

US Application No 88500652

Mark: MAXXPRO

Amended Goods in class 013

Automatic firearm ammunition belts; Belts adapted for ammunition; Cartridge belt filling machines; Cartridge cases; Cartridge fillers; Cartridge pouches; Cleaning brushes for firearms; Gun belts; Gunstock recoil pads; Gunstocks; Hand gun accessories, namely, belt clips for securing a gun without the use of a holster; Holsters; Hunting firearms; Shoulder straps for weapons; Sighting mirrors for guns; Sighting mirrors for rifles; Sights, other than telescopic sights, for firearms; Sprays for personal defense purposes; Tripods and stands for firearms; Noise suppressors for guns; Pistol holsters

Section 2(d) Refusal.

Examiner has cited U.S. Registration Nos. 2825167 and 2834488 for PROMAX as a word mark and with a design, in association with, in relevant part, "Containers for storage and transport of items used by outdoorspeople, namely, firearm cases" in class 013.

A. The Marks Must be Considered in their Entireties.

In comparing Applicant's and Registrants' marks, the marks must be compared in their entireties. A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important. See e.g., Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399, 1402, 181 U.S.P.Q. 272, 273 (C.C.P.A. 1974) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."); Dreyfus Fund, Inc. v. Royal Bank of Canada, 525 F. Supp. 1108, 213 U.S.P.Q. 872 (S.D.N.Y. 1981) (quoting treatise); In re National Data Corp., 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985) ("[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark."); General Mills, Inc. v. Kellogg Co., 824 F.2d 622, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987) ("[I]n analyzing the similarities of sight, sound and meaning between two marks, a court must look to the overall impression created by the marks and not merely compare individual features."); Duluth News-Tribune v. Mesabi Publ.Co., 84 F.3d 1093, 38 U.S.P.Q.2d 1937 (8th Cir. 1996) ("Rather than consider the similarities

between the component parts of the marks, we must evaluate the impression that each mark in its entirety is likely to have on a purchaser exercising the attention usually given by purchasers of such products.").

A significantly different display of the same term or an addition of a distinctive element (i.e. term or design) can avoid a likelihood of confusion. First Savings Ban, F.S.B. v. First Bank Systems, Inc., 40 U.S.P.Q.2d 1865 (10th Cir. 1996) (no confusion between FIRST BANK and FIRST BANK SYSTEM (and design)).

B. The Marks at Issue Create Unique Commercial Impressions.

Applicant's mark MAXXPRO starts with MAX, rather than the PRO of the Registrant's mark. Not only is the appearance of the starting syllables, between MAXX and PRO, different, but the sound is different. It is well known that the first syllable of a trademark is the most important from the point of view of consumer impression. When considered in their entireties, the marks are different from each other.

Applicant's MAXXPRO also has a unique spelling MAXX, noticeable for the consumer and taking the mark away from merely MAX, connoting a maximum, to MAXX.

Based on the differences in the marks, and the commonality of both PRO and MAX in the firearms field, as discussed below, the marks are distinctive from one another in the firearms field, in both sound and appearance.

C. The Goods are Different.

Registrant's goods are similar in the area of firearms cases. It is submitted that goods such as cartridge cases, gunstocks, gun cleaning equipment, and firearms themselves are clearly different from the Registrant's goods ID, and do not have a likelihood of confusion.

Applicant has removed "Bags specially adapted to hold rifles; Gun cases; Rifle cases; Weapon cases for firearms;" from the goods ID to remove a likelihood of confusion with Registrant's marks. Therefore there is no overlap between the goods of Registrant and goods of the Applicant.

D. The Channels of Trade are Different.

Firearm cases are provided in different channels of trade than firearms, cartridges, firearm parts and gun cleaning equipment. As can be seen from the attached screenshot from Cabela's, a large shooting and firearms retailer, gun cases are under the heading "Gun Storage", a separate heading from Ammunition (where cartridges may be found), Gun Maintenance (like cleaning kits), Holsters & Belts, and Firearms themselves. From this differentiation, we can see that consumers segment their needs in the firearms area - when they are looking for firearms or holsters, they do not also want to see gun cases because the products are not substitutes or closely related. They would not appear on the shelf next to one another.

D. The Number of Similar marks in the Register.

There are a vast number of marks with PRO or MAX in the firearms field (see enclosed search results). These are common laudatory words, suggestive of "professional" in the case of PRO and "maximum" in the case of MAX. These parts in the mark are not overly distinctive, and Applicant suggests that the commonality of these terms results in a smaller ambit of protection for these terms.

Applicant believes that the Du Pont factors weigh in Applicant's favor and requests the Examiner reconsider and withdraw the Section 2(d) refusal.