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A042 T03079- - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 85209952

MARK: SPARTAN RAIL



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

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<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

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CORRESPONDENT'S REFERENCE/DOCKET NO:

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's final refusal to register the standard character mark SPARTAN RAIL (with RAIL disclaimed) for "firearm attachments, namely, modular external rail systems for M-16, M4 and AR15 rifles for use by military and law enforcement professionals." Registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) because there is a likelihood of confusion between the mark for which registration is sought and two prior registrations. The cited mark U.S. Registration No. 2988217, SPARTAN GUNWORKS (with GUNWORKS disclaimed) is for "firearms," and the cited U.S. Registration No. 3669441, SPARTAN ASSAULT SYSTEMS (with ASSAULT SYSTEMS disclaimed) is for "Nylon ballistic cases for use in carrying weapons and ammunition," "Backpacks, bags and pouches which can be attached to nylon ballistic outer carriers, " and "vests for use in wearing removable bullet proof panels."

FACTS

On January 2, 2011, applicant applied to register the standard character mark SPARTAN RAIL for “Firearm attachments, namely, modular external rail systems for firearms.”

On March 28, 2011, the examining attorney issued an Office action refusing registration per Section 2(d) of the Trademark Act, and requiring a disclaimer of the descriptive term RAIL.

On August 2, 2011, applicant filed a response arguing against the Section 2(d) refusal and providing a disclaimer of the term RAIL.

On August 23, 2011, the examining attorney made final the refusal to register per Section 2(d) of the Trademark Act.

Applicant filed a Request for Reconsideration on November 10, 2011, amending the goods to “firearm attachments, namely, modular external rail systems for M-16, M4 and AR15 rifles for use by military and law enforcement professionals,” and presenting additional arguments against the Section 2(d) refusal. The Request for Reconsideration was denied on December 4, 2011 as it did not present any new facts or reasons that were significant in consideration of the likelihood of confusion refusal.

Applicant filed a Notice of Appeal on November 10, 2011, concurrent with its Request for Reconsideration. On February 15, 2012 the appeal brief was forwarded to the examining attorney.

ISSUE

Applicant's proposed mark SPARTAN RAIL, is confusingly similar to the marks in U.S. Registration No. 2988217, SPARTAN GUNWORKS and U.S. Registration No. 3669441, SPARTAN ASSAULT SYSTEMS, such that when used with the identified goods it is likely to cause confusion, to cause mistake, and to deceive as to the source of the goods, and should therefore be refused registration under Section 2(d) of the Trademark Act.

ARGUMENT

Consideration of a case under Section 2(d) of the Trademark Act turns on two inquiries. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). First, the Board must compare the marks in question, assessing the similarities in appearance, sound, meaning or connotation and commercial impression. In comparing the marks, it is well settled that similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); TMEP §1207.01(b).

Next, the goods are compared to determine whether they are similar or commercially related or travel in the same trade channels. The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the goods are related in some manner and the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

A. The Proposed Mark is Highly Similar to the Registered Mark

When considering the issue of likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser

who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

As consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark, the fact that the first term in each of the marks at issue is the identical term SPARTAN, is important. *See generally Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions). Accordingly, when the average consumer encounters the marks at issue, it is the dominant term SPARTAN that will impress upon their mind and be remembered.

Applicant argues that it is improper to focus on the first term of the marks, and that the marks are distinguishable because they sound different, are comprised of a different amount of syllables and create different commercial impressions in light of the additional wording present in each mark. The examining attorney agrees that the marks are not identical, but maintains the position that the marks are confusingly similar for the purposes of the instant analysis. While it is noted that each of the marks at issue contains additional descriptive and disclaimed wording, namely, RAIL, GUNWORKS and ASSAULT SYSTEMS, these additions are not sufficient to obviate confusion as courts

have long recognized that for the purposes of a Section 2(d) analysis, disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Consequently, contrary to applicant's arguments, the inclusion of the descriptive wording RAIL, GUNWORKS and ASSAULT SYSTEMS is not significant and is insufficient to obviate confusion. Therefore, when confronted SPARTAN RAIL, SPARTAN GUNWORKS and SPARTAN ASSAULT SYSTEMS, consumers are likely to become confused as to the source of the goods because a confusingly similar commercial notion will be impressed upon them.

Applicant also argues that the term SPARTAN is weak. Specifically, applicant references two registrations and a prior pending application for goods such as explosives and fireworks which contain the term SPARTAN in the mark. In support of its position that firearms, firearm attachments, fireworks and explosives are related, and thus the term SPARTAN is weak in the relative fields, applicant submitted eleven third-party registrations showing that goods such as firearms, explosives and fireworks are sold under the same mark. (*See* November 10, 2011 Request for Reconsideration.) However, all of the third-party registrations submitted are registered under §66 of the Trademark Act. Third-party registrations that are not based on use in commerce, such as those registered under §66 of the Trademark Act (15 U.S.C. §1141f(a)) and for which no §8 affidavits of continuing use have been filed (15 U.S.C. §1058), have very little, if any, persuasive value. *See Calypso Tech., Inc. v. Calypso Capital Mgmt., LP* __ USPQ2d __,

n.15 (TTAB August 29, 2011); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993). Accordingly, the registrations referenced by applicant are not supportive of applicant's position that the term SPARTAN is weak in the relevant or related fields.¹

B. The Goods of the Respective Parties Are Highly Related

The second step in determining whether there is a likelihood of confusion is to compare the goods of the respective parties. In assessing the relatedness of the goods, all circumstances surrounding the sale of the goods are considered. These circumstances include the marketing channels, the identity of the prospective purchasers, and the degree of similarity between the marks and between the goods. *See Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386 (C.C.P.A. 1973); TMEP §1207.01. In comparing the goods, it is necessary to show that they are related in some manner. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); TMEP §1207.01(a)(vi).

Applicant is seeking registration for “firearm attachments, namely, modular external rail systems for M-16, M4 and AR15 rifles for use by military and law enforcement professionals.” U.S. Registration No. 2988217 is for “firearms,” and U.S. Registration No. 3669441 “Nylon ballistic cases for use in carrying weapons and ammunition,” “Backpacks, bags and pouches which can be attached to nylon ballistic outer carriers,” and “vests for use in wearing removable bullet proof panels.”

¹ Of the eleven §66 registrations relied on by applicant, only U.S. Registration No. 3057925 contains a use affidavit. However, the specimen only supports use in connection with firearms, and not “ammunition and projectiles; explosives” as listed in the identification.

The goods at issue are highly related firearms, and accessories and attachments therefore, which are both of a kind that travel in the same channels of trade and emanate from the same source. Thus, the goods are likely to be encountered by consumers under the same set of circumstances such that confusion as to source is highly likely.

To demonstrate the relatedness of the goods, the examining attorney highlights the following third party registrations made of record in the March 28, 2011 Office action:

U.S. Registration No. 3431687, BLACKWATER, for “Law enforcement and military tactical operations products and accessories, namely, magazine pouches, grenade pouches, rifle shell pouches, flash bang pyrotechnic equipment pouches, weapon suppressor pouches, cartridge pouches, dump pouches, breaching equipment pouches, weapon drop leg platforms, weapon retention lanyards, tactical packs and specialized equipment bags adapted for law enforcement and military tactical operations; rifle cases; firearms; holsters; belts for military equipment; and rifle slings,” and “Bullet-proof vests; armored vests; fall protection equipment for fall restraint and fall arrest, namely, harnesses and repelling belts; telescopic rifle scopes; laser designators; tactical gloves; traffic control gloves; shooting gloves; gasmask pouches; radio pouches; night vision equipment pouches; armor plate carriers; tactical vest armor side panels.”

U.S. Registration No. 3734014, GAS PEDAL, for “Firearm attachments, namely, mounts for attaching ancillary equipment to a firearm; Firearm attachments, namely, mounts for attaching grips to a firearm; Firearm hand guards; Firearms.”

U.S. Registration No. 3913361, FIREFIELD, for “...Bags specially adapted to hold rifles; Butt plates for pistols, rifles, and shotguns; Combination pistols and rifles; Component parts for rifles; Firearm attachments, namely, mounts for attaching accessories to a firearm; Firearm attachments, namely, mounts for attaching ancillary equipment to a firearm; Firearm attachments, namely, mounts for attaching grips to a firearm...Machine guns and parts thereof; Magazines for weapons; Military rifles; Mobile gun mounts; Muzzle breaks that screw onto a rifle barrel; Muzzle-loading rifles; Noise suppressors for guns; Non-telescopic gun sights for firearms; Rifle barrels; Rifle cartridges; Rifle cases; Rifle covers; Rifle fore arms; Rifle fore ends; Rifle hand grips; Rifle hand guards; Rifle magazine clamps; Rifle mounts; Rifle rails; Rifle rings; Shooting accessories, namely, gun rests...”

The following third-party registrations were made of record in the December 4, 2011 denial of the Request for Reconsideration:

U.S. Registration No. 3872396, 6.5 SAOD, for “Ammunition bags; Bags specially adapted to hold rifles; Cartridge belts; Cartridge pouches; Case covers for firearms... Covers for firearms; Firearm attachments, namely, modular external

rail systems for attaching accessories to firearms; Firearm attachments, namely, modular external rail systems for firearms; Firearm attachments, namely, mounts for attaching accessories to a firearm... Rifles; Rifles and parts thereof; Shooting accessories, namely, gun rests; Sniper drag bags; Weapon cases for firearms....”

U.S. Registration No. 3995719, SAFARILAND, for “body armor; ballistic vests; radio holders; cassette recorder cases; gas mask pouches; concealed bullet-resistant panels used in body armor; portable ballistic shields...” and “Holsters; military and police duty gear, namely, holsters, revolver parts in the nature of revolver speedloader holders, ammo caddies, magazine holders for weapons, gun cases, cartridge pouches, firearm attachments, namely, mounting devices consisting of bases, rings and fasteners for mounting scopes on handguns and rifles, all sold as individual pieces and as assemblies; ammo caddies; cartridge pouches; gun cases; cartridge belts; holster adapters; magazine holders for weapons...”

The above highlighted evidence clearly demonstrates that firearms, firearm attachments, cases therefore and protective vests are of a kind that routinely emanate from a single source under a single mark. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

To further demonstrate the relatedness of the goods, the examining attorney highlights the following online marketplace evidence via screen shots from the following websites, made of record in the August 23, 2011 Final Office action:

BPOUTFITTERS.net showing applicant's Spartan rail for sale along with various firearm carriers and vests

DEL-TON.com showing rifles and applicant's rail for sale in the same retail outlet

TACTICALTURTLE.com offering applicant's Spartan rail, various cases for ammunition and guns, and goods marketed toward law enforcement officers for sale at the same location

BLACKOPSLLC.com showing various rails, shotguns and vests and cases for weaponry, all traveling in the same channels of trade.

The following online marketplace evidence was made of record in the December 4, 2011 denial of the Request for Reconsideration:

Screen shots from OMBEXPRESS.com and HINTERLANDOUTFITTERS.com, showing that firearms, firearm attachments, cases therefore and protective vests are available for sale to both military/law enforcement and civilians alike.

Applicant does argue that the goods are unrelated for the purposes of a Section 2(d) analysis. Rather, applicant argues that there is not likelihood of confusion because the relevant consumers are highly sophisticated. Specifically, applicant argues that the purchasers of applicant's goods are law enforcement professionals with experience in tactical shooting. (Brief at page 20). It is important to note, however, that the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see In re Cynosure, Inc.*, 90 USPQ2d 1644 (TTAB 2009); *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

Furthermore, while the intended consumers of applicant's goods may be sophisticated military and law enforcement personnel, the consumers of the registrants' goods include the general firearm, and firearm accessory purchasing public. When the relevant consumer includes both professionals and the general public, the standard of care for purchasing the goods is that of the least sophisticated purchaser. *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004). Thus, in this case, the standard of care for purchasing the goods at issue is not the sophisticated standard as measured by law enforcement professionals with tactical training, but rather the less sophisticated general firearm purchasing public. Accordingly, applicant's argument that the consumers

of the goods at issue are sophisticated and therefore immune to confusion, is not persuasive.

The evidence of record establishes that the same entity commonly produces, provides and markets the relevant goods under the same mark, and that firearms, firearm attachments, cases therefore and protective vests are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use. Moreover, the evidence shows that retailers market and sell the firearms, firearm attachments, cases therefore and protective vests to both sophisticated military and law enforcement personnel as well as the general consuming public. Therefore, applicant's and registrants' goods are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Accordingly, as the first and dominant term in each of the marks it issue is the identical term SPARTAN, and the evidence of record demonstrates a high degree of relatedness between applicant's goods and the registrants' goods, the record is sufficient to sustain a finding that the marks are confusingly similar under Section 2(d) of the Trademark Act.

CONCLUSION

For the foregoing reasons, it is respectfully requested that the refusal to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), be affirmed.

Respectfully submitted,

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