

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

December 3, 2019

Ms. Inga Ervin, Esq.
Trademark Examining Attorney
Law Office 111
United States Patent and Trademark Office

RE: Serial Number: 88438656
 Mark: WAM
 Applicant: First Capitol Consulting Inc.
 Office Action: August 6, 2019

APPLICANT'S RESPONSE TO OFFICE ACTION

The following is the response of Applicant, First Capitol Consulting Inc., to the Office Action sent via email on August 6, 2019, by Examining Attorney Inga Ervin, Esq.:

I. SUMMARY:

In the Office Action dated August 6, 2019 ("OA"), the USPTO refused First Capitol Consulting Inc.'s Application No. 88438656 ("Application") on the grounds that there is a likelihood of confusion between the Applicant's applied for mark and the mark in U.S. Registration No. 4903432 ("Prior Registration").

As discussed below, in refusing to register the Applicant's applied for mark on the basis of a likelihood of confusion between them, the Examiner expressly relied upon a seeming overlap in the description of goods and services as "business management" within international classification IC 035 between Application's applied for mark and the Prior Registration's mark.

However, a close review of the Prior Registration's description of goods and services does not cover "business management" in toto. Rather, the Prior Registration narrows coverage of "business management" to that "in the field of" of various retail merchandise, e.g., watches, jewelry, bags, wallets, clothing, umbrellas, footwear, headgear, and the like. In sharp contrast, the Application's description of goods and services covers "business management" narrowed to the "the field of tax, human resources, business intelligence and data analytics." *See* Application. Tellingly, the owner of the Prior Registration engages in a retail merchandise business online while the Applicant engages in a software and consulting services business.

In summary, the Applicant respectfully submits that a comparison of the goods and/or services identified in the Application and that identified in the Prior Registration do *not* overlap. As such, there is no likelihood of confusion, and the Application should be registered. First Capitol Consulting Inc. requests the USPTO withdraw its refusal of the above referenced trademark application.

II. BACKGROUND:

The Prior Registration, filed on August 14, 2014, was submitted by Wam Denim Wholesale B.V. LLC (“WAM Denim”). WAM Denim appears to be a clothing and other retail merchandise company operating almost exclusively in Europe. *See Exhibit A* (Screenshots and printouts from Wam Denim’s website found at <https://www.wamdenim.com/en/>).

WAM Denim’s registered mark is “WAM.” In the Prior Registration, WAM Denim registered the mark under three separate international classifications: IC 018, IC025, and IC 035. In connection with IC 35,¹ the Prior Registration described the goods and services as follows (emphases added):

“Advertising services; ***business management***; business administration; providing office functions; retail store services and online retail store services and import and export agency services, **all in the fields of watches, stop watches, watchstraps, jewelry, precious metals and their alloys, cufflinks, tie pins, rings, bracelets, earrings, necklaces, ornamental pins, key rings, watch boxes of precious metals and jewelry boxes, straps for bags, bags, handbags, wallets and purses, all of leather or imitation leather, animal skins, trunks and traveling bags, umbrellas, parasols and walking sticks, garment bags for travel, briefcases, toiletry bags sold empty, clothing, footwear, headgear and belts**; the bringing together, for the benefit of others, of a variety of goods excluding the transport thereof, enabling customers to conveniently view and purchase those goods in the field of watches, stop watches, watchstraps, jewelry, precious metals and their alloys, cufflinks, tie pins, rings, bracelets, earrings, necklaces, ornamental pins, key rings, watch boxes of precious metals, jewelry boxes, leather or imitation leather straps for bags, bags, handbags, wallets and purses, animal skins, trunks and traveling bags, umbrellas, parasols, walking sticks, garment bags for travel, briefcases, toiletry bags sold empty, clothing, footwear, headgear and belts; the bringing together of consumers and manufacturers of clothing, footwear, headgear and bags made of leather and imitations of leather for

¹ In connection with IC 018, the Prior Registration described its goods and services as “Straps for leather bags; bags, handbags, wallets and purses, all of leather or imitation leather; animal skins; trunks and traveling bags; umbrellas, parasols and walking sticks; garment bags for travel; briefcases; toiletry bags sold empty.” In connection with IC 025, the Prior Registration described its goods and services as “Clothing, namely, shirts, shorts, suits, blouses, skirts, jackets, hats, pants, sweat suits, tops, footwear, headwear; belts.”

commercial purposes via the Internet; systematization of data into computer databases for business purposes; organization of trade fairs for commercial or advertising purposes; franchising services, namely, offering ***business management assistance in the establishment and/or operation of retail stores in the field of watches, stop watches, watchstraps, jewelry, precious metals and their alloys, cufflinks, tie pins, rings, bracelets, earrings, necklaces, ornamental pins, key rings, watch boxes of precious metals and jewelry boxes, and in the field of straps for bags, bags, handbags, wallets and purses, all of leather or imitation leather, animal skins, trunks and traveling bags, umbrellas, parasols and walking sticks, garment bags for travel, briefcases, toiletry bags sold empty, clothing, footwear, headgear and belts***; information and consultancy relating to the aforesaid services; all the aforesaid services provided via computer and communication networks.” *See* OA, at 2.

In sharp contrast to WAM Denim, the Applicant is a software solutions company with an office in the United States that specializes in providing software and consulting services for purposes of workforce management, data analytics and business intelligence. *See Exhibit B* (Printout and Screenshot from Applicant’s website found at www.trusaic.com). The Application seeks registration under IC 035 to cover “Business consulting, management, and planning services in the field of tax, human resources, business intelligence and data analytics.” *See* Application.

III. ANALYSIS:

Likelihood of confusion is the standard to apply to applications where there is a potential that the mark is so similar “to a registered mark that it is likely that consumers would be confused, mistaken or deceived as to the commercial source of the goods and/or services of the parties.” *See Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973); USPTO Response August 6, 2019 at 2, *citing* 15 U.S.C. §1052(d). “Likelihood of confusion is a question of law with underlying factual findings made pursuant to the DuPont Factors.” *Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372 (Fed. Cir. 2018) (*quoting Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 1321(Fed. Cir. 2014)), *cert. denied*, 139 S. Ct. 1550, 203 L. Ed. 2d 713 (2019). The factors followed by the USPTO in this factual inquiry are laid out by the United States Court of Customs and Patent Appeals in *DuPont. In re Detroit Athletic Co.*, 903 F.3d 1297, 1302 (Fed. Cir. 2018).

The Examiner need only consider those factors that are relevant and of record. *See* OA, at 2, *citing* *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1382 (Fed. Cir. 2006). But, when a factor is relevant and of record, it must be considered. *Shen Mfg. Co. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1241 (Fed. Cir. 2004). To this end, the Examiner discussed only the following two

factors as relevant to the present inquiry: (1) similarities between the compared marks, and (2) the relatedness of the compared goods and/or services. *See* USPTO Response August 6, 2019 at 3.

The “relatedness in the fields” is relevant to the inquiry as to whether there is similarity in the goods and services between the two marks. *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1383 (Fed. Cir. 2006). Where there are similarities between the two marks, the weight given to this first factor in determining likelihood of confusion often depends on the analysis of the second factor, the relatedness of the goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1362–63 (Fed. Cir. 2012) (“where, as here, the goods at issue are identical, the degree of similarity necessary to support a conclusion of likely confusion declines.” (internal citation and quotation omitted).) Moreover, “to rely on the similarity of the goods and services as a basis for refusing registration, the PTO must come forth with a persuasive evidentiary showing of relatedness between the goods and services at issue.” *In re St. Helena Hosp.*, 774 F.3d 747, 753 (Fed. Cir. 2014).

In its analysis of the second factor, the relatedness of the compared goods and/or services, the Examiner relied exclusively on the use of the phrase “business management” in both the Application and the Prior Registration to determine that the goods and/or services offered were similar. *See* OA, at 3. This analysis failed to review the context of that phrase in both.

The description of goods and/or services in the Prior Registration is not a model of clarity. However, a close review of the lengthy description reveals that the phrase “business management” does not cover “business management” in general. Rather, the phrase “business management” has limitations. Specifically, the phrase “business management” is limited to the field of various retail merchandise, namely, “watches, stop watches, watchstraps, jewelry, precious metals and their alloys, cufflinks, tie pins, rings, bracelets, earrings, necklaces, ornamental pins, key rings, watch boxes of precious metals and jewelry boxes, straps for bags, bags, handbags, wallets and purses, all of leather or imitation leather, animal skins, trunks and traveling bags, umbrellas, parasols and walking sticks, garment bags for travel, briefcases, toiletry bags sold empty, clothing, footwear, headgear and belts . . .” In essence, the goods and/or services have nothing to do with “tax, human resources, business intelligence and data analytics.”

In contrast, in the description of goods and/or services, the Application specifically identifies the field of “tax, human resources, business intelligence and data analytics.” There is no encroachment whatsoever in to the field of any retail merchandise.

These stated limitations in the registrations are important to the analysis of the relatedness of the goods/services. The Federal Circuit in *M2 Software, Inc v. Mr. COMmc'ns, Inc.* concluded that the differences between the music/entertainment industry and the pharmaceutical/medical industry were significant facts in their determination that the goods and services were dissimilar.

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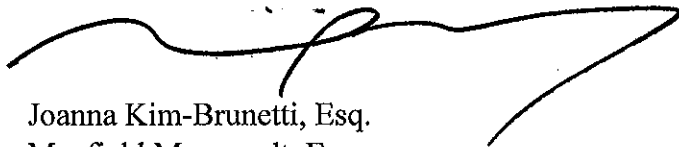
Id. at 1384. Here, the differences between the Application and the Prior Registration are night and day.

IV. CONCLUSION:

The Applicant has responded to all issues raised in the Office Action. Based on the foregoing, the Applicant respectfully requests the trademark be granted and the refusal withdrawn.

The Applicant submits this Response in anticipation of contacting the Examiner after according the Examiner an opportunity to review the Response. If any further information or response is required, please let us know. We can be reached at 213-355-5109 for further comments or clarifications.

Respectfully submitted:



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