
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Maserati S.p.A.

Application No.: 79304454

Filing Date: November 2, 2020

Mark: MASERATI (Stylized) & Design

Classes: 03, 09, 12, 14, 16, 18, 25, 28, 35, 37

Examining Attorney: Leslie Ann Thomas-Riggs

Law Office: 125

APPLICANT'S RESPONSE TO OFFICE ACTION

Pursuant to 37 C.F.R. §2.62(a) and TMEP § 711, Applicant Maserati S.p.A. ("Applicant"), by and through its attorneys, respectfully submits this Response to Office Action (the "Response") regarding Application Serial No. 79304454 (the "Application") for the mark MASERATI (Stylized) & Design ("Applicant's Mark"). Applicant is responding to the Office Action dated March 23, 2021, and mailed from the USPTO to WIPO on March 25, 2021 (the "Office Action"). Applicant responds to each of the issues identified in the Office Action as follows:

I. **Description of Goods and Services**

In order to respond to and resolve the issues raised in the Office Action, and clarify its goods and services in light of the Section 2(d) refusal, Applicant respectfully requests that the services in the Application be amended as follows:

Class 03: Eau de cologne; toilet water; hair conditioners; joss sticks; massage candles for cosmetic purposes; mouthwashes, not for medical purposes; cosmetics; cosmetics for animals; cosmetic creams; shoe cream; dentifrices; deodorants for human beings or for animals; cleansers for intimate personal hygiene purposes, non-medicated; incense; after-shave lotions; hair lotions; lotions for cosmetic purposes; lip glosses; mascara; beauty masks; **cosmetic kits comprised primarily of cosmetics, lip stick, make-up**]; essential oils; oils for perfumes and scents; **fragrances, namely, potpourris**; cosmetic preparations for baths; cosmetic preparations for skin care; perfumery; make-up preparations; shaving preparations; **laundry pre-soak preparations**; sachets for perfuming linen; make-up removing preparations; perfumes; air fragrancing preparations; lipsticks; bath salts, not for medical purposes; tissues impregnated with make-up removing preparations; shaving soap;

cakes of toilet soap; **non-medicated soap**; shampoos; **non-medicated grooming preparations, namely, shampoos for pets**; dry shampoos; nail polish; breath freshening sprays; talcum powder, for toilet use; make-up

Class 09: Eyewear; pince-nez; anti-glare glasses; sunglasses; goggles for sports; smartglasses; eyeglasses; 3D spectacles; contact lenses; close-up lenses; **optics, namely, magnifying glasses**; optical lenses; spectacle lenses; **selfie lenses for cameras**; padlocks, electronic; magnets; eyeglass frames; smartwatches; **time recording devices, namely, time clocks**; electronic key fobs being remote control apparatus; projection screens; simulators for the steering and control of vehicles; smartphones; computer game software, recorded; computer game software, downloadable; subwoofers; downloadable ring tones for mobile phones; tablet computers; mouse pads; computer keyboards; cellular phones; **television apparatus, namely, televisions, satellite television receiving apparatus**; camcorders; video telephones; electronic agendas; **speed checking apparatus for vehicles, namely, speed indicators**; **navigation apparatus for vehicles in the nature of on-board computers**; **satellite navigational apparatus for vehicles**; **telecommunication apparatus in the nature of wireless receivers in the form of jewelry**; **cameras for photography**; **global positioning system (GPS) apparatus**; sound reproduction apparatus; vehicle radios; telephone apparatus; containers for contact lenses; eyeglass cases; ear pads for headphones; earpieces for remote communication; **anti-theft warning apparatus, namely, theft alarms**; batteries, electric; scales; binoculars; bags adapted for laptops; **connected bracelets, namely, instruments for measuring length**; encoded identification bracelets, magnetic; directional compasses; pocket calculators; battery chargers; chargers for electric accumulators; encoded key cards; video game cartridges; protective helmets; protective helmets for sports; eyeglass chains; **blank USB flash drives**; cinematographic cameras; cell phone straps; laptop computers; pedometers; covers for smartphones; eyeglass cords; digital photo frames; covers for tablet computers; **encryption devices, namely, electronic security token in the nature of a fob-like device used by an authorized user of a computer system to facilitate authentication**]; **electric igniting apparatus for igniting at a distance, namely, keyless entry system and keyless ignition switch system for automotive vehicles comprised of a microprocessor, electronic signal receiver, and keyfob with electronic signal transponder**; downloadable emoticons for mobile phones; sports whistles; dog whistles; reflective safety vests; downloadable graphics for mobile phones; data gloves; gasoline gauges; speed indicators; hands-free kits for telephones

Class 12: Cars; sports cars; robotic cars; motor racing cars; sport utility vehicles; electric cars; land vehicles; automobile hoods; automobile bodies; **anti-skid chains for vehicles**; automobile chains; brake shoes for vehicles; security harness for vehicle seats; safety belts for vehicle seats; spare wheel covers; hoods for vehicle engines; hub caps; brake discs for vehicles; **anti-glare devices for vehicles, namely, sun visors**; **non-skid devices for vehicles tires, namely, non-skid chains and studs**; vehicle bonnet pins; **fitted seat covers for vehicles**; clutches for land vehicles; brake linings for vehicles; **propulsion**

mechanisms for land vehicles, namely, motors and engines for land vehicles; transmissions for land vehicles; vehicle suspension springs; shock absorbing springs for vehicles; jet engines for land vehicles; motors, electric, for land vehicles; engines for land vehicles; **vehicle windcreens;** mudguards; bumpers for automobiles; brake pads for automobiles; **air pumps for automobiles;** luggage carriers for vehicles; ski carriers for cars; doors for vehicles; ashtrays for automobiles; vehicle running boards; luggage nets for vehicles; rearview mirrors; safety seats for children, for vehicles; vehicle seats; horns for vehicles; reversing alarms for vehicles; side view mirrors for vehicles; spoilers for vehicles; engine mounts for land vehicles; caps for vehicle fuel tanks; automobile chassis; **vehicle parts, namely, windshield wipers;** headlight wipers; windows for vehicles; steering wheels for vehicles; cigar lighters for automobiles; **safety devices for automobiles, namely, air bags;** anti-theft alarms for vehicles; sun-blinds adapted for automobiles; suspension shock absorbers for vehicles; shock absorbers for automobiles; anti-theft devices for vehicles; head-rests for vehicle seats; axles for vehicles; bicycles; electric bicycles; saddlebags adapted for bicycles; panniers adapted for motorcycles; **vehicles, namely, vans;** rims for vehicle wheels; mopeds; self-balancing electric unicycles; **vehicles, namely, push scooters;** motorcycles; motor scooters; pneumatic tires; self-balancing scooters; bicycle saddles; **sledges, namely, sleds for transport purposes;** **air vehicles, namely, airplanes and helicopters;** snowmobiles; **water vehicles, namely, boats;** yachts; sailing vessels

Class 14: **Rings being jewelry;** split rings of precious metal for keys; **bracelets being jewelry;** bracelets made of embroidered textile being jewelry; watch bands; **watch cases being parts of watches;** watch chains; **jewelry chains;** jewellery charms; **necklaces being jewelry;** **chronographs as watches;** chronometers; stopwatches; tie clips; cufflinks; jewelry; badges of precious metal; medals; movements for clocks and watches; **lockets being jewelry;** precious metals, unwrought or semi-wrought; coins; works of art of precious metal; earrings; wristwatches; clocks; atomic clocks; **control clocks in the nature of master clocks;** clocks and watches, electric; precious stones; **key rings comprised of split rings with decorative fobs or trinkets;** retractable key rings; jewelry rolls; **dials for clock-and-watch-making;** presentation boxes for jewelry; boxes of precious metal; jewelry boxes; presentation boxes for watches; tie pins; **pins being jewelry;** **ornamental pins being jewelry;** **brooches being jewelry;** statues of precious metal; chronometric instruments; alarm clocks

Class 16: **Photo albums, sticker albums;** stationery; **office requisites except furniture, namely, rubber bands, staplers, paper embossers;** **drawing sets comprised of pens, pencils and paper;** writing cases, namely, pen and pencil cases; stationery, namely, **stickers;** **office requisites, namely, name badges;** table linen of paper; **printed tickets;** greeting cards; stationery, namely, **writing pads;** stationery, namely, **envelopes;** calendars; hat boxes of cardboard; paper; writing paper; desk mats; folders for papers; postcards; **printed catalogs in the field of automobiles;** sealing wax; letter trays; pen clips; **book covers, document covers;** **transfers, namely, decalcomanias;** paperweights; postage stamps; flags of paper; newspapers; rubber erasers; **printed books in the field of automobiles;** **printed manuals in the field of automobiles;** terrestrial globes; pencils; **pen wipers in the nature of blotting paper;** **print engravings;** **printed**

pamphlets in the field of automobiles; nibs for writing instruments; document holders; pencil holders; passport holders; penholders; writing or drawing books; **printed magazines in the field of automobiles;** conical paper bags; boxes of paper or cardboard; bookmarks; inkstands; **stamps, namely, seals for the office;** fountain pens; note books; **hand-held paper knives**]; pencil sharpeners, electric or non-electric; **sealing stamps**

Class 18: Wallets; **all-purpose carrying bags, handbags;** purses; **trunks being luggage;** suitcases; beach bags; cosmetic bags sold empty; boston bags; handbags; traveling bags; briefcases; leather briefcases; leather document briefcases; key cases of leather and skins; sports bags, namely, all-purpose sport bags; backpacks and rucksacks; school bags; garment bags for travel; shoe bags for travel; traveling trunks; overnight bags; carry-on bags; satchels; unfitted vanity cases; labels of leather; slings for carrying infants; business card cases; **credit card cases in the nature of wallets;** luggage tags; suitcases with wheels; animal hides; leather cases and boxes; leather straps; umbrellas; leather leashes

Class 25: **Clothing, namely, shirts, pants, hats;** jackets; jumpers; trousers; skirts; dresses; coats; overcoats; parkas; shirts; underwear; swim suits; dressing gowns; shawls; scarves; **ties as clothing;** shoes; beach shoes; gymnastic shoes; boots; ski boots; half boots; sandals; bath sandals; leather jackets; leather trousers; leather belts; belts; padded jackets; stuff jackets; jeans; sweaters; evening dresses; sweatshirts; undershirts; polo shirts; blazers; sport shirts; track-racing shoes; work shoes; **winter gloves as clothing;** leather coats; **leather braces as suspenders for clothing;** suits; cloaks; raincoats; pullovers; T-shirts; blouses; bathrobes; bathing costumes; nightgowns; neckties; gentlemen's suits; dress shirts; body suits; shorts; slippers; hiking shoes; inner soles; rain shoes; soles for footwear; arctic boots; football boots; gloves; leather gloves; mittens; hats and **caps being headwear; leather caps being headwear**

Class 28: **Games, namely, card games, board games, dice games; toys, namely, toy cars;** scale model vehicles; model cars; radio-controlled toy vehicles; **toys, namely, scale model kits; hand-held units for playing electronic games;** ride-on toys; **apparatus for electronic games other than those adapted for use with an external display screen or monitor;** card games; cases for playing cards; jigsaw puzzles; video game machines; board games; hand-held consoles for playing video games; parlor games; joysticks for video games; stuffed toys; dolls; toy robots; chessboards; **gymnastic and sporting articles, namely, gymnastic apparatus, balls for sports;** machines for physical exercises; golf bags, with or without wheels; golf bag carts; golf gloves; boxing gloves; **toys, namely, scooters;** play balloons; roller skates; rackets; skis; skateboards; snowboards; surfboards; **bags specially adapted for tennis equipment**

Class 35: Advertising, business management; business administration; **providing office functions; providing television home shopping services in the field of general consumer merchandise;** commercial administration of the licensing of the goods and services of others; import-export agency services; sales promotion for others; providing an online marketplace for buyers and sellers of goods and services; **commercial information and advice for consumers in the choice of products and services; retail and wholesale**

store services featuring motor vehicles, motor vehicle parts and fittings, motors and engines for land vehicles, chassis for land vehicles, vehicle superstructures and tires for vehicle wheels, bicycles and motorcycles; retail and wholesale mail order services featuring motor vehicles, motor vehicle parts and fittings, motors and engines for land vehicles, chassis, vehicle superstructures and tires for vehicle wheels, bicycles and motorcycles; online retail and wholesale store services featuring motor vehicles, motor vehicle parts and fittings, motors and engines for land vehicles, chassis for vehicles, vehicle superstructures and tires for vehicle wheels, bicycles and motorcycles; retailing and wholesaling by means of teleshopping channels, namely, home shopping services in the field of motor vehicles, motor vehicle parts and fittings, motors and engines for land vehicles, chassis for vehicles, vehicle superstructures and tires for vehicle wheels, bicycles and motorcycles; the bringing together, for the benefit of others, of a variety of motor vehicles, motor vehicle parts and fittings, motors and engines for land vehicles, chassis for vehicles, vehicle superstructures and tires for vehicle wheels, bicycles and motorcycles excluding the transport thereof, enabling customers to conveniently view and purchase those goods; business administration and organisational administration of vehicle fleets, for others; retail store services featuring leather goods, bags, wallets, backpacks, rucksacks, clothing, footwear, headwear, belts, scarves, neckties, gloves, ropes, perfumes, cosmetics, watches, jewelry, writing instruments, stationery items, games, toys, toy models, scale model vehicles, eyeglasses and sunglasses, rechargeable batteries; **online retail store services featuring leather goods, bags, wallets, backpacks, rucksacks, clothing, footwear, headwear, belts, scarves, neckties, gloves, ropes, perfumes, cosmetics, watches, jewelry, writing instruments, stationery items, games, toys, toy models, scale model vehicles, eyeglasses and sunglasses, rechargeable batteries**; online retail store services for **downloadable ring tones**; sponsorship search; promotion of goods and services through sponsorship of sports events

Class 37: **Automotive conversion services, namely, converting automobiles and trucks to electric power; automobile maintenance and repair services**; custom installation of automobile interiors; providing information relating to repairs; **installation of insulation materials and automobile washing services**; anti-rust treatment for automobiles; installation of electric and electronic equipment in automobiles; custom modification of automobiles; custom restoration of automobiles; **automobiles; automobile customization in the nature of installation of automobile interiors; upgrades namely, supercharging, turbocharging and performance upgrades of automobiles; automobile upgrade services in the nature of in the nature of upgrading of computer hardware**; rebuilding engines that have been worn or partially destroyed; rebuilding automobiles that have been worn or partially destroyed; charging of electric automobiles; automobiles battery charging; **automobile cleaning; automobile polishing; automobile greasing; automobile washing**

II. **No Likelihood of Confusion Exists between Applicant's Mark and the Cited Marks**

The Examining Attorney has issued a refusal to register Applicant's Mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that it could likely be confused with the U.S. Registration No. 1160119 (the "Cited Mark"). Applicant also brings to the Examining Attorney's attention that the Cited Mark is currently in the 6-month Grace Period for submitting the Section 8 and 9 Renewal. At this time, Applicant respectfully requests the Examining Attorney suspend its Application, pending the outcome of the Cited Marks registration maintenance due on January 7, 2022.

III. **Description of Mark**

Applicant hereby submits the following mark description:

The mark consists of the stylized design of a trident with the word "MASERATI" below, all contained within an oval with shading in the lower third of the oval.

Applicant submits that with the responses and arguments above, all of the issues raised by the Examining Attorney in the Office Action have been resolved. Applicant therefore respectfully requests that the Application be approved for publication.

The Examining Attorney is invited to contact the undersigned with any remaining questions or concerns.

Respectfully submitted,
/Michelle P. Ciotola/

Attorneys for Applicant Maserati S.p.A.
Our Ref: JNP0443TUS

Michelle P. Ciotola, Esq.
Cantor Colburn LLP
20 Church Street
22nd Floor
Hartford, Connecticut 06103-3207 U.S.A.

Phone: 860-286-2929
Fax: 860-286-0115
Email: TM-CT@cantorcolburn.com