



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

U.S. Application Serial No.: 79/003500
International Registration No.: 0827830

Attached is a PROVISIONAL FULL REFUSAL Office action that applies to all the goods and/or services in the U.S. application identified above application identified above: 15 U.S.C. §1141h(c).

The identification of goods requirement, entity, citizenship clarification and likelihood of confusion refusal applies to all the goods and/or services in the application and therefore comprise a provisional full refusal of the entire application.

RESPONSE DUE:

A response to this provisional refusal is due within six (6) months from the mailing date of the Office action, i.e., within six months from 21 December 2004.

APPLICANT OR ATTORNEY CAN RESPOND TO PROVISIONAL REFUSAL:

Applicant can respond directly to this provisional refusal Office action, or applicant can hire an attorney to represent itself before the Office and that attorney can respond on applicant's behalf. The Office cannot aid in the selection of an attorney. 37 C.F.R. §2.11.

NOTE: Attorneys hired to represent an applicant in a trademark matter before the Office must be eligible under 37 C.F.R. §10.14:

- (1) *Attorneys residing in the United States* who are in good standing with the bar of any United States court or the highest court of any state, may practice before the Office in trademark matters.
- (2) *A foreign attorney not residing in the United States* who is in good standing before the patent or trademark office of the country in which he or she resides, may practice before the Office in trademark matters only in cases where the patent and trademark office of that foreign country allows substantially reciprocal privileges to those permitted to practice before the Office. Currently, Canadian attorneys are the only foreign attorneys recognized as meeting this criterion. A foreign attorney who meets the requirements of 37 C.F.R. §10.14(c) can only represent parties located in the country in which the foreign attorney resides and practices. TMEP §602.

Please note that non-attorneys are not permitted to practice before the Office except under the very limited circumstances specified in 37 C.F.R. §10.14(b).


Pages enclosed - 9

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/003500

APPLICANT: PASCUAL ROS AGUILAR

CORRESPONDENT ADDRESS:
GARRIGUES
Agencia de Propiedad
Industrial e Intelectual, S.L.
José Abascal, 45
E-28003 MADRID SPAIN

DEC 21 2004

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

MARK: SIXTYSEVEN BY MUSTANG

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 79/003500

The assigned examining attorney has reviewed the referenced application and determined the following.

Likelihood of Confusion

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods/services, so resembles the mark in U.S. Registration No. 0802773 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 *et seq.* See the enclosed registration.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978). TMEP §§1207.01 *et seq.*

The marks are compared in their entireties under a Section 2(d) analysis. Nevertheless, one feature of a

mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); TMEP §1207.01(b)(viii).

In this case, MUSTANG, the dominant portion of the applicant's mark, is identical to the registrant's mark, MUSTANG. Moreover, where the literal portions of both marks are nearly identical in appearance, sound and meaning. The addition of the design element does not obviate the similarity between the marks. *In re Shell Oil Company*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975); TMEP §§1207.01(b)(viii) and 1207.01(c)(ii).

With regard to the goods, the applicant provides clothing, which includes footwear and headgear. The types of goods appear to be related to, and travel in the same trade channels as the registrant's items of clothing. A consumer encountering the respective goods in the marketplace would be confused about the source of the goods because of the similar commercial impression of the marks.

In addition, the examining attorney encloses information regarding pending Application Serial Nos. 78164529, 76596873, and 74303359. The filing dates of the referenced applications precede the applicant's filing date. There may be a likelihood of confusion between the applicant's mark and the referenced marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d). If one or more of the referenced applications matures into a registration, the examining attorney may refuse registration in this case under Section 2(d). 37 C.F.R. §2.83; TMEP §1208.01.

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

Entity

Applicant must specify its entity type and citizenship. For example, an applicant can apply as an individual, a partnership, a corporation or a joint venture. 37 C.F.R. §2.32(a)(3); TMEP §§802.03 *et seq.* If applicant is an individual, then applicant must indicate his or her national citizenship for the record. 37 C.F.R. §2.32(a)(3)(i). If applicant is a corporation or association, then applicant must set forth the U.S. state or country (for foreign applicants only) under whose laws applicant is organized. 37 C.F.R. §2.32(a)(3)(ii). If applicant is a partnership or joint venture, then applicant must list the names and the national citizenship or the U.S. state or country (for foreign applicants only) of organization or incorporation of all the general partners or joint venturers, as well as specify the state or country under whose laws the partnership or joint venture is organized. 37 C.F.R. §§2.32(a)(3)(ii) and (iii).

Identification of Goods

The identification of goods is too indefinite for registration purposes. Therefore, the applicant must amend the identification to read as follows, if accurate:

"Ready-made wear for women, men, and children, namely _____ (specify types of clothing, e.g. shirts, slacks, sweaters); footwear, headgear, namely _____ (specify type)," in International Class 25.

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may

not amend to include any goods that are not within the scope of goods set forth in the present identification.

NOTICE: TRADEMARK OPERATION RELOCATION

The Trademark Operation has relocated to Alexandria, Virginia. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

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

Applicants, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at <http://www.uspto.gov/teas/index.html>.

/Julia Hardy Cofield/
Examining Attorney
Law Office 108
(571) 272-9145

How to respond to this Office Action:

You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://eteas.uspto.gov/V2.0/oa242/WIZARD.htm> and follow the instructions therein, but you must wait until at least 72 hours after receipt if the office action issued via e-mail). PLEASE NOTE: Responses to Office Actions on applications filed under the Madrid Protocol (Section 66(a)) CANNOT currently be filed via TEAS.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

Print: Dec 20, 2004

72217465

TYPED DRAWING

Serial Number

72217465

Status

SECTION 15-ACKNOWLEDGED

Word Mark

MUSTANG

Standard Character Mark

No

Registration Number

0802773

Date Registered

1966/01/25

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

HAGGAR CLOTHING CO. CORPORATION NEVADA 6113 LEMMON AVENUE DALLAS TEXAS
75209

Name Change

BY CHANGE OF NAME FROM

Goods/Services

Class Status -- ACTIVE. IC 025. US 039. G & S: MEN'S AND BOYS'
CLOTHING-NAMELY, SLACKS. First Use: 1938/04/05. First Use In
Commerce: 1938/04/05.

Prior Registration(s)

0362418

Filing Date

1965/04/27

Examining Attorney

UNKNOWN

Attorney of Record

Print: Dec 20, 2004

72217465

PRISCILLA L. DUNCKEL,

Print: Dec 20, 2004

74303059

TYPED DRAWING

Serial Number

74303059

Status

SECTION 8 & 15-ACCEPTED AND ACKNOWLEDGED

Word Mark

MUSTANG

Standard Character Mark

No

Registration Number

1871947

Date Registered

1995/01/03

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

Haggar Apparel Company CORPORATION NEVADA 6113 Lemmon Avenue Dallas
TEXAS 75209

Goods/Services

Class Status -- ACTIVE. IC 025. US 039. G & S: men's and boys' wear; namely, slacks, and shorts. First Use: 1993/10/00. First Use In Commerce: 1993/10/00.

Filing Date

1992/08/07

Examining Attorney

ROSSMAN, MARY

Attorney of Record

JOCELYN R. DABEAU

Print: Dec 20, 2004

76596873

DESIGN MARK

Serial Number

76596873

Status

NEW APPLICATION - RECORD INITIALIZED NOT ASSIGNED TO EXAMINER

Word Mark

MUSTANG BOOTS & SHOES

Standard Character Mark

No

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Owner

ROS AGUILAR, PASCUAL INDIVIDUAL SPAIN Partida De Algoda, P.2, No. 37
03296 Elche (Alicante) SPAIN

Goods/Services

Class Status -- ACTIVE. IC 025. US 022 039. G & S: Footwear.
First Use: 1967/00/00. First Use In Commerce: 1967/00/00.

Filing Date

2004/06/10

Examining Attorney

UNKNOWN

Attorney of Record

Neil F. Greenblum

MUSTANG BOOTS & SHOES

Print: Dec 20, 2004

78164529

TYPED DRAWING

Serial Number

78164529

Status

SECOND EXTENSION - GRANTED

Word Mark

MUSTANG

Standard Character Mark

No

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

Haggar Clothing Co. CORPORATION NEVADA 6113 Lemmon Avenue Dallas TEXAS
75209

Goods/Services

Class Status -- ACTIVE. IC 025. US 022 039. G & S: Women's and
girls' wearing apparel, namely, pants, jeans, shorts, shirts, blouses,
jackets and skirts..

Filing Date

2002/09/16

Examining Attorney

BOULTON, KELLY

Attorney of Record

Pamela S. Ratliff