

NO LIKELIHOOD OF CONFUSION OR MISTAKE

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 has only addressed two of the 13 du Pont factors:

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

A. The cited marks and the Applicant's mark are different as a whole in their entirety.

Applicant seeks to register the mark:



Applicant seeks to register the entire mark as a whole, not just a part of it and not just the words portion.

The cited marks (all co-existing) are:

- "SPARTAN DIET"
- "SPARTAN MENTAL TRAINING"

- “SPARTAN MENTAL TOUGHNESS”
- “SPARTAN PSYCHOLOGY AND WELLNESS”

Although the cited marks contain the same word, that is not the end of the enquiry nor is it fatal. 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).

The Marks are Distinguishable based on Sight and Sound

As to sight, "the relevant inquiry is whether a particular trademark, when viewed alone, would lead to uncertainty about the goods or services that it identifies." Therma-Scan, Inc. v.

Thermoscan, Inc., 295 F.3d 623, 633-34 (6th Cir. 2002) (quoting Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Center, 109 F.3d 275, 283 (6th Cir. 1997) (noting that "courts must determine whether a given mark would confuse the public when viewed alone, in order to account for the possibility that sufficiently similar marks may confuse consumers who do not have both marks before them but who may have a general, vague, or even hazy, impression or recollection of the other party's mark") (internal quotation marks and citation omitted))). In analyzing this consideration, courts look to font, typeface, and design. See, e.g., Therma-Scan, 295 F.3d at 633-34; AutoZone, Inc. v. Tandy Corp., 373 F.3d 786, 796 (6th Cir. 2004).

In this instance, Applicant's mark and the cited marks are visually different on their face to any ordinary observer:

SPARTAN DIET

SPARTAN MENTAL TRAINING

SPARTAN MENTAL TOUGHNESS

SPARTAN PSYCHOLOGY AND WELLNESS



The Applicant's mark contains a starkly unique visual design and logo, make the difference obvious.

Although the Examining Attorney has proposed that the term SPARTAN creates the dominant feature of the marks, that does not mean that the remaining portions of Applicant's Mark is to be ignored. Applicant submits, that just relying on the feature of the word portion of Applicant's mark does not take into consideration the entirety of the marks themselves and does not take into consideration the actual distinctions between the cited marks with multiple extra words and meanings and Applicant's mark.

As to sound, courts consider the number of syllables, position of similar syllables, and pronunciation of the marks. See A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc., 237 F.3d 198, 217 (3d Cir. 2000). Courts have also looked to different stress patterns and other further sophisticated phonetic analysis in aiding its analysis of sound. 4 McCarthy on Trademarks and Unfair Competition § 23:22 (4th ed.).

Applicant's mark utilizes a total of two (2) syllables in *one* word compared to the stark difference in the cited marks:

SPARTAN DIET = four (4) syllables in two words.

SPARTAN MENTAL TRAINING = six (6) syllables in three words.

SPARTAN MENTAL TOUGHNESS = six (6) syllables in three words.

SPARTAN PSYCHOLOGY AND WELLNESS = nine (9) syllables in four words.

It is undisputable therefor that the marks also differ in pronunciation and sound. The cited marks are hard and take longer to pronounce, i.e., they are *different*.


In addition, there are other benefits to be achieved by considering these marks in their entireties. As stated by McCarthy, *McCarthy on Trademarks and Unfair Competition, Fourth Ed.* §23:41:

Where there are both similarities and differences in the marks, these must be weighed against one another to see which is predominant.


The rationale of the anti-dissection rule is based upon this assumption: "An average purchase purchaser does not retain all the details of a mark, but rather the mental impression the mark creates in its totality." It has been held to be a violation of the anti-dissection rule to focus upon the "prominent" feature of a mark and decide likely confusion solely upon that feature, ignoring all other elements of the mark. Similarly, it is improper to find that one portion of a composite mark has not trademark significance, leading to a direct comparison between only that which remains. [citations omitted.]

Limiting the consideration of Applicant's mark and the cited mark to Applicant's word portion alone eliminates further consideration of the additional terms in the cited marks. By essentially ignoring the entire marks in the consideration of likelihood of confusion, the Examining Attorney is improperly dissecting and limiting the full scope of consideration in determining whether confusion between the cited marks and Applicant's mark is likely.



Just because Applicant's mark and the cited mark have a single word in common does not mean the marks look the same, or are likely to be, confused when considered overall in their entireties.

While it is often true that the words in a composite word and design mark are considered to be dominant, that is not always the case. In Viterra, the Federal Circuit acknowledged this general rule while affirming a Board decision that found the dominant portion of the registered mark  was the literal portion (XSEED) rather than the stylized letter "X" alone, but it also found no inconsistency between the Board's Viterra decision and its earlier decision in In re White Rock Distilleries, Inc., 92 USPQ2d 1282, 1284 (TTAB 2009), wherein the Board found no likelihood of confusion between applicant's standard character mark VOLTA for caffeine-infused vodka and the cited mark for wines, **due to the prominent design** in the registered mark:



See also Ferro Corp. v. Ronco Labs., Inc., 356 F.2d 122, 124, 148 USPQ 497, 498-99 (CCPA 1966) (confusion was unlikely between applicant’s mark  and several marks owned by opposer consisting of or containing FERRO, **due to the dominance of the design elements** of applicant’s mark and the relatively small typeface in which FERRO appeared); *accord* Parfums de Coeur Ltd. v. Lazarus, 83 USPQ2d 1012 (TTAB 2007) (**prominently displayed**



design considered to be dominant element of the  **mark** because it catches the eye and engages the viewer before the viewer looks at the word “Bodyman”); Steve’s Ice Cream v. Steve’s Famous Hot Dogs, 3 USPQ2d 1477, 1478-79 (TTAB 1987) (no likelihood of confusion between  for restaurant services and STEVE’S for ice cream; “Even

with the word ‘STEVE’S’ appearing above the hot dog figures, applicant’s mark is distinguishable from the registered mark of opposer, which is simply the word ‘STEVE’S’ in block letter form.”).

With these considerations in mind, it is submitted that it is improper under the present circumstances to dissect the marks to reach the result that the single word SPARTAN is the most prominent feature found in Applicant’s mark, when in fact the helmet design logo is the first portion of the Applicant’s mark and also a dominant feature. The marks are vastly

dissimilar as to sight. Applicant's mark is dominated by its design logo feature, and this weighs heavily against a conclusion that confusion is likely.

Different Meanings and Impressions

Nor by any stretch do the respective marks share the same meaning or commercial impression. The mark



does not mean “DIET”, “MENTAL”, “PSYCHOLOGY” or “WELLNESS”.

Therefore, it is requested that the Examining Attorney further consider the cited marks and Applicant’s mark in their entirety, and fully consider the clear connotation and mental impressions created by the cited marks and Applicant’s mark. With such consideration, it is submitted that no likelihood of confusion will be found and the refusal to register should be withdrawn.

B. The services are unrelated.

Applicant’s services, as amended, are: PROVIDING A WEBSITE FEATURING INFORMATION ON NUTRITION TO ACHIEVE IMPROVED HEALTH OUTCOMES.

These are not similar to the services of the co-existing cited marks, namely “Counseling services” in the fields of holistic health, nutrition and lifestyle wellness; Anti-smoking therapy; Consulting services in the field of mental health and wellness; Health care services, namely, wellness programs; Hypnosis services; Providing a web site featuring information in the field of mental health and wellness; Providing smoking cessation treatment services; Providing weight loss

program services; Psychological consultation; Psychological counseling; Psychological counseling in the field of behavioral consulting services, namely, sports psychology and athletic performance, mental training, psychotherapy and hypnosis; Providing weight loss, smoking cessation, personal health, fitness and wellness programs; Providing a website featuring information and general advice in the above areas; Psychological counseling services in the field of sports; Psychotherapy services; Services of a psychologist; Weight management services, namely, providing weight loss and/or weight maintenance programs; Anti-smoking therapy; Hypnosis services; Mental health therapy services; Psychological counseling; Psychological consultation; Psychological counseling in the field of behavioral consulting services, namely, sports psychology and athletic performance, mental training, psychotherapy and hypnosis; Psychological counseling services in the field of sports; Psychotherapy services; Weight management services, namely, providing weight loss and/or weight maintenance programs; Consulting services in the field of mental fitness; Consulting services in the field of mental health and wellness; Consulting services in the field of sports psychology; Consulting services in the field of sports psychology; Hypnosis services; Psychological consultation; Psychological counseling; Psychological counseling in the field of behavioral consulting services, namely, anxiety and depression treatment, psychotherapy and hypnosis; Psychological counseling in the field of sports psychology and athletic performance, namely, mental training and mental toughness; Psychotherapy services; Services of a psychologist; Anti-smoking therapy; Hypnosis services; Mental health therapy services; Providing smoking cessation treatment services; Providing a website featuring information in the field of sports psychology and athletic performance, mental training, wellness and personal health; Psychological counseling; Psychological counseling services in the field of sports; Psychological counseling in the field of behavioral consulting

services, namely, sports psychology and athletic performance, mental training, psychotherapy and hypnosis; Psychological consultation; Psychotherapy services; Services of a psychologist; Weight management services, namely, providing weight loss and/or weight maintenance programs; Consulting services in the field of mental fitness; Consulting services in the field of mental health and wellness; Consulting services in the field of sports psychology.”

Plainly, on their face, the Applicant’s services are not the *same*. Nor are they so related the consumers would consider the services of Applicant as emanating from the same source as the cited marks. To be related, services must be consumed in such a way that buyers are likely to believe that all of the services 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 services for real estate brokers under HMS and real estate brokerage services under HMS HOME MARKETING SPECIALISTS).

Put simply, a trademark registrant’s rights do not extend in gross to all products and services. 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).

Determining the similarity of goods 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).

C. The trade channels and industries are different.

The respective services under each mark are targeted to and rendered to very different consumer bases and categories, and the parties, and the respective goods, operate in separate trade channels and industries do not compete with one another. The prior registrants target and market to individuals and groups of people interested in counseling and a psychologist, neither of which are the same target or market consumer class as Applicant’s amended services for providing information on a website. Moreover, because of the highly personal nature of counseling and psychology services, the consumers of such different services will be keenly aware of the source of such services; they require personal interaction with the source provider, making confusion and mistake as to source or origin of such services nearly impossible. No one going to a website that has information about nutrition is going to think that information posted in the same as counseling or going to see a psychologist.

D. The conditions of sale mitigate against risk of confusion or mistake.

The more sophisticated and knowledgeable the purchasers, the less likely it is that those purchasers will be confused by similar marks. Dynamics Research Corp. v. Langenau Mfg. Co.,

704 F.2d 1575, 217 U.S.P.Q. 649 (Fed. Cir. 1983) (No likely confusion found in sale of industrial parts); Electronic Design & Sales, Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 718, 21 U.S.P.Q.2d 1388 (Fed. Cir. 1992) (No likelihood of confusion where plaintiff sold “E.D.S.” computer services to experienced corporate officials while defendant sold “EDS” power supplies and battery chargers; Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc., 269 F.3d 270, 286, 60 U.S.P.Q.2d 1609, (3rd Cir. 2001) (no likelihood of confusion between CHECKPOINT for electronic surveillance and theft detection systems and CHECK POINT for expensive corporate computer firewall security programs, because of their high costs, consumers take care in making purchasing decisions and are not likely to be confused by the parties' similar marks”); Calypso Technology, Inc. v. Calypso Capital Management, LP, 100 USPQ2d 1213 (TTAB 2011) (CALYPSO for “equity investment management and fund services” and CALYPSO for “computer software for use by financial institutions for core processing and control” not likely to cause confusion, because the expense of the services and the sophistication of the customers outweighed the other relevant factors, including the similarity of the marks).

Counseling and psychology services are usually purchased after careful consideration by persons who are highly knowledgeable about their selection. No consumer buys time with a counselor or a psychologist as an impulse purchase. The prices for such services are also generally very expensive.

The high prices for counseling and psychology services means that consumers of such services are sophisticated purchasers who will be more deliberate about their purchasing decision and are extremely unlikely to make a mistake in their purchasing decision as to the source of the services.

CONCLUSION

For these reasons, the Examining Attorney should respectfully withdraw the refusal 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 registrations 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.