IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Name of Applicant: **Investec Bank Limited**

Docket No. **9496-102548**

Serial Number of Application: **78/979,110**

Filing Date of Application: **July 30, 2007**

Trademark: **INVESTEC and design**

TTAB

International Class(es): **36**

NOTICE OF APPEAL

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration.

This Appeal is taken for:

☒ all classes listed above ☐ only the following classes: _____

The total number of classes associated with this Appeal are: **1**

The prescribed appeal fee of **$100.00** is to be paid as follows:

☒ A check in the amount of **$100.00** is attached.
Any excess or insufficiency should be credited or debited to Deposit Account No. **23-0920.**

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WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Signature

Dated: **November 2, 2007**

Elliott C. Bankendorf
Attorney for Applicant

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11-05-2007

U.S. Patent & TMOfc/TM Mail Rcpt Dt #81

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November 2, 2007 .

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Elliott C. Bankendorf

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Investec Bank Limited	)	Trademark Law Office 116
Serial No.:	78/979,110	)	*I hereby certify that this correspondence is being deposited with the United Postal Service as first-class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, on November 2, 2007.*
Filed:	July 30, 2007	)	
Class(es):	36	)	
Mark:	INVESTEC and design	)	
Examiner:	Kristina Kloiber	)	Elliott C. Bankendorf
Attorney Docket No. 9496-102548		)	

REQUEST FOR RECONSIDERATION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Ms. Kloiber:

In response to the Final Trademark Office Action, e-mailed on May 2, 2007, the Applicant hereby incorporates the arguments and evidence submitted with its March 2, 2007 response to the Notice of Suspension. In addition thereto, the Applicant respectfully submits its Notice of Appeal to the Trademark Trial and Appeal Board with applicable filing fee. Reconsideration of the Final Refusal is requested based on the following:

There are no remaining outstanding issues with exception of Registration Number 1,876,895 for INVESTECH and design, which unlike the other references, has not yet been withdrawn as a reference under §2(d) of the Act. The other two child applications, U.S. Ser. Nos. 78/979,108 and 78/979,109 have recently been approved for publication.

It is respectfully requested that in light of the amendment to the recitation of services as well as other distinguishing aspects of this new child application, that the refusal under §2(d) of the Act now be withdrawn and that this application be allowed to publish along with the other two co-pending child applications

A. The Amended Identification Obviates Confusion and Warrants Withdrawal of the §2(d) Refusal.

Importantly, the services used in connection with Applicant's mark have now been amended to avoid any likelihood of confusion, mistake, or deception. Furthermore, any conflicting goods are removed from the identification of the goods.

This newly created Application for INVESTEC and design is for "agency and brokerage services for bonds and securities."

Applicant has removed the conflicting wording of commercial banking; financing services; fiscal assessment and valuation; money exchange services; provision of financial guarantees; trading in the money market for others; brokerage in the field of currency, interest rates, stock, bills, claims, and notes; financial services, namely, settlement, planning, management, and control; investment services, namely, investment advice and investment brokerage, investment trust services, namely, trust management accounts and trust company services; credit card services; commodities brokerage; financial portfolio management for investors; mortgage services, namely mortgage bonds and participation in mortgage bond programs excluding financial research, analysis, and consulting services.

Importantly, the Section 2(d) citation must have evidence of record to support sustaining and maintaining this refusal for registration. Careful review of the third-party

registrations submitted with the Examining Attorney's Final Refusal fail to connect Applicant's *revised* services currently subject to this child application and the services in the referenced registration. Therefore, they have no evidentiary value and the §2(d) refusal is wholly unsupported. TMEP 1207.01(d)(iii). *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988), *aff'd,* 864 F.2d 149 (Fed. Cir. 1988).

Even if the third-party registrations showed a nexus between the Applicant's and Registrant's services (which it does not), in the absence of proof of use and effect on the public mind, third-party registrations can have no impact on the strength and likelihood of confusion refusal issues: "The purchasing public is not aware of registrations reposing in the Patent [and Trademark] Office and though they are relevant, in themselves, they have little evidentiary value on the issue before us." *Smith Bros. Mfg. Co. v. Stone Mfg. Co.,* 476 F.2d 1004, 177 U.S.P.Q. 462 (C.C.P.A. 1973) (In an opposition, applicant introduced several third-party registrations to show that opposer's mark was weak and entitled to only a narrow scope of protection. Board's decision dismissing the opposition was reversed.). *See AMF Inc. v. American Leisure Products, Inc.,* 474 F.2d 1403, 177 U.S.P.Q. 268 (C.C.P.A. 1973) ("It appears that the board relied heavily upon the existence of third-party trademark registrations in reaching its decision. We have frequently said that little weight is to be given such registrations in evaluating whether there is likelihood of confusion. The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them . . ..").

B. Applicant's Proposed Mark and Registrant's Marks are Different

The Applicant's design with lower case wording would not be perceived by consumers as emanating from the same source, particularly with the differences highlighted above with respect to the services and that there is no direct nexus between the services.

In many cases, a word is dominant over design justifies a refusal of likelihood of confusion under § 2(d) of the Act if the goods are the same. TMEP 1207.01(c). However, this is not the rule. This might be labeled the "literacy" presumption, in that it assumes that words have more impact than designs, which is a dubious generalization. *McCarthy on Trademarks* §23.47 ["Dominant" part of composite word and design marks"]. The Federal Circuit has cautioned that: "There is no general rule as to whether letters or design will dominate in composite marks. *In re Electrolyte Laboratories, Inc.*, 913 F.2d 930, 16 U.S.P.Q.2d 1239 (Fed. Cir. 1990), corrected, 929 F.2d 645 (Fed. Cir. 1990).

That this "rule" of word dominance is merely a guideline is shown by cases finding that a design element is dominant than accompanying words. *Id. In re Computer Communications, Inc.,* 484 F.2d 1392, 179 U.S.P.Q. 51 (C.C.P.A. 1973*); Association of Co-operative Members, Inc. v. Farmland Industries, Inc.,* 684 F.2d 1134, 216 U.S.P.Q. 361 (5th Cir. 1982), *cert. denied,* 460 U.S. 1038, 75 L. Ed. 2d 788, 103 S. Ct. 1428 (1983); *Envirotech Corp. v. National Service Industries, Inc.,* 197 U.S.P.Q. 292 (T.T.A.B. 1977) (addition of word mark to design similar to that of senior user held not sufficient to avoid confusion); *In re Sloppy Joe's International Inc.,* 43 U.S.P.Q.2d 1350

(T.T.A.B. 1997) (in composite of words "Sloppy Joe's" and large portrait of a famous writer, the guideline that words are normally dominant is not operative because of the person pictured).

The overall image in both Applicant's and Registrant's marks are clearly dominant when compared to each other. *See Supra, In re Sloppy Joes.* In this case, there is no denying the fact that the ordinary consumer will notice and have better recognition of the large, centralized image of Registrant's design or the fact that the circle/cross design is the first aspect of the mark consumers notice (as they read left to rights). The only overlapping word at issue is displayed meagerly, either to the left of the design in lower case letters (Applicant's mark) or embedded in a much larger design (Registrant's mark) at a smaller location relative to the design and eclipsed by the design, while its words are blurred by distinctive and fanciful stylization.

C. Sophisticated Purchasers – Applicant's and Registrant's Services Cater to Professional "Discriminating Buyers.

Where the relevant buyer class is composed solely of professional purchasers, it is reasonable to set a higher standard of care than what exists for consumers. Many cases state that where the relevant buyer class is composed of professionals or commercial buyers familiar with the field, they are sophisticated enough not to be confused by trademarks that are closely similar. That is, it is assumed that such professional buyers are less likely to be confused than the ordinary consumer. *Dynamics Research Corp. v. Langenau Mfg. Co.,* 704 F.2d 1575, 217 U.S.P.Q. 649 (Fed. Cir. 1983). *McCarthy on Trademarks and Unfair Competition §23.101.*

Thus, while two marks might be sufficiently similar to confuse an ordinary consumer, a professional buyer or an expert in the field may be more knowledgeable and will not be confused. *Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384, 35 U.S.P.Q.2d 1449 (2d Cir. 1995). In this case, the marks are not so similar and the consumers of "agency and brokerage services for bonds and securities" are clearly professional in nature and due to large sums of money involved with the subject matter of the agency and brokerage services, confusion is highly unlikely.

REMARKS

In conclusion, it is submitted that the Applicant has cured the remaining objections of the Trademark Examining Attorney and that the Final Refusal to register based on likelihood of confusion under §2(d) of the Act should be withdrawn. In view of the preceding, it is respectfully submitted that the application is now in condition for allowance and should be passed to publication.

Respectfully submitted,

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