

EXHIBIT A

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78299179
MARK SECTION (no change)	
ARGUMENT(S)	
<p>With the entry of the foregoing amendments, applicant disclaims the words "Buffalo" in the application.</p> <p>The Trademark Examining Attorney has refused registration of applicant's mark BOUNTY HUNTER BUFFALO, as to the Class 25 goods only, on the grounds of likelihood of confusion with the marks in U.S. Registration Nos. 2690997 and 1804553 (BOUNTY HUNTER). Reconsideration of the refusal is respectfully requested in view of the following remarks.</p> <p>In analyzing whether there is a likelihood of confusion, comparison must be made between the marks themselves in appearance, sound, connotation, and commercial impression, and one must further compare the goods on which, or services for which, the marks are used to determine whether the goods or services are related and also to determine if the activities surrounding their marketing are such that confusion as to origin or source is likely. The Trademark Examining Attorney has asserted that a portion of the applicant's mark is identical to the mark in the cited registrations, that the applicant's Class 25 goods are identical to the goods in U.S. Registration No. 1804553 and are the type of goods that are sold through registrant's services in U.S. Registration No. 2690997.</p> <p>The examining attorney must compare the marks for similarities in sound, appearance, meaning or connotation. <i>In re E. I. duPont de Nemours & Co.</i>, 467 F.2d 1357, 177 USPQ 563 (CCPA 1973). The entire mark, including disclaimed words,</p>	

must be considered by the examining attorney. "It is well settled that the question of likelihood of confusion is to be resolved upon a consideration of the marks in their entireties. Disclaimed material forming part of a trademark cannot be ignored in determining whether the marks are confusingly similar." *Industria Espanola de Perlas Imitacion, S.A. v. National Silver Company*, 459 F.2d 1049, 173 U.S.P.Q. 769 (CCPA 1972); see also *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 U.S.P.Q. 433 (CCPA 1965) (A disclaimer of specific words appearing in a trademark disclaimed only any exclusive right in such words per se and did not have effect of removing them from mark sought to be registered). "Disclaimers are not material to the issue of the likely confusion. The public is not aware of what words have been disclaimed." *First Nationwide Bank v. Nationwide Savings and Loan Association*, 682 F. Supp. 965, 6 U.S.P.Q.2d 1917 (E.D. Ark. 1988).

For example, in the recent *Hearst Corporation* case, the Federal Circuit found *no* likelihood of confusion between the mark "VARGA GIRL" and the existing trademark of "VARGAS." *In re the Hearst Corporation*, 982 F.2d 493, 25 U.S.P.Q.2d 1238 (Fed.Cir. 1992). Both marks referred to the World War II era drawings of Alberto Vargas. VARGAS was registered for use with calendars (among other items) featuring the artist's drawings. The applicant sought to register VARGA GIRL for use in conjunction with calendars also bearing Vargas' drawings. The Federal Circuit focused its inquiry on "the similarity *vel non* of VARGA GIRL and VARGAS, the identity of goods (calendars) and the channels of trade." *Id.* at 494. The Trademark Trial and Appeal Board of the United States Patent and Trademark Office had found that "varga" was the dominant element of the VARGA GIRL mark and that "girl" was merely descriptive and was not entitled to substantial weight in comparing the two marks. *Id.* The Federal Circuit disagreed, stating:

The Board erred in its analytic approach. Although undoubtedly "varga" and "vargas" are similar, the marks must be considered in the way that they are used and perceived. Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight. The appearance, sound, sight, and commercial impression of VARGA GIRL derive significant contribution from the component "girl". By stressing the portion "varga" and diminishing the portion "girl", the Board inappropriately changed the mark. Although the weight given to

the respective words is not entirely free of subjectivity, we believe that the Board erred in its diminution of the contribution of the word "girl". When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely.

Id. (Citations omitted).

In comparing the marks BOUNTY HUNTER with the applicant's mark, BOUNTY HUNTER BUFFALO, applicant believes that the respective marks are obviously significantly different in appearance, sound, sight, connotation and commercial impression once due weight is given to the descriptive word "buffalo." The words "bounty hunter" are like to the words "varga" and "vargas" in the *Hearst Corporation* case in that they cannot be the sole focus of the examining attorney. Ignoring the word "buffalo" inappropriately changes applicant's mark (making it identical with the mark BOUNTY HUNTER) and diminishes the contribution that the disclaimed word "buffalo" makes to the applicant's mark. Indeed, the addition of the word "buffalo" to applicant's mark results in a significant perceptual difference between the marks. "Buffalo" makes a substantial contribution to applicant's mark, resulting in the likely public impression that applicant's mark refers to an anthropomorphized buffalo that engages in bounty hunting rather than an actual human bounty hunter. The alliterative sound of applicant's mark (which follows the theme of applicant's family of marks discussed below) also relies on the word "buffalo" and changes the sound and tone of the entire mark. The distinct connotation of applicant's mark clearly will be perceived by the public. Applicant believes that this distinction will be far more obvious to the public than the distinction between VARGAS and VARGA GIRL.

Applicant's mark also will not likely be confused with the mark BOUNTY HUNTER because BOUNTY HUNTER BUFFALO is part of a family of marks with a common theme. Applicant is the owner of registered marks BOOK'EM BUNNY (Registration No. 2517916), MUGGER MOOSE (Registration No. 2500705), SGT. SQUIRREL (Registration No. 2702759), DEPUTY DOLPHIN (Registration No. 2827702), and FOXY FELON (Registration No. 2513063), PENITENTIARY

PENGUIN (2724293), and GANGSTER GATOR (Registration pending) among other animal themed trademarks owned by applicant and used in conjunction with applicant's prison inmate commissary business. Each of these marks utilizes alliteration and animal caricatures relating in some clever way to the prison system. The word "BUFFALO" is a critical element of the mark BOUNTY HUNTER BUFFALO because it continues this fine tradition in applicant's family of marks. As the newest addition to this family, BOUNTY HUNTER BUFFALO bears a strong thematic relationship to the earlier marks that will serve to distinguish it from the marks using BOUNTY HUNTER alone. The public will not likely confuse the marks in this context.

In summary, applicant believes that there is no likelihood of confusion between BOUNTY HUNTER and BOUNTY HUNTER BUFFALO because the disclaimed portion of applicant's mark - "buffalo" - contributes substantially to the likely public perception of the mark. Although applicant has disclaimed "buffalo", it is inappropriate to diminish the value of the disclaimed word in evaluating the likelihood of confusion. The public will see applicant's entire mark and will recognize that it is not the same mark as or even related to BOUNTY HUNTER. This impression will be reinforced in the context of applicant's family of marks which share a common connotation - that of anthropomorphized animals involved in the criminal justice system.

In view of the foregoing amendments and these remarks, it is respectfully submitted that this application is in condition for prompt publication. Favorable action is therefore requested.

ADDITIONAL STATEMENTS SECTION

DISCLAIMER	No claim is made to the exclusive right to use BUFFALO apart from the mark as shown.
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SIGNATURE SECTION

SIGNATURE	/sverre david roang/
SIGNATORY NAME	Sverre David Roang
SIGNATORY POSITION	Attorney
SIGNATORY DATE	06/17/2004

FILING INFORMATION SECTION

SUBMIT DATE	Thu Jun 17 12:49:19 EDT 2004
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OMB Control #0651-0050 (Exp. 04/30/2006)

Response to Office Action To the Commissioner for Trademarks:

Application serial no. **78299179** is amended as follows:

Argument(s)

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

With the entry of the foregoing amendments, applicant disclaims the words "Buffalo" in the application.

The Trademark Examining Attorney has refused registration of applicant's mark BOUNTY HUNTER BUFFALO, as to the Class 25 goods only, on the grounds of likelihood of confusion with the marks in U.S. Registration Nos. 2690997 and 1804553 (BOUNTY HUNTER). Reconsideration of the refusal is respectfully requested in view of the following remarks.

In analyzing whether there is a likelihood of confusion, comparison must be made between the marks themselves in appearance, sound, connotation, and commercial impression, and one must further compare the goods on which, or services for which, the marks are used to determine whether the goods or services are related and also to determine if the activities surrounding their marketing are such that confusion as to origin or source is likely. The Trademark Examining Attorney has asserted that a portion of the applicant's mark is identical to the mark in the cited registrations, that the applicant's Class 25 goods are identical to the goods in U.S. Registration No. 1804553 and are the type of goods that are

sold through registrant's services in U.S. Registration No. 2690997.

The examining attorney must compare the marks for similarities in sound, appearance, meaning or connotation. *In re E. I. duPont de Nemours & Co.*, 467 F.2d 1357, 177 USPQ 563 (CCPA 1973). The entire mark, including disclaimed words, must be considered by the examining attorney. "It is well settled that the question of likelihood of confusion is to be resolved upon a consideration of the marks in their entireties. Disclaimed material forming part of a trademark cannot be ignored in determining whether the marks are confusingly similar." *Industria Espanola de Perlas Imitacion, S.A. v. National Silver Company*, 459 F.2d 1049, 173 U.S.P.Q. 769 (CCPA 1972); *see also Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 U.S.P.Q. 433 (CCPA 1965) (A disclaimer of specific words appearing in a trademark disclaimed only any exclusive right in such words per se and did not have effect of removing them from mark sought to be registered). "Disclaimers are not material to the issue of the likely confusion. The public is not aware of what words have been disclaimed." *First Nationwide Bank v. Nationwide Savings and Loan Association*, 682 F. Supp. 965, 6 U.S.P.Q.2d 1917 (E.D. Ark. 1988).

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contribution from the component "girl". By stressing the portion "varga" and diminishing the portion "girl", the Board inappropriately changed the mark. Although the weight given to the respective words is not entirely free of subjectivity, we believe that the Board erred in its diminution of the contribution of the word "girl". When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely.

Id. (Citations omitted).

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with applicant's prison inmate commissary business. Each of these marks utilizes alliteration and animal caricatures relating in some clever way to the prison system. The word "BUFFALO" is a critical element of the mark BOUNTY HUNTER BUFFALO because it continues this fine tradition in applicant's family of marks. As the newest addition to this family, BOUNTY HUNTER BUFFALO bears a strong thematic relationship to the earlier marks that will serve to distinguish it from the marks using BOUNTY HUNTER alone. The public will not likely confuse the marks in this context.

In summary, applicant believes that there is no likelihood of confusion between BOUNTY HUNTER and BOUNTY HUNTER BUFFALO because the disclaimed portion of applicant's mark - "buffalo" - contributes substantially to the likely public perception of the mark. Although applicant has disclaimed "buffalo", it is inappropriate to diminish the value of the disclaimed word in evaluating the likelihood of confusion. The public will see applicant's entire mark and will recognize that it is not the same mark as or even related to BOUNTY HUNTER. This impression will be reinforced in the context of applicant's family of marks which share a common connotation - that of anthropomorphized animals involved in the criminal justice system.

In view of the foregoing amendments and these remarks, it is respectfully submitted that this application is in condition for prompt publication. Favorable action is therefore requested.

Additional Statements

No claim is made to the exclusive right to use BUFFALO apart from the mark as shown.

Response Signature

Signature: /sverre david roang/ Date: 06/17/2004

Signatory's Name: Sverre David Roang

Signatory's Position: Attorney

Serial Number: 78299179

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