
To: Blandi International, LLC (ndean@langdalevalotton.com)
Subject: U.S. TRADEMARK APPLICATION NO. 77482010 - PRONTO - 051320/S
Sent: 9/26/2009 1:52:46 PM
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/482010

MARK: PRONTO

CORRESPONDENT ADDRESS:
JOHN P. SINNOTT
LANGDALE VALLOTTON, LLP
1007 N PATTERSON ST
VALDOSTA, GA 31601-3918



GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Blandi International,
LLC

CORRESPONDENT'S REFERENCE/DOCKET
NO:

051320/S

CORRESPONDENT E-MAIL ADDRESS:

ndean@langdalevalotton.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 9/26/2009

Applicant is requesting reconsideration of a final refusal issued/mailed March 6, 2009.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Accordingly, applicant's request for reconsideration is *denied*. The time for appeal runs from the date the final action was issued/mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c). If applicant has already filed a timely notice of appeal, the application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

Registration of the applied-for mark has been finally refused because of a likelihood of confusion with the mark in U.S. Registration No. 1345457. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.*

Registration No. 1345457 is for the mark PRONTO for use on hair shampoos and hair conditioners. Applicant's proposed mark is for PRONTO and is for use on Hair lotions and cosmetics and providing information about the application to hair of lotions and cosmetics for cosmetic use and hair care.

Applicant argues the goods and services are different and that consumers would not be confused. Applicant argues that it has provided evidence that the registrant's mark is solely used on delousing agents, such as lice shampoo. This is assumed by applicant from the specimen submitted by applicant. Firstly applicant is reminded that specimens submitted to fulfill the Section 8 & 15 Affidavit requirement does not have to show every good that the mark is used upon. Rather only one specimen showing one good in the class is required. Any type of hair shampoo or conditioner would be acceptable. Simply because the specimen shows a delousing type of shampoo does not limit registrant to those goods. "If more than one item of goods, or more than one service, is specified in an application in one class, it is usually not necessary to have a specimen for each product or service" TMEP Section 904.01(a). "There must be one specimen of the mark for each class. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv) and 2.56(a)." TMEP Section 904.01(b).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); see, e.g., *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Likelihood of confusion is determined on the basis of the goods and/or services as they are identified in the application and registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 1207 n.4, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); TMEP §1207.01(a)(iii).

In this case, the registrant's goods and/or services are identified broadly. Therefore, it is presumed that the registration encompasses all goods and/or services of the type described, including those in applicant's more specific identification, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(a)(iii).

Applicant should note that there is a Registration No. 1441745 for the mark PRONTO for use on lice shampoo that has NOT been cited against applicant.

In any event, attached are excerpts from the United States Trademark Office X-search database showing that shampoos and lice preparations are often sold by the same registrants under the same trademark.

Since applicant has already filed a timely notice of appeal, the application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

/Jacqueline A. Lavine/
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(571) 273-9101 FAX
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STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

Print: Sep 25, 2009

73621145

TYPED DRAWING

Serial Number

73621145

Status

REGISTERED AND RENEWED

Word Mark

PRONTO

Standard Character Mark

No

Registration Number

1441745

Date Registered

1987/06/09

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

CHURCH & DWIGHT CO., INC. CORPORATION DELAWARE 469 NORTH HARRISON
STREET LAW DEPARTMENT PRINCETON NEW JERSEY 08543

Goods/Services

Class Status -- ACTIVE. IC 005. US 006 052. G & S: PEDICULICIDE
AND LICE SHAMPOO. First Use: 1986/08/29. First Use In Commerce:
1986/08/29.

Prior Registration(s)

0931659;1345457

Filing Date

1986/09/22

Examining Attorney

MORRIS CRAIG K

Attorney of Record

Elisabeth A. Langworthy

Print: Sep 25, 2009

76189920

DESIGN MARK

Serial Number

76189920

Status

SECTION 8 & 15-ACCEPTED AND ACKNOWLEDGED

Word Mark

KROGER

Standard Character Mark

No

Registration Number

2673940

Date Registered

2003/01/14

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

Kroger Co. of Michigan, The CORPORATION MICHIGAN 18334 Laurel Park Drive North Livonia MICHIGAN 481522686

Goods/Services

Class Status -- ACTIVE. IC 003. US 001 004 006 050 051 052. G & S: Skin soap; anti-bacterial soap; deodorant soap; liquid soaps for hands, face, and body; bath foam; aloe vera gels for cosmetic use, namely, for bath, eyes, skin, styling, and shower; self-tanning lotions; sun tan lotion; after-sun lotions; sun block preparations; sun block; sun tan oil; pre-shaving lotions; shaving lotions; tooth paste; mouthwash; non-medicated mouthwash and gargle; denture cleaning preparations; body lotions; facial cleansers; facial creams; face creams; pre-moistened cosmetic towelettes; body oil containing vitamin E; hair shampoo; hair shampoo and conditioners combinations; hair conditioners; non-medicated foot powder; cotton for cosmetic purposes; personal deodorants; pumice stones for personal use; nail buffing preparations; emery boards; nail polish remover; all purpose cotton swabs for personal use; baby wipes; baby shampoo; baby lotion; baby oil; baby powder. First Use: 1986/10/00. First Use In Commerce: 1986/10/00.

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