

John M. Wilke
Attorney Examiner
Law Office 104

In re. USPTO OFFICIAL NOTICE
Office Action issued on August 20, 2019 for
U.S. Trademark Application Serial No. 88453372

Dear Mr. Wilke,

I am James C. Richards, applicant for Serial No. 88453372 (CROSSFIRE BOOMERANG) standard character mark. I would like for you to consider the fact that:

1. Our mark will be on different products than the existing mark (76289898). None of our goods are exactly the same as the referenced existing mark (CROSS^FIRE). Further, the two marks will not only exist on different products, they will be marketed through distinctly different trade channels.
2. The referenced existing mark (CROSS^FIRE) has design elements that we don't have, which creates a distinctly different commercial impression in the marketplace. The overall commercial impression is visually distinct and different.
3. Most importantly, our mark incorporates the highly distinctive and unique word "BOOMERANG" in the standard character mark. This not only creates a fundamentally different impression in the marketplace, the distinctive word "BOOMERANG" leads to entirely different search results in any online search string or word combination. BOOMERANG is a fundamentally distinguishing word.

Comparison of the Marks



crossfire boomerang

Word Mark CROSS FIRE

Word Mark CROSSFIRE BOOMERANG

Serial Number 76289898

Serial Number 88453372

Goods and Services IC 025. US 022 039.
G & S: Clothing consisting of men's and boys,
jeans, pants, jackets and shorts.

Goods and Services IC 025. US 022 039.
G & S: Hats; Polo shirts; T-shirts

Mark Drawing Code (3) DESIGN PLUS WORDS,
LETTERS, AND/OR NUMBERS

Mark Drawing Code (4) STANDARD CHARACTER
MARK



Design Search Code 26.17.10 - Lines, zig-zag ;
Zig-zag line(s)

Design Search Code NA

Discussion:

1. USPTO: Likelihood of Confusion Refusal: Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant.

Response: The existing mark (CROSS FIRE) is a Mark Drawing Code(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS. The Design Search Code is 26.17.10 - Lines, zig-zag ; Zig-zag line(s). Our mark is a STANDARD CHARACTER MARK incorporating the highly unique word: BOOMERANG. Consumers will not confuse the marks. BOOMERANG is a fundamentally distinguishing word and, most importantly, our mark incorporates no design or art element.

Cited Existing Mark (CROSS^FIRE)		Our mark (CROSSFIRE BOOMERANG)
	Application	crossfire boomerang
	In Use Today	crossfire boomerang

2. USPTO: Comparison of the Marks: Marks are compared in their entirety for similarities in appearance, sound, connotation, and commercial impression. Similarity in any one of these elements may be sufficient to find the marks confusingly similar. Applicant's mark is CROSSFIRE BOOMERANG. The mark in the cited registration is CROSS^FIRE and Design. The marks are similar in sound, appearance and overall commercial impression, sharing the dominant term CROSSFIRE. Applicant has merely added a term to the registered mark. Since the dominant first word of applicant's mark is identical to the literal portion of the registered mark, the addition of a design element does not obviate the similarity of the marks in this case. The cited registration also includes a design element. When evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods and/or services. Thus, although marks must be compared in their entirety, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar,

Response: As shown in the comparison table in Response 1 above, not only was the original cited registration [CROSS^FIRE and Design] significantly different from our WORD MARK (no design), the cited registration has become more distinctively different from our mark in standard marketplace usage over time. Once again, the overall commercial impression is visually distinct and different. The only common aspect is CROSS^FIRE, and cited registration incorporates a highly unique and descriptively specific design element. You must consider the mark in its entirety (CROSS^FIRE vs CROSSFIRE BOOMERANG). The incorporation in our mark of the distinctive word BOOMERANG, which connotes an Australian Aboriginal hunting tool, eliminates the possibility of marketplace confusion. Consumers will not confuse the marks.

3. USPTO: Comparison of the Goods: The goods of the parties need not be identical or even competitive to find a likelihood of confusion. The respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” Applicant’s goods are “Hats; Polo shirts; T-shirts” in Class 25. Registrant’s goods are “Clothing consisting of men’s and boys jeans, pants, jackets and shorts” in Class 25. The goods are closely related, all being clothing items that may be worn by men and boys, and all typically produced by the same companies and sold through the same channels of trade. Neither the application nor the registration(s) contains any limitations regarding trade channels for the goods and therefore it is assumed that registrant’s and applicant’s goods are sold everywhere that is normal for such items, i.e., clothing and department stores. Thus, it can also be assumed that the same classes of purchasers shop for these items and that consumers are accustomed to seeing them sold under the same or similar marks. Since the respective marks are confusingly similar, and applicant’s goods and the goods in the cited registration are closely related, purchasers of applicant’s goods may mistakenly assume that the goods come from registrant, or that registrant and applicant are somehow related.

Response: The cited registration is limited to IC 025. US 022 039. G & S: Clothing consisting of men's and boys, jeans, pants, jackets and shorts. Our registration is strictly limited to IC 025. US 022 039. G & S: Hats; Polo shirts; T-shirts. There is no overlap in products. We will not infringe on their product categories in the future - we are only pursuing hats and t-shirts. Further, our limited product selection will only be marketed through a simple online website, whereas the cited registration mark is used to brand products that are sold through traditional brick-and-mortar retail establishments. Therefore, the two marks will not only exist on different products, they will be marketed through distinctly different trade channels. An online search for the cited existing mark leads to a static website for the holding company that owns the existing mark (along with many other brands) and some leads as to where a consumer can actually purchase the apparel at specific existing brick-and-mortar establishments, most of which are in Canada. Consumers will not confuse the marks.

In summary, I have reviewed the many distinctions between the marks, the trade channels used to market the goods, the significant differences in the products that would carry the marks, and the remote possibility that there may be confusion in the marketplace between the two marks. **Conclusion:** The marks do not represent any significant prospect for confusion for the reasons laid out above. I request that this evidence and argument in support of registration be considered and that the mark: CROSSFIRE BOOMERANG be approved.

Sincerely,

/James C. Richards/

James C. Richards

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