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Filing date: **03/31/2016**

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

Proceeding	91211637
Party	Plaintiff Craig R. Bell d/b/a Destinee' - Eploriums
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Submission	Rebuttal Brief
Filer's Name	Craig R. Bell
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Signature	/Craig R. Bell/
Date	03/31/2016
Attachments	Sur-Reply Brief.pdf(1785135 bytes ) Sur_Reply Exhibit A.pdf(4221528 bytes ) Sur-Reply Exhibit B.pdf(1714820 bytes ) Sur-Reply Exhibit C.pdf(1684818 bytes ) Sur-Reply Exhibit D (6).pdf(2057916 bytes )



1        2. Furthermore, the examining attorney must view and  
2 compare the goods or services to determine if they are related  
3 or if the activities surrounding their marketing are such that  
4 confusion as to source and origin is likely; instances of actual  
5 confusion is not the litmus test. In re August Storck KG, 218  
6 USPQ 823 (TTAB 1983); In re International Telephone and  
7 Telegraph Corp., 197 USPQ 910 (TTAB 1978); Guardian Products  
8 Co., v Scott Paper Co., 200 USPQ 738 (TTAB 1978).

### 9        **The Rebuttal**

10       3. In refuting Applicants contentions that not only are the  
11 various uses of the Opposers RIDE HARD marks not identical to  
12 Applicants WORK HARD RIDE HARDER mark, but further, that there  
13 are significant, material and distinctive differences between  
14 them both in additional and different wording in Applicants  
15 mark, in addition to the distinctive design element that is a  
16 part thereof. Opposer will provide administrative authority  
17 from the USPTO in the form of several office actions of  
18 examining attorneys that are analogous to the matter at hand.

19       4. The first of these office actions is for an Applicant's  
20 mark for (**ALASKAN PERIMETER EXPEDITIONS. HUNT SMART. HUNT HARD**).  
21 and design. And Registrant's marks of **HUNT HARD** and **HUNT HARD**  
22 **OUTFITTERS** in standard character form. A printout of this office  
23 action downloaded from the United States Patent and Trademark  
24 Office TSDR system is attached hereto as Exhibit A.

25       5. Here, in the aforementioned Exhibit, the registrant made  
26 use of similar terms as Opposer in HUNT HARD and HUNT HARD  
27 OUTFITTERS, juxtapose to RIDE HARD, RIDE HARD *America*, RIDE 1  
28 HARD and RIDE HARD, TRANSCENDING THE COMPETITIVE MIND-SET marks.

1        6. Of significant importance, in the examining attorney's  
2 office action thereof, she made mention of the probability that  
3 consumers were likely to perceive "HUNT HARD" as a unique  
4 catchphrase indicating a common source for applicant's and  
5 registrant's services. It is here where the issues relevant to  
6 Exhibit A and those of this Opposition matter here at hand are  
7 most analogous.

8        7. The marks of the registrant in Exhibit A herein and  
9 Opposer are those unique catchphrases, unitary terms worthy of  
10 such characterization; while Applicants use of WORK HARD garners  
11 no such distinction. This can be deduced from a basic search of  
12 the USPTO records of each term, where RIDE HARD and HUNT HARD  
13 register use is initially and only by Opposer and registrant in  
14 Exhibit A, where as the Applicants use of WORK HARD is muddled  
15 by hundreds of uses and it has never been used in such a manner  
16 in which to garner such distinction.

17        8. With respect to 2(d) refusals of applications regarding  
18 root words and either the addition or deletion of suffixes,  
19 Opposer submit two such matters that will complete the analogy  
20 of the matter at hand. The first of these office actions are  
21 for an applicant who attempted registration of the term HUNT  
22 HARDER, which was refused registration because of the registered  
23 term HUNT HARD. A printout of this office action downloaded  
24 from the USPTO TSDR system is attached hereto as Exhibit B.

25        9. The examining attorney here wrote that **"the marks are**  
26 **similar because they are identical but for the addition of the**  
27 **suffix "-ER" at the end of the applicant's mark. The mere**  
28 **addition of a term to a registered mark generally does not**



1 *obviate the similarity between the marks nor does it overcome a*  
2 *likelihood of confusion under Trademark Act Section 2(d)".*

3 10. This generality that the examining attorney most likely  
4 is referring to is the fact that in most instances the addition  
5 of the "ER" suffix generally makes the word either a comparative  
6 or superlative. The mere adding of the "ER" suffix to the word  
7 does not change the commercial impression of the word or term;  
8 making it comparative to Harder or RIDE HARDER. And if "EST" is  
9 added making it would be a superlative. In any event, the  
10 commercial impression of the term remains the same.

11 11. To bring this point home, there are a few words that  
12 by adding "ER" to the end of them changes the commercial meaning  
13 and impression. POST to POSTER, SHOW to SHOWER, CORN to CORNER  
14 and MAST to MASTER. Adding the "ER" to the end of each of these  
15 words changes the meaning and commercial impression, while when  
16 added to the end of the word hard does not.

17 12. The last examples regarding this subject matter  
18 encompasses the registered trademarks "WORK HARD PLAY HARDER"  
19 and "PLAY LONG PLAY HARD". The applicants' attempted removal of  
20 subject matter in attempts at registering the marks "WORK HARD  
21 PLAY HARD" and "PLAY HARD" were refused registration. Here, the  
22 applicants' attempts at removing either the suffix from the mark  
23 or other wording was deemed just as insufficient as the addition  
24 thereof; particularly when the parties marks shared a phrase  
25 that was deemed to be a distinct and unique catchphrase capable  
26 of indicating a common source of goods for either. A printout of  
27 these office actions from the United States Patent and Trademark  
28 Office TSDR system is attached hereto as Exhibit's C & D.

## CONCLUSION

13. As stated by the examining attorney in Exhibit A, "the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. In re West PointPepperell, Inc., 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. See Recot, Inc. v. M.C. Becton, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); Visual Info. Inst., Inc. v. Vicon Indus. Inc., 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. Chemetron Corp. v. Morris Coupling & Clamp Co., 203 USPQ 537, 540-41 (TTAB 1979); Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

If the goods and/or services of the respective parties are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods and/or services. In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987); see Shen Mfg. Co. v. Ritz Hotel Ltd., 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b)."

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14. Therefore, here in this instant matter, Opposer respectfully submits that the same refusal should apply here as Applicant WORK HARD RIDE HARDER mark is merely the addition of the "ER" suffix to the end of the Opposers RIDE HARD mark, in addition to the term WORK HARD and design.

15. Accordingly, because of the similarity of Opposers marks and that of Applicants instant application to register its WORK HARD RIDE HARDER mark, and because of the relatedness of the lines of goods described thherein, Opposer believes that he will be damaged by said registration and prays that registration of Application Serial No. 85/726,991 to Applicant be denied.

Respectfully submitted,

Dated this 31<sup>st</sup> day of March 2016

By: s/Craig R. Bell  
Craig R. Bell  
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(619) 270-9649  
Unrepresented

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**PROOF OF SERVICE**

**CERTIFICATE OF FILING**

I hereby certify that this NOTICE OF OPPOSITION to U.S. Trademark Application Serial No. 85/726,991 for the trademark WORK HARD RIDE HARDER is being filed with the Trademark Trial and Appeal Board using ESTTA filing system of the U.S. Patent and Trademark Office on the below date.

Date: March 31, 2016

s/Craig R. Bell/

**CERTIFICATE OF SERVICE**

I hereby certify that this SUR-REPLY TO APPLICANTS REPLY BRIEF to Opposition No. 91211637 of the trademark WORK HARD RIDE HARDER is being duly served upon the Applicant by mailing copies thereof via email to [jesse@lambert.net](mailto:jesse@lambert.net) and U.S. postal Service in a sealed envelope as first-class mail with postage thereupon fully prepaid and addressed to the following address:

JESSE D. LAMBERT  
LAW OFFICE OF JESSE D. LAMBERT, LLC  
1018 HARDING ST, STE 102B  
LAFAYETTE, LOUISIANA 70503-2403

Date: March 31, 2016

s/Craig R. Bell/

# EXHIBIT A

**To:** Tiffany IV, Henry Dyer ([henrydtiffanyiv@yahoo.com](mailto:henrydtiffanyiv@yahoo.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 77968588 - EXPEDITIONS  
ALASKAN PERIMETER HUNT - N/A  
**Sent:** 7/1/2010 9:49:48 PM  
**Sent As:** ECOM107@USPTO.GOV  
**Attachments:** [Attachment - 1](#)  
[Attachment - 2](#)  
[Attachment - 3](#)  
[Attachment - 4](#)  
[Attachment - 5](#)  
[Attachment - 6](#)  
[Attachment - 7](#)  
[Attachment - 8](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**APPLICATION SERIAL NO.** 77968588

**MARK:** EXPEDITIONS ALASKAN PERIMETER  
HUNT

**\*77968588\***

**CORRESPONDENT ADDRESS:**

TIFFANY IV, HENRY DYER  
TIFFANY IV, HENRY DYER  
PO BOX 329  
ESTER, AK 99725-0329

**CLICK HERE TO RESPOND TO THIS LETTER:**

<http://www.uspto.gov/teas/eTEASpageD.htm>

**APPLICANT:** Tiffany IV, Henry Dyer

**CORRESPONDENT'S REFERENCE/DOCKET  
NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

[henrydtiffanyiv@yahoo.com](mailto:henrydtiffanyiv@yahoo.com)

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST  
RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE  
ISSUE/MAILING DATE BELOW.



**ISSUE/MAILING DATE: 7/1/2010**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62, 2.65(a); TMEP §§711, 718.03.

### **SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION**

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 3633938 and 3633940. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

#### Comparison of Marks

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

Applicant's mark is ALASKAN PERIMETER EXPEDITIONS. HUNT SMART. HUNT HARD. and design. Registrant's marks are HUNT HARD and HUNT HARD OUTFITTERS in standard character form.

Applicant's and registrant's marks share the phrase "HUNT HARD."

Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558

(TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii).

It seems probable consumers are likely to perceive “HUNT HARD” as a unique catchphrase indicating a common source for applicant’s and registrant’s services.

The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

If the goods and/or services of the respective parties are “similar in kind and/or closely related,” the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

#### Comparison of Services

Applicant’s services are hunting guide services; providing information in the field of hunting and fishing via the Internet. Registrant’s services are hunting guide services (registrant also uses the mark on hunting bags).

Applicant’s and registrant’s hunting guide services directly overlap. Applicant’s information services in the field of hunting and fishing are closely related to hunting guide services, as shown by applicant’s own multi-class application.

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Although applicant’s mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

#### **REQUIREMENTS**

Applicant must respond to the requirement(s) set forth below.



#### A. Disclaimer

Applicant must disclaim the geographically descriptive and descriptive wording “ALASKAN” and “EXPEDITIONS” apart from the mark as shown because “ALASKAN” is primarily geographically descriptive of the place of rendering of applicant’s services (see attached excerpt from applicant’s website [alaskanperimeter.com](http://alaskanperimeter.com); Google search; July 1, 2010) and “EXPEDITIONS” describes the venue of applicant’s services (the website indicates that the hunting guide services are provided in the form of expeditions). See 15 U.S.C. §1056(a); TMEP §§1210.06(a), 1213.03(a).

#### B. Description of the Mark

The description of the mark is accurate but incomplete because it does not describe all the significant aspects of the applied-for mark. Applications for marks not in standard characters must include an accurate and concise description of the entire mark that identifies literal elements as well as any design elements. See 37 C.F.R. §2.37; TMEP §§808 *et seq.*

Therefore, applicant must provide a more complete description of the applied-for mark. The following is suggested:

The mark consists of an elongated rectangle with points on either end and a half circle attached above this elongated rectangle, all outlined in forest green. A stylized mountain and valley scene appear in the half circle in light gray, darker gray, white and outlined in black with a red sunset behind the mountain peak. The stylized wording “HUNT SMART. HUNT HARD.” appears in red below the design. Within the elongated rectangle the stylized wording “ALASKAN PERIMETER EXPEDITIONS” appear in darker gray, and beneath them appears the stylized word “EXPEDITIONS” in a lighter gray against a gray background.

#### C. Information

Applicant must submit the following information to permit proper examination of the application. See 37 C.F.R. §2.61(b); TMEP §§814, 1402.01(e). Does the phrase “Alaskan perimeter” describe a particular region of Alaska, and if so, what is the relationship of that region to applicant’s services?

#### D. Specimens

Applicant has provided three different specimens. Two of these specimens are unacceptable because the mark does not match the mark in the drawing. The third specimen is unacceptable because the mark cannot be clearly viewed.

The specimen consisting of a screen shot of applicant’s webpage is unacceptable because it shows the mark in a different form than on the drawing. The website mark uses a different color scheme, and the letters do not appear in the linked, somewhat three dimensional form they do in the drawing. The specimen showing the mark on the caps is unacceptable because the mark is too small (even when the image is enlarged) for the examining attorney to make out the necessary details. The specimen consisting of the letterhead is unacceptable because it shows the mark with different typeface and different use of color.

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each class of goods and/or services. Trademark Act Sections 1 and 45, 15

U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a). The mark on the drawing must be a substantially exact representation of the mark on the specimen. 37 C.F.R. §2.51(a); TMEP §807.12(a); *see* 37 C.F.R. §2.72(a)(1). In addition, the drawing of the mark can be amended only if the amendment does not materially alter the mark as originally filed. 37 C.F.R. §2.72(a)(2); *see* TMEP §§807.12(a), 807.14 *et seq.*

Therefore, applicant must submit one of the following:

- (1) A new drawing of the mark that agrees with the mark on the specimen but does not materially alter the original mark. *See* 37 C.F.R. §2.72(a)(2); TMEP §§807.12(a), 807.14 *et seq.* Amending the drawing to agree with the specimen would not be considered a material alteration of the mark in this case.; or
- (2) A substitute specimen showing use in commerce of the mark on the drawing, and the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **“The substitute specimen was in use in commerce at least as early as the filing date of the application.”** *See* 37 C.F.R. §§2.59(a), 2.193(e)(1); TMEP §§807.12(a), 904.05. If submitting a specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c); TMEP §904.05.

Please note that if applicant chooses to submit a substitute drawing, applicant may drop the claim to color and show the drawing in black and white. If applicant chooses to take such action, the reference to color in the description of the mark should be deleted, and the color claim withdrawn.

If applicant cannot satisfy one of the above requirements, applicant may amend the application from a use in commerce basis under Trademark Act Section 1(a) to an intent to use basis under Section 1(b), for which no specimen is required. *See* TMEP §806.03(c). However, if applicant amends the basis to Section 1(b), registration will not be granted until applicant later amends the application back to use in commerce by filing an acceptable allegation of use with a proper specimen. *See* 15 U.S.C. §1051(c)-(d); 37 C.F.R. §§2.76, 2.88; TMEP §1103.

To amend to Section 1(b), applicant must submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **“Applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods and/or services listed in the application as of the filing date of the application.”** 37 C.F.R. §2.34(a)(2); TMEP §806.01(b); *see* 15 U.S.C. §1051(b); 37 C.F.R. §§2.35(b)(1), 2.193(e)(1).

Pending receipt of a proper response, registration is refused because the specimen does not show the applied-for mark in use in commerce as a trademark and/or service mark. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

## RESPONSE

For this application to proceed toward registration, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options for responding to a refusal and should consider such options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements and request that the Office enter them into the application record.



Applicant's response must be properly signed by (1) the individual applicant (for joint individual applicants, both must sign) or (2) someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). *See* 37 C.F.R. §§2.62(b), 2.193(a), (e)(2)(ii); TMEP §§611.03(b), 611.06 *et seq.*, 712.01. If applicant retains an attorney, the attorney must sign the response. 37 C.F.R. §2.193(e)(2)(i); TMEP §§611.03(b), 712.01. The individual(s) signing must personally sign or personally enter his/her electronic signature. *See* 37 C.F.R. §2.193(a), (e)(2)(ii); TMEP §§611.01(b), 611.02.

If applicant does not respond to this Office action within six months of the issue/ mailing date, or responds by expressly abandoning the application, the application process will end, the trademark will fail to register, and the application fee will not be refunded. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a), 2.209(a); TMEP §§405.04, 718.01, 718.02. In such case, applicant's only option would be to file a timely petition to revive the application, which, if granted, would allow the application to return to live status. *See* 37 C.F.R. §2.66; TMEP §1714. There is a \$100 fee for such petitions. *See* 37 C.F.R. §§2.6, 2.66(b)(1).

**TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE:** Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

## **ASSISTANCE**

If applicant has questions about the application or this Office action, please telephone the assigned trademark examining attorney at the telephone number below.

/Jeri Fickes/  
USPTO  
Trademark Examining Attorney  
Law Office 107  
571/272-9157  
Email: [jeri.fickes@uspto.gov](mailto:jeri.fickes@uspto.gov)

**TO RESPOND TO THIS LETTER:** Use the Trademark Electronic Application System (TEAS) response form at <http://teasroa.uspto.gov/roa/>. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov).

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant

or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

Print: Jul 1, 2010

77455276

**DESIGN MARK**

**Serial Number**

77455276

**Status**

REGISTERED

**Word Mark**

HUNT HARD

**Standard Character Mark**

Yes

**Registration Number**

3633938

**Date Registered**

2009/06/09

**Type of Mark**

TRADEMARK; SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

Lester, Jeffrey T. INDIVIDUAL UNITED STATES 70 S. Aspen Eagar ARIZONA 85925

**Goods/Services**

Class Status -- ACTIVE. IC 018. US 001 002 003 022 041. G & S: Hunting bags. First Use: 2008/02/05. First Use In Commerce: 2008/02/05.

**Goods/Services**

Class Status -- ACTIVE. IC 041. US 100 101 107. G & S: Hunting guide services. First Use: 2002/12/31. First Use In Commerce: 2002/12/31.

**Disclaimer Statement**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HUNT" APART FROM THE MARK AS SHOWN.

**Filing Date**

2008/04/22

**Examining Attorney**

**Print: Jul 1, 2010**

**77455276**

HAYES, GINA

**Attorney of Record**

Michael M. Ballard

HUNT HARD

**DESIGN MARK**

**Serial Number**

77455283

**Status**

REGISTERED

**Word Mark**

HUNT HARD OUTFITTERS

**Standard Character Mark**

Yes

**Registration Number**

3633940

**Date Registered**

2009/06/09

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

Lester, Jeffrey T. INDIVIDUAL UNITED STATES 70 S. Aspen Eagar ARIZONA 85925

**Goods/Services**

Class Status -- ACTIVE. IC 041. US 100 101 107. G & S: Hunting guide services. First Use: 2002/12/31. First Use In Commerce: 2002/12/31.

**Disclaimer Statement**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HUNT" AND "OUTFITTERS" APART FROM THE MARK AS SHOWN.

**Filing Date**

2008/04/22

**Examining Attorney**

HAYES, GINA

**Attorney of Record**

Michael M. Ballard



# HUNT HARD OUTFITTERS



## WELCOME

*All hunts come with a free copy of  
video from your hunt*

**IF YOU'VE DREAMED** of big game hunting in Alaska and are interested in a superior, top quality, exciting and successful hunting experience, join Alaskan Perimeter Expeditions, and Master Guide Henry D. Tiffany IV, on your next big game adventure.

You'll enjoy some of the most dynamic and beautiful wilderness in the world in, among other areas we guide in, my two exclusive-use guide areas within National Wildlife Refuges and receive the finest guiding expertise, personal service and attention to detail found anywhere.



Unlike any other guiding operation in Alaska, your hunting expedition will be filmed, quite possibly even the kill, at no extra charge! The video camera is carried by either your guide or a packer in the Palmcorder Pouch™ every day to capture all the special moments you will experience. At the end of the season, you will receive a free, edited, VHS, DVD, Hi8 or PAL (your choice) video copy of your hunt. Not only will my guides and I help you harvest the trophy animal(s) of your dreams but we will capture the experience on film for you so that you may relive it for years to come.





I'm a guide because I love hunting, Alaska , the outdoors and because I enjoy sharing these things with other hunters, like you, who appreciate what they have to offer. My goal, aside from helping you harvest a magnificent trophy animal, is to share with you this incredible state and all that it has to offer. When you leave one of my camps as a friend, I want you to take home fond lifetime memories of your Alaskan experience. The quality of your trophy and your whole experience is my primary concern. This is your adventure and I want to help fulfill all of your expectations.



I offer traditional, authentic and comfortable wilderness experiences. You'll stay in wall-type tents at the base camps and geodesic, backpacking tents in spike camps; along with all the wilderness comforts that don't require electricity. When in any of my base camps, you will be served hearty full- course meals such as eggs, bacon, pancakes, omelets, fresh fruits, smoked salmon,



Many claim to be the finest guides but with almost 20 years of guiding experience, and a lifetime growing up and hunting here in Alaska , after a hunt with us you will realize that we are some of the finest guides in Alaska and our reputation will attest to that. I encourage you to contact my references. Then compare my commitment to you and your safety, your success and my attention to detail to that of others. Through talking with these fellow hunters, you will learn the many positive differences between Alaskan Perimeter Expeditions and the other guiding operations. My company is not the largest guiding operation in Alaska because I'm not willing to compromise quality for quantity. As a result, mine is one of the best, offering the finest hunting expeditions in some of the very best areas in the State of Alaska !



as eggs, bacon, pancakes, omelets, fresh fruits, smoked salmon, steak, chicken, wild game meat, pastas, fresh salads and breads. If you travel to any of our spike camps, I will provide you with an array of delicious lightweight meals and other fine high-energy foods. I'm also very conscious of some individual's specific dietary needs and will adjust the menus to suit those needs when possible. As a result of my attention to detail, you'll have a unique Alaskan hunting adventure in which you'll be comfortable, dry and well fed with delicious and nutritious food.



---

**HUNT SMART. HUNT HARD.**

**Alaskan Perimeter Expeditions**

P.O. Box 329

Ester, AK. 99725

PHONE 907-223-3226 or 907-456-4868

FAX 907-479-8240

[Henry@AlaskanPerimeterExpeditions.com](mailto:Henry@AlaskanPerimeterExpeditions.com)

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**To:** Tiffany IV, Henry Dyer ([henrydtiffanyiv@yahoo.com](mailto:henrydtiffanyiv@yahoo.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 77968588 - EXPEDITIONS  
ALASKAN PERIMETER HUNT - N/A  
**Sent:** 7/1/2010 9:49:51 PM  
**Sent As:** ECOM107@USPTO.GOV  
**Attachments:**

## **IMPORTANT NOTICE REGARDING YOUR TRADEMARK APPLICATION**

Your trademark application (Serial No. 77968588) has been reviewed. The examining attorney assigned by the United States Patent and Trademark Office (“USPTO”) has written a letter (an “Office action”) on **7/1/2010** to which you must respond (*unless the Office letter specifically states that no response is required*). Please follow these steps:

1. **Read** the Office letter by clicking on this [link](http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77968588&doc_type=OOA&)  
<http://tmportal.uspto.gov/external/portal/tow> and enter your serial number to access the Office letter. If you have difficulty accessing the Office letter, contact [TDR@uspto.gov](mailto:TDR@uspto.gov).

**PLEASE NOTE:** The Office letter may not be immediately available but will be viewable within 24 hours of this e-mail notification.

2. **Contact** the examining attorney who reviewed your application if you have any questions about the content of the Office letter (contact information appears at the end thereof).

3. **Respond** within 6 months, calculated from **7/1/2010** (*or sooner if specified in the Office letter*), using the Trademark Electronic Application System (TEAS) [Response to Office Action form](#). If you have difficulty using TEAS, contact [TEAS@uspto.gov](mailto:TEAS@uspto.gov).

### **ALERT:**

Failure to file any required response by the applicable deadline will result in the [ABANDONMENT](#) (loss) of your application.

**Do NOT hit “Reply” to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses.**

# EXHIBIT B

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 85768885

**MARK:** HUNT HARDER

**\*85768885\***

**CORRESPONDENT ADDRESS:**

JOHN W. PROVO  
MASLON EDELMAN BORMAN & BRAND, LLP  
90 S 7TH ST STE 3300  
MINNEAPOLIS, MN 55402-4104

**CLICK HERE TO RESPOND TO**  
<http://www.uspto.gov/trademarks/teas/r>

**APPLICANT:** Hustle Harder, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET NO :**  
2011-1015

**CORRESPONDENT E-MAIL ADDRESS:**

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE:**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

**Trademark Act Section 2(d) Refusal to Register**

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 2847551. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

A likelihood of confusion determination requires a two-part analysis. First the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*



## A. The Marks

The applicant seeks to register “HUNT HARDER,” and the registered mark is “HUNT HARD.” The marks are similar because they are identical but for the addition of the suffix “-ER” at the end of the applicant’s mark. The mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR’S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY’S ACCU TUNE); TMEP §1207.01(b)(iii). Therefore, the addition of “-ER” does not obviate the similarity of the marks.

## B. The Goods/Services

The goods of the parties are clothing.

Decisions regarding likelihood of confusion in the clothing field have found many different types of apparel to be related goods. *Cambridge Rubber Co. v. Cluett, Peabody & Co.*, 286 F.2d 623, 624, 128 USPQ 549, 550 (C.C.P.A. 1961) (women’s boots related to men’s and boys’ underwear); *Jockey Int’l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1236 (TTAB 1992) (underwear related to neckties); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (women’s pants, blouses, shorts and jackets related to women’s shoes); *In re Pix of Am., Inc.*, 225 USPQ 691, 691-92 (TTAB 1985) (women’s shoes related to outer shirts); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 398-99 (TTAB 1982) (hosiery related to trousers); *In re Cook United, Inc.*, 185 USPQ 444, 445 (TTAB 1975) (men’s suits, coats, and trousers related to ladies’ pantyhose and hosiery); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400, 404 (TTAB 1964) (brassieres and girdles related to slacks for men and young men).

Neither the application nor the registration(s) contains any limitations regarding trade channels for the goods and therefore it is assumed that registrant’s and applicant’s goods are sold everywhere that is normal for such items, i.e., clothing and department stores. Thus, it can also be assumed that the same classes of purchasers shop for these items and that consumers are accustomed to seeing them sold under the same or similar marks. See *Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); TMEP §1207.01(a)(iii).

Based on the similarity of the marks and relatedness of the goods/services, consumers are likely to be confused by the marks into believing that the goods/services of the parties share a common source or sponsorship.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

### **Pending Conflicting Application**

The filing date of pending U.S. Application Serial No. 85694267 precedes applicant’s filing date. See attached referenced application. If the mark in the referenced application registers, applicant’s mark may



be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

/Vivian Micznik First/  
Vivian Micznik First  
Examining Attorney  
Law Office 114  
571-272-9159  
vivian.first@uspto.gov

**TO RESPOND TO THIS LETTER:** Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp). Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

**TYPED DRAWING**

**Serial Number**

78263615

**Status**

SECTION 8 & 15-ACCEPTED AND ACKNOWLEDGED

**Word Mark**

HUNT HARD

**Standard Character Mark**

No

**Registration Number**

2847551

**Date Registered**

2004/06/01

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(1) TYPED DRAWING

**Owner**

Lester, Jeffrey, T. INDIVIDUAL UNITED STATES PO Box 913 Eagar ARIZONA  
85925

**Goods/Services**

Class Status -- ACTIVE. IC 025. US 022 039. G & S: Men's, women's  
and children's clothing, namely, shirts, [ shorts, pants,] jackets,  
[sweatpants], sweatshirts, [underwear], socks [and hats]. First Use:  
2002/05/25. First Use In Commerce: 2002/05/25.

**Filing Date**

2003/06/17

**Examining Attorney**

MULLEN, MARK T.

**Attorney of Record**

Michael M. Ballard

**DESIGN MARK**

**Serial Number**

85694267

**Status**

PUBLISHED FOR OPPOSITION

**Word Mark**

HARDER

**Standard Character Mark**

No

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

**Owner**

Russell, Marco A. INDIVIDUAL BAHAMAS 5880 Boulder Falls Bldg 20 Apt  
2144 Henderson NEVADA 89011

**Goods/Services**

Class Status -- ACTIVE. IC 025. US 022 039. G & S: Athletic  
apparel, namely, shirts, pants, jackets, footwear, hats and caps,  
athletic uniforms.

**Colors Claimed**

Color is not claimed as a feature of the mark.

**Filing Date**

2012/08/02

**Examining Attorney**

ROSENBERG, MIAH

HARDER

# EXHIBIT C



**To:** BoDog Entertainment Group S.A. ([BillF.docketing@SeedIP.com](mailto:BillF.docketing@SeedIP.com))  
**Subject:** TRADEMARK APPLICATION NO. 78827809 - PLAY HARD - N/A  
**Sent:** 2/20/2007 8:30:58 AM  
**Sent As:** ECOM104@USPTO.GOV  
**Attachments:** [Attachment - 1](#)  
[Attachment - 2](#)  
[Attachment - 3](#)

## UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 78/827809

**APPLICANT:** BoDog Entertainment Group S.A.

**CORRESPONDENT ADDRESS:**

William O. Ferron, Jr.  
Seed IP Law Group PLLC  
Suite 5300  
701 Fifth Avenue  
Seattle WA 98104

**\*78827809\***

**RETURN ADDRESS:**

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

**MARK:** PLAY HARD

**CORRESPONDENT'S REFERENCE/DOCKET NO :** N/A

**CORRESPONDENT EMAIL ADDRESS:**

[BillF.docketing@SeedIP.com](mailto:BillF.docketing@SeedIP.com)

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

## OFFICE ACTION

**RESPONSE TIME LIMIT:** TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

**MAILING/E-MAILING DATE INFORMATION:** If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 78/827809

This action is in response to applicant's letter, dated January 4<sup>th</sup>, 2007, in which applicant 1) added classes and 2) amended the identification of goods. As discussed below, the identification of goods is still unacceptable. Furthermore, a likelihood of confusion refusal and a potential likelihood of confusion cite are now made.

The following requirement has been satisfied and is now withdrawn: (1) additional fees. TMEP §714.04.

## **LIKELIHOOD OF CONFUSION – CLASS 25 REFUSAL ONLY**

With respect to International Class 25 only, registration of the proposed mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 2933801. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.* See the enclosed registration.

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods and services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

### **A) COMPARISON OF THE MARKS**

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

Applicant's mark is "PLAY HARD." Cited registrant's mark is "PLAY LONG, PLAY HARD." The marks are similar because they both contain the term "PLAY HARD."

Although applicant's mark does not contain the phrase "PLAY LONG," the mere deletion of wording from a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). *See In re Optical Int'l*, 196 USPQ 775 (TTAB 1977) (where applicant filed to register the mark OPTIQUE for optical wear, deletion of the term BOUTIQUE is insufficient to distinguish the mark, *per se*, from the registered mark OPTIQUE BOUTIQUE when used in connection with competing optical wear). In the present case, applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, and there is no other wording to distinguish it from registrant's mark. Additionally, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956). TMEP §1207.01(b).

### **B) COMPARISON OF THE GOODS AND SERVICES**

The goods and services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

Applicant's refused goods are "clothing." Cited registrant's goods are "articles of clothing, namely, jackets, coats, vests, blazers, jerseys, anoraks, pull-overs, track suits, pants, trousers, slacks, sweaters, sweat shirts, sweat pants, t-shirts, tank tops, shorts, jeans, suits, turtle necks, underwear, briefs, boxer briefs, and boxer shorts; wearing accessories, namely, kerchiefs and belts; headwear, namely, hats, caps, sweat bands, sun-visors, berets, bandannas, hoods, and head bands," and its services are "retail store services and wholesale distributorships featuring, apparel, apparel accessories, leather and imitation leather goods; on-line retail services, namely featuring, apparel, apparel accessories, leather and imitation leather goods." The goods and services are related because they all deal with clothing.

Because the marks are similar and the goods and services are closely related, a likelihood of confusion exists to prevent registration of applicant's mark with respect to International Class 25 under Section 2(d) of the Trademark Act.

#### **POTENTIAL LIKELIHOOD OF CONFUSION – CLASSES 25 and 41**

Information regarding pending Application Serial No. 78150855 is enclosed. The filing date of the referenced application precedes applicant's filing date. There may be a likelihood of confusion between the two marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d). If the referenced application registers, registration may be refused in this case under Section 2(d). 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon entry of a response to this Office action, action on this case may be suspended pending final disposition of the earlier-filed application.

If applicant believes there is no potential conflict between this application and the earlier-filed application, then applicant may present arguments relevant to the issue in a response to this Office action. The election not to submit arguments at this time in no way limits applicant's right to address this issue at a later point.

#### **RESPONDING TO A PARTIAL REFUSAL**

Applicant may respond to the stated refusal by doing one of the following:

- (1) deleting the class to which the refusal pertains;
- (2) arguing against the refusal of the combined application as a whole; or
- (3) filing a request to divide out the goods and services that have not been refused registration, so that the mark may be published for opposition in the classes to which the refusal does not pertain (See 37 C.F.R. §2.87 and TMEP §§1 110.05 and 1403.03 regarding the requirements for filing a request to divide).

Applicant must also respond to the following requirement:

## IDENTIFICATION/CLASSIFICATION OF GOODS AND SERVICES

The identification consists of the class heading for International Class 25. The purpose of class headings is to indicate the subject matter and general scope of the class, but headings are considered too broad for identifying goods or services in U.S. applications. TMEP §§1401.08, 1402.01 *et seq.* Therefore, applicant must amend the clothing goods to specify the common commercial or generic name for each item of clothing.

Additionally, the wording “gaming equipment, namely poker chips and playing cards” is unacceptable because it does not fit within the scope of “promotional items” as currently worded. While the identification of goods and services may be amended to clarify or limit the goods and services, additions to the identification or a broadening of the scope of the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §§1402.06 *et seq.* and 1402.07. Therefore, this wording should be deleted from the identification, or limited to fit within the scope of the original application.

Also, the proposed amendment to the identification cannot be accepted because the wording “retail store services and distributorship services in the field of... videos, films, movies, and related merchandise,” and “providing... videos, films, movies, and related merchandise” refers to services that are not within the scope of the identification that was set forth in the application at the time of filing. Applicant’s original application limited the “purchase, sale, distribution” services to “music.” The videos, films, and movies were only listed under “promotion” services. Therefore, this wording should be deleted from the identification. 37 C.F.R. §2.71(a); TMEP §§1402.06 *et seq.* and 1402.07.

Furthermore, the wording “providing... promotional items,” which occurs repeatedly in the amended identification of goods and services is not an entertainment service in International Class 41. Rather, it is a business advertising service in International Class 35. Also, such a service is not a service in commerce unless the services are provided for others. Promoting one’s own goods and services is *not* considered a service in commerce. Rather, such promotion is incidental to applicant’s larger business.

Similarly, if the purpose of applicant’s “contests and sweepstakes” is to promote the sale of its *own* goods and not the goods of others, the activities are not a service in commerce if the contests and sweepstakes are not separately offered, promoted, and charged-for. While it is true that benefits accrue to the winners of the contest, this is true generally of all promotional devices, and this fact alone does not transform the activity into a registrable service. *In re Dr. Pepper Co.*, 836 F.2d 508, 5 USPQ2d 1207 (Fed. Cir. 1987); *In re Loew’s Theatres, Inc.*, 179 USPQ 126 (TTAB 1973); *In re Johnson Publishing Co., Inc.*, 130 USPQ 185 (TTAB 1961); TMEP §1301.01(b)(i).

The following three criteria have evolved for determining what constitutes a “service”:

- (1) A service is a real activity, not an idea, concept, process or system. TMEP §1301.01(a)(i);
- (2) A service is performed to the order of, or for the benefit of, someone *other* than applicant. *See In re Canadian Pac. Ltd.*, 754 F.2d 992, 994-5, 224 USPQ 971 (Fed. Cir. 1985); *In re Integrated Res., Inc.*, 218 USPQ 829 (TTAB 1983); TMEP §1301.01(a)(ii);
- (3) A service is an activity that is sufficiently separate or qualitatively different from an applicant’s principal activity, i.e., it cannot be an activity that is merely incidental or necessary to applicant’s larger business. *See In re Betz Paperchem, Inc.*, 222 USPQ 89, 90 (TTAB 1984); *In re Moore Bus. Forms, Inc.*, 24 USPQ2d 1638, 1639 (TTAB 1992); *In re Landmark Commc’ns*,

# EXHIBIT D



**To:** BoDog Entertainment Group S.A. ([BillF.docketing@SeedIP.com](mailto:BillF.docketing@SeedIP.com))  
**Subject:** TRADEMARK APPLICATION NO. 78827809 - PLAY HARD - N/A  
**Sent:** 2/20/2007 8:30:58 AM  
**Sent As:** ECOM104@USPTO.GOV  
**Attachments:** [Attachment - 1](#)  
[Attachment - 2](#)  
[Attachment - 3](#)

## UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 78/827809

**APPLICANT:** BoDog Entertainment Group S.A.

**CORRESPONDENT ADDRESS:**

William O. Ferron, Jr.  
Seed IP Law Group PLLC  
Suite 5300  
701 Fifth Avenue  
Seattle WA 98104

**\*78827809\***

**RETURN ADDRESS:**

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

**MARK:** PLAY HARD

**CORRESPONDENT'S REFERENCE/DOCKET NO :** N/A

**CORRESPONDENT EMAIL ADDRESS:**

[BillF.docketing@SeedIP.com](mailto:BillF.docketing@SeedIP.com)

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

## OFFICE ACTION

**RESPONSE TIME LIMIT:** TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

**MAILING/E-MAILING DATE INFORMATION:** If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 78/827809

This action is in response to applicant's letter, dated January 4<sup>th</sup>, 2007, in which applicant 1) added classes and 2) amended the identification of goods. As discussed below, the identification of goods is still unacceptable. Furthermore, a likelihood of confusion refusal and a potential likelihood of confusion cite are now made.

The following requirement has been satisfied and is now withdrawn: (1) additional fees. TMEP §714.04.

## **LIKELIHOOD OF CONFUSION – CLASS 25 REFUSAL ONLY**

With respect to International Class 25 only, registration of the proposed mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 2933801. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.* See the enclosed registration.

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods and services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

### **A) COMPARISON OF THE MARKS**

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

Applicant's mark is "PLAY HARD." Cited registrant's mark is "PLAY LONG, PLAY HARD." The marks are similar because they both contain the term "PLAY HARD."

Although applicant's mark does not contain the phrase "PLAY LONG," the mere deletion of wording from a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). *See In re Optical Int'l*, 196 USPQ 775 (TTAB 1977) (where applicant filed to register the mark OPTIQUE for optical wear, deletion of the term BOUTIQUE is insufficient to distinguish the mark, *per se*, from the registered mark OPTIQUE BOUTIQUE when used in connection with competing optical wear). In the present case, applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, and there is no other wording to distinguish it from registrant's mark. Additionally, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956). TMEP §1207.01(b).

### **B) COMPARISON OF THE GOODS AND SERVICES**

The goods and services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

Applicant's refused goods are "clothing." Cited registrant's goods are "articles of clothing, namely, jackets, coats, vests, blazers, jerseys, anoraks, pull-overs, track suits, pants, trousers, slacks, sweaters, sweat shirts, sweat pants, t-shirts, tank tops, shorts, jeans, suits, turtle necks, underwear, briefs, boxer briefs, and boxer shorts; wearing accessories, namely, kerchiefs and belts; headwear, namely, hats, caps, sweat bands, sun-visors, berets, bandannas, hoods, and head bands," and its services are "retail store services and wholesale distributorships featuring, apparel, apparel accessories, leather and imitation leather goods; on-line retail services, namely featuring, apparel, apparel accessories, leather and imitation leather goods." The goods and services are related because they all deal with clothing.

Because the marks are similar and the goods and services are closely related, a likelihood of confusion exists to prevent registration of applicant's mark with respect to International Class 25 under Section 2(d) of the Trademark Act.

#### **POTENTIAL LIKELIHOOD OF CONFUSION – CLASSES 25 and 41**

Information regarding pending Application Serial No. 78150855 is enclosed. The filing date of the referenced application precedes applicant's filing date. There may be a likelihood of confusion between the two marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d). If the referenced application registers, registration may be refused in this case under Section 2(d). 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon entry of a response to this Office action, action on this case may be suspended pending final disposition of the earlier-filed application.

If applicant believes there is no potential conflict between this application and the earlier-filed application, then applicant may present arguments relevant to the issue in a response to this Office action. The election not to submit arguments at this time in no way limits applicant's right to address this issue at a later point.

#### **RESPONDING TO A PARTIAL REFUSAL**

Applicant may respond to the stated refusal by doing one of the following:

- (1) deleting the class to which the refusal pertains;
- (2) arguing against the refusal of the combined application as a whole; or
- (3) filing a request to divide out the goods and services that have not been refused registration, so that the mark may be published for opposition in the classes to which the refusal does not pertain (See 37 C.F.R. §2.87 and TMEP §§1 110.05 and 1403.03 regarding the requirements for filing a request to divide).

Applicant must also respond to the following requirement:

## IDENTIFICATION/CLASSIFICATION OF GOODS AND SERVICES

The identification consists of the class heading for International Class 25. The purpose of class headings is to indicate the subject matter and general scope of the class, but headings are considered too broad for identifying goods or services in U.S. applications. TMEP §§1401.08, 1402.01 *et seq.* Therefore, applicant must amend the clothing goods to specify the common commercial or generic name for each item of clothing.

Additionally, the wording “gaming equipment, namely poker chips and playing cards” is unacceptable because it does not fit within the scope of “promotional items” as currently worded. While the identification of goods and services may be amended to clarify or limit the goods and services, additions to the identification or a broadening of the scope of the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §§1402.06 *et seq.* and 1402.07. Therefore, this wording should be deleted from the identification, or limited to fit within the scope of the original application.

Also, the proposed amendment to the identification cannot be accepted because the wording “retail store services and distributorship services in the field of... videos, films, movies, and related merchandise,” and “providing... videos, films, movies, and related merchandise” refers to services that are not within the scope of the identification that was set forth in the application at the time of filing. Applicant’s original application limited the “purchase, sale, distribution” services to “music.” The videos, films, and movies were only listed under “promotion” services. Therefore, this wording should be deleted from the identification. 37 C.F.R. §2.71(a); TMEP §§1402.06 *et seq.* and 1402.07.

Furthermore, the wording “providing... promotional items,” which occurs repeatedly in the amended identification of goods and services is not an entertainment service in International Class 41. Rather, it is a business advertising service in International Class 35. Also, such a service is not a service in commerce unless the services are provided for others. Promoting one’s own goods and services is *not* considered a service in commerce. Rather, such promotion is incidental to applicant’s larger business.

Similarly, if the purpose of applicant’s “contests and sweepstakes” is to promote the sale of its *own* goods and not the goods of others, the activities are not a service in commerce if the contests and sweepstakes are not separately offered, promoted, and charged-for. While it is true that benefits accrue to the winners of the contest, this is true generally of all promotional devices, and this fact alone does not transform the activity into a registrable service. *In re Dr. Pepper Co.*, 836 F.2d 508, 5 USPQ2d 1207 (Fed. Cir. 1987); *In re Loew’s Theatres, Inc.*, 179 USPQ 126 (TTAB 1973); *In re Johnson Publishing Co., Inc.*, 130 USPQ 185 (TTAB 1961); TMEP §1301.01(b)(i).

The following three criteria have evolved for determining what constitutes a “service”:

- (1) A service is a real activity, not an idea, concept, process or system. TMEP §1301.01(a)(i);
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- (3) A service is an activity that is sufficiently separate or qualitatively different from an applicant’s principal activity, i.e., it cannot be an activity that is merely incidental or necessary to applicant’s larger business. *See In re Betz Paperchem, Inc.*, 222 USPQ 89, 90 (TTAB 1984); *In re Moore Bus. Forms, Inc.*, 24 USPQ2d 1638, 1639 (TTAB 1992); *In re Landmark Commc’ns*,



*Inc.*, 204 USPQ 692, 695 (TTAB 1979); TMEP §1301.01(a)(ii).

Also, the wording “premier events,” “tournaments,” “related merchandise,” and “games of... skill” in the identification of goods and services is indefinite and must be clarified. TMEP §1402.01. Applicant should specify what “games of skill” are being played, and what is being played at the tournaments.

Applicant may adopt the following identification of goods and services, if accurate:

International Class 9 – “Musical sound recordings.”

International Class 25 – “Clothing, namely {please specify the type of clothing, e.g. t-shirts, pants, jackets, etc.}”

International Class 28 – “Promotional gaming equipment, namely poker chips and playing cards.”

International Class 35 – “Talent management; retail store services and distributorship services in the field of music; on-line retail store services and on-line distributorship services in the field of music; advertising services, namely promoting the music, videos, films, and movies of others via the internet, radio, television, film, other media, and by conducting premier marketing promotional events for others; providing promotional items, namely distribution of the samples of others for publicity purposes.”

International Class 36 – “Electronic payment services, namely electronic processing and transmission of bill payment data.”

International Class 41 – “Entertainment services, namely providing wagering services, {please specify what is being played} tournaments, gaming contests, and games of chance; on-line entertainment services, namely providing wagering services, {please specify what is being played} tournaments, gaming contests, and games of chance; on-line entertainment services, namely providing prerecorded music via a global computer network; entertainment services, namely arranging contests and sweepstakes; on-line entertainment services, namely arranging contests and sweepstakes.”

Please note that, while the identification of goods and services may be amended to clarify or limit the goods and services, adding to the goods and services or broadening the scope of the goods and services is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, applicant may not amend the identification to include goods and services that are not within the scope of the goods and services set forth in the present identification.

For assistance with identifying and classifying goods and services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahtml/tidm.html>.

The requirement for an acceptable identification of goods and services is continued and maintained.

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney directly at the number below.

/Jason Paul Blair/  
Examining Attorney  
Law Office 104