

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/416524

APPLICANT: Ptak, Frank S.

CORRESPONDENT ADDRESS:
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2900 Crystal Drive
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MARK: ACG

CORRESPONDENT'S REFERENCE/DOCKET NO: FP-1

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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

RE: Serial Number 76/416524

The assigned examining attorney has reviewed the referenced application and determined the following.

Failure to Function as a Mark

The examining attorney refuses registration because the proposed mark merely identifies a system, according to the identification of services in the application. The proposed mark, as used, would not be perceived as a service mark. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127. See *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213 (C.C.P.A. 1976); *In re Griffin Pollution Control Corp.*, 517 F.2d 1356, 186 USPQ 166 (C.C.P.A. 1975); *In re Big Stone Canning Co.*, 169 USPQ 815 (TTAB 1971). Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

The applicant should also note the following additional ground for refusal.

Refusal under Section 2(d) –Likelihood of Confusion

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods/services, so resembles the marks in U.S. Registration Nos.:

2,050,182	investment consultation;
2,112,210	computer software for forecasting sales; and services related to computer software for forecasting sales, namely, computer consultation services which entail the providing of written recommendations on the utilization of the software;
2,112,211	computer programs for businesses, namely, software for creating on line analytical processor (OLAP) data base reports using data retrieved from the global computer network.

-as to be likely to cause confusion, or to cause mistake, or to deceive. TMEP §1207. See the enclosed registrations.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

The goods or services of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

The applicant's proposed mark is ACG for business valuation services-- namely, providing a system for corroborating reported earnings of an enterprise. The registrants' referenced marks also

contain the letters "ACG." Consequently, the applicant's mark and the cited marks may be perceived by consumers to have a common source connection.

Because the respective marks are similar, the only issue before the examining attorney is whether the applicant's services are so related to the registrants' goods or services that confusion as to source of origin or sponsorship is likely to occur. The examining attorney must conclude that they are so related, for it is foreseeable that customers of the applicant might encounter the registrants' respective goods or services and mark in the marketplace given similar channel of trade within which the identified goods and services travel.

Confusion as to source of origin or sponsorship is extremely likely if the applicant's proposed mark is allowed to register. Registration is therefore refused by the examining attorney. Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

If the applicant decides to respond to the refusals, then the applicant must respond to the following items.

Entity Omitted

The applicant must indicate what type of entity is applying, for example, an individual, partnership, corporation or joint venture. 37 C.F.R. §2.32(a)(3); TMEP §803.03. The citizenship of the entity must also be indicated.

Recitation of Services

The wording "providing a system for" in the recitation of services is unacceptable as indefinite. A manual containing a listing of goods or services and proper wording for each classification is available on-line at the U.S. Patent and Trademark Office's web site: www.uspto.gov. The applicant may amend this wording to the following, if accurate:

"business evaluation of [specify subject matter]" in International Class 35.

TMEP section 804.

Please note, while an application may be amended to clarify or limit the recitation, additions to the recitation are not permitted. 37 C.F.R. Section 2.71(b); TMEP section 804.09. Therefore, the applicant may not amend to include any services that are not within the scope of services set forth in the present application.

Meaning of the Mark

The applicant must indicate whether the acronym "ACG" has any significance in the relevant trade. 37 C.F.R. § 2.61(b). If the mark does have any significance, the applicant must submit a concise description of the mark. 37 C.F.R. § 2.35.

Christopher L. Buongiorno

Christopher L. Buongiorno
Law Office 109
(703) 308-9109 ext. 240

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

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To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

[Typed Drawing]

Mark
ACG

Goods and Services
IC 036. US 100 101 102. G & S: investment consultation. FIRST USE:
19880227. FIRST USE IN COMMERCE: 19880227

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
74614399

Filing Date
December 22, 1994

Publication for Opposition Date
September 5, 1995

Registration Number
2050182

Registration Date
April 8, 1997

Owner Name and Address
(REGISTRANT) Asset Consulting Group, Inc. CORPORATION MISSOURI 7700
Bonhomme Avenue, Suite 650 Clayton MISSOURI 63105

Type of Mark
SERVICE MARK

Register
PRINCIPAL

Live Dead Indicator
LIVE

Attorney of Record
Richard B. Walsh, Jr.

[Typed Drawing]

Mark .

THE ACG FORECAST MANAGER

Goods and Services

IC 009. US 021 023 026 036 038. G & S: computer software for forecasting sales. FIRST USE: 19960801. FIRST USE IN COMMERCE: 19960801

IC 042. US 100 101. G & S: services related to computer software for forecasting sales, namely, computer consultation services which entail the providing of written recommendations on the utilization of the software. FIRST USE: 19960801. FIRST USE IN COMMERCE: 19960801

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75191164

Filing Date

November 1, 1996

Publication for Opposition Date

August 19, 1997

Registration Number

2112210

Registration Date

November 11, 1997

Owner Name and Address

(REGISTRANT) Application Consulting Group, Inc. CORPORATION NEW JERSEY
121 Headquarters Plaza Morristown NEW JERSEY 07960

Assignment Recorded

ASSIGNMENT RECORDED

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "FORECAST MANAGER" APART FROM THE MARK AS SHOWN

Type of Mark

TRADEMARK. SERVICE MARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

RICHARD T LAUGHLIN

[Typed Drawing]

Mark:
ACG ACTIVE OLAP SUITE

Goods and Services

IC 009. US 021 023 026 036 038. G & S: computer programs for businesses, namely, software for creating on line analytical processor (OLAP) data base reports using data retrieved from the global computer network. FIRST USE: 19960901. FIRST USE IN COMMERCE: 19960901

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75191165

Filing Date

November 1, 1996

Publication for Opposition Date

August 19, 1997

Registration Number

2112211

Registration Date

November 11, 1997

Owner Name and Address

(REGISTRANT) Application Consulting Group, Inc. CORPORATION NEW JERSEY
121 Headquarters Plaza Morristown NEW JERSEY 07960

Assignment Recorded

ASSIGNMENT RECORDED

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "ACTIVE OLAP SUITE" APART
FROM THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

RICHARD T LAUGHLIN

J

Incoming Correspondence Routing Sheet

To: TMO LAW OFFICE 113 - AWAITING RESPONSE DOCKET

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RAM Mail Date: 032703



2

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)
)
Frank S. Ptak)
)
Serial No. 76/416,524) Christopher L. Buongiorno
) Trademark Examining Attorney
) Trademark Law Office 109
Filed: June 3, 2002)
)
Mark: ACG)

Assistant Commissioner For Trademarks
Box RESPONSES NO FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

Dear Sir:

RECEIVED
2003 APR -8 A 10:39
OFFICE 113

RESPONSE

This paper is in response to the Office Action issued for the above referenced Office Action on October 8, 2002.

AMENDMENTS

1. Please amend the description of services as follows:

"Business valuation services, namely, corroborating reported earnings of an enterprise."
2. Please amend the application to show that applicant, Frank S. Ptak, is an individual with United States citizenship.

REMARKS

The Examiner has initially refused registration of the mark, stating that it fails to function as a trademark pursuant to Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051,

1052 and 1127. The Examiner also bases the initial refusal on a likelihood of consumer confusion with Registration Nos. 2,050,182, 2,112,210 and 2,112,211 under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). The Examiner also asks Applicant to indicate whether the acronym ACG has any significance in the relevant trade. Applicant respectfully offers the following remarks for the Examiner's consideration.

I. Applicant's Mark Functions as a Trademark

In response to the Examiner's initial refusal of registration, Applicant offers the above amendment to the description of services and the following comments. Applicant respectfully submits that he is not providing a system, but rather a service to consumers to assist in the valuation of business earnings. Applicant's description of services as applied for was poorly worded, and as such Applicant offers the above amendment to clarify that its services are business valuation services and not a system. This is further supported by the fact that Applicant applied for its mark in Class 36, which covers business services. In light of the above amendment and remarks, Applicant asks that the Examiner withdraw the refusal of registration based on failure of the mark to act as a trademark.

II. Applicant's Mark is Not Likely to Cause Confusion, or to Cause Mistake, or to Deceive with the Mark Cited by the Examiner.

The Examining Attorney has reviewed the above referenced application and initially refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), stating that the mark so resembles the mark in U.S. Registration Nos. 2,050,182, 2,112,210 and 2,112,211 as

to be likely to cause confusion, or to cause mistake, or to deceive. Applicant respectfully submits that its ACG mark is not confusingly similar to the marks cited by the Examiner and offers the following remarks for the Examiner's consideration.

A. The Services Sold Under Applicant's Mark are Sufficiently Different from the Goods or Services Sold by the Owners of the Marks Cited by the Examiner to Preclude a Likelihood of Consumer Confusion.

A factor to be considered is whether the goods or services sold under the potentially conflicting marks are sufficiently similar to create a likelihood of consumer confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 171 U.S.P.Q. 563, 567 (C.C.P.A. 1973); T.M.E.P. § 1207.01. In the present application, Applicant is attempting to register its ACG mark for "business valuation services, namely, corroborating reported earnings of an enterprise." These services are distinguishable from the goods and services provided under the marks cited by the Examiner. The marks cited by the Examiner are used for investment consultation (Registration No. 2,050,182) and computer software and programs for forecasting sales and services relating to the computer software and programs (Registration Nos. 2,112,210 and 2,112, 211). As the description of goods and services in the registrations cited by the Examiner indicate, the marks do not cover the services offered by the Applicant. The Applicant is not offering investment consultation services or software relating to sales forecasting and related services, but rather very specific business valuation services related to the earnings of an enterprise. As a result of the difference between the services offered by

the Applicant and the goods offered by the Registrant, the likelihood of consumer confusion is mitigated.

B. The Different Nature of the Goods and Services Offered Under the Mark Negate the Possibility that the Registrant Will Expand into the Applicant's Services.

Another *du Pont* factor to be considered by the Examiner in determining the likelihood of consumer confusion is whether the owner of the mark cited is likely to expand into the market in which the Applicant uses its mark. *du Pont* at 1361. The *du Pont* Court and its progeny hold that the likelihood of consumer confusion is minimized when there is little likelihood that the owner of a registered mark will expand into the area of goods or services sold by the potentially conflicting mark. *Id.*

In the present application, there is no evidence that the owners of the mark cited by the Examiner will expand into Applicant's specific and sophisticated business earnings valuation services. To the contrary, the registrations cited by the Examiner suggest that the owners are consistently limiting use of the marks for the distinguishable goods and services detailed in the registrations. The fact that the two registrations owned by Application Consulting Group, namely Registration Nos. 2,112,210 and 2,112, 211, cover related services further demonstrates that the Registrant will not expand into the Applicant's services. Similarly, the Applicant limits its services under its mark to the distinguishable services detailed above. In that it appears the Registrants of the marks cited by the Examiner will not

expand into the area and manner of services offered by the Applicant, there is no likelihood of consumer confusion between the marks.

C. The Applicant Markets Its Services Under its Mark to Different Audiences and Through Different Channels than the Marks Cited by the Examiner.

Under the *du Pont* test, the Examiner should also consider the target audience and resulting different channels used by the owner to market the goods or services sold under the mark. *Supra* at F.2d 1361. If the goods or services are marketed and sold via different channels, there is less likelihood for consumer confusion. *Id.*; T.M.E.P. 1207.01. In *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, the First Circuit held that different goods sold under identical marks to a pharmacy and lab in the same hospital would not create a likelihood of consumer confusion, 220 U.S.P.Q. 786, 791 (1st Cir. 1983). The Court held “[t]he ‘hospital community’ is not a homogenous whole, but is composed of separate departments with diverse purchasing requirements, which, in effect, constitute different markets for the parties’ respective products.” *Id.*

In the present application, Applicant targets its services to individuals within an enterprise that are responsible for and interested in valuation of the enterprises’ earnings. The typical consumer would be executive officers, members of a company’s board of directors and professional research analysts who are responsible for monitoring and assessing the company’s earnings. To the contrary, the Registrant for Registration No. 2,050,182 targets individuals seeking personal investment advice, and the owner of Registration Nos.

2,112,210 and 2,112,211 targets individuals involved in sales forecasting before any earnings are made by an entity. None of these targeted consumers of either Registrant is typically involved in the valuation of a company's earnings.

As in the *Astra* case, the Registrants cited by the Examiner will be communicating with different consumers than those of the Applicant, who have diverse requirements. While it is possible that individuals within the same company could utilize the Applicant's services, as well as those of the owner of Registration Nos. 2,112,210 and 2,112,211, as in *Astra*, there is no likelihood of consumer confusion because of the very different nature of the services and the different consumers seeking to use the services. Indeed, the Applicant's services are in a distinctly separate market with its own marketing methods, contacts and sales from that of Registrants' services. Accordingly, Applicant's distinguishable target audience requires promotion and marketing in channels of trade different from those of the Registrant of Registration Nos. 2,112,210 and 2,112,211. Applicant asserts that Registration No. 2,050,182 covers such distinguishable services that the target consumers would not likely be found within the same company.

The different target consumers and resulting channels of marketing and sales unique to the distinguishable services and audiences preclude the likelihood that a buyer would confuse the Applicant's ACG mark with the marks cited by the Examiner.

**D. The Purchasers of Registrant's Services are Sophisticated,
Precluding a Likelihood of Consumer Confusion.**

In determining the likelihood of consumer confusion, the Examiner should also consider the sophistication of the consumer who purchases the goods or services. *DuPont* at 567; *see also* T.M.E.P. 1207.01. When the sale of goods or services is limited to professional buyers, there is less likelihood of confusion between two marks. *Save-A-Stop, Inc. v. Sav-A-Stop, Inc.*, 121 U.S.P.Q. 232, 234 (1959). Indeed, it is reasonable to assume a higher standard of care exists with professional buyers than with ordinary consumers. *Id.* Additionally, consumers are generally discriminating and careful in their purchase of any type of financial services. *First National Bank, in Sioux Falls v. First National Bank, South Dakota*, 153 F.3d 885, 889-90 (8th Cir. 1980); *Express Funding Inc. v. Express Mortgage Inc.*, 34 U.S.P.Q.2d 1801, 1807 (E.D. Mich. 1995). Courts have also specifically found that consumers will exercise a great degree of care in selecting financial services and “are more likely to notice what, in other contexts, may be relatively minor differences in names.” *First National*, 153 F.3d at 889.

In the present matter, Registrants’ consumers are limited to individuals seeking investment consultation and those involved in sales forecasting. Both of these services are under the umbrella of the financial industry. Accordingly, Registrants’ consumers are highly sophisticated and would not mistakenly believe that Applicant’s services are related to those of the Registrants. Additionally, because of the narrow target audience of Registrants’ services, the specific consumers using Applicant’s services would not even be aware of the Registrants’ services.

Additionally, Applicant's services relating to business earning valuation are used by highly sophisticated consumers involved in the valuation of earnings of a company. Accordingly, Applicant's consumers will be capable of distinguishing Applicant's services from those of the Registrants. Because of the sophisticated nature of the consumers seeking the services of the Applicant and Registrants, as well as the sophisticated nature of the services themselves, there is not a likelihood of consumer confusion.

Finally, Applicant notes that the U.S. Patent and Trademark Office allowed Registration Nos. 2,112,210 and 2,112,211 to mature to registration despite the existing registration of Registration No. 2,050,182. Applicant respectfully asserts that its mark, which covers distinguishable services, can also co-exist in the marketplace.

III. Remaining Informalities

As to the Examiner's request for amendment of the recitation of services, Applicant submits that Amendment One (1) above addresses the request.

In response to the Examiner's request as to whether the acronym ACG has any significance in the relevant trade, Applicant respectfully submits that ACG is a coined mark of the Applicant. Applicant is unaware of any significance of the mark in the relevant trade.

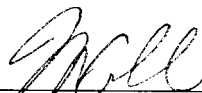
CONCLUSION

In light of the foregoing, Applicant respectfully submits that the ACG application is now entitled to publication and requests the same.

Respectfully submitted,

Dated: _____

3/16/03



Mark W. Croll
3600 West Lake Avenue
Glenview, IL 60025

Attorney for Applicant

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this Response is being deposited with the United States Postal Service as Express Mail, No. EJ53234089145 in an envelope addressed to: Assistant Commissioner For Trademarks, Box RESPONSES NO FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513:

Date: 3-26-03

Linda S. Kalyan