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Subject: U.S. Trademark Application Serial No. 88739935 - NFX CAPITAL - 117145-4003 - 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. 88739935

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Reference/Docket No. 117145-4003

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REQUEST FOR RECONSIDERATION

AFTER FINAL ACTION

DENIED

Issue date: **April 06, 2021**

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(s), 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).

In its request for reconsideration, applicant made additional amendments to its identification of services and asserts its amended services and the services specified in the cited registration are sufficiently distinct, unrelated, and unlikely to cause consumer confusion. Specifically, applicant states that registrant's services relate to conducting a derivatives exchange and other services that pertain to derivatives markets, and applicant's services relate to assisting startup companies and venture capitalists. Applicant asserts that because of its amendment to the identification of services, which now includes the wording "*all of the foregoing in connection with assisting startup companies and venture capitalists, and none of the foregoing in connection with conducting a derivatives exchange or providing data or information relating to derivatives markets*" in Class 36, and "*none of the foregoing in connection with conducting a derivatives exchange or providing data or information relating to derivatives markets*" in Class 41, that "*no overlap exists with respect the parties' services, the intended customers to whom their services are offered, and the channels of trade via which the parties' services would be advertised and offered.*"

In regards to applicant's argument that the parties' offerings are unrelated, the examining attorney notes that the fact that the services of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular services, but likelihood of confusion as to the source or sponsorship of those services. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01. Further, although applicant has narrowed its identification of services to specifically exclude services encompassing or in the field of derivatives, applicant's and registrant's services are nonetheless similar in nature as they both involve financial services. Indeed, the evidence of record shows that the same entities provide financial services related to derivatives markets as well as financial services involving venture capital and assistance to startup companies. Moreover, registrant's mark is incorporated in its entirety into applicant's mark and the parties' marks are identical in regards to their dominant source-indicating elements. Where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the services needed to support a finding of likelihood of confusion declines. *See In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *5 (TTAB 2019) (citing *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017)); TMEP §1207.01(a); *see also In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). Therefore, applicant's amendments to its identification of services to further narrow the fields of use does not avoid a likelihood of confusion.

Applicant argues that the regulatory requirements involved in registrant's business "*make it exceedingly unlikely that [a]pplicant would ever cross over into the registrant's field as described in the registration, that it would begin offering the same types of services as the registrant, or that the parties' respective consumers would be confused as to the sources of the parties' services.*" Applicant's argument that the barriers of entry to the registrant's business renders consumer confusion unlikely is unpersuasive

because applicant has not explained why the regulatory barriers to registrant's business would differentiate the marks in the minds of consumers, nor has applicant explained why consumers would not view applicant's services as being associated with the registrant. That is, even if applicant's argument that the regulatory barriers to registrant's business would cause consumers to believe that it is unlikely that applicant would be providing registrant's services, applicant's argument does not address the possibility that consumers could mistakenly believe that the registrant is the source or sponsor of applicant's services. The Trademark Act not only guards against the misimpression that the senior user is the source of a junior user's goods and/or services, but it also protects against "reverse confusion," where a significantly larger or prominent junior user is perceived as the source of a smaller, senior user's goods and/or services such that the "senior user may experience diminution or even loss of its mark's identity and goodwill due to extensive use of a confusingly similar mark by the junior user" for related goods and/or services. *In re i.am.symbolic, llc*, 866 F.3d 1315, 1329, 123 USPQ2d 1744, 1752 (Fed. Cir. 2017) (quoting *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993)); *Fisons Horticulture, Inc. v. Vigoro Indust., Inc.*, 30 F.3d 466, 474-75, 31 USPQ2d 1592, 1597-98 (3d Cir. 1994).

Finally, applicant notes in its request for reconsideration that registrant announced that it had ceased operations as a futures exchange. However, a trademark or service mark registration on the Principal Register is prima facie evidence of the validity of the registration and the registrant's exclusive right to use the mark in commerce in connection with the specified goods and/or services. *See* 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv). Thus, evidence and arguments that constitute a collateral attack on a cited registration, such as information or statements regarding a registrant's nonuse of its mark, are not relevant during ex parte prosecution. *See In re Dixie Rests.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); TMEP §1207.01(d)(iv). Such evidence and arguments may, however, be pertinent to a formal proceeding before the Trademark Trial and Appeal Board to cancel the cited registration.

Accordingly, the Section 2(d) refusal made final in the Office action dated September 10, 2020 is **maintained and continued**. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

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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