

## Request for Reconsideration after Final Action

**The table below presents the data as entered.**

Input Field	Entered
<b>SERIAL NUMBER</b>	86827085
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 104
<b>MARK SECTION</b>	
<b>MARK FILE NAME</b>	http://tmng-al.uspto.gov/resting2/api/img/86827085/large
<b>LITERAL ELEMENT</b>	CV INVESTMENTS
<b>STANDARD CHARACTERS</b>	NO
<b>USPTO-GENERATED IMAGE</b>	NO
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_1-21613612218-20160818105758229806_cv_investments_response.pdf</a>
<b>CONVERTED PDF FILE(S) (7 pages)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\868\270\86827085\xml9\RFR0002.JPG</a>
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<b>DESCRIPTION OF EVIDENCE FILE</b>	Response to office action
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/michael.g.frey/
<b>SIGNATORY'S NAME</b>	Michael G. Frey
<b>SIGNATORY'S POSITION</b>	Attorney, Ohio bar member
<b>SIGNATORY'S PHONE NUMBER</b>	513-241-2324
<b>DATE SIGNED</b>	08/18/2016
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Thu Aug 18 11:05:53 EDT 2016
<b>TEAS STAMP</b>	USPTO/RFR-XXX.XXX.XXX.XX- 20160818110553171785-8682 7085-550f1628abe18c61b587

9ed1a8422a57557f1bfce9305  
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OMB No. 0651-0050 (Exp 07/31/2017)

## Request for Reconsideration after Final Action

### To the Commissioner for Trademarks:

Application serial no. **86827085** CV INVESTMENTS (Stylized and/or with Design, see <http://tmng-al.uspto.gov/resting2/api/img/86827085/large>) has been amended as follows:

#### EVIDENCE

Evidence in the nature of Response to office action has been attached.

#### Original PDF file:

[evi\\_1-21613612218-20160818105758229806\\_cv\\_investments\\_response.pdf](#)

Converted PDF file(s) ( 7 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

#### SIGNATURE(S)

##### Request for Reconsideration Signature

Signature: /michael.g.frey/ Date: 08/18/2016

Signatory's Name: Michael G. Frey

Signatory's Position: Attorney, Ohio bar member

Signatory's Phone Number: 513-241-2324

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: 86827085

Internet Transmission Date: Thu Aug 18 11:05:53 EDT 2016

TEAS Stamp: USPTO/RFR-XXX.XXX.XXX.XX-201608181105531

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## **Request for Reconsideration**

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Serial No. 86/827,085

The Trademark Office has maintained and made final of registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that Applicant's mark, as used with the recited goods and services, so resembles the mark in U.S. Registration No. 4,019,081 as to be likely to cause confusion, to cause mistake, or to deceive. Applicant respectfully disagrees that its mark is likely to cause confusion with the cited mark, and requests that the refusal to register its mark be withdrawn. Applicant is submitting a Notice of Appeal concurrently with this Request for Reconsideration.

Applicant seeks registration of the mark CV INVESTMENTS and Design (shown below), in connection with the following services: "financial and investment services, namely, financial investment brokerage services, individual retirement account services, asset and investment acquisition, consultation, advisory and development; management of investment of funds for others in the fields of mutual funds, stock, bonds, annuities, insurance, and money management; asset acquisition and management of investment property; managing real estate investment trust funds associated with investment properties."



The cited mark is a registration of the mark CV and Design (shown below), owned by Carter/Validus REIT Investment Management Company, LLC, and covering "financial and investment services, namely, investment management of funds; investment services, namely, asset acquisition and management of investment property; managing real estate investment trust funds associated with investment properties."



The basis for refusal is that both Applicant's mark and the cited mark contain the letters CV, and that both are used with similar services. Applicant does not dispute that the services offered under its mark and the cited mark are similar. However, that similarity does not automatically mandate a finding of likelihood of confusion. *Cf. Kellogg Co. v. Pack'em Enterprises Inc.*, 21 U.S.P.Q.2d 1142 (Fed. Cir. 1991) (noting that differences between two marks can be sufficient, in and of themselves, to warrant a finding that there is no likelihood of confusion between them, regardless of whether the goods are related or not).

The Trademark Office stakes much weight on the fact that both Applicant's mark and the cited mark contain the letters CV. However, that factor creates similarity when you focus on only one aspect of each of the relevant marks. The fact that Applicant's mark may contain the entire **textual** portion of the cited mark does not mandate a finding of likelihood of confusion. *Cf. Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (explaining that even in situations where one mark includes the **whole** of another does "not ipso facto warrant a holding that the marks are confusingly similar"). Instead, as the Federal Circuit has plainly instructed, a comparison of the marks must take into account a consideration of the marks **in their entirety**. *See In re National Data Corp.*, 224 U.S.P.Q. 749, 750-51 (Fed. Cir. 1985) (explaining that "likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark").

The Trademark Office errors in focusing on and placing undue emphasis on the common letters CV found in each mark. In doing so, the Trademark Office relies mainly on the principle of trademark law that holds that where a mark is comprised of textual and design elements, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the services. The error in the Trademark Office's approach is that this principle is not to be applied broadly to all types of marks. In fact, it is inaccurate to apply this principle to marks such as Applicant's or the cited mark — that is, composite word + design marks where the textual portion is (primarily) a string of random letters.

Where such letter marks are involved, there is no likelihood of confusion where the marks are highly stylized and decidedly different in overall appearance. In such cases, the theory that the

textual portion of a mark predominates over the design elements falls to the wayside, and instead the design or stylization becomes the most significant factor when comparing the marks as part of the likelihood of confusion analysis. As the Trademark Trial and Appeal Board has explained,

[W]hen letter marks are presented in a highly stylized form, so that they are essentially design marks incapable of being pronounced or conveying any inherent meaning, then differences in the lettering style and design may be sufficient to prevent a likelihood of confusion. In these cases *similarity of appearance is usually controlling* and ***the decision will turn primarily on the basis of the visual similarity of the marks.***

*Textron Inc. v. Maquinas Agricolas “Jacto” S.A.*, 215 U.S.P.Q. 162, 163 (T.T.A.B. 1982) (emphasis added); *see also* J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (4th ed. 2000) §23:33 (noting that “highly stylized, highly contrasting letter design logos tend to fall on the no likelihood of confusion side of the line”).

Blindly applying the “text predominates” principle to marks such as these also runs contrary to the position taken by the Court of Appeals for the Federal Circuit, which has recognized that this principle is not a blanket rule, nor does it provide a license to discount the difference in appearance between two stylized marks.

There is no general rule as to whether letters or design will dominate in composite marks....

[T]he spoken or vocalizable element of a design mark, taken without the design, need not of itself serve to distinguish the goods. The nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur....

[E]ven if the letter portion of a design mark could be vocalized, that [is] not dispositive of whether there [is] likelihood of confusion. A design is viewed, not spoken, and a stylized letter design cannot be treated simply as a word mark.

*In re Electrolyte Laboratories, Inc.*, 16 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990). In other words, stylized letter marks are not to be treated as pure word marks. *See, e.g., Georgia-Pacific Corp. v. Great Plains Bag Co.*, 204 U.S.P.Q. 697, 699 (C.C.P.A. 1980) (explaining that a highly stylized

letter mark is “in the gray area between pure design marks which cannot be vocalized and word marks which are clearly intended to be”); *see also In re TSI Brands, Inc.*, 67 U.S.P.Q.2d. 1157 (T.T.A.B. 2002). Hence, it is not axiomatic that the textual portion of Applicant’s mark will dominate over the design portion — this is particularly true given that the cited mark is nothing more than a highly stylized representation of the letters CV, which — given its almost abstract appearance — may not even be recognized as such by consumers when they first encounter it.

A proper likelihood of confusion analysis will take into account all elements of both marks at issue, and shall give due weight and consideration to *all* elements of the marks. This analysis must therefore encompass not only the common letters CV, but also the stylized or design elements present in each mark, the additional wording present in Applicant’s mark, and the overall appearance of and impression conveyed by each mark. When such an analysis is conducted, it is clear that the overall appearance of Applicant’s mark distinguishes and differentiates it from the cited mark. As such, there is no likelihood of confusion between Applicant’s CV INVESTMENTS and Design mark and the cited CV and Design mark.

Applicant has previously argued that the marks are also distinguishable on the basis that they present different commercial impressions. This argument is based on the contention that consumers encountering the marks will equate the letters CV in each mark with a different antecedent. In the case of Applicant’s mark, the letters CV will be recognized as a shorthand for Applicant’s name, Cumberland Valley Financial Services. In the case of the cited mark, the letters CV will be recognized as a shorthand reference to the owner’s name, Carter/Validus REIT Investment Management Company, LLC. (Indeed, as noted above, in light of the highly stylized nature of the cited mark, it is questionable whether consumers would recognize the mark as the letters CV unless they were already familiar with the Carter/Validus antecedent.)

The Trademark Office has dismissed this argument on the ground that there is nothing in either mark to indicate these different antecedents to consumers. Such a narrow, blind approach to reading the marks ignores the practical reality that these marks will almost certainly be used in connection with or in close proximity to material that presents each party’s complete name. Further, it is not in line with past decisions of the Trademark Trial and Appeal Board. For

example, in *Hewlett-Packard Company v. Human Performance Measurement, Inc.*, the Board listed the following among the considerations that led to a conclusion of no likelihood of confusion between marks that included the initialisms HPM and HP:

[T]he letters “HPM” in applicant’s mark and the letters “HP” in opposer’s marks are not arbitrary; rather, they obviously serve as acronyms for the distinguishing portions of the parties’ respective trade names, namely, Human Performance Measurement and Hewlett-Packard.

23 U.S.P.Q.2d 1390, 1396 (T.T.A.B. 1991). Similarly, in *Sales Analysis Institute, Inc. v. Sales Training, Inc.*, the Board concluded two alleged marks comprised of similar letter strings were not likely to be confused, noting that the letter strings in question

are acronyms derived from the corporate names of the parties.... As such, in addition to performing the service mark function of identifying and distinguishing the services of the parties, the letter combinations are used within and without both opposer and applicant corporations as terms of reference for the corporate entities.

181 U.S.P.Q. 341, 346 (T.T.A.B. 1973). Finally, as summed up in another Board decision,

In the realities of the commercial world, it must be recognized that there is a tendency of commercial organizations ... to adopt and use designations comprising the initial letters of the various components of their corporate names as shorthand abbreviations or acronyms for their trade names ...; that inevitably more than one company will come up with the same arrangement of letters, notwithstanding distinct differences in the corporate names from which they are derived; and that it would be unreasonable to preclude a subsequent user to register the same or a similar term where ... the circumstances surrounding such use is not reasonably likely to conflict with the activities of the prior user in a manner calculated to cause confusion or mistake in trade.

*SSP Industries v. Solid State Products, Inc.*, 184 U.S.P.Q. 628, 633 (T.T.A.B. 1974).

It is plain from the reasoning used by the Board in these cases that the antecedents of initialisms are relevant to the issue of likelihood of confusion, even if the antecedents are not expressly

spelled out in the marks themselves. Since the antecedents involved here are completely distinct from one another — Cumberland Valley vs. Carter/Validus — the circumstances surrounding the use of the common CV letter string is not reasonably likely to give rise to consumer confusion, particularly as consumers are aware of the tendency of organizations to adopt and use designations comprised of their corporate name initials.

However, even if the antecedents are ignored — as the Trademark Office has done thus far — the principles espoused by the Board and other authorities still point to a conclusion that there is no likelihood of confusion between Applicant’s mark and the cited mark. If the antecedents are ignored, then the letter string CV in each mark is purely arbitrary and should be judged as having no inherent meaning. In that case, the two marks at issue are essentially stylized design marks of the sort discussed by the Board in *Textron*. In such a case, the key consideration is whether the marks, in their entireties — and particularly focusing on their visual appearance — are highly similar. *See Textron*, 215 U.S.P.Q. at 163 (where marks are comprised of initials without any inherent meaning, the issue of likelihood of confusion turns on the visual similarity of the marks); *see also* McCarthy § 23:33 (“similarity of appearance is usually controlling” for marks “incapable ... of conveying any inherent meaning”). In this case, when the visual appearance of Applicant’s mark (with the additional term INVESTMENTS and the tree design) is compared with the purely stylized initials CV in the cited mark, the differences are obvious, pointing unmistakably toward the conclusion that there is no likelihood of confusion between the marks.

In this case, however, it is not only the differences in the marks themselves that weighs against a finding of likelihood of confusion. The degree of care likely to be exercised by customers of Applicant and the owner of the cited mark also cuts against any likelihood of confusion between the marks. Both parties offer investment and other financial services. The services themselves may not be extremely expensive, but there is considerable personal risk associated with any sort of investment. Indeed, some customers may be gambling their life savings or retirement funds when availing themselves of these types of services. Even if the risk does not encompass a person’s entire financial wealth, people remain cautious about investments, and are bound to take special care in choosing where and with whom to make such a significant move.

The fact that a particular service is one generally purchased only after thorough investigation and careful consideration is a factor to be considered in the likelihood of confusion analysis. *See In re E. I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973) (noting that “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing,” are relevant to the likelihood of confusion question). Due to the risk involved, the importance of the purchase to their future, and the fact that choosing to go with the wrong company can have disastrous effects, consumers are not likely to purchase construction services on impulse or with little or no consideration. Instead, they will investigate and become familiar with the services and the company providing them before making such a large investment. *See Kiekhaefer Corp. v. Willys-Overland Motors, Inc.*, 111 U.S.P.Q. 105, 108 (C.C.P.A. 1956) (explaining that where goods or services “are not ordinarily purchased casually, but only after rather careful consideration,” confusion is less likely than where the goods or services are purchased casually); *see also* McCarthy § 23:96. As a result of the degree of care exercised by consumers, the likelihood that they will be confused by some degree of similarity between two marks is greatly lessened.

Applied these principles to the facts of the instant case, consumers are not likely to engage in financial investing without becoming well-educated about the company that will be handling their money. The risks are simply too great for someone to jeopardize their financial future and well-being simply in the basis of a couple of initials. At the very least, the average consumer will investigate at least sufficiently to learn the antecedents of the initials CV in the mark. Such investigations would plainly show the two entities to be different, and obviate any potential for confusion between the marks.

For the foregoing reasons, there is no likelihood of confusion as to source between Applicant’s CV INVESTMENTS and Design mark and the cited CV and Design mark. Consequently, Applicant respectfully requests that the refusal to register its mark under Section 2(d) of the Trademark Act be withdrawn.

With this response, the application is in condition for publication.