

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

In re application of : MATE 12  
Serial No. : 88570941  
For : remarkable.legal  
Examiner : MUNN LEWIS, LAKEISHA S  
Law Office : 105

**RESPONSE TO OFFICE ACTION DATED 11/12/2019**

This is responsive to Office Action dated 11/12/2019. The Applicant respectfully requests that the application be reconsidered.

**BACKGROUND**

Applicant Xu, Ming seeks registration of U.S. Serial No.88570941 for MATE 12 in relation to "A-shirts; Abayas; Adhesive bras; Adult novelty gag clothing item, namely, socks; After ski boots; Aikido uniforms; Albs; American football bibs; Anglers' shoes; Ankle boots; Ankle socks; Anklets; Anoraks; Anoraks; Anti-perspirant socks; Anti-sweat underclothing; Anti-sweat underwear; Apparel for dancers, namely, tee shirts, sweatshirts, pants, leggings, shorts and jackets; Apres-ski shoes; Aprons; Aqua shoes; Artificial flower headdresses; Ascots; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic footwear; Athletic jackets; Athletic pants; Athletic shirts; Athletic shoes; Athletic shorts; Athletic skirts; Athletic sweaters; Athletic tights; Athletic uniforms; Babies' pants; Babies' trousers; Babushkas; Baby bibs not of paper; Baby bodysuits; Baby

bottoms; Baby doll pyjamas; Baby layettes for clothing; Baby tops; Balaclavas; Ball gowns; Ballet shoes; Ballet slippers; Balloon pants; Ballroom dancing shoes; Ballroom dancing uniforms; Bandanas; Bandeau tops; Bandeaux; Barber smocks; Baseball caps; Baseball caps and hats; Baseball shoes; Baseball uniforms; Baselayer bottoms; Baselayer tops; Basketball shoes; Basketball sneakers; Bath robes; Bath sandals; Bath slippers; Bathing caps; Bathing costumes; Bathing costumes for women; Bathing suits; Bathing suits for men; Bathing trunks; Bathrobes; Beach cover-ups; Beach coverups; Beach footwear; Beach shoes; Beachwear; Beanies; Bed jackets; Belts; Belts for clothing; Belts made from imitation leather; Belts made of leather; Belts made out of cloth; Belts of textile; Belts that are designed to accommodate pregnancy size changes; Berets; Bermuda shorts; Bib overalls; Bib overalls for hunting; Bib shorts; Bib tights; Bibs for babies, sleeved, not of paper; Bibs not of paper; Bibs, not of paper; Bicycle gloves; Bicycling gloves; Biketards; Bikinis; Birding vests; Blazers; Bloomers; Blouses; Blousons; Blue jeans; Board shorts; Boardshorts; Boas; Boat shoes; Boat socks; Boaters; Bodices; Bodies being underclothing; Body linen; Body shapers; Body shirts; Body stockings; Body suits; Bodysuits; Boleros; Bolo ties; Bomber jackets; Bonnets; Boot accessories, namely, fitted decorative covers for boots; Boot cuffs; Boot uppers; Booties; Boots; Boots for motorcycling; Boots for sport; Bottoms as clothing; Bow ties; Bowling shoes; Boxer briefs; Boxer shorts; Boxing shoes; Boxing shorts; Bra extenders; Bra strap cushions; Bra strap pads; Braces as suspenders; Bralettes; Bras; Brassieres; Breeches; Breeches for wear; Bridal garters; Bridesmaid dresses; Briefs; Briefs as underwear; Brogue shoes; Bucket caps; Bucket hats; Burkas; Business wear, namely, suits, jackets, trousers, blazers, blouses, shirts, skirts, dresses and footwear; Bustiers; Bustle holder bands for obi (obiage); Bustles for obi-knots (obiage-shin); Button down shirts; Button-front aloha shirts; Caftans; Cagoules; Camiknickers; Camisettes; Camisoles; Camouflage gloves; Camouflage jackets; Camouflage pants;

Camouflage shirts; Camouflage vests; Camp shirts; Canvas shoes; Cap peaks; Cap visors; Capelets; Capes; Capes for use in salons and barber shops; Capri pants; Capris; Caps being headwear; Caps with visors; Cardigans; Cargo pants; Cassocks; Cat suits; Catsuits; Chadors; Chappals; Chaps; Chasubles; Chef coats; Chef hats; Chef pants; Chef shirts; Chemises; Chemisettes; Cheongsams (Chinese gowns); Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; Children's and infants' apparel treated with fire and heat retardants, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; Children's and infants' cloth bibs; Children's cloth eating bibs; Children's headwear; Children's underwear; Choir robes; Christening gowns; Christening robes; Clam diggers; Cleats for attachment to sports shoes; Climbing boots; Climbing footwear; Climbing shoes; Cloaks; Cloche hats; Clogs; Cloth bibs; Cloth bibs for adult diners; Cloth bibs for use by senior citizens or physically- or mentally-challenged persons; Clothing extension used to extend the normal size range of clothing items to accommodate pregnancy size changes; Clothing for athletic use, namely, padded pants; Clothing for athletic use, namely, padded shirts; Clothing for athletic use, namely, padded shorts; Clothing for babies, toddlers and children, treated with fire and heat retardants, namely, pajamas, jackets, shirts, pants, jumpers; Clothing for wear in judo practices; Clothing for wear in wrestling games; Clothing items, namely, adhesive pockets that may be affixed directly to the body as a decorative piece of clothing with utility; Clothing items, namely, adhesive pockets that may be affixed directly to the inside of clothing for storage and safekeeping of personal items; Clothing items, namely, blindfolds worn over the eyes; Clothing items, namely, gags worn over the mouth; Clothing layettes; Clothing shields, namely, pads applied to the underarms of shirts, blouses and sweaters; Clothing wraps; Clothing, namely, arm warmers; Clothing, namely, base layers; Clothing, namely, cowls and smoke ring scarves; Clothing, namely, crops; Clothing, namely, folk costumes; Clothing, namely, hand-warmers;

Clothing, namely, khakis; Clothing, namely, knee warmers; Clothing, namely, maternity bands; Clothing, namely, neck tubes; Clothing, namely, neck warmers; Clothing, namely, thobes; Clothing, namely, wrap-arounds; Coats; Coats for men and women; Coats made of cotton; Coats of denim; Cobblers' aprons; Cocktail dresses; Coifs; Collar guards for protecting clothing collars; Collar liners for protecting clothing collars; Collar protector pads for application to clothing collars; Collar protector strips for application to clothing collars; Collared shirts; Collars; Combative sports uniforms; Combinations; Competitors' numbers of textile; Corduroy pants; Corduroy shirts; Corduroy trousers; Corselets; Corsets being clothing; Corsets being foundation clothing; Corsets being underclothing; Costumes for use in children's dress up play; Costumes for use in role-playing games; Costumes for use in the amusement industry; Coveralls; Coverups; Cowboy hats; Cravates; Cravats; Creepers; Crew neck sweaters; Crew necks; Crop pants; Crop tops; Cross-country gloves; Cross-country mittens; Cuffs; Culottes; Cumberbunds; Custom made to measure suits for men and women; Cycling bib shorts; Cycling caps; Cycling shoes; Cycling shorts; Cyclists' jerseys; Dance costumes; Dance pants; Dance shoes; Dance slippers; Deck-shoes; Denim jackets; Denim jeans; Denim pants; Denims; Detachable collars; Detachable neckpieces for kimonos (haneri); Disposable slippers; Disposable underwear; Do rags for use as headwear; Down jackets; Down suits; Drawers as clothing; Dress pants; Dress shields; Dress shirts; Dress shoes; Dress straps; Dress suits; Dresses; Dresses made from skins; Dresses that may also be used as towels; Dressing gowns; Dressing gowns and bath robes; Drivers as shoes; Driving gloves; Dry suits; Duffle coats; Dungarees; Dust coats; Dusters in the nature of coats; Ear bands; Ear muffs; Ear warmers; Ear warmers being clothes; Earbands; Earmuffs; Embossed soles and heels of rubber or of plastic materials; Espadrilles; Esparto shoes or sandals; Eternity scarves; European football bibs; Evening coats; Evening dresses; Evening gowns; Eyeshades as headwear; Fabric belts; Fascinator

hats; Fashion hats; Fedoras; Fezzes; Fichus; Fight shorts for mixed martial arts or grappling; Fingerless gloves; Fingerless gloves as clothing; Finished textile linings for garments; Fishermen's jackets; Fishing shirts; Fishing vests; Fishing waders; Fitted heel protectors for shoes; Fitted shoe or boot covering to protect the shoes or boot from water or other damage; Fitted swimming costumes with bra cups; Fleece bottoms; Fleece jackets; Fleece pullovers; Fleece shorts; Fleece tops; Fleece vests; Flight suits; Flip flops; Flip-flops for use as footwear; Flood pants; Flower headdresses; Foam pedicure slippers; Foot volleyball shoes; Football boots; Football boots and studs therefor; Football shoes; Football uniforms; Footies; Footwear; Footwear; Footwear for men; Footwear for men and women; Footwear for track and field athletics; Footwear for women; Footwear made of vinyl; Footwear made of wood; Footwear not for sports; Footwear uppers; Footwear, namely, pumps; Footwear, namely, rubbers; Footwear, namely, work boots; Formalwear, namely, dresses, gowns, tuxedos, dinner jackets, trousers and footwear; Foul weather gear; Foulards; Foundation garments; Foundation garments worn around the midsection or thighs to keep the stomach in and create a slimming effect; Frocks; Full-length kimonos (nagagi); Fur cloaks; Fur coats; Fur coats and jackets; Fur hats; Fur jackets; Fur muffs; Fur stoles; Furs being clothing; G-strings; Gaberdines; Gaiter straps; Gaiters; Gaiters of leather; Galoshes; Garrison caps; Garter belts; Garters; Gauchos; Gift packages sold as a unit consisting primarily of a sweatshirt and also including a photo frame, a coffee mug, and a tote bag; Gilets; Girdles; Gloves; Gloves as clothing; Gloves for apparel; Gloves for personal hand conditioning use; Gloves including those made of skin, hide or fur; Gloves with conductive fingertips that may be worn while using handheld electronic touch screen devices; Golf caps; Golf cleats; Golf pants, shirts and skirts; Golf shirts; Golf shoes; Golf shorts; Golf spikes; Golf trousers; Goloshes; Gowns; Graphic T-shirts; Greatcoats; Gym boots; Gym pants; Gym shorts; Gym suits; Gymnastic shoes; Hairdressing capes; Half-boots; Halloween costumes; Halloween

costumes and masks sold in connection therewith; Halter tops; Handball shoes; Hat frames; Hat liners; Hats; Hats for infants, babies, toddlers and children; Head scarves; Head sweatbands; Head wear; Head wraps; Headbands; Headbands against sweating; Headbands for clothing; Headwear; Heavy coats; Heavy jackets; Heel inserts; Heel pieces for shoes; Heelpieces for footwear; Heelpieces for stockings; Heels; Helmet liners being headwear; Henley shirts; High rain clogs (ashida); Hijabs; Hiking boots; Hiking jackets; Hiking trousers; Hip-guards especially made for fishing; Hockey shoes; Hooded pullovers; Hooded sweat shirts; Hooded sweatshirts; Hoodies; Hoods; Hoods; Horse-riding boots; Horse-riding pants; Hosiery; Housecoats; Hunting boot bags; Hunting boots; Hunting jackets; Hunting pants; Hunting shirts; Hunting vests; Infant and toddler one piece clothing; Infant sleepers being clothing; Infant wear; Infant wearable blankets; Infants' shoes and boots; Infants' trousers; Infantwear; Infinity scarves; Inner soles; Insoles; Insoles; Insoles for footwear; Jacket liners; Jackets; Jackets and socks; Jackets incorporating backpacks; Jandals; Japanese footwear of rice straw (waraji); Japanese sleeping robes (nemaki); Japanese split-toed work footwear (jikatabi); Japanese style clogs and sandals; Japanese style sandals (zori); Japanese style sandals of felt; Japanese style sandals of leather; Japanese style socks (tabi covers); Japanese style socks (tabi); Japanese style wooden clogs (geta); Japanese toe-strap sandals (asaura-zori); Jeans; Jeggings; Jeggings, namely, pants that are partially jeans and partially leggings; Jerkins; Jerseys; Jodhpurs; Jogging outfits; Jogging pants; Jogging suits; Judo suits; Judo uniforms; Jump suits; Jumper dresses; Jumpers; Jumpsuits; Kaftans; Karate suits; Karate uniforms; Keffiyehs (Yashmaghs); Kendo outfits; Kerchiefs; Kilts; Kimonos; Kippahs (yarmulkes); Knee highs; Knee-high stockings; Knickers; Knit bottoms; Knit dresses; Knit face masks; Knit jackets; Knit shirts; Knit skirts; Knit tops; Knitted baby shoes; Knitted caps; Knitted gloves; Knitted underwear; Knot caps; Knotted caps; Korean outer jackets worn over basic garment; Korean topcoats; Korean ?traditional tops

as clothing (Jeogori); Lab coats; Lace boots; Ladies' boots; Ladies' suits; Ladies' underwear; Leather belts; Leather boots; Leather coats; Leather harnesses worn by people as clothing; Leather hats; Leather headwear; Leather jackets; Leather pants; Leather shirts; Leather shoes; Leather skirts; Leather slippers; Leather vests; Leg shapers; Leg shielding device, attachable to and detachable from a person's pants, comprised of padding to shield the legs from flying debris when mowing with a string trimmer; Leg warmers; Leg-warmers; Leggings; Leggins; Leisure shoes; Leisure suits; Leotards; Leotards and tights for women, men and children of nylon, cotton or other textile fibers; Light-reflecting coats; Light-reflecting jackets; Lingerie; Lingerie accessories, namely, removable silicone breast enhancer pads used in a bra; Live flower headdresses; Liveries; Loafers; Long jackets; Long johns; Long sleeve pullovers; Long sleeved vests; Long underwear; Long-sleeved shirts; Lounge pants; Loungewear; Low wooden clogs (hiyori-geta); Low wooden clogs (koma-geta); Maillots; Maniples; Mankinis; Mantillas; Mantles; Mantles; Martial arts uniforms; Martial arts uniforms, namely, gis; Masquerade costumes; Masquerade costumes and masks sold in connection therewith; Maternity bras; Maternity leggings, namely, leggings featuring built-in maternity bands; Maternity lingerie; Maternity sleepwear; Men's and women's jackets, coats, trousers, vests; Men's dress socks; Men's socks; Men's suits; Men's suits, women's suits; Men's underwear; Metal fittings for Japanese style wooden clogs; Military boots; Millinery, namely, fascinators; Miniskirts; Mittens; Mittens modified to cover the hand and an animal leash handle or other loop; Mixed martial arts suits; Moccasins; Mock turtle-neck sweaters; Mocknecks; Moisture-wicking sports bras; Moisture-wicking sports pants; Moisture-wicking sports shirts; Money belts; Monokinis; Morning coats; Motorcycle gloves; Motorcycle jackets; Motorcycle rain suits; Motorcyclist boots; Mountaineering boot liners; Mountaineering boots; Mountaineering shoes; Mufflers as neck scarves; Muffs; Mukluks; Mules; Muscle tops; Muu muus; Neck bands; Neck gaiters; Neck

scarfs; Neck scarves; Neckerchiefs; Neckerchieves; Neckties; Neckwear; Negligees; Night gowns; Night shirts; Nightcaps; Nightdresses; Nightgowns; Nighties; Nightshirts; Nightwear; Nipple covers, namely, pasties; Niqabs; Non-disposable cloth training pants; Non-slip socks; Non-slip soles for footwear; Novelty headwear with attached wigs; Nurse dresses; Nurse overalls; Nurse pants; Nursing bras; Nursing shoes; Obis; One piece garment for infants and toddlers; One-piece garments for children; One-piece play suits; Open-necked shirts; Outdoor gloves; Outdoor mittens; Outer jackets; Over coats; Over shirts; Over-trousers; Overalls; Overalls for use in salons and barber shops; Overcoats; Overshoes; Oxford shoes; Padded jackets; Padding jackets; Pajama bottoms; Pajamas; Pajamas treated with fire and heat retardants; Pantaloons; Panties; Panties, shorts and briefs; Pants; Pantsuits; Pantyhose; Paper aprons; Paper hats for use as clothing items; Paper shoes used when going through metal detectors to keep feet and socks clean; Paraments; Pareos; Pareu; Pareus; Parkas; Parts of clothing, namely, gussets for tights, gussets for stockings, gussets for bathing suits, gussets for underwear, gussets for leotards and gussets for footlets; Parts of clothing, namely, underarm gussets; Pashmina shawls; Patient slippers; Pea coats; Peacoats; Pedal pushers; Pedicure sandals; Pedicure slippers; Peignoirs; Pelerines; Pelisses; Perspiration absorbent strap to be used in the bill of a hat; Perspiration absorbent underwear clothing; Petti-pants; Petticoats; Pinafore dresses; Pinafores; Pinnies in the nature of scrimmage vests for use in sports; Pique shirts; Plastic aprons; Plastic baby bibs; Plastic slippers used in the airport environment when going through security to keep feet and socks clean, dry and sanitary; Plastic socks used in the airport environment when going through security to keep feet clean, dry and sanitary; Platform shoes; Play suits; Pleated skirts; Pleated skirts for formal kimonos (hakama); Plimsolls; Plus fours; Pocket kerchiefs; Pocket squares; Pockets for clothing; Polo knit tops; Polo shirts; Polymer custom cushioned shoe inserts for primarily non-orthopedic purposes; Ponchos; Posing suits for bodybuilding



competitions; Pram suits; Prayer shawls; Protective metal members for shoes and boots; Protective neck and arm guards made of neoprene or other materials to prevent wetsuit chafing; Pullovers; Pumps as footwear; Puttees; Puttees and gaiters; Pyjamas; Pyjamas; Quilted vests; Race number belts that hold a paper number on the race participant's front or back during competition; Rain boots; Rain coats; Rain hats; Rain jackets; Rain slickers; Rain suits; Rain trousers; Rain wear; Raincoats; Rainproof jackets; Rainwear; Ramie shirts; Rash guards; Rash vests; Ready-made linings being parts of clothing; Redingotes; Removable breast enhancer pads used in bras or swimsuits; Removable collars; Reversible jackets; Riding boots; Riding coats; Riding gloves; Riding jackets; Riding shoes; Robes; Rompers; Ruanas; Rubber and latex costumes for use in the fashion industry; Rubber shoes; Rubber soles for jikatabi; Rubbers; Rugby shirts; Rugby shoes; Rugby shorts; Rugby tops; Running costumes; Running pads that strap onto shoes; Running shoes; Running suits; Russian felted boots (Valenki); Sabots; Safari jackets; Sailor suits; Salopettes; Sandal-clogs; Sandals; Sandals and beach shoes; Sarees; Saris; Sarongs; Sash bands for kimono (obi); Sashes; Sashes for wear; Scarfs; Scarves; School uniforms; Scrimmage vests; Scrub tops and pants not for surgical purposes; Sedge hats (suge-gasa); Serapes; Shampoo capes; Shapewear; Shawls; Shawls; Shawls and headscarves; Shawls and stoles; Sheepskin coats; Sheepskin jackets; Shell jackets; Shifts as clothing; Shirt fronts; Shirt inserts, namely, dickies; Shirt yokes; Shirt-jacs; Shirts; Shirts and short-sleeved shirts; Shirts for infants, babies, toddlers and children; Shirts for suits; Shoe accessories, namely, fitted decorative covers for shoes; Shoe covers for use when wearing shoes; Shoe inserts for primarily non-orthopedic purposes; Shoe inserts for primarily non-orthopedic purposes that also deodorize shoes; Shoe liners; Shoe soles; Shoe soles for repair; Shoe straps; Shoe uppers; Shoes; Shoes for protection of airline passengers' feet during airport security screening; Shoes with hook and pile fastening tapes; Short overcoat for kimono (haori); Short petticoats;

Short sets; Short trousers; Short-sleeve shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Shortalls; Shorts; Shoulder scarves; Shoulder wraps; Shoulder wraps for clothing; Shower caps; Shrugs; Silk scarves; Singlets; Skapris; Skating outfits; Ski and snowboard shoes and parts thereof; Ski bibs; Ski boot bags; Ski boot cases; Ski boot liners; Ski boots; Ski gloves; Ski jackets; Ski masks; Ski pants; Ski suits; Ski suits for competition; Ski trousers; Ski wear; Skiing shoes; Skirt suits; Skirts; Skirts and dresses; Skiwear; Skooters; Skorts; Skull caps; Skullies being headwear; Slacks; Sleep masks; Sleep pants; Sleep shirts; Sleeping garments; Sleepsuits; Sleepwear; Sleepwear treated with fire and heat retardants; Sleeved or sleeveless jackets; Sleeveless jerseys; Sleeves worn separate and apart from blouses, shirts and other tops; Sliding shorts; Slip-on shoes; Slipovers; Slipper socks; Slipper soles; Slippers; Slips being underclothing; Small hats; Smocks; Smoking jackets; Snap crotch shirts for infants and toddlers; Sneakers; Snow boarding suits; Snow boots; Snow pants; Snow suits; Snowboard boot liners; Snowboard boots; Snowboard gloves; Snowboard jackets; Snowboard mittens; Snowboard pants; Snowboard trousers; Soccer bibs; Soccer boots; Soccer shoes; Sock suspenders; Socks; Socks and stockings; Soles; Soles for footwear; Soles for Japanese style sandals; Spats; Spiked running shoes; Sport coats; Sport shirts; Sport stockings; Sports bra; Sports bras; Sports caps and hats; Sports jackets; Sports jerseys; Sports jerseys and breeches for sports; Sports over uniforms; Sports overuniforms; Sports pants; Sports shirts; Sports shirts with short sleeves; Sports shoes; Sports singlets; Sports vests; Stiletto heels; Stocking caps; Stocking hats; Stocking suspenders; Stockings; Stoles; Strapless bras; Strapless brassieres; Straps for bras; Stretch pants; String fasteners for haori (haori-himo); Studs for football boots; Stuff jackets; Suede jackets; Suit coats; Suits; Suits of leather; Sun leggings; Sun sleeves; Sun visors being headwear; Sundresses; Sunsuits; Surf wear; Suspender belts; Suspender belts for men; Suspender belts for women; Suspenders; Suspenders; Swaddling clothes; Sweat bands; Sweat jackets;

Sweat pants; Sweat shirts; Sweat shorts; Sweat suits; Sweat-absorbent socks; Sweat-absorbent stockings; Sweat-absorbent underclothing; Sweat-absorbent underwear; Sweatbands; Sweaters; Sweatpants; Sweatshirts; Socks; Sweatsuits; Swim caps; Swim suits; Swim trunks; Swim wear; Swim wear for gentlemen and ladies; Swimming caps; Swimming caps; Swimming costumes; Swimming trunks; Swimsuits; Swimwear; T-shirts; Tabards; Taekwondo uniforms; Tailleurs; Tallitot; Tallits; Tams; Tangas being swimwear; Tangas being underwear; Tank tops; Tank-tops; Tankinis; Tap pants; Tap shoes; Teddies being underclothing; Tee shirts; Tee-shirts; Tennis dresses; Tennis shoes; Tennis wear; Thermal socks; Thermal underwear; Thigh high stockings; Thong beachwear; Thong footwear; Thong sandals; Thong underwear; Ties as clothing; Tightening-up strings for kimonos (datejime); Tights; Tips for footwear; Toboggan hats; Toboggan hats, pants and caps; Toe boxes; Toe caps; Toe socks; Toe straps for Japanese style sandals (zori); Toe straps for Japanese style wooden clogs; Togas; Tongue or pullstrap for shoes and boots; Top coats; Top hats; Topcoats; Tops as clothing; Toques; Torsettes; Track and field shoes; Track jackets; Track pants; Track suits; Tracksuits; Traction attachments for footwear; Training shoes; Training suits; Travel clothing contained in a package comprising reversible jackets, pants, skirts, tops and a belt or scarf; Trekking boots; Trekking jackets; Trekking trousers; Trench coats; Trews; Triathlon clothing, namely, triathlon tights, triathlon shorts, triathlon singlets, triathlon shirts, triathlon suits; Trouser socks; Trouser straps; Trousers; Trousers for sweating; Trousers of leather; Trunks being clothing; Tube dresses; Tube skirts; Tube tops; Tunics; Tuques; Turbans; Turtle neck shirts; Turtleneck pullovers; Turtleneck sweaters; Turtlenecks; Tutus; Tuxedo belts; Tuxedos; Twin sets; Under garments; Underarm clothing shields; Underclothes; Underclothing; Undergarment accessories, namely, removable silicone buttock enhancer pads; Undergarments; Undergarments, namely, waspies; Underpants; Undershirts; Undershirts for kimonos

(juban); Undershirts for kimonos (koshimaki); Underskirts; Underwear; Underwear, namely, boy shorts; Uniforms; Union suits; Unitards; Uppers for Japanese style sandals; Uppers of woven rattan for Japanese style sandals; Ushankas being headwear; V-neck sweaters; Valenki; Veils; Vest extenders; Vested suits; Vests; Vests for use in barber shops and salons; Viscous gel polymer sold as a component of finished custom cushioned footwear for non-orthopedic purposes and apparel; Visors being headwear; Volleyball jerseys; Volleyball shoes; Waist bands; Waist belts; Waist cinchers; Waist strings for kimonos (koshihimo); Waistband extender consisting of a button and button hole mounted on a strip of fabric that is inserted into the existing waistband of a garment; Waistbands; Waistcoats; Walking shorts; Warm up outfits; Warm up suits; Warm-up suits; Water repelling boots; Water repelling footwear; Water repelling leather boots; Water repelling leather shoes and boots; Water ski boot liners; Water socks; Waterproof boots; Waterproof footwear; Waterproof jackets and pants; Waterproof leather boots; Waterproof leather shoes; Waterproof leather shoes and boots; Waterskiing suits; Wearable blankets in the nature of blankets with sleeves; Wearable computers in the nature of activity trackers sold as integral components of running shoes; Wearable garments and clothing, namely, shirts; Wedding dresses; Wedding garters; Wedding gowns; Wedge sneakers; Wellington boots; Welts for boots and shoes; Welts for footwear; Wet suit gloves; Wet suits; Wet suits for water-skiing; Wet suits for water-skiing and sub-aqua; Wetsuits; Wetsuits for surfing; Wetsuits for water-skiing; Wimples; Wind coats; Wind pants; Wind resistant jackets; Wind shirts; Wind suits; Wind vests; Wind-jackets; Wind-resistant vests; Windbreakers; Windcheaters; Windjammers; Windshirts; Winter boots; Winter coats; Women's athletic tops with built-in bras; Women's ceremonial dresses; Women's clothing, namely, shirts, dresses, skirts, blouses; Women's foldable slippers; Women's hats and hoods; Women's shoes; Women's shoes, namely, foldable flats; Women's tops, namely, camis; Women's underwear; Wooden clogs; Wooden main bodies

of Japanese style wooden clogs; Wooden shoes; Wooden supports of Japanese style wooden clogs; Woollen socks; Woollen tights; Woolly hats; Work shoes and boots; Working overalls; Woven bottoms; Woven dresses; Woven or knitted underwear; Woven shirts; Woven skirts; Woven tops; Wrap belts for kimonos (datemaki); Wraparound skirts; Wrist bands as clothing; Wristbands as clothing; Wristbands containing a cooling substance to cool the wearer; Yoga pants; Yoga shirts; Yoga socks; Yoga tops; Zoot suits; Zori" in International Class 25. The Examining Attorney has refused registration of the mark.

The Examining Attorney alleges that the applied for mark is likely to be confused with the mark(s) listed below. Trademark Act Section 2(d), 15 U.S.C. § 1052(d); see TMEP § § 1207.01 et seq.

- U.S. Registration No. 5585893 for MATE THE LABEL covering "Bottoms as clothing; Dresses; Hoodies; Pants; Rompers; Sweatshirts; T-shirts; Tank tops; Jackets" in International Class 25.
- U.S. Registration No. 5747926 for MATES (and design) covering "Clothing, namely, t-shirts, polo shirts, hoods, jerseys, undershirts, sweat shirts, jackets, head scarves, bandanas, neckerchiefs; headwear; footwear; belts of leather" in International Class 25.
- U.S. Registration No. 5705872 for MATES (and design) covering "Clothing, namely, t-shirts, polo shirts, hoods, jerseys, undershirts, sweat shirts, jackets, head scarves, bandanas, neckerchiefs; headwear; footwear; belts of leather" in International Class 25.

**APPLICANT'S ARGUMENT THAT THE MARK PRESENTS NO LIKELIHOOD OF  
CONFUSION**

Applicant respectfully disagrees with the Examining Attorney's decision for the reasons discussed below.

**The Standard for Determining Likelihood of Confusion**

A determination of likelihood of confusion between two marks is determined on a case by case basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The Examining Attorney is to apply each of the applicable thirteen factors set out in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant DuPont factors as they relate to likelihood of confusion in this case are reviewed below.

**The similarity or dissimilarity of the marks in their entireties as to appearance, sound,  
connotation, and commercial impression;**

In comparing two trademarks for confusing similarity, the Examining Attorney must compare the marks for resemblances in sound, appearance and meaning or connotation. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Similarity in one respect - sight, sound, or meaning - does not support a finding of likelihood of confusion, even where the goods or services are identical or closely related. TMEP §1207.01(b)(i).

It has long been established under the "anti-dissection rule" that "the commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." *Estate of P. D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46, 64 L. Ed. 705, 40 S. Ct. 414 (1920). It violates the anti-dissection rule to focus on the "prominent" feature of a mark, ignoring other elements of the mark, in finding likelihood of confusion. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974). See *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 U.S.P.Q. 233 (C.C.P.A. 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."); *Sun-Fun Products, Inc. v. Suntan Research & Development, Inc.*, 656 F.2d 186, 213 U.S.P.Q. 91 (5th Cir. 1981) (the test is "overall impression," not a "dissection of individual features").

*1. No Explicit Rule that Likelihood of Confusion Applies Where Junior User's Mark Contains the Whole of Another Mark.*

There is no explicit rule that likelihood of confusion automatically applies where a junior user's mark contains in part the whole of another mark. See, e.g., *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (PEAK PERIOD not confusingly similar to PEAK); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972) (ALL CLEAR not confusingly similar to ALL); *In re Ferrero*, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973) (TIC TAC not confusingly similar to TIC TAC TOE); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 U.S.P.Q. 422 (C.C.P.A. 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); *In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364 (T.T.A.B. 1974) (there is no absolute rule that no one has the right to in-corporate the total mark of another as a part of one's own mark: MMI MENSWEAR not confusingly similar to MEN'S WEAR); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520 (T.T.A.B. 1975) (PROTEIN PLUS and PLUS not confusingly similar). See *Monsanto Co. v. CI-BA-GEIGY Corp.*, 191 U.S.P.Q. 173 (T.T.A.B. 1976) (use of portion of another's mark to indicate that defendant's product contains plaintiff's product held not likely to cause confusion). Even the use of identical dominant words or terms does not automatically mean that two marks are similar. *Luigino's Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark LEAN CUISINE was not confusingly similar to MICHELINA'S LEAN 'N TASTY though both products were similar low-fat frozen food items and both shared the dominant term "lean." Finally, "marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight." *In re Hearst*, 982 F.2d 493, 494 (Fed.Cir. 1992). In *Hearst*, Applicant registered VARGA GIRL for calendars and was refused



registration by the Trademark Trial and Appeal Board because of earlier registration of VARGAS for posters, calendars, and greeting cards. The Federal Circuit reversed the refusal on appeal. The higher court found that the Board inappropriately changed the mark by diminishing the portion of "girl." When the mark was reviewed in its entirety, there was no likelihood of confusion. Here, the marks share the term "MATE" in common but this common term is not enough to support a finding of likelihood of confusion, particularly where there are a number of differentiating factors.

## *2. Marks Differ in Sight, Sound, and Commercial Impression*



### *a. Marks Differ in Sight*

Where there is an addition of a distinctive element, as in a term or a design, or there is a significantly different display of the same terms, there is little likelihood of confusion. *First Savings Bank, F.S.B. v. First Bank Systems, Inc.*, 40 U.S.P.Q.2d 1865 (10th Cir. 1996) (no confusion between FIRST BANK and FIRST BANK SYSTEM (and design)). Likelihood of confusion is minimized where a design is used as part of a mark. *Harlem Wizards*, 952 F. Supp. at 1096 (citing *McCarthy* at §23:15[51]).

A visual examination of the literal elements of the conflicting marks supports a finding that they are different. Applicant's mark consists of the wording MATE 12. In contrast, Registrant's A, B and C mark

consists of MATE THE LABEL, MATES, and MATES. Given the significantly different literal elements discussed above, there is little likelihood of confusion.

*b. Marks Differ in Sound*

Here, the marks vary substantially in sound. Applicant's mark is pronounced with two syllable whereas Registrant's marks are pronounced with four syllables, and one syllables. As such, these marks sound little alike and have an entirely different phonetic profile.

However, even where two marks are phonetically similar, no likelihood of confusion exists if other differentiating factors can be established. See *National Distillers & Chemical Corporation v. William Grant and Sons, Inc.*, 505 F.2d 719 (finding that DUVET and DUET did not raise likelihood of confusion where other differentiating factors existed such as the term "duet" was a com-mon word whereas "duvet" was not). As stated above, the visual differences between Applicant's mark and the Registrant's mark provide one of many differentiating factors that do not support a claim of likelihood of confusion.

*c. Marks Differ in Commercial Impression*

The marks in this case vary substantially in commercial impression. Applicant's mark MATE 12, has a unique complexion to it, particularly because of the number 12. The number 12 has a whole variety of meanings to different people. If you think about it from a mathematical point of view the

number has a perfect number of divisors and the sum of its divisors is also a perfect number. Exhibit 1. Thus, MATE 12 for clothing might signify to some people the idea of perfect clothing for a mate.

Our lives are also surrounded by the number twelve as we use it on a daily basis, the number is notably the number of full lunations in a solar year, hence the number of months in a solar calendar, as well as the way we measure time. Exhibit 1. As a result, MATE 12 in relation to clothing can also communicate the idea of a fast fashion clothing line that will satisfy your seasonal clothing cravings.

The number 12 also has a profound religious and otherworldly symbolism, as it signifies in many systems the idea of perfection and order. This has played a significant role even on the justice system as we well know many commonwealth countries judge their citizens with 12 jurors. Thus, MATE 12 in relation to clothing could also inspire in consumers the idea of spirituality. After all, not everyone was selected by Jesus to be part of the 12 chosen students. Mate 12 could signify being one of those twelve mates.

Finally, a consumer most probably will entertain the idea that MATE 12 is all about chinese zodiac culture. The number 12 refers to the 12 animal types that assign to each individual unique characteristics in 12 year cycles. It's all about clothing for pairs that reference zodiac animals.

In contrast, Registrant's A, MATE THE LABEL, in relation to clothing gives the idea of a mate who made a label clothing line. It communicates a very bland idea, if you can call it that. On the other hand, Registrant's B and C, MATES for clothing, use of the plural version of the word MATE capitalizes on its pirate use history. In America, it seems relevant to state that MATES is well known to be language used back in the day by pirates, at least that is how it's portrayed by culture. Exhibit 2.

Thus, consumers will think of clothing with an aura of pirate camaraderie. Given the significant differences in commercial impressions, there is little likelihood of confusion between the marks.

**CONCLUSION**

For the reasons listed above, Applicant respectfully requests that the Examining Attorney should remove all refusals for the trademark MATE 12 (U.S. Serial No. 88570941) and approve the mark for publication.

Respectfully submitted:



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