PTO Form 1930 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77149567
LAW OFFICE ASSIGNED	LAW OFFICE 108
MARK SECTION (no change)	
ARGUMENT(S)	

The Examiner has issued a Final Office Action, refusing to register the subject mark based on a likelihood of confusion with the word mark SANTANA, found at U.S. registration no. 2211379.

In its response of January 23, 2008 to the Examiner's previous Office Action, Applicant argued that (a) the Applicant's mark and the mark at U.S. registration no. 2211379 ("Registrant's Mark"), when properly viewed as a whole and not dissected, are not confusingly similar in appearance, sound, or meaning; and (b) the Applicant's and Registrant's goods are not related and are purchased after careful consideration.

The Applicant would like to further address the Examiner's position that the goods covered by the application and registration at issue are related.

The Registrant's Mark covers "yarn," in class 23. In connection with this Request for Reconsideration, the Applicant is amending its application to delete all of the goods in class 23, which are "yarn; textile materials, namely, threads and yarn for textile use." Applicant submits that this deletion obviates any likelihood of confusion – yarn and textile fabrics are two entirely different goods that fall into different international classes. However, for the sake of completeness, Applicant will address the Examiner's objection based on the goods remaining in the application, which are "textile fabrics for the manufacture of clothing, in the indigo denim color, and in other colors."

Goods are related when buyers are likely to believe that the goods come from a common source or are otherwise sponsored by or connected with a common company. AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348 (9th Cir. 1979). However, there can be no rule that certain goods are per se related "such that there must be a likelihood of confusion." TRADEMARK MANUAL OF EXAMINING PROCEDURE 1207.01(a)(iv). For example, in M2 Software, Inc. v. M2 Communications, Inc., the court found that the relatedness of software-related goods cannot be presumed just because the goods are delivered in the same media format. 450 F.3d 1378 (Fed. Cir. 2006) *See also* Hi-Country Foods Corp. v. Hi Country Beef Jerky, 4 U.S.Q.P.2d 1169 (T.T.A.B. 1987) (where the Board held that all food products are not related goods simply because they are sold in the modern supermarket "with its enormous variety of food, cleaning, paper, and other products."), Beneficial Corp. v. Beneficial Capital Corp., 529 F.Supp. 445 (S.D.N.Y. 1982)(where BENEFICIAL

for consumer loans and BENEFICIAL CAPITAL for business loans where held not to be confusingly similar.), and Fossil Inc. v. Fossil Group, 49 U.S.P.Q.2d 1451 (T.T.A.B.)(finding that FOSSIL for watches and THE FOSSIL GROUP for clocks are not confusingly similar).

The goods are unrelated. As supported by the cases cited above, relatedness cannot be presumed simply because the Applicant's goods and the Registrant's goods may have a connection to wearing apparel. Indeed, courts dealing with the issue of relatedness within the apparel industry have held that marks may co-exist without likely confusion, where the goods are encountered by different classes of consumers, at different points along the manufacturing chain. In Exquisite Form Industries, Inc. v. Exquisite Fabrics of London, 378 F.Supp. 403 (D.C.N.Y. 1974), a New York court found that use of the identical mark on fabrics and ladies' undergarments did not support a finding of a likelihood of confusion and stated: "There is little, if any overlap between those who buy plaintiff's products and those who buy defendant's. Plaintiff's sole argument . . . is that both it and the defendant sell "knitwear," if the term is defined expansively. Although both do admittedly market knit goods, the resemblance ends there: plaintiff's goods are finished products, defendant's nothing but uncut fabric." *See also* Oxford Industries, Inc. v. JBJ Fabrics Inc,. 6 U.S.P.Q.2d 1756(S.D.N.Y. 1988) (where, although plaintiff's apparel and defendant's fabrics "are sufficiently close to raise the possibility of confusion," they are not close enough to establish enough of a likelihood of confusion to be of "controlling significance" because the parties' products "have dissimilar physical attributes.") and Toro Manufacturing Corp. v. The Gleason Works, 474 F.2d 1401 (C.C.P.A. 1973)(where court was not persuaded to find a likelihood of confusion between TOROID for gears, gear cutters, and blades and TORO for grass cutting machinery, automotive vehicles, and snow blows even though the goods sold under TORO contain gears).

Like those in Exquisite and the other cases cited above, the goods at issue in this case have different purposes and uses and are encountered by different groups of consumers: yarn is sold at retail for knitting into finished goods, while fabrics are finished goods. What is more, Exquisite and Toro dealt with identical marks. In this case, there are pronounced differences between the appearance, sound, and commercial impression of the two marks, rendering confusion even less likely. Accordingly, under the reasoning applied in the cited decisions, the goods may not be deemed "related," and there is no likelihood of confusion.

The Applicant's goods consist primarily of denim fabrics, and it is a leading producer of denim worldwide. (See attached print-outs from Applicant's Web site and articles from Edinburg Times and Texas Insider.) The Applicant's customers consist of manufacturers and distributors – not the general public. Upon information and belief, the Registrant's goods are not sold through the same channels or to the same consumers. Furthermore, as the art of knitting has become more and more mainstream and popular in the United States, entire stores devoted to the sale of yarn and knitting equipment have cropped up around the country. (See attached articles discussing knitting's popularity and listing numerous yarn stores in major metropolitan areas.) The goods of the Applicant and Registrant will not be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods come from a common source because the purchasers are vastly different, i.e. the average American knitter shopping at his or her local yarn shop versus large manufacturing and distributing concerns purchasing fabric from the Applicant. *See* Oxford Industries, Inc. v. JBJ Fabrics Inc,. 6 U.S.P.Q.2d 1756(S.D.N.Y. 1988)(where "no competitive proximity between plaintiff's apparel and defendant's fabric" was found "because of the disparity in the parties' products which are marketed through distinctly different channels of commerce."). The goods at issue are approached by entirely different consumers at different points along the manufacturing chain. Accordingly, there is no likelihood of confusion.

It is respectfully submitted that confusion is unlikely because the marks are not confusingly similar in appearance, sound, or meaning; the goods are not related and will not be encountered by the same purchasers or under circumstances that would give rise to the mistaken belief that the goods come from a common source; and the goods are purchased after careful consideration. Applicant requests that that the Examiner accept its Request for Reconsideration, withdraw the refusal to register its mark based on a likelihood of confusion with the Registrant's Mark, and allow its mark to proceed to publication.

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DESCRIPTION OF EVIDENCE FILE	articles, print-out of TARR information about registration no. 1992324, print-out of Applicant's Web site, lists of yarn shops in the metropolitan areas of New York, Chicago, Los Angeles and San Francisco
GOODS AND/OR SERVICES SECTION (023)(class deleted)	
INTERNATIONAL CLASS	023
DESCRIPTION	
Yarn; textile materials, namely, threads and yarns for textile use	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 08/03/2001
FIRST USE IN COMMERCE DATE	At least as early as 08/03/2001
GOODS AND/OR SERVICES SECTION (024)(no change)	
SIGNATURE SECTION	

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