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Subject: U.S. TRADEMARK APPLICATION NO. 85362134 - VAULT BIOVENTURES - 118199-1 - EXAMINER BRIEF

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**U.S. APPLICATION SERIAL NO.** 85362134

**MARK:** VAULT BIOVENTURES



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** Vault Bioventures, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

118199-1

**CORRESPONDENT E-MAIL ADDRESS:**

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

The Applicant, Vault Bioventures, Inc., has appealed the Examining Attorney's refusal

to register the mark VAULT BIOVENTURES in standard characters under §2(d) of the Trademark Act of 1946 (as amended) (hereinafter “the Trademark Act”), 15 U.S.C. §1052(d) for services in Class 35. This refusal is the only issue on appeal.

## FACTS

On July 1, 2011 Applicant filed an intent to use based application for the mark VAULT BIOVENTURES in standard characters for services in Class 35 defined as:

Assistance, advisory services and consultancy with regard to business analysis, business development, business operations, marketing, product commercialization, clinical and market research and development, branding, project management, portfolio management and medical communications in the field of biopharmaceutical and biotechnology companies

In an office action dated October 21, 2011 the Examining Attorney refused registration based on a likelihood of confusion, Section 2(d) of the Trademark Act, with U.S. Registration Nos. 4030759, 4030758 and 3864144.<sup>1</sup>

Registration 4030759 VAULT COMMUNICATIONS, INC. in standard characters for “Class 35--public relations, marketing and advertising services, namely, promoting and marketing the goods and services of others through public communication means.” Owned by Vault Communications, Inc., corporation of Pennsylvania.

Registration 4030758 VAULT COMMUNICATIONS, INC. in special form for “Class 35--public relations, marketing and advertising services, namely, promoting and marketing the goods and services of others through public communication means.” Owned by Vault Communications, Inc., corporation of Pennsylvania.

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<sup>1</sup> The VAULT COMMUNICATIONS, INC. marks were initially refused registration based on a likelihood of confusion with the THE VAULT mark. The refusal was only withdrawn after the parties (now the currently cited Registrants) reached a consent agreement. *See* copy of response to office action filed by Vault Communications, Inc. in response to refusal to register attached to the Final refusal of May 15, 2012.

Registration 3864144 THE VAULT in standard characters for “Class 35--advertising, marketing and promotion services.” Owned by The Vault NYC, LLC limited liability company, New York.

The first office action also required Applicant to disclaim the wording BIOVENTURES and amend the description of services. On April 23, 2012 Applicant responded to the office action arguing against a likelihood of confusion, providing the required disclaimer and amending the description of services including the addition of classes 38 and 42.<sup>2</sup> Applicant’s class 35 description of services, as amended, reads as follows:

Class 35-Assistance, advisory services and consultancy with regard to business analysis, business development, business operations, marketing, product commercialization, market research, branding, business project management and portfolio management for biopharmaceutical and biotechnology companies

On May 15, 2012 the Examining Attorney issued a Final action refusing registration under Section 2(d) of a Trademark Act limited to services in Class 35.<sup>3</sup> On November 15, 2012 Applicant filed a Notice of Appeal and Request for Reconsideration. On December 6, 2012 the Examining Attorney issued an action denying the Request for Reconsideration.

#### **ISSUE ON APPEAL**

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<sup>2</sup> Applicant’s description of services in classes 38 and 42 read as follows: Class 38--Assistance, advisory services and consultancy with regard to communications in the medical field for biopharmaceutical and biotechnology companies; Class 42--Assistance, advisory services and consultancy services with regard to clinical research and product development for biopharmaceutical and biotechnology companies.

<sup>3</sup> The refusal to register in the Final action is limited to class 35. The Final action makes clear that services in classes 38 and 42 are not barred from registration.

Whether Applicant's proposed use of the mark VAULT BIOVENTURES in standard characters for services defined as:

Class 35--Assistance, advisory services and consultancy with regard to business analysis, business development, business operations, marketing, product commercialization, market research, branding, business project management and portfolio management for biopharmaceutical and biotechnology companies

creates a likelihood of confusion with the following U.S. registrations:

4030759 VAULT COMMUNICATIONS, INC. in standard characters for "Class 35--public relations, marketing and advertising services, namely, promoting and marketing the goods and services of others through public communication means." Owned by Vault Communications, Inc., corporation of Pennsylvania.

4030758 VAULT COMMUNICATIONS, INC. in special form for "Class 35--public relations, marketing and advertising services, namely, promoting and marketing the goods and services of others through public communication means." Owned by Vault Communications, Inc., corporation of Pennsylvania.

3864144 THE VAULT in standard characters for "Class 35--advertising, marketing and promotion services." Owned by The Vault NYC, LLC limited liability company, New York.

#### **LIKELIHOOD OF CONFUSION ANALYSIS**

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the Applicant and Registrant. See 15 U.S.C. §1052(d). In the seminal decision *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973),

the court listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). See TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the Registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the Registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

## ARGUMENT

### 1. THE MARKS ARE HIGHLY SIMILAR

*Applicant's Mark and Registrations 4030759 and 4030758 VAULT COMMUNICATIONS, INC. and VAULT COMMUNICATIONS, INC. in special form.*

Applicant's mark, VAULT BIOVENTURES and registrations 4030759 and 4030758 for VAULT COMMUNICATIONS, INC. and VAULT COMMUNICATIONS, INC. in special form are highly similar. Each mark contains the distinctive wording VAULT as the first and most dominant portion. This shared wording creates a strong similarity.

The added wording in each mark is descriptive, disclaimed, and does not remove the similarity created by the shared dominant wording VAULT. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Here, the added wording in each mark is highly descriptive. Indeed, Applicant states in its brief that “[o]n a scale of one to ten, with one being the most descriptive, BIOVENTURES would definitely be much closer to a one or a two.” Applicant’s brief at 6. Thus, by Applicant’s own admission, the added wording in its mark is highly descriptive and therefore much less important in creating commercial impression.

Additionally, with respect to registration 4030758 the design element serves to strengthen the commercial impression of the VAULT portion. The wording VAULT in registration 4030758 is extremely large in relation to the remaining wording. This dominant wording is identical to the first and most dominant portion of Applicant’s mark. Thus, the marks are highly similar.

*Applicant’s Mark and Registration 3864144 THE VAULT.*

Applicant's mark, VAULT BIOVENTURES and registration 3864144 THE VAULT are highly similar. Each mark contains the distinctive wording VAULT as the most dominant portion. This shared wording creates a strong similarity.

The added wording THE in the registered mark does not overcome the similarity created by the shared and dominant wording VAULT. When comparing similar marks, the Trademark Trial and Appeal Board has found that inclusion of the term "the" at the beginning of one of the marks will generally not affect or otherwise diminish the overall similarity between the marks. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (finding WAVE and THE WAVE "virtually identical" marks; "[t]he addition of the word 'The' at the beginning of the registered mark does not have any trademark significance."); *In re Narwood Prods. Inc.*, 223 USPQ 1034, 1034 (TTAB 1984) (finding THE MUSIC MAKERS and MUSIC-MAKERS "virtually identical" marks; the inclusion of the definite article "the" is "insignificant in determining likelihood of confusion") *Bank of Am. Nat'l Trust & Savings Ass'n v. First Nat'l Bank of Allentown*, 220 USPQ 892, 896 (TTAB 1984) (finding TIME\$AVER and THE TIMESAVER STATEMENT to be "confusingly similar" marks).

Further, as discussed above, the highly descriptive and disclaimed matter BIOVENTURES in the Applicant's mark does not remove the similarity created by the shared and dominant wording VAULT.

The most dominant and distinctive matter in Applicant's mark is VAULT. The added disclaimed matter BIOVENTURES is highly descriptive and does not alter the commercial impression created by the VAULT portion. The dominant portion of the registered marks is VAULT. The added wording and/or design elements do not alter the commercial impression created by this shared wording. Therefore, the marks are highly similar and the refusal to register should be affirmed.

## 2. THE SERVICES ARE HIGHLY RELATED

The services of the parties are highly related. Here, the Registrants' marketing, advertising and promotion services are essentially identical to Applicant's "marketing," and "branding" services (branding is an advertising activity per the dictionary page attached to the Final action).

The descriptions in the registrations are not limited to a specific industry. Thus, it is presumed that the Registrants operate in all fields including the fields of the Applicant. Unrestricted and broad identifications are presumed to encompass all services of the type described. See *In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identifications set forth in the cited registrations use broad wording to describe the services and do not contain any limitations as to channels of trade or classes of purchasers. Therefore, it is presumed that the registrations encompass all services of the types described, that the services move in all normal channels of trade, and that they are available to all potential customers. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). Thus, the Registrants' unrestricted marketing and advertising services include the industry specific marketing and advertising services provided by the Applicant.

Furthermore, the website pages of Registrant "Vault Communications, Inc.," attached to the Final action, make clear that it actually operates in the pharmaceutical industry just as the Applicant does. The "Vault Communications, Inc." website shows clients including the large pharmaceutical company "Aventis," (which is now merged to become "Sanofi"), as well as BSF which operates a pharmaceutical division and "AmerisourceBergen" which is a pharmaceutical distributor. See the web pages of Sanofi, BSF and AmerisourceBergen attached to the Final action for verification that these companies, who are clients of the Registrant, operate in the pharmaceutical industry. Thus, not only are the clients of the parties presumed to overlap but the evidence of record shows that the Registrant "Vault Communications, Inc." actually operates in the very industry defined by the Applicant.

Moreover, the third party web pages attached to the Final action show that it is common for marketing/advertising services providers, such as the Registrants, to operate in multiple industries at one time (not limiting service provision to specific industries.). The evidence shows that such industries commonly include the industries to which Applicant limits its description. Thus, consumers would expect marketing companies, such as the Registrants, to operate in multiple fields, including those identified by the Applicant. Therefore, the evidence demonstrates that the services are related because the industries to which Applicant limits its channels of trade are normal channels of trade for marketing/advertising companies such as the Registrants. The third party web pages include the following:

- BLUE SAGE CONSULTING, INC. which claims to have serviced “scores of companies and organizations” in broad industries including “Healthcare” with clients including “Pharmacia Corporation/Pfizer” as well as the diverse industries of “Non-profit,” “Schools & Universities” and “Technology.” [www.bluesageconsulting.com](http://www.bluesageconsulting.com).
- FROST & SULLIVAN who’s website lists diverse industries including “Advanced Medical Technologies” and “Life Sciences” under the general “Healthcare” heading and as well as “Chemicals, Materials and Food” and “Automotive and Transportation.” [www.frost.com](http://www.frost.com)
- J&M MANAGEMENT CONSULTING which states “Our client portfolio comprises prestigious industrial companies and commercial enterprises. Though they range from medium-sized, family-run firms to international conglomerates, the challenges they face are similar.” The website lists diverse industries including “Life Science Industry,” and “Chemical Industry,” as well as “Aerospace and Defense” and “Building Material Industry.” [www.jnm.com](http://www.jnm.com)
- ADAYANA who’s website claims to identify “only a fraction of our clients and represents and diversity and breadth of our industry experience.” The website lists industries including “Healthcare” with clients including “Abbott” as well as diverse industries including “Agribusiness,” “Automotive,” and “Government.” [www.adayana.com](http://www.adayana.com)
- LUCINTEL which states “As the global leader in management consulting and market research, we have provided insights and increased bottom line growth for more than 1,000 leading companies in more than 70 countries. Clients across the value chain have come to value our services.” The website lists diverse industries including “Medical,” “Chemical and Composites” and “Consumer Goods.” [www.lucintel.com](http://www.lucintel.com)

- JENA COMMUNICATIONS which claims “Industry Expertise” in diverse industries including “Biotechnology,” “Medical” and “Pharmaceutical” as well as “Gaming,” “Retail,” “Education,” and “Political Marketing.” [www.jenacommunications.com](http://www.jenacommunications.com)
- ROAR MEDIA which claims to work in diverse sectors including “Healthcare,” and “High Tech/High Growth” to “Financial Services” and “Real Estate.” [www.roarmedia.com](http://www.roarmedia.com)
- PARTNERS MARKETING GROUP which states “Since 2001, we have worked with over 150 clients spanning dozens of industries.”
- MCDOUGALL & DUVAL ADVERTISING which states “We specialize in strategic planning, creative services, public relations, direct marketing and interactive, and serve a wide range of industries including: . . .Healthcare . . .Real Estate. . .Technology.” [www.mcdougallduval.com](http://www.mcdougallduval.com)
- LEVELWING which identifies industries served as including “Healthcare” and “Pharmaceutical” to “Publishing,” “Retail,” and “Travel & Tourism.” [www.levelwing.com](http://www.levelwing.com)

Again, the evidence highlighted above shows that marketing and advertising providers/consultants commonly work in a variety of industries including the industry defined by the Applicant and that normal channels of trade for marketing/advertising providers include the industries to which Applicant limits its description.

With respect to Applicant’s more general business consulting/advisory services the third party web pages attached to the Final action show that it is common for providers of marketing/advertising services, such as the Registrants, who commonly provide services to multiple industries as discussed above, to also provide business consulting such as provided by the Applicant under a single mark. A review of the third party web pages shows the following companies using a single mark for both marketing and business consulting:

- BLUE SAGE CONSULTING INC. for business management, business analysis and business plan development as well as marketing consulting. [www.bluesageconsulting.com](http://www.bluesageconsulting.com)
- FROST & SULLIVAN for business strategy consulting as well as a variety of marketing services. [www.frost.com](http://www.frost.com)

- LUCINTEL for management consulting as well as market research and entry strategy. [www.lucintel.com](http://www.lucintel.com)
- ADAYANA for business strategy development as well as market intelligence studies, market evaluation, prioritization and selection and market research. [www.adayana.com](http://www.adayana.com)
- J&M MANAGEMENT CONSULTING for business strategy consulting as well as marketing. [www.jnm.com](http://www.jnm.com)
- BUFORD CREEK for management, business development and marketing consulting. [www.bufordcreek.com](http://www.bufordcreek.com)
- PICUS ENTERPRISES, LLC for management consulting as well as marketing services. [www.picuserprises.com](http://www.picuserprises.com)
- STRATIVA for business consulting and project management as well as marketing services. [www.strativa.com](http://www.strativa.com)
- GLOBAL BUSINESS CONSULTING for business and management consulting as well as marketing and advertising. [www.gbci.net](http://www.gbci.net)
- CORVUS MARKETING ANALYSIS CONSULTING for “Management consulting, business analysis & strategic marketing.” [www.corvusmarketing.com](http://www.corvusmarketing.com)
- JOHN RUST CONSULTING for business management, business development and strategic planning consulting as well as marketing consulting. [www.johnrustconsulting.com](http://www.johnrustconsulting.com)

Similarly, the 16 use based third party registrations attached to the Final action show that it is common for marketing and advertising service providers to also provide business consulting services such as defined by the Applicant under a single mark. A representative sample of the registrations are highlighted below:

- Registration 3826254 (owned by McCluney, Alan M., DBA AMM Solutions) for services including “assistance, advisory services and consultancy with regard to business planning, business, analysis business management” as well as the “assistance, advisory services and consultancy” in the field of “marketing.”
- Registration 3840096 (owned by Growth Catalysts, Inc.) for services including a variety of business consulting services and branding services as well as a variety of marketing services.

- Registration 3891926 (owned by Cunningham Group, Inc.) for services including “assistance, advice and consultancy with regard to business planning, business analysis, business management and business organization,” and “Branding services” as well as advertising services.
- Registration 3988979 (owned by PMGTVA, INC. DBA PMGT Corporation) for services including “assistance, advisory services and consultancy with regard to business planning, business analysis, business management and business organization,” and “Branding services” as well as advertising and marketing consulting.
- Registration 3849972 (owned by Fathom SEO) for services including “assistance, advisory services and consultancy with regard to business planning, business analysis, business management and business organization,” as well as a variety of marketing and advertising services.

The third party web pages and registrations demonstrate that marketing and advertising service providers such as the Registrants, who commonly operate in multiple industries, also commonly provide other business consulting services such as provided by the Applicant under a single mark.

The Registrants’ unrestricted descriptions of services include the marketing and branding services of the Applicant. The web pages of Registrant “Vault Communications, Inc.” show that it actually operates in the same industry as Applicant. The third party web pages show both that it is common for marketing, advertising and business consulting service providers to provide such services in multiple industries, including the industry identified in Applicant’s description of services, and that it is common for providers of business related consulting, such as the Applicant, to also provide marketing and advertising, such as provided by the Registrants, under a single mark. The third party registrations show that it is common for providers of business related consulting and branding, such as the Applicant, to also provide marketing and advertising services, such as provided by the Registrants, under a single mark. The evidence of record overwhelmingly establishes that the services are related. Thus, refusal to register should be affirmed.

3. APPLICANT'S ARGUMENTS ARE UNPERSUASIVE

Applicant argues that the added wording BIOVENTURES in its mark obviates the similarity created by the shared wording VAULT. However, as discussed above, the added wording is highly descriptive and disclaimed. Thus, inclusion of this matter does not remove the similarity created by the shared dominant wording.

Applicant argues that the commercial impressions created by the marks are different. No evidence has been supplied to support Applicant's position. On the contrary, each mark contains the wording VAULT as the primary and distinctive portion. Thus, any commercial impression created by the wording VAULT in THE VAULT is shared in VAULT BIOVENTURES. Likewise, any commercial impression created by VAULT in VAULT COMMUNICATIONS, INC. is shared in VAULT BIOVENTURES.

Applicant argues that its channels of trade are limited. However, as discussed above, no limits appear in the Registrants' descriptions of services and normal channels of trade for advertising/marketing service providers include the channels of trade to which Applicant limits its description. Further, the evidence of record firmly establishes that, despite Applicant's limitation in its description, the services are related. Indeed, as discussed above, the web pages of Registrant "Vault Communications, Inc." show that it actually operates in the same industry as Applicant. The third party web pages show that it is common for advertising and marketing providers to provide such services in multiple industries including that of the Applicant. Thus, Applicant and Registrants are presumed to compete for the same clients and market their services to the same potential clients in the same channels of trade. The markets of the Registrants include the very market to which Applicant has limited its description.

Finally, Applicant argues that the purchasers are sophisticated. No evidence has been supplied to support this conclusion. Thus, it stands as mere conjecture. Further, even if the purchasers are

sophisticated there still is a likelihood of confusion. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, 34 USPQ2d 1526, 1530 (Fed. Cir. 1995); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

### **CONCLUSION**

The marks at issue, VAULT BIOSCIENCES, VAULT COMMUNICATIONS, INC., VAULT COMMUNICATIONS INC. in special form, and THE VAULT are highly similar. The evidence of record firmly establishes that the services are highly related. Thus, there is a likelihood of confusion and the refusal to register should be affirmed.

Respectfully submitted,

/Daniel F. Caphaw/

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