

Response to Office Action

MARK: VENTURE
SERIAL NO.: 87868862
APPLICANT: Brent F. Cooley
FILING DATE: July 27, 2018
INTERNATIONAL CLASS: 036
TO: Geoffrey Fosdick
Examining Attorney
USPTO, Law Office 111

This is in response to the Office Action dated July 27, 2018, wherein the Examining Attorney refused registration for the composite mark “VENTURE” (the “Applicant’s Mark”), in Class 036, under Section 2(d) for likelihood of confusion with the existing work mark for “VENTURE” bearing registration number 1502489 (the “Cited Mark”). In addition the Examiner cited the prior pending application for “VENTURE” in standard characters, bearing serial number 87472784 as a potential source of confusion (the “Prior Pending Mark”).

Applicant respectfully requests that the Examining Attorney reconsider and withdraw the refusal to register on this ground.

I. Likelihood of Confusion Standard

Likelihood of confusion is determined on a case-by-case basis, with application of the factors identified in *Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The likelihood standard means that it must be probable that confusion as to source will result from the simultaneous registration of two marks; it is not sufficient that confusion is merely possible. Trademark law is “not concerned 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.” *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713 (Fed. Cir. 1992), quoting *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 1403 (C.C.P.A. 1969). As such, no per se rule exists that confusion is automatically likely between marks merely because they share similar wording. Moreover, registrations for identical marks (which Applicant’s mark and Cited Mark are not) for closely related goods and services may coexist when the totality of the circumstances indicates there is no likelihood of confusion.

II. The Applicant's Mark Is Visually Dissimilar From The Cited Mark and They Create Distinct Commercial Impressions In Their Respective Contexts

The Applicant's Mark is dissimilar from the Cited Mark in appearance and overall commercial impression.

1. The Marks Are Dissimilar In Appearance

In determining likelihood of confusion, marks being compared should be considered in their entirety. *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005 (C.C.P.A. 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). It is improper to focus on a single portion of a mark and decide likelihood of confusion only upon that feature, ignoring all other elements of the mark. *Massey Junior*

College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399, 1402 (C.C.P.A. 1974).

Here, Applicant's Mark is the word "venture," with a capital V and the rest of the letters in lowercase, accompanied by the graphic logo seen in the representation below. Both the registered mark and the prior-pending mark contain only the word "venture" in standard characters (Prior-Pending Mark) of typed characters (Registered Mark).



Applicant's Composite Mark

The Applicant acknowledges that the inclusion of a design element does not itself distinguish a mark from a mark with similar or identical literal element. However, respectfully, in this case the design element does sufficiently distinguish the marks in question. Consumers tend to focus on the first word in a mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("VEUVE . . . remains a 'prominent feature' as the first word in the mark[.]") The design element in the Applicant's mark—including a striking 4-pointed star shape that is the focus of the entire mark—is arranged to the left of the word "venture," making it essentially the first thing readers see when they encounter the mark. Since consumers tend to focus on the first word in a mark, and this design is essentially arranged as the first word in the mark, consumers are likely to focus on this design component over the literal portion "venture."

Because it is the most striking, distinctive feature of the mark (more striking than anything in either Cited Mark), the Applicant respectfully concludes that it obviates any meaningful likely confusion between the Applicant's Mark and the Cited Marks.

2. The Respective Services Are Distinguishable

The goods offered under the respective marks are dissimilar. There is no per se rule that goods or services which fall into the same broad, general field are "related" for Section 2(d) purposes. See *Umc Industries, Inc. v. Umc Electronics Co.*, 207 U.S.P.Q. 861, 879, 1980 WL 30155 (T.T.A.B. 1980) ("[T]he fact that one term, such as 'electronic', may be found which generically describes the goods of both parties is manifestly insufficient to establish that the goods are related in any meaningful way.").

Here, while Applicant acknowledges that the identification of goods contains some overlapping descriptions as Cited Mark's, examining the goods sold in context demonstrates that the goods offered under each mark are dissimilar.

The trademarks in question in this matter are registered/applied-for for the following services.

Applicant's
Mark



IC 36

Business brokerage services and related consulting pertaining to business sales, mergers, acquisitions and business valuations; Insurance brokerage; Insurance brokerage services; Insurance information and consultancy; Insurance agencies

Registered
Mark

VENTURE

IC 36

LIFE INSURANCE SERVICES, NAMELY UNDERWRITING AND ADMINISTERING ANNUITIES

Prior-
Pending
Mark

VENTURE

IC 36

insurance underwriting in the field of accident, property, casualty and worker's compensation insurance; insurance administration; underwriting, brokerage and administration of accident, property, casualty and worker's compensation insurance for social clubs, private clubs, country clubs, golf clubs, athletic clubs, fitness clubs, gyms, yoga and fitness studios, spas, hunting clubs, fishing clubs, university clubs, commercial marine businesses, marine vessels, commercial properties, hotels, resorts, hunting lodges, fishing lodges, homeowner associations, golf management companies, hotel management companies, personal trainers

While all three of these recitations of services are broadly under the banner of “financial services,” the Applicant’s services are sufficiently distinct to obviate any meaningful confusion. Applicant’s services are designed for the business brokerage, M&A, consulting and business valuation contexts, as well as the insurance brokerage context.

The Registered Mark and the Prior-Pending Mark both recite only insurance-centric services. The Registered Mark is authorized for use only in connection to life insurance underwriting. As financial services go, life insurance underwriting and M&A consulting services are about as distinct as possible within that one broad umbrella. Life insurance is a very personal field where consumers’ ultimate interest is the well-being of others in the event he or she sustains some kind of accident. M&A consulting is a field governed largely by impersonal and short-term (or at least relatively short-term) financial interests of the customer him- or herself.

The Prior-Pending Mark seeks registration for use in connection with accident, property, casualty and workers’ comp insurance underwriting for 23 specific types of businesses. While this and business brokerage consulting could appear to be similar, the addition of types of businesses in the Prior-Pending Application indicates that that mark’s services are exclusively providing insurance for those types of businesses. The Applicant’s mark, on the other hand, is used primarily for valuation of such businesses and consulting for clients interested in purchasing any kind of business, including the 23 types recited in the Prior-Pending Application. In other words, the Applicant’s services are business brokerage consulting that happens to include insurance underwriting as a natural byproduct, whereas the prior-pending applicant is an insurance company that exclusively offers accident, property, casualty, and workers’ comp

insurance.

3. The Marks Create Distinct Commercial Impressions In Their Respective Contexts

Most importantly, the marks create distinct connotations in their respective contexts. In determining the commercial impression created by a mark, the mark must be viewed in its entirety. *See Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974). Further, a mark that contains in part the whole of another mark will not be found to pose a likelihood of confusion where the marks differ in overall commercial impression. In *In re Hearst Corp.*, 25 U.S.P.Q. 2d 1238 (Fed. Cir. 1992), the court found that the Trademark Trial and Appeal Board had erred in holding that there was a likelihood of confusion between VARGAS and VARGA GIRL, both for use on calendars, stating that although “Vargas” and “Varga” were similar, “the marks must be considered in the way they are used and perceived ... and all components thereof must be given appropriate weight.” The court went on to say that “[b]y stressing the portion ‘varga’ and diminishing the portion ‘girl’, the Board inappropriately changed the mark.” *In re Hearst Corp.* at 1239, *see also Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107 (C.C.P.A. 1972) (ALL CLEAR not likely to cause confusion with ALL, both for household cleaning products).

The Registered Mark

The word “venture” takes on a completely distinct meaning in the context of “*Business brokerage services and related consulting pertaining to business sales, mergers, acquisitions and business valuations*” than it does with “*LIFE INSURANCE SERVICES*”. When colored by the business brokerage, M&A context, “venture” echoes the connotations of the word as used in, e.g. “venture capital,” that is, the high-risk, high-reward excitement built into “venturing” into unchartered markets, etc. In sum, it is “venture” in the entrepreneurial, profit-seeking sense.

When used with respect to life insurance services, “venture” takes on a softer, more philosophical meaning of “venture” as the enterprise of one’s life itself.

The Prior-Pending Mark

When used in the context of “accident, property, casualty and workers’ compensation insurance,” “venture” takes on a similar meaning to that of the life insurance context. This meaning is substantially distinct from use in connection with the services recited in Applicant’s services portion. Moreover, the Prior-Pending Application specifies 23 particular types of businesses for which it intends to provide these insurance services.

When the average consumer encounters “venture” in connection with an insurance company that advertises its accident, property, casualty, and workers’ comp services to specific types of businesses, he or she is likely to interpret it as meaning the business itself, *i.e.* the country club, golf club, fitness club, etc. When the same average consumer encounters “venture” in connection with business brokerage/M&A consulting, he or she is most likely to interpret it as meaning the *purchase* of the business is itself the “venture.” While obviously related, these two commercial impressions are highly distinct.

III. The Conditions Under Which Sales Are Made And The Buyers To Whom They Are Made Renders Confusion Unlikely

Conditions under which purchases of a particular kind of good or service are made are to be considered in determining likelihood of confusion. TMEP § 1207.01.

The consumer base for Applicant's services includes individuals and business entities information for a business merger or acquisition, and/or information related to insurance brokerage in the abstract. Both the Registered Mark and the Prior-Pending Mark are targeted at a consumer base that is purchasing insurance services themselves, whether it be life insurance or insurance related to an existing business.

Even if there is some overlap in the consumer base, which Applicant does not deny, consumers purchasing any of these services would be sophisticated with respect to business valuation, the operation of the business in question, and/or the insurance market in question.

Respectfully, there is a stark difference in conditions under which the sale of the respective goods are sold and the buyers to whom they are made. Therefore, such buyers would be highly unlikely to be confused.

IV. Conclusion

Because, as described in greater detail above, Applicant's Mark is highly unlikely to cause any confusion with the Cited Marks, particularly when examining each mark in their respective contexts, Applicant respectfully submits that the Mark is entitled to registration on the Principal Register.

Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's Mark and approve the Application for publication. If a telephone call will assist in the prosecution of this Application, the Examining Attorney is invited to call 917-933-3895.

Respectfully submitted,

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