

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<b>Mark:</b> SPArtan	<b>Examiner:</b> Jill Prater
<b>Serial No.:</b> 88/464,610	<b>Docket No.:</b> 15861.019
<b>Filing Date:</b> June 7, 2019	

## RESPONSE TO NON-FINAL OFFICE ACTION

This communication is in response to the non-final office action dated September 4, 2019 (the "Office Action"), in which the Examining Attorney refused registration on the grounds that (i) the applied-for mark creates a likelihood of confusion under Trademark Act Section 2(d) with U.S. Reg. No. 755,792 ("Registration"); and (ii) the recitation of goods is indefinite under TMEP § 1402.01. For the reasons explained below, Applicant respectfully traverses the Examining Attorney's refusal to register the applied-for mark, and Applicant offers the following arguments and evidence in support of passage for publication.

### Amendment to the Description of the Mark

Please amend the description of the mark as follows:

(*markup*): The mark consists of ~~standard characters, without claim to any particular style, size, or color.~~ the word "spartan" with capital letters "SPA" followed by the remaining lower case letters "rtan."

(*clean*): The mark consists of the word "spartan" with capital letters "SPA" followed by the remaining lower case letters "rtan."

### Amendment to the Recitation of Goods

Please amend the recitation of goods as follows:

(*markup*): Metal hardware for securing wood framed walls to concrete foundations, namely, sill plate anchors ~~anchor assemblies.~~

(*clean*): Metal hardware for securing wood framed walls to concrete foundations, namely, sill plate anchors.

As amended, these goods are referred to herein as "Applicant's Goods."

## **No Likelihood of Confusion**

Analysis of the relevant *DuPont* factors show that there is no likelihood of confusion between the applied-for mark and the Registration. The Office Action based the Section 2(d) refusal on two predominant *DuPont* factors: the similarity of the marks, and the relatedness of the goods. However, in view of the facts and circumstances relevant to Applicant and the Registrant, third party use is also an important *DuPont* factor.

### *Dissimilarity of the Marks*

Differences in stylization between Applicant's mark and the registered mark is a factor that weighs against a likelihood of confusion. "A design is viewed, not spoken, and a stylized letter design cannot be treated simply as a word mark." *In re Electrolyte Labs., Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990) (quoting *In re Burndy*, 300 F.2d 938, 940 (CCPA 1962)).

Applicant's mark is "SPArtan," with the capital letters "SPA" dominating the remainder of the term. The capitalized style of "SPA" in Applicant's mark stands for "Sill Plate Anchor." This stylization promotes a distinct meaning and a unique commercial impression in relation to Applicant's Goods.

By contrast, the Registration is for "spartan" with no particular stylization. There is therefore no stylized element that creates a unique or particular commercial impression in relation to the goods recited in the Registration. There is nothing in the Registration that suggests or alludes to sill plate anchors or to any other goods that can be indicated with the letters S-P-A. In this case, Applicant's mark differs from the Registration in both sight and meaning, and the *DuPont* factor of similarity in the marks weighs against a likelihood of confusion. These differences in the marks are magnified in view of the evidence of widespread third-party use discussed below.

### *Dissimilarity of the Nature of Goods*

Applicant's Goods are sill plate anchors for securing wood framed walls to a concrete foundation. In a common construction technique, a concrete foundation supports a wood-frame structure of a building. The wood frame has vertical wooden support members resting on a bottom wooden horizontal member. This horizontal member is called a "sill plate." The sill plate is in direct contact with the concrete foundation. Sill plate anchors are used to securely connect the horizontal wooden member to the concrete foundation in a manner that resists pull-up forces caused by wind and earthquakes, and resists shear forces caused by wind, earthquake, and temperature-related loads. The sill plate anchor bolts are embedded into the concrete foundation, and they protrude up and through the sill plate of the wooden frame, thereby holding the entire building frame securely in place. To resist the large structural forces, the sill plate anchors are made from structural grade metal. Sill plate anchors made from lower-grade metals are susceptible to failure under large structural loads.

By contrast, the goods recited in the Registration are hardware used in finish carpentry, such as hardware for doors, windows, transoms, furniture, and cabinets, as well as plumbing hardware

such as shower heads and associated fittings (“Registrant’s Goods”). These goods are limited to finish carpentry and plumbing supplies. All of this hardware is made from a lower grade metal, such as zinc, brass, bronze, silicon bronze, aluminum, or lower grade steel, such as grade 305 stainless steel. None of these items are useful for, or even intended to, penetrate concrete or anchor anything to concrete. These items are different in nature, use, and performance than the sill plate anchors offered under Applicant’s mark. In short, there is no question that Applicant’s goods are of different types than, and are unrelated to, the goods recited in the Registration.

When the parties’ respective goods are of different types, relatedness of the goods can be established only by (1) demonstrating that the relatedness of the goods is well known or generally recognized, or (2) providing substantial evidence of “something more” than the mere fact that the goods are used together. TMEP § 1207.01(a)(ii); *In re St. Helena Hospital*, 774 F.3d 747, 753-54 (Fed. Cir. 2014). Applicant respectfully submits that the Office Action does not establish that sill plate anchors are generally recognized as related to hardware for doors, windows, furniture, and plumbing. The Office Action provides no evidence to establish that it is well known or generally recognized that providers of hardware for doors, windows, furniture, and plumbing also provide sill plate anchors for concrete foundations, or conversely, that the providers of sill plate anchors also provide finish carpentry and plumbing hardware.

Neither does the Office Action establish “something more,” as required by the U.S. Court of Appeals for the Federal Circuit. Instead, the Office Action finds only that the parties’ respective goods are complimentary, and therefore sufficiently related to favor a likelihood of confusion. In this case, the requisite “something more” cannot be satisfied merely by showing that Applicant’s Goods and the Registered Goods both include hardware for buildings. *See, e.g., Parfums de Coeur, Ltd. v. Lory Lazarus*, 83 U.S.P.Q.2d 1012 (TTAB 2007) (concluding that the parties’ goods and services did not weigh in favor of confusion merely because they both related to the Internet). The requisite “something more” also cannot be established by showing that the Applicant’s Goods and the Registered Goods are used or encountered by the same customers. *See, e.g., In re Coors Brewing Co.*, 343 F.3d 1340 (Fed. cir. 2003) (finding no likelihood of confusion even though the parties’ goods and services were used by the same classes of consumers). Since the Office Action provides no evidence in support of “something more” under *St. Helena Hospital* to establish the relatedness of Applicant’s Goods and Registrant’s Goods, this factor cannot weigh in favor of a likelihood of confusion.

#### *Widespread Third-Party Use Weakens the Registered Mark*

The registration is entitled to only a narrow scope of protection because of the large number of third party, use-based registrations that use various forms of the term “SPARTAN.” “[T]hird-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services.” TMEP § 1207.01(d)(iii). Attached hereto as **Exhibit A** are over two hundred use-based registrations showing such marks, more than fifty-five of which incorporate a design element or stylized font. Of these two hundred plus registrations, more than twenty-five are directly related to carpentry, cabinets, furniture, and plumbing, all of which are related to the Registered Goods. Registration certificates for these thirty-one registrations are attached hereto as **Exhibit “B.”**

