

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Trademark Application of:	§	
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Good Sportsman Marketing, LLC.	§	Trademark Law Office No.: 118
	§	
Serial No.: 88366079	§	Examining Atty: Katherine DuBray
	§	
Filed: April 01, 2019	§	Attorney Docket No.: GSM042TM
Mark: SPOT SHOT		International Class No.: 009

RESPONSE TO OFFICE ACTION DATED JUNE 12, 2019

Dear Examining Attorney DuBray,

The Office Action of June 12, 2019 has been received and its contents carefully noted. The Office Action refuses registration stating that the subject mark, SPOT SHOT, may be potentially refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with prior filed application, Ser. No. 88176636 for SHOTSPOTZ (“the cited mark”). In addition, the Office Action states that the identification of goods is indefinite and must be clarified.

In response, Applicant herein submits arguments against the likelihood of confusion rejection and adopts the suggested proposed identification of goods herein.

I. IDENTIFICATION OF GOODS

Current Identification of Goods: The current identification of goods for the above-referenced trademark application is as follows: “*Cameras, namely, scope mountable WiFi-enabled video cameras and still cameras; and downloadable software in the nature of a mobile application for video and still cameras,*” in International Class 009.

Proposed Clarification of Identification of Goods: Applicant proposes to clarify the identification of goods, as requested by the Examining Attorney, as follows: “Cameras, namely, scope mountable wireless local area networking enabled video cameras and still cameras; and downloadable software in the nature of a mobile application for organizing and editing photos for video and still cameras,” in International Class 009.

Applicant respectfully requests that the Examining Attorney enter these amendments to the identification of goods.

II. NO LIKELIHOOD OF CONFUSION UNDER DU PONT

In determining likelihood of confusion under Section 2(d), the marks must be considered in their entirety and in relation to the goods identified in the application and registration. *See Opryland U.S.A., Inc. v. Great American Music Show, Inc.*, 970 F.2d 947 (Fed Cir. 1992) (marks must be viewed as a whole). There is no established rule that a likelihood of confusion is to be found whenever goods of the same general category are sold under the same or similar marks. Each case must be decided on its own facts.

The landmark decision in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973), provides a guide in determining whether there is a likelihood of confusion between Applicant’s mark and the Registrant’s mark. The *du Pont* case enumerates thirteen different factors¹ that are to be considered in an analysis of the

¹ The thirteen *du Pont* factors are:

- 1) The similarity of dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- 2) The similarity of 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;
- 3) The similarity of dissimilarity of established, likely-to-continue trade channels;
- 4) The conditions under which and buyers to whom sales are made, *i.e.*, “impulse” vs. careful, sophisticated purchasing;

question of likelihood of confusion. All factors in an analysis should be taken into account. *du Pont*, 476 F.2d at 1361.

Of the thirteen *du Pont* factors, the factors raising issues in this case are dissimilarities of marks in their entirety as to appearance, sound, connotation and commercial impression, the dissimilarity of the goods associated with the marks, conditions under which sales are made, different channels of trade, and the lack of fame of the cited mark. These with the other *du Pont* factors, which, together with the analysis below, favors a finding against *likelihood of confusion*.

A. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression

Applicant's mark is dissimilar to the cited mark in its entirety as to appearance, sound, connotation and commercial impression. *See, In re Bed & Breakfast Registry*, 791 F.2d 157 (Fed. Cir. 1986), wherein the court concluded that the two marks "Bed & Breakfast Registry" and "Bed & Breakfast International" were not confusingly similar in either sound or appearance, even though both marks were used for similar services and contained identical partial components. Even the dominant and identical portions of the marks "Bed & Breakfast Registry" and "Bed & Breakfast International," as applied to identical goods and services did not constitute consuming similarity.

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- 5) The fame of the prior mark (sales, advertising, length of use);
 - 6) The number and nature of similar marks in use on similar goods;
 - 7) The nature and extent of any actual confusion;
 - 8) The length of time during and condition under which there has been concurrent use without evidence of actual confusion;
 - 9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark);
 - 10) The market interface between applicant and the owner of a prior mark....;
 - 11) The extent to which applicant has a right to exclude others from use of its mark on its goods;
 - 12) The extent of possible confusion, *i.e.*, whether *de minimis* or substantial; and
 - 13) Any other established fact probative of the effect of use.

Also, the Trademark Trial and Appeal Board dismissed an opposition to an application filed by Georgallis Holdings, LLC to register MAYARI for use on wine because it found that the plaintiff's registered mark MAYA and Georgallis's applied-for mark MAYARI were not confusingly similar. See *Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, No. 91211612, 2015 TTAB 228, 2015 WL 4573202 (T.T.A.B. July 16, 2015).

In this case, unlike the marks “Bed & Breakfast Registry” and “Bed & Breakfast International”, or the marks “MAYA” and “MAYARI” there is an even greater dissimilarity between the cited mark and the applied for mark.

A side by side comparison of the marks, as shown below, clearly displays the distinctive commercial impression and connotation of the marks:

SPOT SHOT and SHOTSPOTZ

In the case of In re Hearst Corporation, 982 F.2d 493 (Fed. Cir. 1992), the Federal Circuit Court of Appeals stated:

“Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight. (Citations omitted.) . . . By stressing the portion “varga” and diminishing the portion “girl”, the Board **inappropriately changed the mark.**” (Emphasis added.)

In re Hearst Corporation, 982 F.2d, at 494.

The focus of the comparison must not inappropriately change the mark. The Applicant's mark, **SPOT SHOT** consisting of two distinct words cannot be compared to the improperly dissected unitary mark **SHOTSPOTZ**. This impermissibly alters Applicant's mark for this important consideration. **SPOT SHOT** must be compared in its

entirety to **SHOTSPOTZ** to note their vast dissimilarities. *See, e.g., Freedom Sav. & Loan Ass'n*, 757 F.2d at 1183 (“Freedom Savings and Loan” and “Freedom Realty” marks “lack. . . of confusing similarity”); *Sun Banks*, 651 F. 2d at 316 (“Sun Federal and Savings Loan Association” not confusingly similar to “Sun Banks”); *Amstar*, 615 F.2d at 260 (“Domino’s Pizza” not similar to “Domino sugar”); *Bell Laboratories, Inc. v. Colonial Prods., Inc.*, 644 F. Supp. 542, 547 (S.D. Fla. 1986) (“Final flip” and “Flip” marks for same product are “ultimately different and different sounding”); *In re Hearst Corp.*, 982 F.2d 493, 494 (Fed. Cir. 1992) (“Varga girl” and “Vargas” are “sufficiently different in sound, appearance, connotation, and commercial impression to negate likelihood of confusion”); *Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co.*, 781 F. 2d 884, 888 (Fed. Cir. 1986) (“Romanburger” and “Roman” marks for food products “are not similar in appearance”); *Little Caesar Enterprises*, 834 F.2d 568, 571 (“Pizza Caesar U.S.A.” not similar to “Little Caesar’s”); *Conde Nast Pubs., Inc. v. Miss. Quality, Inc.*, 507 F.2d 1404, 1407 (CCPA 1975) (“Country Vogues” and “Vogue publications” “do not look or sound alike”); *Pacquin- Lester Co. v. Charmaceuticals, Inc.* 484 F.2d 1384 (CCPA 1973) (“Silk ‘n’ Satin” beauty and bath lotion and oil not similar to “Silk” face cream).

In a similar case, the Tenth Circuit held that "Generic Value Products" was not similar to GENERIX. [Sally Beauty Co., 304 F.3d at 972-73](#). One mark consisted of three words, the other mark only one. [Id. at 972](#). Moreover, the sound of the marks was different: Generic Value Products did not sound like GENERIX. [Id. at 973](#). The court noted that the marks conveyed a similar meaning—that the products were inexpensive—but this was insufficient to conclude that a reasonable jury could find that the marks were

similar. *Id.* The court also held that the district court erred when it shortened Generic Value Product to Generic to compare the aural similarities between the marks. *Id.*

SPOT SHOT is dissimilar in appearance to **SHOTSPOTZ**. Visually, **SPOT SHOT** is entirely distinct from **SHOTSPOTZ**. As is evident here, the applied for mark consists of two distinct words. The first word is “SPOT” which is clearly visually differently from “Shot”. Further the second word of the applied-for mark does not end in a “Z”. Also, as evident here, SHOTSPOTZ contains no spacing. As such, the two marks are visually distinct.

Also, there is no question that SPOT SHOT is entirely dissimilar in its sound from SHOTSPOTZ. SHOT is pronounced first in the cited mark – this sounds different from the word SPOT in the applied-for mark. Further, the second word of the applied-for mark, “SHOT” does not end in the letter “Z”. Also “Shot” is pronounced very differently from the letters “Spotz”. As such, the two marks are also pronounced very differently.

Any potential of likelihood of confusion between SPOT SHOT and the cited mark, SHOTSPOTZ does not exist without a complete disregard of the letter Z in the cited mark as well as the fact that SHOT is pronounced first in the cited mark. These are two important components of the cited mark. The pronunciation which is to be given to a trademark is one which would be found in a common sense real world application, rather than a constrained and stretched approach. This constrained pronunciation is inadequate as a matter of law, to establish a likelihood of confusion between SPOT SHOT and the cited mark when the marks are considered “side-by-side” and in their entirety. “The marks are examined in their entirety, rather than simply by comparison of the similar terms or dominant features.” *Michael Caruso & Co.*, 994 F. Supp. at 1460. *See also, e.g.*,

In re National Data Corp., 753 F.2d 1056, 1058 (“[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of the mark.”); *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of action.”).

Based on the above, Applicant respectfully suggests that the applied for mark, SPOT SHOT is not similar, and the mark is certainly not *confusingly* similar to cited mark SHOTSPOTZ, when viewed as a whole. Also, in terms of their commercial impressions, these marks are distinctive enough to dispel any real risk of confusion.

B. The Goods at Issue are Unrelated

The nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. *See, e.g.,* Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). Since the Applicant has clarified the nature of the goods associated with the applied for mark, Applicant submits that it would be improper to presume that it is that it is likely to cause confusion with the aforementioned cited registration and applications in Class 009.

Applicant respectfully submits that the class 009 goods provided under the cited registration for SHOTSPOTZ (*Downloadable software in the nature of application for users to rate photographic locations and related photographic content,*) are unrelated to those provided under the Applicant's mark in class 009. The goods provided under the Applicant's mark (*scope mountable **wireless local area networking enabled video cameras and still cameras; and downloadable software in the nature of a mobile application for organizing and editing photos for video and still cameras***) are strictly limited to camera goods namely mountable scopes and applications associated with video and still camera photo editing.

Goods are considered to be proximate or related if they "are similar in use and function," and "would be reasonably thought by the buying public to come from the same source if sold under the same mark." [*See AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 \(9th Cir. 1979\), 599 F.2d at 348 n.10, 350](#) (quoting [*Standard Brands, Inc. v. Smidler*, 151 F.2d 34, 37 \(2d Cir. 1945\)](#)); [*Fleischmann Distilling Corp. v. Maier Brewing Co.*, 314 F.2d 149, 159 \(9th Cir. 1963\)](#)).

Software for rating photos is not "similar in use and function" to mountable scopes and applications associated with video and still camera photo editing. Therefore, Applicant respectfully submits that the respective goods are not only dissimilar, they are also unrelated. Applicant's mark is not filed in connection with photo rating software. Applicant's mark is also not filed in connection with any software goods which could be considered related to the Registrant's goods.

Given the dissimilarity of the goods provided under each mark, Applicant respectfully submits that no likelihood of confusion would exist with respect to the source of the goods.

C. The conditions under which and buyers to whom sales are made

Moreover, taking into account another relevant *du Pont* factor, the conditions under which and buyers to whom sales are made, *i.e.* "impulse" vs. careful, sophisticated purchasing, Applicant respectfully submits that purchasers of Applicant's goods would carefully consider their purchases. Therefore, the "discriminating purchaser" standard is appropriate for this likelihood of confusion determination.

While purchasers may exercise care in the purchase of a *downloadable app for users to rate photographic locations content* (for example, SHOTSPOTZ goods), Applicant respectfully submits that the degree of care exercised in these purchases is significantly lower than that exercised in the purchase of mountable camera scopes and apps for editing video and still camera photos, as in the case of Applicant's goods. The nature and expense of the Applicant's custom goods would ensure that its purchasers would be educated and careful purchasers. They are not likely to confuse the sources of downloadable apps for rating photos and mountable camera scopes and apps for editing video and still camera photos.

It is well-settled that the likelihood of confusion is reduced where purchasers and potential purchasers of the products or services are sophisticated. *See Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 718 (Fed. Cir. 1992) (no confusion between identical marks where, *inter alia*, both parties' goods and services "are


usually purchased after careful consideration by persons who are highly knowledgeable about the goods or services and their source.”). *See also* TMEP § 1207.01(d)(vii) (care in purchasing tends to minimize the likelihood of confusion). “In making purchasing decisions regarding expensive goods, the reasonably prudent purchaser standard [that is normally applied in determining likelihood of confusion] is elevated to the standard of the ‘discriminating purchaser.’” *Weiss Associates v. HTL Associates Inc.*, 14 U.S.P.Q.2d 1840, 1841-42 (Fed. Cir. 1990). Accordingly, where products are expensive, confusion is unlikely because the purchase is made after careful consideration in which the purchaser would be likely to become aware of the different sources of the products. *See generally* 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:96 (4th ed. 1998).

Accordingly, there is no real potential that the relevant purchasers would be confused as to the source of the parties’ respective product and services.

Given these differences, it is highly unlikely that Applicant’s and Registrant’s respective products would be encountered by the same purchasers or under circumstances that could give rise to the mistaken belief that those goods and/or services came from a common source.

D. The variety of goods on which a mark is or is not used

Applicant also submits that there is co-existence of marks containing the term SPOT and/or SHOT on the USPTO register in multiple classes on a variety of goods further proving that the term “SPOT” and “SHOT” are not unique to the owners of the cited marks:

Mark	App.No/Reg No.	Owner	Goods
SHOT SPOTZ	3917727	Bring It Incorporated	<i>Class 028: Action skill games.</i>
	3758944	CRC FAMILY HOLDINGS, INC	<i>Class 009: Quick change mounts for camera tripods.</i>

Exhibits A and B are attached for copies of the registrations referenced above. Applicant acknowledges that evidence of third-party registrations and of positions the Office has taken in prior cases is not conclusive or binding on the Trademark Office in this case, but respectfully urges that when exercising discretion in this case, the Trademark Office should at least afford the foregoing substantial weight. In particular, this evidence is relevant not only in the way that it demonstrates the general nature of Applicant's mark, but especially because it demonstrates the manner in which the public views marks that are similar in this regard.

Moreover, in addition to co-existence on the USPTO register, these and other identical and similar marks co-exist in the marketplace for other goods in related fields.

See, e.g.:

Mark(s)	Source	Description
SPOTSHOT	https://www.spotshot.io/#how-it-works	<i>Mobile app for creating sharing and celebrating challenges</i>
SHOT SPOT	https://www.shotspotllc.com	<i>Gun Range</i>
SHOT SPOT	http://www.shotspot.co.uk/	<i>Aim and eye dominance correction</i>

Exhibits C-E are attached for copies of the webpages referenced above.

In comparing Applicant's mark with previously registered or pending marks, one factor that must be considered is the impact of prior registrations or prior filed marks on the strength of the registered marks. TMEP § 1207.01 ("In testing for likelihood of confusion under Sec. 2(d), therefore, the following, when of record, must be considered: . . .6. The number and nature of similar marks in use on similar goods.")

In light of the foregoing evidence that many entities have used SPOT and/or SHOT based marks in connection with various goods, it would be disingenuous to claim that the cited marks are strong marks. "[I]n a 'crowded' field of similar marks, each member of the crowd, is relatively 'weak' in its ability to prevent use by others in the crowd." J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 11:85 at 11-163 (4th Ed. 2001). Accordingly, the cited marks should be given a narrow scope of protection, in light of their coexistence, barring registration of only virtually identical

marks. As such, since Applicant's mark is not virtually identical to the cited marks, it too is entitled to a narrow scope of protection.

Lastly, the overall weakness of the terms SPOT and SHOT, makes Applicant's mark unlikely to cause confusion.

"It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks." *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (C.C.P.A. 1958). In this case, the owners of the cited marks adopted weak marks, and thus should be afforded a narrow scope of protection.

If the common element of two marks is "weak" in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d, 1338-40 (Fed. Cir. 2015).

Therefore, for all the aforementioned reasons, Applicant respectfully submits that there is no likelihood of confusion between its mark and the cited mark.

E. The Cited Mark Is Not Famous

There is no evidence of record that the cited mark is famous or that it has been used for so long that they should be entitled to broad protection. As a consequence, this factor suggests that confusion between Applicant's mark and the cited mark is not likely. *See, e.g., In re E.I. du Pont de Nemours & Co.*, 476 f.2d at 1361, 177 U.S.P.Q at 567.

F. Other Probative Evidence Supports the Conclusion that Confusion Between Applicant's Mark and the Cited Mark is Unlikely

“[C]ourts regularly include intent as one of the factors to be assessed in evaluating likelihood of confusion” *Restaurants (Third) of Unfair Competition*, § 22 reporter's note to comment b (Tent. Draft No.2, March 23, 1990). *See general 2 J. McCarthy, Trademarks and Unfair Competition*, 23.24[1][b], at 23-155 (3d ed. 1992) (“Intent is relevant to determination of a likelihood of confusion”).

In this instance, Applicant was unaware of and had no intent to trade upon the registrant's reputation in adopting its mark.

Applicant also submits that the mere possibility that relevant purchasers might relate the two different marks does not meet the statutorily established test of likelihood of confusion. 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") (emphasis added).

In light of all of the arguments made herewith (dissimilarity in entirety and appearance, differences in commercial impression, consumer sophistication, and lack of overlap in market interface, etc.), Applicant respectfully submits that the possibility of confusion is negligible, or limited, if any.

Accordingly, the applications of the cited mark should not cause a bar to registration of the Applicant's mark.

CONCLUSION

In light of all of the arguments made herewith, Applicant respectfully submits that the possibility of confusion is negligible, or limited, if any. Allowance of the mark in Class 009 is respectfully requested.

Respectfully submitted,

/Usha Menon/

Usha Menon
Attorney, Texas Bar Member
D'Ambrosio & Menon, PLLC.
Email: umenon@dmiplaw.com

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