

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85304372

MARK: SAN FRANCISCO

85304372

CORRESPONDENT ADDRESS:

MARY L. KEVLIN, ESQ,
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http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: San Francisco Baseball
Associates, L.P.

**CORRESPONDENT'S REFERENCE/DOCKET
NO:**

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE:

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

Likelihood of Confusion Refusal

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3933119. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

The applicant applied for the mark SAN FRANCISCO and design for clothing, namely, shirts and jackets; headwear. The registrant owns the mark SAN FRANCISCO CALIFORNIA and design for caps; hats; headwear; jackets; shirts; sweat shirts; tops.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark

that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, ___ F.3d ___, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); TMEP §§1207.01 *et seq.*

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

Here, the marks are virtually identical. Both share the same large wording SAN FRANCISCO in a stylized cursive font sloping upwards from left to right and with the same underline shape extending from the O under the wording. The only difference is the applicant did not include the geographically descriptive wording CALIFORNIA in small letters in the underline portion of the registrant's mark.

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, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and/or services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

In this case, the goods are identical.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Applicant must respond to the requirement(s) set forth below.

Claim of Ownership

If applicant is the owner of U.S. Registration Nos. 1544375 and 1522132, then applicant must submit a claim of ownership. *See* 37 C.F.R. §2.36; TMEP §812. The following standard format is suggested:

Applicant is the owner of U.S. Registration Nos. 1544375 and 1522132.

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

/Amy E. Hella/
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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

Print: Aug 8, 2011

73673356

TYPED DRAWING

Serial Number

73673356

Status

REGISTERED AND RENEWED

Word Mark

SAN FRANCISCO GIANTS

Standard Character Mark

No

Registration Number

1522132

Date Registered

1989/01/24

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

SAN FRANCISCO BASEBALL ASSOCIATES L.P. LIMITED PARTNERSHIP CALIFORNIA
AT&T PARK 24 WILLIE MAYS PLAZA SAN FRANCISCO CALIFORNIA 94107

Goods/Services

Class Status -- ACTIVE. IC 041. US 107. G & S: ENTERTAINMENT
SERVICES IN THE NATURE OF BASEBALL EXHIBITIONS. First Use:
1958/00/00. First Use In Commerce: 1958/00/00.

Prior Registration(s)

1010059

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SAN FRANCISCO" APART
FROM THE MARK AS SHOWN.

Filing Date

1987/07/20

Examining Attorney

UNKNOWN

Print: Aug 8, 2011

73673356

Attorney of Record
KATHRYN L. BARRETT

DESIGN MARK

Serial Number

73720225

Status

REGISTERED AND RENEWED

Word Mark

SAN FRANCISCO GIANTS

Standard Character Mark

No

Registration Number

1544375

Date Registered

1989/06/20

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

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

Owner

SAN FRANCISCO BASEBALL ASSOCIATES L.P. LIMITED PARTNERSHIP CALIFORNIA
AT&T PARK 24 WILLIE MAYS PALAZA SAN FRANCISCO CALIFORNIA 94107

Goods/Services

Class Status -- ACTIVE. IC 025. US 022 039. G & S: CLOTHING -
NAMELY, T-SHIRTS, [SWEATSHIRTS, JACKETS, SWEATERS, SUN VISORS, HATS
AND CAPS]. First Use: 1983/05/00. First Use In Commerce:
1983/05/00.

Goods/Services

Class Status -- SECTION 8 - CANCELLED. IC 021. US 002 013 023 029
030 033 040 050. G & S: [PLASTIC COFFEE MUGS]. First Use:
1983/04/00. First Use In Commerce: 1983/04/00.

Goods/Services

Class Status -- ACTIVE. IC 024. US 050. G & S: CLOTH PENNANTS.
First Use: 1983/02/00. First Use In Commerce: 1983/02/00.

Goods/Services

Class Status -- ACTIVE. IC 016. US 002 005 022 023 029 037 038 050.
G & S: [TRADING CARDS,] STICKERS, [POSTERS,] DECALS, [LABELS,

Print: Aug 8, 2011

73720225

SCORE CARDS, PROGRAMS, SCOREBOOKS, YEARBOOKS AND POSTCARDS]. First Use: 1983/02/00. First Use In Commerce: 1983/02/00.

Prior Registration(s)

1010059;1034287;1314552;1340707;AND OTHERS

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SAN FRANCISCO" APART FROM THE MARK AS SHOWN.

Filing Date

1988/04/04

Examining Attorney

REIHNER, DAVID C.

Attorney of Record

ROBERTO LEDESMA

SAN FRANCISCO
GIANTS

Print: Aug 8, 2011

85166712

DESIGN MARK

Serial Number

85166712

Status

REGISTERED

Word Mark

SAN FRANCISCO CALIFORNIA

Standard Character Mark

No

Registration Number

3933119

Date Registered

2011/03/15

Type of Mark

TRADEMARK

Register

SUPPLEMENTAL

Mark Drawing Code

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

Owner

Gogo Sports, Inc. CORPORATION CALIFORNIA 23385 Foley Street Hayward
CALIFORNIA 94545

Goods/Services

Class Status -- ACTIVE. IC 025. US 022 039. G & S: Caps; Hats;
Headwear; Jackets; Shirts; Sweat shirts; Tops. First Use: 2008/00/00.
First Use In Commerce: 2008/00/00.

Description of Mark

The mark consists of the stylized wording "SAN FRANCISCO CALIFORNIA".

Colors Claimed

Color is not claimed as a feature of the mark.

Filing Date

2010/11/02

Amended Register Date

2011/02/07

Examining Attorney

Print: Aug 8, 2011

85166712

NADELMAN, ANDREA K.

Attorney of Record
XAVIER MORALES

San Francisco
California