

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

WARRIOR FIT, LLC
US Serial Number: 88579902
Filed: August 15th, 2019
Examining Attorney: Gandra, Keyla

For: WARRIOR

RESPONSE TO OFFICE ACTION 88579902

To the Commissioner for Trademarks:

INTRODUCTION

In response to the Office Action mailed on November 19th, 2019, Applicant respectfully requests that the following arguments be considered in support of allowance.

The Examining Attorney has refused registration of Applicant's composite mark WARRIOR under Trademark Act Section 2(d) on the basis of likelihood of confusion with U.S. Registration Nos. 3939866 WARRIOR (stylized) relating to clothing in IC 025, 3939867 WARRIOR (stylized) relating to certain clothing items in IC 025, 5339035 WARRIOR STYLE relating to clothing in IC 025 and sporting goods in IC 028, 5677165 WARRIOR relating to clothing in IC 025, and 5842290 WARRIOR CATS relating to IC 16, 25, and 28 (collectively the "Cited Warrior Marks").

Applicant's mark in its entirety is WARRIOR for use in connection with the following amended goods: Hats; Hoodies; Shirts; Sweatshirts; Sweat bands; Wrist bands as clothing in IC 025; card games for providing fitness and exercise in IC 028; and drinking bottles for sports in IC 021. Applicant has deleted certain clothing items in IC 025, blank journals in IC 016 and Athletic sporting goods, namely, athletic wrist and joint supports; work-out gloves; weight lifting belts in IC 028 from the

application.

The Examining Attorney asserts that there is a likelihood of confusion between Applicant's mark and the Cited Warrior Marks. Applicant contends, as demonstrated below, the common word portion "warrior" is a widely used term by a myriad of 3rd parties in relation to a wide variety of goods and services, in particular clothing items and sporting goods. The term "warrior" is not strongly associated or unique to any of the Cited Warrior Marks. It is therefore entitled only to a very narrow scope of protection. As such, consistent with recent Federal Circuit precedent, Applicant submits that there are significant differences in Applicant's mark and the Cited Warrior Marks with respect to overall appearance, commercial impression, narrowed listing of goods, and the differences in the channels of trade preclude a likelihood of confusion among potential consumers. Accordingly, Applicant requests that the refusal to register be withdrawn.

ARGUMENT

A. "WARRIOR" is Entitled to a Very Narrow Scope of Protection

The Federal Circuit made clear that widespread third-party use significantly affects the scope of the protection that should be afforded to a cited mark.

"[E]vidence of third-party use bears on the strength or weakness of an opposer's mark." *Juice Generation*, 794 F.3d at 1338, 2015 WL 4400033, at *3. "The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection." *Id.*; see also *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1373 (Fed.Cir.2005) ("Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection."). [...]

As we recently explained in *Juice Generation*, such extensive evidence of third-party use

and registrations is "powerful on its face," even where the specific extent and impact of the usage has not been established. 794 F.3d at 1339, 2015 WL 4400033, at *4 (detailing the extensive use of marks used in connection with the food service industry that incorporate the words "Peace" and "Love"). For example, evidence of third party registrations is relevant to "show the sense in which a mark is used in ordinary parlance," *id.* at 1339, 2015 WL 4400033 at *4; that is, some segment that is common to both parties' marks may have "a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak," *id.* In addition, evidence of third-party use of similar marks on similar goods "can show that customers have been educated to distinguish between different marks on the basis of minute distinctions." *Id.* at 1338, 2015 WL 4400033 at *3 (internal quotation marks omitted). In this case, Jack Wolfskin's evidence demonstrates the ubiquitous use of paw prints on clothing as source identifiers.

Jack Wolfskin v. New Millennium Sports, 797 F.3d 1363, 1373-74 (Fed. Cir. 2015)(finding Board erred in concluding that extrinsic evidence of third-party use was only neutral, rather than establishing weakness).

Here, there can be no doubt that the common term "warrior" is entitled to a very narrow scope of protection. This term is commonly used in the context of describing products which suggest qualities and imagery commonly relating to a warrior and overcoming challenges – such as strength, resilience, and endurance. As such, it is not strongly associated with the Cited Warrior Marks and, consistent with the recent Federal Circuit decisions of *Juice Generation* and *Jack Wolfskin*, the differences are of increased importance and preclude a finding of likelihood of confusion.

1. The Term "Warrior" is Used For a Wide Variety of Goods and Services

In consideration of the universal resonance of the "warrior" term, consumers have come to associate the term with a wide variety of sources. Even when the evidence reflects use other than strict source identification, the Federal Circuit has indicated that such evidence may be "powerful on its face" in establishing weakness of a mark. *Juice Generation Inc. v. GS Enterprises, LLC*, 794 F.3d 1334, 1339

(Fed. Cir. 2015). Clearly, such evidence exists in the present case.

By way of examples, a basic search of the internet for the term “warrior” produces thousands of products utilizing the term “warrior” to suggest warrior-like characteristics. Here is a small representative example of the common and overwhelming usage of “warrior” utilized in connection with the sale of a wide variety of products found on the Amazon marketplace having the below URL’s accessed on July 2nd, 2020 (see **Attachment.01 – Attachment.24**), which have no relation to the Cited Warrior Marks:

Attachment.01

<https://www.amazon.com/Sunwarrior-Warrior-Protein-Chocolate-Servings/dp/B07176RNWP>

Attachment.02

<https://www.amazon.com/Warrior-Tech-Rechargeable-Flameless-Upgraded/dp/B083F2C94V/>

Attachment.03

<https://www.amazon.com/Gentle-Warriors-Kan-Windbreaker/dp/B00ORQB7KA/>

Attachment.04

<https://www.amazon.com/Warrior-Protein-Granola-Peanut-Chocolate/dp/B082SV96NX/>

Attachment.05

<https://www.amazon.com/Kate-Somerville-Wrinkle-Warrior-Anti-Wrinkle/dp/B06X9B8W8X/>

Attachment.06

<https://www.amazon.com/American-Ninja-Warrior-Deluxe-NinjaLine/dp/B077BMCDHG/>

Attachment.07

<https://www.amazon.com/OLIGHT-Magnetic-Rechargeable-Tactical-Flashlight/dp/B083NPLG93/>

Attachment.08

<https://www.amazon.com/Medieval-Warrior-Trojan-Ponytail-Leather/dp/B07664T5QF/>

Attachment.09

<https://www.amazon.com/Warriors-Product-Backpack-Military-Tactical/dp/B07ZRFBG9X/>

Attachment.10

<https://www.amazon.com/Harnds-Warrior-Tactical-Titanium-Combination/dp/B07VMH43SF/>

Attachment.11

<https://www.amazon.com/Warrior-Table-Soccer-foosball-table/dp/B002LHP7JE/>

Attachment.12

<https://www.amazon.com/Arcturus-Warrior-Ghillie-Suit-Woodland/dp/B009L6RDGS/>

Attachment.13

<https://www.amazon.com/Warrior-Junior-Lacrosse-Stick-Black/dp/B07FN5BG74/>

Attachment.14

<https://www.amazon.com/Bear-Archery-Warrior-Youth-Bow/dp/B00HYJJXSA/>

Attachment.15

<https://www.amazon.com/Bolsa-Warrior-Black-Hole-T1/dp/B01KOXLVA0/>

Attachment.16

<https://www.amazon.com/Fierce-Defender-Holster-Winter-Warrior/dp/B075KWJ86K>

Attachment.17

<https://www.amazon.com/Shot-Warrior-Weighted-Tungsten-Barrels/dp/B07HDX21WL/>

Attachment.18

<https://www.amazon.com/Body-Glove-Barefoot-Warrior-Yellow/dp/B077V7HPTT/>

Attachment.19

<https://www.amazon.com/Game-Face-GameFace-Airsoft-GFR37PKT/dp/B079VJF51F/>

Attachment.20

<https://www.amazon.com/RAVE-Sports-Person-Warrior-Boat/dp/B009VR9C7A/>

Attachment.21

<https://www.amazon.com/Warrior-Quest-Adjustable-1000D-Nylon/dp/B0776X524D/>

Attachment.22

<https://www.amazon.com/Cold-Steel-Warrior-Handle-Scabbard/dp/B000Q9CAEY>

Attachment.23

<https://www.amazon.com/Tactical-Freerunning-athletes-gymnasts-climbers/dp/B075ZZ3VP5>

Attachment.24

<https://www.amazon.com/HEALTH-WARRIOR-Chocolate-Peanut-Butter/dp/B00CMQD0DE>

Further, a search for the term “warrior” in the basic index of the USPTO database accessed on July 3rd, 2020 reveals over 1600 live trademark application and registrations which encompass some form of the term “warrior” in the mark (See **Attachment.25**). Such evidence reinforces the “normally understood and well-recognized descriptive or suggestive meaning” of the term to refer to products having warrior-like qualities and conditions consumers to look for differences and additional indicia of origin when encountering the term in the marketplace.

Therefore, the evidence of record establishes that the term “warrior” is widely used which is normally understood and well-recognized as describing or suggesting a product has warrior-like qualities.

2. The Term “warrior” is Widely Used with Clothing Items

As clearly demonstrated by the cited Registrations in the office action date November 19th, 2020, the term “warrior” is widely used by third parties in connection with a wide variety of clothing products. Not unlike the paw prints in *Jack Wolfson* and the use of “peace and love” in *Juice Generation*, relevant evidence of third-party use is not limited to strict trademark usage and specific extent and impact of usage need not be separately established.

A search for “warrior” in the Amazon.com clothing department yields over 9000 results. The following is a list of Amazon product URL’s accessed on July 2nd, 2020 (See **Attachment.26 – Attachment.46**) which is a small representative example of the common and overwhelming usage of the term “warrior” utilized in connection with the sale of a wide variety of clothing related products not originating from the Cited Warrior Marks found on the Amazon marketplace:

Attachment.26

<https://www.amazon.com/Warrior-12-Baddest-Valley-White/dp/B083G8RBGD>

Attachment.27

<https://www.amazon.com/JM-WARRIORS-Embroidered-Military-Baseball/dp/B01HYUREK2>

Attachment.28

<https://www.amazon.com/WOLVERINE-Warrior-Puncture-Resistant-CarbonMax/dp/B07V5JVKKH>

Attachment.29

<https://www.amazon.com/Body-Glove-Barefoot-Warrior-Yellow/dp/B077V5CSTF>

Attachment.30

<https://www.amazon.com/Eat-Sleep-Warrior-Cats-Repeat/dp/B07K7FGHXX>

Attachment.31

<https://www.amazon.com/Under-Armour-Warrior-Bucket-Hat/dp/B07LFPQS9W/>

Attachment.32

<https://www.amazon.com/WOLVERINE-Warrior-Met-Guard-Boot-Brown/dp/B07SFZJNK7/>

Attachment.33

<https://www.amazon.com/Warrior-Alpaca-Socks-Performance-Black/dp/B00FA64KTG>

Attachment.34

<https://www.amazon.com/Stance-M803D18WAR-Warriors-Boxer-Underwear/dp/B07KGDFJJH>

Attachment.35

<https://www.amazon.com/Warrior-T-Shirt-Yoga-Peaceful-Mindful/dp/B07KW57XBQ>

Attachment.36

<https://www.amazon.com/Mountain-Warrior-Adult-T-Shirt-Medium/dp/B01MXF3EQ0>

Attachment.37

<https://www.amazon.com/Wonder-Woman-Movie-Warrior-Shirt/dp/B07KQ54LG4>

Attachment.38

<https://www.amazon.com/Warriors-Scholars-Athletic-Athletics-t-Shirt/dp/B07CZ77DY5>

Attachment.39

<https://www.amazon.com/Fibro-Warrior-Unbreakable-Fibromyalgia-Awareness/dp/B07C83QL9S/>

Attachment.40

<https://www.amazon.com/Warriors-Scholars-Hoodie-Men-Sweatshirt/dp/B07G72MKJ1>

Attachment.41

<https://www.amazon.com/Warrior-12-Believe-Something-Hoodie/dp/B07N4CDQSP/>

Attachment.42

<https://www.amazon.com/KRAV-MAGA-Hoodie-Israeli-Combat/dp/B07JCHYXLH>

Attachment.43

<https://www.amazon.com/Knight-Templar-American-Crusader-Pullover/dp/B07PVYMZ3K>

Attachment.44

<https://www.amazon.com/American-Warrior-Thin-Blue-Line/dp/B07GT54D35>

Attachment.45

<https://www.amazon.com/Black-Angel-Wings-Hoodie-Women/dp/B07PZZC1WF>

Attachment.46

<https://www.amazon.com/American-Warrior-Performance-T-Shirt-Blue-Medium/dp/B0754QNK2R/>

Further, a search of the PTO database reveals over 300 registrations containing the term WARRIOR in international class 025 relating to clothing items (See **Attachment.47** search results). The following table contains selected current live registrations that were thought to be highly relevant in providing evidence of substantial 3rd party use of the term “warrior” in connection with clothing products (See **Attachment.48 – Attachment.71**).

<i>Mark</i>	<i>Reg. or Ser. No.</i>	<i>Goods / Services</i>
SPORTS WARRIOR	2,658,825	Athletic clothing ...
WARRIORS	2,241,720	Clothing...
WARRIOR INTERNATIONAL	2,685,053	Clothing...
ECO WARRIOR	3,900,934	Clothing...
WARRIOR WORN	5,910,920	Clothing...
GOLDEN STATE WARRIORS	3,718,639	Clothing...

WARRIORS IN PINK	3,710,623	Clothing...
WARRIOR FISHING	4,495,245	Hats, T-shirts.
WARRIOR ONE	4,458,116	Athletic apparel...
WARRIOR ELEMENTS	4,883,247	Clothing...
WARRIOR ADDICT	5,006,532	Athletic pants; Baseball caps; Beanies; Capris; Hooded sweatshirts; Pants; Short-sleeved or long-sleeved t-shirts; Shorts; Sweatshirts; T-shirts; Tank-tops; Yoga pants
WARRIOR GEAR WG	5,074,640	Athletic pants; Athletic shirts; Athletic shorts; Beanies; Caps; Gloves; Shorts; Socks; Sweatpants; Sweatshirts; T-shirts.
WARRIOR NATION	6,064,403	Athletic apparel...
WARRIOR WOVEN	5,524,768	Beanies; Hats; Hoodies; Shirts
WARRIOR MOVEMENT	5,704,976	Hats; shirts; sweaters; sweatpants; wristbands
WARRIOR WAER	5,707,877	Tank tops, tops as clothing, pants, leggings, sweat pants, sweatshirts
WARRIOR STYLE	5,339,035	Clothing...
WARRIOR 12	5,245,663	B Baseball caps; Baseball caps and hats; Button down shirts; Collared shirts; Golf shirts; Graphic T-shirts; Henley shirts; Hooded sweat shirts; Jackets; Knitted caps; Pants; Shorts; Sweat shirts; T-shirts; Tee shirts; Wind shirts; Long-sleeved shirts.
WARRIORS RUGBY	5,955,972	Clothing...
WARRIOR UNLIMITED	5,842,875	Belts; Bottoms as clothing; Footwear; Headwear; Tops as Clothing
WARRIOR TOO	5,890,754	Sweatshirts; Tanks Tops...
WARRIOR ELITE	5,956,950	Clothing...

WARRIOR REPUBLIC	6,018,327	Hats; Hoodies; Martial arts uniforms, namely, gis; Rash guards; Shirts; Shorts; Sweat shirts; Dress shirts; Moisture-wicking sports shirts.
WARRIOR STRONG	6,068,355	Clothing, namely, t-shirts, sweatshirts, sweatpants, pants, tops, shorts, sweaters, hats, jackets, baby undergarments.
WARRIOR GIRL	6,090,092	Clothing...

Accordingly, given the widespread use of “warrior” by third parties with clothing products and given that such use substantially follows the normally understood meaning as providing warrior-like characteristics, there can be no question that the cited registrations are entitled to a very limited scope of protection in the present circumstances.

3. The Term “warrior” is Widely Used with Sporting Goods

In furtherance to the evidence detailed above, the term “warrior” is widely used by third parties in connection with a wide variety of sporting goods. A search for “warrior” in the Amazon.com Sports & Outdoors department yields over 5000 results. Moreover, a search of the PTO database reveals over 100 registrations containing the term “warrior” in international class 028 relating to sporting goods (See **Attachment.72** search results). **Attachment.73** – **Attachment.83** are selected current live registrations that were thought to be highly relevant in providing evidence of substantial 3rd party use of the term “warrior” in connection with sporting goods.

Accordingly, given the widespread use of “warrior” by third parties with sporting goods and given that such use substantially follows the normally understood meaning as providing warrior-like characteristics, there can be no question that the Cited Warrior Marks are entitled to a very limited scope of protection in the present circumstances.

B. There is No Likelihood of Confusion Because Applicant’s Mark is Distinct from Registrant’s Marks in Appearance, Connotation, and Commercial Impression

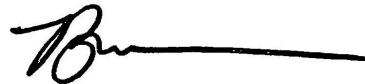
Given the volume of evidence in the record of widespread use and ordinary meaning to suggest warrior-like characteristics, consumers are conditioned to look for differences between marks when encountering the term “warrior” in the marketplace. Here, Applicant’s mark WARRIOR provides a distinctive overall appearance and commercial impression which should not be overlooked. While the shared portions are certainly part of the analysis, the marks must be considered in their entirety. *See Juice Generation, Inc., supra*, 794 F.3d at 1340-4. In stark contrast to the cited marks, Applicant’s mark is distinctive boasting the silhouette of a person wielding a sword and a shield collectively representing the first letter R of the literal element as well as the term WARRIOR underscored. Given that consumers have been conditioned to look for differences between the marks when encountering the term “warrior”, Applicant’s mark provides an overall, distinctive appearance than that of the Cited Warrior Marks, namely, WARRIOR CATS, WARRIOR STYLE, and WARRIOR marketed towards a wide variety of goods. Thus, when the marks are properly considered in their entireties, the differences in the respective marks’ appearances and overall commercial impressions extinguish any likelihood of confusion.

C. Conclusion

In consideration of the foregoing, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register. In view of the myriad of third-party use – the term “warrior” should be afforded a narrow scope of protection. Moreover, Applicant submits to the Examiner that by comparing the marks in their entirety involving their appearance, connotation, commercial impression, the marks are sufficiently different in that there is not a likelihood of confusion as to the goods originating from the same source.

Applicant respectfully requests that the Examining Attorney consider the preceding arguments and that the Section 2(d) Refusal be withdrawn.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "B. Miracle", followed by a long horizontal line extending to the right.

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