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Subject: U.S. Trademark Application Serial No. 79247897 - M MAN GLG - T-574250-US - Request for Reconsideration Denied - Return to TTAB

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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. 79247897

Mark: M MAN GLG

Correspondence Address:

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Applicant: Man Group plc

Reference/Docket No. T-574250-US

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REQUEST FOR RECONSIDERATION
AFTER FINAL ACTION
DENIED

Issue date: **April 10, 2020**

International Registration No. 1440262

Applicant's request for reconsideration is denied. *See* 37 C.F.R. §2.63(b)(3). The trademark examining attorney has carefully reviewed applicant's request and determined the request did not:

(1) raise a new issue, (2) resolve all the outstanding issue(s), (3) provide any new or compelling evidence with regard to the outstanding issue, or (4) present analysis and arguments that were persuasive or shed new light on the outstanding issue(s). TMEP §§715.03(a)(ii)(B), 715.04(a).

Specifically, the evidence provided by applicant lacks probative value, and fails to shed new light or provide any new guidance to the examining attorney. The evidence provided is (1) the examination record related to prior registrations, submitted to establish no prior refusals were ever issued; (2) evidence of a cancelled registration; and (3) evidence of foreign registrations held by applicant and registrant.

With respect to the evidence submitted regarding the prior decisions and actions of other trademark examining attorneys, prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); see *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017). Thus, the statements set forth in Office actions or absence of prior Office actions is not probative evidence with respect to the question of likelihood of confusion in this case.

Applicant argues that the coexistence of the mark in U.S. Reg. No. 5199847 and the cited mark in registration, U.S. Reg. No. 5038735, establishes that there is no likelihood of confusion between the applied-for mark containing the identical element as its prior GLG mark and registrant's mark; therefore, the trademark examining attorney should withdraw the Trademark Act Section 2(d) refusal.

While coexistence can obviate a likelihood of confusion, the registered GLG marks have only coexisted since May 9, 2017, just shy of three years. Neither the registration has reached incontestability, and thus neither are immune from attack on likelihood of confusion ground. In this case, applicant's prior registration does not correspond to the facts set forth in *In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 1399-1400 (TTAB 2012). See TMEP §1207.01. Thus applicant's prior registration does not obviate the Section 2(d) refusal.

Applicant's evidence pertaining to its cancelled registration lacks probative value pertaining to the coexistence of the marks. The registration cited as evidence by applicant, U.S. Reg. No. 3112508, was cancelled on February 10, 2017. Similarly, evidence of other non-GLG formative mark registrations which applicant owns, including the U.S. Reg. No. 5865750, fails to provide evidence regarding the use and/or coexistence of the confusingly similar marks.

Finally, applicant's submission of a number of foreign registrations fails to provide evidence of weakness. Evidence of third party use under the sixth *du Pont* factor must establish that the consuming public is exposed to third-party use of similar marks. See TMEP §1207.01(d)(iii). However, the

submission of foreign registrations fails to establish that the consuming public in the United States has been exposed to these marks; it merely indicates that the specified owners have obtained registrations abroad. Further, the evidence fails to establish weakness or dilution by third parties under the sixth *du Pont* factor, but merely that applicant and registrant own registrations abroad. Accordingly, the evidence submitted does not obviate the Section 2(d) refusal.

Applicant's arguments pertaining to the similarities between the marks are found unpersuasive. The evidence regarding applicant's use of its house mark in conjunction with lettering or wording for its various subsidiaries further reinforces a likelihood of confusion where applicant's mark incorporates the entirety of the registered mark in the manner shown in the mark. While there are cases where the addition of a word, term, or a space can distinguish a mark based on the differing commercial impressions, the particularized presentation of the mark in this case, along with the wholesale incorporation of the registered mark, fails to distinguish the source of the legally identical services. When viewed in their entireties in association with the relevant financial informational and consulting services offered under the MAN | GLG design mark and the GLG mark, the services would appear to consumers to originate from a single source.

As previously indicated, examination shall continue on the application despite applicant's consent negotiations, as suspension is not permitted to obtain or negotiate a consent agreement. 37 C.F.R. §2.67; TMEP §716.02. As a general rule, the USPTO will not suspend under these circumstances. TMEP §716.02. However, should applicant initiate formal legal proceedings to cancel the cited registration, suspension would be appropriate. TMEP §716.02(a).

Accordingly, the following Section 2(d) likelihood of confusion refusal made final in the Office action dated August 28, 2019, is **maintained and continued**. See TMEP §§715.03(a)(ii)(B), 715.04(a).

Examiners Amendment. Application has been amended as shown below. As agreed to by Todd Braverman on March 2, 2020, the examining attorney has amended the application as shown below. Please notify the examining attorney immediately of any objections. TMEP §707. Otherwise, no response is required. In addition, applicant is advised that amendments to the goods and/or services are permitted only if they clarify or limit them; amendments that add to or broaden the scope of the goods and/or services are not permitted. 37 C.F.R. §2.71(a).

As requested by applicant, the identification of services has now been restored to the previously approved recitation from the Response dated August 6, 2019, and the limitation from the IB added thereto, and now reads as follows:

International Class 036: Financial and investment services, namely, investment advice, investment management, investment consultation, and investment of funds for others, including private and public equity and debt investment services, strategic financial advisory services, financial information, advisory, and consultancy services, the trading of financial instruments, securities, shares, options and other derivative products, and operation and management of hedge funds, commodity pools and other collective investment vehicles, and trading for others of securities, options, futures, derivatives, debt instruments and commodities; financial management services; investment banking services; management of investment products; investment consulting services; investment fund management; and information and advisory services in the fields of finance and investment; *none of the aforesaid services including the financing of commercial, industrial and utility vehicles and machines, printing machines and printing equipment, motors and engines, turbines, gearing and machines for the chemical industry, or the provision of financial advice relating to industrial projects*

See TMEP §§1402.01, 1402.01(e).

If applicant has already filed an appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If applicant has not filed an appeal and time remains in the six-month response period, applicant has the remainder of that time to (1) [file another request for reconsideration](#) that complies with and/or overcomes any outstanding final requirement(s) and/or refusal(s), and/or (2) [file a notice of appeal](#) to the Board. TMEP §715.03(a)(ii)(B). Filing a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); see TMEP §715.03(c).

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