

May 20, 2019

United States Patent and Trademark Office
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In re: U.S. APPLICATION SERIAL NO. 88060515, DOLLARSPROUT
U.S. APPLICATION SERIAL NO. 88060546, DOLLARSPROUT

Dear Mr. Clark:

We are writing in response to the Office Actions issued in the above referenced mark applications. Because both applied-for marks were rejected on the same bases, we are submitting this single, consolidated response.

1. SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for marks was refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 1724200 and 1724199, SPROUT GROUP and SPROUT (hereinafter, the “Registered Marks”). Respectfully, applicant has reviewed the registrations for each of the Registered Marks, and the specimens submitted for them, and believes that the applied-for marks satisfy a number of the du Pont factors, *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973), that warrant registration.

Specifically, applicant believes that analysis of the following du Pont factors, as applied to the marks at issue, weighs in favor of registration of applicant’s marks:

1. *The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.*

Applicant submits that there is no reason to perceive any separation of the component parts of the applied-for marks, which consist of a unitary word, DOLLARSPROUT. Neither of the Registered Marks contains the word DOLLAR as part of the mark, nor does either of the Registered Marks suggest, by mere inclusion of the word SPROUT, any association with DOLLAR, which is the leading component of the applied-for marks

To the contrary, the overall commercial impression of the singular combined DOLLARSPROUT is the intended suggestion of “growing your money,” i.e., helping your dollars to sprout. Applicant respectfully submits that DOLLAR being the leading portion of the applied-for marks, the commercial impression created by the applied-for marks starts with and remains centered on the concept of the dollar, or money. The word “dollar” alone creates a unique and strong commercial impression which distinguishes the applied-for marks from the Registered Marks. Nothing about the commercial impression created by the Registered Mark suggests or includes any reference to the concept of a dollar, or even money for that matter. Inasmuch as the marks, therefore, are visually distinct and dissimilar in spelling and certainly pronounced dissimilarly in the spoken word, it is reasonable to believe that the consuming public would perceive the marks to have different meanings and overall commercial impressions. *See, e.g., Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 2350 (Fed. Cir. 2011) (affirming the TTAB’s finding that the applied-for mark, CAPITAL CITY BANK was sufficiently dissimilar from the registered mark CITIBANK, because “(1) it starts with the word ‘Capital’ not ‘CITIBANK’, (2) ‘City Bank’ is two words, not a compound word.”). The same considerations and analysis apply here.

Applicant respectfully submits that the leading component of the applied-for marks, DOLLAR, creates a commercial impression distinct and unique from those of the Registered Marks, thereby favoring registration.

2. *The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.*

Applicant submits that the Registered Marks appear from their specimens on private, “Confidential” materials intended for those clients with an investor relationship with the owner of the Registered Marks, concerning the specific performance, operation and outlook of the marks’ owner’s specific investment funds. In fact, the marks are registered specifically for unique and singularly focused financial services for the specialized and limited investor client of the marks’ owner: “venture capital funds investment advisory and management services.” Conversely, the applied-for marks are used by applicant in and on materials of general interest to common lay consumers of simple personal money management tips and information, distributed at large on the Internet through sites accessible to and widely viewed by anyone from the consuming public. Thus, although both the applied-for marks and the Registered Marks exist within the same overall International class of goods and services, the nature of the goods and services offered under both are at the extreme opposite ends of a very wide spectrum of financial information – one very specific, and tied to a specific investment fund or funds, and the other providing very basic and general strategies, tips and concepts for a lay person to use to manage his or her personal finances. Nowhere within applicant’s scope of goods or services will one find “venture capital funds investment advisory and management services” offered, if for no other reason than applicant is not even licensed or qualified to provide such goods or services. The nature of the goods and services therefore diverge widely because they are tailored to consumer bases at very different ends of a broad spectrum.

Notwithstanding the already perceived distinction between the goods and services covered by the Registered Marks and the applied-for marks, applicant is submitting a

proposed amendment of its goods and services to further clarify the distinction of goods and services from those covered by the Registered Marks.

3. *The similarity or dissimilarity of established, likely-to-continue trade channels.*

Applicant submits that, following from the prior factor, the trade channels of distribution for the goods or services provided under the Registered Marks are as widely separated from those through which applicant offers its goods or services as are the consumer bases for such goods or services. The Registered Marks cover goods and services designed for investor clients of an investment fund management company, which goods or services will be delivered privately, directly and exclusively to such clients, under the “Confidential” designation seen in the specimen. In contrast, applicant’s goods or services are offered openly and freely to all members of the consuming public, through open and obvious methods of Internet advertising and distribution, including through social media. It is apparent that the goods and services offered as “Confidential” under the Registered Marks would not be so widely distributed and made publicly available in that same fashion.

Applicant therefore believes the very different manner of delivery of such goods and services further distinguishes the marks and favors registration.

4. *The number and nature of similar marks in use on similar goods.*

Applicant submits that, in addition to the Registered Marks, U.S. Registration No. 4602966, for the mark SPROUT, was allowed in International Class 036 for “banking and financing services,” over the Registered Marks. Additionally, applicant notes the following other third-party uses of the mark or brand “SPROUT” for varying financial service offerings that similarly would fall within International Class 036 for registration:

Sprout Financial Inc.	https://savewithsprout.com/
Sprout Financial LLC	https://www.sproutfin.com/
Sprout Lending	https://sproutlending.com/
Sprout Funding	https://www.getsproutfunding.com/
Sprout Financial Inc.	https://www.inc.com/profile/sprout-financial
Sprout Mortgage	https://www.sproutmortgage.com/
Sprout Personal Finance Manager	https://www.ccuky.org/accounts/sprout.php

Each of these existing brands and marks, used on goods and services connected to the field of finance, banking or investment services, demonstrates that the Registered Marks, SPROUT and SPROUT GROUP are not so uniquely situated in their relevant industry to be entitled to a degree of protection from newcomers as dissimilar as the applied-for marks, DOLLARSPROUT. *See, e.g., Miguel Torres, S.A. v. Bodegas Muga, S.A.*, 176 F. App'x 124 (Fed. Cir. 2006) (upholding dismissal of a trademark opposition finding evidence of numerous third-party uses of the word “torre” in the names of wines probative of the fact that the mark-holder did not occupy such a unique position in the industry to exclude others from incorporating the same or similar word).

Applicant believes the dilution that already exists in the relevant financial field for marks and brands containing the term SPROUT favors registration of applicant's dissimilar marks, DOLLARSPROUT, over any claim of protection by the Registered Marks. In fact, a similar Internet search for the terms "Dollar Sprout" produced only one noteworthy use of that brand: applicant's own website and related social media sites, <https://www.dollarsprout.com/>.

5. *The nature and extent of any actual confusion.*
6. *The extent of potential confusion, i.e., whether de minimis or substantial.*

Addressing the last two du Pont factors of relevance jointly, applicant notes that it is unaware of any evidence of actual confusion between its uses of the applied-for marks and the Registered Marks, most likely due to the limited channels of commercial distribution available for the goods and services under the Registered Marks and the relatively high degree of sophistication of the consumers of the goods and services covered by the Registered Marks, as compared to those for the applied-for marks. Further, for the same reasons, it is unlikely that any potential confusion will exist, or that if any does exist, it will be more than *de minimis* as the consumers of the goods and services offered under the Registered Marks are more sophisticated users of financial services and likely would dismiss the goods and services offered under the applied-for marks as not relevant to them.

Applicant therefore submits that these considerations of the nature and extent of any actual or potential confusion favor registration of the applied-for marks.

2. ENTIRE MARK DISCLAIMED

Registration of the applied-for marks was refused because applicant has disclaimed the entire applied-for mark. Applicant seeks to amend its application to withdraw the disclaimer.

We trust the foregoing is fully responsive to the Office Action in each of the referenced applied-for marks and adequately addresses the bases for rejection of the applications for registration in a manner that will overcome such rejections.

If you have any further questions, please do not hesitate to contact the undersigned attorney of record for applicant directly.

Very Truly Yours,

THE CREEKMORE LAW FIRM PC



James R. Creekmore