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UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICANT: Broadview Advisors, LLC

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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: BROADVIEW ADVISORS

CORRESPONDENT'S REFERENCE/DOCKET NO: 057628

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's refusal to register the trademark BROADVIEW ADVISORS, for "financial investment in the field of securities; financial advisory services," as amended. Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the ground that the mark, when applied to the services of applicant, so resembles the mark BROADVIEW, U.S. Registration No. 2497558, for "acquisition and merger consultation relating to the information technology, communications and media industries," as to be likely to cause confusion, or to cause mistake or to deceive. It is respectfully requested that this refusal be affirmed.

ARGUMENT

In re E.I. Dupont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), lists the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending on the evidence of record. In this case, the following factors are the most relevant: similarity of the marks, similarity of the services, and similarity of the trade channels of the services.

I. Similarity of the Marks

The marks are compared for similarities in sound, appearance, meaning or connotation. *Id.* Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988).

In the present case, applicant “acknowledges that there is a degree of similarity in the two marks.” Brief for Applicant at p.3. Applicant, however, argues that the marks at issue are distinguishable in that the “Cited Mark consists of one word. In contrast, Applicant’s mark, BROADVIEW ADVISORS, is composite mark [sic] 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.” *Id.*

The marks are compared in their entireties under a Section 2(d) analysis. Nevertheless, one feature of a mark may be recognized as more significant in creating a

commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In the present case, the term BROADVIEW is the dominant feature of applicant's mark, which otherwise consists of the disclaimed word ADVISORS. This dominant feature is identical to registrant's mark.

Accordingly, as applicant's mark BROADVIEW ADVISORS and registrant's mark BROADVIEW create the same commercial impression in that they are identical save for the addition to applicant's mark of the generic word ADVISORS, they must be deemed to be confusingly similar under Section 2(d).

II. Similarity of the Services and Channels of Trade

The services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); TMEP §1207.01(a)(i).

In the present case, applicant's "financial investment in the field of securities; financial advisory services" and registrant's "acquisition and merger consultation relating to the information technology, communications and media industries" are related in that they both concern financial and investment services and are the types of services which frequently emanate from a common source. In the latter regard, see the 12 third-party registrations enclosed with the final Office action, dated January 11, 2006, whose recitations of services include both applicant's and registrant's services.

Applicant, however, argues that the services at issue are distinguishable in that applicant's mark is 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." Brief for Applicant at p.4.

In addition, applicant argues that the trade channels in which applicant's and registrant's services move are dissimilar. In particular, applicant asserts that registrant "is an investment bank 'focused on the IT, communications, healthcare technology and digital media industries'" while applicant "is an investment management firm. The services offered under the mark BROADVIEW ADVISORS are of financial nature [sic], and they concern personal investments in the field of securities." *Id.* at p.6. In support of its position, applicant has submitted excerpts of registrant's website which describe registrant's services as providing "'advice on merger and acquisition transactions, restructuring and equity private placements.'"¹ *Id.*

Likelihood of confusion, however, is determined on the basis of the services identified in the application and registration. If the application describes the services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, it is presumed that the application encompasses all services of the type

1 In support of its description of registrant's services applicant has submitted excerpts of registrant's website as attachments to its brief, in contravention of 37 C.F.R. §2.142(d); TMEP §710.01(c). However, because these excerpts duplicate evidence already submitted by applicant in its March 7, 2005, response to the initial Office action, they will be addressed herein.

described, that they move in all normal channels of trade, and that they are available to all potential customers. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); TMEP §1207.01(a)(iii).

In its brief, applicant describes its services as “personal financial investment in the field of securities, and for financial advisory services.” Brief for Applicant at p.4. Applicant further characterizes its services as being “of financial nature [sic], 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.” *Id.* at p.6. Applicant’s recitation of services, however, defines applicant’s services merely as “financial investment in the field of securities; financial advisory services” and does not limit the scope of its financial services to those utilized by personal or individual investors. Accordingly, as applicant describes its services broadly without limitation as to their nature, type, channels of trade or classes of purchasers, it must be presumed that applicant’s services encompass all services of the type described, and that these services move in all normal trade channels and are available to all potential customers, including, as with registrant’s services, those in the information technology, communications and media industries.

That applicant’s and registrant’s services encompass the same potential customers is further supported by applicant’s own assertion that “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.” *Id.* at p.7. In so characterizing both its customers and those of registrant, then, applicant itself makes no distinction as to the type of purchaser of its services and registrant’s services.

In addition, while the excerpt of registrant's website made of record by applicant describes registrant's services as providing "advice on merger and acquisition transactions, restructuring and equity private placements," the same excerpt also describes registrant as a "corporate finance advisor." See the excerpts of registrant's website enclosed with applicant's communication dated March 7, 2005. Thus, as applicant's recitation of services includes "financial advisory services," this latter description of registrant as a "corporate finance advisor" further demonstrates that applicant's services are broad enough to encompass registrant's services. Moreover, the relatedness of applicant's and registrant's services is further supported by the fact that they are the types of services which frequently emanate from a common source. In this regard, see the 12 third-party registrations enclosed with the final Office action, dated January 11, 2006, whose recitations of services include both applicant's and registrant's services.

In further support of its argument that the channels of trade at issue are distinguishable, applicant cites *In re Shoe Works, Inc.*, 6 USPQ2d 1890 (TTAB 1988), in which no likelihood of confusion was found between the marks PALM BAY, and design, for women's shoes, and PALM BAY, for men's, women's and children's shorts and pants; *Sunenblick v. Harrell*, 38 USPQ2d 1716 (S.D.N.Y. 1995), in which two marks including the wording UPTOWN RECORDS, but also having distinguishing design features, were found not to create a likelihood of confusion when used in connection with jazz versus rap recordings; and *Lang v. Retirement Living Publishing Co., Inc.*, 21 USPQ2d 1041 (2d Cir. 1991), in which no likelihood of confusion was found between the trade name NEW CHOICES PRESS, for publishing services featuring image-building

books, and the mark NEW CHOICES FOR THE BEST YEARS, for a magazine directed to readers over the age of 50. Brief for Applicant at pp.5-6.

The cases relied on by applicant, however, are all clearly distinguishable from the present case. Specifically, in *In re Shoe Works, Inc.*, the Trademark Trial and Appeal Board, in finding no likelihood of confusion between the marks PALM BAY, and design, for women's shoes, and PALM BAY, for men's, women's and children's shorts and pants, placed great emphasis on the fact that applicant and the cited registrant had entered into a consent agreement under which applicant was permitted to register its mark, and that applicant had amended its identification of goods to "women's shoes sold solely through applicant's retail shoe store outlets." 6 USPQ2d at 1890-1891. By contrast, applicant and registrant in the present case have not entered into a consent agreement allowing for the registration of applicant's mark and, as previously discussed, applicant has not limited the scope of its services so as to distinguish them from registrant's services.

Similarly, in *Sunenblick v. Harrell*, in which two marks including the wording UPTOWN RECORDS were found not to create a likelihood of confusion when used in connection with jazz versus rap recordings, the court stressed the marks' distinguishing design features as well as the fact that in the case of musical recordings consumers are less susceptible to source confusion because they are more concerned about the identity of the musical artists featured on such recordings than they are the name of the record label. 38 USPQ2d at 1726, 1729. Unlike the marks in this decision, however, the marks in the present case do not include design elements and are not used in connection with entertainment products such as musical recordings where the identity of the artist is more

relevant to consumers then is the name of the record label. And in *Lang v. Retirement Living Publishing Co., Inc.*, in which no likelihood of confusion was found between the trade name NEW CHOICES PRESS, for publishing services featuring image-building books, and the mark NEW CHOICES FOR THE BEST YEARS, for a magazine directed to readers over the age of 50, the court focused primarily on the dissimilarity of the marks and the different classes of consumers of the goods at issue, respectively, image-builders and older adults. 21 USPQ2d at 1045. In the present case, however, applicant's mark BROADVIEW ADVISORS and registrant's mark BROADVIEW are identical save for the addition to applicant's mark of the generic word ADVISORS and, as previously noted, applicant's and registrant's services both comprise finance-related services which are available to the same potential consumers.

Applicant additionally argues that confusion as to the source of applicant's and registrant's services is unlikely due to the relative sophistication of the consumers of these services. Brief for Applicant at pp. 6-7. Finally, applicant asserts that registrant's mark is not entitled to a scope of protection which is sufficient to bar registration of applicant's mark because the word BROADVIEW has become diluted through third-party usage. *Id.* at p.8. In this regard, applicant has made of record three third-party registrations which include the word BROADVIEW in the mark.

The fact that purchasers are sophisticated or knowledgeable in a particular field, however, does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); TMEP §1207.01(d)(vii). Third-party registrations, moreover, are entitled to little weight on the question of likelihood of confusion. *In re Melville Corp.*,

18 USPQ2d 1386, 1388 (TTAB 1991). Third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of those marks. *In re Comexa Ltda*, 60 USPQ2d 1118 (TTAB 2001); TMEP §1207.01(d)(iii). Further, existence on the register of other confusingly similar marks would not assist applicant in registering yet another mark which so resembles the cited registered mark that confusion is likely. *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999). This is particularly true in the present case where the third-party registrations cited by applicant - U.S. Registration No. 2636354, for production and distribution of commercials, films and television programs; U.S. Registration No. 2494916, for telecommunications services; and U.S. Registration No. 1823858, for dairy products -- are for goods and services which are completely unrelated to the services presently at issue. Thus, applicant has failed to demonstrate that the word BROADVIEW has become diluted in the field of financial services.

Accordingly, as applicant's securities investment and financial advisory services and registrant's acquisition and merger consultation services both involve finance, are potentially available to the same class of consumers, and are the types of services which frequently emanate from a common source, they must be deemed to be related services.

CONCLUSION

In sum, applicant's mark BROADVIEW ADVISORS and registrant's mark BROADVIEW are legally identical in that they consist of the same wording except for the addition to applicant's mark of the generic word ADVISORS. Furthermore, applicant's financial investment and advisory services and registrant's acquisition and merger consultation services are related in that they both concern finance, are offered to

the same potential customers, and are the types of services which commonly emanate from the same source.

For the foregoing reasons, the refusal of registration under Section 2(d) of the Trademark Act should be affirmed, especially since any doubt as to the issue of likelihood of confusion should be resolved in favor of the prior registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979).

Respectfully submitted,

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