IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Baron Capital Group, Inc.	Law Office	: 111
		Examiner	: Judith Michel Helfman
Serial No.	: 87/816,616		
Filed	: March 1, 2018		
Mark	: BARON FUNDS (& Design)		

RESPONSE TO OFFICE ACTION

This is in response to the Office Action dated June 15, 2018.

I. DISCLAIMER

In accordance with the Examining Attorney's request, the Applicant hereby amends the application to insert the following disclaimer:

No claim is made to the exclusive right to use "FUNDS" apart from the mark as shown. In so doing, Applicant does not waive, and hereby expressly reserves, any common law rights that it has accrued or will accrue in the mark as a whole.

II. CLAIM OF OWNERSHIP OF PRIOR REGISTRATIONS

Applicant is hereby submitting a claim of ownership to the following registrations: BARON FUNDS (Reg. No. 2,662,525) and BARON (Reg. No. 2,961,602).

III. RESPONSE TO REFUSAL UNDER SECTION 2(D)

i. *Introduction*

The Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act on the basis that the mark, when used in connection with the applied for services in Class 36, is confusingly similar to the mark BARRON'S (Reg. No. 4,567,087), registered on July 15, 2014 and owned by Dow Jones & Company, Inc. (the "Cited Mark").

As an initial matter, Applicant notes that it owns the following fifteen registrations, *all of which predate the registration date of the Cited Mark*. Copies of the registration certificates for these marks are attached as **Exhibit A**.

Mark	Status	Reg. Date/Reg. No.	Goods/Services
BARON FUNDS **Disclaims:** “FUNDS"	Renewed (Registered) **First Used:** 12-JUN-1987 (IC 36) **In Commerce:** 12-JUN-1987	**Reg** 17-DEC-2002 **Reg** 2662525	**INT. CL. 36** Investment management services and mutual fund investment
BARON OPPORTUNITY FUND **Disclaims:** “OPPORTUNITY FUND"	Renewed (Registered) **First Used:** 18-JAN-2000 (IC 36) **In Commerce:** 18-JAN-2000	**Reg** 15-JUN-2004 **Reg** 2854085	**INT. CL. 36** Financial services, namely mutual fund brokerage, distribution and investment services
BARON	Renewed (Registered) **First Used:** OCT-1984 (IC 36) **In Commerce:** OCT-1984	**Reg** 14-JUN-2005 **Reg** 2961602	**INT. CL. 36** Investment management services, mutual funds investment, mutual funds distribution and mutual funds brokerage
BARON FOCUSED GROWTH FUND **Disclaims:** “GROWTH FUND"	Registered **First Used:** 31-DEC-2010 (IC 36) **In Commerce:** 31-DEC-2010	**Reg** 24-JUL-2012 **Reg** 4180101	**INT. CL. 36** Investment management; mutual fund investment
BARON EMERGING MARKETS FUND **Disclaims:** “EMERGING MARKETS FUND"	Registered **First Used:** 31-DEC-2010 (IC 36) **In Commerce:** 31-DEC-2010	**Reg** 01-NOV-2011 **Reg** 4048017	**INT. CL. 36** Investment management; mutual fund investment
BARON ASSET FUND **Disclaims:** “ASSET FUND"	Registered **First Used:** 12-JUN-1987 (IC 36) **In Commerce:** 12-JUN-1987	**Reg** 27-JUL-2010 **Reg** 3825113	**INT. CL. 36** Investment management; mutual fund investment
BARON GROWTH FUND **Disclaims:** “GROWTH FUND"	Registered **First Used:** 31-DEC-1994 (IC 36) **In Commerce:** 31-DEC-1994	**Reg** 27-JUL-2010 **Reg** 3825114	**INT. CL. 36** Investment management; mutual fund investment
BARON SMALL CAP FUND	Registered **First Used:** 30-SEP-1997 (IC 36)	**Reg** 27-JUL-2010 **Reg** 3825115	**INT. CL. 36** Investment management; mutual fund investment

Mark	Status	Reg. Date/Reg. No.	Goods/Services
Disclaims: "SMALL CAP FUND"	**In Commerce:** 30-SEP-1997		
BARON PARTNERS FUND **Disclaims:** "PARTNERS FUND"	Registered **First Used:** 31-JAN-1992 (IC 36) **In Commerce:** 31-JAN-1992	**Reg** 30-NOV-2010 **Reg** 3882416	**INT. CL. 36** Investment management; mutual fund investment
BARON FIFTH AVENUE GROWTH FUND **Disclaims:** "GROWTH FUND"	Registered Partial Section 2(F) **First Used:** 30-APR-2004 (IC 36) **In Commerce:** 30-APR-2004	**Reg** 30-NOV-2010 **Reg** 3882417	**INT. CL. 36** Investment management; mutual fund investment
BARON INTERNATIONAL GROWTH FUND **Disclaims:** "INTERNATIONAL GROWTH FUND"	Registered **First Used:** 31-DEC-2008 (IC 36) **In Commerce:** 31-DEC-2008	**Reg** 27-JUL-2010 **Reg** 3825117	**INT. CL. 36** Investment management; mutual fund investment
BARON REAL ESTATE FUND **Disclaims:** "REAL ESTATE FUND"	Registered **First Used:** 31-DEC-2009 (IC 36) **In Commerce:** 31-DEC-2009	**Reg** 27-JUL-2010 **Reg** 3825118	**INT. CL. 36** Investment management; mutual fund investment
BARON CAPITAL MANAGEMENT **Disclaims:** "CAPITAL MANAGEMENT"	Registered **First Used:** 31-DEC-1982 (IC 36) **In Commerce:** 31-DEC-1982	**Reg** 27-JUL-2010 **Reg** 3824937	**INT. CL. 36** Investment management services, mutual funds investment, mutual funds distribution and mutual funds brokerage
BARON CAPITAL **Disclaims:** "CAPITAL"	Registered **First Used:** 31-DEC-1982 (IC 36) **In Commerce:** 31-DEC-1982	**Reg** 27-JUL-2010 **Reg** 3824939	**INT. CL. 36** Investment management services, mutual funds investment, mutual funds distribution and mutual funds brokerage
BARON ENERGY AND RESOURCES FUND **Disclaims:** "ENERGY AND RESOURCES	Registered **First Used:** 30-DEC-2011 (IC 36) **In Commerce:** 30-DEC-2011	**Reg** 23-APR-2013 **Reg** 4322820	**INT. CL. 36** Investment management; mutual fund investment

Mark	Status	Reg. Date/Reg. No.	Goods/Services
FUND"			

As is clarified with the claim of prior ownership submitted herewith, Applicant owns existing registrations for the marks BARON FUNDS and BARON (Reg. Nos. 2,662,525 and 2,961,602), registered December 17, 2002 and June 14, 2005, long before the October 28, 2013 filing date of the Cited Mark. A review of the USPTO file history for the Cited Mark indicates that it was approved for publication by its Examining Attorney without citing any prior conflicting marks, despite the fact that *all* of the above registrations were active and in full effect at that time. Thus, the Examining Attorney who handled the application for the Cited Mark ran the requisite search of prior marks, which presumably revealed Applicant's *fifteen* prior registrations, including Reg. Nos. 2,662,525 and 2,961,602 for the marks BARON FUNDS and BARON, and concluded that there was no likelihood of confusion between the Cited Mark and said registrations. Therefore, inasmuch as the USPTO has concluded that there was no likelihood of confusion between the Applicant's prior registrations and the Cited Mark, logic and consistency dictates that there must also be no likelihood of confusion between the Cited Mark and Applicant's present application for the BARON FUNDS (& Design) mark for proposed use with similar financial services. Given the USPTO's prior position in this regard, it is fundamentally unfair and inconsistent to allow the Cited Mark to now stand as a bar to registration of Applicant's present application.

i. *There is No Likelihood of Confusion with Reg. No. 4,567,087*

It is well settled that a likelihood of confusion may be said to exist only where (1) an applicant's mark is similar to the cited prior mark in terms of sound, appearance, and/or overall commercial impression, and (2) the applicant's goods or services are so related or the activities

surrounding their marketing are such that confusion as to their origin is likely. *See In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973). When viewed in their entireties and in context, and evaluated in accordance with the *DuPont* factors and the analogous guidelines set forth in the Trademark Manual of Examining Procedure ("TMEP") § 1207.01, it is evident that there would be no likelihood of confusion between Applicant's mark and the Cited Marks.

ii. *The Marks in their Entireties Are Different*

It is axiomatic that a determination of likelihood of confusion must also be based on a consideration of the marks in their entireties. *See, e.g.*, *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1108 (6th Cir. 1991) (marks must be viewed in their entirety and in context). *In re National Data Corp.*, 753 F.2d 1056, 1058, 1060 (Fed. Cir. 1985); *Aries Sys. Corp. v. World Book, Inc.*, 26 USPQ2d 1926, 1932 (TTAB 1993); *Innovation Data Processing, Inc. v. Innovative Software, Inc.*, 4 USPQ2d 1972, 1974 (TTAB 1987); *Interwoven Stocking Co. v. Crest Hosiery Mill*, 134 USPQ 43, 44-45 (TTAB 1962). As the *National Data* Court held:

> The basic principle in determining confusion between marks is that marks must be compared in their entireties. On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.

National Data, *supra*, 753 F.2d at 1058 (citations omitted; emphasis supplied).

Thus, "[i]t is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue." *China Healthways Institute, Inc. v. Wang*, 491 F.3d 1337, 1338, 83 USPQ2d 1123 (Fed. Cir. 2007). It is also not proper to find that one portion of a composite mark has no trademark significance, leading to a direct comparison between only that which remains. *See, e.g.*, *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 USPQ 529

(C.C.P.A. 1970) (PEAK PERIOD not confusingly similar to PEAK); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 USPQ. 392 (C.C.P.A. 1972) (ALL CLEAR not confusingly similar to ALL); *In re Ferrero*, 479 F.2d 1395, 178 USPQ. 167 (C.C.P.A. 1973) (TIC TAC not confusingly similar to TIC TAC TOE); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 USPQ. 422 (C.C.P.A. 1975) (COUNTRY VOGUES not confusingly similar to VOGUE). Applicant respectfully submits that the refusal of the Applicant's mark is premised on an improper dissection of its mark.

In taking the position that Applicant's BARON FUNDS (& Design) mark is confusingly similar to the Cited Mark, the Examining Attorney has improperly dissected Applicant's mark, focusing only on the shared use of BARON and BARRON'S, and ignoring the presence of the design element of Applicant's mark as well as the term FUNDS. While FUNDS is being disclaimed in this application, when a disclaimer is required, the most common format is as follows:

> No claim is made to the exclusive right to use the word [DISCLAIMED TERM] apart from the mark as shown.

Emphasis added. Disclaimed terms are thus still protectable and important elements of a mark, when the mark is viewed in its entirety. The Examining Attorney has improperly dissected Applicant's Mark, in violation of the principle that marks must be considered in their entireties. The relevant inquiry is not to determine the similarities of the marks based on one similar feature, the marks must be compared in their entireties and likelihood of confusion must be determined based on the comparison of the marks as a whole – in this case, BARON FUNDS (& Design) v. BARRON'S. The presence of the additional term FUNDS and design element in Applicant's mark provide it with a completely different visual, aural and commercial impression than the Cited Mark. Notably, the presence of FUNDS in Applicant's mark suggests to

consumers that the services refer to some form of investment service – a connotation that is completely absent from the Cited Mark. Accordingly, when Applicant's Mark is viewed as a whole, any confusion between Applicant's Mark and the Cited Mark is unlikely.

iii. <u>The Respective Services are Different</u>

The mere similarity of two marks does not necessarily give rise to a likelihood of confusion by itself; rather, confusion is likely where similar marks are used in connection with similar or related goods or services. If the goods and services in question are so unrelated that reasonable consumers would not mistakenly believe that they emanate from the same source, then there is no likelihood of confusion. Indeed, it is well established that even identical marks do not give rise to a likelihood of confusion where the goods and services are unrelated. *See, e.g., Local Trademarks, Inc. v. Handy Boys Inc.,* 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products [*e.g.*, lamps, tubes] related to the photocopying field); *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSSOVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes).

Further, the mere fact that both parties' businesses fall into the very broad category of financial services cannot lead to a *per se* determination of likelihood of confusion. *See* Trademark Manual of Examining Procedure ("TMEP"), § 1207.01(a)(iv), *citing Information Resources, Inc. v. X*Press Information Services, Inc*., 6 USPQ2d 1034, 1038 (TTAB 1988); *Hi-*

Country Foods Corp. v. Hi Country Beef Jerky, 4 USPQ2d 1169, 1171–72 (TTAB 1987); *In re Quadram Corp.,* 228 USPQ 863, 865 (TTAB 1985); *In re British Bulldog, Ltd.,* 224 USPQ 854, 855-56 (TTAB 1984); *M2 Software, Inc. v. M2 Commc'ns, Inc.,* 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947–48 (Fed. Cir. 2006). Rather, where the parties' products or services are somewhat related but not competitive, a finding of likelihood of confusion must depend on other factors. *See Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1108, 18 USPQ2d 1587, 1593 (6th Cir. 1991). Thus, in *Information Resources*, the Board concluded that the mark X*PRESS for a news service delivered over a computer network was not confusingly similar to EXPRESS for information analysis computer programs, after considering the differences in spelling between the marks, the differences between the goods and services, the widespread third-party use and registration of the word in the same field, and the expensive and sophisticated nature of the products. 6 USPQ2d at 1038-39. Nor should it matter that both parties' services fall in the same international class (36), as "[t]he classification of goods and services has no bearing on the question of likelihood of confusion. Rather, it is the manner in which the applicant and/or registrant have identified their goods or services that is controlling. *Jean Patou Inc. v. Theon Inc*., 9 F.3d 971, 29 USPQ2d 1771 (Fed. Cir. 1993); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990)." TMEP § 1207.01(d)(v). In the present case, all of these factors weigh against a finding of confusing similarity. Nor should it matter that both parties' services fall in the same international class (36). *See* TMEP § 1207.01(d)(v) (The classification of goods and services has no bearing on the question of likelihood of confusion. *See Jean Patou, Inc. v. Theon Inc*., 9 F.3d 971, 975, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993). Rather, it is the manner in which the applicant and/or

registrant have identified their goods or services that is controlling. *See Nat'l Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 & n.5 (TTAB 1990).

Applicant respectfully submits that its "investment management services" description is more than sufficient to distinguish its mark from the provision of financial information services description claimed under the Cited Mark and render confusion between the two unlikely. Applicant is an asset management firm focused on delivering growth equity investment solutions. The services description in the Cited Mark makes no mention of the investment management services. This makes sense given that the owner of the Cited Mark does not use the Cited Mark in connection with these services. Rather, the Cited Mark is used in connection with a weekly newspaper in the fields of financial information and market developments. *See* **Exhibit B**, https://www.barrons.com/. Ultimately, a potential purchaser of such a subscription would not be able to do so from Applicant. Conversely, a consumer seeking investment management advice would not be able to do so through the Registrant. Accordingly, there is no likelihood of confusion between the marks.

iv. The Channels of Trade and Target Customers are Different

Following from the previous point, the marks are used in different channels of trade. The Cited Mark is used with a financial publication and targeted to individuals looking for a publication featuring general financial news. Applicant is an investment management firm and its goods and services are targeted directly to a very narrow market: professional and institutional investors. As such, Applicant's customers are unlikely ever to encounter the Cited Mark in their search for investment management services, and Registrant's customers or potential customers are not going to encounter Applicant in their search for financial news publication. Confusion between the two is therefore unlikely.

v. ***The Relevant Consumers are Sophisticated and Discerning and Not Likely to be Confused***

A further *DuPont* factor which weighs in favor of the Applicant here is the "conditions under which, and buyers to whom, sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing." *DuPont* , 476 F.2d at 1361. It has been recognized that the consumers at issue are particularly careful regarding their investment activities. *See Lincoln Financial Advisors Corp. v. Sagepoint Financial Inc.*, 91 U.S.P.Q.2d 1110 (N.D. Ind. 2009) ("Because the consumers in question are wealthier individuals and businesses seeking to invest their savings, they will exercise more care in picking an investment service."). Under such circumstances, confusion between Applicant's mark and the Cited Mark is significantly less likely.

Here, Applicant's goods and services are marketed to sophisticated and/or careful purchasers who are less likely to be confused. The goods and services offered under Applicant's mark involve the services involve the entrusting of money and consequently the Applicant's investors will also exercise great care in their decision-making. Moreover, the Applicant's services are targeted and sold to a class of highly sophisticated, well-educated professional investors. These individuals are and will be highly familiar with the universe of company names and brand names in the investment management field. *Homeowners*, 931 F.2d at 1111, 18 USPQ2d at 1596 ("When the relevant buyer class is composed of such professional purchasers, the likelihood of confusion is lower"); *see also, e.g., Astra Pharmaceutical Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206, 220 USPQ 786, 790-91 (1st Cir. 1983). It is therefore highly unlikely that entities or individuals seeking either financial information services or investment management services will blithely purchase such services, or carelessly confuse or conflate the two. Accordingly, confusion between Applicant's Mark and the Cited Mark is unlikely.

vi. There Has Been No Actual Confusion Despite Lengthy Coexistence of the BARON FUNDS Marks with the Cited Mark

An additional *Du Pont* factors that favor the Applicant in this case are that there is no evidence of actual confusion despite the lengthy coexistence of Applicant's BARON and BARON FUNDS marks with the Cited Mark, which is supported by the fact that neither user has objected to the other's longtime use of the respective marks.

According to *Du Pont,* the examiner must consider the 'nature and extent of any actual confusion" (factor seven), and the "length of time during and conditions under which there has been concurrent use without evidence of actual confusion" (factor eight). *DuPont*, 177 USPQ at 567. While the subject application is based on intent-to-use due to the presence of the design element, Applicant's preexisting registrations for a family of BARON marks establish that Applicant has been using the term BARON for a several years, specifically, since 1982. The Class 36 services in the Cited Mark contain a date of first use in commerce of July 15, 1997. Accordingly, Applicant appears to be the senior user. Moreover, to date, Applicant has never received any complaint or other communication from the owner of the Cited Mark objecting to its use of BARON. The absence of any complaint on the part of the owner of the Cited Mark is indicative that the marks in question are not confusingly similar. At bottom, through its use of BARON names and marks, including BARON FUNDS for over thirty years, consumers in the marketplace have come to recognize the BARON and BARON FUNDS marks and exclusively associate them with Applicant and its high quality investment management services. Due to the exclusive use by Applicant in the investment management field, the current record simply does not support the conclusion that consumers are likely to be confuse Applicant's BARON FUNDS mark with the Cited Mark.

CONCLUSION

Applicant believes that the foregoing amendments and remarks satisfactorily address all open issues raised by the Office Action and therefore respectfully requests that the application be approved for publication.