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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78366359
Applicant	Broadview Advisors, LLC
Applied for Mark	BROADVIEW ADVISORS
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Submission	Appeal Brief
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Docket No.: 057628-0005 Trademark Application No. 78/366,359

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant	:	Broadview Advisors, LLC
Serial No.	:	78/366,359
Filed	:	February 11, 2004
Mark	:	BROADVIEW ADVISORS
International Class	:	36
Examining Attorney	:	Barney L. Charlon
Law Office	:	105

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APPLICANT'S APPEAL BRIEF

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APPLICANT'S APPEAL BRIEF

Applicant, Broadview Advisors, LLC ("Applicant"), respectfully submits its appeal from the final Office Action issued in the above-identified application.

I. SUMMARY OF THE PROSECUTION

Applicant filed its application for the mark BROADVIEW ADVISORS on February 11, 2004 for "financial investment and advisory services," in International Class No. 36.

On September 5, 2004, the Examining Attorney issued an Office Action, refusing registration on the basis that the "applicant's mark, when used on or in connection with the identified services, so resembles the mark in U.S. Registration No. 2497558 as to be likely to cause confusion, to cause mistake, or to deceive." The Examining Attorney also requested that Applicant respond to certain informalities, including that the recitation of services was unacceptable as indefinite. Applicant responded to the Office Action by arguing that Applicant's mark is unlikely to create confusion as compared to the mark in U.S. Registration No. 2497558. Applicant also amended its recitation of services to read: "financial investment in the field of securities; financial advisory services." ("Applicant's Services"). On January 11, 2006, the Examining Attorney issued a Final Office Action maintaining the refusal under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant filed its appeal and now submits its brief in support of registration of the BROADVIEW ADVISOR mark. Applicant respectfully submits that Applicant's mark is unlikely to create confusion as compared to the mark in U.S. Registration No. 2497558.

II. ARGUMENT

The sole issue on appeal is the Examining Attorney's refusal to register Applicant's mark on the basis of a perceived likelihood of confusion with the mark in U.S. Trademark Registration No. 2,497,558 for the mark BROADVIEW ("Cited Mark"). Applicant respectfully submits that its mark is unlikely to create confusion as compared to the Cited Mark.

Applicant respectfully states that the Cited Mark's services are very different from Applicant's services. The Cited Mark is claimed to be used in connection with "acquisition and merger consultation services relating to the information technology, communications and media industries," in International Class 35. In contrast to the services offered by the owner of the Cited Mark, Applicant's mark is intended for use with investment management services in the field of securities, i.e., financial advisory services, in International Class 36.

A likelihood of confusion determination is based on the test enunciated in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Likelihood of confusion is determined by examining several factors, including: (1) The similarity or dissimilarity of the marks in their entireties; (2) The similarity or dissimilarity and nature of the goods or services with which the marks are used; (3) The similarity or dissimilarity of the used trade channels; (4) The conditions under which, and buyers to whom, sales are made; (5) The fame of the prior mark; (6) The number and nature of similar marks; (7) Actual confusion. *Id.* Remarks on the relevant *Du Pont* factors are presented herein.

A. Similarity of the Marks in Their Entirety

The similarity of the marks in appearance, sound, and meaning is assessed under the first *Du Pont* factor. Generally, the appearance, sound, and meaning of the mark comprise the commercial impression of a given mark. Likelihood of confusion is based on the overall impression created by the mark as observed by an ordinary consumer in a marketplace. *Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Center*, 109 F.3d 275, 42 U.S.P.Q.2d 1173 (6th Cir. 1997).

The Cited Mark consists of one word. In contrast, Applicant's mark, BROADVIEW ADVISORS, is composite mark formed by two words. As such, the mark should not be dissected or split up into its component parts and each of them compared with corresponding parts of a potentially conflicting mark to determine the likelihood of confusion. When Applicant's mark, as a whole, is compared to the Cited Mark, as a whole, the differences in appearance and sound are readily apparent.

Applicant acknowledges that there is a degree of similarity in the two marks. However, such similarity falls short of a standard for rejection of a mark's registration. It is the impression that the mark as a whole creates on the average, reasonably prudent consumer, and not the individual parts thereof that are important. *Estate of P.D. Beckwith, Inc., v. Comm'r of Patents*, 252 U.S. 538, 545-46 (1920). The "use of identical, even dominant, words in common does not automatically mean that two marks are similar." *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987). That is, no one factor is determinative in the analysis. All of the other relevant factors should also be considered.

B. Similarity of Services with Which the Marks are Used

The services offered by the Applicant and by the owner of the Cited Mark are vastly different. In fact the only relationship between the two is that, in the broadest sense, they both in some way relate to the capitalization and ownership of companies.

Applicant has applied to register BROADVIEW ADVISORS for personal financial investment in the field of securities, and for financial advisory services. That is, Applicant offers investment advice to people, on the basis of which advice, the individuals will make investments to grow their wealth. In contrast, the owner of the Cited Mark provides consulting services on acquisitions and mergers relating to certain industries, namely, the information technology, communications and media industries. Therefore, the services offered by Applicant and by the owner of the Cited Mark are very distinct, and this factor weighs heavily against a finding of likelihood of confusion.

Each mark should be considered in its entirety as it is encountered in the marketplace. Courts have held that the mere fact that "two products or services fall within the same general field does not mean that the two products or services are sufficiently similar to create a likelihood of confusion." *Harlem Wizards Entm't Basketball, Inc. v. NBA Props., Inc.*, 952 F.Supp. 1084, 1096 (D.N.J. 1997). For example, the fact that both products could broadly be described as relating somehow to the same general field is not sufficient to find that the products have a similar use or function." *See Mach. Head v. Dewey Global Holdings, Inc.*, 61 USPQ2d 1313, 1318 (N.D. Cal. 2001). "Meaningful differences between the products and services are often cited as a factor tending to negate confusion, even when the products are superficially

within the same category." *Harlem Wizards Entm't Basketball, Inc.*, 952 F.Supp. at 1095; *see also Sunnenblick v. Harrell*, 895 F.Supp. 616, 629 (S.D.N.Y. 1995), *aff'd* 101 F.3d 684 (2d Cir. 1996).

C. Similarity of Used Trade Channels and Buyers to Whom Sales are Made

Those differences between the services offered by the owner of the Cited Mark and those offered by the Applicant are magnified even further when the channels of trade and the buyers to whom the services are offered are considered, as discussed in *Du Pont*'s third and fourth factors. The "channels of trade" factor concerns how and to whom the respective products are sold and distributed. *Homeowners Group, Inc. v. Home Marketing Specialist, Inc.*, 931 F.2d 1100, 18 U.S.P.Q.2d 1587, 1595 (6th Cir. 1991). "[T]his factor takes into account where, how, and to whom the parties' products are sold." *Frehling v. International Select Group*, 192 F.3d 1330, 1339, 52 U.S.P.Q.2d 1447 (11th Cir. 1999). Differences in the channels of trade in which goods and services are offered may avoid a likelihood of confusion conflict. J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:79; *In re Shoe Works, Inc.*, 6 U.S.P.Q.2d 1890 (T.T.A.B. 1988). For example, no likelihood of confusion was found between an applicant's mark PALM BAY for women's shoes and a cited mark PALM BAY for shorts and pants because the goods offered under each mark were sold in different stores, even though they were the types of goods that are classified in the same International Class 25 for clothing. *Id.*; *see also Sunnenblick v. Harrell*, 895 F.Supp. 616, 629 (S.D.N.Y. 1995) *aff'd* 101 F.3d 684 (2d Cir. 1996) (no confusion for jazz records and hip-hop records sold under the same UPTOWN mark because they were marketed to different consumers and sold in separate sections of the record store); *Lang v. Retirement Living Publishing Co.*, 949 F.2d 576 (2d Cir. 1991) (use of NEW CHOICES

FOR THE BEST YEAR for a magazine and NEW CHOICES PRESS for a publishing house was not likely to cause confusion).

Here, the scope of use of the Cited Mark is very limited. As indicated in the registration, the Cited Mark is used with management consulting services, in particular, with acquisition and merger consultation relating to the information technology, communications and media industries. As indicated on its web site, the owner of the Cited Mark is an investment bank "focused on the IT, communications, healthcare technology and digital media industries." Furthermore, the owner of the Cited Mark provides clients "with advice on merger and acquisition transactions, restructuring and equity private placements." Attached hereto are copies of relevant pages from the web site of the owner of the Cited Mark (Exhibit A).

In contrast, Applicant is an investment management firm. The services offered under the mark BROADVIEW ADVISORS are of financial nature, and they concern personal investments in the field of securities. Individual investors who are interested in financial investments in the field of securities use these financial services.

The buyers who purchase Applicant's financial advisory services such as financial investment in the field of securities are sophisticated buyers, frequently with special needs. These specialty buyers will exercise a higher degree of ordinary care, especially when they are purchasing financial advisory services at a significant cost. The consumers of services offered under the Cited Mark are concerned with investment banking related to acquisitions and mergers. These consumers are also sophisticated, having extremely valuable interests at stake.

The degree of sophistication of potential purchasers of goods and services is important in determining any likelihood of confusion. *McCarthy*, § 23:101. Sophisticated consumers exercise a higher degree of care when purchasing products and thus are less likely to be confused than the reasonably prudent ordinary buyer. *McCarthy* § 23:99. As such, the sophistication of the buyers of the product has been held to be the "most critical factor." *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 220 U.S.P.Q. 786 (1st Cir. 1983). Courts have also found that buyers exercise a higher degree of care when purchasing certain products or services. *McCarthy* § 23:99; *Luiginio's, Inc. v. Stouffer Corp.*, 170 F.3d 827, 50 U.S.P.Q.2d 1047 (8th Cir. 1999) (finding buyers exercise a higher degree of care when purchasing diet conscious food products); *First Nat'l Bank v. First Nat'l Bank, South Dakota*, 153 F.3d 885 (8th Cir. 1998) (finding buyers exercise a higher degree of care when selecting bank services); *Barbecue Marx, Inc. v. 551 Ogden, Inc.*, 235 F. 3d 1041 (7th Cir. 2000) (finding buyers exercise a higher degree of care when choosing $20 per meal restaurants).

In this case, consumers of the services offered under Applicant's mark and the Cited Mark generally are educated and experienced professionals in their respective fields who are very unlikely to be confused, especially about services being offered in an entirely different field, as is the case here. Accordingly, the factors of the channels of trade, the conditions of sale, and the sophistication of potential customers, weigh heavily against a finding of likelihood of confusion between the Applicant's mark and the Cited Mark.

D. Number and nature of similar marks

Between the Applicant's mark and the Cited Mark, the common element is the word BROADVIEW. This common element of course does exist in other registered trademarks. As evidenced at the USPTO web site, other live marks include the word BROADVIEW in the mark. The existence and use of other trademarks containing the word BROADVIEW demonstrates actual co-existence of such marks. Please find enclosed a copy of the TESS reports from the www.uspto.gov web site enlisting the summary of live marks that include the term BROADVIEW, attached hereto as Exhibit B.

The existence of other marks that include the term BROADVIEW in various industries is indicative of the fact that consumers of the products and services offered under these marks are already well-enough educated, and sophisticated enough, to discern differences between the sources of these goods and services. Consequently, Applicant respectfully submits that reasonable consumers of the services offered under the existing Cited Mark will have no trouble discerning that Applicant is a different company, offering different services, and that, again, based on this factor, there is no substantial likelihood of confusion.

On balance, the relevant *Du Pont* factors lead to a conclusion that there is no substantial likelihood of confusion between the Cited Mark and Applicant's mark. The question of confusion is "related not to the *nature* of the mark but to its *effect* when applied to the goods of the applicant" (emphasis in original). *Du Pont*, 476 F.2d 1357. On the basis of this analysis, the Examining Attorney is respectfully requested to withdraw the refusal of the proposed mark under Section 2(d).

III. CONCLUSION

For the foregoing reasons, Applicant respectfully submits that its mark is unlikely to create confusion as compared to the Cited Mark. Applicant respectfully requests that the Board reverse the Examining Attorney's refusal and instruct the Examining Attorney to pass the mark to publication.

Respectfully submitted,

BROADVIEW ADVISORS, LLC

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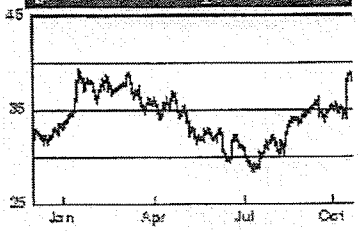

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