

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.: 88508055

Examining Attorney: Meghan Reinhart

Trademark: ARRIVE

Law Office: 108

Applicant: Tumi, Inc.

Action Dated: October 2, 2019

RESPONSE TO OFFICE ACTION

This responds to the October 2, 2019 Office action issued with regard to the above-referenced application for ARRIVE (“Applicant’s Mark”).

REMARKS

Applicant seeks to register the trademark ARRIVE on the Principal Register for “Luggage; Suitcases; All-purpose carrying bags; Carry-on bags; Travelling bags; Backpacks; Handbags; Travel cases; Wallets; key cases; Luggage tags” in Class 18. The Examining Attorney has refused registration under Section 2(d) because of a likelihood of confusion with U.S. Registration No. 2945114 ARRIVAL, owned by Samsonite IP Holdings S.A.R.L. (“Registrant”). Applicant respectfully requests that the Office withdraw the refusal to register because, due to the years of co-existence between the parties’ respective marks without confusion and the dissimilarity of the parties’ channels of trade, confusion is unlikely. *See* Ex. 1, Consent Agreement.

Applicant asks that the Examining Attorney “give substantial weight” to the parties’ consent agreement, and withdraw the refusal. *See, e.g.*, TMEP § 1207.01(d)(viii). The Federal Circuit “has indicated that consent agreements should be given great weight, and that the USPTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest . . .” *Id.* (citing *In re Four Seasons Hotels Ltd.*, 26 USPQ2d 1071, 1072 (Fed.

Cir. 1993)) (reversing refusal to register where “the PTO postulated that confusion between the marks was likely” even though “the self-interests of applicant and registrant have caused them to enter into a consent agreement determining for themselves that confusion of their marks is unlikely.”). The Court of Customs and Patent Appeals stated as follows:

“[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won’t. A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.”

Id. (citing *In re E. I. du Pont de Nemours & Co.*, 177 USPQ 563, 568 (CCPA 1973)).

In February 2011, Applicant started selling luggage and related goods under the ARRIVE mark. Since this date, Applicant has sold products continuously under the ARRIVE mark. Never—in nearly 10 years in the marketplace—have consumers confused the source of Applicant’s ARRIVE products with Registrant’s ARRIVAL products, or vice versa. Ex. 1 at ¶ 1. This should come as no surprise as the respective marks are visually dissimilar, *id.* at ¶ 2, and the parties’ respective products travel in different channels. *Id.* at ¶ 3. The parties have considered the realities of the marketplace, and the respective marks and goods, and agree that the use and registration of Applicant’s ARRIVE mark is unlikely to lead to consumer confusion. *Id.* at ¶ 4. Consumer confusion is further unlikely because Applicant and Registrant have a common business relationship under the Samsonite Group of Companies. *Id.* In 2016, Registrant’s parent company Samsonite International S.A. (“Samsonite”) acquired Applicant’s parent, Tumi Holdings Inc. *See* Ex. 1 at 1. Samsonite owns all of both Applicant and Registrant. Therefore, in the unlikely event that consumer confusion should occur, the parties agree to take the necessary steps to mitigate against any confusion. *Id.* at ¶ 5.

Applicant respectfully requests that the Examining Attorney give preponderant weight to the attached Consent Agreement, withdraw the Section 2(d) refusal, and approve the Application for publication.

EXHIBIT 1

CONSENT AGREEMENT

This Consent Agreement (the "Agreement") is entered into as of January 6, 2020 (the "Effective Date"), by and between Samsonite IP Holdings S.A.R.L., a private limited liability company organized and existing under the laws of Luxembourg ("Samsonite"), and Tumi, Inc., a corporation organized and existing under the laws of New Jersey ("Tumi"). Samsonite and Tumi are referred to individually as a "Party" and collectively as the "Parties".

WHEREAS, Samsonite owns U.S. Trademark Registration No. 2945114 (the "Registration") for the trademark ARRIVAL for "luggage" in International Class 18 (the "Samsonite Goods").

WHEREAS, on July 10, 2019, Tumi filed U.S. Application Serial No. 88508055 (the "Application") for the trademark ARRIVE for "Luggage; Suitcases; All-purpose carrying bags; Carry-on bags; Travelling bags; Backpacks; Handbags; Travel cases; Wallets; key cases; Luggage tags" in International Class 18 (the "Tumi Goods").

WHEREAS, Tumi has been using the ARRIVE mark in connection with the Tumi Goods in United States commerce since at least as early as February 2011.

WHEREAS, in 2016 Samsonite's parent company, Samsonite International S.A., acquired Tumi's parent, Tumi Holdings Inc. Samsonite and Tumi therefore have a common business relationship under the Samsonite Group of Companies.

WHEREAS, the Registration was cited by the U.S. Patent and Trademark Office as a block to the registration of the Application.

WHEREAS, the Parties agree that their respective marks can coexist without causing deception, mistake, or a likelihood of confusion.

For the reasons set forth herein and for other good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, the Parties intending to be bound, hereby agree as follows:

1. No Actual Confusion. The Parties' respective goods have co-existed in the marketplace since at least as early as February 2011, and the Parties have found no evidence of confusion, deception or mistake in the marketplace.
2. Dissimilar Marks. The Parties' respective marks are sufficiently distinct such that the marks convey different overall commercial impressions.
3. Different Channels of Trade. The Parties' respective products travel in different channels such that the typical consumer of the Parties' respective goods are able to distinguish the sources of the respective goods.
4. No Likelihood of Confusion. The Parties have considered the realities of the marketplace and the Parties' respective marks and offerings, and believe that the use and

registration of the ARRIVE mark in connection with the Tumi Goods is unlikely to lead to consumer confusion with the use and subsisting registration of the ARRIVAL mark with the Samsonite Goods.

5. Further Actions. The Parties, which have a common business relationship under the Samsonite Group of Companies, will work together to take necessary steps to mitigate against any confusion between their respective marks, in the unlikely event that confusion should occur or become likely to occur in the future.

6. Consent to Use and Registration. Samsonite consents to Tumi's registration of the ARRIVE mark in connection with the Tumi Goods.

7. This Agreement may be executed in counterparts and signatures upon it may be exchanged and transmitted by electronic transmission, which counterparts and signatures shall be deemed to be originals constituting a single agreement and shall be deemed valid and binding.

IN WITNESS WHEREOF, the Parties have executed this Agreement as of the Effective Date.

SAMSONITE IP HOLDINGS S.A.R.L.

TUMI, INC.

By: 

By: 

Name: Richard A. Lamb

Name: Anne-Laure Bernard

Title: Director

Title: Assistant Secretary