

Docket No.: **1011-TM-1139**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE EXAMINER OF TRADEMARKS

Mark: LOCMAN ITALY STEALTH

Serial: 77/801,258

Filed: August 10, 2009

Class(es): 14

Applicant: LOCMAN S.P.A.

Law Office: 112

Examiner: Darryl M. Spruill, Esq.

New York, NY 10020  
May 18, 2010

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**AMENDMENT**

This Amendment is being filed in response to the Office Action that was mailed November 18, 2009. Kindly amend the subject application as follows:

**IN THE IDENTIFICATION OF GOODS**

Please amend the identification of goods and services in International Class(es) 14 to read as follows:

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05-24-2010

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Watches; chronometers; pendulum clocks; wrist watches; table clocks; pocket watches; alarm-clocks; cases and other containers for watches; watch straps in International Class 14.

**CLAIM OF OWNERSHIP OF PRIOR REGISTRATIONS:**

Please insert the following claim:

Applicant is the owner of U.S. Registration Nos. 1,725,464, 2,708,578, 2,894,070, and 3,046,331.

**DISCLAIMER**

Please insert the following disclaimer:

No claim is made to the exclusive right to use "ITALY" apart from the mark as shown.

**REMARKS**

Based on the above amendments and these remarks, Applicant requests that the Examiner reconsider the application, withdraw all objections and allow the application to proceed to publication.

Applicant has reviewed the Examiner's suggestions with regard to the identification of goods and services and amended the recitation of goods and services in International Class(es) 14. Therefore, reconsideration is requested on the issue of the identification.

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Applicant has inserted the requested claim of ownership of prior registrations and disclaimed the term ITALY. Therefore, reconsideration is requested on these issues.

Applicant will proceed under Section 44(d) and will provide a Certified Copy of the Foreign registration when available.

**SECTION 2(d) REFUSAL :**

The Examiner has refused registration of the applicant's trademark citing U.S. Registration No. 1,711,555 for STEALTH.

As set forth in the application, Applicant has filed for registration of the mark LOCMAN ITALY STEALTH, for use on watches; chronometers; pendulum clocks; wrist watches; table clocks; pocket watches; alarm-clocks; cases and other containers for watches; watch straps in International Class 14.

The cited registration offers a distinct commercial impression from the instant application and the Applicant respectfully states that the differences in marks alone are sufficient to obviate any possible confusion. Therefore, allowance is proper.

Applicant does not dispute that the issue of likelihood of confusion, for registration purposes, is determined by evaluating the factors established in *In re E.I. du Pont DeNemours & Co.*, 476 F. 2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The significance of each factor is determined on the particular circumstances of each case. *G.H. Mumm & Cie v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 1295, 16 USPQ2d 1635, 1637 (Fed. Cir. 1990). Applicant does offer that the most important du Pont factor in the instant matter is the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

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When this factor is considered and applied to the present application, it is clear that there is no likelihood of confusion between the Applicant's mark and the cited registration.

When assessing the similarities of two marks, the marks must be considered in their entireties. *In re Electrolyte Laboratories, Inc.*, 929 F. 2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (wherein the court held that a “K+” design and the mark “K+EFF” for dietary potassium supplements were sufficiently different to avoid likelihood of confusion.)

In both sound and appearance Applicant's mark is a multi-word mark in stark contrast to the cited registration. Applicant respectfully disagrees with the Examiner's conclusion that the applicant's mark is highly similar to the cited registration. Applicant's mark is dominated by (1) the company name LOCMAN (which as the Examiner has noted, is used in at least four (4) US TM registrations in connection with a wide variety of goods) and (2) the place of manufacture of the goods sold under the mark, ITALY. The fact that the word ITALY is subject to a disclaimer does not remove it from consideration when evaluating the overall impression of the Applicant's mark when compared to other marks.

It is clear from the comparison of Applicant's mark and the cited registration that the marks are dissimilar in sight, sound, connotation and commercial impression.

As the court held in *Kellogg Co. v. Pack'em Enterprises, Inc.*, 951 F. 2d 330, 21 USPQ 2d 1142 (Fed. Cir. 1991), a great difference between an applicant's mark and the cited registration is enough to obtain registration. In *Kellogg*, the Federal Circuit affirmed the Board's decision granting the applicant's summary judgment motion because the Board properly considered all the relevant *du Pont* factors before making its determination that the applicant's mark FROOTEE ICE and design for frozen flavored liquid bars was so different in appearance from opposer's mark FOOT LOOPS for breakfast cereals, dessert sundaes, shakes and frozen confections that no likelihood of confusion would occur from the simultaneous use of the marks.

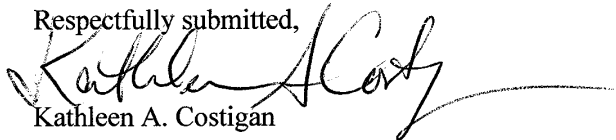
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Applicant respectfully requests reconsideration based on the cited differences between the Applicant's mark and the cited registration.

Early and favorable action is earnestly solicited.

It is requested that the Examiner contact the undersigned with any questions.

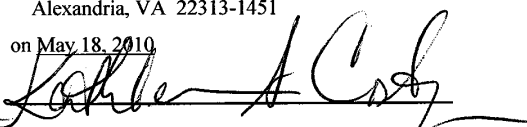
Respectfully submitted,



Kathleen A. Costigan

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<p><b><u>CERTIFICATE OF MAILING under 37 CFR 1.8</u></b> I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:</p> <p>Commissioner for Trademarks P.O. Box 1451 Alexandria, VA 22313-1451</p> <p>on May 18, 2010.</p>  <p><b>Kathleen A. Costigan</b> 212-302-8989</p>
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