

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/021220

APPLICANT: PRADA S.A.

79021220

CORRESPONDENT ADDRESS:

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RETURN ADDRESS:

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

MARK: PRADA MILANO DAL 1913

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

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

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

MAILING/E-MAILING DATE INFORMATION: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 79/021220

INTERNATIONAL REGISTRATION NO. 0662397

This is a **PROVISIONAL FULL REFUSAL** of the trademark and/or service mark in the above-referenced U.S. application. 15 U.S.C. §1141h(c).

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL:

Applicant may respond directly to this provisional refusal Office action, or applicant's attorney may respond on applicant's behalf. However, **the only attorneys who can practice before the United States Patent and Trademark Office (USPTO)** in trademark matters are:

- (1) **Attorneys in good standing with the bar of any U.S. federal court or the highest court of any U.S. state, and**
- (2) **Canadian attorneys who have applied for and received reciprocal recognition by the USPTO under 37 C.F.R. §10.14(c).**

37 C.F.R. §10.14; TMEP §602.

Foreign attorneys are *not* permitted to practice before the USPTO, other than properly authorized Canadian attorneys. Preparing a paper, authorizing an amendment to an application, or submitting legal arguments in response to a requirement or refusal constitutes representation of a party in a trademark matter. *A response signed by an unauthorized foreign attorney will be considered an incomplete response.* TMEP §§602, 602.03, 603.05.

THE APPLICATION HAS BEEN PROVISIONALLY REFUSED AS FOLLOWS:

DISCLAIMER

Applicant must disclaim the descriptive wording “MILANO and DAL 1913” apart from the mark as shown because it merely describes aspects of applicant’s goods, specifically presumably, the goods are derivation and year of conception. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a).

The computerized printing format for the Office’s *Trademark Official Gazette* requires a standardized format for a disclaimer. TMEP §1213.08(a)(i). The following is the standard format used by the Office:

No claim is made to the exclusive right to use “MILANO and DAL 1913” apart from the mark as shown.

See In re Owatonna Tool Co., 231 USPQ 493 (Comm’r Pats. 1983).

TRANSLATION

The applicant must submit an English translation of the foreign wording in the mark. 37 C.F.R. Section 2.61(b); TMEP section 809. Upon applicant’s response, additional issues may arise.

CLAIM PRIOR REGISTRATIONS

The applicant is the owner of Registration Nos. 2286904, 1873854 and others, and must submit a claim of ownership. 37 C.F.R. Section 2.36; TMEP section 812.

The claim may take the following form: Registration Nos. 22869001, 25353821 and others.

LEGAL NATURE AND LEGAL PLACE

Please provide information regarding LEGAL NATURE and LEGAL PLACE.

IDENTIFICATION OF GOODS

The identification of goods is unacceptable as indefinite because some of the wording is unclear. TMEP section 1402.01. The applicant may adopt the following identification, if accurate.

Perfumery, perfumes, essential oils; cosmetics; cosmetic skin creams; lipsticks; make-up powders; eye shadows; hair lotions; dentifrices, soap [indicate type, e.g. hand soap; cakes of soap [indicate type, e.g. for body]; shaving soap; cleaning preparations [indicate purpose, e.g. for household cleaning], liquid soap, non-medicated cosmetic bath salts; preparations for setting and permanent waving of hair; hair dying and bleaching products; deodorants for personal use; deodorant soap. International Class 3.

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. Section 2.71(a); TMEP section 804.09. The international classification of goods and/or services in applications filed under Trademark Act Section 66(a) cannot be changed from the classification given to the goods and/or services by the International Bureau of the World Intellectual Property Organization in the corresponding international registration. TMEP §§1401.03(d), 1401.04 and 1904.02(b).

NO SIMILAR MARKS FOUND

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 704.02.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Dezmona Mizelle-Howard/

Dezmona J. Mizelle-Howard, Trademark Attorney
United States Patent and Trademark Office
Law Office 110
571.272.9368

HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. **NOTE: The filing date of the response will be the date of receipt in the Office,** not the postmarked date. To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

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

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

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

Print: Apr 25, 2006

73922699

DESIGN MARK

Serial Number
73922699

Status
REGISTERED AND RENEWED

Word Mark
PRADA MILANO DAL 1913

Standard Character Mark
No

Registration Number
1673554

Date Registered
1995/01/17

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner
PRADA S.A. CORPORATION LUXEMBOURG 23, RUE ALDRINGEN L-1118 LUXEMBOURG
LUXEMBOURG

Goods/Services
Class Status -- SECTION 8 - CANCELLED. IC 025. US 039. G & S:
CLOTHING FOR MEN, WOMEN AND CHILDREN; NAMELY, SUITS, TROUSERS, WOMEN'S
SUITS, SKIRTS, MEN'S FORMAL DRESS SHIRTS, TUXEDOS, DINNER JACKETS,
FORMAL DRESS SUITS, VESTS, TIES, CORMORBUND; SWEATERS, CARDIGANS;
SHIRTS; COLLARS; BLOUSES; SPORTS SHIRTS; POLO SHIRTS; UNDERSHIRTS;
SLACKS; CAMISOLES; SLIPS; NIGHT GOWNS; PAJAMAS; SCARVES; BELTS, SUN
VISORS, GLOVES, HATS AND SUSPENDERS.

Goods/Services
Class Status -- ACTIVE. IC 019. US 002 003 041. G & S: BRIEF
CASES; TOTE BAGS; SHOULDER BAGS; SATCHELS; HANDBAGS; TRUNKS;
SUITCASES; TRAVELING BAGS; PURSES; BRIEF CASE-TYPE PORTFOLIOS; HAND
BAGS FOR MEN; BEACH UMBRELLAS; UMBRELLAS; WALKING STICKS; HARNESSSES;
SADDLES; WHIPS; ATTACHE CASES; WALLETTS.

Foreign Country Name
ITALY

Print: Apr 25, 2006

73822689

Foreign Priority
FOREIGN PRIORITY CLAIMED

Foreign Application Number
22967C/89

Foreign Filing Date
1989/07/21

Foreign Registration Number
538448

Foreign Registration Date
1991/01/10

Foreign Expiration Date
2009/07/21

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "MILANO" AND "DAL 1913"
APART FROM THE MARK AS SHOWN.

Filing Date
1989/08/31

Examining Attorney
BYERS, KRISTEN S.

Attorney of Record
RAYMOND A. KURZ



Print: Apr 25, 2006

78002280

DESIGN MARK

Serial Number
78002280

Status
REGISTERED

Word Mark
PRADA BEAUTY, INTELLIGENT BEAUTY

Standard Character Mark
Yes

Registration Number
3011572

Date Registered
2005/11/01

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
PRADA S.A. Société Anonyme LUXEMBOURG 23, rue Aldringen L-1118
Luxembourg LUXEMBOURG

Goods/Services
Class Status -- ACTIVE. IC 003. US 001 004 006 050 051 052. G & S:
Bleaching preparations for laundry use; cleaning, polishing, scouring
and abrasive preparations for general purpose cleaning; cosmetics,
namely hand, body, face cosmetics, soaps; perfumery; essential oils
for personal use, hair-lotions; dentifrices.

Priority Date
2003/12/31

Prior Registration(s)
2286904;2303400;2504023

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE BEAUTY APART FROM THE
MARK AS SHOWN.

Filing Date

Print: Apr 25, 2006

78002280

2004/03/11

Examining Attorney
BELLO, ZACHARY

PRADA BEAUTY. INTELLIGENT BEAUTY