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Date of Deposit: November 3, 2005

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Christina Rodgers  
Name of Person Mailing Paper or Fee

Christina Rodgers  
Signature of Person Mailing Paper or Fee

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

IN RE: Reg. No. -1,537,609 /73727701

REGISTERED: May 2, 1989

REGISTRANT: Sue Goldstein

SmartBargains.com LP

Petitioner,

vs.

Sue Goldstein

Registrant.

Cancellation No. \_\_\_\_\_

11/10/2005 6THXNAS2 00000037 233000 1537609  
01 FC:6401 300.00 DA

CANCELLATION PETITION

COMMISSIONER FOR TRADEMARKS  
P.O. Box 1451  
Alexandria, VA 22313-1451



11-03-2005

U.S. Patent & TMO/TM Mail Rcpt Dt. #01

Dear Madam:

Petitioner, SmartBargains.com LP, a Delaware limited partnership, composed of SmartBargains, Inc., a Delaware corporation, and SB.com, Inc., a Delaware corporation, having a principal place of business at 10 Milk Street, 10th Floor, Boston, MA 02108, believes that it is and

will continue to be damaged by the registration of the mark shown in U.S. Registration No. 1,537,609 in International Class 35 for "television shop-at-home services," claiming first use anywhere and in commerce on December 31, 1987, and hereby petitions to cancel same. A copy of the TESS/TARR printout for the aforesaid registration is attached as Exhibit A.

As grounds therefor, Petitioner alleges that:

1. Petitioner has a bona fide intent to use the NEVER PAY RETAIL mark for:

"Online retail store services, telemarketing and mail order catalog services, featuring off-price, close-out, liquidation, and marked-down general merchandise, footwear, headwear, clothing, jewelry, watches, luggage, sporting goods, home furnishings and decor, home improvement goods, bath linens, bed linens, china, crystal, silver, kitchen and dining appliances, electronic goods, toys, cameras, audio equipment, housewares, computers, telephones, camcorders, art and wall decor, fragrances, cosmetics, sunglasses, attache cases, briefcases, leather goods, furniture, telescopes, binoculars, video games, cookware, beverage ware, dinnerware and cutlery, in International Class 35.

2. Petitioner is a well-known Internet retailer of off-price, close-out, liquidation, and marked-down general merchandise in a wide and diverse range of product categories.

3. Petitioner currently owns pending U.S. intent-to-use service mark application Serial No. 76/613,566, filed September 30, 2004, for the NEVER PAY RETAIL service mark, seeking to register the mark for the services set forth above in Paragraph 1. A copy of Petitioner's application, as filed, is enclosed as Exhibit B. Also enclosed is a copy of Petitioner's Response (Exhibit C) to the outstanding Official Action (Exhibit D) and a copy of an Amendment to Allege Use (Exhibit E), both of which are being filed concurrently with this Petition for Cancellation.

4. Upon information and belief, Sue Goldstein, an individual, located at Suite 101, 1508 E. Beltline Road, Carrollton, TX 75006, is the last listed owner of U.S. Registration No. 1,537,609. A copy of the USPTO online Trademark Assignment Abstract of Title of this registration is enclosed as Exhibit F.

5. In an Office Action (Exhibit D) mailed May 3, 2005, issued by the United States Patent and Trademark Office against Petitioner's pending U.S. trademark application Serial No. 76/613,566, the Examining Attorney refused registration under Trademark Act § 2(d) because, in the opinion of the Examining Attorney, the Petitioner's mark, when used on the identified services, is likely to be confused with the registered mark of U.S. Registration No. 1,537,609.

6. Upon information and belief, Registrant does not currently sell any goods or provide any services under the mark of U.S. Registration No. 1,537,609.

7. Upon information and belief, Registrant has abandoned its rights and interest in the mark of U.S. Registration No. 1,537,609 in the United States by discontinued use of said mark for three years immediately preceding filing of this Petition to Cancel with no intent to resume said use and is no longer entitled to use the mark of U.S. Registration No. 1,537,609.

8. Continuation of U.S. Registration No. 1,537,609 on the Principal Register of the United States Patent and Trademark Office has damaged and will continue to damage Petitioner. Damage to Petitioner is evidenced by the fact that U.S. Registration No. 1,537,609 has been cited by the Examining Attorney against Petitioner's pending U.S. service mark application Serial No. 76/613,566 for the NEVER PAY RETAIL mark and used as a basis for refusing to register Petitioner's NEVER PAY RETAIL mark.



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**NEVER PAY RETAIL!**

<b>Word Mark</b>	RETAIL NEVER PAY RETAIL!
<b>Goods and Services</b>	(CANCELLED) IC 042. US 100 101. G & S: TELEVISION SHOP-AT-HOME SERVICES. FIRST USE: 19871231. FIRST USE IN COMMERCE: 19871231
	IC 035. US 100 101 102. G & S: [ PROMOTING THE SALE OF GOODS AND SERVICES OF OTHERS THROUGH THE DISTRIBUTION OF PRINTED MATERIAL AND AUDIO-VIDEO MEDIA ]. FIRST USE: 19871231. FIRST USE IN COMMERCE: 19871231
<b>Mark Drawing Code</b>	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
<b>Design Search Code</b>	241714
<b>Serial Number</b>	73727701
<b>Filing Date</b>	May 11, 1988
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	February 7, 1989
<b>Change In Registration</b>	CHANGE IN REGISTRATION HAS OCCURRED
<b>Registration Number</b>	1537609
<b>Registration Date</b>	May 2, 1989
<b>Owner</b>	(REGISTRANT) WINKELHORN, KARIN M. INDIVIDUAL UNITED STATES SUITE 25 3540 WEST

SAHARA AVENUE LAS VEGAS NEVADA 89102

**Assignment  
Recorded** ASSIGNMENT RECORDED  
**Attorney of  
Record** L. S. VAN LANDINGHAM, JR.  
**Type of Mark** SERVICE MARK  
**Register** PRINCIPAL  
**Affidavit Text** PARTIAL SECT 8 (6-YR).  
**Live/Dead  
Indicator** LIVE



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Serial Number: 73727701 Assignment Information

Registration Number: 1537609 Assignment Information

Mark



**NEVER PAY RETAIL!**

(words only): RETAIL NEVER PAY RETAIL!

Standard Character claim: No

Current Status: A partial Section 8 affidavit has been accepted.

Date of Status: 1995-12-18

Filing Date: 1988-05-11

Transformed into a National Application: No

Registration Date: 1989-05-02

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

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](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: 900 -File Repository (Franconia)

Date In Location: 2004-06-23

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. WINKELHORN, KARIN M.

Address:

WINKELHORN, KARIN M.  
SUITE 25 3540 WEST SAHARA AVENUE

LAS VEGAS, NV 89102

United States

**Legal Entity Type:** Individual

**Country of Citizenship:** United States

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**GOODS AND/OR SERVICES**

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**International Class:** 035

Cancelled, surrendered, or expired

**First Use Date:** 1987-12-31

**First Use in Commerce Date:** 1987-12-31

**Basis:** 1(a)

**International Class:** 042

TELEVISION SHOP-AT-HOME SERVICES

**First Use Date:** 1987-12-31

**First Use in Commerce Date:** 1987-12-31

**Basis:** 1(a)

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**ADDITIONAL INFORMATION**

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(NOT AVAILABLE)

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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1995-12-18 - Partial Section 8 (6-year) accepted

1995-04-26 - Section 8 (6-year) and Section 15 Filed

1989-05-02 - Registered - Principal Register

1989-02-07 - Published for opposition

1989-01-09 - Notice of publication

1989-01-07 - Notice of publication

1988-11-21 - Approved for Pub - Principal Register (Initial exam)

1988-10-03 - Communication received from applicant

1988-10-12 - Communication received from applicant

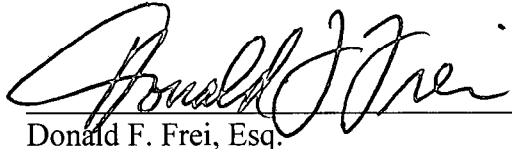
9. Based on the foregoing, U.S. Registration No. 1,537,609 is causing and will continue to cause injury and damage to Petitioner.

WHEREFORE, Petitioner believes that it is damaged by U.S. Registration No. 1,537,609 and respectfully petitions for cancellation thereof. The Commissioner is hereby authorized to charge the \$300.00 fee to cover cancellation of a registration in a single class and any underpayment of fees associated with this communication or credit any overpayment to Deposit Account No. 23-3000.

WHEREFORE, Petitioner, SmartBargains.com LP prays that U.S. Registration No. 1,537,609, be cancelled.

Respectfully submitted,

SMARTBARGAINS.COM LP



Donald F. Frei, Esq.

Sarah Otte Graber, Esq.

WOOD, HERRON & EVANS, L.L.P.

Attorneys for Petitioner

Date: November 3, 2005

2700 Carew Tower  
441 Vine Street  
Cincinnati, Ohio 45202-2917  
(513) 241-2324

K:\SMART26A\Petition for Cancellation.wpd



1988-08-05 - Non-final action mailed

1988-06-23 - Case file assigned to examining attorney

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**CORRESPONDENCE INFORMATION**

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**Correspondent**

L. S. VAN LANDINGHAM, JR. (Attorney of record)

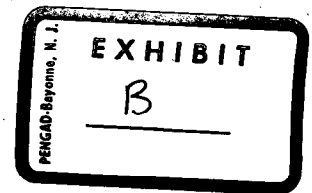
L. S. VAN LANDINGHAM, JR.

SUITE 507

2001 JEFFERSON DAVIS HIGHWAY

ARLINGTON, VA 22202

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Express Mail Label No. EV 536051498 US

Date of Deposit September 29, 2004

I hereby certify that this paper or fee 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 above and is addressed to the Commissioner for Trademarks, 2900 Crystal Dr., Arlington, VA 22202-3514.

Kenneth Eads  
Name of Person Mailing Paper or Fee

Kenneth Eads  
Signature of Person Mailing Paper or Fee

SERVICE MARK APPLICATION  
INTENT-TO-USE

MARK: NEVER PAY RETAIL

INTERNATIONAL CLASS: 35

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

Sir:

Applicant is SmartBargains.com LP, a limited partnership organized under the laws of the State of Delaware, located and doing business at 10 Milk Street, 10<sup>th</sup> Floor, Boston, MA 02108.

Applicant requests registration of the above-identified trademark 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:

Online retail store services and catalog, telephone and mail order services, featuring off-price, close-out, liquidation, and marked-down general merchandise,

footwear, headwear, clothing and accessories, jewelry, watches, luggage, sporting goods and equipment, home furnishings and decor, home improvement goods, bath linens and accessories, bed linens and accessories, china, crystal, silver, kitchen and dining appliances and accessories, electronic goods, toys, cameras, audio equipment, housewares, computers, telephones, camcorders, art and wall decor, fragrances, cosmetics, sunglasses, attache cases, briefcases, leather goods, furniture, telescopes, binoculars, video games, cookware, beverage ware, dinnerware, and cutlery, in International Class 35.

Applicant has a bona fide intention to use the mark in commerce on or in connection with the above-identified services.

The mark is presented in standard character format without claim to any particular font style, size, or color. (37 C.F.R. §2.52)

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/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation or association has the right to use the said mark in commerce, either in the identical form thereof or in such near resemblance thereto 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/her own knowledge are true and all statements made on information and belief are believed to be true.

The undersigned hereby appoints Bruce Tittel, Donald F. Frei, David J. Josephic, David S. Stallard, J. Robert Chambers, Gregory J. Lunn, Kurt L. Grossman, Clement H. Luken, Jr., Thomas J. Burger, Gregory F. Ahrens, Wayne L. Jacobs, Kurt A. Summe, Kevin G. Rooney, Keith R. Haupt, Theodore R. Remaklus, Thomas W. Humphrey, Scott A. Stinebruner, David H. Brinkman, Beverly A. Lyman, Ph.D., John D. Poffenberger, Thomas W. Flynn, Joseph R. Jordan, C. Richard Eby, David E. Pritchard, J. Dwight Poffenberger, Jr., Kathryn E. Smith, Kristi L. Davidson, P. Andrew Blatt, Ph.D., David E. Jefferies, John P. Davis, William R. Allen, Ph.D., Douglas A. Scholer, Brett A. Schatz, David W. Dorton, Sarah Otte Graber, Wesley L. Strickland, Steven W. Benintendi, Ph.D., and Randall S. Jackson, Jr. ; in care of Wood, Herron & Evans, L.L.P., 2700 Carew Tower, Cincinnati, Ohio 45202 (Telephone No. 513-241-2324), its attorneys with full power of substitution and revocation, to prosecute this application and to transact all business in connection therewith, and to receive the Certificate of Registration.

Please address all communication in connection with this application to:

Donald F. Frei, Esq.  
Wood, Herron & Evans, L.L.P.  
2700 Carew Tower  
441 Vine Street  
Cincinnati, OH 45202  
(513) 241-2324.

SMARTBARGAINS.COM LP

Date: 9/20/04

By: Marguerite Hill

Name: Marguerite J. Hill

Title: Secretary

## INTENT-TO-USE

Applicant: SmartBargains.com LP  
10 Milk Street, 10<sup>th</sup> Floor  
Boston, MA 02108.

For: Online retail store services, and catalog, telephone and mail order services, featuring off-price, close-out, liquidation, and marked-down general merchandise, footwear, headwear, clothing and accessories, jewelry, watches, luggage, sporting goods and equipment, home furnishings and decor, home improvement goods, bath linens and accessories, bed linens and accessories, china, crystal, silver, kitchen and dining appliances and accessories, electronic goods, toys, cameras, audio equipment, housewares, computers, telephones, camcorders, art and wall decor, fragrances, cosmetics, sunglasses, attache cases, briefcases, leather goods, furniture, telescopes, binoculars, video games, cookware, beverage ware, dinnerware, and cutlery, in International Class 35

NEVER PAY RETAIL

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

Examining Attorney: GOLD, BARBARA

Serial Number: 76/613566

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

*Sandra L. Meyer* 11/3/05  
Sandra L. Meyer November 3, 2005

Mark: NEVER PAY RETAIL  
Serial No.: 76/613,566  
Filed: September 30, 2004  
Applicant: SmartBargains.com LP  
Examining Attorney: Barbara A. Gold, Law Office 106

**RESPONSE TO OFFICIAL ACTION MAILED MAY 3, 2005**

COMMISSIONER FOR TRADEMARKS  
P.O. Box 1451  
Alexandria, VA 22313-1451

Sir:

This is a response to the Official Action mailed May 3, 2005.

Please amend the application as follows:

Delete the identification of services as filed, and substitute therefor the following:

**Class 35:** Online retail store services, telemarketing and mail order catalog services, featuring off-price, close-out, liquidation, and marked-down general merchandise,

footwear, headwear, clothing, jewelry, watches, luggage, sporting goods, home furnishings and decor, home improvement goods, bath linens, bed linens, china, crystal, silver, kitchen and dining appliances, electronic goods, toys, cameras, audio equipment, housewares, computers, telephones, camcorders, art and wall decor, fragrances, cosmetics, sunglasses, attaché cases, briefcases, leather goods, furniture, telescopes, binoculars, video games, cookware, beverage ware, dinnerware, and cutlery.

Please also amend the "Applicant's Name" and "Applicant's Entity Type" as follows:

SmartBargains.com LP, a partnership organized under the laws of Delaware, composed of SmartBargains, Inc., a Delaware corporation, and SB.com, Inc., a Delaware corporation.

Please enter the following disclaimer in the application:

No claim is made to the exclusive right to use "RETAIL" apart from the mark as shown.

The Examiner has objected to the identification of services and proposed certain acceptable language in lieu thereof. Applicant has reviewed the Examiner's proposal and, finding it accurate and complete, has substituted the Examiner's proposed identification of the services for that which was originally filed. Accordingly, it is believed that the identification of services is now clarified and no longer objectionable.



Serial No. 76/613,566  
Law Office 106  
Examiner Barbara A. Gold

The Examiner has also requested that the composition of Applicant, a limited partnership, be identified, which Applicant has now done. Thus, it is believed that this basis for objection is no longer appropriate.

The Examiner has also required a disclaimer of the descriptive word "RETAIL" apart from the mark as shown, which Applicant has also done. Hence, this requirement of the Examiner has now been satisfied.

The Examiner has refused to register the mark on the basis that it is merely descriptive. Applicant has, on even date hereof, filed an Amendment to Allege Use. Assuming the Amendment to Allege Use is acceptable, Applicant requests that the application be amended to request registration on the Supplemental Register. Accordingly, it is requested that the words "Principal Register" be amended to "Supplemental Register."

The Examiner has also refused registration of Applicant's mark under Section 2(d) in view of U.S. Registration No. 1,537,609. Applicant disagrees with the Examiner that the marks are confusingly similar. The dominant element of the cited mark is in the nature of an international road sign consisting of a circle with an angled

line across the diameter thereof located on top of the word RETAIL, which appears in relatively large letters. The phrase, NEVER PAY RETAIL!, in relatively small letters, appears below, as well as across, the angled diameter line. While a portion of the cited mark includes the words "NEVER PAY RETAIL!," these words are certainly not the dominant component of the mark, and, in fact, pale by comparison to the international sign consisting of a circle with an angled line across the diameter thereof.

Applicant also wishes to note that television shop-at-home services are clearly not the same as Applicant's claimed services. The respective services are delivered through entirely different channels of trade.

For the foregoing reasons, it is not believed that the mark of the cited application, when used in connection with the services for which it is registered, are confusingly similar to Applicant's mark when used in connection with its services.

Applicant has on even date hereof, filed a Petition for Cancellation of the cited registration based on Applicant's belief that the registrant has abandoned the mark covered by the registration. A copy of the Petition for Cancellation is enclosed.

Serial No. 76/613,566  
Law Office 106  
Examiner Barbara A. Gold

Applicant requests that examination of its application be suspended pending the outcome of the Cancellation Proceeding.

Applicant has attempted to respond to every issue raised by the Examiner. In the event that Applicant has not done so, the Examiner is requested to promptly contact the undersigned so that any remaining issues can be immediately resolved.

Applicant does not believe that any fees are due in connection with this submission. However, if such fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to deposit account 23-3000.

Respectfully submitted,

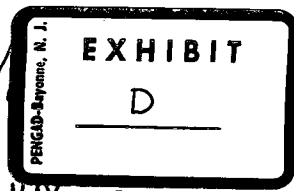
WOOD, HERRON & EVANS, L.L.P.

Date 2 Nov. 2005

By   
Donald F. Frei, Reg. No. 21,190

2700 Carew Tower  
Cincinnati, OH 45202  
(513) 241-2324

ROA Due 11/03/



UNITED STATES PATENT AND TRADEMARK OFFICE

MAY - 3 2005

2005 MAY - 6 PM 12: 09

WOOD, HERRON & EVANS

SERIAL NO: 76/613566

APPLICANT: SmartBargains.com LP

CORRESPONDENT ADDRESS:

DONALD F. FREI  
WOOD, HERRON & EVANS, L.L.P.  
2700 CAREW TOWER  
441 VINE STREET  
CINCINNATI, OH 45202



RETURN ADDRESS:

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

MARK: NEVER PAY RETAIL

CORRESPONDENT'S REFERENCE/DOCKET NO: SMART-26A-10

CORRESPONDENT EMAIL ADDRESS:

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

**RESPONSE TIME LIMIT:** TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

RE: Serial Number 76/613566

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

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. §1052(d). TMEP §704.02.

Refusal to Register - Merely Descriptive ✓

The mark is a combination of terms that describe applicant's promise to it's customers that they will never pay retail prices for the goods applicant sells, which are offered at substantial discounts. The examining attorney refuses registration on the Principal Register because the proposed mark merely describes the services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); TMEP §§1209 *et seq.*

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP §1209.01(b).

It is not necessary that a term describe all of the purposes, functions, characteristics or features of the services to be merely descriptive. It is enough if the term describes one attribute of the services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). TMEP §1209.01(b).

### Refusal to Register - Confusingly Similar ✓

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified services, so resembles the mark in U.S. Registration No. **1,537,609**, as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 *et seq.* See the enclosed registration.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 416 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978). TMEP §§1207.01 *et seq.*

The phrase, "NEVER PAY RETAIL," is dominant and identical in spelling, sound and meaning. The punctuation and design features in the registration are subordinate elements that do not diminish the common commercial impression created by the dominant phrase. In addition, the marks are used in connection with related promotional services and retail store, mail order catalog, and telemarketing services. Confusion as to source is likely.

The services of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). TMEP §1207.01(a)(i).

The examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). TMEP §§1207.01(d)(i).

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

**Partnership Designation Unacceptable** ✓

Applicant must amend the "Applicant's Name" and "Applicant's Entity Type" sections of the application to identify itself as follows, if accurate: "SmartBargains.com LP, a partnership organized under the laws of Delaware, composed of \_\_\_\_\_." Applicant must list all general partners and their national citizenship (for individuals) or the U.S. state or foreign country of their organization or incorporation, as appropriate. 37 C.F.R. §2.32(a)(3)(iii); TMEP §§803.03(b) and 803.04.

**Disclaimer Required** ✓

The applicant must disclaim the descriptive wording "**RETAIL**" apart from the mark as shown. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a). The wording is merely descriptive of applicant's online and mail order retail store services. *See attached definitions.*

The computerized printing format for the Office's *Trademark Official Gazette* requires a standardized format for a disclaimer. TMEP §1213.08(a)(i). The following is the standard format used by the Office:

No claim is made to the exclusive right to use "**RETAIL**" apart from the mark as shown.

*See In re Owatonna Tool Co.*, 231 USPQ 493 (Comm'r Pats. 1983).

**Recitation of Services Amendment Required** ✓

The recitation of services is unacceptable as indefinite. The applicant must amend the recitation to specify the common commercial names of the services and arrange them by proper classification in ascending numerical order by international class. If there is no common commercial name, the applicant must describe the nature of the services and their particular field. TMEP section 1301.05. The applicant may access the Office's *Acceptable Identification of Goods and Services Manual* at: <http://www.uspto.gov/web/offices/TAC/doc/gsmmanual>.

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 services that are not within the scope of the services recited in the present identification.

The applicant may adopt the following recitation, if accurate:

**Class 35: Online retail store services, telemarketing and mail order catalog services, featuring off-price, close-out, liquidation, and marked-down general merchandise, footwear, headwear, clothing, jewelry, watches, luggage, sporting goods, home furnishings and decor, home improvement goods, bath linens, bed linens, china, crystal, silver, kitchen and dining appliances, electronic goods, toys, cameras, audio equipment, housewares, computers, telephones, camcorders, art and wall decor, fragrances, cosmetics, sunglasses, attaché cases,**

briefcases, leather goods, furniture, telescopes, binoculars, video games, cookware, beverageware, dinnerware, and cutlery.

**The wording, "accessories" and "equipment," is indefinite and must be defined by identifying the common commercial names of the goods.**

### **Multiple Class Requirements**

If applicant prosecutes this application as a combined, or multiple-class application, then applicant must comply with each of the following for those services based on <an intent to use the mark in commerce under Trademark Act Section 1(b)/a foreign registration under Trademark Act Section 44(e)/an intent to use the mark under Trademark Act Section 1(b) and/or a foreign registration under Trademark Act Section 44(e)>:

- (1) Applicant must list the services by international class with the classes listed in ascending numerical order. TMEP § 1403.01; and
- (2) Applicant must submit a filing fee for each international class of services not covered by the fee already paid. 37 C.F.R. §2.86(a)(2); TMEP §§810.01 and 1403.01.

### **NOTICE: FEE CHANGE**

Effective January 31, 2005 and pursuant to the Consolidated Appropriations Act, 2005, Pub. L. 108-447, the following are the fees that will be charged for filing a trademark application:

- (1) \$325 per international class if filed electronically using the Trademark Electronic Application System (TEAS); or
- (2) \$375 per international class if filed on paper

These fees will be charged not only when a new application is filed, but also when payments are made to add classes to an existing application. If such payments are submitted with a TEAS response, the fee will be \$325 per class, and if such payments are made with a paper response, the fee will be \$375 per class.

The new fee requirements will apply to any fees filed on or after January 31, 2005.

### **NOTICE: TRADEMARK OPERATION RELOCATION**

The Trademark Operation has relocated to Alexandria, Virginia. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

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

Applicants, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at <http://www.uspto.gov/teas/index.html>.

/Barbara A. Gold/  
Attorney  
Law Office 106  
571/ 272-9165  
571/ 273-9106 (fax)  
[barbara.gold@uspto.gov](mailto:barbara.gold@uspto.gov)

**HOW TO RESPOND TO THIS OFFICE ACTION:**

- **ONLINE RESPONSE:** You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://www.uspto.gov/teas/index.html> and follow the instructions, but if the Office Action issued via email you must wait 72 hours after receipt of the Office Action to respond via TEAS).
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above and include the serial number, law office number and examining attorney's name in your response.

**STATUS OF APPLICATION:** To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

**VIEW APPLICATION DOCUMENTS ONLINE:** Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

**GENERAL TRADEMARK INFORMATION:** For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.**



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Dictionary Search[Home](#) [About](#) [Browse Dictionaries](#) [Customize](#)**Free College Search Tool**Search over 3,600 colleges and universities at [CollegeBoard.com](#)Word or phrase: ☒ Find definitions ☐ Find translations ☐ Search all dictionariesJump to: [General](#), [Art](#), [Business](#), [Computing](#), [Medicine](#), [Miscellaneous](#), [Religion](#), [Science](#), [Slang](#), [Sports](#), [Tech](#), [Phrases](#)**We found 27 dictionaries with English definitions that include the word *retail*:***Tip: Click on the first link on a line below to go directly to a page where "retail" is defined.*➤ **General** (21 matching dictionaries)

1. [retail](#) : Merriam-Webster's Online Dictionary, 10th Edition [[home](#), [info](#)]
2. [retail](#) : Compact Oxford English Dictionary [[home](#), [info](#)]
3. [retail](#) : Encarta® World English Dictionary, North American Edition [[home](#), [info](#)]
4. [retail](#) : Cambridge International Dictionary of English [[home](#), [info](#)]
5. [retail](#) : The Wordsmyth English Dictionary-Thesaurus [[home](#), [info](#)]
6. [retail](#) : The American Heritage® Dictionary of the English Language [[home](#), [info](#)]
7. [retail](#) : Infoplease Dictionary [[home](#), [info](#)]
8. [retail](#) : Dictionary.com [[home](#), [info](#)]
9. [retail \(v.\)](#) : Online Etymology Dictionary (word origins) [[home](#), [info](#)]
10. [retail](#) : UltraLingua English Dictionary [[home](#), [info](#)]
11. [retail](#) : Cambridge Dictionary of American English [[home](#), [info](#)]
12. [Retail](#) : Wikipedia, the Free Encyclopedia [[home](#), [info](#)]
13. [Retail](#) : Online Plain Text English Dictionary [[home](#), [info](#)]
14. [retail](#) : Webster's Revised Unabridged, 1913 Edition [[home](#), [info](#)]
15. [retail](#) : Rhymezone [[home](#), [info](#)]
16. [retail](#) : AllWords.com Multi-Lingual Dictionary [[home](#), [info](#)]
17. [retail](#) : Webster's 1828 Dictionary [[home](#), [info](#)]

Quick definitions (*retail*)

- **noun**: the selling of goods to consumers; usually in small quantities and not for resale
- **verb**: sell on the retail market
- **verb**: be sold at the retail level (Example: "These gems retail at thousands of dollars each")
- **adjective**: selling or related to selling direct to the consumer (Example: "Retail trade")
- **adverb**: at a retail price (Example: "I'll sell it to you retail only")
- Word origin info is available.

Test Your Skills --

17. [retail](#) : Webster's 1828 Dictionary [[home](#), [info](#)]
18. [retail](#) : The New Dictionary of Cultural Literacy [[home](#), [info](#)]
19. [RETAIL](#) : 1911 edition of the Encyclopedia Britannica [[home](#), [info](#)]
20. [retail](#) : WordNet 1.7 Vocabulary Helper [[home](#), [info](#)]
21. [retail](#) : LookWAYup Translating Dictionary/Thesaurus [[home](#), [info](#)]

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➡ **Business** (3 matching dictionaries)

22. [Retail](#) : MoneyGlossary.com [[home](#), [info](#)]
23. [retail](#) : INVESTORWORDS [[home](#), [info](#)]
24. [Retail](#) : Bloomberg Financial Glossary [[home](#), [info](#)]

➡ **Computing** (1 matching dictionary)

25. [Retail](#) : Game Dictionary [[home](#), [info](#)]

➡ **Tech** (2 matching dictionaries)

26. [retail](#) : AUTOMOTIVE TERMS [[home](#), [info](#)]
27. [RETAIL](#) : LANL Clean Coal Technology Compendium [[home](#), [info](#)]

Phrases that include **retail**: [retail price index](#), [retail chain](#), [retail investor](#), [retail price](#), [retail store](#), [more...](#)

Words similar to **retail**: [retailed](#), [retailer](#), [retailing](#), [more...](#)

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Print: May 2, 2005

73727701

**DESIGN MARK****Serial Number**

73727701

**Status**

PARTIAL SECTION 8 ACCEPTED

**Word Mark**

RETAIL NEVER PAY RETAIL!

**Standard Character Mark**

No

**Registration Number**

1537609

**Date Registered**

1989/05/02

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

**Owner**WINKELHORN, KARIN M. INDIVIDUAL UNITED STATES SUITE 25 3540 WEST  
SAHARA AVENUE LAS VEGAS NEVADA 89102**Goods/Services**Class Status -- SECTION 8 - CLASS(ES) IN MULT. CL. REG.. IC 042. US  
100 101. G & S: TELEVISION SHOP-AT-HOME SERVICES. First Use:  
1987/12/31. First Use In Commerce: 1987/12/31.**Goods/Services**Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: [ PROMOTING  
THE SALE OF GOODS AND SERVICES OF OTHERS THROUGH THE DISTRIBUTION OF  
PRINTED MATERIAL AND AUDIO-VIDEO MEDIA ]. First Use: 1987/12/31.  
First Use In Commerce: 1987/12/31.**Filing Date**

1988/05/11

**Examining Attorney**

ZEE, WAI BUI

**Attorney of Record**

**Print: May 2, 2005**

**73727701**

L. S. VAN LANDINGHAM, JR.



**NEVER PAY RETAIL!**



I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

TRADEMARK/SERVICE MARK  
INTENT TO USE

Kathi Howard 11-3-05  
Kathi Howard Date

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

Mark: NEVER PAY RETAIL  
Applicant: SmartBargains.com LP  
Serial No.: 76/613,566  
Filing Date: September 30, 2004

**AMENDMENT TO ALLEGE USE UNDER 37 CFR §2.76**  
**WITH DECLARATION**

Madam:

Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 1015 *et seq.*, as amended). One specimen showing the mark as used in commerce for each class is submitted with this Amendment.

Applicant is using the mark in interstate commerce in connection with the following goods:

Online retail store services, telemarketing and mail order catalog services, featuring off-price, close-out, liquidation, and marked -down general merchandise, footwear, headwear, clothing, jewelry, watches, luggage, sporting goods, home furnishings and decor, home improvement goods, bath linens, bed linens, china, crystal, silver, kitchen and dining appliances, electronic goods, toys, cameras, audio equipment, housewares, computers, telephones, camcorders, art and wall decor, fragrances, cosmetics, sunglasses, attache cases, briefcases, leather goods, furniture, telescopes, binoculars, video games, cookware, beverage ware, dinnerware, and cutlery, in International Class 35.

Date of first use of the mark anywhere: November 1, 2004

Date of first use of the mark in commerce  
which the U.S. Congress may regulate: November 1, 2004

Specify type of commerce: Interstate

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/she is properly authorized to execute this Amendment to Allege Use on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered; the trademark is now in use in commerce; and that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

SMARTBARGAINS.COM LP

Date: 11/1/05

By: Marguerite J Hill

Name: Marguerite J. Hill

Title: Vice President, Legal Counsel

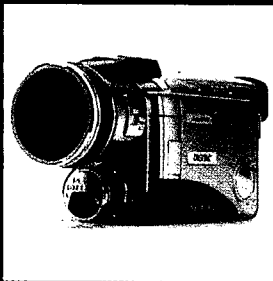
Fall 2004

SmartBargains.com

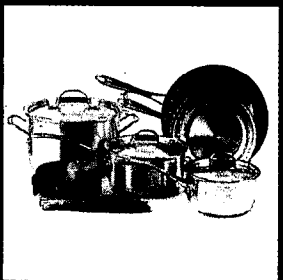
# TOP BRANDS SMART PRICES



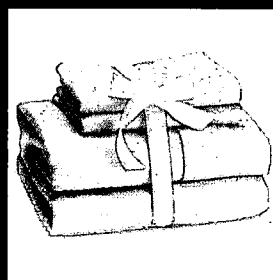
Closeout  
Prices



Never  
Pay  
Retail



Limited  
Quantities



**SPECIMEN**

**International Class 35**

Specimens accompanying Amendment to Allege Use of SmartBargains.com LP, for the mark  
NEVER PAY RETAIL, mailed to the U.S. Patent and Trademark Office on **November 3, 2005**



## SmartBargains.com®

*Top Brands. Smart Prices.*

Bedding & Bath • Women's Accessories • Men's Apparel • Home Furnishings  
Electronics • Kitchen & Dining • Jewelry & Watches • Luggage • Shoes  
Home Improvement • Art & Wall Decor • Women's Apparel • Toys & More





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## Trademark Assignment Abstract of Title

**Total Assignments: 1**

**Serial #:** 73727701      **Filing Dt:** 05/11/1988

**Reg #:** 1537609

**Reg. Dt:** 05/02/1989

**Registrant:** WINKELHORN, KARIN M.

**Mark:** RETAIL NEVER PAY RETAIL!

**Assignment: 1**

**Reel/Frame:** 1411/0086      **Received:** 12/13/1995

**Recorded:** 11/20/1995

**Pages:** 4

**Conveyance:** ASSIGNS THE ENTIRE INTEREST

**Assignor:** WINKELHORN, KARIN M.K.

**Exec Dt:** 10/10/1995

**Entity Type:** INDIV.

**Citizenship:** NONE

**Entity Type:** INDIVIDUAL

**Citizenship:** UNITED STATES

**Assignee:** GOLDSTEIN, SUE

STE. 101 1508 E. BELTLINE ROAD  
CARROLLTON, TEXAS 75006

**Correspondent:** VINSON & ELKINS L.L.P.

W. DAVID LEE, ESQ.  
2500 FIRST CITY TOWER  
1001 FANNIN STREET  
HOUSTON, TX 77002-6760

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