

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86230345
LAW OFFICE ASSIGNED	LAW OFFICE 105
MARK SECTION	
MARK FILE NAME	http://tmng-al.uspto.gov/resting2/api/img/86230345/large
LITERAL ELEMENT	GUARD CAPITAL
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO

ARGUMENT(S)

REQUEST FOR RECONSIDERATION

This is in response to the Office Action issued on February 3, 2015. Reconsideration of this application is respectfully requested in view of the following remarks.

In the Office Action, the Examining Attorney made final the refusal to register for certain goods and services based on U.S.

Registration No. 4182543 for the mark CAPITALGUARD covering “financial planning and investment advisory services.” Specifically,

the Examining Attorney refused registration in Class 36, as well as

the following goods/ services in Classes 16 and 35:

Printed matter, namely, magazines, newsletters and journals relating to banking, broking and financial procedures and services; printed instructional and teaching material not including apparatuses, namely, printed

instructional and teaching material in the field of finance; printed matter and printed publications, namely, printed information reports all related to banking, broking and financial procedures and services, in Class 16.

Business advisory services relating to stock floatation, capital restructuring, financing policies, mergers and acquisitions; business advisory services relating to banks; business appraisal relating to banks; provision and compilation of business information relating to banks; business enquiries relating to banks; business advisory services relating to banking business management and organization; business management relating to banks; business planning relating to banks; preparation of banking business reports; business management relating to trust; preparation of reports relating to financial services, namely, preparation of reports relating to finance and investments for business or commercial purposes, in Class 35.

Applicant has carefully considered the Examining Attorney's remarks but simply cannot agree that

Applicant's mark would be likely to cause confusion with the mark of the cited registration. Applicant submits that the Examining Attorney erred by focusing solely on the marks' similarities rather than giving appropriate weight to the dissimilarities in appearance and sound.

Applicant respectfully requests that the Examining Attorney reconsider her position and waive the citation, in order to allow Applicant's mark to proceed to publication.

There are notable differences between Applicant's mark and the mark of the cited registration in terms of sight and sound. Further, consumers of financial services are sophisticated and exercise a high degree of care in choosing an entity to handle their money.

Consumers are also aware of the use of arguably-similar marks by

different entities in the financial services industry, which has led courts to determine that there is minimal or no likelihood of confusion between similar names and marks of financial institutions even with shared terms. These factors are discussed below.

The Marks are Distinguishable

Applicant's mark is GUARD CAPITAL with a distinctive design, whereas the cited mark is CAPITALGUARD. The marks do not sound alike when spoken. GUARD is the first term in Applicant's mark, and it is the second term in Applicant's compound mark.

Thus, the marks begin with terms that sound nothing alike. Similarly, the marks end with wording that does not sound alike.

The marks also create different visual images when the respective marks are viewed in their entireties. The transposition of the individual terms, coupled with the distinctive design element in Applicant's mark, gives rise to marks that are substantially different in appearance. Thus, this factor weighs in Applicant's favor.

The Parties' Consumers are Sophisticated

Even when marks share similarities, the sophistication of the relevant purchasers must be considered as part of a likelihood of confusion

analysis. In re Software Design, Inc., 220 USPQ 662 (TTAB) (“they are ... relatively expensive services, which are likely to be purchased only with care and deliberation after investigation ... and under these circumstances, the phonetic similarity between the marks is not as significant As it would be if the marks were used, for example, to identify inexpensive, over-the-counter items...”). With respect to services in the financial services field, courts and the Board has found consumers weighs heavily in favor of finding no likelihood of confusion. See First National Bank in Sioux Falls v. First National Bank South Dakota, 47 USPQ2d 1847 (8th Cir. 1998) (finding purchasers of banking services sophisticated consumers that tend to exercise a relatively high degree of care in selecting services and are therefore more likely to notice minor differences in marks). In re Bridger Management, LLC, Serial No. 78516349 (TTAB Dec. 28, 2007) (reversing examiner’s refusal since “[t]he nature of the services clearly requires that any of the involved financial transactions are made only with care and deliberation after investigation.”). The degree of inquiry that consumers of financial services are likely to make before making a purchase decision is expected to be thorough, since no reasonable consumer would do

business with a financial institution or investment manager they do not know or trust to handle their money. The services provided by Applicant and the cited registrant are not the type of services that would be subject to impulse buying. This factor too weighs strongly in Applicant's favor.

Consumers have been Educated to Distinguish Between Marks in this Field

Consumers are also aware of the use of similar marks by different entities in the financial services field, and this has led courts to determine there can be minimal or no likelihood of confusion even where the names of financial institutions share the same dominant terms. First Savings Bank, F.S.B. v. First Bank System, Inc. , 40 USPQ2d 1865 (10th Cir. 1996) (no likelihood of confusion between "FirstBank" and "First Bank System" service marks where bank logos were visually distinct); Sun Banks of Fla., Inc. v. Sun Fed. Sav. & Loan , 211 USPQ 844 (5th Cir. 1981) (no likelihood of confusion between "Sun Federal Savings" and "SunBanks" service marks); First Bank v. First Bank System, Inc., 909 F.Supp. 657, 661 (S.D.Iowa 1995) (confusion between names "First Bank" and "First

Bank Iowa” is reasonably manageable such that equities weigh against permanent injunction), aff'd. 38 USPQ2d 1837 (8th Cir. 1996). As such, this factor weighs in Applicant’s favor.

Confusion Must be Likely

The mere possibility of confusion is not enough to justify a refusal to register Applicant’s Mark. In a Section 2(d) determination, the concern is not “with mere theoretical possibilities of confusion, deception or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.” Witco Chemical Corp. v. Whitfield Chemical Co., 164 USPQ 43, 44 (CCPA 1969). The Lanham Act precludes registration of a mark only where confusion as to source or origin is likely, not where merely a possibility of such confusion exists. In re Hughes Aircraft, 222 USPQ 263, 264 (TTAB 1984).

Conclusion

Under the circumstances, Applicant believes that its mark is distinguishable from the cited registration. Accordingly, Application respectfully requests that the Section 2(d) refusal be withdrawn and that Applicant’s mark be approved for publication.

SIGNATURE SECTION

RESPONSE SIGNATURE	/TLZ/
SIGNATORY’S NAME	Tracy L. Zawaski
SIGNATORY’S POSITION	Attorney of record, Illinois bar member

SIGNATORY'S PHONE NUMBER	312-368-3470
DATE SIGNED	08/03/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Aug 03 22:24:21 EDT 2015
TEAS STAMP	USPTO/RFR-65.175.3.10-201 50803222421607917-8623034 5-5408992f2e91db87733d3fb 97ff26368becb1e8123d6157e cdb22946b4f388ba82-N/A-N/ A-20150803222321122888

PTO Form 1960 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 07/31/2017)

**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **86230345** GUARD CAPITAL (Stylized and/or with Design, see <http://tmng-al.uspto.gov/resting2/api/img/86230345/large>) has been amended as follows:

ARGUMENT(S)

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

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SIGNATURE(S)

Request for Reconsideration Signature

Signature: /TLZ/ Date: 08/03/2015

Signatory's Name: Tracy L. Zawaski

Signatory's Position: Attorney of record, Illinois bar member

Signatory's Phone Number: 312-368-3470

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: 86230345

Internet Transmission Date: Mon Aug 03 22:24:21 EDT 2015

TEAS Stamp: USPTO/RFR-65.175.3.10-201508032224216079

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