

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

October 1, 2019

James Hill
Trademark Examining Attorney, Law Office 115
United States Patent and Trademark Office

RE: Serial No: 88269580
Mark: BONFIRE
Applicant: Bonfire Holdings, LLC
Office Action Of: April 3, 2019

APPLICANT'S RESPONSE TO OFFICE ACTION

The following is the response of Applicant, Bonfire Holdings, LLC, by Counsel, to the Office Action sent via email on April 3, 2019, by Examining Attorney James Hill.


LIKELIHOOD OF CONFUSION REFUSAL

The Examining Attorney has refused registration of Applicant's standard character BONFIRE mark pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that the mark is likely to be confused with BONFIRE in Registration No. 3,604,917 and BONFYRE in Registration No. 5,538,970. For the following reasons, Applicant respectfully disagrees with this finding and requests that the Examining Attorney reconsider the statutory refusal and allow registration of Applicant's mark.

Likelihood of confusion between two marks at the USPTO is determined by a review of all of the relevant factors under the *du Pont* test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Although the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services, "there is no mechanical test for determining likelihood of confusion and 'each case must be decided on its own facts.'" TMEP § 1207.01 (*citing du Pont*, 476 F.2d at 1361, 177 USPQ at 567). Each of the thirteen *du*

Pont factors may be considered in weighing likelihood of confusion, if raised, and any one may be dispositive. *See* TMEP § 1207.01. In some cases, a determination that there is no likelihood of confusion may be appropriate, even where the marks share common terms and the goods/services relate to a common practice covering countless industries, because these factors are outweighed by other factors, such as differences in the relevant trade channels of the goods/services, the distinct consumers of each entity, the presence in the marketplace of a significant number of similar marks in use on similar goods/services, or another established fact probative of the effect of use. *Id.* Table 1, below, compares the relevant marks.

Table 1: Relevant Marks and Goods/Services

Mark	Goods/Services
 Serial No.: 88269580	Class 35: Business advice and information; Business consulting and information services; Business management consulting and advisory services
BONFIRE Registration No.: 3,604,917	Class 35: Business consulting services for others that targets users and buyers of any product; market analysis for companies and for individuals to develop, to build, and to market products more effectively.
BONFYRE Registration No.: 5,538,970	Class 35: Business consulting services in the field of business analytics, namely, collecting and analyzing engagement, usage and other data with respect to group communications, postings, memoranda and instant messaging, file sharing, calendar synchronization, and automated integrations with external service providers

Here, Applicant seeks registration of the stylized mark BONFIRE for “Business advice and information; Business consulting and information services; Business management consulting and advisory services” in International Class 35. Applicant’s mark has been refused registration based on an alleged likelihood of confusion with the standard character mark BONFIRE for “Business consulting services for others that targets users and buyers of any product; market analysis for companies and for individuals to develop, to build, and to market products more effectively.” in International Class 35 and the standard character mark BONFYRE for “Business consulting services in the field of

business analytics, namely, collecting and analyzing engagement, usage and other data with respect to group communications, postings, memoranda and instant messaging, file sharing, calendar synchronization, and automated integrations with external service providers” in International Class 35. *See* Table 1, above. There is no likelihood that consumers will be confused as to the source of goods in connection with each of these marks because the goods and services, channels of trade, and sophistication of purchasers are different. Further, consulting services are specialized and sought out by leading-edge consumers who exercise a high degree of care due to the industry in which the consulting is provided and the cost. Therefore, Applicant respectfully requests the Examining Attorney withdraw his refusal and permit Applicant’s Mark to be published on the Principal Register.

Differences in Goods and Services Used in Connection with the Marks

The Examining Attorney asserts that the marks are likely to be confused in commerce because Applicant uses broad wording to describe “business advice and information; business consulting and information services,” which naturally encompasses registrants’ narrower recitation of consulting services. *See* Office Action of April 3, 2019, p. 3. The Federal Circuit and the Board, however, have established that similarity is not a binary factor, but is a matter of degree. *In re Coors Brewing Co.*, 343 F.3d 1340, 1344 (Fed. Cir. 2003); *In re HerbalScience Group, LLC*, 96 U.S.P.Q.2d 1411 (TTAB 2010) [precedential]. Here, the services are not identical, and while all three fall into the category of business consulting services, the businesses operate in drastically different industries. Applicant’s services are directed solely to those operating or desiring to operate in state-legal cannabis industries. Its consulting services are highly specialized and sought by a very distinct group of consumers where millions of dollars are at stake. Notably, Applicant does not provide software or internet-based workplace solutions or web design/internet marketing services as is the case with the registrants.

In contrast to Applicant’s use of the BONFIRE mark, BONFIRE in Reg. No. 3,604,917 is a web design and Internet marketing company. The registrant’s specimen of use, provided in conjunction with its Combined Declaration of Use and Incontestability under Sections 8 & 15 is attached hereto as Exhibit A. In addition, Applicant was unable to locate a website used by the cited registrant for its services. Indeed, BONFIRE in Reg. No. 3,604,917 does not provide cannabis-specific consulting services, design, train and open cannabis dispensaries, or provide cannabis cultivation facility design, or provide operational support to existing cannabis operators, but rather focuses on software

development and web design. Accordingly, Applicant's services and the cited services in each mark are clearly different and are not similar enough to create a likelihood of confusion in the minds of the consumers.

Similarly, BONFYRE in Reg. No. 5,538,970 provides specialized consulting services such that an overlap in customers would not occur. As seen in Exhibits B and B-1, BONFYRE is used by the registrant on an Internet-based application directed towards workplace teambuilding, employee collaboration and workplace culture development. As with the other cited registrant, Applicant's services and the cited services in the BONFYRE mark are clearly different and are not similar enough to create a likelihood of confusion in the minds of the consumers.

Differences in Channels of Trade

In assessing the similarity of channels of trade and classes of consumers or users, courts must determine whether there is likely to be an overlap between the respective purchasers/users of the goods and services of the parties to confuse actual and potential purchasers/users. *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 21 USPQ2d 1388, 1390 (Fed. Cir. 1992); *see also* TMEP §1207.01(a)(iii):

[W]here both applicant's goods and opposer's services are marketed and sold in the medical and certain other fields, it is error to deny registration simply because "applicant sells some of its goods in some of the same fields in which opposer provides its services," without determining who are the "relevant persons" within each corporate customer. This is especially true where, as here, the Board acknowledged that "applicant's goods are specifically different and noncompetitive." [Internal citations omitted]. *Electronic Design & Sales v. Electronic Data Systems*, 21 USPQ2d at 1391.

Although both Applicant and the cited registrants provide business consultation and advisory services, the respective products and services of the parties are drastically different and noncompetitive. Applicant's consulting services are marketed towards consumers who seek cannabis business guidance and operational consultation with respect to cannabis license acquisition, cultivation, manufacturing and dispensary facility design and build-out, and retail operational knowhow to businesses and individuals in states in which cannabis is legal for either medical or adult-use. All of the goods in Applicant's identification relate solely to cannabis. Applicant, therefore, has a customer base of cannabis entrepreneurs, seeking to acquire industry-specific know-how and

consulting services. In contrast, BONFIRE in Reg. No. 3,604,917 is a web-technology company with its services marketed toward consumers who are looking for “cost effective web design, Search Engine Marketing, pay per click management, software development, mobile apps, review generation, email marketing, and online promotion marketing.” Further, BONFYRE in Reg. No. 5,538,970 is “an employee experience platform built to help place company culture in the hands of those most capable of shaping it.” In essence, the company provides a software platform to allow for employee engagement and collaboration. Likewise, the same companies who purchase a team-building and employee engagement software platform are not the same individuals who seek entrance into the cannabis industry. As such, there is no basis for the Examining Attorney to presume that the same individuals who purchase web design services or software-based employee collaboration tools and internet-based marketing services are also the same individuals who seek cannabis business consulting services. None of the markets for the respective goods overlap, and thus the parties’ channels of trade are separate and distinct.

Relevant Purchasers are Sophisticated and the Goods are Relatively Expensive

The Federal Circuit and the Trademark Trial and Appeal Board have recognized that where the consumers are sophisticated and the goods and services are expensive, the consumers are less likely to be confused. In finding no likelihood of confusion between NARKOMED for anesthesia machines and NARCO & Design for medical equipment, including anesthesia machines or NARCO MEDICAL SERVICES for leasing of hospital and surgical equipment, the Federal Circuit found that “only very sophisticated purchasers are here involved who would buy with great care and unquestionably know the source of the goods.” *In re N.A.D. Inc.*, 224 USPQ 969, 971 (Fed. Cir. 1985); *see also Aries Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926, 1933 (TTAB 1993); *Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 USPQ2d 1390, 1396 (TTAB 1991); *Electro Corporation v. Electro Sensors, Incorporated*, 196 USPQ 315, 320 (TTAB 1977) (“[T]he products are sophisticated electrical or electronic products advertised, marketed, and purchased for specific industrial applications by sophisticated technical personnel with care and deliberation and knowledge of the different technology involved in the operation of these goods.”).

The services of the respective parties are not off the shelf impulse items bought by the average consumer. Prior to purchasing a web site, Internet marketing services or business software, consumers spend considerable time researching. The sophisticated purchasers

involved in these purchasing decisions of consulting services would be aware of the practices of the industry, and recognize that the services do not emanate from a single source.

Here, Applicant's services are specialized cannabis-specific industry services, generally purchased by sophisticated consumers seeking very specified services with millions of dollars at stake in their business venture. Thus, because the consumers are sophisticated and the services are carefully purchased, the consumers are less likely to be confused.

Balancing the Factors

In sum, the shared term "BONFIRE" among Applicant's mark and the cited registrations will not create consumer confusion. Consumers have been able to differentiate marks that share some form of "BONFIRE." Further, Applicant's services are separate and distinct from the cited registrants' goods and services and are not likely to be purchased by the same consumers. Accordingly, Applicant respectfully requests that the statutory refusal be withdrawn and that the application be permitted to proceed to publication. If the Examining Attorney deems it necessary to allow for registration, the Applicant is amenable to narrowing the scope of its offered services.

The Applicant has responded to all issues raised in the Office Action. If any further information or response is required, please contact the Applicant's attorney. The attorney may be reached by telephone at 303-875-5386.

Respectfully submitted,

Jay Kotzker Esq. Attorney for Applicant