

RESPONSE

This filing is in response to the Office Action mailed March 9, 2016, in which the Examining Attorney initially refused registration of Application Serial No. 86/817,381 for the mark PHANTOM (“Applicant’s Mark”) under Section 2(d) of the Lanham Act on the grounds that the mark is likely to be confused with U.S. Trademark Registration Nos 2,250,131 for the mark PHANTOM and 3,175,600 for the mark PHANTOM (hereinafter the “Cited Marks”).

REMARKS

I. APPLICANT’S MARK IS NOT LIKELY TO BE CONFUSED WITH THE CITED MARKS.

Registration of Applicant’s Mark, PHANTOM, for “Noise suppressors for guns” in International Class 013 and in use since 1997, has been refused by the Examining Attorney over the Cited Marks, PHANTOM in International Class 013, for the goods of “center fire cartridges” and in use since 1998, and PHANTOM in International Class 013, for the goods of “airguns”, in use since 2006.

The Applicant respectfully submits that the Applicant’s Mark is not confusingly similar to the Cited Marks. In determining whether there is a likelihood of confusion, the court in *In re DuPont De Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) listed a number of factors to consider in making such a determination. The Examiner points out only three of these factors: The similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the good. Applicant submits that when all of the *DuPont* factors are considered, the marks themselves and the goods are sufficiently dissimilar to eliminate a likelihood of confusion.

Specifically, Applicant submits that careful consideration of several *DuPont* factors, such as:

- (A) The number and nature of the marks comprising a similar term;
- (B) Dissimilarity of the goods

weigh toward a finding of no likelihood of confusion between the Applicant's Mark and the Cited Marks.

A. The Number and Nature of the Marks Comprising a Similar Term Weighs Toward a Finding of no Likelihood of Confusion.

The sixth *DuPont* factor recognizes that the less distinctive a mark, the greater the likelihood that use on non-competitive goods or services will not cause confusion. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 comment i (Tentative Draft No. 2, 1990); *Plus Products v. Plus Discount Foods, Inc.*, 722 F.2d 999 (2d Cir. 1983); *Cotton Club Bottling Co. v. American Brands, Inc.*, 174 U.S.P.Q. 343 (T.T.A.B. 1972); *Nestles Milk Products, Inc. v. Baker Importing Company*, 182 F.2d 193 (C.C.P.A. 1950). For example, the use of "KICK-ER" was found not to cause likely confusion with "KIK-IT" when both were used on tabletop soccer games, because the common element "kick" is suggestive of such games. *Affiliated Hospital Products, Inc. v. Merdel Game Mfg. Co.*, 513 F.2d 1183 (2d Cir. 1975); *In re Hamilton Bank*, 222 U.S.P.Q. 174 (T.T.A.B. 1984) (no likelihood of confusion found between "KEY" for banking services and other marks for banking containing the word "key"; the common word "key" is weak, is widely used in the financial field, and is suggestive of a desirable characteristic of banking); *Worster Brush Co. v. Prager Brush Co.*, 231 U.S.P.Q. 316 (T.T.A.B. 1986) (no likelihood of confusion between "POLY PRO" and "POLY FLOW" for paint brushes, because of weak descriptive "Poly" (made of polyester or polymers), and weak "PRO" (professional quality) and weak "FLO" (flows easily)).

When a mark is merely one in a crowd of marks, "customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other." MCCARTHY § 11.85 p.11-144, *citing Standard Brands, Inc. v. RJR Foods, Inc.*, 192 U.S.P.Q. 383, 385 (T.T.A.B. 1976); *Miss World (UK) Ltd. v. Mrs. America Pageants*, 856 F.2d 1445 (9th Cir. 1988). Thus, courts have held that marks and words which are in common use, such as ROYAL, BLUE RIBBON, ADVANTAGE, PREMIUM and NATIONAL have all been classified as "weak." *See* MCCARTHY § 11.86 and cases cited therein. The realities of the marketplace are that small differences are important in distinguishing among goods and services.

The list of numerous marks which identify goods and services with the term "PHANTOM" in International Class 013 (Table A, below) which identifies numerous marks incorporating the term PHANTOM, or using PHANTOM alone, used on very similar or identical goods (Table B, below) is evidence that the Cited Marks are weak marks entitled to only an extremely narrow scope of protection. Further, altogether, more than 276 marks are registered or pending applications with the USPTO containing the word PHANTOM (and slight variants). The foregoing facts clearly demonstrate that the public has learned to distinguish between these numerous marks used for various related goods using the term "PHANTOM," that the Patent and Trademark Office has recognized this public awareness, and that there would be no likelihood of confusion resulting from the use of the Cited Mark or the registration of Applicant's Mark.

Table A

1	86909553		PHANTOM	TSDR	LIVE
2	86663383		PHANTOM ELITE	TSDR	LIVE
3	86817381		PHANTOM	TSDR	LIVE
4	86317338	4687987	PHANTOM PHAN-TASTIC	TSDR	LIVE
5	86269129	4656013	PHANTOM SPIKES	TSDR	LIVE
6	85119927	3965200	PHANTOM OC BY SABRE	TSDR	LIVE
7	85583515	4249587	PHANTOM ULTIMATE PARTY	TSDR	LIVE

8	85417681	4193325	PHANTOM FIREWORKS EXPRESS	TSDR	LIVE
9	85196141	4005572	PHANTOM PIXIE DUST	TSDR	LIVE
10	85017928	4013383	PHANTOM EXPRESS	TSDR	LIVE
11	85298092	4292906	PHANTOM	TSDR	LIVE
12	85298064	4283527	PHANTOM	TSDR	LIVE
13	78781609	3175600	PHANTOM	TSDR	LIVE
14	77879003	3821039	PHANTOM'S FURY	TSDR	LIVE
15	77672149	3710491	PHANTOM DRAGON SLAYER	TSDR	LIVE
16	77672119	3710490	PHANTOM MYSTICAL MAGIC	TSDR	LIVE
17	77319665	3541435	PHANTOM STRIKE	TSDR	LIVE
18	77247574	3385232	PHANTOM MAN-O-WAR	TSDR	LIVE
19	77231873	3573388	PHANTOM THUNDER	TSDR	LIVE
20	77147056	3395624	OPERATION PHANTOM FURY	TSDR	LIVE
21	76163706	2580167	PHANTOM MISSILE BASE	TSDR	LIVE
22	75245642	2250131	PHANTOM	TSDR	LIVE
23	74584780	1923560	PHANTOM	TSDR	LIVE
24	74584779	1923559	PHANTOM	TSDR	LIVE

Table B

1	86909553		PHANTOM	Component parts for pistols; Component parts for rifles; Firearms; Guns; Pistols; Pistols and parts thereof; Rifles; Rifles and parts thereof
2	86663383		PHANTOM ELITE	Air pistols; Bullets; Firecrackers; Gun barrels; Gun cartridges; Gun cases; Guns; Gunstocks; Hunting rifles; Non-telescopic gun sights for firearms; Personal defense sprays; Sights, namely, open sights for use on firearms.
3	86817381		PHANTOM	Noise suppressors for guns (Application which is the issue of this Response)
4	86317338	4687987	PHANTOM PHAN-TASTIC	fireworks
5	86269129	4656013	PHANTOM SPIKES	projectiles, namely, devices ejected onto roads to deflate tires
6	85119927	3965200	PHANTOM OC BY SABRE	Pepper spray
7	85583515	4249587	PHANTOM ULTIMATE PARTY	fireworks
8	85417681	4193325	PHANTOM FIREWORKS EXPRESS	fireworks
9	85196141	4005572	PHANTOM PIXIE DUST	fireworks
10	85017928	4013383	PHANTOM EXPRESS	fireworks

11	85298092	4292906	PHANTOM	Grenade pouches (additional goods outside of class 013)
12	85298064	4283527	PHANTOM	Grenade pouches (additional goods outside of class 013)
13	78781609	3175600	PHANTOM	Airguns
14	77879003	3821039	PHANTOM'S FURY	Fireworks
15	77672149	3710491	PHANTOM DRAGON SLAYER	Fireworks
16	77672119	3710490	PHANTOM MYSTICAL MAGIC	Fireworks
17	77319665	3541435	PHANTOM STRIKE	Fireworks
18	77247574	3385232	PHANTOM MAN-O-WAR	Fireworks
19	77231873	3573388	PHANTOM THUNDER	Fireworks
20	77147056	3395624	OPERATION PHANTOM FURY	Fireworks
21	76163706	2580167	PHANTOM MISSILE BASE	Fireworks
22	75245642	2250131	PHANTOM	Center fire cartridges
23	74584780	1923560	PHANTOM	Fireworks
24	74584779	1923559	PHANTOM	Fireworks

As stated by Professor McCarthy:

[A] mark that is hemmed in on all sides by similar marks on similar goods cannot be very “distinctive.” It is merely one of a crowd of marks. In such a crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other. . . . Thus, in a “crowded” field of similar marks, each member of the crowd is relatively “weak” in its ability to prevent use by others in the crowd.

MCCARTHY § 11.26[1], at 11-141.

Given the number of “PHANTOM” registrations for related goods and services, the word PHANTOM is “merely part of a crowd of marks,” and customers are not likely to be confused between Applicant’s Mark and the Cited Marks merely because they share this common term.

II. OWNERS OF THE CITED MARKS HAVE GIVEN CONSENT TO APPLICANT’S REGISTRATION.

Applicant’s use of the mark precedes the uses of PHANTOM by the owners of the Cited Marks. Applicant has maintained continuous use of the PHANTOM trademark on its noise suppressors for guns since 1997, which predates both of the Cited Marks. In nineteen years of use of the PHANTOM trademark, Applicant has not received any opposition from the owners of the Cited Marks herein. There

has been nineteen years of peaceful co-existence in the marketplace, indicating that the owners of the Cited Marks do not perceive any potential consumer confusion in the Applicant's use of the PHANTOM trademark.

Applicant is in the process of negotiating signed consent to registration from the owners of the Cited Marks. The signed consent will be forthcoming and filed herein. The parties have agreed that the marks may co-exist which renders the precedence of the Marks moot.

III. PRIOR FILED APPLICATION MAY NOT BE AT ISSUE

The Examiner has cited U.S. Application Serial No. 86/663,383 as a prior filed application which may bar registration of Applicant's mark. Serial No. 86/663,383 has an outstanding Office Action dated April 19, 2016 in which the Examiner issued a final rejection. Although this application has not yet abandoned, Applicant believes it may abandon shortly and no longer be at issue.

CONCLUSION

Applicant has addressed all outstanding issues raised by the Examining Attorney. Applicant respectfully requests that the application be approved for publication and requests that the Examining Attorney take such action.