Attorney Dkt. No.: S-15328

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the matter of

Enterprise Financial Group, Inc.	Trademark Examining Attorney
U.S. Serial No.: 85/303,970	Janice Kim
Filed: April 25, 2011	Law Office 103
Mark: MPOWER	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

Applicant's counsel is in receipt of the Office Action dated October 30, 2015. After careful consideration of its contents and correspondence with applicant, counsel responds as follows.

AMENDMENT

Applicant requests the following amendment to International Class 36 only.

Providing motor vehicle services agreements on vehicles in the field of emergency roadside assistance; providing extended warranties on tires and wheels; extended warranty services, namely, service contracts; providing extended warranties for land vehicles; insurance services, namely, underwriting extended warranty contracts in the field of land vehicles; providing extended warranties on land vehicles; warranty claims administration, namely processing warranty claims for land vehicles; insurance services, namely, insurance consultation, insurance administration, insurance claim consultation, ***providing solely to credit unions for inclusion in their vehicle loan applications as incentives and benefits to their members***, in International Class 36.

REMARKS

Applicant has requested amendment to the identification in International Class 36 only in order to define its use of the mark with more specificity. The identification for International Class 37 remains in the application as previously amended.

The Examining Attorney has initially refused registration of applicant's mark under Section 2(d) of the Trademark Act citing U.S. Registration No. 4,729,767 for the mark M Power owned by Bayerische

Motoren Werke Aktiengesellschaft of Munich Germany (otherwise known as the luxury car manufacturer BMW.)

The Examining Attorney has appeared to refuse registration of applicant's mark specifically to International Class 36. Counsel must disagree with the Examining Attorney that applicant's mark MPOWER should be refused registration on the basis of Section 2(d) of the Trademark Act for the following reasons.

In an *ex parte* case, in determining whether there is a likelihood of confusion between two marks, the Examining Attorney must undertake two steps. First, the Examining Attorney must determine whether the marks are similar in appearance, sound, commercial impression, and meaning. See *In re E. I. du Pont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973). Secondly, 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. See *In re August Storck KG*, 218 USPQ 823 (TTAB 1983).

In connection with the first step to the analysis under Section 2(d) of the Trademark Act, the marks must be compared in their entireties, and similarities as well as dissimilarities must be considered in this analysis. Applicant's mark consists of the word MPOWER, which suggests the term EMPOWER, meaning "empowering someone to be stronger, more confident, especially in controlling their life and claiming their rights."

On the other hand, registrant's mark M Power, highly suggests registrant's luxury BMW M Series, which over the years has become associated with expensive, very high quality motor vehicles. It is believed most consumers viewing the mark M Power will associate the mark with BMW motor vehicles. A review of the specimens of record connected with the M Power registration file history reveals that the mark M Power is marketed in close connection with registrant's BMW mark.

While the applicant's mark may share some similarity to the cited registrant's mark, the commercial impression and meaning engendered by applicant's mark is highly dissimilar to the commercial impression and meaning behind registrant's M Power mark as it relates to its BMW branding.

With respect to the second step of the likelihood of confusion analysis, applicant believes its services in Class 36 would not, by nature, overlap with the registrant's services, primarily due to the fact that

applicant's services are narrowly directed to credit unions as evidenced by the amendment to the description of services in International Class 36 referenced above.

Applicant herein, Enterprise Financial Group, Inc., has partnered with one of the largest international financial services companies in the U.S. to develop the MPOWER product in the nature of specialized auto loans directed to credit union members. As noted from the attached page connected the applicant's promotional materials, "The approach behind MPOWER was to give credit union members confidence to make a vehicle purchase or loan decision following one of the largest national financial downturns in history. The name was developed as a brand promise, which served as a platform for significant market differentiation."

Even if the Examining Attorney assumes there is some overlap between the respective channels of trade of the applicant and the cited registrant, the primary issue for the Examining Attorney is whether there is a significant overlap between applicant's services and those of the registrant such that consumers would have reason to believe that applicant's services emanate from those of the registrant. Generally, where the channels of trade differ and do not lead to same target purchaser, there is less likelihood of confusion. Even if there were some market overlap, the mere movement of goods through the same overlapping channels would not necessarily result in a likelihood of confusion. Even if an overlap is considered *de minimus*, then a likelihood of confusion should be viewed as unlikely. See *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 21 USPQ2d 1388 (Fed. Cir. 1992).

The Trademark Trial and Appeal Board in the past has found no likelihood of confusion even with respect to identical marks applied to goods or services in a common industry where it can be shown that the respective goods would not be encountered by the same class of purchasers. See *Borg-Warner Chemicals, Inc. v. Helena Chemical Co.*, 225 USPQ 222 (TTAB 1983) (BLENDEX for chemicals not confusingly similar to BLENDEX for synthetic resins); *In re Fesco, Inc.*, 219 USPQ 437 (TTAB 1983) (FESCO & Design for distributorship services in the field of farm equipment and machinery versus FESCO for a variety of fertilizer processing machinery and equipment not confusingly similar); *Chase Brass & Copper Co., Inc. v. Special Springs, Inc.*, 199 USPQ 243 (TTAB 1978) (BLUE DOT for springs for engine distributors versus

BLUE DOT for brass rods, both products in new automobile manufacture, not confusingly similar); and *Autac, Inc. v. Walco Systems, Inc.*, 195 USPQ 11 (TTAB 1977) (AUTAC for thermocouple automatic temperature regulators for brushless wire preheaters versus AUTAC for retractile electric cords, both products used in the wire manufacturing industry, not confusingly similar).

In this case, given the differences between the marks themselves in connection with meaning and commercial impression, the differences in connection with the respective trade channels for applicant and registrant, the sophistication of the purchasers connected to registrant's goods and services in particular, and the fact that registrant's goods fall into the category of very expensive automobiles, meaning that consumers will pay closer attention to marks associated with registrant's brand, it is believed there is no possibility of likelihood of confusion in this case. Therefore, it is requested the Examining Attorney withdraw the refusal to register applicant's mark and allow the instant application to proceed to publish for opposition purposes at the earliest possible date.

If any further amendments are required, the Examining Attorney is encouraged to contact undersigned counsel by telephone.

Respectfully submitted,

ENTERPRISE FINANCIAL GROUP, INC.

Date: April 28, 2016

By: ________________________________

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Increase Loan Acquisition Success

The approach behind MPOWER was to give credit union members confidence to make a vehicle purchase or loan decision following one of the largest national financial downturns in history. The name was developed as a brand promise, which served as a platform for significant market differentiation. MPOWER was designed to:

Separate from the competition

Separate SWBC member credit unions from the competition by offering significantly more value than reputation and interest rate alone, and drive traffic through a break-through compelling offer;

Motivate auto financing

Provide products and services complimentary to the member that motivate auto loan financing as well as speak to a positive financial future. The program highlights the quality of loan servicing that each credit union provides, and the credit union's commitment to its

Focus on all phases of lending lifecycle

Focus on all phases of the lending lifecycle (rather than just loan closing and communicate with the credit union's member base through a behaviorally triggered email contact strategy; and,

Communicate a consistent brand promise

Communicate a consistent brand promise across all platforms enabling member credit unions to drive in increased awareness and ultimately decrease advertising costs.