

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77684162
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION (no change)	
ARGUMENT(S)	

This Request for Reconsideration is being filed pursuant to 37 C.F.R. §2.64(b) and TMEP §715.03, in response to the Final Office Action concerning the above application for trademark registration. In the Final Office Action, the Examining Attorney maintained and made final the refusal to register Applicant's mark on the basis of a §2(d) likelihood of confusion with the following four registered marks:

Reg. no. 2996293: LIBRA
Reg. no. 2996294: LIBRA ADVISORS
Reg. no. 3390496: LIBRA ADVISORS logo
owner: Libra Advisors LLC ("Libra Advisors")
services: hedge fund management

and

Reg. no. 2954003: LIBRA
owner: Libra Securities Holdings, LLC ("Libra Securities")
services: Investment banking services; financing services relating to commercial loans and investment banking products; securities brokerage and dealer services; corporate financing services; financial research, analysis, consultation, and advisory services; investment management services; funds investment services; investment advisory services; investment consultation services; and investment of funds for others

The relevant consumers for Applicant's and the registrants' services are not likely to be confused by coexistence of Applicant's mark with the above marks.

The Marks are Different

The marks are different. Applicant's mark has a unique font, and the design of two triangles is the most prominent aspect of the mark. These design elements do not resemble any elements of the cited marks.

Additionally, the wording CAPITAL MANAGEMENT does not appear in any of the cited marks.

The Examining Attorney states that Applicant's design elements do not obviate the similarity of the marks, and he discounts the differences between the disclaimed portions of the mark on the basis that it is less significant or less dominant when comparing marks. See Final Office Action, p. 1. Applicant respectfully submits that such a conclusion stems from an analysis that fails to analyze the marks in their entireties as required by trademark law. *In re National Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ (BNA) 749, 752 (Fed. Cir. 1985). See also, *California Cooler, Inc. v. Loretto Winery Ltd.*, 774 F.2d 1451, 1455, 227 U.S.P.Q. 808, 810-811 (9th Cir. 1985).

When considered as a whole, Applicant's mark and the cited marks are distinct in appearance, meaning and commercial impression, thus eliminating any potential for confusion. The Court of Appeals has stated that "[t]here is no general rule as to whether letters or design will dominate in composite marks[.]" *In re Electrolyte Laboratories, Inc.*, 16 U.S.P.Q.2d (BNA) 1239, 1240 (Fed. Cir. 1990). In that case, the Court held that the Trademark Trial and Appeal Board erred in finding the applicant's stylized "K+" mark confusingly similar to "K+EFF" for the same goods based on consumers calling the products "K-plus" and "K-plus-eff." The Court explained that "even if the letter portion of a design mark could be vocalized, that was not dispositive of whether there would be likelihood of confusion. *A design is viewed, not spoken, and a... design can not be treated simply as a word mark.*" *Id.* (emphasis added).

Thus, because a stylized design mark cannot be "treated simply as a word mark," Applicant's design mark must be "viewed, not spoken," and compared, in its entirety, with the registrants' marks. When properly analyzed in this manner, Applicant's mark presents a distinctly different commercial impression from the registered marks, rendering confusion unlikely.

Coexistence of Cited Registrations and Third-Party Registrations Weakens the Cited Marks

Third-party registrations for similar marks may be relevant to show that the mark is so commonly used that the public will look to other elements to distinguish the source of the goods or services. See, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (C.C.P.A. 1973); *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983). The Trademark Office Manual of Examining Procedure states that Examining Attorney should consider each of these coexisting marks and "the extent to which dilution may indicate that there is no likelihood of confusion." TMEP section 1207.01(d)(x).

In addition to the four cited registrations, the following third party registrations are registered on the Principal Register under Section 1(a) for services in the field of finance:

Mark	Reg. No.	Services
LIBRA	1760271	Class 36: insurance services, namely, disability insurance

LIBRA (and design)	1896447	Class 36: issuing and servicing credit, debit, access and prepaid value cards and accounts
PRO LIBRA	2824727	Class 36: Appraisal of real estate, books, periodicals and audio-visual works.

The above registrations are attached as Exhibit A.

It is evident from the large number of registrations and approved applications that contain the term "Libra" that "marks containing [such] term...have been registered for the same or closely related goods or services because the marks are weak and because the remaining portions of the marks are sufficient to distinguish the marks as a whole from one another." *In re Hamilton Bank*, 222 U.S.P.Q. 174 (T.T.A.B. 1984). The fact that the cited LIBRA marks owned by different parties coexist on the register is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). Since the cited marks coexist, Applicant's mark should be allowed on the register as well.

Coexistence of Common Law Marks Weakens the Cited Marks

The number and nature of similar unregistered (common law) marks in use with related services is also significant in this case. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). The following companies also offer services in the field of finance under the LIBRA name, and are not related to either of the cited registration owners:

LIBRA CAPITAL (New York, New York) - investment management services
<http://www.libra.com>

LIBRA FINANCIAL PLANNING (Media, Pennsylvania) - financial planning services
<http://www.librafinancialplanning.com/>

See Exhibit B, attached.

Including the registered and unregistered LIBRA marks, there are a total of at least seven (7) entities using LIBRA marks in the field of finance in the United States. Clearly, consumers are accustomed to distinguishing among these marks and they are not likely to be confused by Applicant's use or registration of the subject mark.

Sophisticated Consumers and High-Priced Services

Customers for financial services exercise a very high degree of care in making investment decisions. They must be sophisticated in order to handle large sums of money and to research the best financial services provider to handle their money. Therefore, the registrants' and Applicant's services will never be utilized based on impulse, but rather will be offered through targeted, sophisticated marketing efforts and possible face-to-face or telephonic meetings. It is also important to note that access to hedge funds in particular is very limited because such funds are open to only a limited range of professional or wealthy investors. The relevant consumers are knowledgeable and are extremely careful in choosing a

hedge fund for their large investments.

Sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care. *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 212 USPQ 246, 252 (1st Cir. 1981). The Examining Attorney has improperly discounted the importance of consumer sophistication in this case, and Applicant notes again that "[t]here is always less likelihood of confusion where goods are expensive and purchased after careful consideration." *Astra Pharmaceuticals Prods., Inc. v. Beckman Instruments, Inc.*, 220 USPQ 786, 790 (1st Cir. 1993).

Conclusion

In light of the differences between Applicant's mark and the cited marks, the high degree of care used by Applicant's and the registrants' customers, and the large number of LIBRA marks already used in the financial sector, confusion among consumers is not likely. Applicant therefore respectfully requests that the Examining Attorney withdraw the refusal under Section 2(d).

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_63197243249-194042055_._LIBRA_Exhibit_A.pdf
CONVERTED PDF FILE(S) (4 pages)	\\TICRS\EXPORT10\IMAGEOUT10\776\841\77684162\xml1\RFR0002.JPG \\TICRS\EXPORT10\IMAGEOUT10\776\841\77684162\xml1\RFR0003.JPG \\TICRS\EXPORT10\IMAGEOUT10\776\841\77684162\xml1\RFR0004.JPG \\TICRS\EXPORT10\IMAGEOUT10\776\841\77684162\xml1\RFR0005.JPG
ORIGINAL PDF FILE	evi_63197243249-194042055_._LIBRA_Exhibit_B.pdf
CONVERTED PDF FILE(S) (3 pages)	\\TICRS\EXPORT10\IMAGEOUT10\776\841\77684162\xml1\RFR0006.JPG \\TICRS\EXPORT10\IMAGEOUT10\776\841\77684162\xml1\RFR0007.JPG \\TICRS\EXPORT10\IMAGEOUT10\776\841\77684162\xml1\RFR0008.JPG
DESCRIPTION OF EVIDENCE FILE	Exhibit A: Copies of third-party registrations for LIBRA marks in the financial sector. Exhibit B: Copies of third-party common law financial sector trademarks containing LIBRA.

ADDITIONAL STATEMENTS SECTION

DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of the word "LIBRA" in stylized letters with the letter "A" comprised of two triangles. The wording "Capital Management" appears below the word "LIBRA".
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SIGNATURE SECTION

RESPONSE SIGNATURE	/img/
SIGNATORY'S NAME	Linda M. Goldman
SIGNATORY'S POSITION	Attorney of record; CA bar member
DATE SIGNED	06/24/2010
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Jun 24 20:02:24 EDT 2010
TEAS STAMP	USPTO/RFR-63.197.243.249- 20100624200224969798-7768 4162-460377bf51af3d4b5d1e 54e2f0d06cab81-N/A-N/A-20 100624194042055148

FILED BY: [redacted]
DATE: 06/24/2010

**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **77684162** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

This Request for Reconsideration is being filed pursuant to 37 C.F.R. §2.64(b) and TMEP §715.03, in response to the Final Office Action concerning the above application for trademark registration. In the Final Office Action, the Examining Attorney maintained and made final the refusal to register Applicant's mark on the basis of a §2(d) likelihood of confusion with the following four registered marks:

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and

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EVIDENCE

Evidence in the nature of Exhibit A: Copies of third-party registrations for LIBRA marks in the financial sector. Exhibit B: Copies of third-party common law financial sector trademarks containing LIBRA. has been attached.

Original PDF file:

evi_63197243249-194042055_._LIBRA_Exhibit_A.pdf

Converted PDF file(s) (4 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Original PDF file:

evi_63197243249-194042055_._LIBRA_Exhibit_B.pdf

Converted PDF file(s) (3 pages)

Evidence-1

Evidence-2
Evidence-3

ADDITIONAL STATEMENTS

Description of mark

The mark consists of the word "LIBRA" in stylized letters with the letter "A" comprised of two triangles. The wording "Capital Management" appears below the word "LIBRA".

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /lmg/ Date: 06/24/2010

Signatory's Name: Linda M. Goldman

Signatory's Position: Attorney of record; CA bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77684162

Internet Transmission Date: Thu Jun 24 20:02:24 EDT 2010

TEAS Stamp: USPTO/RFR-63.197.243.249-201006242002249

69798-77684162-460377bf51af3d4b5d1e54e2f

0d06cab81-N/A-N/A-20100624194042055148

EXHIBIT A

Int. Cl.: 36

Prior U.S. Cl.: 102

United States Patent and Trademark Office Reg. No. 1,760,271
Registered Mar. 23, 1993

**SERVICE MARK
PRINCIPAL REGISTER**

LIBRA

GUARDIAN LIFE INSURANCE COMPANY OF
AMERICA, THE (NEW YORK CORPORA-
TION)
201 PARK AVENUE SOUTH
NEW YORK, NY 10003

FIRST USE 12-0-1986; IN COMMERCE
1-0-1987.

SER. NO. 74-299,876, FILED 7-29-1992.

FOR: INSURANCE SERVICES; NAMELY,
DISABILITY INSURANCE, IN CLASS 36 (U.S.
CL. 102).

CONNIE M. JUDGE, EXAMINING ATTORNEY

Int. Cl.: 36

Prior U.S. Cl.: 102

United States Patent and Trademark Office

Reg. No. 1,896,447

Registered May 30, 1995

**SERVICE MARK
PRINCIPAL REGISTER**



1ST FINANCIAL BANK SOUTH DAKOTA
(SOUTH DAKOTA CORPORATION)
P.O. BOX 98
DUPREE, SD 57623

FOR: ISSUING AND SERVICING CREDIT,
DEBIT, ACCESS AND PREPAID VALUE
CARDS AND ACCOUNTS, IN CLASS 36 (U.S.
CL. 102).

FIRST USE 6-17-1993; IN COMMERCE
6-17-1993.

MARK IS LINED FOR THE COLORS
BROWN, RED, BLUE, SILVER, PURPLE, AND
YELLOW, BUT COLOR IS NOT A FEATURE
OF THE MARK.

SEC. 2(F).

SER. NO. 74-411,543, FILED 7-9-1993.

ANDREW BAXLEY, EXAMINING ATTORNEY

Int. Cls.: 35, 36 and 41

Prior U.S. Cls.: 100, 101, 102 and 107

United States Patent and Trademark Office

Reg. No. 2,824,727

Registered Mar. 23, 2004

**SERVICE MARK
PRINCIPAL REGISTER**

PRO LIBRA

PRO LIBRA ASSOCIATES, INC. (NEW JERSEY CORPORATION)
6 INWOOD ROAD
MAPLEWOOD, NJ 070402529

FOR: EMPLOYMENT HIRING, RECRUITING, PLACEMENT AND STAFFING SERVICES FOR LIBRARIES AND SIMILAR INFORMATION CENTERS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 10-28-1975; IN COMMERCE 1-13-1978.

FOR: APPRAISAL OF REAL ESTATE, BOOKS, PERIODICALS AND AUDIO-VISUAL WORKS, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 10-28-1975; IN COMMERCE 1-13-1978.

FOR: LIBRARY CONSULTING SERVICES FOR LIBRARIES AND SIMILAR INFORMATION CENTERS, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 10-28-1975; IN COMMERCE 1-13-1978.

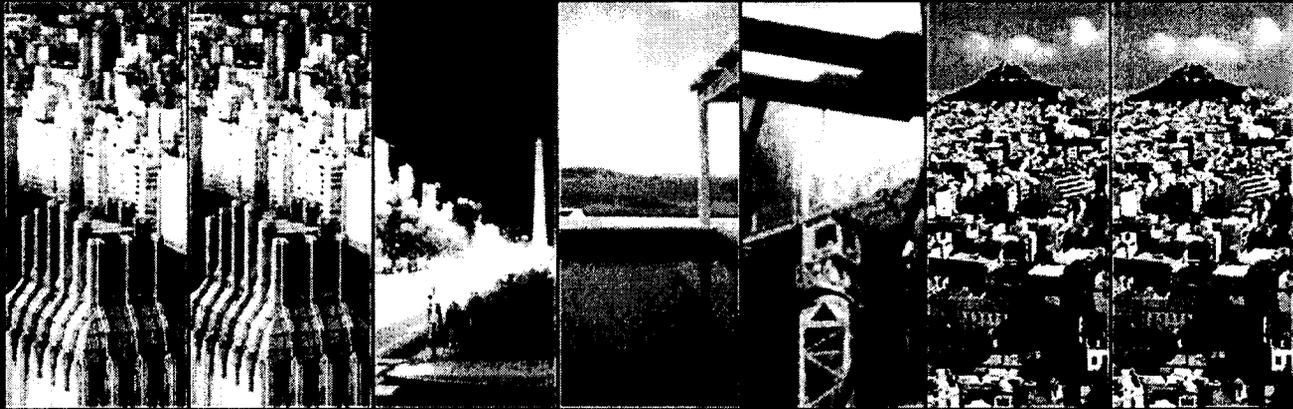
OWNER OF U.S. REG. NO. 1,232,989.

THE LATIN TRANSLATION OF "PRO LIBRA" IS "FOR BALANCE".

SER. NO. 76-501,244, FILED 3-19-2003.

IRA J. GOODSaid, EXAMINING ATTORNEY

EXHIBIT B



www.libra.com

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[Track Record](#)

[Global Reach](#)

[Libra at a glance](#)

[Management](#)

[Contact us](#)

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LIBRA FINANCIAL PLANNING

"Adding Balance To Your Financial Future"

HOME WHO WE ARE OUR SERVICES OUR MISSION CLIENT FORMS CLIENT NEWSLETTER WEB RESOURCES DISCLOSURE CONTACT US

Financial Planning, Investment Advisory and Income Tax Services designed to meet your needs!

Libra Financial Planning provides independent, objective, fee-only, hourly as-needed financial planning, investment advisory and income tax services to a wide range of clients. Our areas of expertise include retirement planning, education funding, asset allocation and tax minimization.

We offer attentive service and creative solutions suited to your unique situation and place an emphasis on client education and empowerment. Our clients tell us they appreciate our ability to explain the complexities of the financial world in a way that is meaningful and easy to understand. Our mission is to help you overcome uncertainty, take control of your finances and move confidently toward your goals.



Your Financial Planner

We are totally committed to your values and objectives. We will work with you to produce an unbiased, comprehensive analysis of your finances and taxes. You can count on us to deliver high-quality financial planning advice that fits your budget because we:

- **LISTEN** to your concerns and financial challenges
- **EVALUATE** your current situation
- **EDUCATE** you about realistic and achievable goals
- **DEVELOP** a detailed plan for achieving your objectives
- **SUPPORT** you with implementation strategies that promote your long-term success and financial well-being.

Managing your finances today, let alone planning for what tomorrow may bring, doesn't happen automatically - or easily. Squeezed by the demands of daily life, you may know the importance of planning for a secure financial future, but have placed it on the back burner. The good news is that financial planning doesn't have to be an overwhelming burden. It is a tool that's available to everyone, rather than a luxury for a select few.

Enjoy your visit to our website.



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info@librafinancialplanning.com

