

**To:** Ilene B. Tannen([nytef@jonesday.com](mailto:nytef@jonesday.com))  
**Subject:** U.S. Trademark Application Serial No. 97120376 - JUNYA WATANABE - 005010-0076  
**Sent:** August 24, 2022 09:51:47 AM EDT  
**Sent As:** [tmng.notices@uspto.gov](mailto:tmng.notices@uspto.gov)

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**Attachments**

**United States Patent and Trademark Office (USPTO)  
Office Action (Official Letter) About Applicant's Trademark Application**

**U.S. Application Serial No.** 97120376

**Mark:** JUNYA WATANABE

**Correspondence Address:**

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JONES DAY  
250 VESEY STREET  
NEW YORK NY 10281 UNITED STATES

**Applicant:** Comme des Garçons Co., Ltd.

**Reference/Docket No.** 005010-0076

**Correspondence Email Address:** [nytef@jonesday.com](mailto:nytef@jonesday.com)

**NONFINAL OFFICE ACTION**

**The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be [abandoned](#).** Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

**Issue date:** August 24, 2022

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.

**SUMMARY OF ISSUES:**

- Identification of goods
- Consent
- Basis
- Declaration

## **SEARCH RESULT**

The trademark examining attorney has searched the USPTO database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). 15 U.S.C. §1052(d); TMEP §704.02.

## **IDENTIFICATION OF GOODS**

Some of the identification of goods are indefinite and must be clarified. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant must amend the identification to specify the common commercial or generic name of the goods. *See* TMEP §1402.01. If the goods have no common commercial or generic name, applicant must describe the product, its main purpose, and its intended uses. *See id.*

The identification of goods contains parentheses. Generally, an applicant should *not* use parentheses and brackets, including curly brackets, in identifications in order to avoid confusion with the USPTO's practice of using parentheses and brackets in registrations to indicate (1) goods and/or services that have been deleted from registrations, (2) goods and/or services not claimed in an affidavit of incontestability, or (3) guidance to users of the USPTO's [\*U.S. Acceptable Identification of Goods and Services Manual\*](#) to draft an acceptable identification. *See* TMEP §§1402.04, 1402.12. The only exception for including parenthetical information in identifications is if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity or scope of the identification, e.g., "fried tofu pieces (abura-age)." *See* TMEP §1402.12.

Therefore, applicant must remove the parentheses from the identification and incorporate any parenthetical or bracketed information into the description of the goods.

In addition, the wording "including" in the identification of goods is indefinite and must be deleted. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03(a). The identification must be specific and all-inclusive. This wording is an open-ended term (e.g., "such as") that is not acceptable because it fails to identify specific goods. *See* TMEP §1402.03(a).

For easier reference, the suggested amendments are shown in bold and italics.

Applicant may substitute the following wording, if accurate:

Folding briefcases, shoulder bags, Gladstone bags, briefcases, suitcases, carry-on bags, tote bags, ***trunks being luggage***, handbags, Boston bags, schoolchildren's backpacks, ***backpacks in the nature of rucksacks, credit card cases, textile shopping bags, wheeled shopping bags, purses not of precious metal***, key cases, ***wallets not of precious metal, commuter's-pass holders in the nature of mass transit card cases***, business card cases, ***vanity cases, not fitted***, umbrellas and their parts, parasols, industrial packaging containers of leather, clothing for domestic pets, walking sticks, canes, in international class 18;

Clothing, one-piece dresses, jackets, *clothing of leather, namely, (SPECIFY type of clothing, e.g., leather jackets, leather pants, etc.)*, suits, vests, coats, sweatshirts, trousers and pants, shirts, polo shirts, blouses, dresses, skirts, t-shirts, nightwear, underwear, evening gowns, sweaters, cardigans, overalls, garters, *belts for clothing*, waistbands, suspenders, neckties, scarves, hosiery, shoes, athletic shoes, overshoes, *headgear for wear, namely, hats and caps being headwear*, gloves, swimwear, boots, masquerade costumes, in international class 25.

Please note the parentheticals denote place(s) where the applicant must provide acceptable identifications. Any identification must be incorporated into the identification without the use of parentheticals or brackets.

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Applicant's goods may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different goods or add goods not found or encompassed by those in the original application or as acceptably amended. *See* TMEP §1402.06(a)-(b). The scope of the goods sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods will further limit scope, and once goods are deleted, they are not permitted to be reinserted. TMEP §1402.07(e).

**For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable [U.S. Acceptable Identification of Goods and Services Manual](#). *See* TMEP §1402.04. To expedite prosecution of this trademark application, when amending the identification as required above, the Office strongly encourages the applicant to select pre-approved wording contained within this manual that accurately describes the goods and/or services therein. Failure to do so may result in delay.**

## **CONSENT**

Applicant must clarify whether the name JUNYA WATANABE in the mark identifies a particular living individual. *See* 37 C.F.R. §2.61(b); TMEP §§813, 1206.03. In this case, the application neither specifies whether the name in the mark identifies a particular living individual nor includes a written consent. *See* TMEP §§813.01(a)-(b), 1206.04(a), 1206.05. In addition, although the applicant claims ownership of prior registrations containing the same name that shows a consent statement, in this case, the applicant did not state that the consent is of record therein. TMEP § 1206.04(c).

To register a mark that consists of or comprises the name of a particular living individual, including a first name, pseudonym, stage name, or nickname, an applicant must provide a written consent personally signed by the named individual. 15 U.S.C. §1052(c); TMEP §§813, 1206.04(a).

**Accordingly, if the name in the mark does not identify a particular living individual**, applicant must submit a statement to that effect (e.g., "The name shown in the mark does not identify a particular living individual.").

**However, if the name in the mark does identify a particular living individual**, applicant must submit both of the following:

- (1) The following **statement**: "The name(s) shown in the mark identifies a

living individual(s) whose consent(s) to register is made of record.” If the name is a pseudonym, stage name, or nickname, applicant must provide the following statement: “JUNYA WATANABE identifies (specify name), a living individual whose consent is of record.”

(2) **A written consent**, personally signed by the named individual(s), as follows: “I, (specify name), consent to the use and registration of my name, JUNYA WATANABE, as a trademark and/or service mark with the USPTO.”

For an overview of the requirements for names appearing in marks, and instructions on how to satisfy this requirement using the online Trademark Electronic Application System (TEAS) response form, see the [Name/Portrait/Signature of Particular Living Individual in Mark webpage](#).

Applicant has a duty to respond directly and completely to this requirement for information. *See In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at \*2 (TTAB 2019) (citing *In re AOP LLC*, 107 USPQ2d 1644, 1651 (TTAB 2013)); TMEP §814. Failure to comply with a requirement for information is an independent ground for refusing registration. *In re SICPA Holding SA*, 2021 USPQ2d 613, at \*6 (TTAB 2021) (citing *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI P’ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003); TMEP §814).

## **BASIS**

The application specifies both an intent to use basis under Trademark Act Section 1(b) and a claim of priority under Section 44(d) based on a foreign application. *See* 15 U.S.C. §§1051(b), 1126(d); 37 C.F.R. §2.34(a)(2), (a)(4). However, no copy of a foreign registration has been provided even though the application indicates applicant’s intent to rely on Section 44(e) as an additional basis for registration. *See* 15 U.S.C. §1126(e).

An application with a Section 44(e) basis must include a true copy, photocopy, certification, or certified copy of a foreign registration from an applicant’s country of origin. 15 U.S.C. §1126(e); 37 C.F.R. §2.34(a)(3)(ii); TMEP §§1004, 1004.01, 1016. In addition, an applicant’s country of origin must be a party to a convention or treaty relating to trademarks to which the United States is also a party, or must extend reciprocal registration rights to nationals of the United States by law. 15 U.S.C. §1126(b); TMEP §§1002.01, 1004.

Therefore, applicant must provide a copy of the foreign registration from applicant’s country of origin when it becomes available. TMEP §1003.04(a). A copy of a foreign registration must consist of a document issued to an applicant by, or certified by, the intellectual property office in applicant’s country of origin. TMEP §1004.01. If applicant’s country of origin does not issue registrations or Madrid Protocol certificates of extension of protection, applicant may submit a copy of the Madrid Protocol international registration that shows that protection of the international registration has been extended to applicant’s country of origin. TMEP §1016. In addition, applicant must also provide an English translation if the foreign registration is not written in English. 37 C.F.R. §2.34(a)(3)(ii); TMEP §1004.01(a)-(b). The translation should be signed by the translator. TMEP §1004.01(b).

If the foreign registration has not yet issued, or applicant requires additional time to procure a copy of the foreign registration (and English translation, as appropriate), applicant should so inform the trademark examining attorney and request that the U.S. application be suspended until a copy of the foreign registration is available. TMEP §§716.02(b), 1003.04(b).

If applicant cannot satisfy the requirements of a Section 44(e) basis, applicant may request that the mark be approved for publication based solely on the Section 1(b) basis. *See* 15 U.S.C. §§1051(b), 1126(e); 37 C.F.R. §2.35(b)(1); TMEP §§806.02(f), 806.04(b), 1003.04(b). Although the mark may be approved for publication on the Section 1(b) basis, it will not register until an acceptable allegation of use has been filed. *See* 15 U.S.C. §1051(c)-(d); 37 C.F.R. §§2.76, 2.88; TMEP §1103. Please note that, if the U.S. application satisfied the requirements of Section 44(d) as of the U.S. application filing date, applicant may retain the priority filing date under Section 44(d) without perfecting the Section 44(e) basis, provided there is a continuing valid basis for registration. *See* 37 C.F.R. §2.35(b)(3)-(4); TMEP §§806.02(f), 806.04(b).

Alternatively, applicant has the option to amend the application to rely solely on the Section 44(e) basis and request deletion of the Section 1(b) basis. *See* 37 C.F.R. §2.35(b)(1); TMEP §806.04. The foreign registration alone may serve as the basis for obtaining a U.S. registration. *See* 37 C.F.R. §2.34(a)(3); TMEP §806.01(d).

## **DECLARATION**

The application was unsigned, resulting in the application not being properly verified. *See* TMEP §804. Applicant must properly sign and therefore verify the application in an affidavit or signed declaration under 37 C.F.R. §2.20. *See* 37 C.F.R. §§2.2(n), 2.33(a), (b)(2)-(c), 2.34(a)(2), (a)(3)(i), (a)(4)(ii); TMEP §804.02.

The following statements must be verified: That applicant has a bona fide intention to use the mark in commerce and had a bona fide intention to use the mark in commerce as of the application filing date; that applicant believes applicant is entitled to use the mark in commerce on or in connection with the goods or services specified in the application; that to the best of the signatory's knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive; and that the facts set forth in the application are true. 37 C.F.R. §§2.33(b)(2), (c), 2.34(a)(2), (a)(3)(i), (a)(4)(ii).

For more information about the verified statement and instructions on providing one using the online Trademark Electronic Application System (TEAS) response form, see the [Verified statement](#) webpage.

**How to respond.** [Click to file a response to this nonfinal Office action.](#)

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## RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to [abandon](#).** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or [unforeseen circumstances](#) could affect an applicant's ability to timely respond.
- **[Responses signed by an unauthorized party](#)** are not accepted and can **cause the application to [abandon](#)**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find [contact information for the supervisor](#)** of the office or unit listed in the signature block.

## United States Patent and Trademark Office (USPTO)

### USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued  
on August 24, 2022 for  
**U.S. Trademark Application Serial No. 97120376**

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action in order to avoid your application abandoning. Follow the steps below.

- (1) **[Read the Office action](#)**. This email is NOT the Office action.
- (2) **Respond to the Office action by the deadline** using the Trademark Electronic Application System (TEAS). Your response must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response period. Otherwise, your application will be **[abandoned](#)**. See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO **[website](#)**, the application process, the status of your application, and whether there are outstanding deadlines to the **[Trademark Assistance Center \(TAC\)](#)**.

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

### GENERAL GUIDANCE

- **[Check the status](#) of your application periodically** in the **[Trademark Status & Document Retrieval \(TSDR\)](#)** database to avoid missing critical deadlines.
- **[Update your correspondence email address](#)** to ensure you receive important USPTO notices about your application.
- **[Beware of trademark-related scams](#)**. Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. And all official USPTO correspondence will only be emailed from the domain “@uspto.gov.” Verify the correspondence originated from us by using your Serial Number in our database, **[TSDR](#)**, to confirm that it appears under the “Documents” tab, or contact the **[Trademark Assistance Center](#)**.

- **Hiring a U.S.-licensed attorney.** If you do not have an attorney and are not required to have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.



Statistics for Case 97120376						
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration
1	97120376[sn]	1	0	1	1	0:00
2	*{"gj"}{"eou"}{"ouw"0:1}nya*[bi,ti] and live[ld]	29	0	23	23	0:00
3	*watanab{"ite"}*[bi,ti] and live[ld]	10	0	10	10	0:00
4	*watanab*[bi,ti] and live[ld]	10	0	10	10	0:00
5	*wat\$ nab*[bi,ti] and live[ld]	10	0	10	10	0:00
6	*wat*[bi,ti] and live[ld]	15448	0	0	0	0:01
7	*nab*[bi,ti] and live[ld]	5394	0	0	0	0:01
8	6 and 7	26	0	23	23	0:00
9	4746382	4	0	4	4	0:00
10	2032607	14	0	4	4	0:00
11	5895311	2	0	2	2	0:00
12	*man*[bi,ti] and live[ld]	54458	0	0	0	0:01
13	*men*[bi,ti] and live[ld]	57733	0	0	0	0:01
14	(12 13) and "018"[cc]	39021	0	0	0	0:00
15	(12 13) and "025"[cc]	36210	0	0	0	0:00
16	(12 13) and ("018" or "a" or "b" or "200")[ic]	2466	0	0	0	0:01
17	(12 13) and ("025" or "a" or "b" or "200")[ic]	8830	0	0	0	0:01
18	(12 13) and ("035" or "a" or "b" or "200")[ic]	18278	0	0	0	0:01
19	(12 13) and ("042" or "a" or "b" or "200")[ic]	11539	0	0	0	0:01
20	("e y e" "e ye" "ey e" *eye*)[bi,ti] not dead[ld]	8269	0	0	0	0:01
21	20 and "018"[cc]	2726	0	0	0	0:00
22	20 and "025"[cc]	2173	0	0	0	0:00
23	20 and ("018" or "a" or "b" or "200")[ic]	92	0	35	35	0:01
24	20 and ("025" or "a" or "b" or "200")[ic]	514	0	30	30	0:02
25	20 and ("035" or "a" or "b" or "200")[ic]	904	0	0	0	0:01
26	20 and ("042" or "a" or "b" or "200")[ic]	710	0	0	0	0:01
27	6182481	2	0	2	2	0:00
28	6058886	2	0	2	2	0:00
29	4746382,	4	0	4	4	0:00

Session started 08/24/2022 9:11 am

Session ended 08/24/2022 9:23 am

Total search duration 14.00

Session duration 12 minutes 2 seconds

Adjacency Level 1

Near Level 1