's mark is entitled to registration on the Principal Register.

Respectfully submitted,

By:

John W. McGlynn

Venable, Baetjer, Howard & Civiletti, LLP

P.O. Box 34385

Washington, D.C. 20045-9998

Telephone: (202) 216-8167

Fax: (202) 962-8300

Attorney for Applicant

Date: February 7, 2002
349917

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/306798

APPLICANT: AAI Corporation

CORRESPONDENT ADDRESS:

JOHN P. SHANNON
BAETJER, HOWARD & CIVILETTI, LLP
PO BOX 34385
WASHINGTON DC 20043-4385

RETURN ADDRESS:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
ecom105@uspto.gov

MARK: SHADOW

CORRESPONDENT'S REFERENCE/DOCKET NO: 13346-174132

CORRESPONDENT EMAIL ADDRESS:

N/A

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

RE: Serial Number 76/306798 SHADOW

Upon further examination of the referenced application, the assigned examining attorney has determined the following. The Office apologizes for any inconvenience.

Identification and Classification of Goods

The applicant has classified "computerized unmanned vehicles" in International Class 9. The correct classification is International Class 12. The applicant must either delete these goods or add International Class 12 to the application. 37 C.F.R. §§2.32(a)(7) and 2.85; TMEP §1401.04(b).

The remainder of the identification is acceptable.

Additional Classes

If the applicant prosecutes this application as a combined, or multiple-class, application, the applicant must comply with each of the following.

- (1) The applicant must list the goods/services by international class with the classes listed in ascending numerical order. TMEP §1403.01.

(2) The applicant must submit a filing fee for each international class of goods/services not covered by the fee already paid. 37 C.F.R. §§2.6(a)(1) and 2.86(a); TMEP §§810.01 and 1403.01. Effective January 10, 2000, the fee for filing a trademark application is \$325 for each class. This applies to classes added to pending applications as well as to new applications filed on or after that date.

Response

No set form is required for response to this Office action. The applicant must respond to each point raised. The applicant should simply set forth the required changes or statements and request that the Office enter them. The applicant must sign the response. In addition to the identifying information required at the beginning of this letter, the applicant should provide a telephone number to speed up further processing.

If the applicant has any questions or needs assistance in responding to this office action, please telephone the assigned examining attorney.



Idi Aisha Clarke
Trademark Attorney
Law Office 105
(703) 308-9105 Ext. 174
Fax: (703) 872-9825

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

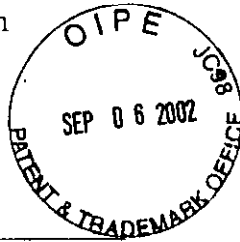
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: AAI Corporation

Serial No.: 76/306,798

Mark: SHADOW

Filed: August 29, 2001



Examining Attorney: Idi Aisha Clarke

Law Office: 105

Attorney Reference: 13346-174132

BOX FEE

Honorable Assistant Commissioner for Trademarks

2900 Crystal Drive

Arlington, Virginia 22202-3513

RESPONSE

Sir:

This is in response to the Office Action dated July 31, 2002.

Applicant respectfully requests that the present identification of goods be amended to read as follows:


"Computerized control station, video terminal, and antenna for use with ✓
computerized unmanned air vehicle," in International Class 9;
"Computerized unmanned air vehicles," in International Class 12. ✓

One class has been added to this application. The additional filing fee of \$325.00 is attached. In the event there is no fee attached, or an insufficient amount, please charge the fee to our Deposit Account No. 22-0261.

In view of the foregoing, it is respectfully requested that the mark be forwarded for publication in the Official Gazette.

Respectfully submitted,

By:


Jacqueline L. Patt

Venable, Baetjer, Howard & Civiletti, LLP

P.O. Box 34385

Washington, D.C. 20045-9998

Telephone: (202) 216-8167

Fax: (202) 962-8300

Attorney for Applicant

09/12/2002 EP1WA1 00000033 76306798

01 FC:361

325.00 OP

Date: September 6, 2002