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

Proceeding	86394529
Applicant	NexBank Capital, Inc.
Applied for Mark	NEXBANK
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Serial No.: 86394529
Mark: NEXBANK
Applicant/Appellant: Nexbank Capital, Inc.
Examining Attorney: Anne M. Farrell
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**EX PARTE APPEAL
APPELLANT'S BRIEF**

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I. DESCRIPTION OF THE RECORD

A. Prosecution History

The Application for NEXBANK was filed on September 15, 2014 under section 1(a) in for “[f]inancial affairs, monetary affairs; banking and related financial services; financial research; financial information; financial analysis; financial advice; financial planning; financial consultation; financial management; investment brokerage; investment consultation; investment management; investment advice; mutual fund investment; real estate lending; corporate lending; treasury management; loan servicing; deposit services; mortgage banking; mergers; acquisition; corporate finance; corporate reorganization; residential and small commercial real estate developments; developing and purchasing land; providing resources to develop real estate infrastructure, such as roads, utilities and other additions; Investment Banking, including Mergers and Acquisitions, Corporate Finance, Sponsor Services, Valuations and Expert Opinions; Restructuring services, including Corporate Reorganization, Creditor and Debtor Advisory, Operations Advisory, Crisis and Interim Management, Fiduciary and Wind-Down Services; Operations Advisory services, including Enterprise Value Realization, Strategy Deployment, Operations Improvement, Revenue Generation, Mergers and Acquisitions Support, and Training and Education; and Real estate services, namely Property Management and Direct Investments.”

The Examining Attorney initially refused NEXBANK on January 5, 2015 “because of a likelihood of confusion with the mark in U.S. Registration No. 4380835,” particularly, “NEXT MYNEXTBANK.COM”. *See* Office Action dated January 15, 2015 at 2-5. The Office Action dated January 5, 2015 also noted that the application as filed identified services in at least three (3) classes while having only submitted fees for a single class. As such, the Office Action dated

January 5, 2015 required that the Applicant either restrict the services identified to a single class or submit additional fees. *Id.* at 5-6.

Appellant responded on July 5, 2015, amending the description services to identify “[f]inancial affairs, monetary affairs; banking and related financial services; financial research; financial information; financial analysis; financial advice; financial planning; financial consultation; financial management; investment brokerage; investment consultation; investment management; investment advice; mutual fund investment; real estate lending; corporate lending; treasury management; loan servicing; deposit services; mortgage banking; mergers; acquisition; corporate finance; corporate reorganization; residential and small commercial real estate developments; developing and purchasing land; providing resources to develop real estate infrastructure, such as roads, utilities and other additions; Investment Banking, including Mergers and Acquisitions, Corporate Finance, Sponsor Services, Valuations and Expert Opinions; Restructuring services, including Corporate Reorganization, Creditor and Debtor Advisory, Operations Advisory, Crisis and Interim Management, Fiduciary and Wind-Down Services; Operations Advisory services, including Enterprise Value Realization, Strategy Deployment, Operations Improvement, Revenue Generation, Mergers and Acquisitions Support, and Training and Education; and Real estate services, namely, Property Management and Direct Investments.” *See* Response to Office Action dated July 6, 2015. Appellant also distinguished the applied-for mark from the NEXT MYNEXTBANK.COM, identified by the January 5, 2015 Office Action. *See* Response to Office Action dated July 6, 2015.

On July 28, 2015, the Examiner responded, suspending action in view of three (3) prior-filed applications for trademark, particularly, U.S. Application Serial Nos. 85857303, 85872277, and 86371486. *See* Suspension Notice dated July 28, 2015.

The Examining Attorney again refused NEXBANK on October 2, 2017 “because of a likelihood of confusion with the mark in U.S. Registration No. 4978333,” particularly, “NXT BANK.” *See* Office Action dated October 2, 2017.

Appellant responded on April 2, 2018, arguing that NEXBANK is distinct from NXT BANK. Particularly, Appellant explained that NEXBANK and NXT BANK yield entirely different commercial impressions and, in consideration of the narrow scope of protection for marks registered in IC 036 and containing NXT, NEX, and NEXT, would have given rise to a likelihood of confusion.

The Examining Attorney responded on April 30, 2018, finally rejecting NEXBANK, “because of a likelihood of confusion with the marks in U.S. Registration Nos. 4380835 and 4978333,” NEXT MYNEXTBANK.COM and NXT BANK, respectively.

On October 30, 2018, Appellant submitted a Notice of Appeal in conjunction with a Request for Reconsideration, urging the allowability NEXBANK. The Examining Attorney denied the Request for Reconsideration on November 26, 2018.

However, prior counsel for Appellant failed to submit an Appeal Brief within the time allotted for the same and, as such, the Appeal in this application was dismissed and the application subsequently deemed abandoned. Upon learning of the failure to submit an Appeal Brief and the subsequent dismissal and abandonment, Appellant promptly sought and engaged new counsel.

Appellant, by new counsel, now submit this Appeal Brief in conjunction with motion to accept a late-filed Appeal Brief pursuant to T.B.M.P. § 1203.02(a) and T.M.E.P. § 1714.01(f)(ii)(E).

B. Appellant's Evidence

Appellant believes the following evident to be pertinent to the issues presented herein.

Application and Specimen

Appellant included no evidence pertinent to the issues presented herein along with the Application and Specimen, as filed on September 15, 2014.

Response to Office Action dated July 6, 2015

Appellant included no evidence pertinent to the issues presented herein along with the Response to Office Action dated July 6, 2015.

Response Office Action dated April 2, 2018

In the Response to Office Action dated April 2, 2018, Appellant referenced various registered marks identifying services in IC 036 and incorporating NXT, NEX, or NEXT. Specifically, Appellant identified U.S. Registration 5410271, U.S. Registration 531598, U.S. Registration 5355985, U.S. Registration 5198559, U.S., Registration 5324486, U.S. Registration 5101894, U.S. Registration 5101893, U.S., Registration 5101891, U.S. Registration 5206075, U.S. Registration 4871641, U.S. Registration 4969264, and U.S. Registration 5007034.

Request for Reconsideration dated October 30, 2018

Along with the Request for Reconsideration dated October 30, 2018, Appellant included the previously-referenced, registered marks, specifically U.S. Registration 5410271, U.S. Registration 531598, U.S. Registration 5355985, U.S. Registration 5198559, U.S., Registration 5324486, U.S. Registration 5101894, U.S. Registration 5101893, U.S., Registration 5101891, U.S.

Registration 5206075, U.S. Registration 4871641, U.S. Registration 4969264, and U.S. Registration 5007034.

C. Examining Attorney's Evidence

Office Action dated January 5, 2015

The Office Action dated January 5, 2015 referenced various registered trademarks and trademark applications. Among the evidence identified by in the Office Action dated January 5, 2015, most-pertinent is U.S. Registration 4380835.

Suspension Notice dated July 28, 2015

The Suspension Noticed dated July 28, 2015 referenced three pending trademark applications, particularly, U.S. Application Serial Nos. 85857303, 85872277, and 86371486.

Office Action dated October 2, 2017

The Office Action dated October 2, 2017 included no new or further evidence pertinent to the issues here-presented.

Final Office Action dated April 30, 2018

The Final Office Action dated April 30, 2018 included no new or further evidence pertinent to the issues here-presented.

II. STATEMENT OF THE ISSUES PRESENTED

The sole issue on Appeal is whether or not Appellant's mark, NEXBANK, bears a likelihood of confusion with respect to any previously-registered mark, particularly, whether or

not there is “a likelihood of confusions with the marks in U.S. Registration Nos 4380835 and 4978333,” for NEXT MYNEXTBANK.COM and NXT BANK, respectively.

III. ARGUMENT

A. Legal Standard.

Whether a likelihood of confusion exists is a question of law, based on underlying factual determinations. *See Lloyd’s Food Prods., Inc. v. Eli’s, Inc.*, 987 F.2d 766, 767, 25 U.S.P.Q.2d 2027, 2028 (Fed. Cir. 1993); *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 352, 22 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1992). Likelihood of confusion is determined on a case-specific basis, applying the factors set out in *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (CCPA 1973) (enumerating factors that may be considered when relevant evidence is of record).

Specifically, the *DuPont* factors are: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made; (5) the fame of the prior mark (sales, advertising, length of use); (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used (house mark, “family” mark, product mark); (10) the market interface between applicant and the owner of a

prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion, i.e., whether de minimis or substantial; and (13) any other established fact probative of the effect of use. *See id.* Of these, the dissimilarities of the marks in their entireties are dispositive, here.

B. Analysis

As noted above, the sole issue on Appeal is whether or not there is “a likelihood of confusions with the marks in U.S. Registration Nos 4380835 and 4978333,” for NEXT MYNEXTBANK.COM and NXT BANK, respectively. *See supra.*

1. The Examining Attorney’s Rejection

The Examining Attorney suggests that NEXBANK is confusingly similar to NEXT MYNEXTBANK.COM and NXT BANK. *See* Final Office Action. The Examining Attorney explains:

Registrant’s mark is “NEXT MYNEXTBANK.COM” and design.
Applicant’s mark is “NEXBANK”.

...

In this case, the marks share the identical portion “BANK” and the similar terms “NEXT” and “NEX”. **The mark “NEXBANK” sounds highly similar to registrant’s use of “NEXTBANK”.**

Thus, the marks are highly similar.

See Office Action dated January 5, 2015 (emphasis added), and:

In this case, registrant’s mark is NXT BANK. Applicant’s mark is NEXBANK.

The marks are highly similar in sound and commercial impression.

The attached evidence shows that “NXT” is an abbreviation for “next.” See the attached evidence. **Applicant’s mark sounds very similar to “next.” Additionally, the marks share the identical wording “BANK.”**

...

Thus, the marks are highly similar.

See Office Action dated October 2, 2017 (emphasis added). That is, the Examining Attorney’s finding that NEXBANK is confusingly similar to each of NEXTBANK and NXT BANK is premised upon the Examiner’s opinion that NEX sounds highly similar to each of NEXT and NXT. *See supra.*

As discussed below, the Examining Attorney’s finding that NEXBANK is confusingly similar to each of NEXTBANK and NXT BANK is incorrect because NEX yields an entirely different commercial impression than each of NEXT and NXT.

2. NEX yields an entirely different commercial impression than each of NEXT and NXT.

In considering the similarity or dissimilarity of the marks in their entireties as to appearance, sound, and meaning, the test is what the purchasing public would think when confronted with the mark as a whole. *See, e.g., In re Electrolyte Laboratories, Inc.*, 16 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990) (“likelihood of confusion depends on the overall impression of the marks;” “[n]o element of a mark is ignored simply because it is less dominant.”); *see also, In Re Hearst Corp.*, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992) (“Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight.”); T.M.E.P. § 1207.01. When the respective marks are considered in their entireties, it is clear there is no likelihood of confusion.

Viewed in their entirety, the marks are dissimilar. Particularly, the marks, as a whole, are different in sight, sound, meaning and overall commercial impression and there is no likelihood of confusion.

Contrary to the Examiner's assertion that NEX sounds like NEXT or NXT, the first syllable of each mark looks and sounds entirely different, providing distinctive commercial impressions. NXT and NEXT each sound like and give the impression of the word "next." Conversely, the first syllable of Applicant's mark is composed of the letters NEX. NEX sounds markedly different from each of NXT and NEXT. The Examining Attorney asserts, without support, that NEX sounds like "next." *See supra*. It does not—the absence of the hard consonant sound of the letter "T" at the end of "NEX" yields a significantly different sound with respect to each of NXT and NEXT.

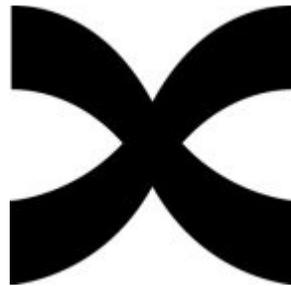
Responsive, the Examining Attorney suggests:

Applicant argues that "NEX" is dissimilar because it does not include the hard consonant sound of the letter "T." However, **slight differences in the sound of similar marks will not avoid a likelihood of confusion.** *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983); *see In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012).

Office Action dated April 30, 2018 (emphasis added). That is, the Examining Attorney suggests that the differences resulting from the "T" at the end of "NXT" and "NEXT" are, effectively, insignificant. As explained above, the "T" sound is significant; *nex* sounds entirely different from *next*.

Moreover, even if, *arguendo*, NEX did not sound different from both NXT and NEXT, it yields a significantly different commercial impression. The Examining Attorney has presented no evidence to demonstrate that NEX means, or might be recognized as meaning, "next." To the

contrary, the Examining Attorney fails to consider the possibility that NEX might have some meaning entirely apart from “next.” For instance, “NEX” could just as easily mean “nexus.” Notably, in the context of Appellant’s mark, the “X” in NEXBANK is representative of the stylized “X” of Applicant’s U.S. Registration 4536723:



See U.S. Registration 4536723. It is evident that the “X” in NEXBANK, and in fact, “NEX” in NEXBANK, each invoke the idea of a nexus, that is, an intersection/integration of the different, but related services provided by Applicant under the mark. The specimens provided with the instant application illustrate that NEXBANK is used to identify and provide this nexus, integration/intersection of services, noting that NEXBANK “...is a fully-integrated financial services organization that includes a *commercial* and *investment* bank.” *See* Specimen.

Thus, not only has the Examining Attorney failed to provide any support for the conclusion that NEX yields a similar commercial impression with respect to NXT and NEXT, the Examining Attorney disregards evidence tending to indicate that NEX yields an entirely different commercial impression than each of NXT and NEXT. Appellant respectfully submits that NEXBANK yields an entirely different commercial impressions than each of NEXTBANK and NXT BANK. As such, considering the *DuPont* Factors, Appellant’s mark is not likely be confused with the cited registrations.

SUMMARY IN CONCLUSION

For the reasons given above, the Examining Attorney has failed to meet the burden necessary to establish that Appellant's mark, that NEXBANK is confusingly similar to either NEXT MYNEXTBANK.COM or NXT BANK. In light of the above, Appellant respectfully requests that the Board grant this Ex Parte Appeal and allow the registration of NEXBANK.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the mark, the Examining Attorney is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,
WICK PHILLIPS GOULD & MARTIN, LLP

Date: April 23, 2019

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