

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
OFFICE OF THE COMMISSIONER FOR TRADEMARKS

In Re Application of:
BISON PRODUCTS, LLC

Mark:
BISON

Application Serial No.:
90081500

Trademark Examining Attorney:
Tasneem Hussain

Filed via TEAS
Mail Stop Amendment
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

RESPONSE

Dear Examiner Hussain:

This is a response to the Office Action dated November 17, 2020 (“Office Action”), Applicant responds as follows:

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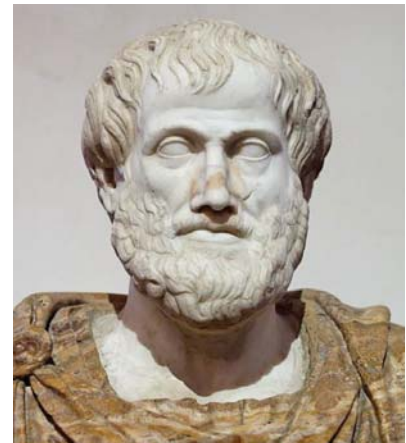
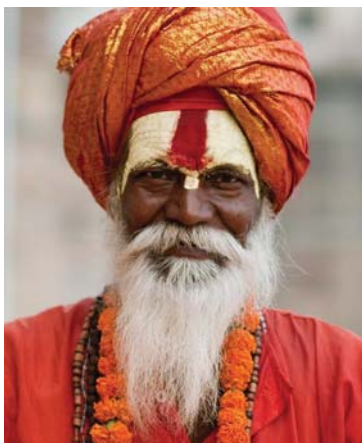
REMARKS

A. Section 2(d) Refusal

In the Office Action, the Examining Attorney refused registration for the applied-for-mark BISON under Trademark Act Section 2(d) because the applied-for mark is allegedly confusing similar to U.S. Reg. No. 554968 for BISON BODY BUTTER (“Cited Mark”).¹ Respectfully, Applicant traverses this rejection based on the following remarks and amendment.

1. A man’s “beard” is not a human body part.

The Cited Registration lists the following goods in connection with BISON BODY BUTTER, namely: “Cosmetics; Moisturizing body lotions; body moisturizers.” In contrast, the goods within the applied-for-mark are directed at pubescent or *adult males* having or growing a beard. To Applicant’s knowledge, the majority of females do not grow beards. Under any reasonable analysis, the main purchasers or consumers of Applicant’s goods are adult males—a specific audience. In addition, there are various types of beards that a man can grow, which dates back to centuries ago and is recognized by just about every society and culture on the planet, such as shown below:²



¹ Office Action pp. 2-6

² Retrieved on 2021-02-12 from: <https://en.wikipedia.org/wiki/Beard>

Moreover, a man's beard is not a human body part. A man's beard is comprised of dead cells which allow it be dyed with color, woven, trimmed, or even completely shaven off without any harm to the body. None of the foregoing can happen with any other part of the human body. Here, the registrant's goods pertaining to the "body" are explicitly included in its own mark BISON BODY BUTTER. Hence, it's inconceivable that the purchaser of Applicant's goods pertaining to "beard care" bearing the mark BISON would be confused with "Cosmetics; Moisturizing body lotions; body moisturizers" bearing the mark BISON BODY BUTTER—it simply can't happen.

2. The registrant of the Cited Mark cannot and could not have used a shortened form of its mark to show use in commerce.

Here, it simply cannot be ignored that the Cited Mark BISON BODY BUTTER explicitly includes the descriptive terms BODY BUTTER in its mark. As shown in the Cited Mark's specimen of record, all three of the terms BISON + BODY + BUTTER appear on the alleged label:³



³ U.S. Reg. No 554968, retrieved from TSDR, entry of Jan. 3, 2018 (annotated).

Here, the registrant of the Cited Mark must use the ***substantially exact*** representation of the mark in its application to satisfy its requirement of showing use-in-commerce in connection with the identified goods. See 37 C.F.R. §2.51(a); TMEP 807.12(d). Simply put, the registrant of the Cited Mark cannot and could not have used a shortened form of the mark in connection with its identified goods, such as BISON (without BODY BUTTER), without running afoul of the foregoing legal requirement. In fact, the registrant of the Cited Mark would not have been entitled to registration had the registrant not used its mark in the exact same form shown in its application which includes all three words “BISON BODY BUTTER.”

Further, the Examiner has not introduced any evidence that shows registrant of the Cited Mark using any other variation of the mark, such as BISON (by itself), or BISON BODY, or BISON BUTTER. Moreover, the Examiner has not introduced any evidence of third parties or consumers referring to registrant’s goods by the mark BISON (by itself) or any other variation.

Simply put, since the legal requirement is for registrant of the Cited Mark to use the exact same form of its registration (“BODY BODY BUTTER”) and not in any other form, then there could not and cannot be any confusion whatsoever between BISON BODY BUTTER and BISON. Applicant respectfully requests the Examiner to withdraw the rejection under Section 2(d) and place this application in condition for allowance.

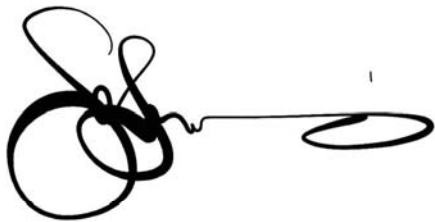
3. The cited prior-filed application is now abandoned.

Applicant respectfully submits that the prior-filed U.S. Application Serial No. 88820403 cited in the Office Action which precedes Applicant’s filing date is now designated by the Office as abandoned. Applicant respectfully requests the Examiner to withdraw this rejection.

B. Conclusion

Applicant has now made an earnest attempt in this Response to place this Application in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests allowance for the applied-for-mark BISON. Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the number listed below to further expedite prosecution of the present Application.

Respectfully Submitted,



Dated: February 24, 2021

Sam Sokhansanj

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