

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77481198
LAW OFFICE ASSIGNED	LAW OFFICE 112
MARK SECTION (no change)	
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	http://tgate/PDF/RFR/2009/05/25/20090525131700807482-77481198-001_001/evi_68110175167-123741441_ _T07950_requestForReconsideration.pdf
CONVERTED PDF FILE(S) (7 pages)	\\TICRS\EXPORT7\IMAGEOUT7\774\811\77481198\xml1\RFR002.JPG
	\\TICRS\EXPORT7\IMAGEOUT7\774\811\77481198\xml1\RFR003.JPG
	\\TICRS\EXPORT7\IMAGEOUT7\774\811\77481198\xml1\RFR004.JPG
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	\\TICRS\EXPORT7\IMAGEOUT7\774\811\77481198\xml1\RFR008.JPG
DESCRIPTION OF EVIDENCE FILE	Remarks/Arguments.
GOODS AND/OR SERVICES SECTION (current)	

INTERNATIONAL CLASS	035
DESCRIPTION	
online retail store services related to sporting goods and sporting gear, extreme-sport sporting goods, extreme-sport gear, watersports, wakeboards, waterskiis, snowsports, snowboards, snowskiis, watersport-related gear, snowsport-related gear, related accessories, related apparel, related clothing, related footwear, and related silks, for men and women	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	035
DESCRIPTION	
online retail store services featuring snowboards, snow-skis, wakeboards, water-skis, and related accessories, apparel and footwear, specifically excluding fishing equipment, fishing lures, fishing rods, and fishing lines	
FILING BASIS	Section 1(b)
SIGNATURE SECTION	
DECLARATION SIGNATURE	The filing Attorney has elected not to submit the signed declaration, believing no supporting declaration is required under the <i>Trademark Rules of Practice</i> .
RESPONSE SIGNATURE	/Michael D. Volk Jr./
SIGNATORY'S NAME	Michael D. Volk Jr.
SIGNATORY'S POSITION	Attorney of record, Arizona bar memner
DATE SIGNED	05/25/2009
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon May 25 13:17:00 EDT 2009
TEAS STAMP	USPTO/RFR-68.110.175.167- 20090525131700807482-7748 1198-430442d0c5ef5be4ab6d d80971b26d6e-N/A-N/A-2009 0525123741441597

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. 77481198 has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Please see the actual argument text attached within the Evidence section.

EVIDENCE

Evidence in the nature of Remarks/Arguments. has been attached.

Original PDF file:

http://tgate/PDF/RFR/2009/05/25/20090525131700807482-77481198-001_001/evi_68110175167-123741441_._T07950_requestForReconsideration.pdf

Converted PDF file(s) (7 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Evidence-5

Evidence-6

Evidence-7

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 035 for online retail store services related to sporting goods and sporting gear, extreme-sport sporting goods, extreme-sport gear, watersports, wakeboards, waterskiis, snowsports, snowboards, snowskiis, watersport-related gear, snowsport-related gear, related accessories, related apparel, related clothing, related footwear, and related silks, for men and women

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed: Class 035 for online retail store services featuring snowboards, snow-skis, wakeboards, water-skis, and related accessories, apparel and footwear, specifically excluding fishing equipment, fishing lures, fishing rods, and fishing lines

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)

Declaration Signature

I hereby elect to bypass the submission of a signed declaration, because I believe a declaration is not required by the rules of practice. I understand that the examining attorney could still, upon later review, require a signed declaration.

Request for Reconsideration Signature

Signature: /Michael D. Volk Jr./ Date: 05/25/2009
Signatory's Name: Michael D. Volk Jr.
Signatory's Position: Attorney of record, Arizona bar memner

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77481198
Internet Transmission Date: Mon May 25 13:17:00 EDT 2009
TEAS Stamp: USPTO/RFR-68.110.175.167-200905251317008
07482-77481198-430442d0c5ef5be4ab6dd8097
1b26d6e-N/A-N/A-20090525123741441597

Docket No. T07950

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
APPLICANT : Okraski et al.
MARK : REDEMPTION SPORTS
SERIAL NO. : 77/481,198
FILING DATE : 5/22/2008
ATTY. DOCKET NO. : T07950

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

REQUEST FOR RECONSIDERATION AFTER FINAL ACTION

Attention: Examiner Sharon A. Meier
Law Office 112
(571) 272-9195

Hon. Commissioner,

This is an amendment and "Request for Reconsideration after Final Office Action" in response to the Office Action dated 12/5/2008. Favorable reconsideration is respectfully requested.

AMENDMENTS

Please see amendments submitted via TEAS.

REMARKS

LIKELIHOOD OF CONFUSION – SECTION 2(d) REFUSAL

The examining Attorney has made the refusal to register the applied-for mark final. Applicant respectfully requests reconsideration of the refusal in view of the amendment to the identified services and the following remarks.

The Examining Attorney has refused registration of the above-referenced mark alleging that there would be a likelihood of confusion between Applicant's applied-for mark and U.S. Registration No. 3,473,211.

CERTIFICATE OF TRANSMISSION

I hereby certify that, on the date shown below, this correspondence is being transmitted to the U.S. Patent and Trademark Office by the Trademark Electronic Application System ("TEAS").

Date: May 25, 2009

/Michael D. Volk Jr./

Signature

Michael D. Volk Jr.

(type or print name of person certifying)

The Examiner states that “the Applicant’s recitation is broad enough to encompass retail sales of goods identical to the registrant’s fishing gear. Specifically, the Applicant’s recitation begins ‘online retail store services related to sporting goods and sporting gear.’ This wording is broad enough to encompass sporting goods in the nature of fishing equipment.”

Applicant has amended the services. Applicant’s services specifically exclude those services and goods which might be confused with the registrant’s fishing lures, fishing rods, and fishing lines.

When the registrant’s identification is sufficiently narrow, the Applicant can amend its identification of goods and services in the application to show the difference between the goods or services.

Since a comparison of the goods or services in applications is based solely upon the respective identifications, it is evident that, as now defined, Applicant’s services clearly differentiate it from the *goods* of the cited registration. Accordingly, it is respectfully submitted that the mark should be published for opposition.

Additionally, the Examiner states, “The Applicant’s services are related to the registrant’s goods because they are all types of sporting goods that are often sold by the same source under the same marks. Fishing goods and sporting goods are commonly sold under the same mark” and that the attached “printouts have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely sporting goods and retail services featuring sporting goods, are of a kind that may emanate from a single source. *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d) (iii).”

Applicant respectfully submits that (according to TMEP §1207.01(d) (iii)) third-party registrations that cover a number of different goods or services only have “*some*” probative value to the extent that they “*may*” serve to “*suggest*” that goods or services are of a type that “*may*” emanate from a single source. The fact that the goods/services may emanate from a single source is just *one* factor with regards to the evaluation of a likelihood of confusion. Applicant respectfully submits that the Examiner must compare the marks in their entirety to determine whether there is a “likelihood of confusion”. *Packard Press, Inc. v. Hewlett-Packard Co.*, 56 U.S.P.Q.2d 1351 (Fed. Cir. 2000).

It is evident that Applicant’s services do not cover sporting goods in general and that the Applicant’s services specifically exclude fishing equipment, fishing lures, fishing rods, and fishing lines. In other words, the Applicant’s recitation of *services* specifically excludes retail sales of *goods* identical to the registrant’s *highly specialized goods* of fishing lures, fishing rods, and fishing lines. Thus, it is respectfully submitted that the printouts have significantly diminished, if any, probative value in this matter anymore, since the Applicant does not sell a broad range of sporting goods.

The Examiner also states that the Trademark Trial and Appeal Board has held that various sporting *goods* are considered related *goods* under Trademark Act Section 2(d), such that their marketing under the same or similar marks may be likely to cause source confusion.

Applicant respectfully submits that all of the examples provided by the Examining Attorney regard *goods*, not a comparison of *services* and *goods*. Further, it has to be taken into consideration that there is a difference between goods and services. *Shen Mfg. Co., Inc. v. The Ritz Hotel, Ltd.*, 393 F.3d 1238, 1245 (Fed. Cir., 2004) (“Cooking classes are not the same type of product as kitchen textiles: one is a service while the other is a tangible good. Nor are they the same category of product in the sense that snack foods and dog treats are. In this sense, it would be more accurate to say that cooking classes are in the same category as language or pottery classes”).

Applicant further submits that all the cases¹ referenced by the Examining Attorney regard marks which are very similar in appearance and, thus, are not comparable to the present case. The registrant’s mark consists of one word while Applicant’s mark consists of two words, which has the effect that the overall impression of the words composing the mark is different.

A policy relating to the “likelihood of confusion” standard is that a senior user is protected against the use of confusingly similar marks on closely related goods so that the senior user may enter markets in which it does not now trade, but into which it might reasonably be expected to expand in the future.

Applicant respectfully submits that since the Registrant only focuses on highly specialized goods (fishing equipment, fishing lures, fishing rods, and fishing lines) it is not reasonable to expect the Registrant to expand its business into services featuring snowboards, snow-skis, wakeboards, water-skis, related apparel and related footwear. Applicant submits herewith Exhibit A (pictures from registrant’s website available at <http://www.luckycraft.com/luckycrafthome/home.htm>) demonstrating that the Registrant develops *highly specialized fishing equipment* (for professional anglers). Based on the fact that the registrant develops *highly specialized fishing equipment*, it is not likely that the registrant would expand business into services featuring snowboards, snow-skis, etc. In fact, the Registrant’s mission statement states²,

Lucky Craft Inc., craftsmen of the Pointer, Sammy and other high performance lures, is quickly becoming recognized as the leader among American anglers. In a whirlwind of tournament victories across the country, Lucky Craft has become the Pros' #1 choice in bait. And now the secret is out as anglers of all levels are

¹ See page 4, paragraph 2 of the outstanding Office Action.

² See Exhibit A.

developing a special attraction for these lures for one simple reason... they catch more fish. Our lures, a result of many years of research and development coupled with the finest materials, patented manufacturing process and quality control, are a testament to our complete dedication for the ultimate fishing experience. This excellence in craftsmanship goes into every Lucky Craft bait. As soon as you pick up our lure, you immediately see the quality that's apparent in our product. And we're proud to say, that's just the beginning... wait until you feel the irresistible action on the water!

Applicant further submits that if the goods are related, but not competitive, several other factors are added to the calculus. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (C.A.9 (Cal.), 1979). Applicant's and registrant's goods are not competitive since the registrant goods are *highly specialized fishing equipment* and the Applicant specifically excludes fishing equipment from the description of *services*.

The Examiner also states that "because registrant's identification is unrestricted, it must be presumed to include all the normal types of sporting goods sold through all the normal trade channels for sporting goods and fishing gear. This includes goods commonly sold through the same trade channels as Applicant's goods."

Applicant respectfully submits that the identification as amended is restricted. Thus, it cannot be presumed anymore that the identification includes all types of sporting goods sold through all the normal trade channels for sporting goods and fishing goods.

The Examiner states that the marks share the identical allegedly dominant term REDEMPTION and that the "mere addition" of the descriptive term SPORTS to the Applicant's mark will not avoid a likelihood of confusion with the registrant's mark.

Applicant respectfully submits that there are exceptions to the general rule stated by the Examiner if the marks in their entireties convey different commercial impressions. *In re Sheen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with "CATFISH" disclaimed) for fish held not likely to be confused with BOBBER for restaurant services); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

In this case, the applied for and the registered mark convey different commercial impressions. The registered mark "Redemption" does not create any particular commercial impression while the

Serial No. 77/481.198
Docket No. T07950

applied-for mark creates a "sports" impression. Thus, the two marks convey different commercial impressions.

In view of the amendments submitted herewith and the above comments, Applicant respectfully requests favorable reconsideration and ask that the Examiner find that there is no likelihood of confusion.

If the Examiner would like to discuss any issues in this application by telephonic interview, Applicant's undersigned attorney respectfully invites such a discussion. Applicant's undersigned attorney is reachable at 602.263.9200.

Respectfully submitted,

Date: May 25, 2009

/Michael D. Volk Jr./

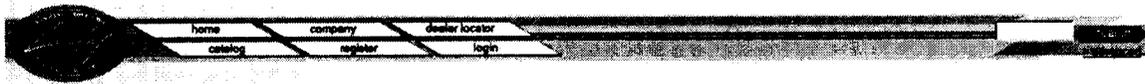
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Enc. Exhibit A

EXHIBIT A-1

The screenshot displays the Lucky Craft website interface. At the top left, there is a 'TEAM LUCKY CRAFT' logo and a 'YouTube' logo. A navigation menu on the left lists: Home, History, National Pro Staff, National Pro Staff ~SW~, Regional Pro Staff, International Pro Staff, Media, Catalog, Item List, and For Dealer. The main content area features a large image of two fishing lures, the Sammy 105 and Kelly J. Below the image is the heading 'The Sammy 105 & Kelly J' and a short article snippet: 'CASTA & EIA, Calif. - April 17, 2009) - AT ICAST 2008, Lucky Craft released the Sammy 105, a new design of one of the most popular Lucky Craft topwater lures. The new bait doesn't replace any of the existing baits in the Sammy series, but with its new features, it will add another element to fishing a topwater plug. Read entire story >>'. To the right of the article is a 'Product' section with a 'Redemption' link. At the bottom left, there are banners for 'The Daily Crank' magazine, a 'Redemption' offer for a 'FREE Monthly Magazine' with the text 'Sign up Today!', and logos for 'YouTube' and 'STIHL'.

EXHIBIT A-2



company

Contact information

Telephone
> Toll Free (800) 270-3117
> Catalog Request: (714) 241-8484 x1
> Sales: (714) 241-8484 x1
> Accounting: (714) 241-8484 x2
> Warehouse: (714) 241-8484 x3

Facsimile
> (714) 241-8480

Address
> 380 Clinton Street
> Costa Mesa, CA 92626

E-mail
> Catalog Request: info@luckycraft.com
> Sales: sales@luckycraft.com
> Customer Support: support@luckycraft.com

Complete Dedication to Ultimate Performance...that's Lucky Craft

Lucky Craft Inc., craftsmen of the Pointer, Sammy and other high performance lures, is quickly becoming recognized as the leader among American anglers.

In a whirlwind of tournament victories across the country, Lucky Craft has become the Pros' #1 choice in bait. And now the secret is out as anglers of all levels are developing a special attraction for these lures for one simple reason... they catch more fish.

Our lures, a result of many years of research and development coupled with the finest materials, patented manufacturing process and quality control, are a testament to our complete dedication for the ultimate fishing experience. This excellence in craftsmanship goes into every Lucky Craft bait.

As soon as you pick up our lure, you immediately see the quality that's apparent in our product. And we're proud to say, that's just the beginning... wait until you feel the irresistible action on the water!

So get your Lucky Craft lure today and experience the ultimate rewards of fishing.

Modern Technology &
Traditional Craftsmanship

