

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

<b>In re Application of:</b>	:	
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<b>IW Apparel, LLC (formerly W-D Apparel Company, LLC)</b>	:	<b>Trademark Examining Attorney:</b>
	:	
	:	<b>Michele-Lynn Swain</b>
<b>Mark: LADY LIBERTY</b>	:	<b>Law Office 116</b>
<b>Serial No.: 88/094112</b>	:	
<b>Filing Date: August 27, 2018</b>	:	
	:	

**APPLICANT’S REQUEST FOR RECONSIDERATION**

IW Apparel, LLC (formerly W-D Apparel Company, LLC) (“Applicant”), by and through its undersigned counsel, hereby requests the Examining Attorney’s reconsideration and withdraw of the final refusal issued in the Office Action of September 14, 2020 (“Final Office Action”), on the above-captioned trademark application for LADY LIBERTY (“Applicant’s Mark”).

**I. INTRODUCTION**

The Examining Attorney issued a Final Office Action against Applicant’s Mark, on the continued basis that Applicant’s Mark is likely to cause confusion with the mark LADY LIBERTY, the subject of Registration No. 5880404 (the “Cited Registration”). The Examining Attorney has maintained refusal on the basis that Applicant’s Mark and the Cited Registration are identical and while the respective marks are in different classes for different products, the products are purportedly related.

Applicant respectfully continues to disagree with the Examining Attorney’s conclusion that a likelihood of confusion exists between Applicant’s Mark and the mark in the Cited Registration and requests withdrawal of the §2(d) refusal for the reasons set forth in the Arguments section below.

## II. ARGUMENT

The sole focus of the Examining Attorney's continued refusal to pass for registration Applicant's Mark is that Applicant's Mark and the Cited Registration are identical marks, and while both marks are contained in different classes, it is the Examining Attorney's position that the goods of the respective parties are related. However, Applicant respectfully submits that the Examining Attorney overlooks the entire argument that Applicant set forth that it is the owner of several registrations of essentially the same mark, in the same class, for apparel goods, and all of which registered prior to the Cited Registration.

Applicant has long held several registered trademarks for substantially the same mark, LIBERTY, in International Class 25, for apparel, with use extending for over a century and current registrations extending back to 1978, with first use being in 1915:

a. LIBERTY<sup>®</sup> (Registration No. 1084058) (1978; first use 1915) for "Men's and boy' overalls" in International Class 25;

b. LIBERTY<sup>®</sup> (Registration No. 3940998) (2011; first use 1996) for "clothing, namely, overalls" in International Class 25;

c. LIBERTY & Design<sup>®</sup> (Registration No. 5272198) (2017; first use 1927) for "Men's, Women's and Children's clothing, namely overalls" in International Class 25; and

d. LIBERTY EST 1912 EST<sup>®</sup> (Registration No. 5675523) (2019; first use 2014), "EST 1912 EST" disclaimed for "Men's, Women's and Children's clothing, namely, denim overalls, workwear, namely overalls" in International Class 25.

("Applicant's Registrations<sup>1</sup>"). Applicant's Mark is, therefore, a continuation of its long-standing "LIBERTY" marks that cover apparel, here particularly directed to women. Given this situation, there is no likelihood of confusion as between Applicant's Mark and the Cited Registration. See *In re Strategic Partners, Inc.*, 102 USPQ 2d 1397 (2012). Indeed, two of

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<sup>1</sup> Copies of the TSDR Reports downloaded from the USPTO are of record in Applicant's Response to the Office Action filed August 20, 2020.

Applicant's prior registrations are over five years old and Applicant's Registrations are substantially the same as in the applied-for application. This situation can be a basis to weigh against finding there is a likelihood of confusion. See *Inn at St. John's*, 126 USPQ2d 1742, 1746 (citing *In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012)).

Finally, the Examining Attorney raises the issue that the goods of the respective parties, while in different classes, and are for different products, are nonetheless related goods. It is surprising, therefore, that even though the goods are different and in different classes, there were no citations of Applicant's Registrations raised against the Cited Registration prosecution. Given the analysis of the Final Office Action, the addition of "LADY" should not have been the distinguishing factor in the prosecution of the Cited Registration.

### **III. CONCLUSION**

In view of the foregoing, Applicant respectfully requests that the Examining Attorney withdraw refusal to register Applicant's Mark.