

Galaxy Fireworks, Inc.

204 E. Martin L. King Jr. Blvd.

Tampa, Fl. 33603

813-234-2264

April 21, 2006

Commissioner for Trademarks
Trademark Law Office 104
2900 Crystal Dr.
Arlington, Va. 22202-3513

Re.: Notification of Cancellation on Registration No. 2473386, *Star Burst*.

Dear Sir or Madam:

On March 13, 2006 Registrant received Notification of Cancellation on Registration No. 2473386, *Star Burst*. This calls for an official response to this Action, which was filed by TNT Fireworks (Petitioner) against the owner of the mark, Galaxy Fireworks, Inc. (Registrant). Initial Response is due to the USPTO prior to (but no later than) April 24, 2006. As such:

Petitioner alleges the following:

1. They have sold Fireworks (G & S) since September 7, 1989 under the Starburst name.
2. They applied for, and were refused, a registration from the USPTO on the mark Starburst (see USPTO Serial No. 73834887).
3. Registrant fraudulently obtained said registration as they were knowledgeable of Petitioner's use of the name Starburst through the Petitioner's listing on the **2000 Fl. State Sparkler List**.
4. Registrant's use of the mark *Star Burst* with "Fireworks" as Goods and Services is seen by the Petitioner as "merely descriptive" and thus not allowable under 15 U.S.C. § 1052(e)(1).
5. Petitioner claims similarities in appearance of the marks, goods and services, and confusion over the maker of the items.
6. Petitioner alleges that the Registrant no longer utilizes the mark *Star Burst* in interstate commerce, thus are deemed to be ineligible for further registration privileges.

Registrant affirms that:

The Date of First Use for Registrant's *Star Burst* is June of 1997 with these units being offered for sale in the states of Florida and other parts of the United States at that time. It is their assertion that the registered use of the name *Star Burst* from 1997 through the

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present gives both a common-law claim to the name in the State of Florida, and the right and privileges accorded to a trademark at the federal level. See *Marks v. Cayo Hueso Ltd.*, 437 So.2d 775 (Fl. App. 3 Dist., 1983), *Permanent Make-up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004).

An initial word search of the USPTO database was accomplished by the Registrant's office staff prior to submission of the application for registration on said mark. This search returned two previous attempts to register variations of the name "Star Burst" with "fireworks" listed as Goods and Services. See Serial Number 74496926, Salish Trust and Serial Number 73834887, China Pyrotechnics, Inc. Both Serial Numbers 74496926 and 73834887 were abandoned due to lack of response to official actions by the USPTO. Thus this name was considered to be available for use as a registered mark at the Federal level.

A search was also accomplished on the State of Florida name database prior to the filing of the application with the USPTO. This database is made available to the general public by the Florida State Division of Corporations expressly for this purpose (see: <http://www.sunbiz.org/corpweb/inquiry/cormenu.html>). This search returned one recorded use of the name "Star Burst" as a trademark that was filed in 1963 and expired in 1973. There is no record to show what the Goods and Services were for this name, if any.

As such, our company applied for, and received a registered trademark for the name *Star Burst*. Registration Number 2473386 was granted for this mark to Galaxy Fireworks, Inc. on July 31, 2001, and has been in continuous use in both inter and intra-state commerce by the Registrant since that time. It should also be noted that the mark *Star Burst* was published in the Trademark Official Gazette on or about May 8, 2001, and was not contested at that time by the Petitioner. See *Permanent Make-up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004), *Marks v. Cayo Hueso Ltd.*, 437 So.2d 775 (Fl. App. 3 Dist., 1983).

It was at this point in the registration process that the Petitioner should have been vigorously contesting this issue if their company had objections to the Registrant's use of the name *Star Burst*. In *Polaroid Corp. v. Polorad Elect. Corp.*, 287 F.2d 492 (2nd Circuit 1961) Judge Friendly writes that "it cannot be equitable for a well informed merchant with knowledge of a claimed invasion of right to wait to see how successful his competitor will be and then destroy with the aid of a court decree, much that the competitor has striven for (quoting from *Valvoline Oil Co. v. Havoline Oil Co.*, D.C.S.D.N.Y. 1913, 211 F. 195). This is exactly what the Petitioner is attempting to accomplish in the instant matter.

The Petitioner alleges that the marks are identical, both have the same Goods and Services, and the use by the registrant is likely to cause confusion with the consumers of these products. In the instant matter it is the Registrant, as owner of the *Star Burst* mark, that is the aggrieved party and the Petitioner that is the encroaching party. The Court clearly states that "federal registration of a trademark is prima facie evidence of the

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mark's validity, the registrant's ownership of the mark, and its exclusive right to use the mark in commerce". See *Lucent Information Management, Inc. v. Lucent Technologies, Inc.*, 1999 U.S. App. (3rd Cir. 1999) and 15 U.S.C. §1115(a).

A closer look at the dilution that the Petitioner alleges brings several shortfalls on the Petitioner's part to light. First, it is the owner of the mark, in this case the Registrant, that is eligible to claim dilution, and secondly, the dilution claimed by the Petitioner must actually be established rather than simply inferred. See *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003). As such, any confusion noted would be attributed to the Petitioner rather than the Registrant. It is the Petitioner's use of the name that needs to be discontinued to comply with the requirements noted in 15 U.S.C. And this is the action that the Registrant requested in the original document to the Petitioner on February 17, 2006. See *Appendix A*.

Petitioner has alleged that the mark *Star Burst* is no longer in use in interstate commerce, thus violating the precepts set forth in 15 U.S.C. However, the *Star Burst* mark has been in continuous usage on Registrant's fireworks assortment package labels since 1997 and samples of this item may be seen at the Registrant's physical sales locations and on the world wide web.

This item is available for purchase and shipment to any address in the continental United States where fireworks devices of this nature are not specifically prohibited by law. This *Star Burst* assortment package has been listed, and is available for sale, on the Registrant's website (www.galaxyfireworks.com) since the site's inception in 1999. This act in and of itself constitutes use in interstate commerce. See *in re Dell, Inc.*, 71 U.S.P.Q. 2d 1725 (T.T.A.B. 2004).

Therefore it is the contention of the Registrant that all criterions required for receiving and maintaining a registration has been, and still is, fulfilled. It is also the contention of the Registrant that the Petitioner has filed this suit as a harassment tactic in hopes that the Registrant will concede both the use and registration of the mark *Star Burst*.

Please send future correspondence to my attention at the above-noted address or to my e-mail address at galaxyfire@aol.com. Thank you for your assistance in this matter.

Sincerely,



Patrick Cook
General Manager

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Appendix A

Galaxy Fireworks, Inc.

204 E. Martin L. King Jr. Blvd.

Tampa, Fl. 33603

813-234-2264

February 17, 2006

American Promotional Events, Inc
P.O. Box 1318
4511 Helton Drive
Florence, AL 35630

Attention: Mr. Tommy Glasgow

Re: Starburst Fountain

Dear Mr. Glasgow,

This letter is to inform you of a trademark conflict between your "Starburst Fountain" (CP108) and our "Star Burst" trademark. I have attached a copy of the documentation for our mark registration for your reference. As you will note, our mark has been in continuous use since 1997.

At this time we are asking that your company discontinue all present and future uses of this name (Starburst Fountain), and remove existing stocks of said item from distribution. We are also requesting that you notify the Florida State Fire Marshal's office and have this name removed from the **2006 Florida List of Approved Sparklers** prior to its publishing date. Should there be any questions, please do not hesitate to call me at 800-334-2264 or email to galaxyfire@aol.com. Thank you for your cooperation in resolving this matter.

Sincerely,



Pat Cook
General Manager

File Copy

Galaxy Fireworks, Inc.

204 E. Martin L. King Jr. Blvd.

Tampa, Fl. 33603

813-234-2264

813-234-1516 (Fax)

April 21, 2006

FAX COVER SHEET: 5 pages total including cover sheet.

ATTENTION: Law Office 104

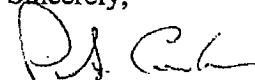
SENT FROM: Patrick Cook

SUBJECT:

Re: Notification of Cancellation on Registration No. 2473386, *Star Burst*

76041186

Sincerely,



Patrick Cook
General Manager

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