

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: G-III Leather Fashions, Inc.
Serial No.: 88/255,552
Filed: January 9, 2019
Mark: MARC NEW YORK
Examiner: Sahar Nasserghodsi
Law Office: 115

REQUEST FOR RECONSIDERATION

In response to the Final Office Action dated September 6, 2019, Applicant respectfully requests that the Examining Attorney reconsider the refusal to register the above-identified application (“Application”) in view of the arguments and evidence presented in Applicant’s Response to Office Action filed on August 15, 2019.

Refusal to Register Based on Likelihood of Confusion

The Examining Attorney has refused registration under Trademark Act 2(d), 15 U.S.C. § 1052(d), of Applicant’s mark MARC NEW YORK for the goods “Eyewear; Sunglasses” in Class 9, based on a likelihood of confusion with the marks in the following registrations:

U.S. Reg. No. 3,699,162 for the mark MARC BY MARC JACOBS for the goods “Spectacles, sunglasses and spectacle cases” in Class 9;

U.S. Reg. No. 4,559,716 for the mark MARC BY MARC JACOBS for the goods “Eyeglasses; sunglasses; eyeglass cases; sunglass cases” in Class 9; and

U.S. Reg. No. 4,735,403 for the mark MARC BY MARC JACOBS for the services “Retail store services and on-line retail store services featuring clothing, footwear, headwear, handbags, leather goods, luggage, belts, eyewear, jewelry, watches, books and stationery items, cases for mobile phones, laptop carrying cases, headphones, protective cases, covers and sleeves for tablet computers, fragrances, cosmetics, skin and personal care products, hair accessories and ornaments” in Class 35.

Applicant maintains its position that there is no likelihood of confusion between the marks at issue because: 1) Applicant's previous registration for MARC NEW YORK for eyewear coexisted with the cited registrations for multiple years without confusion; 2) Applicant's registrations for MARC NEW YORK for other goods and services coexist with Registrant's registrations for MARC BY MARC JACOBS for identical or similar goods and services; and 3) the number and nature of similar marks in use for similar goods indicates MARC NEW YORK can peacefully coexist among third party marks containing the element "MARC" for eyewear.

Based on the arguments and evidence presented by Applicant in its response filed on August 15, 2019, it is clear that consumers will distinguish Applicant's MARC NEW YORK from the cited MARC BY MARC JACOBS.

Request for Suspension of the Application

Applicant requests suspension of the Application pursuant to TMEP § 716.02(e) because the cited Reg. No. 3,699,162 is in the grace period for filing a §71 affidavit. In addition, the cited Reg. No. 4,559,716 is due for a §8 affidavit on July 1, 2020. Accordingly, Applicant requests that the Application be suspended until disposition of the cited Reg. Nos. 3,699,162 and 4,559,716.

Dated: March 6, 2020

Respectfully submitted,

/s/ Chandler Stephens

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