

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK EXAMINING DIVISION**

In re Application of: :
Spartan Race, Inc. :
Serial No.: 88047299 :
Filed: July 21, 2018 :
Mark: SPARTAN COMBAT :

RESPONSE TO OFFICE ACTION

The Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act on the ground that the Applicant’s service mark for SPARTAN COMBAT for “Online retail store services featuring clothing, namely, shirts and shorts, and featuring apparel for combat and fighting sports and equipment for combat and fighting sports” when used on or in connection with the identified services so resembles U.S. Registration No. 4675455



for “On-line retail store services featuring firearms, firearm attachments, and weapons” that it is likely to cause confusion, mistake, or to deceive.

Applicant respectfully requests that the Examining Attorney withdraw her refusal to register for the reasons set forth below.

The Lanham Act provides for rejecting registration of a mark that “so resembles a [registered] mark . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). The section continues

that if “confusion, mistake, or deception is not likely to result from continued use . . . of similar marks . . . , concurrent registrations may be issued.” Id. The Examining Attorney correctly asserts that the likelihood of confusion determination is assisted by applying the du Pont factors outlined by the Court of Customs and Patent Appeals. In re E.I. du Pont DeNemours & Co., 476 F.2d 1357 (C.C.P.A. 1973). The thirteen du Pont factors are as follows: (1) the marks' similarity in appearance, sound, connotation, and commercial impression; (2) the similarity of the goods and services covered by the marks; (3) the similarity of the channels of trade; (4) the sophistication of the typical consumer; (5) the distinctiveness (sales, advertising, length of use) of the registered mark; (6) the number of other, similar marks used for similar goods or services; (7) any evidence of actual confusion; (8) the length of concurrent use without evidence of actual confusion; (9) the variety of goods or services covered by the marks; (10) any discussions or agreements between the marks' owners; (11) the marks' current exclusivity in the marketplace; (12) the substantiality of potential confusion; and (13) any other evidence probative of concurrent use's effects on consumers. Id. at 1361.

Because the likelihood of confusion determination is case specific, some factors may be more or less relevant in a given case. Id. at 1361-62; see also Citigroup Inc. v. Capital City Bank Grp., Inc., 637 F.3d 1344, 1355-57 (Fed. Cir. 2011); In re August Storck KG, 218 U.S.P.Q. 823 (T.T.A.B. 1983); In re Int'l Telephone & Telegraph Co., 197 U.S.P.Q. 910 (T.T.A.B. 1978). Therefore, none of the above factors is automatically controlling. Rather, each must be examined on a case-by-case basis to determine the appropriate weight given to each factor. There is simply no mechanical test for determining likelihood of confusion and each case must be decided on its own facts.

The determinative inquiry is always not whether consumers believe the *goods or services* are similar but whether the marks' concurrent use "will confuse people into believing that the goods they identify emanate from the same *source*" (emphasis added). Paula Payne Prods. Co. v. Johnson's Publ'g Co., 473 F. 2d 901, 902 (C.C.P.A. 1973); In re Rexel Inc., 223 U.S.P.Q. 830, 831 (TTAB 1984).

The Examining Attorney asserts that the following factors are most relevant in this case:

- (1) similarity of the marks; and
- (2) similarity and nature of the services.

A. The cited mark itself, and the services in Applicant's mark, are so unrelated that confusion is unlikely.

The Examiner proclaims that the two marks are similar because the wording itself in the two marks "has similar meaning referring to physical violence and/or warfare." Says who? In fact, by stark contrast, the mark in the drawing page of the cited registration is vastly different than the mark in the drawing page of the Application.

First, the mark in the cited registration is different because it blatantly looks different and sounds different. It contains an obvious visual difference that shouts loud to any ordinary observer – it contains a helmet design, a spear, and the extra words "TACTICAL GEAR" stacked underneath the word SPARTAN and the helmet and the spear. The spelling difference is dramatic. And "SPARTAN TACTICAL GEAR" (six syllables) does not sound like, and is not pronounced like, "SPARTAN COMBAT" (four syllables) in any stretch of the imagination. Applicant's mark does not contain any such multifarious elements as helmets or spears. No one would ever conclude that they are the same or similar such that the mark on one drawing page would be mistaken for

the mark on the other drawing page. In determining whether two marks are likely to be confused, it is well settled that “marks must be compared in their entireties.” In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985); see also Homeowners Group, Inc. v. Homeowners Marketing Specialists, Inc., 931 F.2d 1100 (6th Cir. 1991) (marks must be viewed in their entirety and in context). The similarity of the marks in their entireties must be considered with respect to appearance, sound, connotation, and commercial impression. DuPont, 476 F.2d 1361, 177 USPQ at 567 (C.C.P.A.). The Examiner must not ignore significant differences that may make the marks distinguishable, and must not break the mark into component parts for comparison. See, e.g., Franklin Mint Corp. v. Master Mfg. Co., 677 F.2d 1005, 1007 (C.C.P.A. 1981); Estate of P.D. Beckwith, Inc. v. Comm’r of Patents, 252 U.S. 538 (1920); Coca-Cola Co. v. Snow Crest Beverages, 162 F.2d 280, 7 U.S.P.Q. 518 (CCA 1st Cir. 1947); China Healthways Institute, Inc. v. Wang, 491 F.3d 1337, 83 U.S.P.Q.2d 1123 (Fed. Cir. 2007), cert. denied 128 S. Ct. 661 (2007) (“It is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue.”). The Federal Circuit has cautioned: “[t]here is no general rule as to whether letters or design will dominate in composite marks. ... No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” In re Electrolyte Laboratories, Inc., 13 F.3d 930 (Fed. Cir. 1990), corrected 929 F.3d 645 (Fed. Cir. 1990). Therefore, the design element here cannot to be overlooked, swept under the rug, glossed over or ignored and instead provide blatant additional elements and weight to distinguish Applicant’s mark from the cited mark, given that the design element is very visually different.

Second, the registrant’s mark, with all its extra words, trappings and dressings, creates an entirely distinct and unique and separate evocation, meaning, identity and commercial impression – “tactical” -- than Applicant’s mark that does not use the word “tactical” and that contains no

visual graphics that are similar to those unique graphics of the registrant. Applicant's mark cannot be confused with the cited registrant and the very different evocation, meaning, identity and commercial impression of tactical, because **“tactical” does not mean “physical violence” or “warfare”** despite the Examiner's gross assumption and unfounded conclusion that it does. In fact, as shown by the attached dictionary definition of “tactical”, the word simply means, and only means, “done in order to get a particular result”. The examples of usage given in the dictionary is:

“He made a tactical error in agreeing to the debates.”

“It was a tactical vote.”

“He has plenty of tactical ability and is a great organizer.”

“The tactical advantage offered by cash is flexibility.”

“They made a tactical error by coming in with an offer that was so unrealistic.”

“Analysts have largely viewed his resignation as a tactical move.”

The Examiner should not be creating meanings of words that do not exist to fit preconceived bias against Applicant. That is unfair and prejudicial.

Applicant respectfully disagrees that the Applicant's services are similar or related to the services of the cited registration. The Examiner proclaims: “The attached Internet evidence demonstrates that applicant's and registrant's services are commonly provided by the same entity under the same mark. In conclusion, the applicant's and registrant's services are related.” If only it were so easy.

Goods and services are not “related” simply because they co-exist in the same broad industry. They are “related” if the goods are marketed and consumed in such a way that buyers are likely to believe that all of the goods come from the same source. Homeowner's Group, Inc.

v. Home Marketing Specialists, Inc., 18 USPQ2d 1587, 1594 (6th Cir. 1991). (No likelihood of confusion between marketing and advertising support services for real estate brokers under HMS and providing real estate brokerage services under HMS HOME MARKETING SPECIALISTS on non-commission or flat-fee rates.) Likelihood of confusion occurs when “the respective goods or services are related in [the] same manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would be encountered by the *same persons* under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer.” In re Hal Leonard Publishing Corp., 15 USPQ2d 1574, 1575 (TTAB 1990).

Put simply, a trademark registrant’s rights do not extend in gross to *all* products. There must be a very close overlap, nexus or relationship between the goods before a likelihood of confusion can be found between similar marks. Indeed, many *identical* marks may and do co-exist in different fields without confusion.

“Thus NOTRE DAME brand imported French cheese has been permitted to co-exist with NOTRE DAME UNIVERSITY; BULOVA watches with BULOVA shoes; ALLIGATOR raincoats with ALLIGATOR cigarettes; THIS BUD’S FOR YOU in beer commercials with the same phrase used by a florist; WHITE HOUSE tea and coffee with WHITE HOUSE milk; BLUE SHIELD medical care plan with BLUE SHIELD mattresses; FAMILY CIRCLE magazine with FAMILY CIRCLE department store; OLE cigars with OLE tequila; and SUNKIST fruits with SUNKIST bakery products, the list continues.” Quality Inns Int’l v. McDonald’s Corp., 8 USPQ2d 1633, 1641 (D. Md. 1988).

In Electronic Design & Sales, Inc. v. Electronic Data Systems Corp., 954 F.2d 713 (Fed. Cir. 1992), there was no likelihood of confusion, even though the plaintiff sold E.D.S. computer services and defendant sold EDS power supplies and battery chargers, and both parties sold in some instances even to the same hospitals. There was no likelihood of confusion because of the distinct types of goods and because despite the overlap in customers, the purchases were made by

different departments within those same hospitals.

Determining the similarity of goods and services is ultimately based on common sense and common experience. ITT Corp. v. XTRA Corp., 225 USPQ 723, 732 (D. Mass 1985). “The Board...has found no likelihood of confusion even with respect to identical marks applied to goods and or services used in a common industry where such goods and/or services are clearly different from each other and there is insufficient evidence to establish a reasonable basis for assuming that the respective goods as identified by their marks, would be encountered by the *same purchasers*.” Borg-Warner Chem, Inc. v. Helena Chem. Co., 225 USPQ 222, 224 (TTAB 1983) (emphasis added).

Moreover, the Examining Attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. See, e.g., In re White Rock Distilleries Inc., 92 USPQ2d 1282, 1285 (TTAB 2009). There is no *per se* rule that certain goods or services are related that would dictate a likelihood of confusion determination. See, e.g., Info. Res. Inc. v. X*Press Info. Servs., 6 USPQ2d 1034, 1038 (TTAB 1988); In re Quadram Corp., 228 USPQ 863, 865 (TTAB 1985); see also M2 Software, Inc. v. M2 Commc'ns, Inc., 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947–48 (Fed. Cir. 2006). When the relatedness of the goods and services is not evident, well known, or generally recognized, “something more” than the mere fact that the goods and services are used together must be shown. In re St. Helena Hosp., 774 F.3d 754, 113 USPQ2d 1087.

Applicant has been able to find no decision in the entire long history of the USPTO holding, nor any other general acceptance, that “firearms, firearm attachments, and weapons” are related to “clothing, namely, shirts and shorts” or “apparel for combat and fighting sports” or “equipment

for combat and fighting sports". That is because they are not similar, and because there is no "something more" as respects the two disparate sets of items.

The established rule is that determining likelihood of confusion is based on the description of the services stated in the application and registration at issue, **not on any evidence of actual use**. See Stone Lion Capital Partners, LP v. Lion Capital LLP, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting Octocom Sys. Inc. v. Hous. Computers Servs. Inc., 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Yet, despite this rule, the Examiner has circumvented this rule by going outside of the descriptions of the application and registration - and has attached extraneous evidence. Nonetheless, the extraneous information is irrelevant and outside the descriptions.

Applicant has not applied here for firearms. Applicant does not sell firearms. Here there is no factual basis to support finding that consumers are likely to conclude that "clothing, namely, shirts and shorts" or "apparel for combat and fighting sports" or "equipment for combat and fighting sports" are similar to "firearms". The mere fact that different goods are sold by *one entity* does not **automatically** make all of these many goods sold "related" goods under the Lanham Act. Such broad comparisons are not permissible under the "something more" test. Under this new law created by the Examiner, *everything* (even private label branded items) sold by online retailers such as Amazon, Walmart or Dick's Sporting Goods is now automatically related for trademark purposes, because it is, well, sold by a single entity. That is preposterous. Imagine the havoc that would cause in clearing any mark. The same online retailers that sell firearms also sell paint cans, but that does not make them related. Here, the respective products sold online are in fact both non-competitive and unrelated, and so distinct from the services offered by the prior registrant that confusion as to the source or origin of the services is entirely unlikely. The fact that

a product is in the same broad field, does not itself provide a basis for regarding them as “related” for purposes of Trademark Act Section 2(d). For example, sugar and pizza are both “food” and are both sold by the same entity, but they are not “related” goods. Jacobs v. International Multifoods Corp., 212 USPQ 641, 642 (CCPA 1982). A determination here that the respective products sold online are related would effectively overturn the requirement that a finding of relatedness requires “something more” than the mere fact that Applicant and others sell something online along with a thousand other items - like everyone else!

Lastly, Applicant submits that firearms are highly regulated and expensive, unlike clothing. There are both federal and state regulations requiring waiting periods for background checks before the purchase can be completed. The waiting period can be days or weeks. In fact, it is doubtful that online purchase of firearms is even possible under the law, which further adds to the speculation and supposition that consumers would find the products sold to be similar. Applicant will not be appearing at the same gun shows, or in the same firearms trade publications as the cited registrant. The high prices for registrant’s firearms and products means that registrant’s consumers are sophisticated purchasers who will be more deliberate about their purchasing decision about what life-taking gun to buy (a deadly serious decision) and are extremely unlikely to make a mistake in their purchasing decision as to the source of the Registrant’s online services of selling firearms and registrant’s weapons, or to believe that Applicant is related to such expensive products or firearms community.

CONCLUSION

For these reasons, the Examining Attorney should withdraw the refusals based on likelihood of confusion. Any mere possibility that relevant purchasers might relate the two

different marks does not meet the statutorily established test of likelihood of confusion. See, e.g., In re Hughes Aircraft Company, 222 U.S.P.Q. 263, 264 (TTAB 1984) (“the Trademark Act does not preclude registration of a mark where there is a possibility of confusion as to source or origin, only where such confusion is likely”).

Based on all of the foregoing, no likelihood of confusion with the prior cited registration exists. There is room for Applicant’s mark to co-exist. Accordingly, this Application requires no further attention. Applicant respectfully requests that the application proceed to publication in the *Official Gazette*. Any party that feels it would be damaged by the Application has a full and fair opportunity to file an opposition.

Applicant requests suspension of its Application pending final disposition of any prior-filed cited applications.



Search English

Meaning of **tactical** in English

Contents



tactical

adjective [not gradable] • **US** /'tæk.tɪ.kəl/

- ★ **relating to tactics; done in order to get a particular result:**

He made a tactical error in agreeing to the debates.

- ★ **Tactical military operations or weapons are used to achieve specific goals.**

(Definition of "tactical" from the [Cambridge Academic Content Dictionary](#) © Cambridge University Press)

"tactical" in English

tactical

adjective • **UK** /'tæk.tɪ.kəl/ **US** /'tæk.tɪ.kəl/

- ★ **relating to tactics or done in order to achieve something:**

It was a tactical vote.

- ★ **Tactical weapons are for use over short distances and, especially in the case of nuclear weapons. have a local effect only.**

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Search English



in sb's crosshairs *idiom* in the pipeline *idiom* intend **lay** **outlook**
planner **propose** purposely
 put the cart before the horse *idiom* put their heads together *idiom*
 rearrange reckon on sth **swing**

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"tactical" in Business English

tactical

adjective • **UK** /'tæktɪkəl/ **US**

★ **relating to the methods used to achieve a particular result:**

He has plenty of tactical ability and is a great organizer.

The tactical advantage offered by cash is flexibility.

a tactical error/mistake *They made a tactical error by coming in with an offer that was so unrealistic.*

a tactical decision/move *Analysts have largely viewed his resignation as a tactical move.*

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