

RESPONSE ARGUMENTS FOR “TRACKER”

(S/N 88/088,415)

2d Arguments: The Examiner has refused registration of the applied-for mark under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) in view of Registration No. 1,629,823 for the mark TRACKER (the “‘823 Mark”) and Registration No. 4,503,615 for the mark VIGO TRACKER (the “‘615 Mark”). For the reasons stated herein, Applicant respectfully disagrees, and requests that the Examiner reconsider her rejection of the Application in view of the following arguments and Applicant’s amendment of the statement of goods.

An Examining Attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the Examining Attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E.I. DuPont de Nemours & Co.*, 177 U.S.P.Q. 563 (CCPA 1973). Second, the Examining Attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 U.S.P.Q. 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 U.S.P.Q. 910 (TTAB 1978); *Guardian Products Co. v. Scott Paper Co.*, 200 U.S.P.Q. 738 (TTAB 1978). Applicant respectfully asserts that after review of the first and second prongs of the likelihood of confusion analysis, there is no likelihood of confusion between Applicant’s “TRACKER” mark for use with the revised description of goods and either of the ‘615 or ‘823 Marks.

First, with respect to the comparison of the marks, namely TRACKER vs. VIGO TRACKER, the mere inclusion of the word TRACKER in the applied for mark does not lend itself to creating confusion in the marketplace with VIGO TRACKER, particularly when each of (i) the goods associated with the marks, (ii) the use of said goods, and (iii) the types of purchasers of said goods are vastly different, as explained more fully below. Therefore, any likelihood of confusion between the respective marks is minimal at best.

Having addressed the first prong of the likelihood of confusion analysis with respect to the ‘615 Mark, Applicant now turns its attention to the second prong of the analysis with respect to both the ‘823 Mark and the ‘615 Mark. Applicant respectfully asserts that the goods themselves are substantially different from one another and the channels of trade are substantially different, such that the likelihood of confusion, if any, is minimal at best. More specifically, Applicant has amended and limited its identification of goods to “*pistons for motorcycles*”, and those goods are primarily directed at sophisticated purchasers of aftermarket motorcycle parts which are solely used in land based applications (as opposed to a water based application).

By comparison, the goods in relation to the ‘823 Mark are “*internal combustion outboard motors for boats*”, which has no relation to land vehicles, or motorcycles specifically. Further, because most internal combustion outboard motors for boats costs several thousands of dollars (if not tens

of thousands of dollars), the purchasers of said outboard motors for boats are going to be sophisticated purchasers and well informed before making such a substantial purchase. Finally, outboard motors for boats are typically advertised and sold in different marketplaces and/or channels of commerce than motorcycle parts (as explained more fully below). Because the respective products are (i) vastly different, (ii) used in vastly different applications, (iii) travel in vastly different channels of commerce, and (iv) are purchased by sophisticated purchasers, there is little, if any, likelihood of confusion between Applicant's Mark and the '823 Mark.

Similarly and also by comparison, the goods in relation to the '615 Mark are "*motors and engines and parts therefor, except for land vehicles*", and have nothing to do with land vehicles such as motorcycles. Indeed, the registrant of the '615 Mark specifically disclaims land vehicles in the description. Further, most motors and engines used in water based applications, as opposed to land based applications, have different requirements and technical specifications (e.g., must be moisture resistant, anti-corrosive, properly sealed, etc.) that are readily available to the purchasers of said motors, engines and parts. For example, most boat or watercraft enthusiast know that different engines and/or parts may be required depending on whether the boat or other watercraft will be used in a salt water application, as opposed to freshwater application. For these reasons, motors, engines and parts that are meant for water based applications are typically advertised and sold in different marketplaces and/or channels of commerce than that of motorcycle parts. Because the respective products are (i) vastly different, (ii) used in vastly different applications, (iii) travel in vastly different channels of commerce, and (iv) are purchased by sophisticated purchasers, there is little, if any, likelihood of confusion between Applicant's Mark and the '615 Mark.

In conclusion, for the reasons stated herein, Applicant respectfully requests that the Examining Attorney reconsider the Section 2(d) rejection.