PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77641462
LAW OFFICE ASSIGNED	LAW OFFICE 117
MARK SECTION (no change)	
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	http://tgate/PDF/RFR/2009/11/03/20091103142958477985-77641462-001_001/evi_6517560226-142133585_._Your_Trusted_Advisor_Appeal.pdf
CONVERTED PDF FILE(S) (3 pages)	\\TICRS\EXPORT8\IMAGEOUT8\776\414\77641462\xml1\RFR0002.JPG
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	\\TICRS\EXPORT8\IMAGEOUT8\776\414\77641462\xml1\RFR0004.JPG
DESCRIPTION OF EVIDENCE FILE	Applicant's arguments for reconsideration of refusal to register mark.
SIGNATURE SECTION	
DECLARATION SIGNATURE	/D. Benson Tesdahl/
SIGNATORY'S NAME	D. Benson Tesdahl
SIGNATORY'S POSITION	Attorney of record
DATE SIGNED	11/03/2009
RESPONSE SIGNATURE	/D. Benson Tesdahl/
SIGNATORY'S NAME	D. Benson Tesdahl

SIGNATORY'S POSITION	Attorney of record
DATE SIGNED	11/03/2009
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Nov 03 14:29:58 EST 2009
TEAS STAMP	USPTO/RFR-65.175.60.226-20091103142958477985-77641462-46051c9e9cf84d1523634-3bf9b4551927d-N/A-N/A-20091103142133585689

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OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **77641462** has been amended as follows:

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

Please see the actual argument text attached within the Evidence section.

EVIDENCE
Evidence in the nature of Applicant's arguments for reconsideration of refusal to register mark. has been attached.
Original PDF file:
http://tgate/PDF/RFR/2009/11/03/20091103142958477985-77641462-001_001/evi_6517560226-142133585_._Your_Trusted_Advisor_Appeal.pdf
Converted PDF file(s) (3 pages)
Evidence-1
Evidence-2
Evidence-3

SIGNATURE(S)
Declaration Signature
If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date

of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii); and/or the applicant has had a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. 37 C.F. R. Sec. 2.44. If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date or as of the date of any submitted allegation of use. 37 C.F.R. Secs. 2.34(a)(1)(i); and/or the applicant has exercised legitimate control over the use of the mark in commerce by its members. 37 C.F.R. Sec. 244. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /D. Benson Tesdahl/ Date: 11/03/2009
Signatory's Name: D. Benson Tesdahl
Signatory's Position: Attorney of record

Request for Reconsideration Signature
Signature: /D. Benson Tesdahl/ Date: 11/03/2009
Signatory's Name: D. Benson Tesdahl
Signatory's Position: Attorney of record

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 applicant'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 applicant in this matter: (1) the applicant 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 applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant'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: 77641462
Internet Transmission Date: Tue Nov 03 14:29:58 EST 2009
TEAS Stamp: USPTO/RFR-65.175.60.226-2009110314295847
7985-77641462-46051c9e9cf84d15236343bf9b
4551927d-N/A-N/A-20091103142133585689

Request for Reconsideration after Final Refusal

The Applicant would like to thank the Examining Attorney for her careful review of Applicant's application for trademark registration for the mark YOUR TRUSTED ADVISORS. Applicant respectfully disagrees with the Examining Attorney's final refusal of registration, and Applicant submits the following arguments and evidence in support of its request for reconsideration.

Notice of Appeal

Notice is hereby given that the Applicant appeals to the Trademark Trial and Appeal Board the refusal to register the mark depicted in Application Serial No. 77641462.

Applicant has filed a request for reconsideration of the refusal to register, and requests suspension of the appeal pending consideration of the request by the Examining Attorney.

The refusal to register has been appealed as to the following class of goods/services:
Class 045: All goods and services are appealed, namely, "Providing information in the field of law by means of a global computer network; and legal services."

Evidence

The Examining Attorney refused registration on the ground that there is a likelihood of confusion with the mark "Trusted Advisors." (Although the Examining Attorney did not identify the serial number of the allegedly similar mark, the Applicant assumes it is Serial Number 77283870).

The Applicant submitted several persuasive legal authorities in support of its Application. Rather than repeat all of those authorities again, Applicant hereby incorporates those authorities by reference, and in addition, adds further authorities below.

The Examining Attorney's final refusal was based on two primary grounds. First, the Examining Attorney expressed her subjective belief that the use by the Applicant of a different initial word ("YOUR") would not create a more distinctive impression in the consumer. In reaching this conclusion, the Examining Attorney dismissed out-of-hand longstanding and persuasive legal authority cited by the Applicant establishing that consumers are more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions). Applicant therefore respectfully requests that the Examining Attorney reconsider her position in light of this legal authority.

Second, the Examining Attorney dismissed Applicant's argument that its services are significantly different from the owner of the mark "TRUSTED ADVISORS" and that Applicant's services are also based out of a different part of the country, thereby making it

impossible for consumers to confuse the source of the two marks. The Examining Attorney argued that trademarks are presumed to be geographically unrestricted, which suggests that the Examining Attorney may have misunderstood the purpose of Applicant's argument and wrongly assumed that Applicant was making some type of geographic limitation with respect to its services. As discussed below, this is not the case.

What the Applicant was trying to establish by the facts regarding its services is that it serves a very specific type of very sophisticated consumer. This is critical because the law is clear that sophisticated consumers are not likely to be confused by marks that may have some overlap in their content. Specifically, Applicant's clients tend to be of two main types. One type of client is the large healthcare provider, such as major hospital systems and large physician groups. Many of these types of clients are multi-million dollar corporations that have their own in-house legal counsel and that seek the Applicant's legal advice in areas of highly complex healthcare law or seek Applicant's assistance in lobbying Congress and the Centers for Medicare and Medicaid Services (CMS). These clients specifically seek a D.C.-based specialty firm like the Applicant's firm because of its proximity to Congress and CMS, as well as Applicant's longstanding expertise in health law matters. The second type of client consists of colleges and universities, which again are large corporations that will sometimes have in-house counsel and which seek the Applicant's education law expertise and Applicant's ability to directly confer with officials in the Department of Education (DOE) and Congress. These clients also want a D.C.-based specialty firm for such services because of Applicant's proximity to DOE and Congress. Applicant is one of the very few firms in the entire country to specialize in its particular type of education law.

In addition to Applicant's high degree of specialization, it should be noted that the healthcare and education entities seeking Applicant's advice pay hourly rates for Applicant's senior attorneys that range from $400-$625 per hour. Consumers paying that kind of money for DC-based specialty legal advice know exactly who they are dealing with and are not going to confuse Applicant's mark and services from those a Texas-based law firm that solely provides for-profit business law services.

The law is clear that likelihood of confusion is greatly reduced where the consumers reviewing the marks are sophisticated and exercise a high degree of care in their purchasing decisions, and that is the point that Applicant was trying to make with its geographic arguments. See, e.g., the authorities and arguments cited by the Trademark Trial and Appeal board in *In re Waterstone Capital Management, L.P.* (TTAB 2005 pertaining to Serial No. 78223503) and *In re Murray* (TTAB 2009 pertaining to Serial No. 77029078). (Applicant realizes that the foregoing TTAB decisions are not precedent, but Applicant nevertheless believes that the authorities cited in these decisions and the rationale of the TTAB stated in these decisions will be useful to the Examining Attorney in analyzing Applicant's analogous case.)

Furthermore, neither Applicant's services, nor the services of the owner of "TRUSTED ADVISOR" are "impulse" purchases (see TMEP § 1207.01). Therefore, it is not credible that the sophisticated consumers that seek out Applicant's services would confuse those services for those of the owner of TRUSTED ADVISOR. Specifically, TMEP § 1207.01(a)(i) provides:

> Conversely, if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 13 50 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field).

Thus, sophisticated healthcare entities and universities seeking information on highly technical areas of healthcare law and education law from a DC-based specialty firm would specifically seek out the Applicant and would readily know that Applicant's services and the use of Applicant's mark would not have been produced by a Texas-based firm dealing in general business law. (See also *Bennett Law Office, P.C. v. Burrus Intellectual Property Law Group* (TTAB 2009) (in which the TTAB noted in a non-precedential decision that "it is also clear that, based on the differences in the location of the services, there has been little if no opportunity for confusion" between two somewhat similar law firm trademarks. Thus, the TTAB clearly believes that the different location of the services offered by two entities with somewhat similar marks can be a factor in determining whether there is any risk of trademark confusion.)

Additionally, applicant has found multiple examples of the USPTO approving marks with the words "TRUSTED" and "ADVISOR", thereby demonstrating the willingness of the USPTO to register similar marks that contain these terms because they are inherently not confusingly similar. See, e.g., "Your Trusted Philanthropic Advisor" (78649035), "Trusted Business Advisor" (77547198), "The Trusted Advisor" (76610280), and "Trusted Advisors to Trusted Advisors" (75928657). The Examining Attorney did not address this argument at all.

In light of the foregoing, the Applicant respectfully requests that its mark be approved for registration because there is no likelihood of confusion for sophisticated consumers seeking the narrow types of services offered by the Applicant.