

UNITED STATES PATENT AND TRADEMARK OFFICE
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October 27, 2023

Concurrent Use No. 94003140

Sparks Law, LLC (RI)
(Application Serial No. 87709845)

v.

Sparks Law, LLC (GA)
(Registration No. 5668170)
(Application Serial No. 90188648)

By the Trademark Trial and Appeal Board:

This proceeding now comes before the Board for consideration of the parties' response, filed August 31, 2023, to the Board's August 14, 2023 order (the Board's "Previous Order").

In the Previous Order, the Board required the parties to (1) clarify whether both parties were claiming the State of New York as part of their areas of use; (2) inform the Board of their intention regarding the remainder of the United States with respect to each party's area of use; and (3) amend the parties' respective recitation of services, if desired.¹

¹ 5 TTABVUE 5-6. Citations to the concurrent use proceeding record refer to TTABVUE, the Board's online docketing system. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding "TTABVUE" corresponds to the docket

In response, the parties clarified that Sparks Law, LLC (RI) (“Sparks RI”) deletes the entire State of New York from its area of use for its application and Sparks Law, LLC (GA) (“Sparks GA”) retains the entire State of New York as an area of use for its application. Additionally, the parties specified that neither party claims the remainder of the United States, other than the states specifically mentioned, as an area of use. Finally, the parties proposed amendments to their respective identifications of services.

Sparks GA’s Registration No. 5668170

The Board further reviewed the parties’ Amendment to Trademark Settlement and Concurrent Use Agreement (“Amended Agreement”), filed June 6, 2023, and the instant response to the Previous Order.² While the parties’ amended their agreement with respect to their respective applications regarding, inter alia, the geographic and identification of services restrictions, the parties’ Amended Agreement and the instant response to the Previous Order do not reference amended limitations with respect to Sparks GA’s Registration No. 5668170 (“Sparks GA’s Registration”), which is also subject to this proceeding.³ Accordingly, with respect to Sparks GA’s

entry number, and any number(s) following “TTABVUE” refer to the page number(s) of the docket entry where the cited materials appear.

² See 3, 6 TTABVUE.

³ See *id.* In both the Amendment Agreement and the response to the Previous Order, the parties’ only refer to their respective applications and do not mention Sparks GA’s Registration No. 5668170 at all, except to the extent the registration is included in the parties’ original agreement as incorporated by reference in paragraph 7 of the Amended Agreement. See *id.*

Registration, for the reasons discussed in the Board's May 8, 2023 order,⁴ the parties' Amended Agreement, in conjunction with the parties' response to the Previous Order, fails to persuade the Board that there is no likelihood of confusion arising from the parties' concurrent use of virtually identical marks for similar services in, at least in part, overlapping geographic areas.

Sparks RI's Proposed Identification of Services Amendment

In the parties' response, Sparks RI proposed an amendment to application Serial No. 87709845, with Sparks GA's consent.

By the proposed amendment, Sparks RI seeks to amend the identification of services in International Class 45 as follows (additions in **bold**):

FROM: Legal services

TO: Legal services **in the field of personal injury law**

The amendment is limiting in nature, as required by Trademark Rule 2.71(a), and Sparks GA consents thereto. Accordingly, the amendment is acceptable. However, entry of the amendment is **deferred**, as discussed below.

Sparks GA's Proposed Identification of Services Amendment

In the parties' response, Sparks GA proposed an amendment to application Serial No. 90188648, with Sparks RI's consent.

By the proposed amendment, Sparks GA seeks to amend the identification of services in International Class 45 as follows (additions in **bold**):

FROM: Legal services

⁴ See 1 TTABVUE.

TO: Legal services **in the field of business transactional, trusts and estates, and intellectual property law**

The amendment is limiting in nature, as required by Trademark Rule 2.71(a), and Sparks RI consents thereto. Accordingly, the amendment is acceptable. However, entry of the amendment is **deferred**, as discussed below.

Next Steps

1. Geographic Restriction for Sparks GA's Registration

The parties are allowed until **thirty days from the date of this order** to clarify that the agreed-to geographic limitations regarding Sparks GA's application Serial No. 90188648 are also applicable to Sparks GA's Registration.

2. Identification of Services Amendment for Sparks GA's Registration

The parties are also allowed until **thirty days from the date of this order** to clarify that the agreed-to amended identification of services regarding Sparks GA's application Serial No. 90188648 are also applicable to Sparks GA's Registration. However, as explained in the Previous Order, an amendment to a registration has additional requirements discussed in TBMP § 514.01. In particular, Trademark Rule 2.173 requires that an amendment (1) be accompanied by the proper fee required by Trademark Rule 2.6 and (2) be verified or supported by a declaration under Trademark Rule 2.20. *See* Trademark Rules 2.6(a)(11), 2.133(a) and 2.173(b). Accordingly, if Sparks GA intends to amend its Registration No. 5668170, it must

also comply with the requirements of Trademark Rule 2.173 in any response to this order.⁵

Proceedings Remain Suspended

Proceedings remain **suspended** and the proposed amendments to the parties' identifications of services are **deferred** pending resolution of these matters.

⁵ The recitation of services in Sparks GA's registration may be amended by filing a consented motion with the Board using the appropriate ESTTA form.