

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial Number: 88/423,180

Filing Date: May 09, 2019

Applicant: DQC International Corp.

Application Basis: Intent to Use

Examiner: Hayes, Ashley D.

Docket Number: 410230

Mark: INVADER word mark

RESPONSE TO NON-FINAL OFFICE ACTION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Commissioner:

In response to the Examining Attorney's Non-Final Office Action dated July 27, 2019 (hereinafter "Office Action"), Applicant responds as follows:

REMARKS IN SUPPORT OF REGISTRATION

Applicant respectfully requests reconsideration of the Office Action's refusal of the instant Application based upon the Likelihood of Confusion Refusal with the mark in U.S. Registration No. 3,858,177, namely the INVADER word mark for the Goods of Crossbows (the "Cited Mark").¹ The Office Action based its Refusal upon similarity of the Marks, similarity and nature of the Goods, and similarity of the trade channels of the Goods.² Applicant respectfully disagrees with the Office Action's Refusal.

A. Comparison of the Goods and Trade Channels

¹ Office Action pp. 2-3; 15 U.S.C. §1052(d); TMEP §§1207.01 et seq.

² Office Action pp. 2-3.

The Office Action refuses the Applicant's Mark based upon a finding that Applicant's goods are commercially related and could give rise to the mistaken belief that the goods emanate from the same source as the Cited Mark.³

Regarding Applicant's mark INVADER, and the Cited Mark, Applicant respectfully disagrees with the Office Action's finding of a likelihood of confusion between the marks. Applicant's goods consist of Fishing Tackle; Artificial fishing baits; and Fishing lures. Quite conversely, the Cited Marks goods are Crossbows. From review of the Office Action, the Office Action compared the goods to determine whether they are similar, commercially related, or travel in the same trade channels. In order to determine such element, the Office Action argued that the goods are "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods] emanate from the same source."⁴ However, Applicant respectfully rejects the argument that "consumers are likely to be confused and mistakenly believe that the respective goods emanate from a common source."⁵

Indeed, consumers would not expect the Cited Marks goods and Applicant's goods to emanate from the same source. The CAFC has upheld the concept of the "sophisticated purchaser" when considering the likelihood of confusion.⁶ The consumers of Applicant's Fishing Tackle; Artificial fishing baits; and Fishing lures products are sophisticated fishermen and as a result "discriminating purchasers". The consumers are not average purchasers who buy these types of

³ Office Action p. 5.

⁴ *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

⁵ Office Action p.4.

⁶ *Weiss Assoc., Inc. v. HRL Assoc., Inc.*, 902 F. 2d 1546, 1548 (Fed. Cir. 1990) ("In making purchasing decisions regarding 'expensive' goods, the reasonably prudent person standard is elevated to the standard of the 'discriminating purchaser.'") (quoting 2 J. McCarthy, *Trademarks and Unfair Competition* § 23:28 at 130 (2d ed. 1984)). See also *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F. 2d 713, 718 (Fed. Cir. 1992) ("[T]he Board gave too much weight to certain du Pont factors . . . and failed to give due weight to countervailing du Pont factors, such as the sophistication of purchasers.").

products as common and everyday items for their daily life but instead are purchasing such fishing products related to their professional activities and/or their hobbies. These sophisticated consumers are well informed and aware of the quality and the prices of the products as well as the marketplace for fishing related items. Similarly, Registrant's sophisticated consumers are equally aware of the marketplace and knowledgeable regarding the products related to hunting.⁷

Registrant cited in its Response to the Office Action filed on March 16, 2015 for its LEGEND ULTRA LITE® word mark that “A crossbow consumer is likely to research the proper size and draw weight as well as consider the available accessories before making a purchase of a crossbow” because “crossbows are expensive, ranging in price from a few hundred dollars up to thousands of dollars.”⁸ Consumers devote more attention to examining different products and will take the initiative to gather additional information about the performance of the products before making a purchase and therefore recognize subtle differences in the different Marks and related products offered in the marketplace. A consumer coming across Registrant's Goods ranging from “\$300-\$2000 hunting weapon” is not likely to be confused with Applicant's Goods ranging from \$5-\$20 artificial fishing baits. Consequently, the discriminating nature of the sophisticated group of consumers (e.g. fishermen and hunters) of both of these products can be presumed to be very concerned with the quality, characteristics and origin of their equipment, and hence will be immune to confusion.

The Office Action states as support for a likelihood of confusion between Applicant's Mark and Cited Mark that goods bows as well as fishing tackle “are sold through the same trade channels and used by the same classes of consumers in the same fields of use, and that the goods are similar

⁷ *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1137 (2nd Cir. 1979) (consumers of women's overcoats/raincoats were identified as "sophisticated and knowledgeable" about women's apparel).

⁸ Exhibit A.

or complementary in terms of purpose or function.”⁹ Applicant’s Goods of “Fishing Tackle; Artificial fishing baits; and Fishing lures” are vastly different from the Cited Marks goods of “Crossbows.” The Cited Marks goods are primarily designed for and used by hunters rather than fishermen for Applicant’s Mark. The goods related to the Cited Mark for crossbows and the description of the goods for Applicant’s Mark for Fishing Tackle; Artificial fishing baits; and Fishing lures are dissimilar and unrelatable.

Although, Applicant’s goods and Registrant’s goods are both recreational equipment, those goods have specific defined purposes that differ. Indeed, Applicant’s goods are reserved to the sport of fishing and cannot be used in the sport of hunting and vice versa with Registrant’s goods that are reserved for the sport of hunting. Similarly, it is not possible to play football with the sport equipment of baseball because the sporting tools will not be useful for the practice of this sport. Thus, Applicant’s Goods and Cited Mark’s goods as sporting tools used in recreational activities that do not overlap.

Similarly, both Registrant as Applicant selected the word “INVADER” but for different meaning related to their products. Applicant’s Mark “INVADER” is used to designate the idea of an object such as a fishing bait conceived to represent small unidentified creatures that are a cross between alien and insect in nature. Applicant’s INAVDER Goods are invading and travelling through the water for the purpose to “Attack the dark deep honey holes where the biggest bass live”¹⁰ and therefore to catch fish, the very characteristic desired by fishermen wishing to catch fish. Thus it is suggestive regarding the Applicant’s goods. On the contrary the term “INVADER” is used by Registrant to designate the forceful and hostile intrusion of hunters beyond the

⁹ Office Action p. 4.

¹⁰ Exhibit B.

boundaries of the territory of wild animal. Such statement is supported by further research on the Hunter's Manufacturing Company, Inc. dba Ten Point Crossbow Technologies regarding the intent to communicate a suggestive message to the buyers of the hunting crossbows with a main tagline "The Invader Knows No Boundaries." A portion of some said campaign can be seen below:



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Additionally, the co-existence of numerous registrations of similar or identical marks for fishing goods on one hand and crossbows and archery goods on the other hand, demonstrates that the sport of fishing is distinct from the sport of bow hunting and archery, such that similar and even identical marks may be used on and registered for these distinctly different type of goods without any confusion. "Third party registrations can be used by examining attorneys to suggest that the goods are related because the same party has registered a common mark for the goods at issue in a likelihood of confusion case. Similarly, applicants may submit sets of third-party registrations to suggest the opposite, i.e. that the Office has registered he same mark to different

¹¹ Exhibit C

parties for the goods at issue.”¹² Indeed, a further review of the registered marks shows that the Trademark Office has registered or allowed a number of similar and virtually identical marks for fishing and hunting goods in International Classification 028 registered to different owners. A sample of the extensive listing of such registrations and applications is included below:¹³

Owner	Goods/Services	Mark	Mark	Goods/Services	Owner
Pure Fishing, Inc.	028 Fishing lines	STEALTH Reg: 4056553 Serial: 77222311 Registered and renewed Reg: 11/15/2011 Filed: 07/05/2007	STEALTH Reg: 4580341 Serial: 85137556 Registered Reg: 08/05/2014 Filed: 09/24/2010	028 Crossbows	Hunter's Manufacturing Company, Inc. dba TenPoint Crossbow Technologies
St. Croix of Park Falls, Ltd.	028 Fishing rods	LEGEND ULTRA Reg: 2226319 Serial: 75476949 Registered and renewed Reg: 02/23/1999 Filed: 04/30/1998	LEGEND ULTRA LIGHT Reg: 4899132 Serial: 86295670 Registered Reg: 02/09/2016 Filed: 05/30/2014	028 Crossbows	Hunter's Manufacturing Company, Inc. dba TenPoint Crossbow Technologies
DQC International Corp.	028 fishing rods	BLACKOUT Reg: 5502570 Serial: 87689884 Registered Reg: 06/26/2018 Filed: 11/17/2017	BLACKOUT Reg: 5875989 Serial: 88975714 Registered Reg: 06/26/2018 Filed: 11/01/2019	028 Crossbow arrows and bolts, etc.	Bass Pro Intellectual Property, L.L.C.
DQC International Corp.	028 Fishing tackle	EVOLVE Reg: 5502569 Serial: 87689874 Registered Reg: 06/26/2018 Filed: 11/17/2017	EVOLVE Reg: 5278222 Serial: 87975574 Registered Reg: 08/29/2017 Filed: 05/19/2016	028 Archery bows	Precision Shooting Equipment, Inc.
DQC International Corp.	028 Fishing tackle; Fishing reels	CREED Reg: 5881922 Serial: 87689863 Registered Reg: 07/30/2019 Filed: 11/17/2017	CREED Reg: 4552313 Serial: 85687707 Registered Reg: 06/17/2014 Filed: 07/26/2012	028 Archery bows	MCP IP, LLC
Plastic Research and Development	028 Fishing lures	ROGUE Reg: 3346831 Serial: 77036617	ROGUE Reg: 5296769 Serial: 86497266 Registered	028 Crossbows	Barnett Outdoors, LLC

¹² See *In re G.B.I. Tile and Stone, Inc.*, 92 U.S.P.Q.2d 1366, 1369-1370 (T.T.A.B. 2009)

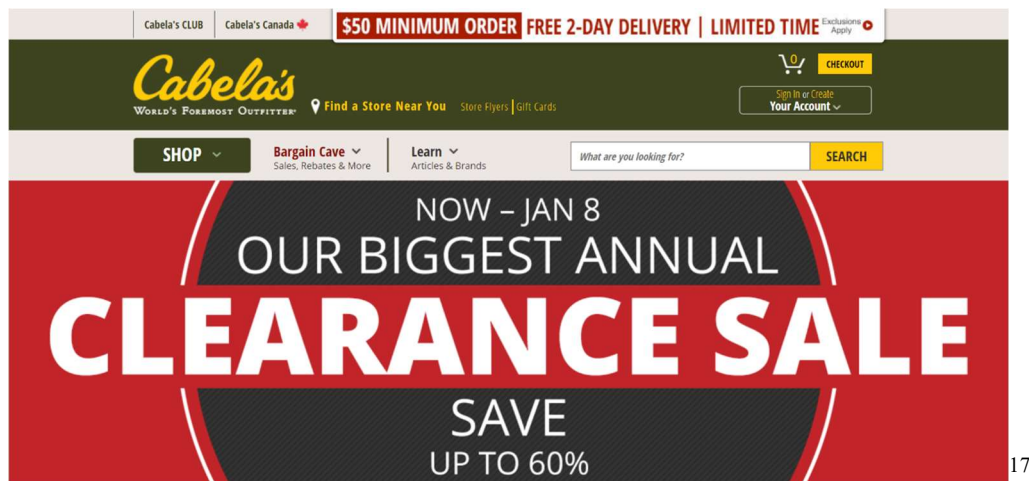
¹³ See Exhibits D-AA.

Corporation dba Pradco		Registered and Renewed Reg: 12/04/2007 Filed: 11/03/2006	Reg: 09/26/2017 Filed: 01/07/2015		
American Maple Inc. dba AHI USA	028 Fishing tackle	ASSAULT Reg: 5486243 Serial: 87668044 Registered Reg: 06/05/2018 Filed: 11/01/2017	ASSAULT Reg: 4951634 Serial: 85828828 Registered Reg: 05/03/2016 Filed: 01/22/2013	028 Archery bows; Crossbows	Barnett Outdoors, LLC
Maurice Sporting Goods LLC	028 Fishing lures	BLAZE Reg: 3586998 Serial: 77546089 Registered and renewed Reg: 03/10/2009 Filed: 08/13/2008	BLAZE Reg: 4328010 Serial: 85722016 Registered Reg: 04/30/2013 Filed: 09/06/2012	028 Crossbows	Arrow Precision LLC
Willtech (PRC)	028 Fishing strings	SIEGE Reg: 3010423 Serial: 76611758 Registered and renewed Reg: 11/01/2005 Filed: 09/16/2004	THE SIEGE Reg: 4402716 Serial: 85762939 Registered Reg: 09/17/2013 Filed: 11/25/2012	028 Archery bows; Archery equipment, namely, crossbows	The Bohning Company, Ltd
Royal Wulff Products, Inc.	028 Fishing lines	AMBUSH Reg: 3939385 Serial: 76703970 Registered and renewed Reg: 04/05/2011 Filed: 08/02/2010	AMBUSH Reg: 5311409 Serial: 87423601 Registered Reg: 10/17/2017 Filed: 04/25/2017	028 Crossbows, etc.	Industrias Tres Americas, de Responsabilid ad Limitada
Stephen A. Parks	028 Fishing rods	RAGE Reg: 4147763 Serial: 85305346 Registered and renewed Reg: 05/22/2012 Filed: 04/26/2011	RAGE Reg: 4812058 Serial: 86526526 Registered Reg: 09/15/2015 Filed: 02/06/2015	028 Archery equipment	Feradyne Outdoors, LLC
Penn Fishing Tackle Mfg. Company	028 Fishing rods; Fishing tackle	RAMPAGE Reg: 4328755 Serial: 85268391 Registered and renewed Reg: 04/30/2013 Filed: 03/16/2011	RAMPAGE Reg: 4840773 Serial: 86562023 Registered Reg: 10/27/2015 Filed: 03/12/2015	028 Archery equipment	Black Eagle Arrows

Therefore, Applicant's Goods and Cited Mark's Goods can coexist regarding the large number of co-existing registrations. Indeed, as evidenced above, Registrant itself filed federal

trademark applications and received U.S. Trademark Registrations for the STEALTH® word mark and the LEGEND ULTRA LIGHT® word mark, although these marks were previously registered and used in connection with fishing products.¹⁴ It is therefore unlikely that prospective purchasers of Applicant's Goods or Cited Mark's Goods would believe that they emanate from a common source.¹⁵

In addition, the Office Action refers and lists different online stores and shops selling both fishing equipment as well as hunting equipment's and concludes that "applicant's and registrant's goods are considered related for likelihood of confusion purposes"¹⁶ However, Applicant respectfully disagrees with the notion that because two types of goods can be found in the same retail store, that they are automatically related for likelihood of confusion purposes. It is quite common for tangentially related or unrelated goods to be available from the same retail store. In fact the retail stores cited in the Office Action include an extremely wide array of goods as can be seen by the following screenshot:



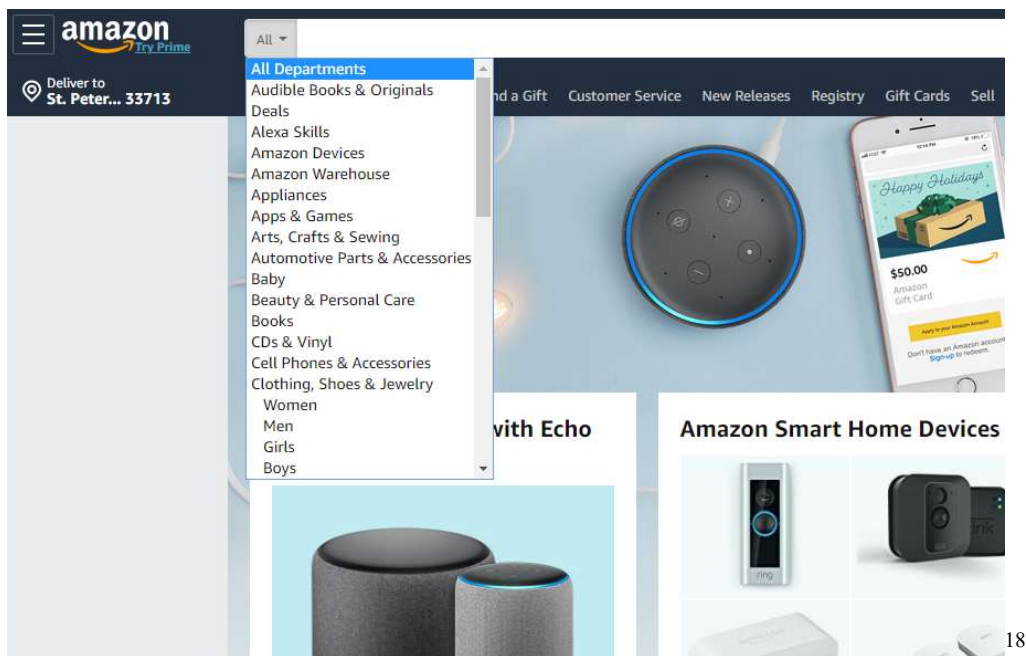
¹⁴ See Exhibits E and G.

¹⁵ *E. Remy Martin & Co., S.A. v. Shaw-Rose Intl'l Imports, Inc.*, 756 F.2d 1525, 225 USPQ 1131, 1134 (11th Cir. 1985) (finding that a sufficient relatedness of goods and services is determined on whether the public has come to attribute them to a single source).

¹⁶ See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

¹⁷ Exhibit AB

Likewise amazon.com is well known for having a wide array of goods available for purchase as can be seen by the partial listing in the following screenshot showing some of the types of goods available:



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Applicant is well known in the world of fishing and especially for its main purpose to “Redesigning the sport of fishing”. Applicant’s activity focuses only on selling fishing related products and uses its own website (<http://store.13fishing.com/>) or Tackle Retailers to sell its products. Similarly, Cited Mark is owned by a company well known in the world of hunting and provides only products related to hunting on its own website (<https://www.tenpointcrossbows.com/pages/about-us/>). Registrant itself only submitted Specimens for the Cited Mark related to hunting. Applicant believes that its Mark as well as Cited Mark create different commercial impression and their purpose is to create different commercial impression. Consumers are unlikely to be confused by the use of these two marks regarding the nature of the activity of both Applicant and Registrant’s businesses.

¹⁸ Exhibit AC.

Applicant respectfully requests that the Office consider the Marks as they are used and how they will be used, because the context of a Likelihood of Confusion analysis is not to be considered in a hypothetical setting; the focus should be on the Marks as they are used under *actual market conditions*.¹⁹ “The realities of the marketplace control because that is where confusion of prospective purchasers would or would not occur.”²⁰ The only connection between Applicant’s Goods and Registrant’s Goods are that they are both related to outdoor activities. The Office Action selected evidence of online retail stores listing a large variety of outdoor recreation merchandise including fishing and hunting items but not limited to it. The Office Action is allocating broader significance to this evidence than relevant and necessary. These online marketplaces offer a large variety of goods including different trade channels and targeting different classes of consumers. Similarly, the evidence submitted for Amazon.com known as the largest online retailer in the United States and which gathered a collection of independent retailers and vendors who sell millions of different products. Thus, this evidence cannot be considered relevant as significantly offering an infinite variety of products and targeting different classes of consumers.

In order to find that Goods are related, there must be more of a connection than that a single term can be used to describe both types of goods.²¹ While Applicant’s Goods and Registrant’s Goods can both be described as “sporting goods,” both respective businesses are targeting distinct customers and do not intend to confuse each other customers. As evidenced above, Applicant has

¹⁹ *Kenner Park Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 426, 22 U.SPQ2d 1453, 1455 (Fed. Cir. 1992).

²⁰ *Giant Foog, Inc. v. Nation’s Foodservices, Inc.*, 710 F.2d 1565, 218 USPQ 390, 393 (Fed. Cir. 1983).

²¹ See *In re W.W. Henry Co.*, 82 USPQ2d 1213, 1215 (TTAB 2007) (it is not sufficient that a particular term may be found which may broadly describe the goods); *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 694 (TTAB 1977) (it is, however, not enough to find one term that may generically describe the goods).

several Trademark Registrations for terms that are also registered by third parties for identical Goods to those of Registrant. Similarly, Registrant has Trademark Registrations for terms that are registered by third parties for identical Goods to those of Applicant. The concurrent registrations show that the businesses for Applicant and Registrant are sufficiently distinct to allow for the coexistence of similar or identical registrations for Applicant's Goods and Registrant's Goods without any likelihood of confusion. . It is therefore unlikely that prospective purchasers for these respective Goods would believe that these Goods emanate from a common source, nor has there been any proof to indicate as such.²² Applicant submits, therefore, that in the real-world setting, confusion in this context is unlikely.

Finally, the Office Action submitted evidence purportedly showing third-party mark registered including a variety of Goods under Class 028. However, only one mark registered, ASSASSNIN HUNTING® (Reg. No. 4,375,362) includes Registrant's Goods "crossbows" and Applicant's Goods "Fishing Tackle; Artificial fishing baits; and Fishing lures." However, after a thorough review of this owner submitted Specimen and website (<http://www.assassinshunting.com/>),²³ there is no relevant evidence supporting that "crossbows" and "Fishing Tackle; Artificial fishing baits; and Fishing lures" are marketed by a single source under one mark. Applicant submits that in the real-world setting hunting products are significantly distinct from fishing products and consumers are unlikely to be confused. Therefore, Applicant respectfully requests that the Office Action's Refusal be reconsidered and withdraw.

B. Comparison of The Marks

²² *E. Remy Martin & Co., S.A. v. Shaw-Rose Intl'l Imports, Inc.*, 756 F.2d 1525, 225 USPQ 1131, 1134 (11th Cir. 1985) (finding that a sufficient relatedness of goods and services is determined on whether the public has come to attribute them to a single source).

²³ Exhibit AD.

Applicant agrees that the marks are identical. Applicant respectfully requests that the Office Action's Refusal be reconsidered based on the difference of Goods and Trade Channels, thus making the aforementioned Refusal moot.

C. CONCLUSION

In view of the aforementioned remarks, it is respectfully requested that the refusal based upon the Likelihood of Confusion Refusal be reconsidered, overcome, and withdrawn.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the Application or document or any registration resulting therefrom, declares that all statements made of her knowledge are true; and all statements made on information and belief are believed to be true. Therefore, registration of Applicant's Mark upon the Principal Registry should be allowed, and such action is earnestly solicited.

Respectfully,

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January 27, 2020
Date

/Brittany J. Maxey-Fisher/
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