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Subject: U.S. TRADEMARK APPLICATION NO. 85732059 - A&M WOLVERINE ASSURANCE COMPANY - 359305.00071 - Request for Reconsideration Denied - Return to TTAB - Message 1 of 10

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 85732059

MARK: A&M WOLVERINE ASSURANCE COMPANY



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

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

APPLICANT: Alvarez & Marsal Holdings, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

359305.00071

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 6/7/2014

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated October 21, 2013 are maintained and continue to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied and the case will be returned to the TTAB for further processing.

Refusal To Register Under Section 2(d)—Likelihood of Confusion

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3239010. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely 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). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. This refusal is continued and maintained for the reasons set forth below.

I. Comparison of the Marks

Applicant's mark "A&M Wolverine Assurance Company" is confusingly similar to registrant's mark "Wolverine Investments." In the present case, the terms "A&M Wolverine" and "Wolverine" are the dominant features of the respective marks because they are combined with generic wording, which has been disclaimed. The term "Wolverine" is not weak because it has no meaning in relation to the services identified in the application or the cited registration.

The term "Wolverine" in registrant's mark is arbitrary when applied to the services identified in the application. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (VEUVE – meaning WIDOW in English – held to be "an arbitrary term as applied to champagne and sparkling wine, and thus conceptually strong as a trademark"). Therefore, the term "Wolverine" is conceptually strong as a service mark for registrant's

services and entitled to a broad scope of protection. Moreover registrant's mark is the only mark that contains the term "Wolverine" for securities and/or insurance related services. Therefore, the term is not diluted in the Trademark Database.

It is clear that the marks both contain the identical term "Wolverine" and differ because of the addition of the house mark "A&M." Adding a house mark to an otherwise confusingly similar mark will not obviate a likelihood of confusion under Section 2(d). See *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366-67 (TTAB 2007) (finding CLUB PALMS MVP and MVP confusingly similar). When the common part of the marks is identical, purchasers familiar with the registrant's mark are likely to assume that the house mark simply identifies what had previously been an anonymous source. See *In re Hill-Behan Lumber Company*, 201 USPQ 246 (TTAB 1978).

The addition of the generic term "assurance company" in applicant's mark does not change the overall commercial impression of the mark. See attached evidence third party registrations which show that the term "assurance" is generic and disclaimed when used in connection with insurance company services. Generic terms are by definition incapable of indicating a particular source of goods and/or services, and cannot be registered as trademarks and/or service marks. *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); see TMEP §1209.01(c).

Applicant argues that the term "Wolverine" is weak and entitled to a narrow scope of protection. Specifically the applicant provides marketplace evidence and FINRA CRD records showing a listing of investment advisors that use the term "Wolverine" in their marks. According to the applicant, this evidence shows that multiple registered investment advisors are already using the term "Wolverine" in marks for financial services. Therefore, the public and the marketplace have already determined that there is no likelihood of confusion when this term is used in connection with investment related services.

As a general rule, trademark Act Section 7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is prima facie evidence of the validity of the registration and of the registrant's exclusive right to use the mark in commerce on or in connection with the goods and/or services specified in the certificate. During ex parte prosecution, the trademark examining attorney has no authority to review or to decide on matters that constitute a collateral attack on the cited registration. TMEP §1207.01(d)(iv).

In the present case, the registrant owns a valid registration for the mark “Wolverine Investments” and this mark is entitled to protection against subsequent applicants who wish to register similar marks for related services. Applicant’s assertion that the mark is weak based on use in connection with related services constitutes a collateral attack on the validity of registrant’s mark. An ex parte proceeding is not the proper forum for reviewing such assertion.

The addition of the house mark “A&M” to registrant’s “Wolverine” mark results in marks that create similar commercial impressions and it is likely that the services provided under these marks would be attributed to a single source. See *In re Chica, Inc.*, 84 USPQ2d 1845, 1848-49 (TTAB 2007).

Therefore, the marks are confusingly similar.

II. Comparison of the Services

Applicant’s services, namely, captive insurance brokerage services; administration and management of captive insurance programs; captive insurance risk management consulting and services; captive insurance consulting and services, namely, performing cost benefit analysis, benchmarking services and market reviews; design and management of captive insurance programs are closely related to registrant’s services, namely, financial investment in the field of securities; Financial management; Financial portfolio management; Financial risk management; Financial services in the nature of an investment security; Investment advice; Investment consultation; Investment management; Management of portfolios comprising securities.

The evidence of records shows that the services in the application and registration frequently originate from a single source. Potential purchasers are accustomed to seeing the same mark used in connection with these types of services. Therefore, the use of similar marks in connection with applicant’s services and registrant’s services is likely to result in confusion.

Applicant argues that the registrant’s marketing materials indicate that its services are limited to investment advisory services in the nature of customized portfolio management for individual and institutional investors. The examining attorney respectfully disagrees.

With respect to applicant’s and registrant’s services, the question of likelihood of confusion is determined based on the description of the services stated in the application and registration at issue,

not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). In the present case, the registrant has not limited the nature of its services or identified the users of the services. Therefore, it is presumed that these goods and/or services travel in all normal channels of trade, and are available to the same class of purchasers.

The applicant also argues that the registrant does not offer captive insurance services. As a general rule the services of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i). The respective goods and/or services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

The registration uses broad wording to describe the services. Specifically, the registrant has registered its mark for “financial management” and “investment advice and consultation.” The identification set forth in the registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, this wording is presumed to encompass all services of the type described.

The attached evidence from the applicant’s website shows that the applicant provides “investment advice and consulting” as part of it is private equity services. In addition, registrant’s “financial management services” could encompass the strategic management, capital planning and management evaluation services advertised on applicant’s website. Registrant’s broad identification of services encompasses some of the more limited services being offered by the applicant under its mark. This shows that the services in the application and the registration may originate from a single source.

Finally, 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., Stone Lion Capital Partners, LP v. Lion Capital*

LLP, ___ F.3d. ___, ___, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

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).

In light of the similarities between the marks and the closely related nature of the goods and/or services, the examining attorney has determined that the mark cannot proceed to registration.

This refusal is continued and maintained.

Identification of Goods and Services

The highlighted wording in the identification of goods and/or services is broad and must be clarified because it could include a variety of goods and/or services in each class. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03.

The USPTO has the discretion to determine the degree of particularity needed to clearly identify goods and/or services covered by a mark. *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d 1593, 1597 (TTAB 2014) (citing *In re Omega SA*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007)). Accordingly, the USPTO requires the description of goods and/or services in a U.S. application to be specific, definite, clear, accurate, and concise. TMEP §1402.01; see *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d at 1597-98; *Cal. Spray-Chem. Corp. v. Osmose Wood Pres. Co. of Am.*, 102 USPQ 321, 322 (Comm'r Pats. 1954).

Applicant must clarify the exact nature of its “bench marking” and “market review” services as it is not clear whether these are primarily business services in Class 035 or insurance services in Class 036. Applicant must also classify the services in the appropriate International Class.

The following substitute wording is suggested, if accurate:

Captive insurance consulting and services, namely, performing cost benefit analysis, benchmarking services **in the nature of [specify exact nature of services, e.g. reimbursement benchmarking to healthcare organizations, etc.]** and market reviews, **namely, [specify exact nature of services]**, in Class 035.

Captive insurance brokerage services; administration and management of captive insurance programs; captive insurance risk management consulting and services, design and management of captive insurance programs; captive insurance consulting and services, namely, benchmarking services **in the nature of [specify exact nature of services in Class 036]** and market reviews, **namely, [specify exact nature of services in Class 036]**, in Class 036.

An applicant may only amend an identification to clarify or limit the goods and/or services, but not to add to or broaden the scope of the goods and/or services. 37 C.F.R. §2.71(a); see TMEP §1904.02(c)(iv).

For guidance on writing identifications of goods and/or services, please use the USPTO's online ID Manual at <http://tess2.uspto.gov/netahtml/tidm.html>, which is continually updated in accordance with prevailing rules and policies. See TMEP §1402.04.

Requirements for A Multi-Class Application Under Section 1(b)

For an application with more than one international class, called a "multiple-class application," an applicant must meet all the requirements below for those international classes based on an intent to use the mark in commerce under Trademark Act Section 1(b):

- (1) LIST GOODS AND/OR SERVICES BY INTERNATIONAL CLASS: Applicant must list the goods and/or services by international class.

- (2) PROVIDE FEES FOR ALL INTERNATIONAL CLASSES: Applicant must submit an application filing fee for each international class of goods and/or services not covered by the fee(s) already paid (confirm current fee information at http://www.uspto.gov/trademarks/tm_fee_info.jsp).

See 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

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Assurance

A chiefly British term for insurance.

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