

ESTTA Tracking number: **ESTTA516560**

Filing date: **01/17/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Watercraft Superstore, Inc.		
Entity	Corporation	Citizenship	Florida
Address	1401 North Myrtle Avenue Clearwater, FL 33755 UNITED STATES		

Correspondence information	Zachary D. Messa Attorney of Record Johnson, Pope, Bokor, Ruppel & Burns, LLP 911 Chestnut Street Clearwater, FL 33756 UNITED STATES zacharym@jpfirm.com, pattit@jpfirm.com Phone:727/461-1818		
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Applicant Information

Application No	85531592	Publication date	12/18/2012
Opposition Filing Date	01/17/2013	Opposition Period Ends	01/17/2013
Applicant	West Marine Products, Inc. 500 Westridge Drive Watsonville, CA 95076 UNITED STATES		

Goods/Services Affected by Opposition

Class 014. All goods and services in the class are opposed, namely: Watches, Clocks
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Applicant Information

Application No	85531595	Publication date	12/18/2012
Opposition Filing Date	01/17/2013	Opposition Period Ends	01/17/2013
Applicant	West Marine Products, Inc. 500 Westridge Drive Watsonville, CA 95076 UNITED STATES		

Goods/Services Affected by Opposition

Class 016. All goods and services in the class are opposed, namely: Stickers, decals, books in the field of fishing and boating, maps, fishing charts
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Applicant Information

Application No	85531596	Publication date	12/18/2012
Opposition Filing Date	01/17/2013	Opposition Period Ends	01/17/2013
Applicant	West Marine Products, Inc. 500 Westridge Drive Watsonville, CA 95076 UNITED STATES		

Goods/Services Affected by Opposition

Class 018. All goods and services in the class are opposed, namely: Tote bags, duffle bags, back packs, beach bags, fanny packs, handbags, wallets, billfolds, business card cases, credit card cases, toiletry cases sold empty and garment bags for travel; leather key chains

Applicant Information

Application No	85531589	Publication date	12/18/2012
Opposition Filing Date	01/17/2013	Opposition Period Ends	01/17/2013
Applicant	West Marine Products, Inc. 500 Westridge Drive Watsonville, CA 95076 UNITED STATES		

Goods/Services Affected by Opposition

Class 011. All goods and services in the class are opposed, namely: Barbecue smokers, electric food dehydrators, deep fat fryers, headlamps for boats
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Applicant Information

Application No	85531586	Publication date	12/18/2012
Opposition Filing Date	01/17/2013	Opposition Period Ends	01/17/2013
Applicant	West Marine Products, Inc. 500 Westridge Drive Watsonville, CA 95076 UNITED STATES		

Goods/Services Affected by Opposition

Class 008. All goods and services in the class are opposed, namely: Fishing knives; hand tools, namely, wire cutters, pliers, scissors and wire crimpers; multi-function hand tools comprised of knives, can opener, pliers, file and screwdriver; hand powered vacuum bag sealers

Applicant Information

Application No	85531585	Publication date	12/18/2012
Opposition Filing Date	01/17/2013	Opposition Period Ends	01/17/2013
Applicant	West Marine Products, Inc.		

	500 Westridge Drive Watsonville, CA 95076 UNITED STATES
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Goods/Services Affected by Opposition

Class 007. All goods and services in the class are opposed, namely: Water aeration systems comprising water pumps, air compressors and air blowers; bilge pumps, trolling motor for boats; electric knives

Applicant Information

Application No	85531582	Publication date	12/18/2012
Opposition Filing Date	01/17/2013	Opposition Period Ends	01/17/2013
Applicant	West Marine Products, Inc. 500 Westridge Drive Watsonville, CA 95076 UNITED STATES		

Goods/Services Affected by Opposition

Class 005. All goods and services in the class are opposed, namely: Insect repellent

Applicant Information

Application No	85531579	Publication date	01/01/2013
Opposition Filing Date	01/17/2013	Opposition Period Ends	01/31/2013
Applicant	West Marine Products, Inc. 500 Westridge Drive Watsonville, CA 95076 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Sunscreen creams, sunscreen lotions, sunscreen sprays, lip balm
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Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3990931	Application Date	12/07/2009
Registration Date	07/05/2011	Foreign Priority Date	NONE
Word Mark	BLACK TIP		

Design Mark	BLACK TIP
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 2010/05/26 First Use In Commerce: 2010/05/26 Personal flotation devices, namely, life vests</p> <p>Class 012. First use: First Use: 2010/02/01 First Use In Commerce: 2010/02/01 Fitted seat covers for marine vehicles, namely, fitted seat covers for personal watercraft</p> <p>Class 025. First use: First Use: 2010/11/09 First Use In Commerce: 2010/11/09 Clothing, namely, T-shirts, hats, shirts, shorts, sweatshirts and jackets</p> <p>Class 027. First use: First Use: 2010/02/04 First Use In Commerce: 2010/02/04 Anti-slip floor mats for marine vehicles, namely, anti-slip floor mats for personal watercraft</p>

Related Proceedings	91205448 91205765 91207395
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Attachments	77981996#TMSN.jpeg (1 page)(bytes) BLACKTIP-Not of Opposition BLACKTIP TACKLE COMPANY.pdf (17 pages)(926021 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Zachary D. Messa/
Name	Zachary D. Messa
Date	01/17/2013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Serial Nos.: 85/531,592, 85/531,595, 85/531,596, 85/531,589, 85/531,586, 85/531,585,
85/531,582, 85/531,579

Mark: BLACKTIP TACKLE COMPANY

_____)	
WATERCRAFT SUPERSTORE, INC.)	
)	
Opposer,)	
)	
v.)	Opposition No.
)	
WEST MARINE, INC.)	
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

Watercraft Superstore, Inc. a Florida corporation, located in Clearwater, Florida (“Opposer”), opposes the registration of West Marine, Inc.’s (“Applicant”), with an address of 500 Westridge Drive, Watsonville, California 95076, applications to register the mark BLACKTIP TACKLE COMPANY with respect to Serial Nos.: 85/531,592, 85/531,595, 85/531,596, 85/531,589, 85/531,586, 85/531,585, 85/531,582, and 85/531,579 (collectively “Applied for Marks”).

ALLEGATIONS

1. Opposer is an establishment that owns and operates an extensive online store at www.watercraftsuperstore.net (the “Website”) dedicated exclusively to personal watercraft (PWC) and accessories thereof, including but not limited to engine parts, pump parts, watercraft trailer parts, life vest, wet suits, watercraft safety supplies, seat covers, anchors, and clothing. Included in Opposer’s product line are the BLACK TIP products consisting of PWC accessories.

2. Opposer is the owner of the United States Trademark Registration for BLACK TIP, Registration No. 3990931, in the following classes: IC 009 for personal flotation devices,

namely, life vests; IC 012 for fitted seat covers for marine vehicles, namely, fitted seat covers for personal watercraft; IC 025 for clothing, namely, T-shirts, hats, shirts, shorts, sweatshirts and jackets; and IC 027 for anti-slip floor mats for marine vehicles, namely, anti-slip floor mats for personal watercraft (“Registered Mark”). *See* Registration at Exhibit “1.”

3. Applicant has applied to register the term “BLACKTIP TACKLE COMPANY” Serial No. 85/531,592 for “Watches, Clocks” in International Class 014.

4. Applicant has applied to register the term “BLACKTIP TACKLE COMPANY” Serial No. 85/531,595 for “Stickers, decals, books in the field of fishing and boating, maps, fishing charts” in International Class 016.

5. Applicant has applied to register the term “BLACKTIP TACKLE COMPANY” Serial No. 85/531,596 for “tote bags, duffle bags, back packs, beach bags, fanny packs, handbags, wallets, billfolds, business card cases, credit card cases, toiletry cases sold empty and garment bags for travel; leather key chains” in International Class 018.

6. Applicant has applied to register the term “BLACKTIP TACKLE COMPANY” Serial No. 85/531,589, for “barbecue smokers, electric food dehydrators, deep fat fryers, headlamps for boats” in International Class 011.

7. Applicant has applied to register the term “BLACKTIP TACKLE COMPANY” Serial No. 85/531,586 for “fishing knives, hand tools, namely, wire cutters, pliers, scissors and wire crimpers; multi-function hand tools comprised of knives, can opener, pliers, file and screwdriver; hand powered vacuum bag sealers” in International Class 008.

8. Applicant has applied to register the term “BLACKTIP TACKLE COMPANY” Serial No. 85/531,585 for “water aeration systems comprising water pumps, air compressors and air blowers; bilge pumps, trolling motor for boats; electric knives” in International Class 007.

9. Applicant has applied to register the term “BLACKTIP TACKLE COMPANY” Serial No. 85/531,582 for “insect repellent” in International Class 005.

10. Applicant has applied to register the term “BLACKTIP TACKLE COMPANY” Serial No. 85/531,579 for “sunscreen creams, sunscreen lotions, sunscreen sprays, lip balm” in International Class 003.

11. The goods identified in the Applied for Marks are related to the goods sold and provided in connection with the Registered Mark to the extent that they are offered alongside and applicable to personal watercraft products, and are likely to be and may be offered through the same, substantially the same, or related channels of trade, to the same, substantially the same, or related classes of purchasers, namely PWC owners and enthusiasts.

12. The Registered Mark’s goods are not related to surfboards or stand-up paddle boards. The Registered Mark’s goods are not distributed in the same channels of trade as surfboards and stand-up paddle boards, and are not companion goods thereof. Applicant concedes that the Registered Mark’s goods are not related to surfboards or stand-up paddle boards as evidenced in its response to a Section 2(d) refusal of registration of its BLACKTIP mark in Class 025 and 028, wherein Applicant adopted and advocated the position that the goods in Class 025 (namely, caps, gloves, and t-shirts) and Class 28 (namely fishing tackle, fishing tackle bags, fishing rods, fishing reels, fishing rod holders, fishing rod racks, outriggers, bait tables, namely tables specifically adapted for preparing fishing bait for use in fishing; fish fillet tables, namely, tables for use in fishing that are specifically adapted for filleting fish; fish dehookers, namely, fish hook removers) were not related to surfboards, traveled in different channels of trade than surfboards and were not companion products thereby dispelling any likelihood of confusion with Surftech’s BlackTip marks for surfboards and design (Reg. Nos. 3,731,932 and, 3,731,933 subsequently assigned to West Marine Products, Inc.). *See* Exhibit “2.” In fact, Applicant adopted and advanced the position that Surftech’s BLACKTIP marks were not entitled to a wide scope of protection.

13. Applicant's use of the Applied for Marks in connection with its proposed goods is likely to cause in the minds of the public confusion, mistake or deception as to the source of origin of Applicant's goods that would lead the relevant purchasing public to believe that Applicant's services are those of the Opposer's and/or are provided by, sponsored by, approved by, licensed by, affiliated with the Opposer or are in some other way legitimately connected to Opposer and/or its services, goods, and/or licensed products. As a result, Opposer will be damaged by the registration of the Applied for Marks.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and Applicant's applications to register the Applied for Marks be denied in all respects, and other further relief be granted as may be deemed to be just and proper.

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being electronically filed with the Trademark Trial and Appeal Board on this 16th day of January, 2013, and served via U.S. Mail upon the following:

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Attorney for Applicant

/s/ Zachary D. Messa
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Counsel for Opposer

United States of America

United States Patent and Trademark Office

BLACK TIP

Reg. No. 3,990,931
Registered July 5, 2011

Int. Cls.: 9, 12, 25, and
27

TRADEMARK
PRINCIPAL REGISTER

WATERCRAFT SUPERSTORE, INC. (FLORIDA CORPORATION)
1401 NORTH MYRTLE AVENUE
CLEARWATER, FL 33755

FOR: PERSONAL FLOTATION DEVICES, NAMELY, LIFE VESTS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 5-26-2010; IN COMMERCE 5-26-2010.

FOR: FITTED SEAT COVERS FOR MARINE VEHICLES, NAMELY, FITTED SEAT COVERS FOR PERSONAL WATERCRAFT, IN CLASS 12 (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

FIRST USE 2-1-2010; IN COMMERCE 2-1-2010.

FOR: CLOTHING, NAMELY, T-SHIRTS, HATS, SHIRTS, SHORTS, SWEATSHIRTS AND JACKETS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 11-9-2010; IN COMMERCE 11-9-2010.

FOR: ANTI-SLIP FLOOR MATS FOR MARINE VEHICLES, NAMELY, ANTI-SLIP FLOOR MATS FOR PERSONAL WATERCRAFT, IN CLASS 27 (U.S. CLS. 19, 20, 37, 42 AND 50).

FIRST USE 2-4-2010; IN COMMERCE 2-4-2010.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 77-981,996, FILED 12-7-2009.

ROBERT C. CLARK JR., EXAMINING ATTORNEY



David J. Kypke

Director of the United States Patent and Trademark Office

EXHIBIT 1

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77921756
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION (no change)	
ARGUMENT(S)	
<p style="text-align: center;"><u>RESPONSE</u></p> <p>This is in response to the Office Action dated May 2, 2010. Reconsideration of this application is respectfully requested in view of the following remarks.</p> <p style="text-align: center;"><u>REMARKS</u></p> <p>In the Office Action, the Examining Attorney requested amendment to the identification of goods. Applicant hereby complies with this request, substantially in the manner suggested by the Examining Attorney. However, Applicant cannot amend "outrigger" to "outrigger paddles." Applicant respectfully submits that "outrigger" is a commonly used term to describe equipment that runs multiple poles or lines from a fishing boat. See the attached reference to "outrigger" from Wikipedia, available at http://en.wikipedia.org/wiki/outrigger. An identification may include terms of art in a particular field or industry, so long as the terms are understood by the general population. TMEP § 1402.01. Thus, Applicant respectfully submits that the current identification of goods should now be accepted based on the Trademark Office's general guidelines for acceptable identification of goods and services.</p> <p>Additionally, the Examining Attorney asked whether the term "BLACK TIP" has any meaning or significance in the industry or if such wording is a term of art in Applicant's industry. Applicant responds that the wording refers to a species of shark but has no meaning as applied to the goods or in the industry.</p>	

EXHIBIT 2

Finally, the Examining Attorney raised an initial refusal against Applicant's mark, stating that there may be a likelihood of confusion between Applicant's mark BLACKTIP and Surftech LLC's registered marks BLACKTIP and BLACKTIP (and design) (U.S. Reg. Nos. 3,731,932 and 3,731,933), as well as Watercraft Superstore, Inc.'s prior-filed pending application for BLACK TIP (U.S. App. Serial No. 77/887,629). Applicant elects not to submit arguments regarding the prior-filed pending application for BLACK TIP at this time, but reserves the right to do so if and when the cited application matures to registration and the Examining Attorney issues a 2(d) refusal based on this reference.

With respect to Surftech LLC's ("Registrant") registered marks, Applicant has carefully considered the Examining Attorney's arguments, but simply cannot agree that its mark BLACKTIP is likely to be confused with Registrant's BLACKTIP and BLACKTIP (and design) marks. Most strikingly, the significant differences in the parties' respective goods and channels of trade make it unlikely that the marks would be confused or the goods assumed to emanate from the same source.

A multi-factor test is used by the Patent and Trademark Office to assess whether there exists a likelihood of confusion between marks. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) (determining likelihood of confusion by thirteen factors: similarity of the marks, similarity and nature of the goods or services, similarity of established trade channels, whether purchases are impulse or sophisticated, fame of the prior mark, amount and nature of similar marks on similar goods, actual confusion, length of time of concurrent use without evidence of actual confusion, variety of goods on which mark is used, market interface between applicant and owner of prior mark, extent that applicant has a right to exclude others from use of its mark, extent of potential confusion, and any other probative fact). Some of the factors may not be relevant in a particular case. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 U.S.P.Q.2d 1201, 1204 (Fed. Cir. 2003). Additionally, there is no reason why a single *DuPont* factor should not outweigh all the rest. *Kellogg Co. v. Pack 'Em Enters., Inc.*, 951 F.2d 330, 333, 21 U.S.P.Q.2d 1142, 1145 (Fed. Cir. 1991). Applicant submits that the respective marks are not confusingly similar when considered in light of the following *DuPont* factors:

A. **The Goods are Different.**

Applicant's mark and Registrant's marks are unlikely to be confused based on the differences between the parties' respective goods. Even when two marks are identical, they may coexist on the Principal Register, provided that the goods or services associated with the marks are sufficiently different to obviate confusion. *See, e.g., Electronic Design & Sales, Inc. v. Electronic Data Systems*

Corp., 954 F.2d 713, 21 U.S.P.Q.2d 1388 (Fed. Cir. 1992) (reversing the Board's finding of likelihood of confusion between opposer's registered mark EDS for computer programming services and Applicant's mark E.D.S. for power supplies and battery chargers); *Triumph Machinery Company v. Kentmaster Manufacturing Company, Inc.*, 1 U.S.P.Q.2d 1826 (TTAB 1987) (finding no likelihood of confusion between HYDRO-CLIPPER for power operated cattle de-horning shears and HYDRO-CLIPPER and Design for power mower attachments). Here, there exist important differences in the parties' respective goods.

Registrant's registrations cover "surfboards." Applicant's application covers:
---water aeration systems comprising water pumps, bilge pumps in Class 7---
---fishing knives, knife sharpeners; hand tools, namely, wire cutters, pliers, scissors and wire crimper in Class 8---
---caps, gloves and t-shirts in Class 25---
---fishing tackle, fishing tackle bags, fishing rods, fishing reels, fishing rod holders, fishing rod racks, outriggers, bait tables, namely, tables specifically adapted for preparing fishing bait for use in fishing; fish fillet tables, namely, tables for use in fishing that are specifically adapted for filleting fish; fish dehookers, namely, fish hook removers in Class 28---

According to Section 1207.01(a)(vi) of the TMEP, the "Examining Attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion." Here, the Examining Attorney has not asserted that Applicant's Class 7, 8 and 28 goods are related to Registrant's surfboards, nor has the Examining Attorney provided any evidence to this effect. Thus, Applicant will limit its response to the alleged similarities between its Class 25 goods and surfboards. Applicant's caps, gloves and t-shirts in Class 25 are unrelated to Registrant's surfboards in Class 28. Applicant's caps, gloves and t-shirts are not meant to be worn while surfing. Thus, these are not companion products, used simultaneously by consumers.

As evidence of the similarity between these goods, the Examining Attorney attaches printouts of third-party registrations, specifying both apparel and surfboards. However, there is no evidence of record that suggests that any sort of majority or large number of surfboard providers offer apparel, such that consumers would automatically assume that the parties' respective goods emanate from the same source.

Most importantly, the Trademark Trial and Appeal Board has found, under certain circumstances, surfboards are unrelated to wearing apparel. See *Tommy Hilfiger Licensing, Inc. v. Smith*, Opp. No. 113,238, 2001 WL 777069, at *5 (TTAB July 11, 2001)(stating "the surfboards of applicant, on the

other hand, do not fall within any such reasonable extension of opposer's wearing apparel" and finding no likelihood of confusion between the parties' respective marks).

Moreover, the parties' respective goods are not likely to travel through the same channels of trade to the same class of purchasers. Applicant intends to provide a fishing-related line of goods under the applied for mark. Registrant, on the other hand, provides surfboards. Given the unique culture and business associated with the sport of surfing, consumers are not likely to conclude that Applicant's caps, gloves and t-shirts (which are not meant to be worn during surfing) originate from the same source as Registrant's surfboards.

In this instance, Applicant and Registrant provide different goods with distinct focuses and, therefore, there appears to be little, if any, overlap. Thus, just as in the *Tommy Hilfiger* case, the marks should be allowed to coexist.

B. The Registrant's Marks are Not Entitled to a Wide Scope of Protection

The scope of protection for Registrant's marks is narrow, as the Examining Attorney has presented no evidence that they have acquired fame or are otherwise entitled to a greater scope of protection. Thus, there is no likelihood of confusion in this case.

CONCLUSION

For all the foregoing reasons, Applicant submits that its proposed mark is distinguishable from the cited registered marks and that confusion is unlikely and, thus requests that the refusal to register based on Section 2d of the Trademark Act be withdrawn. Applicant respectfully requests that its application be suspended pending final disposition of Application Serial No. 77/887,629.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	<u>evi_20618114134-154529630 . Outrigger.pdf</u>
CONVERTED PDF FILE(S) (1 page)	<u>\\TICRS\EXPORT1\IMAGEOUT1\779\217\77921756\xml1\ROA0002.JPG</u>
DESCRIPTION OF EVIDENCE FILE	Printout from Wikipedia

GOODS AND/OR SERVICES SECTION (007)(no change)

GOODS AND/OR SERVICES SECTION (008)(current)

INTERNATIONAL CLASS	008
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DESCRIPTION	
Fishing knives, knife sharpeners, fish dehooker, hand tools, namely wire cutters, pliers, scissors and wire crimper	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (008)(proposed)	
INTERNATIONAL CLASS	008
TRACKED TEXT DESCRIPTION	
Fishing knives, knife sharpeners, fish dehooker, hand tools, namely wire cutters, pliers, scissors and wire crimper; <u>Fishing knives, knife sharpeners; hand tools, namely wire cutters, pliers, scissors and wire crimper</u>	
FINAL DESCRIPTION	
Fishing knives, knife sharpeners; hand tools, namely wire cutters, pliers, scissors and wire crimper	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (025)(no change)	
GOODS AND/OR SERVICES SECTION (028)(current)	
INTERNATIONAL CLASS	028
DESCRIPTION	
Fishing tackle, fishing tackle bags, fishing rods, fishing reels, fishing rod holders, fishing rod racks, outrigger, bait table and fish fillet table	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (028)(proposed)	
INTERNATIONAL CLASS	028
TRACKED TEXT DESCRIPTION	
Fishing tackle, fishing tackle bags, fishing rods, fishing reels, fishing rod holders, fishing rod racks, outrigger, bait table and fish fillet table; <u>fishing tackle, fishing tackle bags, fishing rods, fishing reels, fishing rod holders, fishing rod racks, outriggers, bait tables, namely, tables specifically adapted for preparing fishing bait for use in fishing; fish fillet tables, namely, tables for use in fishing that are specifically adapted for filleting fish; fish dehookers, namely, fish hook removers</u>	
FINAL DESCRIPTION	
fishing tackle, fishing tackle bags, fishing rods, fishing reels, fishing rod holders, fishing rod racks, outriggers, bait tables, namely, tables specifically adapted for preparing fishing bait for use in fishing; fish fillet tables, namely, tables for use in fishing that are specifically adapted for filleting fish; fish dehookers, namely, fish hook removers	
FILING BASIS	Section 1(b)

SIGNATURE SECTION	
RESPONSE SIGNATURE	/Nicole Ann Chaudhari/
SIGNATORY'S NAME	Nicole Ann Chaudhari
SIGNATORY'S POSITION	Attorney of record, Illinois bar member
DATE SIGNED	11/02/2010
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Nov 02 15:53:58 EDT 2010
TEAS STAMP	USPTO/ROA-206.181.141.34- 20101102155358971073-7792 1756-4704b7995804360e330a 692303ac0e01384-N/A-N/A-2 0101102154529630326

USPTO Form 1987 (Rev 9/2005)
CMB No. 0651-0050 (Exp. 04/30/2011)

**Response to Office Action
To the Commissioner for Trademarks:**

Application serial no. **77921756** has been amended as follows:

ARGUMENT(S)

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

RESPONSE

This is in response to the Office Action dated May 2, 2010. Reconsideration of this application is respectfully requested in view of the following remarks.

REMARKS

In the Office Action, the Examining Attorney requested amendment to the identification of goods. Applicant hereby complies with this request, substantially in the manner suggested by the Examining Attorney. However, Applicant cannot amend "outrigger" to "outrigger paddles." Applicant respectfully submits that "outrigger" is a commonly used term to describe equipment that runs multiple poles or lines

from a fishing boat. See the attached reference to "outrigger" from Wikipedia, available at <http://en.wikipedia.org/wiki/outrigger>. An identification may include terms of art in a particular field or industry, so long as the terms are understood by the general population. TMEP § 1402.01. Thus, Applicant respectfully submits that the current identification of goods should now be accepted based on the Trademark Office's general guidelines for acceptable identification of goods and services.

Additionally, the Examining Attorney asked whether the term "BLACK TIP" has any meaning or significance in the industry or if such wording is a term of art in Applicant's industry. Applicant responds that the wording refers to a species of shark but has no meaning as applied to the goods or in the industry.

Finally, the Examining Attorney raised an initial refusal against Applicant's mark, stating that there may be a likelihood of confusion between Applicant's mark BLACKTIP and Surftech LLC's registered marks BLACKTIP and BLACKTIP (and design) (U.S. Reg. Nos. 3,731,932 and 3,731,933), as well as Watercraft Superstore, Inc.'s prior-filed pending application for BLACK TIP (U.S. App. Serial No. 77/887,629). Applicant elects not to submit arguments regarding the prior-filed pending application for BLACK TIP at this time, but reserves the right to do so if and when the cited application matures to registration and the Examining Attorney issues a 2(d) refusal based on this reference.

With respect to Surftech LLC's ("Registrant") registered marks, Applicant has carefully considered the Examining Attorney's arguments, but simply cannot agree that its mark BLACKTIP is likely to be confused with Registrant's BLACKTIP and BLACKTIP (and design) marks. Most strikingly, the significant differences in the parties' respective goods and channels of trade make it unlikely that the marks would be confused or the goods assumed to emanate from the same source.

A multi-factor test is used by the Patent and Trademark Office to assess whether there exists a likelihood of confusion between marks. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) (determining likelihood of confusion by thirteen factors: similarity of the marks, similarity and nature of the goods or services, similarity of established trade channels, whether purchases are impulse or sophisticated, fame of the prior mark, amount and nature of similar marks on similar goods, actual confusion, length of time of concurrent use without evidence of actual confusion, variety of goods on which mark is used, market interface between applicant and owner of prior mark, extent that applicant has a right to exclude others from use of its mark, extent of potential confusion, and any other probative fact). Some of the factors may not be relevant in a particular case. *In re Majestic*

Distilling Co., 315 F.3d 1311, 1315, 65 U.S.P.Q.2d 1201, 1204 (Fed. Cir. 2003). Additionally, there is no reason why a single *DuPont* factor should not outweigh all the rest. *Kellogg Co. v. Pack 'Em Enters., Inc.*, 951 F.2d 330, 333, 21 U.S.P.Q.2d 1142, 1145 (Fed. Cir. 1991). Applicant submits that the respective marks are not confusingly similar when considered in light of the following *DuPont* factors:

A. The Goods are Different.

Applicant's mark and Registrant's marks are unlikely to be confused based on the differences between the parties' respective goods. Even when two marks are identical, they may coexist on the Principal Register, provided that the goods or services associated with the marks are sufficiently different to obviate confusion. *See, e.g., Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 U.S.P.Q.2d 1388 (Fed. Cir. 1992) (reversing the Board's finding of likelihood of confusion between opposer's registered mark EDS for computer programming services and Applicant's mark E.D.S. for power supplies and battery chargers); *Triumph Machinery Company v. Kentmaster Manufacturing Company, Inc.*, 1 U.S.P.Q.2d 1826 (TTAB 1987) (finding no likelihood of confusion between HYDRO-CLIPPER for power operated cattle de-horning shears and HYDRO-CLIPPER and Design for power mower attachments). Here, there exist important differences in the parties' respective goods.

Registrant's registrations cover "surfboards." Applicant's application covers:
---water aeration systems comprising water pumps, bilge pumps in Class 7---
---fishing knives, knife sharpeners; hand tools, namely, wire cutters, pliers, scissors and wire crimper in Class 8---
---caps, gloves and t-shirts in Class 25---
---fishing tackle, fishing tackle bags, fishing rods, fishing reels, fishing rod holders, fishing rod racks, outriggers, bait tables, namely, tables specifically adapted for preparing fishing bait for use in fishing; fish fillet tables, namely, tables for use in fishing that are specifically adapted for filleting fish; fish dehookers, namely, fish hook removers in Class 28---

According to Section 1207.01(a)(vi) of the TMEP, the "Examining Attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion." Here, the Examining Attorney has not asserted that Applicant's Class 7, 8 and 28 goods are related to Registrant's surfboards, nor has the Examining Attorney provided any evidence to this effect. Thus, Applicant will limit its response to the alleged similarities between its Class 25 goods and surfboards.

Applicant's caps, gloves and t-shirts in Class 25 are unrelated to Registrant's surfboards in Class 28. Applicant's caps, gloves and t-shirts are not meant to be worn while surfing. Thus, these are not companion products, used simultaneously by consumers.

As evidence of the similarity between these goods, the Examining Attorney attaches printouts of third-party registrations, specifying both apparel and surfboards. However, there is no evidence of record that suggests that any sort of majority or large number of surfboard providers offer apparel, such that consumers would automatically assume that the parties' respective goods emanate from the same source. Most importantly, the Trademark Trial and Appeal Board has found, under certain circumstances, surfboards are unrelated to wearing apparel. *See Tommy Hilfiger Licensing, Inc. v. Smith*, Opp. No. 113,238, 2001 WL 777069, at *5 (TTAB July 11, 2001)(stating "the surfboards of applicant, on the other hand, do not fall within any such reasonable extension of opposer's wearing apparel" and finding no likelihood of confusion between the parties' respective marks).

Moreover, the parties' respective goods are not likely to travel through the same channels of trade to the same class of purchasers. Applicant intends to provide a fishing-related line of goods under the applied for mark. Registrant, on the other hand, provides surfboards. Given the unique culture and business associated with the sport of surfing, consumers are not likely to conclude that Applicant's caps, gloves and t-shirts (which are not meant to be worn during surfing) originate from the same source as Registrant's surfboards.

In this instance, Applicant and Registrant provide different goods with distinct focuses and, therefore, there appears to be little, if any, overlap. Thus, just as in the *Tommy Hilfiger* case, the marks should be allowed to coexist.

B. The Registrant's Marks are Not Entitled to a Wide Scope of Protection

The scope of protection for Registrant's marks is narrow, as the Examining Attorney has presented no evidence that they have acquired fame or are otherwise entitled to a greater scope of protection. Thus, there is no likelihood of confusion in this case.

CONCLUSION

For all the foregoing reasons, Applicant submits that its proposed mark is distinguishable from the cited registered marks and that confusion is unlikely and, thus requests that the refusal to register based on Section 2d of the Trademark Act be withdrawn. Applicant respectfully requests that its application be suspended pending final disposition of Application Serial No. 77/887,629.

EVIDENCE

Evidence in the nature of Printout from Wikipedia has been attached.

Original PDF file:

evi_20618114134-154529630 . Outrigger.pdf

Converted PDF file(s) (1 page)

Evidence-1

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Current: Class 008 for Fishing knives, knife sharpeners, fish dehooker, hand tools, namely wire cutters, pliers, scissors and wire crimper

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:

Tracked Text Description: ~~Fishing knives, knife sharpeners, fish dehooker, hand tools, namely wire cutters, pliers, scissors and wire crimper;~~ Fishing knives, knife sharpeners; hand tools, namely wire cutters, pliers, scissors and wire crimper

Class 008 for Fishing knives, knife sharpeners; hand tools, namely wire cutters, pliers, scissors and wire crimper

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)).

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

Current: Class 028 for Fishing tackle, fishing tackle bags, fishing rods, fishing reels, fishing rod holders, fishing rod racks, outrigger, bait table and fish fillet table

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:

Tracked Text Description: ~~Fishing tackle, fishing tackle bags, fishing rods, fishing reels, fishing rod holders, fishing rod racks, outrigger, bait table and fish fillet table;~~ fishing tackle, fishing tackle bags, fishing rods, fishing reels, fishing rod holders, fishing rod racks, outriggers, bait tables, namely, tables specifically adapted for preparing fishing bait for use in fishing; fish fillet tables, namely, tables for use in fishing that are specifically adapted for filleting fish; fish dehookers, namely, fish hook removers

Class 028 for fishing tackle, fishing tackle bags, fishing rods, fishing reels, fishing rod holders, fishing rod racks, outriggers, bait tables, namely, tables specifically adapted for preparing fishing bait for use in fishing; fish fillet tables, namely, tables for use in fishing that are specifically adapted for filleting fish; fish dehookers, namely, fish hook removers

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)

Response Signature

Signature: /Nicole Ann Chaudhari/ Date: 11/02/2010
Signatory's Name: Nicole Ann Chaudhari
Signatory's Position: Attorney of record, Illinois bar member

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.

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Outrigger

From Wikipedia, the free encyclopedia

An **outrigger** is a part of a boat's rigging which is rigid and extends beyond the side or gunwale of a boat.

In an outrigger canoe and in sailboats such as the proa, an outrigger is a thin, long, solid, hull used to stabilise an inherently unstable main hull. The outrigger is positioned rigidly and parallel to the main hull so that the main hull is less likely to capsize. If only one outrigger is used on a vessel, its weight reduces the tendency to capsize in one direction and its buoyancy reduces the tendency in the other direction.



Outrigger on a contemporary Hawaiian sailing canoe

Rowing

In a rowing boat or galley, an outrigger (or just rigger) is a triangular metal frame that holds the oarlock (into which the oar is slotted) away from the gunwale to optimize leverage. Wooden outriggers appear on the new Trireme around the 7th or 6th century BC and later on Italian galleys around AD 1300 ^[*citation needed*] while Harry Clasper (1812–1870), a British professional rower, popularised the use of the modern metal version. ^[*citation needed*]

Fishing

In fishing, an outrigger is a pole or series of poles that allow boats to troll more lines in the water without tangling and simulates a school of fish.

See also

- Outrigger canoe
- Outrigger canoe racing
- Racing shell
- Sailing canoe
- Training wheels

Retrieved from "<http://en.wikipedia.org/wiki/Outrigger>"

Categories: [Ship construction](#) | [Canoes](#) | [Rowing](#) | [Structural system](#) | [Racing sports stubs](#) | [Rowing stubs](#) | [Water sports stubs](#)

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