

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: WHITE RIVER MARINE)
GROUP LLC)
Mark: TRACKER)
Serial No.: 88/361790)
Examiner: Sarah E. Kunkleman
Law Office: 105
RESPONSE TO OFFICE ACTION

In response to the Examiner’s Office Action, Applicant submits the following:

I. IDENTIFICATION AND CLASSIFICATION OF GOODS

Elsewhere in this Response, and in accordance with the Examiner’s request and proposals, Applicant has amended the identifications of goods as follows:

- Class 4: Engine oils; **automotive** lubricants; **all-purpose** lubricants.
- ~~Class 7: Replacement parts for vehicles.~~
- Class 9: Protective wear, namely, **safety** goggles, helmets; electrical systems **comprised of electric accumulators and batteries for vehicles.**
- Class 12: ~~Vehicles accessories, namely,~~ **truck** bed extenders, hood **cargo** racks, brush guards **being automobile bumper guards**, gun mounts **being gun racks for vehicles**; suspension systems **for automobiles**; transmissions **for land vehicles**; electrical systems **comprised of electric motors for land vehicles**;
- Class 25: Clothing, namely, hats, caps being headwear, shirts, t-shirts.

II. SECTION 2(d) REFUSALS & PRIOR PENDING APPLICATIONS

The Examiner has refused registration of Applicant’s mark TRACKER (“Applicant’s Mark”) under Section 2(d) of the Trademark Act, contending that there is a likelihood of confusion with the following registrations:

- **TRACKER** – Reg. No. 1927534 for “supports for roof-mounted racks for vehicles” in Class 12, owned by Thule Sweden AB (“534 Mark”);
- **TRACKER** – Reg. No. 1074959 for “tires” in Class 12, owned by Goodyear Tire & Rubber Company (“959 Mark”);
- **TRAKKER** – Reg. No. 4615794 for “heavy off-road trucks” in Class 12, owned by Iveco S.p.A. (“794 Mark”);

- **TRAKKER** – Reg. No. 3595239 for “winches” in Class 7, owned by Hampton Products International Corporation (“239 Mark”);
- **TRAKOR** – Reg. No. 3072614 for “snow grooming machine implements, namely plows, tillers, cutter bars and rakes and replacement parts therefor for use in connection with grooming snow” in Class 7, owned by Snow Groomers, Inc. (“614 Mark”);
- **TRACKER** – Reg. No. 4607341 for “treestands for hunting” in Class 28, owned by Outdoor Technology Group, LLC (“341 Mark”); and
- **TRACKER** – Reg. No. 4004840 for “money belts; gloves; mittens; woolen caps; hats; scarves; slippers” in Class 25, owned by Bentley Leathers, Inc. (“840 Mark”).

In addition, the Examiner has cited the following prior pending applications as potential bars to registration of Applicant’s Mark if they proceed to registration:

- **TRACKER** – Serial No. 88353898 for “tow bars for trailers; tow bars for vehicles; vehicle tow bar connector covers” in Class 12, filed by Roadmaster, Inc. (“898 Mark”);
- **TRACKER** – Serial No. 88088415 for “pistons for motorcycles” in Class 7, filed by Race Winning Brands, Inc. (“415 Mark”); and
- **TRACKER** – Serial No. 87582011 for “retail stores services in the field of clothing, footwear and fashion accessories, luggage, bags, sleeves, cases, wallets, wallets on a string, purses, backpacks, travel accessories, office supplies, optical products, namely, sunglasses, eyeglasses, binoculars, cameras, lens cleaning wipes, lens cleaning liquids, cases for sunglasses and reading glasses, cords for eyeglasses, chains for eyeglasses, personal care products and containers for food and drink; online retail store services in the field of clothing, footwear and fashion accessories, luggage, bags, sleeves, cases, wallets, wallets on a string, purses, backpacks, travel accessories, office supplies, optical products, namely, sunglasses, eyeglasses, binoculars, cameras, lens cleaning wipes, lens cleaning liquids, cases for sunglasses and reading glasses, cords for eyeglasses, chains for eyeglasses, personal care products and containers for food and drink” in Class 35, filed by Bentley Leathers, Inc. (“011 Mark”).

Applicant respectfully disagrees with the Examiner that there is a likelihood of confusion between Applicant’s Mark and any of the cited marks, as the vast number of TRACKER marks that have been cited, as well as that are registered and in use, shows that the word is weak, such that slight differences between the marks and/or goods suffice to avoid a likelihood of confusion, and because Applicant’s Mark has been amended to distinguish its goods from the cited marks. *See In re E. I. du Pont de Nemours & Co.* 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).

A. Some of the Cited Marks Are Abandoned

First, Applicant notes that a renewal was due for the ‘534 Mark by a final deadline of April 17, 2016 and the record shows that a renewal was not filed by that date, so that registration should be cancelled and the Section 2(d) refusal based on the registration should be withdrawn.

In addition, a renewal was due for the ‘239 registration by a final deadline of September 24, 2019 and the record shows that a renewal was not filed by that date, so that registration should also be cancelled and the Section 2(d) refusal based on the registration should be withdrawn.

B. The Cited TRACKER Marks Have a Limited Scope of Protection

Given the great number of third party registrations for the mark TRACKER, or similar marks, in the relevant fields of use, the word is commercially weak as a mark, and thus entitled to a narrow scope of protection against virtually identical marks for virtually the same goods, which Applicant’s Mark is not.

It is well-established that, if the common element of conflicting marks is a word that is “weak,” in the sense that it is descriptive, highly suggestive, or is in common use by many other sellers in the market, the likelihood of confusion is reduced. *See Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970).

The Examiner has cited seven registrations and three prior pending applications for the mark TRACKER, or similar marks, as bars to registration of Applicant’s Mark, seven of which are for the exact mark TRACKER in standard characters. The co-existence of these cited marks, in and of itself, evidences that the word TRACKER is in common use and has a narrow scope of protection. *See Keebler Co. v. Associated Biscuits, Ltd.*, 207 U.S.P.Q. 1034, 1038 (T.T.A.B. 1980) (citing the plethora of marks registered by the PTO and incorporating the term CLUB as evidence supporting the Board’s finding that such marks were “entitled to only a very circumscribed scope of protection limited to essentially the same mark for essentially the same goods.”).

Such a multitude of registered TRACKER marks owned by different parties in relevant fields further emphasizes that the word is commonly used and that slight differences between the marks and/or goods suffice to distinguish the marks. For example, there are at least 30 registrations for TRACKER or similar marks covering vehicles, parts therefor, and/or related products in Class 12, such as the following representative selection:

- **STREET TRACKER** – Reg. No. 4792704 for “land vehicles, namely, motorcycles, mopeds, scooters, and powered two-wheeled vehicles, namely, e-bikes; luggage racks adapted specifically for motorcycles, mopeds, scooters, and powered two-wheeled vehicles, namely, e-bikes; anti-theft alarm devices for motorcycles and land vehicles; stands for holding motorcycles upright, not being structures; tyres; parts and fittings for all of the aforesaid goods” in Class 12, owned by Triumph Designs Limited;
- **QUAD-STEER TRACKER** – Reg. No. 2590986 for “cargo trailers” in Class 12, owned by Peregrine, Inc.;

- **SNOW TRACKER** – Reg. No. 2752446 for “snowmobile ski accessories, namely steel and plastic pads used under the skis to stabilize the direction of snowmobile” in Class 12, owned by SCM-GL Inc.;
- **SNOWTRAKKER** – Reg. No. 2291475 for “tires” in Class 12, owned by Goodyear Tire & Rubber Company;
- **HYDRAULIC WHEELTRACKER** – Reg. No. 4905474 for “pieces and accessories for recreational vehicles in the nature of ski equipped vehicles, ski-dozers, snowmobiles, motorcycles, mountain bicycles, namely, an automatic positioning wheels system comprised of hydraulic motor and pump, stainless steel tubes, hydraulic cylinders, and electrical wiring” in Class 12, owned by Gestion SCM-GL Inc.;
- **HYTRACKER** – Reg. No. 2017612 for “rail road equipment, namely rail carts and self-propelled railway low beds used to transport heavy maintenance equipment and for use in rail side repairs” in Class 12, owned by Hytracker Manufacturing Ltd.;
- **TRACKER JACK** – Reg. No. 2986200 for “anti-theft system for automotive vehicles, comprised primarily of stencils and etch cream and permanent labels to place personal numbers on glass and metal” in Class 12, owned by Creative Stencil, Inc.;
- **TRACER** – Reg. No. 5444139 for “motorcycles, motor scooters, mopeds, three-wheeled motorcycles, three-wheeled motor scooters, three-wheeled mopeds and structural parts thereof” in Class 12, owned by Yamaha Hatsudoki Kabushiki Kaisha; and
- **TRACER** – Reg. No. 4406756 for “bicycle frames; bicycles; frames for bicycles; structural parts of bicycles” in Class 12, owned by Johnny Jiang.

See attached TESS printouts of the above-referenced registrations.


There are also at least 20 registrations for TRACKER or similar marks covering clothing, footwear, and/or headwear in Class 25, such as the following representative selection:





- **TROPHY TRACKER** – Reg. No. 5723383 for “headwear and clothing, namely, t-shirts” in Class 25, owned by Outdoor Cap Company, Inc.;
- **PROTRACKER** – Reg. No. 4556132 for “clothing, namely, caps and shirts” in Class 25, owned by Pro-Tracker IP Holding, LLC;
- **SILENT TRACKER** – Reg. No. 3101265 for “footwear, namely, shoes and boots” in Class 25, owned by American Sports Licensing, LLC;

- **SWAMP TRACKER** – Reg. No. 2981630 for “footwear, namely, boots” in Class 25, owned by American Sports Licensing, LLC;
- **DEER TRACKER** – Reg. No. 4676347 for “hunting boots” in Class 25, owned by Red Wing Shoe Company, Inc.;
- **SNOW TRACKER** – Reg. No. 2808519 for “hunting boots for adults” in Class 25, owned by Red Wing Shoe Company, Inc.;
- **BAD ASS FLAT TRACKER** – Reg. No. 5244541 for “tee shirts” in Class 25, owned by Rocky Dean Heuer Jr.;
- **AMERICAN FLAT TRACKER** – Reg. No. 4938332 for “hooded sweatshirts” in Class 25, owned by Daytona Motorsports Group, LLC;
- **MARSHAL A.R.T. AMERICAN RENEGADE TRACKER** – Reg. No. 4627084 for “clothing, namely, shirts, t-shirts, sweatshirts, sweat pants, sweat suits, pants, skirts, shorts, sarongs, vests, boxer shorts, underwear, jackets, coats, rain wear, pullovers, sweaters, jumpers, overalls, rompers, infant wear, socks, shoes, slippers, Halloween and masquerade costumes, promotional mascot character costumes, sleep wear, robes, hats, caps, bandanas, headbands, gloves, mufflers, scarves, swimwear, beach cover ups” in Class 25, owned by Kiaico, Inc.;
- **U.S. MARSHAL AMERICAN RENEGADE TRACKER** – Reg. No. 4072057 for “clothing, namely, shirts, t-shirts, sweatshirts, jackets, pullovers, sweaters, jumpers, rompers, infant wear, promotional mascot character costumes, sleep wear, hats, caps, scarves” in Class 25, owned by Kiaico, Inc.;
- **BROOKER TRACKER** – Reg. No. 5371892 for “clothing, namely, shirts, t-shirts, sweat shirts, hooded sweat shirts, sweat jackets, polo shirts, golf shirts, headwear, hats, caps, sun visors, pants, yoga pants, slacks, jeans, shorts, bike shorts, dresses, undergarments, boxer shorts, underwear, sweaters, jackets, socks, wrist bands, head bands, sweat bands, footwear, namely, shoes, sneakers, tennis shoes” in Class 25, owned by Brooker Tracker Enterprises, LLC;
- **RIDGETRACKER** – Reg. No. 5381075 for “bottoms; jeans” in Class 25, owned by Wrangler Apparel Corp.;
- **TRACERS** – Reg. No. 1528400 for “footwear” in Class 25, owned by E.S. Originals, Inc.; and
- **TRACER LIGHT** – Reg. No. 3709477 for “clothing, namely, swimwear” in Class 25, owned by TYR Sport, Inc.

See attached TESS printouts of the above-referenced registrations.

Moreover, it is noteworthy that Applicant owns a family of over 21 registrations for TRACKER marks, including at least 16 registrations covering relevant products in Class 12, many of which predate the cited marks, including but not limited to the following:

- **TRACKER** – Reg. No. 5823489 for “ATVs (all terrain vehicles); UTVs (utility terrain vehicles)” in Class 12;
- **TRACKER OFF ROAD** – Reg. No. 5887067 for “ATVs (all terrain vehicles); UTVs (utility terrain vehicles)” in Class 12;
- **TRACKER** – Reg. No. 5887156 for “PTVs (personal transportation vehicles); motorized golf carts” in Class 12;
- **TRACKER OFF ROAD** – Reg. No. 5887157 for “PTVs (personal transportation vehicles); motorized golf carts” in Class 12;
- **TRACKER** – Reg. No. 1674981 for “boats” in Class 12;
- **TRACKER** – Reg. No. 2149269 for “trailers, namely, boat trailers” in Class 12;
- **TRACKER** – Reg. No. 1629823 for “internal combustion out-board motors for boats” in Class 7;
- **TRACKER** – Reg. No. 1629822 for “electric trolling motors for boats” in Class 12;
- **TRACKER MARINE** – Reg. No. 1473642 for “retail and mail order services in the field of boats and boat accessories” in Class 42;
-  **TRACKER MARINE GROUP** – Reg. No. 2908546 for “Distributorship services in the field of boats, motors for boats, and trailers for boats” in Class 35 and “Manufacture of boats and boat trailers to the order and/or specification of others” in Class 40;
- **TRACKER BOATING CENTERS** – Reg. No. 3892533 for “Retail store services featuring boats and boating accessories” in Class 35;
- **TRACKER BOATING CENTER** – Reg. No. 3892532 for “Retail store services featuring boats and boating accessories” in Class 35;
- **TRACKER PRO 160** – Reg. No. 4604175 for “boats” in Class 12;
- **TRACKER PRO TEAM 175 TF** – Reg. No. 4616023 for “boats” in Class 12;
- **TRACKER PRO TEAM 175 TXW** – Reg. No. 4616022 for “boats” in Class 12;
- **BASS TRACKER** – Reg. No. 2989611 for “boats” in Class 12;

-  – Reg. No. 1179015 for “fishing boats” in Class 12;
- SUN TRACKER – Reg. No. 1618655 for “boats” in Class 12;
-  – Reg. No. 3909653 for “boats” in Class 12;
-  – Reg. No. 3909651 for “boats” in Class 12; and
-  – Reg. No. 4820876 for “boats; structural parts for boats” in Class 12.

See attached TESS printouts of the above-referenced registrations.

The prevalence of so many registrations for TRACKER marks covering related products demonstrates that the word is in common use, such that slight differences between the goods suffice to avoid a likelihood of confusion. *See In re Hamilton Bank*, 222 U.S.P.Q. 174, 177 (T.T.A.B. 1984) (third-party registrations may be used effectively to show that a mark is inherently weak, such as to show that different entities have adopted and registered marks in a particular field, and that the PTO has allowed the registration of marks over one another despite the fact that they have some points of similarity). Given the fact that the USPTO has allowed each of the cited marks to be registered alongside the multitude of similar marks, including Applicant’s family of over 21 registrations for TRACKER marks covering related goods, distinguished by specific differences between the goods, Applicant’s Mark should not be singled out and should be allowed to be registered as well, especially considering Applicant’s amendments to its applied-for goods.

C. The Goods at Issue Are Sufficiently Different

1. ‘534, ‘959, ‘239 & ‘614 Marks

The Examiner contends that “replacements parts for vehicles,” as covered by Applicant’s Mark, could encompass the goods covered by the following marks:

- **‘524 Mark:** “Supports for roof-mounted racks for vehicles” in Class 12;
- **‘959 Mark:** “Tires” in Class 12;
- **‘239 Mark:** “Winches” in Class 7; and
- **‘614 Mark:** “Snow grooming machine implements, namely plows, tillers, cutter bars and rakes and replacement parts therefor for use in connection with grooming snow” in Class 7

While Applicant denies there being any likelihood of confusion between the marks, elsewhere in this Response, Applicant has filed an amendment to delete the general wording “replacement parts for vehicles” from the application. As amended, the respective goods are specifically different, and considering the number of TRACKER or similar marks that are seemingly co-existing for different vehicle parts and products, the specific differences between the goods at issue suffice to distinguish the marks. Further, as noted above, the ‘534 Mark and ‘239 Mark were not timely renewed, so they should be cancelled. Accordingly, as the goods at issue have been deleted and the remaining goods are sufficiently different, it is clear that there is no likelihood of confusion between the marks and Applicant requests that the Section 2(d) refusals based on the ‘534 Mark, the ‘959 Mark, the ‘239 Mark, and the ‘614 Mark be withdrawn.

2. ‘794, ‘898 & ‘415 Marks

The Examiner also seems to contend that “replacements parts for vehicles,” as covered by Applicant’s Mark, are related for likelihood of confusion purposes to the goods covered by the following marks:

- **‘794 Mark:** “Heavy off-road trucks” in Class 12;
- **‘898 Mark:** “Tow bars for trailers; tow bars for vehicles; vehicle tow bar connector covers” in Class 12; and
- **‘415 Mark:** “Pistons for motorcycles” in Class 7.

While Applicant denies there being any likelihood of confusion between the marks, elsewhere in this Response, now that Applicant’s Mark has been amended to delete the general wording “replacement parts for vehicles” and “vehicle accessories” from the application, Applicant’s goods are specifically different from the goods covered by these cited marks. Considering the number of TRACKER or similar marks that are seemingly co-existing for different vehicle parts and products, the specific differences between the goods at issue suffice to distinguish the marks. As such, as the goods at issue are sufficiently different, there is no likelihood of confusion between the marks and Applicant requests that the citations for potential Section 2(d) refusals based on the ‘794 Mark, the ‘898 Mark, and the ‘415 Mark be withdrawn.

3. ‘840 Mark ‘011 Mark

The Examiner contends that “hats, caps being headwear,” as covered by Applicant’s Mark, encompass “woolen caps and hats” in the ‘840 Mark, and also seems to contend that “hats, caps being headwear” are related for likelihood of confusion purposes with the retail store services and online retail store services covered by the ‘011 Mark.

Applicant denies there being any likelihood of confusion between the marks given the large number of other TRACKER marks that are seemingly co-existing. Further, Applicant reserves the right to submit arguments and evidence against a potential Section 2(d) refusal based on the ‘011 Mark at a later date if and when that mark proceeds to registration.

4. '341 Mark

The Examiner seems to contend that “gun mounts,” as covered by Applicant’s Mark, are related for likelihood of confusion purposes to “hunting tree stands” covered by the ‘341 Mark.

While Applicant denies there being any likelihood of confusion between the marks, elsewhere in this Response, Applicant has amended the goods at issue to “gun mounts being gun racks for vehicles.” As amended, the respective goods, namely gun racks for vehicles and hunting tree stands, are specifically different, and considering the number of TRACKER or similar marks that are seemingly co-existing for similar, but specifically different, goods, the specific differences between the goods at issue should suffice to distinguish the marks. Accordingly, as the goods at issue have been amended to further distinguish them from hunting tree stands, it is clear that there is no likelihood of confusion between the marks and Applicant requests that the Section 2(d) refusal based on the ‘341 Mark be withdrawn.

D. There is No Likelihood of Confusion

Given the number of TRACKER or similar marks that are seemingly co-existing in related fields based on slight differences between the respective goods, and considering the specific differences with the goods covered Applicant’s Mark, there is no likelihood of confusion between Applicant’s Mark and the cited registrations. Therefore, the Section 2(d) refusals should be withdrawn and Applicant’s Mark should be approved for publication.