

To: Structures, Inc. (sfaction@spencerfane.com)
Subject: U.S. TRADEMARK APPLICATION NO. 87450298 - STRUCTURES - 5026167-3
Sent: 8/16/2017 9:19:09 PM
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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION
SERIAL NO.** 87450298

MARK: STRUCTURES

87450298

**CORRESPONDENT
ADDRESS:**

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**CORRESPONDENT'S
REFERENCE/DOCKET
NO:**

5026167-3

**CORRESPONDENT
E-MAIL ADDRESS:**

sfaction@spencerfane.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT **EASTERN TIME** OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: 8/16/2017

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. *See* 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone or e-mail without incurring this additional fee.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES:

- Section 2(d) refusal—likelihood of confusion.
- Potential Section 2(d) refusal.
- Information request.
- Requirement for an acceptable identification of services.
- Requirement for compliance with all relevant combined class application requirements.

I. SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 4640532 and 4640531. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registrations.

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the services. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1516 (TTAB 2016) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)); *see* TMEP §1207.01. That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Additionally, the services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

A. SIMILARITY OF THE MARKS

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. *See In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751.

The *applicant's* proposed mark is **STRUCTURES** in standard character form.

The *registrant's* marks are **4STRUCTURES** and **4STRUCTURES.COM** both in standard character form.

The dominant feature among the respective marks is the term STRUCTURES. This dominant feature is given greater weight in the examiner's analysis. Generic top-level domains (gTLDs), such as ".com", are generic locators for Internet website addresses and provide no meaningful source-identifying significance. *See Apple Computer v. TVNET.net, Inc.*, 90 USPQ2d 1393, 1397 (TTAB 2007); TMEP §§1215.01, 1215.02, 1215.09; *cf. In re Hotels.com, L.P.*, 573 F.3d 1300, 1301, 1304, 91 USPQ2d 1532, 1533, 1535 (Fed. Cir. 2009). Thus, a non-source-identifying gTLD is less significant in creating a commercial impression in the minds of consumers, and is generally given little weight when comparing marks. *See* TMEP §1215.09. Therefore, the term ".COM" in cited U.S. Registration Number 4640531 does not obviate the likelihood of confusion.

Furthermore, although the number "4" is not present in the applied-for mark, this factor does not obviate the likelihood of confusion in that the number "4" in the cited marks merely modifies the dominant shared term STRUCTURES among the respective marks meaning "for STRUCTURES." Please note that marks may be confusingly similar in sound, appearance and meaning where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells*

Fargo Bank, Nat'l Ass'n, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP § 1207.01(b)(ii)-(iii). The respective marks here create the same overall commercial impression of a STRUCTURES proprietary brand rendering confusion likely. When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP § 1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d at 1960 (citing *Spoons Rests, Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013)); TMEP § 1207.01(b).

B. SIMILARITY OF THE SERVICES

The services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP § 1207.01(a)(i).

The respective services need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP § 1207.01(a)(i).

The *applicant's* services are:

“Financial advisory and consulting services, namely, designing and administering tax deferred payment vehicles; providing investment advice and financial planning” **in International Class 36.**

The *registrant's* services are:

“Financial services, namely, providing financial planning and financial analysis in connection with the settlement of legal claims; providing insurance and structured settlement consultation and planning services; insurance brokerage services; insurance agencies; insurance agencies in the field of structured settlements; insurance brokerage; insurance brokerage in the field of structured settlements; insurance claims administration; insurance claims processing; insurance consultation; insurance services, namely, structured settlements; insurance underwriting in the field of structured settlements; providing on-line news, information and services in the field of insurance and structured settlements” **in International Class 36.**

The applicant's broadly stated financial advisory and consulting services regarding “tax deferred payment vehicles”, or structured tax-deferred attorney fee payments for the settlement of legal claims according to the specimen of record, are directly competitive with the registrant's financial analysis and consultation services regarding structured settlements of legal claims. Additionally, the applicant's financial planning services are presumed to also relate to said structured settlements of legal claims. It is where services are directly competitive that likelihood of confusion is greatest. In this regard, please note that with respect to applicant's and registrant's services, the question of likelihood of confusion is determined based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Absent restrictions in an application, the identified services are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all services of the type described. See, e.g., *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015); *In re*

N.A.D., Inc., 57 USPQ2d 1872, 1874 (TTAB 2000).

In this case, the identification set forth in the application has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application uses broad wording to describe the services and this wording is presumed to encompass all services of the type described, including those in registrant's more narrow identification. Moreover, those that offer financial investment consultation or advice services also often offer insurance consultation services rendering confusion on this basis also likely. See the attached Automated X-Search System evidence in this regard. For example, see U.S. Registration Number 5267761 attached for "providing financial planning and investment consultation services; providing insurance consultation and brokerage services."

If applicant responds to the refusal, applicant must also respond to the requirements set forth below.

II. APPLICATION NOT ENTITLED TO REGISTER—ONE EARLIER FILED PENDING APPLICATION

The filing date of pending U.S. Application Serial No. 87496928 precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. See 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

III. INFORMATION REQUEST

Applicant must specify whether the wording "STRUCTURES" has any significance in the applicant's trade or industry or as applied to the services described in the application, or if such wording is a "term of art" within applicant's industry. See 37 C.F.R. §2.61(b); TMEP §814.

Failure to respond to a request for information is an additional ground for refusing registration. See *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701 (TTAB 2003); TMEP §814.

IV. AMENDMENT TO THE IDENTIFICATION OF SERVICES

The identification of services is indefinite and must be clarified because the wording "*designing* and administrating tax deferred payment *vehicles*" as to the financial advisory and consulting services therein is unduly vague, and could include services in different international classes, i.e. financial advisory and consulting services in the field of creating structured tax-deferred attorney fee payments and financial administration of the same in International Class 36, and design of software for use in creating and administrating structured tax-deferred attorney fee payments in International Class 42. Furthermore, the field for the services should be clarified, e.g. legal settlements. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Specifically, the applicant may adopt the following identification, if accurate:

"Financial advisory and consulting services in the field of creating structured tax-deferred attorney fee payments for legal settlements and the financial administration of the same; providing investment advice and financial planning" **in International Class 36.**

"Design of computer software for use in creating and administrating structured tax-deferred attorney fee payments for legal settlements" **in International Class 42.**

Applicant's services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different services or add services not found or encompassed by those in the original application or as acceptably amended. *See* TMEP §1402.06(a)-(b). The scope of the services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the services will further limit scope, and once services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e).

V. COMBINED CLASS APPLICATIONS

The application references services based on use in commerce in more than one international class; therefore, applicant must satisfy all the requirements below for each international class:

- (1) **List the goods and/or services by their international class number** in consecutive numerical order, starting with the lowest numbered class (for example, International Class 3: perfume; International Class 18: cosmetic bags sold empty).
- (2) **Submit a filing fee for each international class** not covered by the fee already paid (view the [USPTO's current fee schedule](#)). Specifically, the application identifies services based on use in commerce that are classified in at least two classes; however, applicant submitted a fee sufficient for only one class. Applicant must either (a) submit the filing fees for the classes not covered by the submitted fees or (b) restrict the application to the number of classes covered by the fees already paid.
- (3) **Submit verified dates of first use of the mark** anywhere and in commerce **for each international class**. [See more information about verified dates of use](#).
- (4) **Submit a specimen for each international class**. *The current specimen is acceptable for both international classes of services suggested above.* [See more information about specimens](#).

Examples of specimens for services include advertising and marketing materials, brochures, photographs of business signage and billboards, and website printouts that show the mark used in the actual sale, rendering, or advertising of the services.

- (5) **Submit a verified statement** that “**The specimen was in use in commerce on or in connection with the goods and/or services listed in the application at least as early as the filing date of the application.**” [See more information about verification](#).

See 15 U.S.C. §§1051(a), 1112; 37 C.F.R. §§2.32(a)(6)-(7), 2.34(a)(1), 2.86(a); TMEP §§904, 1403.01, 1403.02(c).

See [an overview](#) of the requirements for a Section 1(a) multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form.

VI. RESPONSE TO A NON-FINAL ACTION

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration.

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issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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