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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78979110
Applicant	Investec Bank Limited
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ON APPEAL

Applicant: Investec Bank Limited

Mark: INVESTEC & Design

Serial No.: 78/979,110

APPLICANT'S REPLY BRIEF IN SUPPORT OF APPEAL

The Applicant respectfully submits this reply brief in support of its appeal of the trademark examiner's final refusal to register the mark INVESTEC & Design Serial No. 78/979,110, based on the examiner's conclusion that the Applicant's claimed goods are confusingly similar to the goods covered by U.S. Registration No. 1,876,895 ("the '895 Reg"); and, Applicant requests oral hearing on this matter.

I. THE EXAMINER'S BRIEF SHOULD NOT BE CONSIDERED.

Although the examiner submitted two separate briefs (one related to the parent application 78/477,240 and the other related to the 78/979,110 child application), the briefs appear to be exactly the identical and only discuss the services in the 78/477,240 parent application.

The services in the 78/477,240 parent application are as follows: Commercial banking; financing services; insurance services, namely, brokerage and underwriting; actuarial 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.

The services in the 78/979,110 child application are as follows: agency and brokerage services for bonds and securities.

The examiner does not make one reference to the services covered in the child application. Therefore, examiner's brief is non-responsive to Applicant's Appeal and should be stricken.

II. APPLICANT'S SERVICES AND REGISTRANT'S SERVICES ARE NOT CONFUSINGLY SIMILAR.

The examiner's refusal is based on the Applicant's recitation of services. (12/17/07 Request for Reconsideration Denied, "THIS REFUSAL APPLIES ONLY TO THE SERVICES SPECIFIED HEREIN.") Any argument beyond the comparison of services should be considered outside the scope of this appeal.

The Applicant's services are as follows: agency and brokerage services for bonds and securities.

The Registrant's services are as follows: financial research, analysis, and consulting services.

The examiner's brief does not address these services and therefore, the entire argument against registration of Applicant's child application should be stricken.

Aside from the examiner failing to analyze the services of this application, the examiner objects to the declaration attached as Exhibit 1 as new evidence; however, the statements made

in this declaration are not new. The Applicant previously argued the differences between its services and those covered under the '895 Reg. For example, the Applicant argued in its Office Action Responses that a customer seeking agency and brokerage services for bonds and securities need to go to a bank as opposed to a financial planner. (3/2/07, Office Action Response; pp. 8-9; 11/2/07, Office Action Response, pp. 6-7.) The Applicant also argued that customers seeking in depth financial counseling or analyses typically do not use the services of a bank; rather they seek the assistance of a financial planner. (3/2/07, Office Action Response; pp. 8-9; 11/2/07, Office Action Response, pp. 6-7.)

CONCLUSION

For the foregoing reasons and for those reasons set forth in Applicant's Appeal Brief, the refusal to register on the basis of § 2(d), for the reason that the services covered under Applicant's Serial No. 78/979,110 will likely be confused with those covered under the Registrant's mark, should be reversed. The Applicant requests oral hearing on this matter.

Respectfully submitted,

/msk/

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