

Response to Office Action (Ser. No. 87153849)

**Preface:**

The applicant's mark, "CHALLENGER" (Ser. No. 87153849) was previously registered on the principal register at Reg. No. 78485438 in the same class, with the same specimen and the same description of specimen, but was cancelled when applicant failed to timely file a Section 8 renewal. On August 29, 2016, applicant sought new registration for the same mark, which has been in use in commerce since January 1, 1992.

Pursuant to 37 C.F.R. §2.36, it is not necessary to assert ownership of expired or cancelled registrations. Notably, the examining attorney did not cite the prior registration against the registrant. TMEP 812.01.

**Specific Responses:**

1. Response to Section 2(d) refusal.

**Errors in Office Action Recitation of Application.** The examining attorney's refusal is premised on a false reading of the applicant's mark. See "Similarity of the Marks" section of Office Action dated 12/9/16. It mischaracterizes the applicant's mark as using the word "**CHALLENGE**", when in fact, the application seeks registration of mark which features the word "**CHALLENGER**". The refusal further mischaracterizes the ostensibly confusing mark "AED CHALLENGE" (Reg. No. 3126782), a word mark, by insisting that it features the word "**CHALLENGER**" (which it does not). Furthermore, the Office Action relies on more than thirty other, unrelated marks, which have absolutely no relationship to the application herein.

**No Commercial Relationship between Marks.** There is no likelihood of confusion between these marks because the applicant's mark "CHALLENGER" appears on the applicant's products, whereas the registrant's mark "AED CHALLENGE" only appears on its web site. The two marks are not commercially related for the purposes of a section 2(d) analysis; they travel in different trade channels and target a different class of purchasers. Prospective purchasers would never believe these goods and services emanate from the same source because "AED CHALLENGE" is a **non-downloadable web service** and, by contrast, "CHALLENGER" materials are "Computer software for clinical training and diagnostic material for use in the medical field that may be downloaded from a global computer network." There is a difference and it is not immaterial.

**No Likelihood of Confusion.** Additionally, "AED CHALLENGE" refers to a service that is identified primarily by "AED", **not** by the disclaimed word "challenge", and which stands for "automated external defibrillators" and which targets a training service to a very unique, discrete class of technicians. AED CHALLENGE is a "service" for these technicians. The applicant's "CHALLENGER" mark, by contrast, has been in use in commerce for more than 25 years on hundreds of "goods" (products) that have been registered with the Copyright Office and which are directed at hospitals, clinics, doctors and nurses.

The applicant has not simply substituted the design element for the literal element "AED" as suggested in the Office Action. Rather, these are two distinct marks, one characterized by the design featuring the knight, and the other characterized by the letters "AED".

2. Identification of Goods Requirement. The applicant wishes to amend the identification of goods as suggested to read, "Computer software for clinical training and diagnostic material for use in the medical field that may be downloaded from a global computer network. "