

I. Response to Primary Basis for Refusal of Registration Under Trademark Act Section 2(d), 15 U.S.C. §1052(d)

In the Office Action for U.S. Trademark Application No.88163192 DISCOVERY and design (the 'Applicant's Mark') the examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the grounds that it creates a likelihood of confusion with the mark in U.S. Registration No. 3522143 (the 'Cited Registration'). Applicant does not agree with this conclusion, and in further support of its original application ('Application'), hereby submits this Response and requests that the examining attorney reconsider his prior determination concluding that the Application should be refused.

Applicant's mark is 'DISCOVERY and design' for 'Sighting mirrors for guns and rifles' in International Class 13.

U.S. Registration Number 5350685 is 'DISCOVERY' for 'Airguns' in International Class 13.

II. The Applicant's Mark Passes The DuPont Multi-Factor Test And Proves There Is No Confusion, Mistake, or Deception With The Registered Marks

In testing for likelihood of confusion under Section 2(d), the Du Pont factors need to be considered, including factors such as the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; the purchasers of the goods i.e. "impulse" vs. careful, sophisticated purchasing; and the number and nature of similar marks in use on similar goods. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).

A. The Applicant's Mark Is Different From The Registered Mark In Appearance and Commercial Impression

The first matter to consider is the similarity on the face of the marks. Here, the Applicant's mark is different from the registered mark. Namely, the Applicant's mark consists of DISCOVERY and design. By contrast, the registered mark consists of word, "DISCOVERY".

However, cited Registration is for trademarks consisting of standard characters without claim to any particular font style, size, or color, whereas the Applicant's Mark consist of 'DISCOVERY' in stylized font with designs of vertical line and bullseye.

B. Registrants Do Not Have the Exclusive Right to the Term 'world'

There is another registered marks on the USPTO in class 13 which include the term 'DISCOVERY'--87765387 'FORT DISCOVERY' for 'Firearms; firearm accessories, namely, cleaning kits, arm slings, lower receivers, magazines, safety equipment; ammunition' in class 13.

This filing shows that the term 'DISCOVERY' is commonly used such that the public will look to other elements to distinguish the source of the goods or services. See, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (C.C.P.A. 1973); *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983).

C. The Applicant's Mark Is Different from The Registered mark in its Goods and Services/ Trade Channels

In the Office Action, the examining attorney states that "The goods and/or services are compared to determine whether they are similar, commercially related, or travel in the same trade channels " to find a likelihood of confusion.

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Accordingly, the goods of cited registration are airguns for sport use while the goods of applicant's mark are sighting mirrors for guns and rifles for military use, they are distinct enough from one another in trade channels and customer group.

Conclusion

In view of the arguments above, Applicant respectfully requests that Examiner withdraw the objection listed in the office action and allow the Applicant's trademark application to proceed for publication in the Official Gazette.