

## RESPONSE TO OFFICE ACTION

### Introduction

This Response is made to the Office Action dated February 6, 2019. In the action, the Examining Attorney refused registration of the Applicant's SAVAGE mark by concluding that there would be a likelihood of confusion with the mark in U.S. Registration No. 5511432.

Regarding the likelihood of confusion, Applicant submits that there is a significant difference between the consumers of products branded with Applicant's mark and those of the Registrant's mark. As a preliminary matter, the mere *possibility* (emphasis added) that relevant consumers might relate two different marks does not meet the statutorily established test of likelihood of confusion. *See e.g. In re Hughes Aircraft Company*, 222 U.S.P.Q. 263, 264 (TTAB 1984) ("the Trademark Act does not preclude registration of a mark where there is a possibility of confusion as to source origin, only where such confusion is likely). The likelihood of confusion analysis relies on consumer impression. As such, consumer's actual impressions, not just the words that make up each mark, are an integral part of the analysis. As further explained below, consumers are not likely to confuse the source of the Applicant's and Registrant's respective goods/services. Accordingly, the Examining Attorney should withdraw the refusal and allow the Applicant to pursue registration.

### Applicant's Business

Applicant began using the Applicant mark in commerce on November 2, 2012, specifically by selling sports clothing that featured the SAVAGE mark. Applicant's website is a marketplace that allows alternative sports teams (such as those that play Quidditch, Disc Golf, and Spikeball) to order custom-crafted clothing (See **Exhibit A**, which features Major League Quidditch items for sale). Customers can also purchase non-custom materials for the above-referenced sports. Applicant's business mission is "To supply brand and customizable apparel to the active world." (See **Exhibit B**.) According to press coverage for the company, Applicant specifically targets niche markets. (See **Exhibit C**.) Their customer-base is a sophisticated, targeted group of consumers that purchase apparel from Applicant that they know is not available elsewhere. Applicant has successfully been in business for nearly a decade and has cultivated a loyal following, something akin to a community for players in the alternative sports world. (See **Exhibit D** for a screenshot of Applicant's Instagram account showcasing players wearing Applicant's apparel.)

### Registrant's Business

Registrant did not file for a trademark or even begin using the mark in commerce until July of 2017, several years after Applicant had already established a successful business and niche following. Registrant does not appear to actually offer any clothing for sale on Registrant's website. (See **Exhibit E**.) Registrant's website features the owner's biography, a defunct blog with no content, and advertises a computer application to assist brand developers with analyzing style metrics. (See **Exhibit F**.) Although Applicant and Registrant have registered their marks in the

same class, they provide vastly different services and products, and are not in conflict with one another.

### **Likelihood of Confusion**

#### **Factors Relevant to Determining Likelihood of Confusion:**

The Office Action addresses only a few of the relevant factors in determining likelihood of consumer confusion. While the marks in question both include the word “SAVAGE,” and the applicable description of goods and services offered refer to goods and services in the same class, these factors are not solely determinative of the likelihood of confusion. A more in-depth analysis of the referenced *Dupont* factors reveals that there is no likelihood of consumer confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)

#### **Similarity of Trade Channels**

The similarity or dissimilarity of established, likely to continue trade channels is important to consider when establishing a likelihood of confusion. *See e.g. du Pont*, 476 F.2d at 1362. A trade channel generally refers to a route through which a good or service must travel to reach a consumer. Although both Applicant and Registrant have registered their mark in class 25, the way in which they offer goods for sale is extremely different.

Applicant’s materials are available for purchase exclusively on Savage Ultimate’s website, meaning that Applicant’s cannot purchase the clothing or place custom orders through any other retailer. Conversely, while Registrant does not appear to be offering any items for sale at the moment, there is no indication that any items for sale were or ever will be available anywhere other than Registrant’s website. This disparity in trade channels weighs in favor of the registration of the Applicant Mark.

#### **Degree of Care in Purchasing**

In *Astra Pharmaceutical Prods. v. Beckman Instruments*, the court held that the use in the same broad field is “not sufficient to demonstrate that a genuine issue exists concerning likelihood of confusion. (*Astra Pharmaceutical Prods. v. Beckman Instruments* 718 F.2d at 1206, 220 USPQ at 790.) As stated in *Astra*, “If likelihood of confusion exists, it must be based on the confusion of some relevant person; i.e. a customer or purchaser.” (718 F.2d 1201, 1206, 220 USPQ 786, 790 (1<sup>st</sup> Cir. 1983)). *See Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, (954 F. 2d 713, 718, 21 USPQ2d (BNA) 1388) [ stating that relevant persons would encompass all who might know of their services and then become purchasers of goods or services of others. The concern for likelihood of confusion is directed towards actual and potential purchasers.]

If the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption

that they originate from the same source, then, even if the marks are identical, confusion is not likely. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board's dismissal of opposer's likelihood-of-confusion claim, noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence).

In the case of Applicant's mark, there is no likelihood of confusion with Registrant's mark despite registration in the same class. The goods and services offered by Applicant and Registrant are so different that they would not create the assumption that they originate from the same source. Applicant's customers are looking for specialty sports clothing in alternative sports. Applicant's consumers are in search of items related to sports such as Quidditch (a sport adopted from the *Harry Potter* series), disc golf (a flying disc sport in which players throw a disc at a target), and spikeball (a sport of roundnet inspired by volleyball.) Consumers are passionate about these sports, partaking in team tournaments and using Applicant's services to buy apparel that they will never find sold at a traditional store. Although currently it does not seem that Registrant is selling any clothing, the target consumers of Registrant's services appear to be sophisticated brand owners (those that would utilize the type of metrics analysis application on Registrant's website), and not those who are looking to buy apparel in alternative sports. Therefore, it is extremely unlikely that consumers of Registrant's marks will be confused by Applicant's website of materials such as Quidditch jerseys.

### **The Nature and Extent of Actual Confusion**

Applicant is not aware of any actual confusion with respect to the parties' respective use of the marks.

### **Use of the Mark in Commerce**

Even if the Examiner determines that there is a likelihood of confusion, the Registrant's mark is not used in commerce and therefore the mark should be cancelled on that basis. The very foundation of trademark law requires that a mark be used in commerce to obtain and maintain federal registration. 15 USC §1051(a). The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. 15 USC §1127. As discussed herein, it seems that Registrant has ultimately discontinued the use of its mark in commerce in connection with the sale of apparel. Registrant's website available at <http://sonsofsavage.com> and as set forth in Exhibits E and F herein, displays the Registrant's mark, but indicates no goods or services for sale in connection with the same. Rather, the Registrant appears to only offer a software application for tracking sales data, a wholly different class of

goods and services. Thus, Registrant does not appear to be using its mark in connection with the sale of the same type goods or services. Rather, Registrant appears to be merely reserving the right to do the same. Conversely, Applicant maintains an online store and offers dozens of types of apparel for sale, under its Mark.

Finally, as discussed herein, Applicant has a clear priority of use over Registrant, as it began using its Mark in 2012. Coupled with the fact that Registrant is no longer using its mark in commerce insofar as its original registration application indicates, Applicant would be able to successfully petition for the cancellation of Registrant's mark, if the USPTO refuses to accept Applicant's Mark for registration. However, Applicant should not be forced to engage in a lengthy and costly judicial process to obtain the right to use its Mark. In light of the foregoing, the USPTO should immediately allow Applicant to move forward with the Mark's registration.

***Conclusion:***

Applicant submits that due to the extreme differences between the potential consumers of Applicant's products and Registrant's products, the cited mark and the Applicant's mark offer no likelihood of confusion. Therefore, Applicant respectfully requests that the Examining Attorney approve the Application for publication at the earliest possible date.

# EXHIBIT A

The screenshot shows a web browser window with the URL <https://savageultimate.com/collections/major-league-quidditch>. The page features the Savage Apparel Co. logo and a navigation menu with links for SHOP, PARTNER STORES, TEAM MARKETPLACE, POWERED BY SAVAGE, GREENBACK, BLOG, and CONTACT. The main content area is titled "MAJOR LEAGUE QUIDDITCH" and "Major League Quidditch Pro Shop" with the subtext "Support your team!". Eight items are displayed in a grid:

- MLQ League III Pride Jersey: \$28.00
- MLQ Non-Binary Pride Jersey: \$28.00
- MLQ Official Referee Jersey: \$49.00
- MLQ Joggers: \$59.00
- MLQ Austin Outlaws Replica Jersey: \$59.00
- MLQ Austin Outlaws Fan Jersey: \$35.00
- MLQ Austin Outlaws Snapbook: \$29.00
- MLQ Austin Outlaws Headband: \$15.00

An "Activate Windows" watermark is visible in the bottom right corner of the browser window. The Windows taskbar at the bottom shows the search bar, taskbar icons, and system tray with the time 12:55 PM on 8/1/2019.

## EXHIBIT B


Alt Legal: Docketing & Assemb... | FOUNDER BRETT SAVAGE BIO P... | Savage Apparel Co. (@savageu... | Company - SAVAGE, The Ultim... | +

https://savageultimate.com/pages/company

# SAVAGE APPAREL CO.

SHOP PARTNER STORES TEAM MARKETPLACE POWERED BY SAVAGE GREENBACK BLOG CONTACT

### COMPANY



#### THE ULTIMATE APPAREL COMPANY

Savage, the Ultimate Apparel Company was born from yeti DNA in 2009. Started in Todd Curran's guest room, SAVAGE quickly gained momentum as one of the top brands in the sport of Ultimate. Recognizing that other sports and industries would benefit from SAVAGE apparel SAVAGE has expanded further into the outdoors market and new sports including kickball, Flag Football, Disc Golf, Quidditch, Darts/Golf and Spinnball.

Savage is headquartered in Richmond, VA and is structured to perform at the highest level for you, your team, or event.


Savage is committed to providing unsurpassed customer service and selling top quality products to the active world.

With close to 10 years in the customizable apparel business, Savage knows what it takes to make our customers happy - quality products, on-time delivery, easy ordering processes, and strong customer service. The Savage team has been trained on providing the customer with all the information they need to make an informed decision. Savage has been working hard to design top-notch apparel for the active world and proudly offering Made in the USA and Made in Canada products.

### MISSION: TO SUPPLY BRAND AND CUSTOMIZABLE APPAREL TO THE ACTIVE WORLD

#### The Crew

\*The following bio may or may not be 100% accurate



Todd Curran  
President

Activate Windows  
Go to Settings to activate

12:56 PM  
8/7/2019


## EXHIBIT C

Sara Williamson of Colliers International is representing Curran in the transaction, which Curran said is set to close in a week or two. He did not say how much he is paying for the property.

Curran started Savage Apparel in 2009, initially targeting intramural and recreational ultimate frisbee teams who needed team jerseys. Originally based out of Charleston, South Carolina, Curran moved the company to Richmond in 2015. It operates out of Cretospace, a coworking space near Battery Park.

The company offers screen printing, embroidery and sublimation – a type of printing designed for polyester. It has made gear for teams across the U.S., Canada and Europe.

Savage Apparel applies its designs to garments it orders from factories in Canada and overseas. Curran said he aims to make the Brookland Park location the company's home base for production, retail and administration.



Curran said the company has been able to grow largely by targeting niche markets. After realizing there aren't enough ultimate frisbee teams to sustain his business, Curran began seeking other non-traditional sports like disc golf, kickball, dodgeball and Quidditch, as well as nonprofits, businesses and events.


"Any sport whose players wear a T-shirt is who we go after now," Curran said.

Curran co-owns the business with his brother Daniel and Dan Lee, who serve as vice presidents of sales and of production, respectively. Savage Apparel employs 15 people.


Brookland Park Boulevard has [grown in intrigue](#) for a growing number of retailers and developers. For Curran, opening in that area keeps him close to home, as he lives in the neighborhood and used to serve as president of the Battery Park Civic Association.

"Living there, I've been seeing the potential of what it can become, and what it is now. One of my personal goals as president of the civic association was to see Brookland Park build up," Curran said.

Curran said he received incentives from the City of Richmond to locate his business in the area. He did not disclose how much he's investing in the new shop.

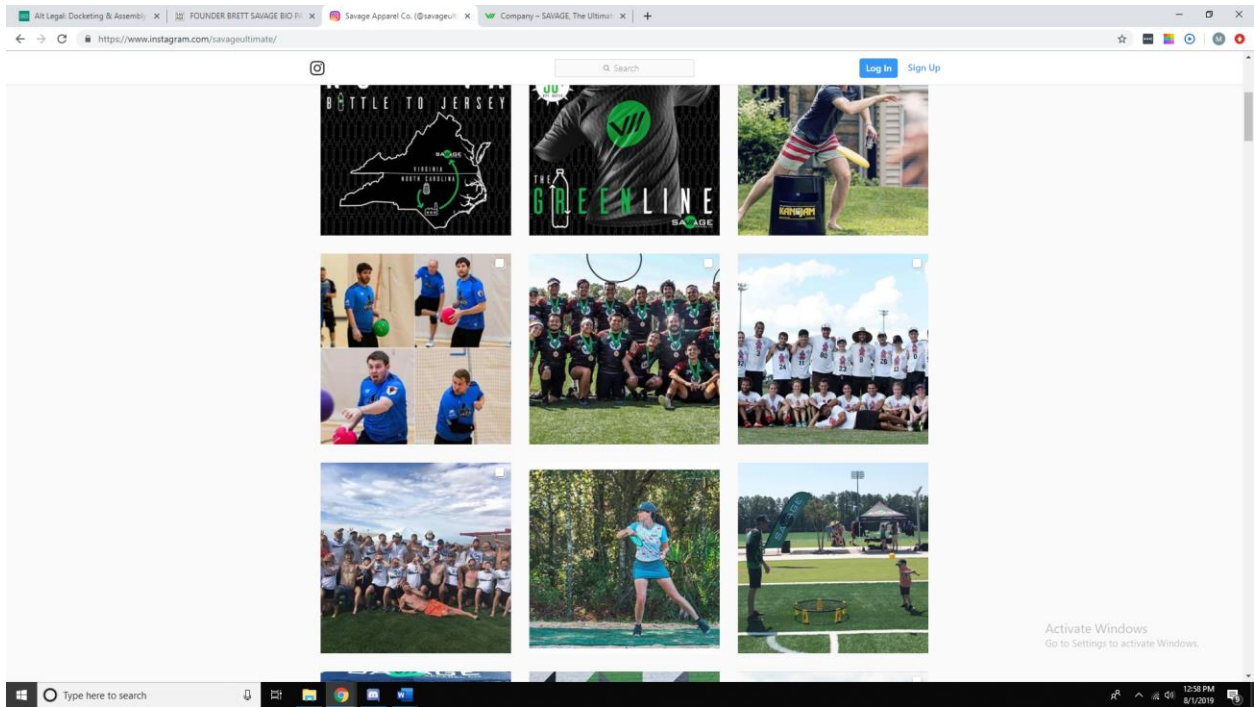


*Travel Care Face*



**MARTINAIR**  
AIRCRAFT CHARTER/MANAGEMENT

# EXHIBIT D





## EXHIBIT E

The screenshot shows a web browser window displaying the homepage of Savage Apparel Co. The browser's address bar shows the URL <https://sonsofsavage.com/index.html>. The website features a large background image of a blue ocean with a wooden post and a chain in the foreground. The Savage Apparel Co. logo, consisting of the word "SAV" over "AGE" in a square, is centered at the top. Below the logo is a paragraph of text: "THE SIZE OF OUR MARKET, POSITIONING OF OUR BRANDS AND THE RELEVANCE OF THE PRODUCT WE MAKE ARE ALL DECIDED UPON BY THE ACTIONS OF OUR CONSUMERS SUMMED UP AS 'CONSUMER ECONOMICS'". Below this text are four semi-transparent rectangular buttons labeled "BIO", "BLOG", "TOOLS", and "CONTACT". The Windows taskbar is visible at the bottom, showing the search bar, taskbar icons, and system tray with the time 12:59 PM on 8/1/2019.

Alt Legal: Docketing & Assemb... X THE PREMIER ACTION SPORTS... X Savage Apparel Co. (@savage)... X Company - SAVAGE, The Ultimi... X

← → <https://sonsofsavage.com/index.html> ☆

SAV  
AGE

THE SIZE OF OUR MARKET, POSITIONING OF OUR BRANDS AND THE RELEVANCE OF THE PRODUCT WE MAKE ARE ALL DECIDED UPON BY THE ACTIONS OF OUR CONSUMERS SUMMED UP AS "CONSUMER ECONOMICS".

BIO

BLOG

TOOLS

CONTACT

Activate Windows  
Go to Settings to activate Windows.

Type here to search

12:59 PM  
8/1/2019

# EXHIBIT F

MENU

SAVAGE

FLOORSCHT

4CASTER

BRANDAD

**4CASTER**

This App allows sell through data to be applied to visual style references with key metrics applied into stock market type algorithms. Our system allows design teams to quickly review competitive product lines to identify meaningful brand relevant "WHITE SPACE" to further develop and expand product strategies. Our system has been developed for designers in a format that is compelling and easy to understand so as to enable the creative mind to absorb clinical data in digestible packages. Our "Velocity Index" indicator has been an instrumental index in helping brands identify up and coming styles in an effort to anniversary product strategies and keep the brands fresh while eliminating trend risks.

MACRO TREND NAME	DIVISION	CATEGORY	MONTH	MEAN VELOCITY		
<b>ACTION WATCH</b>	JEANS	SHORTS	0	0		
BRAND SHARE	PENETRATION	AVG PRICE	AVG MARGIN	AVG UNIT SALES	VELOCITY	AVG INV
0.16%	84.75%	\$50.30	69.68%	0.45	09	00
STYLE NAME						
<b>Billabong - CROSSFIRE X</b>						
VELOCITY FLAG						
NOTES						
0.07%	07.54%	\$54.87	60.70%	0.45	07	02

Activate Windows  
Go to Settings to activate Windows.

Type here to search

1:01 PM  
8/1/2019