

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE APPLICATION OF : **Goal Global Recoveries Inc.**
FOR THE MARK : **GOAL & Design**
SERIAL NO. : **88/324,824**
FILED : **March 4, 2019**
EXAMINING ATTORNEY : **April E. Reeves**

RESPONSE TO OFFICE ACTION

INTRODUCTION

In her office action, dated May 22, 2019, the Examining Attorney refused registration of Goal Global Recoveries Inc.'s ("Applicant") applied-for mark GOAL & Design, Serial No. 88/324,824 ("Applicant's Mark") on the basis of Section 2(d) of the Trademark Act, finding that Applicant's Mark is confusingly similar to U.S. Registration No. 5,592,397 for GOALZ; No. 4,388,916 for GOAL INVESTOR (Stylized); No. 4,388,917 for GOAL INVESTOR; and No. 3,818,133 for GOALMANAGER (collectively, the "Cited Registrations").

The Examining Attorney also determined the following: (a) the submitted specimens do not show use of Applicant's Mark with the services; (b) Applicant must amend the Class 36 services; and (c) Applicant must provide additional information regarding Applicant's services. Applicant is submitting herewith substitute specimens, and as provided herein, Applicant is amending its services and providing additional information regarding its services.

For the reasons set forth below, Applicant asserts that Applicant's Mark is not confusingly similar to the Cited Registrations. Thus, Applicant respectfully requests that Applicant's Mark be approved for publication on the *Official Gazette for Trademarks*.

ARGUMENT

As a preliminary matter, Applicant submits the following:

- 1) Cited Registration No. 5,592,397 for GOALZ was CANCELLED in its entirety on August 8, 2019. Thus, Applicant's Mark should no longer be refused due to this prior registration.
- 2) Cited Registration No. 4,388,917 for GOAL INVESTOR was CANCELLED on September 14, 2019 with respect to all of the Class 9 goods. Thus, Applicant's Mark should no longer be refused due to those Class 9 goods.

- 3) Cited Registration No. 4,388,916 for GOAL INVESTOR (Stylized) was CANCELLED on September 14, 2019 with respect to all of the Class 9 goods. Thus, Applicant's Mark should no longer be refused due to those Class 9 goods.

Accordingly, Applicant's arguments below focus on the remaining Cited Registrations (and services within the Cited Registrations) that have not been cancelled.

In analyzing whether a likelihood of confusion exists between two marks, some courts and the United States Patent and Trademark Office consider the thirteen factors in *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). Of importance in this case are:

1. the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
2. the conditions under which and buyers to whom sales are made, *i.e.*, "impulse" vs. careful, sophisticated purchasing;
3. the similarity or dissimilarity of the marks in their entirety as to appearance, sound and commercial impression; and
4. the number and nature of similar marks in use on similar goods or services.

The guiding principle in all likelihood of confusion analysis is that marks "must be considered in their entirety." *In re Azteca Rest. Enters., Inc.*, 50 U.S.P.Q.2d 1209, 1211 (T.T.A.B. 1999). "The test of actual confusion is not whether anyone could possibly be confused, but whether the 'reasonably prudent consumer' is likely to be confused." *The Network Network v. CBS, Inc.*, 54 U.S.P.Q.2d 1150 (C.D.Cal. 2000) (citing *Brookfield Communications v. West Coast Entin't Corp.*, 174 F.3d 1036, 1060 (9th Cir.1999)). Based on these standards and for the reasons presented below, Applicant respectfully requests that the Examining Attorney approve Applicant's Mark for publication on the *Official Gazette for Trademarks*.

A. Applicant's services and Registrants' services are unrelated and dissimilar, especially when considering the amendments to the identification of services that Applicant is making contemporaneously herewith.

The corollary to the "related goods" doctrine is that trademark rights extend only so far as necessary to avoid consumer confusion. *Libman Co. v. Vining Indus., Inc.*, 69 F.3d 1360, 1361 (7th Cir. 1995); *WCVB-TV v. Boston Athletic Ass'n*, 926 F.2d 42, 45 (1st Cir. 1991) ("The trademark statute does not give appellants any 'property right' in their mark *except* 'the right to prevent confusion'" (emphasis in original). Because trademark rights do not exist "in gross," a mark is not a monopoly as applied to all goods and services. The issues of relatedness of goods or services and likelihood of consumer confusion, therefore, cannot be abstractly resolved merely because it may be possible to generalize different goods and/or services as all belonging to some overarching

broad category. See *Jacobs v. Int’l Multifood Corp.*, 668 F.2d 1234, 1236 (CCPA 1982); *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 927 (CCPA 1978); *Azteca Restaurant*, 50 U.S.P.Q.2d at 1210; *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 U.S.P.Q.2d 1477, 1478 (TTAB 1987); *In re Central Soya Co., Inc.*, 220 U.S.P.Q. 914, 916 (TTAB 1984); see also *Amstar Corp. v. Domino’s Pizza, Inc.*, 615 F.2d 252, 261 (5th Cir. 1980) (finding sugar and pizza not related; “about the only things they have in common is that they are edible”); *American Optical Corp. v. American Olean Tile Co.*, 185 U.S.P.Q. 405 (S.D.N.Y. 1974) (AO for floor coating not likely to cause confusion with AO for ceramic tile).

In this case, the active services in the active Cited Registrations are as follows:

Mark	Services	Owner
GOAL INVESTOR (Reg. No. 4388917)	Cl 36: Providing an interactive website featuring online financial advice and investment management services	SEI Investments Developments, Inc.
GOAL INVESTOR (in stylized form) (Reg. No. 4388916)	Cl 36: Providing an interactive website featuring online financial advice and investment management services	SEI Investments Developments, Inc.
GOALMANAGER (Reg. No. 3818133)	Cl 36: Financial planning and investment advisory services; Financial portfolio analysis services; Financial portfolio management	Bank of America Corporation

Without making any concession as to the relatedness of Applicant’s and Registrants’ services, Applicant is amending and clarifying its services contemporaneously herewith as follows:

Class 36 - Providing outsourced ~~financial information and advisory services, namely,~~ international tax reclamation ~~financial services~~ for others, the foregoing excluding financial advice, financial management advice, investment advice, investment management advice, investment management, financial planning, financial portfolio analysis and financial portfolio management

Class 42 - Providing online non-downloadable software ~~Software as a service (SAAS) featuring software~~ for ~~financial management and~~ document management, namely, software for the management of documents related to the creation, processing, submission, tracking, and reporting of and collection of refunds from tax reclamation claims, and for the management of documents related to the notification, tracking, and reporting of securities class action recovery claims

Class 45 - Legal ~~document preparation and support~~ services, namely, representation of clients in securities class action lawsuits in the nature of notifying, processing,

submitting, tracking, and reporting of and collecting monetary compensation from securities class action recovery claims¹

Regarding Applicant's Class 36 services, Applicant is amending its services to clarify that the services that Applicant seeks to protect are the provision of outsourced international tax reclamation financial services. In the original identification, the services "international tax reclamation for others" is after the word "namely"; the word "namely" further defines an introductory wording and serves to identify a good or service with greater particularity. See TMEP § 1402.03(a). Thus, Applicant is clarifying herewith the narrowed services (international tax reclamation services) that were listed in Applicant's original identification. Applicant is further amending its Class 36 services to exclude the specific financial services listed in the Cited Registrations, as Applicant does not provide those services.

Regarding Applicant's Class 42 services, Applicant is amending its services to clarify that its provision of software is in an online and non-downloadable format, and that the software is for use in the management of documents related to various aspects and elements of international tax reclamation and securities class action recovery claims. The software is not for use in providing financial advice, financial management advice, investment advice, investment management advice, investment management, financial planning, financial portfolio analysis or financial portfolio management.

Overall, international tax reclamation is a niche service, which involves submitting and processing claims to international tax authorities to reclaim over-withheld taxes on cross-border securities income. See Exhibit A, Pages from Applicant's website regarding its tax reclamation services and online article from *The International Investor*. Also, securities class action recovery is a niche service, which involves submitting and processing claims to recover settlement monies in securities class action lawsuits. See Exhibit B, Pages from Applicant's website regarding its securities class action recovery services.

As such, consumers are not likely to be confused into believing that Applicant's niche services emanate from the same source as Registrants' services in the fields of financial advice, investment management, financial planning, investment advice, financial portfolio analysis and financial portfolio management. Registrants should not be able to obtain a monopoly over marks as applied to all services in the broad field of finance.

In *Sullivan v. CBS Corp.*, 385 F.3d 772, 778 (7th Cir. 2004), the court ultimately held that the defendant's SURVIVOR mark, used in connection with its reality-based television show and merchandise related thereto, was not confusingly similar to the plaintiff's SURVIVOR mark, used in connection with its band and musical services. Both the plaintiff's and the defendant's goods and services were related to the entertainment industry. However, the court reasoned, in part, that even though the plaintiff's SURVIVOR mark was arbitrary as used in connection with its services and thus was entitled to strong protection as against other

¹ Although the Section 2(d) refusal does not apply to Class 45, Applicant is amending herewith the Class 45 services so as to clarify the services.

band names, it was used only in a narrow area. *Id.* at 776. Thus, the plaintiff could not enjoin the defendant from using a similar mark in connection with different goods or services. *Id.*

Applying the reasoning in *Sullivan*, it would contravene fundamental trademark principles to allow Registrants to obtain monopoly rights over marks as applied to all services included in the broad realm of finance, especially in Applicant's case, whose services have been amended contemporaneously herewith to clarify the tax reclamation and securities class action recovery services that Applicant provides and to exclude the services specified in the Cited Registrations. The services with which Applicant's and Registrants' marks are connected are sufficiently unrelated. Accordingly, Applicant's Mark should be approved for publication.

B. Consumers exercise a high degree of care when purchasing Applicant's services, and presumably Registrants' services.

Confusion between Applicant's Mark and the Cited Registrations also is unlikely because consumers exercise a high degree of care when purchasing the services connected with Applicant's Mark, and presumably with the Cited Registrations. "A consumer exercising a high degree of care in selecting a product reduces the likelihood of confusion." *Sally Beauty Co. v. Beautyco, Inc.*, 304 F.3d 964, 975 (10th Cir. 2002). Buyers usually exercise little care in selecting inexpensive items and in making impulse purchases. *Id.* Conversely, expensive items are typically chosen more carefully. *Id.* "The relevant inquiry focuses on the consumer's degree of care exercised at the time of purchase." *Id.*

Here, Applicant provides international tax reclamation services, securities class action recovery services, and non-downloadable software services related thereto. Applicant's customers include internationally prominent financial institutions and investment firms, among other customers. See Exhibit C, Page from Applicant's website describing its client base. Such customers' decisions to use Applicant's services are not impulsive or inexpensive decisions. Applicant's services provide long-term solutions to reclaiming over-withheld taxes and to submitting securities class action recovery claims in an efficient, less burdensome, cost-effective manner. Such services are therefore chosen by Applicant's customers after careful consideration and research. Given the nature of Registrants' financial services, it is very likely that Registrants' consumers also exercise a high degree of care in selecting Registrants' services, lessening the likelihood of confusion.

Further, Applicant's customers are "professional buyers" with regard to Applicant's services and are much more sophisticated than an average consumer. "Professional buyers" can be expected to be more discriminating and knowledgeable and are less likely to be confused by arguably similar trademarks. See *Republic Steel Corp. v. M.P.H. Mfg. Corp.*, 312 F.2d 940, 943 (C.C.P.A. 1963) (architects are professional purchasers not likely to confuse TRUSS-SKIN and TRUSCON for steel building products).

In *Clayton Mark & Co. v. Westinghouse Elec. Corp.*, 356 F.2d 943, 944 (C.C.P.A. 1966), the court held that the applicant's mark, MARK 75, for circuit breakers was not confusingly similar to MARK for an electrical conduit, *i.e.*, a steel pipe used in electrical wiring to protect the conducting wires. It reasoned, in part, that highly trained electrical engineers, not mere electricians, were required to select the proper circuit breaker for the particular installation. *Id.* That, and the fact that the MARK 75 breakers were more expensive than ordinary breakers, supported the reasoning that the MARK 75 breakers would be purchased on a very discriminating basis, by persons who not only knew what they were buying and why, but also who knew who produced it. *Id.* Thus, confusion was not likely because it was highly improbable that a buyer of a MARK 75 breaker would not know it was the applicant's product.

Similarly, consumers of Applicant's services (*e.g.*, financial institutions and investment firms) are highly sophisticated and highly trained in their fields. Such consumers know what they are "buying," why they are buying it, and who provides it. It is therefore highly unlikely that Applicant's Mark would be confused with the Cited Registrations.

C. Applicant's Mark and the Cited Registrations are not similar in appearance, sound or commercial impression when viewed in their entireties.

The determination of whether two marks are confusingly similar is not based on a side-by-side comparison but on whether "the appearance of the marks is similar enough that it may confuse customers who do not have both marks before them but who may have a general, vague, or even hazy, impression or recollection of the other party's mark." *Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 423 (6th Cir. 1999) (quoting *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1188 (6th Cir. 1988) (internal quotation marks omitted)). Many courts have looked at the dissimilarity in the appearance and sound of two marks when finding no likelihood of confusion. In *First Sav. Bank v. First Bank Sys., Inc.*, 101 F.3d 645, 653 (10th Cir. 1996), the court found that FIRST BANK SYSTEM was not confusingly similar to FIRSTBANK, noting that FIRST BANK SYSTEM contained an additional word, and to that extent it was pronounced differently than FIRSTBANK. The court in *Conde Nast Publ'ns, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 1407 (C.C.P.A. 1975) held that COUNTRY VOGUES and VOGUE did not look or sound alike, and when viewed in their entireties, the dissimilarities outweighed the fact that VOGUE was part of COUNTRY VOGUES.

In this case, just as the addition of the words "System" and "Country" in the subject marks in *First Sav. Bank* and *Conde Nast* made the marks distinguishable, the addition of the word "INVESTOR" in the GOAL INVESTOR registrations (Nos. 4,388,916 and 4,388,917) and the addition of the word "MANAGER" in GOALMANAGER (Reg. No. 3,818,133) make the Cited Registrations distinguishable in appearance from Applicant's Mark. Further, those additional words in the Cited Registrations create marks with four syllables, versus Applicant's one-syllable mark. Thus, the respective marks have different pronunciations.

Additionally, while Registrants of GOAL INVESTOR (Word) (No. 4,388,917) and GOALMANAGER (Word) (Reg. No. 3,818,133) are entitled to all depictions of their standard character marks, the variations of such depictions are *only* with regard to font style, size, or color of the words, letters, or any combination thereof. *See* TMEP § 1207.01(c)(iii); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1187 (TTAB 2018) (“We hold that when we are comparing a standard character mark to a word + design mark for Section 2(d) purposes, we will consider variations of the depictions of the standard character mark *only with regard to ‘font style, size, or color’ of the ‘words, letters, numbers, or any combination thereof’*”) (emphasis added). With regard to GOAL INVESTOR (Stylized) (No. 4,388,916), such registration entitles the Registrant to protection of the specific stylization depicted in the registration. Thus, while the words GOAL INVESTOR and GOALMANAGER may be displayed in any font style, size, color or any combination thereof (including the stylization depicted in Reg. No. 4,388,916), such standard character and stylized registrations do not entitle Registrants to use a *design* element the same as or similar to the design element shown in Applicant’s Mark. Such design element is a distinctive element of Applicant’s Mark, giving Applicant’s Mark a different appearance and commercial impression than the Cited Registrations. *See In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) (holding confusion unlikely between REDNECK RACEGIRL and design of large, double-letter RR configuration and registered mark RACEGIRL, even when used on in-part identical goods); *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282 (TTAB 2009) (holding VOLTA for vodka infused with caffeine, and TERZA VOLTA and vine shoot design for wines, not likely to cause confusion).

Accordingly, when viewed in their entirety, the dissimilarities in appearance, sound and commercial impression of Applicant’s Mark and the Cited Registrations do not give rise to a likelihood of confusion. Applicant’s Mark should be allowed for publication for opposition.

D. The number and nature of similar marks in use with services similar to Registrants’ services demonstrate that Applicant’s Mark will not likely be confused with the Cited Registrations, especially given the distinguishable services provided under Applicant’s Mark.

Evidence of third-party use is relevant when analyzing the number and nature of similar marks. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361, 177 USPQ at 567. Specifically, third-party registrations may be relevant to show that a mark or a portion of a mark is so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988); *Plus Prods. v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983).

In this case, the Cited Registrations alone demonstrate that marks containing the term “GOAL” in connection with financial-related services can coexist, as the public will look to other elements to distinguish the source. Nonetheless, there are dozens of other third-party registrations for marks containing the term “GOAL” that coexist in connection with financial-related services, including but not limited to the following:

MARK	SERVICES	OWNER
GOALPATH (Reg. No. 5597467)	CI 36: Financial planning; Financial planning and investment advisory services; Financial retirement plan consulting services; Financial services, namely, wealth management services	Two West Advisors
GOALS-BASED PERFORMANCE STANDARDS (Reg. No. 5572310)	CI 36: Financial services, namely, investment management services; investment services, namely, portfolio management, sub-advisory management, separate account management, and management or sub-advisory management of commingled investment vehicles, namely, mutual funds, exchange-traded funds and collective trust funds	Horizon Investments, LLC
GOALCARD (Reg. No. 5429868)	CI 36: Financial services, namely, savings programs for youths	Students of Wealth, Inc.
GOALSETTER (Reg. No. 5429861)	CI 36: Financial services, namely, savings programs for youths	Students of Wealth, Inc.
GOALVEST ADVISORY & Design (Reg. No. 5369138)	CI 36: Financial planning, namely, comprehensive one on one financial advice and recommendations and ongoing financial management and advice services to assist individuals in being proactive and financially prepared; Investment management; Financial services, namely, wealth management services	GoalVest Advisory LLC
GOALS DRIVEN INVESTING (Reg. No. 5527245)	CI 36: Financial and investment services, namely, wealth management, investment management and brokerage in the fields of stocks, bonds, options, commodities, futures and other securities, and the investment of funds of others	Northern Trust Corporation
GOALS POWERED SOLUTIONS (Reg. No. 4987085)	CI 36: Financial and investment services, namely, wealth management, investment management and brokerage in the fields of stocks, bonds, options, commodities, futures and other securities, and the investment of funds of others	Northern Trust Corporation
RUSHGOALS (Reg. No. 4335801)	CI 36: Financial services in the nature of prepaid debit card services; Financial advice in the field of budgeting, saving and goal setting; Financial advice in the field of money management, saving and goal setting; Credit reporting services in the nature of reporting the transactions and payments of account holders to consumer credit reporting agencies; Electronic funds transfer between and within prepaid debit card accounts and sub-accounts	Green Dot Corporation
GOALGETTER & Design (Reg. No. 4330717)	CI 9: Downloadable computer software for personal financial planning	Advisor Software, Inc.
GOALGAMIPRO (Reg. No. 4121203)	CI 42: Providing temporary use of on-line non-downloadable software for financial planning	Advisor Software, Inc.
GOAL & Design (Reg. No. 5075836)	CI 36: Insurance, financial, and real estate consultation offered in connection with humanitarian relief and development programming; financial consultation offered in	Goal Charity

	connection with charitable giving from private donors; charitable fundraising, namely, organizing special fundraising events, raffles, donation subscriptions, financial sponsorship, and monetary collections; financial services to facilitate cash transfers to beneficiaries of relief and development programs; provision of funding to partner organizations to enable such organizations to implement humanitarian relief and development programs; financial sponsorship of humanitarian relief and development programming; management and monitoring of financial investment funds for investment purposes; financial development assistance; financial assistance for populations, in particular in case of war, extreme poverty, epidemic or natural disaster; information and consultancy services relating to the aforesaid services, including via an electronic website, all in the humanitarian relief and development context	
GOALMAKER (Reg. No. 2386529)	CI 36: Investment advisory services in the field of retirement planning and financial portfolio analysis and consultation, featuring asset allocation strategies in the form of diversified investment portfolios for specified investor objectives; providing financial planning and investment information to retirement plan participants by means of a global computer network	The Prudential Insurance Company of America

See Exhibit D, Copies of third-party registration certificates. The above third-party registrations demonstrate that marks containing the term “GOAL” can coexist in connection with related, and even identical services, as the public will look to other elements to distinguish the sources. Indeed, Applicant’s services, as amended, are distinct and sufficiently unrelated to the financial and investment-related services listed in the Cited Registrations and in the above registrations, making consumer confusion even less likely. Thus, Applicant’s Mark should be allowed for publication for opposition.

E. Responses to Request for Information

In response to the Examining Attorney’s request for information, Applicant submits the following:

1. Applicant must submit additional information about Applicant’s services.

RESPONSE: As provided in its amended identification of services, Applicant provides outsourced international tax reclamation financial services, which involves submitting and processing claims to international tax authorities to reclaim over-withheld taxes on cross-border securities income. Applicant also provides online non-downloadable software for customers to manage documents related to the creation, processing, submission, tracking, and reporting of and collection of refunds from tax reclamation claims. See Exhibit A.

Further, Applicant assists customers by notifying, processing, submitting, tracking, reporting and collecting monetary compensation from securities class action recovery claims. Applicant also provides online non-downloadable software for customers to manage documents related to the notification, tracking, and reporting of securities class action recovery claims. See Exhibit B.

Please also refer to the following for additional information:

- a) Applicant's website: <http://www.goalgroup.com/>;
- b) the substitute specimens submitted herewith; and
- c) one of Applicant's brochures regarding Applicant's tax reclamation services, attached hereto as Exhibit E.

2. Please describe the activities involved in "international tax reclamation."

RESPONSE: Please refer to Applicant's Response #1 above.

3. Are Applicant's Class 45 legal services provided by attorneys?

RESPONSE: Applicant's Class 45 services are not provided by attorneys. Applicant is clarifying its Class 45 services herein.

4. How do consumers access Applicant's software as a service services? Please provide the URL where consumers access these services, if applicable.

RESPONSE: Applicant is clarifying its Class 42 services herein to state that Applicant provides "online non-downloadable software." Consumers can access Applicant's online non-downloadable software through the following URL: https://portal.goalgroup.com/rdLogon_Custom_Wait.aspx

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that Applicant's Mark be approved for publication on the *Official Gazette for Trademarks*.

Respectfully submitted,

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