

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79171600
LAW OFFICE ASSIGNED	LAW OFFICE 114
MARK SECTION	
MARK FILE NAME	https://tmng-al.uspto.gov/resting2/api/img/79171600/large
LITERAL ELEMENT	RESPONSIBLE PRODUCTIVE FINANCES
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO

ARGUMENT(S)

This is in response to the Office Action dated April 29, 2016 in this application.

A. The Office Action

The Examining Attorney maintains the refusal of registration of the proposed trademark stating that there is a likelihood of confusion under Section 2(d) of the Trademark Act between applicant's mark and the mark RESPONSIBLE FINANCE, registration 4,407,271.

Applicant appreciates the remarks of the Examining Attorney, but maintains its original position that no likelihood of confusion exists between the proposed mark and the mark that is subject of the cited registration. Applicant repeats and realleges the arguments contained in its previous response and provides the additional comments below.

The general rule for comparing Applicant's mark and the registered mark is that the trademarks must be considered in their entireties focusing on the appearance, sound, connotation and commercial impression. Thus, it would be appropriate to inquire if one element is dominant in creating the commercial impression and it would be reasonable to give more or less weight to a particular element of the marks.

In this regard, simply sharing common elements does not compel a finding of likelihood of confusion. *See Mr. Hero Sandwich Systems, Inc.*, 781 F.2d at 884 (finding that sharing a single common element did not create a likelihood of confusion). Conflicting marks, where words and pictorial symbols also appear, must be compared in their entireties to determine likelihood of confusion. *See Columbian Steel Tank Co. v. Union Tank & Supply Co.*, 277 F.2d 192, 125 U.S.P.Q. 406 (C.C.P.A. 1960); *King of the Mountain Sports, Inc. v. Chrysler Corp.*, 185 F.3d 1084, 51 U.S.P.Q.2d 1349 (10th Cir. 1999) (Because marks are to be compared in their entireties, even if the "dominant" parts of the conflicting word-design marks are the identical words, the marks as a whole are not confusingly similar). Particularly, if one mark consists of a design and a word, and the other mark of merely a word, similarity is usually controlled by determining whether the word or the design dominates the first mark.

Thus, after thorough consideration of all relevant facts pertaining to the trademarks' appearances, sounds, connotations, and commercial impressions, the appropriate test is whether there a likelihood of confusion as to source of the goods or services. In other words, will the consumer believe that the owners of the two trademarks are related, affiliated, connected, or that the goods or services originate from the same source.

The owner of the proposed mark is FUNDACION BBVA PARA LAS MICROFINANZAS, which is well known and distinguished for its specific and distinct design of a monogram "FIF" featuring a lower case "i" between forward and reverse upper case "F"s is highly distinctive and is a dominant element in the applied for mark.

The applied for mark, when considered as a whole and as a composite mark, creates a different overall commercial impression than the cited registration.

Furthermore, the distinctive and unusual FIF monogram design is the subject of Applicant's earlier design trademark registration 3,730,665 and is part of Applicant's earlier registration FIF FINANZASPRODUCTIVAS and design.

Thus, consumer recognition has already been established with the monogram design FIF which is the dominant element of the applied for mark.

Applicant concludes that its present composite mark viewed in its entirety is readily distinguishable from the cited registration. Therefore, Applicant requests that the Examiner withdraw the refusal to register the present mark on the grounds of likelihood of confusion.

In the event that the Examining Attorney is not able to review this response and withdraw the refusal to register within the Office Action response term of October 29, 2016, a Notice of Appeal is submitted simultaneously herewith to protect the rights of the Applicant.

In view of the foregoing, it is respectfully submitted that the application is now in condition for publication, and reconsideration and publication is requested.

SIGNATURE SECTION

RESPONSE SIGNATURE	/dcl/
SIGNATORY'S NAME	Donald C. Lucas
SIGNATORY'S POSITION	attorney for applicant
SIGNATORY'S PHONE NUMBER	212-661-8000
DATE SIGNED	10/31/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Mon Oct 31 12:46:47 EDT 2016
TEAS STAMP	USPTO/RFR-XXX.XXX.XXX.XX- 20161031124647151886-7917 1600-5702835d47fad3d2985a 8b2b19bff20b328ef829f07eb 982ae1ed66fdf76f5512-N/A- N/A-20161031122938391194

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **79171600** RESPONSIBLE PRODUCTIVE FINANCES (Stylized and/or with Design, see <https://tmng-al.uspto.gov/resting2/api/img/79171600/large>) has been amended as follows:

ARGUMENT(S)

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

This is in response to the Office Action dated April 29, 2016 in this application.

A. The Office Action

The Examining Attorney maintains the refusal of registration of the proposed trademark stating that there is a likelihood of confusion under Section 2(d) of the Trademark Act between applicant's mark and the mark RESPONSIBLE FINANCE, registration 4,407,271.

Applicant appreciates the remarks of the Examining Attorney, but maintains its original position that no likelihood of confusion exists between the proposed mark and the mark that is subject of the cited registration. Applicant repeats and realleges the arguments contained in its previous response and provides the additional comments below.

The general rule for comparing Applicant's mark and the registered mark is that the trademarks must be considered in their entireties focusing on the appearance, sound, connotation and commercial impression. Thus, it would be appropriate to inquire if one element is dominant in creating the commercial impression and it would be reasonable to give more or less weight to a particular element of the marks.

In this regard, simply sharing common elements does not compel a finding of likelihood of confusion. See *Mr. Hero Sandwich Systems, Inc.*, 781 F.2d at 884 (finding that sharing a single common element did not create a likelihood of confusion). Conflicting marks, where words and pictorial symbols also appear, must be compared in their entireties to determine likelihood of confusion. See *Columbian Steel Tank Co. v. Union Tank & Supply Co.*, 277 F.2d 192, 125 U.S.P.Q. 406 (C.C.P.A. 1960); *King of the Mountain Sports, Inc. v. Chrysler Corp.*, 185 F.3d 1084, 51 U.S.P.Q.2d 1349 (10th Cir. 1999) (Because marks are to be compared in their entireties, even if the "dominant" parts of the conflicting word-design marks are the identical words, the marks as a whole are not confusingly similar). Particularly, if one mark consists of a design and a word, and the other mark of merely a word, similarity is usually controlled by determining whether the word or the design dominates the first mark.

Thus, after thorough consideration of all relevant facts pertaining to the trademarks' appearances, sounds, connotations, and commercial impressions, the appropriate test is whether there a likelihood of confusion as to source of the goods or services. In other words, will the consumer believe that the owners of the two trademarks are related, affiliated, connected, or that the goods or services originate from the same source.

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In view of the foregoing, it is respectfully submitted that the application is now in condition for publication, and reconsideration and publication is requested.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /dcl/ Date: 10/31/2016

Signatory's Name: Donald C. Lucas

Signatory's Position: attorney for applicant

Signatory's Phone Number: 212-661-8000

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 owner's/holder'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 owner/holder in this matter: (1) the owner/holder 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 owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder'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: 79171600

Internet Transmission Date: Mon Oct 31 12:46:47 EDT 2016

TEAS Stamp: USPTO/RFR-XXX.XXX.XXX.XX-201610311246471

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