

RITCHISON LAW OFFICES, P.C.

Patents, Trademarks and Business Law

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December 17, 2020

SERIAL NO: 88843397
Law Office 117
Miah Rosenberg LaMont

Box RESPONSES
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

To: **Miah Rosenberg LaMont**
Trademark Examining Attorney c/o
UNITED STATES PATENT AND TRADEMARK OFFICE
Law Office 117
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From: **John D. Ritchison**, Attorney for the Applicant/ Respondent

RE: Response to Office Action

Dear **Miah Rosenberg LaMont**:

First, thank you for the consideration and first office action about this application. I am submitting the information and arguments below to respond and address the concerns in the latest action regarding the Trademark application for “**SPUR**”. This response is within the allotted time to respond.

Summary: Applicant will show and persuade the Examiner that the cited previously registered marks and the applicants mark vary greatly in the mark impression, uniqueness, product lines, channels of trade and sophistication of the consumer/buyers of the goods.

A. Particulars for the File are as follows:

1. Filing Date: **2020-03-22**
SERIAL NO: **88843397**
MARK: **SPUR**
APPLICANT: **SPUR BRAND LLC**
2. Date of LAST Office Action: **06/19/2020**
3. Examining Attorney's name and Law Office number:
Miah Rosenberg LaMont
Law Office 117
4. Responding Attorney's telephone number, e-mail address, and attorney's office file:
(765) 640-4134
jdritchison@comcast.net
Attorney file: JR-2020-305

B. Response to the Last Office Action Comments: Mark is likely to cause confusion, to cause mistake or to deceive. TMEP §§ 1207.1 et seq.

This is a response in detail to the specific objection of being likely to cause confusion because of similarities of the Applicant's mark, "SPUR" – Serial Number 88843397 and previously registered mark literal word "SPURR" - Registration Number 3793147. The examining attorney issues a Refusal of Registration: Likelihood of Confusion. The examining attorney refusal is based under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods/services, so resembles another mark in as it is likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 et seq.

The Registered and Applicant's Marks:

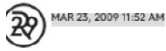
The registered mark cited is:

U.S. Registration No. 3793147 and Serial No. 77978676. This is a literal word mark "SPURR". The application claims "The mark consists of standard character without claim to any particular font, style, size, or color." The mark is without the description of any design. The plural set of R's at the end of the word is without design. The mark was first used in March of 2009. The mark is registered to Nydes-Spurr Group, LLC , a Delaware company with an auxiliary clothing line and is in International Class 018 – Leather Goods. The goods are described as "all purpose carrying bags, leather bags, and wallets." And is related to the Simon Spurr branding. The specimen was a label on a bag:



New Spurr Bags And Other Good Guy Stuff: The Trick to Looking Together Even If You're Not

COMMENTS



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The Applicant's Mark:

The applicant mark cited is Serial No. **88843397**. This mark is a literal word mark without a combination of a word with design. The literal word: SPUR. The description: The mark consists of the *literal words Spur printed with block print, the print having small curved points and the P and R having extended curved points resembling and signifying a spur on an animal such as a wild turkey*. “Color is not claimed as a feature of the mark. The mark was first used in March of 2017. The mark is registered to SPUR BRAND LLC and is in International Class 018. The goods are described as “Backpacks; Leather and imitation leather; Leather and imitation leather bags; Leather bags and wallets; Leather shopping bags; Back packs; Backpacks, book bags, sports bags, bum bags, wallets and handbags; Duffel bags; Fanny packs; Hunting bags; Military duffel bags, garment bags for travel, tote bags, shoulder bags and backpacks; Sports bags; Sports packs; Travelling bags; Waist packs.” The specimens were several, many in camo, including: - Camo pack, day pack, leather bag, wallet all with mark:



The Applicant owns other registered “SPUR” trademarks including: 5471641, 6173877, and 6173879, as well as several other pending “SPUR” applications.

Response to the Likelihood of confusion.

This concept is well developed through studies and case expansions of interpreting *In re E.I DuPont Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). *In re E.I. DuPont de Nemours & Co., Id.*, sets out numerous factors relevant to reaching a decision as to whether a likelihood of confusion exists with regard to competing marks. Each of the *DuPont* factors presents a question of fact for various areas of comparison for substantial evidence when called into question on appeal. See *Recot Inc. v. Benton*, 214 F.3d 1322, 1326-27, 54 USPQ2d 1894, 1896-97 (Fed. Cir. 2000). Further, precedent establishes that the determination of a likelihood of confusion does not require examination and findings as to each and every *DuPont* factor. See *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 352, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) (explaining that different *DuPont* factors may play dominant roles in

determining likelihood of confusion depending on the evidence in each case). In practice, the scope of examination in any particular case will ordinarily be established by the record presented by the parties. That evidence and discussion from the applicant's view is set forth for several of the separate *DuPont factors* as follows:

Test for Likelihood of Confusion

In determining likelihood of confusion under Section 2(d), the Office uses a 13-factor test originally enumerated by the CCPA in 1973. These factors (the "Du Pont" factors) and the argument as to this examination are:

(1) **The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression:** The two marks have some similarity but inherently different even to a casual eye. The marks need to be viewed as to what is claimed as well as the specimen. The Registered mark 3793147 is a single typed word. It is the last name of a fashion creator, Simon Spurr – a person. The literal word is Spurr – two Rs. The application claims “The mark consists of standard characters, without claim to any particular font, style, size, or color.” There is no claim for a design feature. What the examiner sees is the single word with two Rs. The Applicant's mark consists of a single word with several potential meanings – a spur on the back of a Turkey the claw of other birds, a western spur such as a cowboy might prod a horse, or a sports mascot for a professional team or a college/university. The mark consists of the literal words Spur printed with block print, the print having distinct curved points and the P and R having extended curved points resembling and signifying a spur on an animal such as a wild turkey. This is the design seen by the examiner. Color is not claimed as a feature of the mark.

Phonetically the marks have the same sound since there is no mention that the foreign name has rolling of the double Rs.

Applicant has a design coupled with a word. Conclusion is that the applicant mark is somewhat but not clearly distinct from the registered mark. This distinction of the pointed letters changes the commercial impression made by each of the marks.

Supporting precedence: In making her rejection as to confusing similarity, the examining attorney can point to only a portion of the mark, e.g. the phonetic similarity and a similar spelling. Therefore, this must be the main reasons used for rejection. However, applicant's complete mark is a word with the points representing a turkey claw. The “points” are different from the registrant and included as part of the claimed design. As

such *the mark must be reviewed for likelihood of confusion as a whole and should not be broken into component parts to reach a conclusion of confusing similarity*. In re Hearst Corp., 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992) (“marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight.”); In re Hearst Corp., 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992) (“When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely.”).

Conclusion: The overall impression is somewhat similar in sound and spelling but different because the Applicant has the additional design points. If this were the only factor, the rejection would be somewhat of a close call – but there are several additional and important factors to consider.

(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:

The Registered mark 3793147 is for goods in the International Code 018 – – Leather Goods. Specifically, they show fine leather bags with various labels – Simon Spurr; Spurr New York; and Spurr Bags. All show leather bags without design marks. (see samples above). All advertisements found trend to fine, high end leather bags to complement fine apparel. Leather and deerskin. The goods for the Registrant are significantly different. The Applicants goods are also in the Class 018, but the similarity ends there. The goods are described as “Backpacks; Leather and imitation leather; Leather and imitation leather bags; Leather bags and wallets; Leather shopping bags; Back packs; Backpacks, book bags, sports bags, bum bags, wallets and handbags; Duffel bags; Fanny packs; Hunting bags; Military duffel bags, garment bags for travel, tote bags, shoulder bags and backpacks; Sports bags; Sports packs; Travelling bags; Waist packs.” The specimens (see above) were several, many in camo, including: - Camo pack, day pack ,leather bag, wallet all with the SPUR mark with its distinctive design. The applicant’s main use and emphasis of the goods are bags and goods used in and around outdoor sporting events, especially hunting, boating, and fishing. The goods are also associated with apparel with camouflage and hunting outerwear apparel. Conclusion is that the applicant goods are significantly and distinctively different from the registered marks on finer, high fashion accent goods.

Supporting Precedent. Since a comparison of the goods or services in applications is based solely upon the respective identifications, it is evident that applicant’s goods differentiate its goods from those of the cited registration. Accordingly, the mark should be published for opposition. Squirtco v. Tomy Corp., 216 U.S.P.Q.2d 937 (TTAB 1983).

(3) The similarity or dissimilarity of established, likely-to-continue trade channels:

The applicant sells its goods on the internet and at trade shows for hunters and sports people. The registered mark's goods appear to be through high end department stores, fine clothing and clothing retailers. As to the internet sales, there may be overlap but people who use the internet for sales have many options and can easily distinguish the Registered goods as high-end fashion and unrelated to the applicants hunting and outdoor bags and articles with the "turkey spur" related mark. The goods are dissimilar except for the International Class 018. The person looking for high end fine leather bags would certainly have the sophistication to know the difference between hunter's bags and carriers versus leather purses and carrying totes. Further, the retail people have purchasing done for high end department stores are seasoned buyers in the companies, not consumers. This is through a sophisticated system and leaves little chance for confusion. For the internet consumers, the price of the leather goods versus the price of hunting and sport bags will easily show a difference.

Supporting Precedence: The purchase of registered goods is by sophisticated purchasers who exercise extra care with regard to purchasing such goods. In re N.A.D. Inc., 224 U.S.P.Q. 969, 971 (Fed. Cir. 1985); In re Ship, 4 U.S.P.Q.2d 1174, 1176 (TTAB 1987). And - since applicant's goods are normally purchased by consumers at sport and hunting shows or on websites with those type of products, there is little chance for confusion. The purchaser of the high-end leather goodwill takes great care before making its purchase. In re N.A.D. Inc., 224 U.S.P.Q. 969, 971 (Fed. Cir. 1985); In re Ship, 4 U.S.P.Q.2d 1174, 1176 (TTAB 1987).

Conclusion is that the applicant goods are in different trade channels than the registered mark's goods with some purchase on the internet – however, any website overlap of the trade channel is unlikely. No confusion is evident in this trade channel factor.

(4) The conditions under which, and buyers to whom, sales are made, that is, "impulse" vs. careful, sophisticated purchasing:

Some internet sales are impulse. However, as stated, people who use the internet for sales have many options and can distinguish the different marks on different websites offering distinctly different products – fine leather bags versus hunting and sport bags, often with camo designs. The consumers will exercise extra care regarding the purchase of fine leather versus the hunting and camouflaged backpacks, bags and totes. The conclusion is that any confusion of the marks is unlikely based on this factor.

(5) The fame of the prior mark (sales, advertising, length of use):

None to argue currently. However, most of the leather bags use the Simon Spurr mark or Spurr New York rather than the lone “Spurr” mark. Applicant’s mark has registrations in several other classes and is getting wide distribution in hunting and sportwear goods for various classes.

(6) The number and nature of similar marks in use on similar goods:

A search on TESS reveals that Spur has 147 (in all classes and alive). Spur in class 018 has 7 in live/ IC 018 and a total of 12 live/dead in class 018. That increases to 9 and 14 including the Spurr references. Spur has 454 marks (alive and dead) in all classes. The term Spur is a diluted mark but the turkey claw-spur “points” on the word provide a design that is much more distinctive.

Supporting Precedence: The accompanying third-party registrations are probative to demonstrate that Spur has been adopted by a number of other users as a designation. In re Dayco Products-Eagle Motive Inc., 9 U.S.P.Q.2d 1910, 1911-12 (TTAB 1988) In re Broadway Chicken Inc., 38 U.S.P.Q.2d 1559, 1566 (TTAB 1996); In re Bed & Breakfast Registry, 229 U.S.P.Q. 818 (Fed. Cir. 1986); In re J.M. Originals Inc., 6 U.S.P.Q.2d 1393, 1394 (TTAB 1987).

Conclusion: Spurr should not prevent Spur from going forward.

(7) The nature and extent of any actual confusion:

None known.

(8) The length of time during, and the conditions under which, there has been concurrent use without evidence of actual confusion:

Registered mark was first used in 2009. Applicant’s first use was March 2017. The two marks have co-existed without any known confusion or concern expressed by the registrant. If they desire, they will have time once the Application is published to Oppose. Conclusion is that there is no likelihood of confusion.

(9) The variety of goods on which a mark is or is not used (house mark, “family” mark, and product mark):

Applicant’s mark is primarily on hunting and sport bags, often with camo. Registrant’s is in fine, high fashion leather bags. This was argued above and needs no further discussion.

The type of goods is distinct. No confusion likely for this factor.

- (10) **The market interface between applicant and the owner of a prior mark:**
- (a) **A mere “consent” to register or use:**
No contact with Registrant.
- (b) **Agreement provisions designed to preclude confusion, that is, limitations on continued use of the marks by each party:**
None to argue currently.
- (c) **Assignment of mark, application, registration and goodwill of the related business:**
None to argue currently.
- (d) **Laches and estoppel attributable to owner of prior mark and indicative of lack of confusion:**
Almost four (4) years of co-existence of the marks without confusion. No conclusion.
- (11) **The extent to which applicant has a right to exclude others from use of its mark on its goods:**
Nothing to argue.
- (12) **The extent of potential confusion, that is, whether de Minimis or substantial:**
Since no known confusion has occurred, it is believed any potential confusion is de Minimis.
- (13) **and any other established fact probative of the effect of use:**
Nothing to argue.

Conclusion:

The design points as a design are not claimed by the Registrant. The goods are distinct. Spur is already diluted with many other marks SPUR (147 total live with 9 in class 018). The trademark examining attorney apparently focused mostly on the term sound and spelling. The trade channels are significantly different.

As can be seen from evidence and argument under these factors there is no likelihood of confusion.

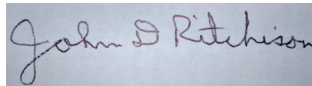
C. Response to ownership of 5471641. Declaration updated to include 5471641 6173877, and 6173879 for “Spur”.

D. Request for consideration of the above information and Continuation of the Registration Process

Applicant believes that now with the above explanations and arguments, the examining attorney’s original action fails to rise to a prima facie showing of likelihood of confusion because of the significant difference in the type of goods, different trade channels, and the apparent dilution of the mark with many other Spur marks registered. Also, the additional points representing a wild turkey claw or spur distinguishes the Applicant’s mark sufficiently to allow publication for opposition. Accordingly, the applicant requests the examining attorney withdraw this refusal. For the reasons stated above, this writer encourages the examiner to be persuaded to accept the mark for publication and to permit the process of registration to continue. Should the examining attorney have any questions, please feel free to telephone this writer direct if that will prove helpful.

Sincerely,

/John D Ritchison/



JOHN D. RITCHISON

JDR/CA

Copy: Applicant Michael Chambliss