

Response to Office Action

This is in response to the Office Action issued June 21, 2019.

Section 2(d) - No Likelihood of Confusion

The Examining Attorney has preliminarily refused to register the subject mark, STERLING PACIFIC, in Class 9 only ("Applicant's Mark"), based on a likelihood of confusion with Registration No. 0948511 for the mark "STERLING OPTICAL" and Registration No. 1565677 for the mark "STERLING" (the "Cited Marks"). Applicant believes that the refusal is traversed for the reasons set forth below.

First, according to the PTO records, the two Cited Marks are owned by different companies. If they can coexist with other, there is no reason why Applicant's Mark, which is even more dissimilar, cannot likewise coexist.

Second, the very existence of one of the Cited Marks is called into question. Notably, the initial renewal deadline for the mark "STERLING" (Reg. No. 1565677) passed more than a month ago, with no filing. The mark is in the grace period and believed likely to lapse.

Third, the Cited Marks have coexisted at one time in the PTO with third-party registrations for marks comprising the term "STERLING", for the identical goods (sunglasses), which supports Applicant's view the confusion is unlikely with Applicant's Mark:

BRITISH STERLING (Reg. No. 2736903)

JOHN STERLING (Reg. No. 3261229)

JOHN STERLING (Reg. No. 3261222)

Copies of TESS printout are attached as Exhibit A.

Amended Identification of Goods

The Examining Attorney has accepted the subject application in Classes 14 and 25 and has request clarification of certain goods in Class 18. Applicant requests that the description for Class 18 be amended as follows:

“Luggage, suitcases, briefcases, wallets, credit card holders, backpacks, leather bags, duffel bags, canvas shopping bags” in Class 18

Conclusion

Applicant requests that the refusal be withdrawn and that the application be accepted for publication in each Class.

Respectfully submitted,

DAVIS & GILBERT LLP

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NYS Bar Member

EXHIBIT A



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TSDR ASSIGN Status TTAB Status (Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark BRITISH STERLING

Goods and Services (CANCELLED) IC 009. US 021 023 026 036 038. G & S: Eyeglasses, reading eyeglasses, eyeglass frames, optical frames and sunglasses. FIRST USE: 20020321. FIRST USE IN COMMERCE: 20020321

Mark Drawing Code (1) TYPED DRAWING

Serial Number 78193490

Filing Date December 11, 2002

Current Basis 1A

Original Filing Basis 1A

Published for Opposition April 22, 2003

Registration Number 2736903

Registration Date July 15, 2003

Owner (REGISTRANT) Finanz St. Honore, B.V. CORPORATION NETHERLANDS Herengracht 548 Amsterdam NETHERLANDS 1017 CG

(LAST LISTED OWNER) LASALLE BUSINESS CREDIT, LLC FINANCIAL INSTITUTION 720 South Powerline Road Suite D Deerfield Beach FLORIDA 33442

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Jeffrey B. McGovern, Esq.

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BRITISH" APART FROM THE MARK AS SHOWN

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator DEAD

Cancellation Date February 20, 2010

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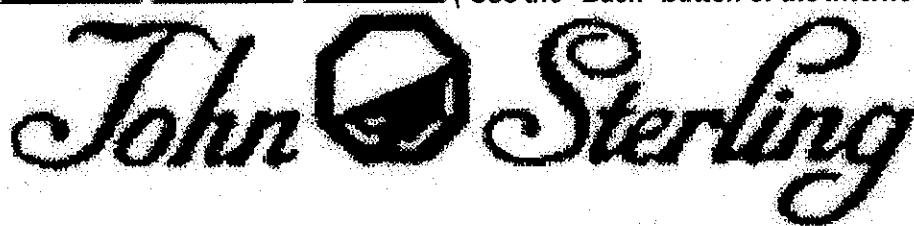
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Word Mark
Goods and
Services

JOHN STERLING

(CANCELLED) IC 003. US 001 004 006 050 051 052. G & S: Soaps, perfumery, essential oils for personal use, cosmetics, hair lotions, dentifrices

(CANCELLED) IC 008. US 023 028 044. G & S: Cutlery, forks and spoons, razors and side arms, not including fire arms, namely, swords and hunting knives

(CANCELLED) IC 009. US 021 023 026 036 038. G & S: Corrective eyeglasses, sunglasses, anti-glare glasses, protective goggles, pince-nez, spectacle cases, spectacle frames, spectacle lenses

(CANCELLED) IC 014. US 002 027 028 050. G & S: Precious metals and their alloys and goods in precious metals or coated therewith, namely, figurines; jewelry, precious stones, semiprecious stones, bijouterie; horological and chronometric instruments

(CANCELLED) IC 016. US 002 005 022 023 029 037 038 050. G & S: Paper and articles made from paper, namely, paper bags, boxes and cake decorations; cardboard and articles made from cardboard, namely, hangtags and boxes; writing instruments; diary books; office requisites, namely, staplers and envelope sealing machines; printed matter, namely, printed forms; paper-cuffers

(CANCELLED) IC 018. US 001 002 003 022 041. G & S: Leather and imitation leather and articles made from leather and imitation leather, namely, leather cases, briefcases and purses; animal skins; trunks and traveling bags; bags, namely, leather bags, all-purpose carrying bags, gym bags; umbrellas, parasols and walking sticks

(CANCELLED) IC 025. US 022 039. G & S: Clothing, namely, shirts, t-shirts, bras and pajamas; footwear, headgear, namely, hats; belts, ties, scarves, foulards, gloves

(CANCELLED) IC 028. US 022 023 038 050. G & S: Games, namely, board games, playing cards and card games; playthings, namely, plush toys, tents, and wands; gymnastic articles, namely, gymnastic apparatus; sporting goods, namely, baseball bats, golf balls and soccer balls

(ABANDONED) IC 033. US 047 049. G & S: Alcoholic beverages, namely, rum and wines

Mark Drawing
Code

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

Design Search
Code

26.15.21 - Polygons that are completely or partially shaded

Serial Number

79010805

Filing Date

April 19, 2005

Current Basis

66A

Original Filing
Basis

66A

Published for Opposition June 20, 2006
Registration Number 3261222
International Registration Number 0766818
Registration Date July 10, 2007
Owner (REGISTRANT) John Sterling of London Limited CORPORATION UNITED KINGDOM 20-22 Bedford Row London, WC1R 4JS UNITED KINGDOM
Attorney of Record Mark A. Steiner,
Type of Mark TRADEMARK
Register PRINCIPAL
Other Data The name JOHN STERLING does not identify a living individual.
Live/Dead Indicator DEAD
Cancellation Date October 1, 2011

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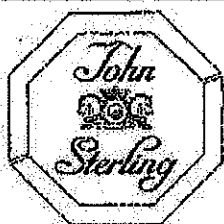
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Word Mark JOHN STERLING

Goods and Services (CANCELLED) IC 003. US 001 004 006 050 051 052. G & S: Soaps, perfumery, essential oils for personal use, cosmetics, hair lotions, dentifrices

(CANCELLED) IC 008. US 023 028 044. G & S: Cutlery, forks and spoons, razors and side arms, not including fire arms, namely, swords and hunting knives

(CANCELLED) IC 009. US 021 023 026 036 038. G & S: Corrective eyeglasses, sunglasses, anti-glare glasses, protective goggles, pince-nez, spectacle cases, spectacle frames, spectacle lenses

(CANCELLED) IC 014. US 002 027 028 050. G & S: Precious metals and their alloys and goods in precious metals or coated therewith, namely, figurines; jewelry, precious stones, semiprecious stones, bijouterie; horological and chronometric instruments

(CANCELLED) IC 016. US 002 005 022 023 029 037 038 050. G & S: Paper and articles made from paper, namely, paper bags, boxes and cake decorations; cardboard and articles made from cardboard, namely, hangtags and boxes; writing instruments; diary books; office requisites, namely, staplers and envelope sealing machines; printed matter, namely, printed forms; paper-cutters

(CANCELLED) IC 018. US 001 002 003 022 041. G & S: Leather and imitation leather and articles made from leather and imitation leather, namely, leather cases, briefcases and purses; animal skins; trunks and traveling bags; bags, namely, leather bags, all-purpose carrying bags, gym bags; umbrellas, parasols and walking sticks

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(CANCELLED) IC 028. US 022 023 038 050. G & S: Games, namely, board games, playing cards and card games; playthings, namely, plush toys, tents, and wands; gymnastic articles, namely, gymnastic apparatus; sporting goods, namely, baseball bats, golf balls and soccer balls

(ABANDONED) IC 033. US 047 049. G & S: Alcoholic beverages, namely, rum and wines

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

Design Search Code 03.05.01 - Horses
03.05.16 - Heads of horses, donkeys, zebras
24.01.02 - Shields or crests with figurative elements contained therein or superimposed thereon
24.11.02 - Crowns open at the top
26.15.01 - Polygons as carriers or as single or multiple line borders
26.15.03 - Incomplete polygons and polygons made of broken or dotted lines; Polygons (incomplete); Polygons made with broken lines

Serial Number 79013753

Filing Date April 19, 2005
Current Basis 66A
Original Filing Basis 66A
Published for Opposition July 18, 2006
Registration Number 3261229
International Registration Number 0766817
Registration Date July 10, 2007
Owner (REGISTRANT) John Sterling of London Limited CORPORATION UNITED KINGDOM 20-22 Bedford Row London, WC1R 4JS UNITED KINGDOM
Attorney of Record Mark A. Steiner
Description of Mark The mark consists of the words JOHN STERLING in fanciful characters on two lines with a design containing two horse heads facing to the outside in the middle within a circle and underneath a crown, all within an octagon border.
Type of Mark TRADEMARK
Register PRINCIPAL
Other Data The name "JOHN STERLING" in the mark does not identify a living individual.
Live/Dead Indicator DEAD
Cancellation Date October 1, 2011

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