

ESTTA Tracking number: **ESTTA326857**

Filing date: **01/14/2010**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Samson Manufacturing Corporation		
Entity	Corporation	Citizenship	Massachusetts
Address	110 Christian Lane Whately, MA 01373 UNITED STATES		

Attorney information	Diane Noel Burns & Levinson LLP 125 Summer Street Boston, MA 02110 UNITED STATES trademarks@burnslev.com Phone:617-345-3648		
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Registrations Subject to Cancellation

Registration No	3505679	Registration date	09/23/2008
International Registration No.	NONE	International Registration Date	NONE
Registrant	PRIMA ARMI S.r.l. Viale Kennedy, 8 I-10064 PINEROLO (TORINO), ITALY		

Goods/Services Subject to Cancellation

Class 013. All goods and services in the class are cancelled, namely: Firearms; ammunition and projectiles; explosives; fireworks
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)		
Registration No	3505684	Registration date	09/23/2008
International Registration No.	NONE	International Registration Date	NONE
Registrant	PRIMA ARMI S.r.l. Viale Kennedy, 8 I-10064 PINEROLO (TORINO), ITALY		

Goods/Services Subject to Cancellation

Class 013. All goods and services in the class are cancelled, namely: Firearms; ammunition and projectiles;
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explosives; fireworks

Grounds for Cancellation

Priority and likelihood of confusion

Trademark Act section 2(d)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	77566738	Application Date	09/10/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	STAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 013. First use: First Use: 2007/10/27 First Use In Commerce: 2007/10/27 Gun accessories, namely, gun rails		

Attachments

77566738#TMSN.jpeg (1 page)(bytes) SamsonPetitionCancel.pdf (16 pages)(565965 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 Overnight Courier on this date.

Signature	/Diane Noel/
Name	Diane Noel
Date	01/14/2010

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

)		
Samson Manufacturing Corporation,)	Cancellation No. _____
)	Registration Nos. 3,505,679 and 3,505,684
Petitioner,)	Marks: STAR STAR and design; STAR
)	FIREARMS and design
v.)	
)	
Prima Armi S.r.l.,)	
)	
Respondent.)	
)	
)	

PETITION TO CANCEL

Petitioner, Samson Manufacturing Corporation, believes that it is or will be damaged by the continued registration of Registration Nos. 3,505,679 and 3,505,684 for the marks STAR STAR and design and STAR FIREARMS and design, registered by Prima Armi S.r.l., and hereby petitions to cancel the same. The grounds for cancellation are as follows:

1. Petitioner Samson Manufacturing Corporation (“Petitioner”) is a Massachusetts corporation with a principal place of business at 110 Christian Lane, Whately, Massachusetts.
2. Petitioner is the owner of the “STAR” mark (“Samson Mark”), U.S. Trademark Serial Number 77/566,738 for “gun accessories, namely, gun rails,” in International Class 013.
3. Petitioner applied for the aforementioned federal trademark registration for the Samson Mark on September 10, 2008.
4. The date of first use in interstate commerce designated on Petitioner’s application for the Samson Mark is October 27, 2007.
5. Petitioner has used the and continues to use Samson Mark in interstate commerce since October 27, 2007.

6. Upon information and belief, Respondent Prima Armi S.r.l. ("Respondent") is an Italian limited liability company with a principal place of business and mailing address at Viale Kennedy, 8 I-10064, Pinerolo (Torino) Italy.

7. Respondent alleges ownership of the following trademark registrations ("Prima Armi Marks"):

- (a) STAR STAR and design, Reg. No. 3,506,679, for "firearms; ammunition and projectiles; explosives; fireworks," in International Class 013. (Registered September 23, 2008).



- (b) STAR FIREARMS and design, Registration No. 3,505,684, for "firearms, ammunition and projectiles; explosives; fireworks," in International Class 013. (Registered September 23, 2008).



8. Each of the Prima Armi Marks was filed under a filing basis of 66(a) of the Trademark Act, 15 U.S.C. §1141f(a). The priority date for both of the Prima Armi Marks is November 30, 2007.

9. On December 18, 2008, the Examining Attorney at the United States Patent and Trademark Office ("PTO") responsible for reviewing the Samson Mark issued an Office Action,

claiming a likelihood of confusion existed between the Samson Mark and the Prima Armi Marks. Based on this conclusion, the PTO denied registration of the Samson Mark. A copy of this Office Action is attached hereto as **Exhibit 1**.

10. Petitioner submitted a response to the PTO's December 18, 2008 Office Action on June 18, 2009. Thereafter, on July 14, 2009, the PTO Examining Attorney upheld her determination of likelihood of confusion and issued a Final Office Action, again denying registration of the Samson Mark. A copy of the Final Office Action is attached hereto as **Exhibit 2**.

Count I – Seniority

11. Petitioner repeats and incorporates herein by reference the allegations set forth in paragraphs 1 – 10 of this Complaint.

12. The Samson Mark, "STAR," Ser. No. 77/566,738, has been used in commerce since October 27, 2007.

13. The earliest priority date claimed by Respondent for each of its Prima Armi Marks is November 30, 2007.

14. Upon information and belief, as of the date of this filing, Respondent has not used either of its Prima Armi Marks in commerce in the United States.

15. The use in commerce of the Samson Mark predates any priority date of both the Prima Armi Marks.

16. The use in commerce of the Samson Mark predates any use in commerce of both of the Prima Armi Marks.

17. Petitioner is unable to obtain registration for the Samson Mark directly because of the alleged "seniority" of the Prima Armi Marks.

18. Due to the foregoing, Petitioner has suffered and will continue to suffer harm and incur damages unless the Prima Armi Marks are cancelled.

Count II – Likelihood of Confusion

19. Petitioner repeats and incorporates herein by reference the allegations set forth in paragraphs 1 - 18 of this Complaint.

20. The Examining Attorney has found that the Samson Mark so resembles the Prima Armi Marks as to be likely to cause confusion.

21. If, as the Examining Attorney states, the Samson Mark is likely to cause confusion with the Prima Armi Marks, Petitioner has suffered and will continue to suffer harm unless the Prima Armi Marks are cancelled.

WHEREFORE Petitioner prays that this Petition to Cancel be sustained in favor of Petitioner and that Registration Nos. 3,505,684 and 3,505,679 be cancelled.

Respectfully Submitted,

SAMSON MANUFACTURING CORPORATION

By its attorneys:

/Diane Noël/

Merton Thompson, MA BBO # 637056

Diane A.D. Noël, MA BBO #656430

trademarks@burnslev.com

Burns & Levinson LLP

125 Summer Street

Boston, MA 02110

(617) 345-3000

January 14, 2010

Certificate of Mailing

I hereby certify under 37 CFR 2.190(b) that this correspondence, entitled "Petition to Cancel," is being deposited with the Commissioner of Trademarks by electronic filing through ESTTA on January 14, 2010.

/Diane Noël/

Diane A.D. Noël

EXHIBIT 1

Document Description: **Off Action Outgoing**
Mail / Create Date: **18-Dec-2008**

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To: Samson Manufacturing Corp. (trademarks@burnslev.com)
Subject: TRADEMARK APPLICATION NO. 77566738 - STAR - 40999-1
Sent: 12/18/2008 1:11:17 PM
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/566738

MARK: STAR

77566738

CORRESPONDENT ADDRESS:

MERTON THOMPSON
BURNS & LEVINSON LLP
125 SUMMER ST STE 600
BOSTON, MA 02110-1624

RESPOND TO THIS ACTION:

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

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Samson Manufacturing Corp.

**CORRESPONDENT'S
REFERENCE/DOCKET NO:**
40999-1

CORRESPONDENT E-MAIL ADDRESS:
trademarks@burnslev.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 12/18/2008

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 mark in U.S. Registration Nos. 3505679 and 3505684. 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.*

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. See *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

Regarding the issue of likelihood of confusion, all circumstances surrounding the sale of the goods and/or services are considered. These circumstances include the marketing channels, the identity of the prospective purchasers, and the degree of similarity between the marks and between the goods and/or services. See *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386 (C.C.P.A. 1973); TMEP §1207.01. In comparing the marks, similarity in any one of the elements of sound, appearance or meaning 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). In comparing the goods and/or services, it is necessary to show that they are related in some manner. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); TMEP §1207.01(a)(vi).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or

services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

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).

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.2d 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).

The marks are compared in their entireties under a Trademark Act Section 2(d) analysis. See TMEP §1207.01(b). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); see TMEP §1207.01(b)(viii), (c)(ii).

Consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); see also *Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions).

Comparison Of Goods/Services

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).

The applicant's mark is STAR for "gun accessories, namely, gun rails." The registrant's mark is STAR [design] and STAR firearms [design] for "firearms; ammunition and projectiles; fireworks." The registrant's marks include star-shaped designs but the applicant's mark does not. However, the word, "star," is the dominant feature that stands out in all three marks. The name by which the goods will be referenced is "star." The registrant's goods include firearms, or guns. The applicant's goods are gun accessories, namely, gun rails. These goods are shooting gear that are used together. See attached web page translated from Italian regarding the registrant. The registrant is Italy's largest wholesaler of shooting sports gear. http://74.125.93.104/translate_c?hl=en&sl=it&u=http://www.primarmi.it/&prev=/search%3Fq%3Dprima%2Barmi%26hl%3Den&usg=ALkJrhiID41WfKy9do17_4WYahtIgorDLw;http://www.hayesandassociates.co.nz/smart_loader.htm. Even if the registrant does not yet make or sell gun rails, any goods or services in the registrant's normal fields of expansion should be considered when determining whether the registrant's goods and/or services are related to the applicant's goods and/or services. TMEP §1207.01(a)(v); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581 1584 (TTAB 2007). Evidence that third parties offer the goods and/or services of both the registrant and applicant suggest that it is likely that the registrant would expand their business to include applicant's goods and/or services. In that event, customers are likely to believe the goods and/or services at issue come from or, are in some way connected with, the same source. *In re 1st USA Realty Prof'ls*, 84 USPQ2d at 1584 n.4; *see* TMEP §1207.01(a)(v). See attached web page from Cabela's web site, a large seller of hunting gear, as evidence that all of the goods are sold by a single source, http://www.cabelas.com/cabelas/en/templates/category/category.jsp?id=cat20712&cmCat=MainCatcat20712&navAction=jump&cm_re=LeftNav*Hunting*121608.

Consumers of these goods are likely to be confused into thinking that the goods emanate from the same STAR source. Therefore, registration is denied.

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

/rscb/

Robin S. Chosid-Brown, Esq.

Law Office 102

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robin.chosid-brown@uspto.gov

RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number,

the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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EXHIBIT 2

Document Description: Offc Action Outgoing

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To: Samson Manufacturing Corp. (trademarks@burnslev.com)
Subject: U.S. TRADEMARK APPLICATION NO. 77566738 - STAR - 40999-1
Sent: 7/14/2009 2:21:24 PM
Sent As: ECOM102@USPTO.GOV

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UNITED STATES PATENT AND TRADEMARK OFFICE**SERIAL NO:** 77/566738**MARK:** STAR**CORRESPONDENT ADDRESS:**

MERTON THOMPSON
BURNS & LEVINSON LLP
125 SUMMER ST STE 600
BOSTON, MA 02110-1624

77566738**RESPOND TO THIS ACTION:**<http://www.uspto.gov/teas/eTEASpageD.htm>**GENERAL TRADEMARK INFORMATION:**<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Samson Manufacturing Corp.

**CORRESPONDENT'S
REFERENCE/DOCKET NO:**
40999-1

CORRESPONDENT E-MAIL ADDRESS:
trademarks@burnslev.com

FINAL OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 7/14/2009

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on June 18, 2009.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration Nos.3505679 and 3505684. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the enclosed registrations.

Regarding the issue of likelihood of confusion, all circumstances surrounding the sale of the goods and/or services are considered. These circumstances include the marketing channels, the identity of the prospective purchasers, and the degree of similarity between the marks and between the goods and/or services. *See Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386 (C.C.P.A. 1973); TMEP §1207.01. In comparing the marks, similarity in any one of the elements of sound, appearance or meaning 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). In comparing the goods and/or services, it is necessary to show that they are related in some manner. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); TMEP §1207.01(a)(vi).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

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).

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).

If the marks of the respective parties are identical, the relationship between the goods and/or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Amcors, Inc. v. Amcor Indus., Inc.*, 210 USPQ 70, 78 (TTAB 1981); TMEP §1207.01(a).

In response to the refusal to register the mark, the applicant argued that it has an actual first date of use that is prior to the filing date of the registrations. Unfortunately, applicant's claim of priority of use is not relevant to this *ex parte* proceeding. *See In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971). Trademark Act Section 7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in commerce on or in connection with the goods and/or services specified in the certificate. During *ex parte* prosecution, the trademark examining attorney has no authority to review or to decide on matters that constitute a collateral attack on the cited registration. TMEP §1207.01(d)(iv).

The applicant also argued that the marks are dissimilar and that the goods are unrelated. The applicant argued that the star design portions of the registrant's marks are the dominant portions that bring to mind a sheriff's badge and that the applicant's goods are very narrow compared to the registrant's goods which are broadly identified. The applicant also argued that STAR stands for Samson Tactical Accessory Rails Systems.

When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods and/or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729, 735 (TTAB 1976); TMEP §1207.01(c)(ii). Customers are likely to remember the STAR wording in order to find ammunition and gun accessories. While the design portion of the mark cannot be ignored, it is the wording in this instance that will create the memorable impression. Also, the acronym, STAR, is not always used together with the wording, "Samson Tactical Accessory Rails Systems." It sometimes appears by itself as the brand of the gun rails. *See* the applicant's web site, http://www.samson-mfg.com/ar-15_html/category/AR-10_Rail.html. Thus a consumer may not necessarily connect "STAR" with Samson manufacturing. Rather, it could be confused into thinking that the registrant is the source of the STAR products.

The applicant has also tried to distinguish the markets for the goods. However, the applicant's goods

and the registrant's goods are clearly related. Gun rails are used on guns. Attached are copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods and/or services as those of applicant and registrant in this case. These printouts have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely firearms, ammunition, projectiles, explosives, fireworks, and gun accessories such as gun rails, are of a kind that may emanate from a single source. *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). See also the applicant's web site that includes gun accessories other than gun rails. <http://www.samson-mfg.com/index.html>.

Because the dominant portion of the marks, STAR, is identical and the goods are related goods, registration is denied because there is a likelihood of confusion as to the source of the goods.

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; see 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

/rscb/
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RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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