

Attorney Ref. No. 24430.047

TRADEMARK LAW OFFICE 110

Serial No. 77/294,796

Mark: GRAYSTONE RESEARCH

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

----- X
In re Application of :
Morgan Stanley :
Serial No.: 77/294,796 :
Filed: October 3, 2007 :
For Mark: GRAYSTONE RESEARCH :
----- X

NOTICE OF APPEAL

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

Attention: Trademark Trial and Appeal Board

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Examining Attorney dated April 21, 2008 refusing registration.

This notice of appeal is accompanied by a copy of a response to the final Office action dated April 21, 2008. Applicant respectfully requests that this appeal be suspended and that the case be remanded to the Examining Attorney for consideration of Applicant's Response.

10/17/2008 SWILSDN1 00000004 77294796

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I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on

October 14, 2008 L. J. Ellis Buchalter
(Date of Deposit) (Print name)

[Signature]
(Signature)



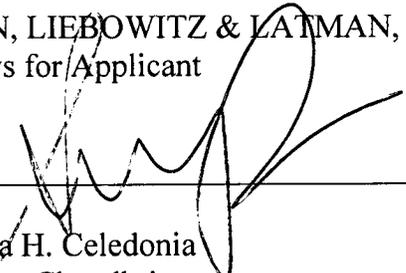
Applicant encloses herewith a check for \$100 in payment of the prescribed appeal fee.

Dated: New York, New York
October 14, 2008

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys for Applicant

By: _____



Baila H. Celedonia
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1133 Avenue of the Americas
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(212) 790-9200

Cc: Daniel Capshaw, Esq., Law Office 110

Attorney Ref. No. 24430.047

TRADEMARK LAW OFFICE 110
Serial No. 77/294,796
Mark: GRAYSTONE RESEARCH

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of :
Morgan Stanley :
Serial No.: 77/294,796 :
Filed: October 3, 2007 :
For Mark: GRAYSTONE RESEARCH :
----- X

**REQUEST FOR
RECONSIDERATION IN
RESPONSE TO OFFICE ACTION
DATED APRIL 21, 2008**

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

Attention: Daniel Capshaw, Esq., Trademark Attorney
Law Office 110

Morgan Stanley ("Applicant") hereby files this Request for Reconsideration in response to the FINAL Office action dated April 21, 2008.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as **First Class Mail** in an envelope addressed to Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on

October 14 2008 Phyllis Buchalter
(Date of Deposit) (Print name)


(Signature)

REMARKS

The Examining Attorney has issued a final refusal to register Applicant's mark, GRAYSTONE RESEARCH on the ground that this mark, when used in connection with "financial services in the nature of research and consultation for others in the field of investment management" is likely to be confused with the following two registered marks owned by Greystone Capital Group, LLC (hereinafter "Registrant"):

- a. G GREYSTONE & Design, Registration No. 2,230,082, covering "investment management services through investments in financial services companies."
- b. GREYSTONE CAPITAL, Registration No. 2,230,083, covering "investment management services through investments in financial services companies."

The marks G GREYSTONE & Design and GREYSTONE CAPITAL are hereinafter collectively referred to as the "Cited Marks."

The final refusal is based, in part, on the Examining Attorney's refusal to accept the consent agreement (attached as **Exhibit A** and hereinafter referred to as "Agreement") between Applicant and Registrant. According to the Examining Attorney, "the consent agreement made of record does not reference the application at issue and is, therefore, not persuasive." Applicant respectfully states that the Examining Attorney has taken an unnecessarily narrow view of the consent agreement, which continues to be in full force and effect. There is no *per se* rule as to what should be included in a consent agreement that is

submitted to the Office. *In re American Management Associations*, 218 U.S.P.Q. 477 (T.T.A.B. 1983) (there is no mandated set of required terms in consent agreements). It is not uncommon for parties to enter into consent agreements that do not refer to specific applications. In fact, the Board has in the past accepted agreements that do not specifically refer to applications that are the subject of disputes brought before it. In *In re Sears, Roebuck and Co.*, 2 U.S.P.Q.2d 1312 (T.T.A.B. 1987), the Board accepted a consent agreement that had been executed well prior to the filing of applicant's involved application, in order to settle a potential opposition by applicant against the application which thereafter matured into registrant's registration. Clearly, the agreement that was discussed in the *Sears* case could not have mentioned the applicant's particular application. The Board nonetheless held that the agreement was entitled to consideration on the ground that it was not a mere "naked" consent, which demonstrated that the parties have "thought out their commercial interests with care." *Id.* Similarly, here, the Agreement was executed before Applicant's filed its application and, as discussed below, is not a mere "naked" consent. Rather than focusing on technicalities such as whether the Agreement mentions Applicant's application, the Examining Attorney should focus on analyzing the Agreement for the purpose of determining whether it is detailed or whether it is merely a "naked" consent.

In the response to the preliminary refusal, Applicant had argued that the Agreement is not a mere "naked" consent. The Examining Attorney has not contested this argument in the final Office action. As previously discussed, Registrant has consented to Applicant's continued use and registration of the marks **GRAYSTONE** and **GRAYSTONE WEALTH**

MANAGEMENT SERVICES in connection with the following services: “financial services in the nature of investment banking services; investment management, and brokerage and trading of securities and investment securities; research and consultation for others in the fields of investment banking, investment management, securities, and investment securities.”

Agreement ¶ 2. Although the Agreement does not specifically cover Applicant’s GRAYSTONE RESEARCH mark, it encompasses the mark GRAYSTONE for a broader range of services¹ than those covered by Applicant’s application², and specifically covers research services. In addition, the parties have acknowledged that there is no likelihood of confusion between their respective marks because of differences in the services, customers and potential customers, channels of trade and coexistence in the marketplace without any instances of actual confusion. Agreement ¶ 4. Furthermore, the Agreement sets out detailed steps that the parties will take to prevent confusion from concurrent use of their respective marks. Agreement ¶ 5. Thus, the Agreement is not a “naked” consent. It follows that the Agreement should be given great weight in determining that Applicant’s mark is unlikely to be confused with the Cited Marks.

Applicant and Registrant executed the Agreement because they thought their respective marks could coexist in the marketplace. In fact, the parties’ marks have coexisted

¹ The Agreement encompasses the following services covered by Applicant’s GRAYSTONE and GRAYSTONE WEALTH MANAGEMENT SERVICES: “financial services in the nature of investment banking services; investment management, and brokerage and trading of securities and investment securities; **research** and consultation for others in the fields of investment banking, investment management, securities, and investment securities.”

² Applicant’s application encompasses the following services, namely, “financial services in the nature of research and consultation for others in the field of investment management.”

for eleven (11) years in the marketplace without any evidence of actual confusion. Applicant has used its GRAYSTONE RESEARCH mark since at least as early as 2002, and had previously used its GRAYSTONE (without the generic term “research”) mark since 1993. Registrant has used its marks since 1997. Eleven years of concurrent use without actual confusion is a significant period of time. This creates a strong inference that there is no likelihood of confusion between the parties’ marks. *CareFirst of Maryland, Inc. v. First Care, P.C.*, 77 U.S.P.Q.2d 1577 (4th Cir. 2006) (nine years of co-existence with no evidence of actual confusion “creates a strong inference that there is no likelihood of confusion”). Thus, this factor favors a finding of no likelihood of confusion.

Applicant also respectfully disagrees with the Examining Attorney’s contention that the parties’ services are related. Applicant’s services are “financial services in the nature of research and consultation for others in the field of investment management.” On the other hand, the Cited Marks cover the following services, namely, “investment management services through investments in financial services companies.” Thus, Registrant is a venture-capitalist, *i.e.*, it invests capital provided by professional, outside investors into other companies. By Registrant’s own admission, its services are focused on investing in financial services companies such as credit card companies and banks. Copies of Office action responses filed by Registrant during prosecution of its applications to register the Cited Marks are attached as **Exhibit B**. By contrast, Applicant does not offer venture capital services under the GRAYSTONE RESEARCH mark. Rather, Applicant provides research and consultation services to others in the field of investment management. Specifically,

Applicant identifies, researches and monitors investment vehicles and provides consulting services to its consumers to allow them to create customized portfolios that are tailored to their unique investment needs. Thus, the parties' services are not related. Rather this is case where the parties' services are marketed under circumstances in which they would not be encountered by the same purchasers under circumstances that would lead to a mistaken belief that they emanate from the same source.

The Examining Attorney has attached twenty-four (24) third-party registrations that show that "it is common for providers of investment management services, such as provided by the registrant, to also provide consulting and research in the field of investment management under a single mark." It is well-settled that third-party registrations that encompass both parties' goods/services "*may* have some probative value to the extent that they serve to *suggest* that the listed goods and/or services are of a type that may emanate from a single source." *In re Albert Trostel & Sons Co.*, 29 U.S.P.Q.2d 1783, 1785-1786 (T.T.A.B. 1993). However, T.M.E.P. § 1207.01(d)(iii) warns that such registrations have probative value *only* if they are based on use. Clearly, the existence of a registration does not prove that the mark in that registration is in use. Since the Examining Attorney has not provided any evidence to demonstrate the use status of the marks in these registrations, the registrations are of little probative value. Moreover, at least one registration submitted by the Examining Attorney is based on a foreign registration. This registration should not be entitled to any weight at all. T.M.E.P. §1207.01(d)(iii) (registrations issued under 15 U.S.C.

§1126(e), based on a foreign registration, have very little, if any, persuasive value). In addition, these registrations do not cover Applicant's services and the services covered by the Cited Marks. Therefore, at best, the registrations annexed to the Office action have *de minimis* significance and are of little probative value. Even if these third-party registrations were relevant, they alone cannot prove that the parties' services are related. If these registrations were sufficient to prove relatedness of services, then the Examining Attorney would be creating a *per se* rule regarding the relatedness of goods and services—a rule that is contrary to trademark law which requires that each case be decided on the basis of all of the relevant facts in evidence. *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 U.P.S.Q. 151, 152 (C.C.P.A 1978).

Further, the Examining Attorney states that the parties' services travel in the same channels of trade because "no restrictions are present in either the registrations or applications." While it is true that in the absence of any restrictions in the trade channels, it is presumed that the goods/services move in all normal channels of trade, here, the "normal" trade channels are distinct. Applicant's services, namely, research and consultation services for others in the field of investment management are normally sold to investors who are interested in creating customized portfolios of their investments. On the other hand, Registrant's investment management services are targeted towards institutional investors and high net worth individuals. See Exhibit B. Both parties' services are likely to be sold by word-of-mouth or referrals and are likely to involve significant pre-purchase deliberations.

Thus, the parties' services are targeted towards different consumers and travel in different trade channels.

Sophistication of the respective purchasers is another factor that weighs heavily in favor of no likelihood of confusion. *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 U.SP.Q.2d 1388 (Fed. Cir. 1992) ["sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care"]; and *In re Box Solutions Corp.*, 79 U.S.P.Q.2d 1953 (TTAB 2006). Here it is immediately apparent after even a cursory reading of the respective recitation of services that the services are rendered to highly sophisticated purchasers who are likely to purchase the services only after significant discussion and deliberation. These purchasers are likely to know who they are dealing with. Thus, consumer sophistication obviates likely confusion.

In addition, there is no likelihood of confusion because the parties' respective marks are different. Applicant's mark is GRAYSTONE RESEARCH (RESEARCH disclaimed). By contrast, Registrant's marks are G GREYSTONE & Design and GREYSTONE CAPITAL (CAPITAL disclaimed). As far as the G GREYSTONE & Design is concerned, it has a distinctive design element. The mark has the letter G, the word GREYSTONE along with a crown and a pair of lions. This distinctive design element cannot be ignored in a likelihood of confusion analysis. *In re Electrolyte Laboratories Inc.*, 16 U.S.P.Q.2d 1239 (Fed. Cir. 1990) (the nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur). Thus, the mark is much more than just the word GREYSTONE. The presence of the design

element gives the G GREYSTONE & Design mark a completely different appearance compared to Applicant's GRAYSTONE RESEARCH mark. Moreover, the commercial impression of Applicant's GRAYSTONE RESEARCH mark differs from the commercial impression of the G GREYSTONE & Design mark. When a consumer looks at the G GREYSTONE & Design mark, he is likely to be reminded of a royal emblem. Moreover, the mark in its entirety has connotations of strength and power. By contrast, Applicant's mark has no such connotations.

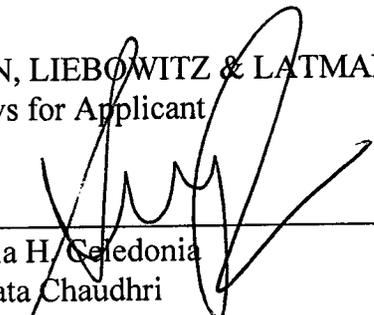
For all the above reasons, there is no likelihood of confusion between Applicant's mark and the Cited Marks.

CONCLUSION

Based on the foregoing remarks, Applicant requests that its application be published for opposition.

Dated: October 14, 2008
New York, New York

COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys for Applicant

By: 
Baila H. Caledonia
Sujata Chaudhri

1133 Avenue of the Americas
New York, New York 10036-6799
(212) 790-9200

cc: Trademark Trial and Appeal Board

EXHIBIT A

CONSENT AGREEMENT

AGREEMENT made this 12th day of April, 2001 by and between **MORGAN STANLEY DEAN WITTER & CO.**, a Delaware corporation with a place of business at 1585 Broadway, New York, New York 10036 ("MSDW") and **GREYSTONE CAPITAL GROUP LLC**, a Georgia Limited Liability Company with a place of business at 1200 Ashwood Parkway, Suite 500, Atlanta, Georgia 30338 ("GCG").

WITNESSETH THAT:

WHEREAS, GCG is the owner of U.S. Trademark Reg. No. 2,230,083, registered on March 9, 1999 in the United States Patent and Trademark Office for the trademark **GREYSTONE CAPITAL** for "investment management services through investments in financial services companies", and U.S. Trademark Reg. No. 2,230,082, registered March 9, 1999, for the trademark **G GREYSTONE** and Design for "investment management services through investments in financial services companies" (collectively, "the GCG Marks");

WHEREAS, MSDW has been using the trademark **GRAYSTONE** for "financial services in the nature of investment banking services; investment management, and brokerage and trading of securities and investment securities; research and consultation for others in the fields of investment banking, investment management, securities, and investment securities", and has filed in the United States Patent and Trademark Office ("PTO") application Ser. No. 75/859,983 to register the **GRAYSTONE** mark, which application claims a first use of at least as early as 1993, as well as application Ser. No. 75/859,984, for the mark **GRAYSTONE WEALTH MANAGEMENT SERVICES**, for "financial services in the nature of investment banking

services; investment management, and brokerage and trading of securities and investment securities; research and consultation for others in the fields of investment banking, investment management, securities, and investment securities" (collectively, "the MSDW Marks");

WHEREAS, the PTO has initially refused registration of the MSDW Marks because of a possible conflict with the GCG Marks;

WHEREAS, MSDW, on November 13, 2000, filed Petitions to Cancel GCG's Reg. Nos. 2,230,082 and 2,230,083, Cancellation Nos. 31,394 and 31,460 (collectively, "the Cancellation Proceedings");

WHEREAS, MSDW and GCG seek to amicably resolve the Cancellation Proceedings, to cooperate in assisting MSDW to obtain federal registrations of the MSDW Marks, and to avoid future controversies between themselves;

NOW, THEREFORE, in consideration of mutual covenants, agreements and understandings hereinafter contained, and for other good and valuable consideration, the receipt of which is hereby acknowledged, the parties agree, and state, as follows:

1. The use, by GCG of the GCG Marks has never been confused with the use by MSDW of the MSDW Marks; and the parties further agree that there is no likelihood of confusion between the GCG Marks and the MSDW Marks as each have heretofore been used by the respective parties.
2. GCG consents to MSDW's continued use and registration of the MSDW Marks, which are the subject of application Ser. Nos. 75/859,983 and 75/859,984, for "financial services in the nature of investment banking services; investment management, and brokerage and trading of securities and investment securities; research and consultation for others in the fields of investment banking, investment management, securities, and investment securities".

3. MSDW consents to GCG's continued use and registration of the GCG Marks for "investment management services through investments in financial services companies".

4. As there has never been any confusion known to the parties, there is no reasonable likelihood of confusion as to source, sponsorship or affiliation among the trade and public with respect to the use by MSDW and GCG of the MSDW Marks and the GCG Marks based upon: (1) the differences in the parties' services; (2) the differences in the parties' customers and potential customers; (3) the differences in the parties' channels of trade; and (4) the coexistence in the marketplace, without any instances of consumer confusion between services bearing the MSDW Marks and services bearing the GCG Marks.

5. The parties hereby agree to cooperate with each other to prevent confusion from their concurrent use of their respective marks, and to take or cause to be taken any and all actions reasonably required to prevent consumer confusion from arising in the future. If instances of confusion do arise, the parties agree to consult promptly and take such steps as are reasonably necessary to ameliorate any such problems. If the parties are unable to agree on appropriate steps to ameliorate any instances of confusion, nothing herein shall preclude either party from taking appropriate action to protect its rights under applicable law. In addition, the parties each agree to execute such other documents as may be reasonably required, in the opinion of their respective counsel, to accomplish the purposes of this Agreement.

6. MSDW shall move to withdraw the Cancellation Proceedings, with prejudice, upon execution of this Agreement.

7. Each party may use a fully executed copy of this Agreement for any purpose consistent with the agreement made herein. In particular, MSDW may use a fully

executed copy of this Agreement in furtherance of the prosecution of federal registration of the MSDW Marks, and GCG may use a fully executed copy of this Agreement to show consent by MSDW to the termination of the Cancellation Proceedings.

8. If any provision of this Agreement shall be held by any court of competent jurisdiction to be illegal, void or unenforceable, such provision shall be stricken and the remainder of this Agreement shall remain in full force and effect.

9. This Agreement constitutes the entire agreement of the parties hereto with respect to the subject matter hereof and supersedes all prior negotiations, understandings, and agreements whether written or oral.

10. This Agreement is binding on and shall inure to the benefit of the parties, the successors and assigns of their respective businesses and/or successors and assigns of the respective marks.

11. Either party may terminate this Agreement, upon the abandonment by the other party of its claimed trademark(s) that are the subject hereof.

12. No part of this Agreement may be varied by either party except by a writing signed by each of the parties hereto. No waiver of any term hereof shall be effective unless it is in writing, signed by the party to be charged. No waiver of any term hereof in any one instance shall constitute a waiver of any such term in any other instance.

IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be executed by their duly authorized officers as of the day, month and year first hereinabove written.

Dated: April 26, 2001



MORGAN STANLEY DEAN WITTER & CO.

By: [Signature]

Its: Treasurer

Dated: April 30, 2001

GREYSTONE CAPITAL GROUP, LLC

By: Thomas J. Rosenthal

Its: Chairman and Chief Executive Officer

EXHIBIT B

104
2A

TRADEMARK LAW OFFICE 104
Serial Number: 75/313501
Mark: GREYSTONE CAPITAL
1998 SEP 24 A 51

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

IN RE TRADEMARK APPLICATION:

File No. : 170703-3010
Mark : GREYSTONE CAPITAL
Filed : June 23, 1997
Ser. No. : 75/313501
Applicant : Greystone Capital Group, LLC



09-14-1998
U.S. Patent & TMO/TM Mail Rcpt Dt #51

CERTIFICATE OF MAILING

I hereby certify that this fee or correspondence is being deposited with the United States Postal Service as First Class Mail, in an envelope addressed to Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on September 11, 1998.

Sanford J. Asman, Reg. No. 26,251

Date: 9/11/98

Assistant Commissioner for Trademarks
Box Responses - Law Office 104
2900 Crystal Drive
Arlington, VA 22202-3513

AMENDMENT

Sir:

In response to the Official-Action mailed on March 12, 1998 (Action No. 1), please amend the trademark application identified above as follows:

Please enter the following disclaimer:

A1D1 | No claim is made to the exclusive right to use CAPITAL apart from the mark as shown. | P.M.D.T.

Please change the recitation of services to read as follows:

A²GS | INVESTMENT MANAGEMENT SERVICES THROUGH
INVESTMENTS IN FINANCIAL SERVICES COMPANIES | 1286 B

Please amend the application by changing the address of the applicant to:

py | [Greystone Capital Group, LLC
1200 Ashwood Parkway
Suite 500
Atlanta, GA 30338]

REMARKS

The Trademark Examining Attorney refused registration of the mark in International Class 36. The Trademark Examining Attorney indicated that such refusal was based upon his opinion that the Applicant's mark, "GREYSTONE CAPITAL", when used on or in connection with the identified services, so resembles the registered mark "GRAY-STONE" (U.S. Reg. No. 1,890,168) as to be allegedly likely to cause confusion, to cause mistake, or to deceive.

The Trademark Examining Attorney allegedly relied upon a two step analysis to arrive at his determination that there is a likelihood of confusion. In particular, the Trademark Examining Attorney concluded that the marks: (1) had similarities in appearance, sound, connotation, and/or commercial impression; and (2) were used on related goods or services.

The Trademark Examining Attorney stated, "The applicant's mark is G GREYSTONE and design..." (Official Action, page 2, line 1). In fact, the mark for which the applicant seeks registration in this application, is "GREYSTONE CAPITAL", and it is devoid of any design. The mark referred to by the Examiner, "G GREYSTONE and design" is actually the

subject of applicant's co-pending application Ser. No. 75/313388. Accordingly, while this response addresses the issues raised in the Official Action, it is not clear on the record that the Official Action, in fact, addresses the correct mark.

The Trademark Examining Attorney argued that the marks have the same sound, and that the applicant's services are consultation and investment services in the field of insurance and financial services, investment consultation and investment management. The Examining Attorney stated, "As the attached sample of marks from the PTO records indicates, the applicant's and the registrant's services are rendered under the same *mark*." (emphasis added). The Examining Attorney is either confused, or this argument makes no sense. Alternatively, he might (possibly) have meant that the applicant's and the registrant's *services* are both classified in the same *International Class*, as that appears to be the only commonality between the marks cited by the Examining Attorney and the applicant's mark. In any event, the basis for the Examining Attorney's refusal to register the mark should not be a matter of speculation by the applicant. Accordingly, while the applicant will respond to the Official Action, *based solely upon what the applicant believes the Examining Attorney meant*, in an effort to advance the prosecution of the application, if the applicant has guessed wrong (particularly in view of the Examining Attorney's reference to the wrong mark, as set forth above), then the Examining Attorney should withdraw the action and issue a new, and clear, action. Alternatively, if the Examining Attorney fails to agree with the applicant that the applicant's mark is now entitled to registration, then the Examining Attorney should clarify the rejection in order to assure that the record is accurate, should an appeal be appropriate.

The foregoing having been said, the applicant acknowledges that *a portion* of the applicant's mark, *i.e.*, "GREYSTONE", might sound similar to the registrant's mark "GRAYSTONE". In fact, the applicant's mark is "GREYSTONE CAPITAL", which clearly looks and

sounds different from the registrant's mark. As the applicant's mark "GREYSTONE CAPITAL" is actually two words made up of five syllables, it sounds different from the registrant's single, hyphenated word mark "GRAY-STONE". Further, as the registrant's mark is hyphenated, it must be assumed that it is pronounced as two words, with a pause between the hyphenated syllables. Thus, even that portion "GREYSTONE" of the applicant's mark which is similar to the registrant's mark, might well sound different from the registrant's full mark, "GRAY-STONE", and, in any event, the applicant's full mark "GREYSTONE CAPITAL" clearly looks, sounds, and is spelled differently than the registrant's mark "GRAY-STONE".

Next, the Examining Attorney argued that the marks are used for the same services. In fact, they are not used for the same, or even for similar, services. The registrant's mark is used for "insurance brokerage" services, and not for any financial investment services. Insurance brokerage involves the marketing of insurance, as an agent for insurance companies. Typically, members of the general public deal with insurance brokers for the purpose of purchasing insurance policies. Accordingly, it is quite common for insurance brokers to advertise their services widely. Further, insurance brokers are typically licensed to sell insurance.

Applicant's services, on the other hand, relate solely to investment services. Even in that area, applicant deals solely with institutional investors and high net worth individuals. Applicant's services involve investment management through investments in financial services companies. Accordingly, applicant deals with a relatively few, very sophisticated clients, and applicant's services involve the investment of client's funds into financial services companies (e.g., credit card companies and banks). Applicant performs no insurance brokerage services, and applicant has never done any advertising.

Consequently, while the applicant's mark, "GREYSTONE CAPITAL" admittedly has a portion which is similar to the registrant's entire mark, neither the services offered by the

registrant and the applicant, nor their respective channels of trade have any similarity whatsoever. Applicant knows of no situation in which Applicant's services have been confused with those of the registrant, and none has been brought to the attention of Applicant by the registrant.

In view of the foregoing, it is quite apparent that the basis upon which the Trademark Examining Attorney relied for refusing registration is nonexistent. Consequently, as there is no likelihood of confusion based upon:

- (1) the extremely specific (and non-overlapping) nature of the services provided by Applicant and those provided by the registrant;
- (2) the dissimilarity of established, likely to continue, trade channels in which Applicant's services and the registrant's services are marketed;
- (3) the sophisticated nature of applicant's clients (institutional investors and very high net worth individuals) and the typical purchasers of insurance brokerage services;
- (4) the fact that registrant's clients are seeking insurance brokerage services, and *not* investment management services, while applicant's clients are seeking investment management services and *not* insurance brokerage services;
- (5) the lack of any actual confusion known by or brought to the attention of Applicant;
- (6) the fact that there has apparently been concurrent use of the marks by both Applicant and by the registrant since the Applicant adopted the mark in May 1997 without any evidence whatsoever of actual confusion;
- (7) the licensing requirements needed to operate in the insurance industry; and
- (8) the limited number of services offered by Applicant and by the registrant,

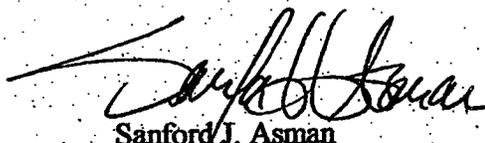
it is apparent that the criteria raised in *In re E.I. du Pont de Nemours & Co.* weigh heavily in favor of withdrawing any objection to registration based upon the mark "GRAY-STONE". Accordingly, such action is respectfully solicited.

Finally, the Trademark Examining Attorney raised the question as to the status of the individual who signed the application. The application was signed by Thomas G. Rosencrants as the Operating Member of the Applicant, Greystone Capital Group, LLC. A Georgia LLC is a "limited liability company", pursuant to O.C.G.A. §14-11-100, *et seq.* As the Operating Member of the Applicant, Mr. Rosencrants manages the Applicant. Accordingly, he properly executed the application on behalf of the Applicant.

In view of the above remarks, Applicant respectfully requests that the Trademark Examining Attorney reconsider his position and approve the present application for publication.

If the Trademark Examining Attorney has any further questions, a telephone interview with the undersigned might expedite the prosecution of the application.

Respectfully submitted,



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Reg. No. 26,251
Attorney for Applicant

Sanford J. Asman, Esq.
570 Vinington Court
Dunwoody, GA 30350

Phone : 770-391-0215
Fax : 770-668-9144
Email : sandy@asman.com

LO 104

TRADEMARK LAW OFFICE

Serial Number: 42

Mark: 24 **G GREYSTONE and DESIGN**

104

75/313388

2A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE TRADEMARK APPLICATION:

File No. : 170703-3020



Mark : G GREYSTONE and DESIGN

09-14-1998

Filed : June 23, 1997

U.S. Patent & TMO/TM Mail Rcpt Dt. #01

Ser. No. : 75/313338

Applicant : Greystone Capital Group, LLC

CERTIFICATE OF MAILING

I hereby certify that this fee or correspondence is being deposited with the United States Postal Service as First Class Mail, in an envelope addressed to Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on September 11, 1998.

Sanford J. Asman, Reg. No. 26,251

Date: 9/11/98

Assistant Commissioner for Trademarks
Box Responses - Law Office 104
2900 Crystal Drive
Arlington, VA 22202-3513

AMENDMENT

Sir:

In response to the Official Action mailed on March 12, 1998 (Action No. 1), please amend the trademark application identified above as follows:

Please change the recitation of services to read as follows:

A1
app

INVESTMENT MANAGEMENT SERVICES THROUGH
INVESTMENTS IN FINANCIAL SERVICES COMPANIES

10/26
AB

Please amend the application by changing the address of the applicant to:

A24

Greystone Capital Group, LLC
1200 Ashwood Parkway
Suite 500
Atlanta, GA 30338 ✓

Please replace the drawing with the enclosed drawing.

REMARKS

The Trademark Examining Attorney refused registration of the mark in International Class 36. The Trademark Examining Attorney indicated that such refusal was based upon his opinion that the Applicant's mark, "G GREYSTONE and Design", when used on or in connection with the identified services, so resembles the registered mark "GRAY-STONE" (U.S. Reg. No. 1,890,168) as to be allegedly likely to cause confusion, to cause mistake, or to deceive.

The Trademark Examining Attorney allegedly relied upon a two step analysis to arrive at his determination that there is a likelihood of confusion. In particular, the Trademark Examining Attorney concluded that the marks: (1) had similarities in appearance, sound, connotation, and/or commercial impression; and (2) were used on related goods or services.

The Trademark Examining Attorney argued that the marks have the same sound, and that the applicant's services are consultation and investment services in the field of insurance and financial services, investment consultation and investment management. The Examining Attorney stated, "As the attached sample of marks from the PTO records indicates, the applicant's and the registrant's services are rendered under the same *mark*." (emphasis added). The

Examining Attorney is either confused, or this argument makes no sense. Alternatively, he might (possibly) have meant that the applicant's and the registrant's *services* are both classified in the same *International Class*, as that appears to be the only commonality between the marks cited by the Examining Attorney. In any event, the basis for the Examining Attorney's refusal to register the mark should not be a matter of speculation by the applicant. Accordingly, while the applicant will respond to the Official Action, *based solely upon what the applicant believes the Examining Attorney meant*, in an effort to advance the prosecution of the application, if the applicant has guessed wrong (particularly in view of the Examining Attorney's reference to the wrong mark, as set forth above), then the Examining Attorney should withdraw the action and issue a new, and clear, action. Alternatively, if the Examining Attorney fails to agree with the applicant that the applicant's mark is now entitled to registration, then the Examining Attorney should clarify the rejection in order to assure that the record is accurate, should an appeal be appropriate.

The foregoing having been said, the applicant's mark is primarily a design, a portion of which contains the word, "GREYSTONE". While that portion might sound similar to the registrant's mark "GRAY-STONE", the overall look of the applicant's mark is a design which is substantially different from the registrant's word mark "GRAY-STONE".

In addition, as the applicant's mark merely includes the letter "G" and the word "GREYSTONE", along with a crown and a pair of lions, the appearance of the applicant's mark is substantially different from the registrant's single, hyphenated word mark "GRAY-STONE". As the registrant's mark is hyphenated, it must be further assumed that it is pronounced as two words, with a pause between the hyphenated syllables. Thus, even that portion "GREYSTONE" of the applicant's mark which is similar to the registrant's mark, might well sound different from the registrant's full mark, "GRAY-STONE", and, in any event, the applicant's full mark "G

GREYSTONE and Design” is a design, rather than a word mark, so it clearly looks, sounds, and is spelled differently than the registrant’s word mark “GRAY-STONE”.

Next the Examining Attorney argued that the marks are used for the same services. In fact, they are not used for the same, or even for similar, services. The registrant’s mark is used for “insurance brokerage”, and not for any financial services. Insurance brokerage involves the marketing of insurance, as an agent for insurance companies. Typically, members of the general public deal with insurance brokers for the purpose of purchasing insurance policies. Accordingly, it is quite common for insurance brokers to advertise their services widely. Further, insurance brokers are typically licensed to sell insurance.

Applicant’s services, on the other hand, relate solely to investment services. Even in that area, applicant deals solely with institutional investors and high net worth individuals. Applicant’s services involve investment management through investments in financial services companies. Accordingly, applicant deals with a relatively few, very sophisticated clients, and applicant’s services involve the investment of client’s funds into financial services companies (e.g., credit card companies and banks). Applicant performs no insurance brokerage services, and applicant has never done any advertising.

Consequently, while the applicant’s mark, “GREYSTONE CAPITAL” admittedly has a portion which is similar to the registrant’s entire mark (although they are spelled differently, and probably sound different, due to the registrant’s use of a hyphen), neither the services offered by the registrant and the applicant, nor their respective channels of trade have any similarity whatsoever. Applicant knows of no situation in which Applicant’s services have been confused with those of the registrant, and none has been brought to the attention of Applicant by the registrant.

In view of the foregoing, it is quite apparent that the basis upon which the Trademark Examining Attorney relied for refusing registration is nonexistent. Consequently, as there is no likelihood of confusion based upon:

- (1) the extremely specific (and non-overlapping) nature of the services provided by Applicant and those provided by the registrant;
- (2) the dissimilarity of established, likely to continue, trade channels in which Applicant's services and the registrant's services are marketed;
- (3) the sophisticated nature of applicant's clients (institutional investors and very high net worth individuals) and the typical purchasers of insurance brokerage services;
- (4) the fact that registrant's clients are seeking insurance brokerage services, and *not* investment management services, while applicant's clients are seeking investment management services and *not* insurance brokerage services;
- (5) the lack of any actual confusion known by or brought to the attention of Applicant;
- (6) the fact that there has apparently been concurrent use of the marks by both Applicant and by the registrant since the Applicant adopted the mark in May 1997 without any evidence whatsoever of actual confusion;
- (7) the licensing requirements needed to operate in the insurance industry; and
- (8) the limited number of services offered by Applicant and by the registrant,

it is apparent that the criteria raised in *In re E.L. du Pont de Nemours & Co.* weigh heavily in favor of withdrawing any potential objection to registration based upon the registered mark "GRAY-STONE". Accordingly, such action is respectfully solicited.

Next, the Trademark Examining Attorney objected to the drawing. A new drawing is being submitted herewith.

Finally, the Trademark Examining Attorney raised the question as to the status of the individual who signed the application. The application was signed by Thomas G. Rosencrants as the Operating Member of the Applicant, Greystone Capital Group, LLC. A Georgia LLC is a "limited liability company", pursuant to O.C.G.A. §14-11-100, *et seq.* As the Operating Member of the Applicant, Mr. Rosencrants manages the Applicant. Accordingly, he properly executed the application on behalf of the Applicant.

In view of the above remarks, Applicant respectfully requests that the Trademark Examining Attorney reconsider his position and approve the present application for publication.

If the Trademark Examining Attorney has any further questions, a telephone interview with the undersigned might expedite the prosecution of the application.

Respectfully submitted,



Sanford J. Asman
Reg. No. 26,251
Attorney for Applicant

Enclosure

Sanford J. Asman, Esq.
570 Vinington Court
Dunwoody, GA 30350

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Email : sandy@asman.com

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

Dated: March 31, 2008

Re: Application of Morgan Stanley
Serial No. 77/294,796
Filed: October 3, 2007
Mark: **GRAYSTONE RESEARCH**
Attorney Ref. No. 24430.047

Dear Sir/Madam:
Please have the Mail Division stamp in the space provided and return this card as
acknowledgment of receipt of the following: Response to Office Action dated
January 10, 2008 with Exhibits A-C.

Respectfully submitted,
COWAN, LIEBOWITZ & LATMAN, P.C.

T
RN CARD STAMP DATE