

**Response to Office Action for
U.S. Trademark Application No. 88900461
ADELIA**

I. Section 2(d) Refusal – Class 25 Only

A. No Likelihood of Confusion with Cited Registration.

In the Office Action, the Examining Attorney refused registration for Applicant’s Class 25 goods under Section 2(d) due to alleged likelihood of confusion with the mark in U.S. Trademark Registration No. 5864918. As explained below, there is no likelihood of confusion, and the refusal regarding Class 25 should be withdrawn.

Application’s mark is the term ADELIA, and the Class 25 goods covered in this application are the following: “Clothing, namely, shirts, t-shirts, tank tops, sweatshirts, hoodies, sweaters, sweatpants, sweatsuits, pants, trousers, shorts, headwear, hats, beanies, caps being headwear, underwear, undershirts, underclothes, socks, stockings, jackets, coats, vests, athletic uniforms, leggings, base layers, body shapers, swimwear, footwear.”

The cited registration is for the following design mark (in which the term “adelia” is barely visible):



The cited registration does not cover any goods in Class 25 but instead covers goods in Classes 23, 24 and 26, all of which are distinguishable and unrelated to Applicant’s Class 25 goods.

Specifically:

1) The cited registrant’s “yarns and threads, for textile use” (in Class 23) are not related to Applicant’s “Clothing, namely, shirts, t-shirts, tank tops, sweatshirts, hoodies, sweaters, sweatpants, sweatsuits, pants, trousers, shorts, headwear, hats, beanies, caps being headwear, underwear, undershirts, underclothes, socks, stockings, jackets, coats, vests, athletic uniforms, leggings, base layers, body shapers, swimwear, footwear.” Consumers are not likely to believe that a company that uses a mark for “yarns and threads, for textile use” would use the same mark for clothing or footwear, or vice versa, because yarns and threads are a specific niche market, with the target consumers being those interested in weaving or knitting or otherwise making textiles (rather than ordinary consumers shopping for clothing or footwear). Also, yarns and threads for textile use are typically sold at craft stores and fabric stores rather than clothing or shoe stores.

2) Similarly, the cited registrant's Class 24 goods (all of which are textiles and fabrics) are not related to Applicant's "Clothing, namely, shirts, t-shirts, tank tops, sweatshirts, hoodies, sweaters, sweatpants, sweatsuits, pants, trousers, shorts, headwear, hats, beanies, caps being headwear, underwear, undershirts, underclothes, socks, stockings, jackets, coats, vests, athletic uniforms, leggings, base layers, body shapers, swimwear, footwear." Consumers are not likely to believe that a company that uses a mark for textiles and fabrics would use the same mark for clothing or footwear, or vice versa, because textiles and fabrics are a specific niche market, with the target consumers being those interested in weaving or knitting or otherwise making their own products out of textiles or fabric (rather than ordinary consumers shopping for clothing or footwear). Also, textiles and fabrics are typically sold at craft stores and fabric stores rather than clothing or shoe stores.

3) Similarly, the cited registrant's "dress fastenings; fastenings for clothing, namely, snap buttons, snap hooks, stud buttons, eyelets, loop fastening tape; buckles for clothing, lace and embroidery, Haberdashery ribbons and braid; buttons, hooks and eyes, safety pins and needles; artificial flowers" (in Class 26) are not related to Applicant's "Clothing, namely, shirts, t-shirts, tank tops, sweatshirts, hoodies, sweaters, sweatpants, sweatsuits, pants, trousers, shorts, headwear, hats, beanies, caps being headwear, underwear, undershirts, underclothes, socks, stockings, jackets, coats, vests, athletic uniforms, leggings, base layers, body shapers, swimwear, footwear." Artificial flowers are wholly unrelated to clothing and footwear, and consumers are not likely to believe that a company that uses a mark for fastenings, buckles, buttons, hooks and eyes and safety pins and needles would use the same mark for clothing or footwear, or vice versa. Fastenings, buckles, buttons, hooks and eyes, and safety pins and needles are readily distinguishable from clothing and footwear, and consumers are not likely to believe that the same source provides clothing and footwear in addition to fastenings, buckles, buttons, hooks and eyes, and safety pins and needles. Also, fastenings, buckles, buttons, hooks and eyes, and safety pins and needles are typically promoted and sold through trade channels that are different than the trade channels for clothing and footwear.

There are very few entities that provide fabrics in addition to finished clothing and footwear in U.S. commerce, and the Office Action mentions only three such entities (none of which appear to sell footwear). Furthermore, even in such instances, the entities often promote or sell fabrics and finished clothing/footwear through different channels and/or under different marks. For example, the Examining Attorney asserts that Ralph Lauren sells both fabric and finished clothing, but the webpage evidence attached to the Office Action illustrates that Ralph Lauren fabric is sold through the Ralph Lauren Home website at ralphlaurenhome.com (along with furniture, lighting, wallcovering, floorcovering, tabletop/accents, and bedding and bath items) whereas the Ralph Lauren clothing is sold through an entirely different website (ralphlauren.com). In sum: consumers are not accustomed to seeing the same entity use the same mark on fabrics as well as finished clothing or footwear; consumers are not accustomed to encountering the cited registrant's goods and Applicant's Class 25 goods in the same or overlapping trade channels; and consumers are not likely to mistakenly believe that a fabric bearing a particular mark originates from the same company as an article of clothing or footwear bearing the same mark.

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Based on the foregoing, there is no likelihood of confusion between the cited registration and Applicant's mark for Applicant's Class 25 goods. The cited registrant selected a particular design mark for particular goods in Classes 23, 24 and 26 and should not be granted protection that is so broad as to prohibit this application for non-overlapping, distinguishable goods in Class 25 that are typically sold to different consumers and through different trade channels.

Accordingly, Applicant respectfully requests that the Class 25 refusal be withdrawn and that this application be approved for publication. Thank you.