

Applicant’s Response to Office Action

Applicant (Serial No. 88494998) responds to the September 23, 2019 Office Action refusing registration under Trademark Act Section 2(d) on the grounds that Applicant’s mark, when used in connection with the identified services so resembles the mark in U.S. Registration No. 2613627 (the “Cited” mark) as to be likely to cause confusion, to cause mistake, or to deceive. Applicant disagrees with this conclusion and in further support of its Application, respectfully submits the following response, requesting that the Examining Attorney reconsider the refusal of the Application.

I. Applicant’s Mark

Applicant seeks protection for the standard character mark containing the literal elements: FINMAIL

Concurrently with this Response to Office Action and in compliance with Examining Attorney’s recommendation, Applicant is amending the Identification of Services associated with its application as follows:

- International Class 009 for **Downloadable** computer software used to send, operate, and access email, blockchain, and digital currency services; **Non-downloadable** computer software used to send, operate, and access email, blockchain, and digital currency services; **Downloadable** software used to send, operate, and access email, blockchain, and digital currency services; **Non-downloadable** software used to send, operate, and access email, blockchain, and digital currency services; **Downloadable** computer programs used to send, operate, and access email, blockchain, and digital currency services; **Non-downloadable** computer programs used to send, operate, and access email, blockchain, and digital currency services; Computer software applications, downloadable, used to send, operate, and access email, blockchain, and digital currency services; Computer software downloaded from the internet, used to send, operate, and access email, blockchain, and digital currency services; **Downloadable** computer software for mobile phones used to send, operate, and access email, blockchain, and digital currency services; **Non-downloadable** computer software for mobile phones used to send, operate, and access email, blockchain, and digital currency services; Computer software, recorded, used to send, operate, and access email, blockchain, and digital currency services; **Downloadable** application software for smartphones, used to send, operate, and access email, blockchain, and digital currency services; **Downloadable** applications for use with mobile devices, used to send, operate, and access email, blockchain, and digital currency services; **Downloadable** software, used to send and access email; **Downloadable** software

applications, **used to send, operate, and access email, blockchain, and digital currency services**; **Downloadable** software and applications for mobile devices, **used to send, operate, and access email, blockchain, and digital currency services**; **Non-downloadable** software and applications for mobile devices, **used to send, operate, and access email, blockchain, and digital currency services**; **Downloadable** programs for computers **used to send, operate, and access email, blockchain, and digital currency services**; **Non-downloadable** programs for computers **used to send, operate, and access email, blockchain, and digital currency services**; **Downloadable** application software **used to send, operate, and access email, blockchain, and digital currency services**; **Non-downloadable** application software **used to send, operate, and access email, blockchain, and digital currency services**; **Downloadable** computer programs **used to send, operate, and access email, blockchain, and digital currency services**; **Non-downloadable** computer programs **used to send, operate, and access email, blockchain, and digital currency services**; Computer programs, **downloadable, used to send, operate, and access email, blockchain, and digital currency services**; **Downloadable** computer software programs **used to send, operate, and access email, blockchain, and digital currency services**; **Non-downloadable** computer software programs **used to send, operate, and access email, blockchain, and digital currency services**; Recorded computer programs **used to send, operate, and access email, blockchain, and digital currency services**; Computer programs, **recorded used to send, operate, and access email, blockchain, and digital currency services**; **Downloadable** computer programs **used to send, operate, and access email, blockchain, and digital currency services**; **Non-downloadable** computer programs **used to send, operate, and access email, blockchain, and digital currency services**; Recorded software programs **used as operating software, blockchain applications, cryptography applications, digital currency applications, blockchain systems, cryptography systems, and digital currency systems**; **Downloadable** computer programs for user interface design; **Non-downloadable** computer programs for user interface design; **Downloadable** computer programs for accessing and using the internet; **Non-downloadable** computer programs for accessing and using the internet; **Recorded** computer programs for accessing and using the internet; **Downloadable** cryptography software; **Non-downloadable** cryptography software; **Recorded** cryptography software; **Downloadable** database software; **Non-downloadable** database software; **Recorded** database software; **Downloadable** electronic software databases; **Non-downloadable** electronic software databases; **Recorded** electronic software databases; **Downloadable** interactive databases; **Non-downloadable** interactive databases; **Recorded** interactive databases; **Downloadable** mail server software; **Non-downloadable** mail server software; **Recorded** mail server software; **Downloadable** e-mail software; **Non-downloadable** e-mail software; **Recorded** e-mail software; **Downloadable**

software for ensuring the security of e-mail; **Non-downloadable** software for ensuring the security of e-mail; **Recorded** software for ensuring the security of e-mail; E-mail **computer, mobile, and hand-held electronic hardware** terminals; E-mail **computer, mobile, and hand-held electronic hardware** servers

- International Class 035 for Advertising, marketing and promotional services; Business analysis, research and information services; Business assistance, management and administrative services; Auctioneering services; Rental of vending machines; Administrative order processing; Administration of newspaper subscription **namely arranging newspaper subscriptions for others**; Administrative processing of mail **purchase** orders; Administrative processing of **electronic** mail orders; Administrative processing of computerized purchase orders; Administrative processing of purchase orders; Administrative processing of purchase orders placed by telephone or computer; Administrative processing of purchase orders within the framework of services provided by mail-order companies; Advisory services relating to the purchase of goods on behalf of others **in the fields of consumer product information, insurance, e-mail, blockchain, and digital currency services**; Advisory services relating to the purchase of goods on behalf of business **in the fields of consumer product information, insurance, e-mail, blockchain, and digital currency services**; Advisory services relating to the ordering of stationery **in the fields of consumer product information, insurance, e-mail, blockchain, and digital currency services**; Advisory services relating to commercial transactions **in the fields of consumer product information, insurance, e-mail, blockchain, and digital currency services**; Advisory and consultancy services relating to the procurement of goods for others **in the fields of consumer product information, insurance, e-mail, blockchain, and digital currency services**; Advice relating to barter trade **in the fields of consumer product information, insurance, e-mail, blockchain, and digital currency services**; Advertising of the services of other vendors, enabling customers to conveniently view and compare the services of those vendors; Administrative services relating to the referral of patients **in the fields of consumer product information, insurance, database management, e-mail, blockchain, and digital currency services**; Administrative services relating to the referral of clients to lawyers **in the fields of consumer product information, insurance, database management, e-mail, blockchain, and digital currency services**; Alcoholic beverage procurement services for others; Arranging and conducting of flea markets; Arranging business introductions relating to the buying and selling of products **in the fields of consumer product information, insurance, database management, e-mail, blockchain, business networking, and digital currency services**; Arranging and conducting sales events for others of livestock and registered and commercial cattle; Arranging and conducting sales events for livestock; Arranging and conducting sales

events for cattle; Arranging commercial **contract** transactions, for others, via online shops **in the fields of consumer product information, insurance, database management, e-mail, blockchain, and digital currency services**; Arranging newspaper subscriptions **for others**; Arranging of buying and selling contracts for third parties; Arranging of collective buying, **namely, arranging of commercial contracts in the fields of consumer product information, insurance, database management, e-mail, blockchain, and digital currency services**; Arranging of commercial and business contacts **in the fields of consumer product information, insurance, database management, e-mail, blockchain, business networking, and digital currency services**; Arranging of contracts for others for the buying and selling of goods; Arranging of contracts for the purchase and sale of goods and services, for others; Arranging of contracts, for others, for the providing of services; Arranging of presentations for business purposes **in the fields of consumer product information, insurance, database management, e-mail, blockchain, business networking, marketing presentations, and digital currency services**; Arranging of subscriptions for the publications of others; Arranging of trading transactions and commercial contracts; Arranging subscriptions of the online publications of others; Arranging subscriptions to Internet services; Arranging subscriptions to electronic journals; Arranging subscriptions to **publications featuring information media in the fields of consumer product information, insurance, database management, e-mail, blockchain, and digital currency services**; Arranging subscriptions to **publications featuring** information packages; Arranging subscriptions to **publications featuring** media packages; Arranging subscriptions to telecommunication services for others; Arranging subscriptions to telephone services; Arranging subscriptions to a television channel; Arranging the buying of goods for others **in the fields of consumer product information, insurance, database management, e-mail, blockchain, and digital currency services**; Automatic re-ordering service for business **in the fields of consumer product information, insurance, database management, e-mail, blockchain, and digital currency services**; Bidding quotation; Business administration services for processing sales made on the internet; Business advisory services in the field of selling products and rendering services; Business intermediary services relating to the matching of potential private investors with entrepreneurs needing funding; Chamber of commerce services, **namely, promotion of businesses in the fields of consumer product information, insurance, database management, e-mail, blockchain, and digital currency services**; Chamber of services, **namely, promotion of commerce**; Clerical services for the taking of sales orders; Commercial administration of the licensing of the goods and services of others; Commercial information and advice for consumers; Commercial information and advice for consumers in the choice of products and services; Commercial information and advice services for consumers in the field of beauty products; Commercial information and

advice services for consumers in the field of cosmetic products; Commercial information and advice services for consumers in the field of make-up products; Comparison shopping services; Computerised stock ordering **namely inventory management in the field blockchain and digital currency services**; Computerized on-line ordering services **in the field blockchain and digital currency services**; **Business** consultancy relating to costing of sales orders **in the field blockchain and digital currency services**; Consultancy services relating to the procurement of goods and services; Consulting in sales techniques and sales programmes; Coupon procurement services for others; Electronic processing **in the field blockchain and digital currency services**; Energy price comparison services; Export agency services; Export promotion services; Foreign trade information and consultation; Goods or services price quotations; Import agency services; Import and export services; Import-export agencies in the field of energy; Import-export agency services; Information about sales methods; Intermediary services relating to advertising **in the field blockchain and digital currency services**; Intermediary services relating to the rental of advertising time and space **in the field blockchain and digital currency services**; Management of industrial and commercial enterprises in terms of supplying them with office requisites **in the field blockchain and digital currency services**; Mediation and conclusion of commercial transactions for others; Mediation of agreements regarding the sale and purchase of goods; Mediation of contracts for purchase and sale of products; Mediation of trade business for third parties; Negotiation and conclusion of commercial transactions for third parties; Negotiation and conclusion of commercial transactions for third parties via telecommunication systems; Negotiation of commercial transactions for third parties; Negotiation of contracts relating to the purchase and sale of goods; Negotiation of contracts with healthcare payors; Newspaper subscriptions; On-line ordering services in the field of restaurant take-out and delivery **in the field blockchain and digital currency services**; Online ordering services **in the field blockchain and digital currency services**; Ordering services for third parties **in the field blockchain and digital currency services**; Outsourcing services in the nature of arranging procurement of goods for others; Price analysis services; Price comparison rating of accommodations; Price comparison services; Procurement of contracts **in the field blockchain and digital currency services**; Procurement of contracts concerning energy supply; Procurement of contracts for others relating to the sale of goods; Procurement of contracts for the purchase and sale of goods and services; Procurement of goods on behalf of other businesses **in the field blockchain and digital currency services**; Procurement services for others **in the field blockchain and digital currency services**; Procurement services for others relating to office requisites; Procuring of contracts for the purchase and sale of goods; Production of teleshopping programmes; Providing consumer information relating to goods and services **in the field blockchain and digital currency services**; Providing consumer product advice;

Providing consumer product advice relating to cosmetics; Providing consumer product advice relating to laptops; Providing consumer product advice relating to software; Providing consumer product information; Providing consumer product information relating to food or drink products; Providing consumer product information relating to cosmetics; Providing consumer product information relating to laptops; Providing consumer product information relating to software; Providing information via the Internet relating to the sale of automobiles; Provision of an on-line marketplace for buyers and sellers of goods and services; Provision of information concerning commercial sales; Provision of online financial services comparisons **in the field blockchain and digital currency services**; Provision of online price comparison services; Purchasing agency services namely consulting **in the field blockchain and digital currency services**; Purchasing of goods and services for other businesses **in the field blockchain and digital currency services**; Purchasing services **in the field blockchain and digital currency services**; Sales administration **in the field blockchain and digital currency services**; Sales management services **in the field blockchain and digital currency services**; Subscription to a television channel; Subscription to an information media package; Subscriptions to a telematics, telephone or computer service **in the field blockchain, digital currency, software, and cloud computing services**; Arranging subscriptions to books, reviews, newspapers or comic books; Subscriptions to electronic journals; Subscriptions to telecommunications database services; Tariff information and advisory services **in the field blockchain and digital currency services**; Telemarketing services; Telephone order-taking services for others; The bringing together, for the benefit of others, of a variety of insurance services, enabling consumers to conveniently compare and purchase those services; The bringing together, for the benefit of others, of a variety of telecommunications services, enabling consumers to conveniently compare and purchase those services; Wholesale ordering services **in the field blockchain and digital currency services**; Online retail **store** services for downloadable and pre-recorded music and movies **in the field blockchain and digital currency services**; Online retail **store** services for downloadable digital music; Online retail **store** services for downloadable ringtones; Online retail **store** services relating to clothing; Online retail **store** services relating to cosmetics; Online retail **store** services relating to handbags; Online retail **store** services relating to jewelry; Online retail **store** services relating to luggage; Online retail **store** services relating to toys; Online retail store services relating to clothing; Online retail store services relating to cosmetic and beauty products; Rental of sales stands; Arranging of contractual services with third parties

- International Class 036 for Financial, monetary, and banking services in the field of blockchain and digital currency services; Charitable fundraising in the field of blockchain and digital currency services; Financial sponsorship in the field of blockchain and digital

currency services; Insurance brokerage services in the field of blockchain and digital currency services; Issuance of prepaid debit, credit, and gift cards and tokens of value in the field of blockchain and digital currency services; Safe deposit box services, including virtual safe deposit box services involving blockchains services; Financial valuation services in the field of blockchain and digital currency services;; Accident, life, property, and medical insurance underwriting in the field of blockchain and digital currency services; Real estate agency services in the field of blockchain and digital currency services; Financial advice in the field of blockchain and digital currency services; Financial analysis in the field of blockchain and digital currency services; Financial consultancy in the field of blockchain and digital currency services; Financial information in the field of blockchain and digital currency services; Providing financial information in the field of blockchain and digital currency services; Providing financial information on-line in the field of blockchain and digital currency services; Providing financial information via a website in the field of blockchain and digital currency services; Financial bill payment services in the field of blockchain and digital currency services; Financial transfers and transactions, and payment services namely, money transfer services in the field of blockchain and digital currency services; Administrative services relating to dental health insurance claims; Administrative services relating to employee stock plans; Brokerage of business contact lists; Financial information advice and consultancy services in the field of big data, blockchain, and digital currency services; Warranty administration in the field of insurance, blockchain, and digital currency services

- International Class 038 for Telecommunication services **in the field of e-mail, blockchain technology, digital currency, and cloud computing services**; Data transmission and reception services via telecommunication means **in the field of e-mail, blockchain technology, digital currency, and cloud computing services**; Electronic exchange of messages via chat lines, chatrooms and Internet forums **in the field of e-mail, blockchain technology, digital currency, and cloud computing services**; Electronic **transmission of** mail services **in the field of e-mail, blockchain technology, digital currency, and cloud computing services**; Instant messaging services; Voice over IP services; Transmission of data, audio, video and multimedia files; Transmission of audio and video content via computer networks; Computer communication services; Wireless communication services **namely electronic transmission of data in the field of e-mail, blockchain technology, digital currency, and cloud computing services**; Telephone communication services; Mobile phone communication services
- International Class 042 for Providing temporary use of non-downloadable computer software **used to send, operate, and access email, blockchain, and digital currency services**; Providing online, non-downloadable software **used to send, operate, and**

access email, blockchain, and digital currency services; Providing temporary use of non-downloadable software **used to send, operate, and access email, blockchain, and digital currency services**; Providing temporary use of online non-downloadable software **used to send, operate, and access email, blockchain, and digital currency services**; Providing temporary use of on-line non-downloadable software **used to send, operate, and access email, blockchain, and digital currency services**; Providing search engines **for the Internet related to blockchain, email, and digital currency services**; Administration of mail servers; Electronic storage of archived e-mails; Hosting **websites of others services related to blockchain, email, and digital currency services** and software as a service **related to blockchain, email, and digital currency services** and rental of software; **Consulting in the field of cloud computing, namely, consulting related to the practice of using a network of remote servers hosted on the Internet to store, manage, and process data, rather than a local server or a personal computer**; Cloud hosting provider services; Consulting in the field of cloud computing networks and applications; Consulting services in the field of software as a service; Fog computing, **namely, designing, hosting, operating, and consulting services related to the integration of computer networks, digital storage, and networks with end devices and cloud computing**; Advice relating to the development of computer systems; Advisory services relating to computer systems design; Computer **design** consultancy and advisory services **in the fields of cloud computing, blockchain technology, digital currencies, and e-mail**; Computer security consultancy; IT consultancy, advisory and information services; IT security, protection and restoration **namely IT consulting services regarding security, protection, and restoration of software systems**

II. The Nature of the Mark the Examining Attorney Concluded Could Lead to Confusion, Mistake, or Deception under 15 U.S.C. § 1052(d)

U.S. Registration No. 2613627

The mark covered by this registration is a standard character mark containing the literal elements: FINANCIAL MAIL

This mark fits into

- International Class 016 for Printed matter and printed publications, namely, [books,] magazines, newspapers, [periodicals, brochures, manuals,] and supplements therefor featuring information relating to news, politics, [fashion, health, beauty, medical matters, sports, entertainment, education, food and drink, travel, hotel and accommodation reservations,] current affairs, financial matters [, the web sites of others, and the world wide web]

- International Class 035 for Providing business information [and business directory agency services;] trade information; providing statistical information; [telephone directory information;] foreign trade information and [consultation; shoppers guide information services;] dissemination of advertising matters for others via an on-line electronic communications network; [computerized on-line ordering services for the goods and services of others in the field of consumer goods and services;] advertising services, namely, providing advertising space on a computer database or a global computer network; business services, namely, providing business information, advice and consultation provided on-line from a computer database or a global computer network; compilation of advertisements for others for use as web pages on a global computer network; [public relations services;] providing information and on-line computer databases in the field of career placement and business
- International Class 036 for Provision of information relating to insurance and financial services-- analysis evaluation, advice and information relating thereto;[financial management services;] financial advisory services; [financial services relating to credit card services, investment schemes and accounts; bank cards, debit cards, check verification and check cashing, issuing and redemption of traveler's checks and travel vouchers] and advisory services relating thereto; all the aforesaid information and services also provided on-line from a computer database or from a global computer network
- International Class 038 for [Telecommunications gateway services; telecommunications services, namely, ISDN and personal communication services; electronic transmission of data;] providing multiple-user access to a global computer information network for the transfer and dissemination of a wide variety of information, websites and home pages of others; providing on-line electronic bulletin boards for the transmission of messages among computer users featuring news, politics, [fashion, health, beauty, gardening, medical matters, sports, entertainment, education, food and drink, travel, hotels and temporary lodging, current affairs,] financial matters on a global computer network” and International Class 041 for “[Education an entertainment services, namely, providing on-line computer games; providing sports information by pre-recorded telephone messages or from a global computer network;] electronic publishing through a global computer network of [books, magazines,] newspapers and [manuals and] supplements therefor of others in the fields of finance and financial matters; [providing information and on-line computer databases in the fields of sports, entertainment, music, television, theater and education]
- International Class 042 for Computer services, namely, providing databases featuring general and local news [and information of specific interest to specific geographic areas;

desktop publishing for others of books, magazines, newspapers, manuals and supplements therefor;] computer services, namely, providing search engines for obtaining data on a global computer network;[making of hotel and temporary lodging reservations for others; news agency services, namely, gathering and dissemination of news;] all the aforesaid services also provided on-line from a computer database or from a global computer network; providing information in the fields of politics, [cultural affairs, fashion, health, beauty, gardening, medical matters, food and drink, cookery, hotels, hotel and accommodation reservations,] current affairs [and science]

This application is based on 44(e) and is owned by Associated Newspapers Limited, a UK company. ANL owns newspapers such as *Daily Mail* and *Mail on Sunday*. As shown by the specimen provided in 2009 and 2013, FINANCIAL MAIL is used for newspaper services.

III. Application of the Relevant *DuPont* Factors to the Pending Application

In an *ex parte* proceeding, the primary considerations in determining whether marks are confusingly similar are the similarity or dissimilarity of the marks in appearance, sound, connotation, and commercial impression; and the similarity or dissimilarity of the goods and/or services.¹ In addition to these two factors, any of the other eleven factors listed in *Du Pont*, when made of record, must also be considered.² Here, the commercial connotation of Applicant's mark is robustly different from the Cited mark. Also, Applicant's mark is used for completely different services than the Cited mark. The possibility of consumer confusion is *de minimis*.

Any likelihood of confusion between marks is determined on a case-by-case basis.³ The marks are compared for similarities, considering the various relevant factors.⁴ Based on the differences between the appearance, sound, and connotation of the marks, as well as the differences between the services and other factors as explained and outlined below, there is no likelihood of consumer confusion between the marks.

A. Comparing Applicant's Mark with Relevant Registered Marks in Their Entireties Reveals Significant Differences that Make Consumer Confusion Unlikely.

DuPont requires the examining attorney to compare the marks in their entireties for similarities and dissimilarities in appearance, sound, and meaning or connotation.⁵ The

¹ *In re E.I. Du Pont Demours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) and TMEP § 1207.01.

² *In re Dixie Restaurants*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 640 (TTAB 1984) and TMEP § 1207.01.

³ *Id.*

⁴ *See In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).

⁵ *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); TMEP § 1207.01(b)-(b)(v); *In re 1st USA Realty Professionals, Inc.*, 84 USPQ2d 1581, 1586 (TTAB

Trademark Trial and Appeals Board (“TTAB”) has held that “Similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a determination that confusion is likely even if the goods are identical or closely related.”⁶ An Examining Attorney must determine whether the total effect conveyed by the two marks is confusingly similar, not simply whether the marks have similar features.⁷ According to Section 1 of the Lanham Act §1, when comparing design marks in the similarity-of-the-marks, likelihood of confusion is determined on the basis of the total effect of the designation, rather than a comparison of individual features.⁸

i. *The Marks Differ in Appearance.*

It is accepted that “use of identical, even dominant, words in common does not automatically mean that two marks are similar.”⁹ Consumers will look at the marks in their entirety. The Examining Attorney has not presented any evidence on why consumers would only focus on the first element and ignore the mark as a whole. When Applicant’s mark is compared in its entirety, the first *Dupont* factor weighs in Applicant’s favor in finding that there is no likelihood of confusion.

It is established case law that registered marks can **share** the first word and **not** be confusingly similar. Instances when courts have found the use of identical dominant words or terms are **not** confusingly similar include:

- BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL not confusingly similar.¹⁰
- FIRSTBANK and FIRST BANK KANSAS not confusingly similar.¹¹
- LEAN CUISINE and MICHELINA’S LEAN ‘N TASTY not confusingly similar, even though both for low-fat frozen food.¹²

2007) (An examining attorney “must compare the marks in their entireties” whenever evaluating their potential for confusion.)

⁶ *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009).

⁷ “All relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar.” *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *See also General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987), *Sensient Technologies Corp. v. SensoryEffects Flavor Co.*, 613 F.3d 754 (8th Cir. 2010); *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1 (1st Cir. 2008); 15 U.S.C.A. § 1051.

⁸ *Id.*

⁹ *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442, 1446 (8th Cir. 1987).

¹⁰ *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986)

¹¹ *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d 645, 653, 40 USPQ2d 1865, 1870 (10th Cir. 1996)

¹² *Luigino’s Inc. v. Stouffer Corp.*, 170 F.3d 827, 50 USPQ2d 1047 (8th Cir. 1999)

- OATMEAL RAISIN CRISP and APPLE RAISIN CRISP not confusingly similar.¹³
- FREEDOM SAVINGS AND LOAN and FREEDOM REALTY not confusingly similar.¹⁴
- SUN FEDERAL AND SAVINGS LOAN ASSOCIATION and SUN BANKS not confusingly similar.¹⁵
- ROMANBURGER and ROMAN for food not confusingly similar.¹⁶
- PIZZA CAESAR U.S.A. and LITTLE CAESAR’S not confusingly similar.¹⁷
- DOMINO SUGAR and DOMINO’S PIZZA not confusingly similar.¹⁸

Even if the dominant portion of a mark is given greater weight, each mark must still be considered as a whole.¹⁹ The mark FINMAIL differs from FINANCIAL MAIL in first word, dominant element, and overall appearance.

Where dominant terms are to be considered, consumers are generally more inclined to focus on the first word, prefix, syllable, or element in any trademark or service mark.²⁰ The first word of Applicant’s mark differs from Cited, allowing consumers to better distinguish between the marks.

Looking at the literal elements, Applicant’s mark is not similar in terms of appearance to the Cited mark. While Applicant’s mark is made up of 7 letters, the Cited mark is made of 13 letters. Applicant’s mark is made up of 1 word while the Cited mark is made up of 2 words. Visually, the literal elements of Applicant’s mark make it distinct from the Cited mark. The word “FINANCIAL” is disclaimed by the Cited registrant, the dominant word in the Cited mark is

¹³ *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442, 1446 (8th Cir. 1987)

¹⁴ *Freedom Sav. & Loan Ass’n v. Way*, 757 F.2d 1176, 1183, 226 USPQ 123, 128 (C.A.11 Fla. 1985)

¹⁵ *Sun Banks of Florida, Inc. v. Sun Federal Sav. and Loan Ass’n*, 651 F.2d 311, 211 USPQ 844 (5th Cir. 1981)

¹⁶ *Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co.*, 781 F.2d 884, 888, 228 USPQ 364, 366 (Fed. Cir. 1986)

¹⁷ *Little Caesar Enters. v. Pizza Caesar, Inc.*, 834 F.2d 568, 4 USPQ2d 1942 (6th Cir. 1987)

¹⁸ *Amstar Corp. v. Domino’s Pizza, Inc.*, 615 F.2d 252, 205 USPQ 969 (5th Cir. 1980)

¹⁹ *See First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d 645, 653, 40 USPQ2d 1865, 1870 (10th Cir. 1996); *Universal Money Centers, Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 1531, 30 USPQ2d 1930 (10th Cir. 1994).

²⁰ *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); *See also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

“MAIL”. In contrast, the dominant word in Applicant’s mark is “FINMAIL”. Accordingly, the two marks have significantly dissimilar dominant words.

Viewing the marks in their entirety reveals differentiations between Applicant’s mark and any Cited mark. Because the marks are dissimilar in appearance, customer confusion as to source is unlikely.

ii. *The Marks Differ in Sound and Pronunciation.*

It has been held that a difference in the sound between two marks may exist given a difference in the number of syllables between the two word portions of a mark.²¹ In this case, the marks differ phonetically as Applicant’s mark is made up of 2 syllables while the Cited mark is made up of 4 syllables.

Applicant’s mark is pronounced like \¹fin ¹māl\ while the Cited mark is pronounced like \fə-¹nan(t)-shəl ¹māl\.

Even if descriptive portions of a mark are disregarded elsewhere in this analysis, descriptive portions would still appear on all of the relevant offerings and be seen and thus pronounced by consumers. Thus, the Cited mark coupled with the wording FINANCIAL still has over a third of additional wording needing to be pronounced, at the very least – even up to three fourths more words when compared to simply MAIL. The words FINANCIAL appear nowhere in Applicant's mark. The pronunciation is therefore dissimilar and no source confusion could take place.

Even if the marks were phonetically similar — which they are not — there would still be no likelihood of confusion because other differentiating factors are present.²² For instance in *Nat’l Distillers & Chem. Corp.*, the Court found DUVET and DUET did not have a likelihood of confusion. Ultimately, as outlined in *DuPont* and other jurisprudence above, an ultimate determination on likelihood of confusion must take into account all the various relevant factors.²³ “The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used.”²⁴ In sum, the differences in sound and pronunciation among Applicant’s and the Cited marks make consumer confusion unlikely.

²¹ *Parfums de Coeur, Ltd. v. Lory Lazarus*, 83 USPQ2d 1012 (TTAB 2007).

²² *Nat’l Distillers & Chem. Corp. v. William Grant & Sons*, 505 F.2d 719, 184 USPQ 34 (C.C.P.A. 1974).

²³ *See also In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985) ().

²⁴ *Id.*

iii. *The Marks Have Significantly Different Connotations and Commercial Impressions.*

The similarity or dissimilarity in meaning or connotation is another factor in determining whether there is a likelihood of confusion.²⁵ The meaning or connotation of a mark must be determined in relation to the named goods or services.²⁶ Whether customers can distinguish the marks in a side-by-side comparison is not the test, instead our inquiry is “whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods and services offered under the respective marks is likely to result.”²⁷

In cases where two marks are identical in appearance or sound, differences in connotation between the marks can be sufficient to obviate any likelihood of consumer confusion.²⁸

In the *Taj Mahal* case, the marks at issue were TAJ MAHAL for an Indian restaurant and TAJ MAHAL for a casino-hotel resort.²⁹ The court held that there was no likelihood of confusion, as the mark TAJ MAHAL for restaurants is suggestive of Indian food, while TAJ MAHAL for casino-hotel evokes images of grandeur, opulence and extravagance.³⁰

Applicant’s mark connotes a shark fin, something to navigate moving waters, while the Cited mark connotes a newspaper about financial industries. Applicant, FINMAIL, endeavours to provide cutting edge technology to help consumers keep up in their business, the way a fin can help a shark maneuver through moving waters. On the other hand, the Cited mark is a magazine similar to *Financial Times* and is part of the *Daily Mail* family of newspapers.

Connotation and significance can be determined based upon a mark holder’s current use in commerce.³¹ The Cited mark is used in commerce in connection with publications featuring information relating to news, politics, and financial matters, which further supports that the Cited mark has a different connotation than Applicant’s mark. Applicant provides services related to blockchain technology not for newspaper services.

²⁵ TMEP § 1207.01(b)(v).

²⁶ *Id.*

²⁷ *Lacoste Alligator S.A. v. Maxoly, Inc.*, 91 USPQ2d 1594, 1598 (TTAB 2009).

²⁸ See *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (finding that CROSS-OVER when applied to bras carried different connotation and/or commercial impression from CROSSOVER as applied to women’s sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (finding that PLAYERS for men’s underwear carried different connotation and/or commercial impression from PLAYERS for shoes); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629, 630 (TTAB 1977) (finding that BOTTOMS UP for ladies’ and children’s underwear held a different connotation or commercial impression from BOTTOMS UP for men’s clothing).

²⁹ See *Taj Mahal Enterprises, Ltd. v. Trump*, 745 F.Supp. 240, 16 USPQ2d 1577 (D.N.J. 1990).

³⁰ *Id.*

³¹ *In re Nationwide Industries*, 6 USPQ2d 1882, 1884 (TTAB 1984) (“Thus, it is settled that evidence of the context in which a mark is used on labels, packaging, advertising, etc., is probative of the significance which the mark is likely to project”); See *7-Eleven, Inc. v. Lawrence I. Wechsler*, 83 USPQ2d 1715, 1721 (TTAB 2007).

Examining Attorney asserts that “fin” refers to “financial” however “fin” can have multiple meanings. The word “fin” is commonly understood to refer to a thin component or appendage attached to a larger body or structure, which typically function as foils that produce lift or thrust, or provide the ability to steer or stabilize motion while traveling in water, air, or other fluids. See Exhibit C. For instance, “fin” can also mean a five-dollar bill or to agitate violently in water. FIN also means “the end” or “final.” Additionally, “fin” is an abbreviation for Finland, Finnish, Fingerprint Identification Number, Input Frequency, Fix It Now, Fleet Identification Number, Field Information Notice, Factory Inspection Note, Functional Identification Number, Finnair Oyj, or Fisher Identification Number. Here, Applicant’s mark intends to suggest the common meaning of FIN, as the part of water animals that helps them navigate, as Applicant offers business and technology solutions to help people navigate the growing world of big data.

Even if a consumer understood “fin” to be an abbreviation of “financial,” “financial department,” or “finance,” the consumer impression of Applicant’s mark still differs from the Cited mark. The abbreviation of “fin” as “finance” suggests emerging technologies, such as internet, big data and, especially blockchain/digital currency, that are frequently used by startup companies to improve today’s financial services. These blockchain companies are a rejection of the traditional finance world. In contrast, the cited mark connotes publications and newspapers about traditional financial institutions and services, instead of blockchain technology. Accordingly, the commercial connotation of Applicant’s mark is distinct from the Cited mark.

B. Applicant’s Offerings are Sufficiently Different from the Cited Offerings.

The second *DuPont* factor evaluates the similarity or dissimilarity of the goods and services offered under the respective marks. To sustain a finding of likelihood of confusion, the goods or services at issue must be “related in some matter and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods or services] emanate from the same source.”³² The inquiry is whether the relevant goods and services could be related “in the mind of the consuming public” such that source confusion would occur.³³ An examining attorney must “provide evidence showing that the goods and services are related to support a finding of likelihood of confusion.”³⁴

i. *The Applicable Standard of Relatedness*

³² *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1370, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (“there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source”).

³³ See *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1358, 56 USPQ2d 1351, 1355 (Fed. Cir. 2000).

³⁴ TMEP § 1207.01(a)(vi).

In circumstances where the goods or services in question “are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely.”³⁵

To establish that identified items are related, “it is not sufficient that a particular term may be found which may broadly describe” them.³⁶ “That two goods are used together . . . does not, in itself, justify a finding of relatedness.”³⁷ That the same customer could seek out relevant goods or services is also insufficient for a finding of relatedness.³⁸

“Merely because parties operate in the same broad industry does not, by itself, establish that their goods and services are related.”³⁹ Being filed in the same class or presumably available to the same class of purchasers is also not a sufficient basis to conclude that identified items are related.⁴⁰ Simply because Applicant and the Cited mark operate generally in the broad industry of software services, telecommunication services and financial services, does not establish that the goods are related. Here, Applicant provides blockchain based services while the Cited mark is a newspaper.

Examining Attorney retains the burden of establishing relatedness of the relevant offerings by evidence. The controlling rule is: to sustain a likelihood of confusion refusal, the goods at issue must be “related in some matter and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods or services] emanate from the same source.”⁴¹ Under the *Coach* standard, the actual circumstances of marketing the goods at issue must have a likelihood of confusion. Examining Attorney has not provided sufficient evidence under the *Coach* standard for a finding of confusion.

ii. *The Goods/Services at Issue Are Not Related.*

³⁵ TMEP § 1207.01(a)(i).

³⁶ *In re The W.W. Henry Co., L.P.*, 82 USPQ2d 1213, 1215 (TTAB 2007).

³⁷ *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244, 73 USPQ2d 1350, 1355 (Fed. Cir. 2004) (no likelihood of confusion between RITZ for cooking classes and RITZ for kitchen textiles).

³⁸ *See Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (“even though opposer’s services and applicant’s product are or can be marketed to the same class of customers . . . these services and goods are so different that confusion is not likely even if they are marketed under the same mark”).

³⁹ *National Rural Electric Cooperative Ass’n v. Suzlon Wind Energy Corp.*, 78 USPQ2d 1881, 1885 (TTAB 2006); *See Steve’s Ice Cream, Inc. v. Steve’s Famous Hot Dogs*, 3 USPQ2d 1477 (TTAB 1987).

⁴⁰ *7-Eleven, Inc. v. Lawrence I. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007); *See In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009).

⁴¹ *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1370, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (likelihood of confusion “must be based on the goods identified in the application” rather than alleged or possible other applications of the mark).

First, since the Cited registrant cancelled registration on International Class 009, Applicant's software that seeks registration under International Class 009 would not cause confusion with the Cited mark.

Second, Applicant's financial services in Class 036 are based on blockchain and digital currency technology. To the opposite, the Cited registrant only offers traditional financial advisory services, which does not involve emerging computer technologies such as blockchain and digital currency. Consumers using traditional financial services are unlikely to try blockchain and digital currency backed financial services. Similarly, consumers used to new tech type of financial services would not change into traditional financial services. Accordingly, Applicant and the Cited registrant target different group of consumers and there is seldom overlap between the two groups of consumers.

Third, Applicant's computer software service that seeks registration under Class 042 is used to provide email access, blockchain and digital currency related services. However, the Cited registrant's computer service is providing users with database featuring general and local news. Applicant's services are used for different purposes by different groups of consumers than the Cited registrant's services. Consumers are unlikely to consider their services generating from the same source.

C. There is no Likelihood of Confusion Arising from Similarity of Trade Channels.

Examining Attorney asserts that absent restrictions in an application and/or registration, the identified goods or services are presumed to travel in the same channels of trade to the same class of purchasers. The rule is that we do not infer nonexistent limitations into a definite identification – the identified goods and services of each mark are presumed to move in all normal trade channels for such goods and services.⁴² To square this assertion with Examining Attorney's: essentially, the differing identified items *are* the restrictions in the identifications that defeat a bald presumption of identical trade channels.

That is not the case here – and why a mere lack of geographic or other limitations in the relevant identifications does not establish that the relevant goods and services travel in the same trade channels.

⁴² See *Harry Winston, Inc. and Harry Winston S.A. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1437 (TTAB 2014) (“we presume that . . . goods move in all channels of trade normal for the identified goods, and that they are available to all classes of purchasers for those goods”).

D. Purchasers of the Goods/Services Associated with Applicant’s and Cited Marks are Likely to be Sophisticated and Knowledgeable.

To the extent that a customer is likely to exercise a high degree of care and/or sophistication when selecting goods or services, the less chance that confusion, mistake, or deception will occur between two or more competing marks.⁴³

Furthermore, the degree of care factor plays a significant role in minimizing potential confusion where the subject products fail to constitute “impulse” purchases.⁴⁴ Goods that are sold to consumers that have a sophisticated knowledge of a given activity are less likely to be confused with goods that are sold to a different class of sophisticated buyers.⁴⁵ As the likely potential buyers of products sold under the Applicant’s mark and those sold under a Cited mark are sophisticated and knowledgeable about their respective interests, the likelihood of confusion between the marks is greatly limited.

While the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion, circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion.⁴⁶ Here, Applicant and Cited products both are not “impulse” goods or services as discussed in *Astra Pharm*, as consumers will research and spend time on offerings made by the respective parties.

Consumers purchasing Applicant’s blockchain and digital currency based mail services are business entities and high income individuals who need to optimize their investment and business conditions. Most of these consumers are sophisticated and have comprehensive knowledge of blockchain technology services. These consumers tend to be careful in selecting emerging technology management service providers. They are unlikely to purchase a wrong service from a wrong provider because of trademark confusion. Similarly, consumers of the Cited registrant’s publications featuring financial analysis and information are likely to be highly educated business people. These consumers are also sophisticated and are careful in selecting

⁴³ See *TCPIP Holding Co., Inc. v. Haar Communications, Inc.*, 244 F.3d 88, 102, 57 USPQ2d 1969, 1981 (2d Cir. 2001) (“The more sophisticated the consumers, the less likely they are to be misled by similarity in marks.”); *Cadbury Beverages, Inc. v. Cott Corp.*, 73 F.3d 474, 480, 37 USPQ2d 1508, 1513 (2d Cir. 1996) (“The sophistication factor recognizes that the likelihood of confusion between the products at issue depends in part on the sophistication of the relevant purchasers.”).

⁴⁴ See, e.g., *Astra Pharm. Prods. Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206, 220 USPQ 786, 790 (1st Cir. 1983) (finding that blood analyzers that cost between \$35,000 to \$60,000 require careful consideration likely to result in added consumer scrutiny and examination).

⁴⁵ See *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 718, 21 USPQ 2d 1388, 1392 (Fed. Cir. 1992).

⁴⁶ TMEP § 1207.01(vii).

financial presses and are unlikely to confuse a financial-focused newspaper with a blockchain service. Thus, consumers are unlikely to be confused between Applicant’s and the Cited mark.

Any of the *DuPont* factors may play a dominant role in a given case.⁴⁷ A single factor may also be dispositive.⁴⁸ Here, it is completely implausible that the sophisticated customers at issue would be likely to confuse Applicant’s and the Cited marks. In the present case, “the sophistication of the customers” would “strongly outweigh” any factors favoring a likelihood of confusion.⁴⁹

E. The Weakness of the Cited Mark Weighs Against Confusion

When determining the scope of protection a mark should be accorded, a vital consideration is the strength of the registered mark. When evaluating the strength of a mark, the commercial strength of the mark is considered along with the inherent strength of the mark.⁵⁰ “A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”⁵¹ It is well established that when analyzing a mark, the Board will “consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark.”⁵²

The USPTO has been comfortable registering marks sharing a weak element alongside one another. The mere fact that two marks incorporate a form of a common identifying word does not render the marks too similar.⁵³

Here, Applicant’s mark is not identical to the Cited Mark, and the weakness of the Cited mark supports that consumers are unlikely to be confused. Here, the differences between Applicant’s and Cited marks are NOT identical and result in separate and distinct commercial impressions. Similar to how the Board found to be PAPER a weak element because of its wide use in the relevant industry, the common element between Applicant’s and Cited marks, FIN, is weak and widely used.

i. The Element at Issue Lacks Inherent Strength

⁴⁷ *In re E.I. DuPont de Nemours & Co.*, 476 F.2d at 1362, 177 USPQ at 567.

⁴⁸ *Kellogg Co. v. Pack’em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

⁴⁹ *Calypso Technology, Inc. v. Calypso Capital Management, LP*, 100 USPQ2d 1213 (TTAB 2011).

⁵⁰ *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010).

⁵¹ *Id.*

⁵² *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011).

⁵³ *See, e.g. In re Hearst Corp.*, 982 F.2d 493, 494, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992) (VARGA GIRL and VARGAS are sufficiently different to negate likelihood of confusion); *Conde Nast Pubs., Inc. v. Miss. Quality, Inc.*, 507 F.2d 1404, 1407, 184 USPQ 422, 425 (C.C.P.A. 1975) (COUNTRY VOGUES and VOGUE publications “do not look or sound alike”).

A vital consideration is the strength of marks cited by an examining attorney in order to determine the scope of protection to be accorded to those registered marks. Weaker marks are entitled to a narrow scope of protection, permitting closer similarities with an applicant’s mark “without causing a likelihood of confusion.”⁵⁴

The weakness of registered matter is a relevant consideration “because it is well established that the scope of protection afforded a merely descriptive or even a highly suggestive term is less than that accorded an arbitrary or coined mark.”⁵⁵ Where a term is considered to be weak, “minor alterations could effectively negate any confusing similarity between the” marks.⁵⁶

Ultimately whether an addition is sufficient to prevent confusion in a particular instance depends upon the strength of the main part of the mark and the distinctiveness of the additional feature. USPTO has been comfortable registering marks sharing a weak element alongside one another “so long as there has been some difference between the marks as a whole or between the goods or services.”⁵⁷

ii. The Market at Issue is a Crowded Field, which Weighs Against Confusion

Widespread third-party use “can serve to diminish the strength of a mark and thus the scope of protection to which a mark is entitled.”⁵⁸ “Extensive evidence of third-party use and registrations is powerful on its face, even where the specific extent and impact of the usage has not been established.”⁵⁹ Evidence of third party use shows that customers in the relevant industry are likely “to distinguish between different marks on the basis of minute distinctions.”⁶⁰

The possibility for the same consumer to purchase items sold under Applicant’s and the Cited marks does not itself establish a likelihood of confusion as to the source of those goods.⁶¹

⁵⁴ *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015); See TMEP § 1207.01(b)(ix). Highly suggestive or descriptive marks are entitled to a narrower scope of protection. See *In re The W.W. Henry Co., L.P.*, 82 USPQ2d 1213 (TTAB 2007) (“Purchasers are simply unlikely to assume that all [goods] offered under these highly suggestive marks emanate from the same source.”).

⁵⁵ *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975).

⁵⁶ See, e.g. *Freedom Sav. & Loan Ass’n v. Way*, 757 F.2d 1176, 1183, 226 USPQ 123, 128 (C.A.11 Fla. 1985) (“Freedom Savings and Loan” and “Freedom Realty” marks “lack ... confusing similarity”); *Pacquin-Lester Co. v. Charmaceuticals, Inc.*, 484 F.2d 1384, 179 USPQ 45 (C.C.P.A. 1973) (“SILK ‘N SATIN” beauty and bath lotion and oil not similar to “SILK” face cream).

⁵⁷ See *In re FiftyThree, Inc.*, Serial No. 86180291, (TTAB 2017) (non-precedential) (PAPER not likely to be confused with BAMBOO PAPER for identical in part goods when it was shown that PAPER is widely used and weak in the relevant industry).

⁵⁸ *Nike, Inc. v. WNBA Enterprises, LLC*, 85 USPQ2d 1187 (TTAB 2007); See also *In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003); TMEP § 1207.01(d)(iii).

⁵⁹ *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1373-74, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015).

⁶⁰ *Juice Generation, Inc.*, 794 F.3d at 1338, 115 USPQ2d at 1674 (internal quotations omitted).

⁶¹ See *The Sports Authority Michigan, Inc. v. The PC Authority, Inc.*, 63 USPQ2d 1782, 1794 (TTAB 2001).

There is nothing in the record that suggests that the consumer would consider the goods as likely to emanate from the same source or have the same sponsorship. Instead, the multitude of third-party marks that all share the same element, FIN, suggests that consumers are unlikely to be confused as to the source of these goods.

If other registrations appear that are owned by more than one registrant, the dilution of those terms among several users indicates that there is no likelihood of confusion between the Applicant’s mark and a Cited mark.⁶² Applicant notes that there are over 92 marks found marks utilizing a variation of the element FIN or phonetic equivalents thereof in International Class 009, 035, 036, 042. TESS Search terms: (fin)[bi,ti] and (live)[ld] and (registrant)[ow] and (financial)[gs]. Given such widespread use of the element FIN consumers are more likely to acknowledge slight variances among its uses.

In this regard, Applicant respectfully submits the following representative sample of use-based registrations for the same and closely related goods and services. Registrant has coexisted with these marks without any evidence of confusion. These registrations are attached as Exhibit III and listed below:

#	MARK	U.S. Reg. No.	OWNER	SERVICES/GOODS
1	FINIT	5888880	The Finit Group LLC	Class 009: Computer software for financial consolidations and reporting, financial budgeting, planning, and forecasting, financial and management analysis, process governance and change management, financial reporting and dash boarding
2	FINCLUB	5833043	KIEVANOS, L.L.C.	Class 036: Financial information services provided on-line from a computer database or a global computer network, namely, providing information in the field of financial classification of companies and securities; Providing an on-line computer database in the field of

⁶² See TMEP § 1207.01(d)(x).

				stock/securities market information
3	FINTECH4GOOD	5793794	Fintech4Good Group LLC	Class 035: Business consultancy; Business networking; Arranging and conducting business competitions for fintech and blockchain entrepreneurs to compete for grants and other resources to facilitate business activities
4	FINTANK	5690566	GMERC LLC	Class 035: Business networking; Business development services, namely, providing start-up support for businesses of others
5	FINRIVER	5411114	FinMason, Inc.	Class 042: Data mining namely, data search and analysis of portfolio statistics, asset allocation Class 035: Business data analysis
6	FINTECH PARTNERS	5764877	Financial Technology Partners LP	Class 036: Investment banking services; investment consultation; investment advice; investment of funds for others; investment advisory services; financial research and information services
7	FIN ENGINES	5664641	EDELMAN FINANCIAL ENGINES, LLC	Class 009: downloadable software in the nature of a mobile application for providing investment account and portfolio information and statements, retirement goal information, investment activity and plan

				updates and information, and contact to a financial advisor
8	FINCHAT	5495808	Chiaw, Eng Hung	Class 042: Financial software as a service (SAAS) services, namely, provide hosting software to help regulated enterprises capture and log business-related instant messaging content from employee mobile devices such as their interactions with clients to satisfy financial regulations on data-retention required for all employees engaged in financial advisory
9	FIN	4714710	Financial Information Network, Inc.	Class 036: Financial and investment services, namely, management and brokerage in the fields of stocks
10	FINPAY	5340943	FINPAY, LLC	Class 036: On-line cash account services that allow individuals to fund their accounts via credit, debit, or checking account to a safe secure account

Attached as Exhibit D, these third party registrations are evidence that Registrant is not entitled to the broad scope of protect initially suggested by the Examining Attorney.

FIN is a weak element, therefore consumers are unlikely to be confused by the registration of Applicant’s mark. In sum, this DuPont factor should weigh in favor of a finding that there is no likelihood of confusion between Applicant’s and Cited marks.

F. The Extent of Potential Confusion Between Applicant’s and the Cited Marks is De Minimis.

The extent of potential confusion is a relevant factor in determining likelihood of confusion between marks.⁶³ When “there is not a practical likelihood of confusion” applications should be permitted to proceed, because the likelihood of confusion analysis is “not concerned with the 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.”⁶⁴ Where the extent of potential confusion is *de minimis*, the factor should weigh against a finding of likelihood of confusion.⁶⁵

The extent of potential confusion between the marks in this case is *de minimis* “because of the limited number of overlapping potential purchasers of the parties’ goods and services, and their sophistication.”⁶⁶ As a practical matter, only a very limited number of potential purchasers will be exposed to both Applicant’s and a Cited mark.⁶⁷

Applicant’s mark distinguishes the Cited mark in appearance, sound, and commercial connotation. Also, Applicant’s services are used for completely different purposes and target significantly different group of consumers than the Cited registrant’s services. Moreover, consumers of both Applicant and the Cited registrant are sophisticated and are careful in selecting service provider. Accordingly, the extent of potential confusion is *de minimis*. The twelfth *DuPont* factor should weigh in favor of no confusion.

IV. Conclusion

For the reasons outlined above, Applicant respectfully submits that confusion between these marks is not likely. It is well settled that a refusal under Section 2(d) of the Lanham Act requires a determination that there is a probability, rather than a mere possibility of consumer confusion. That standard has not been met in this case. Therefore, Applicant requests that the Examining Attorney withdraw the refusal to register and approve this application for publication in the *Official Gazette*.

⁶³ See, e.g., *IDV North America, Inc. v. Chatam International Incorporated*, Opposition No. 101522, (TTAB 1999) (non-precedential); *Franklin Loufrani v. Wal-Mart Stores, Inc.*, Opposition No. 91152145, (TTAB 2009) (non-precedential).

⁶⁴ See *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1414 (TTAB 2010) (quoting *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992)) (internal quotations omitted).

⁶⁵ See *Bose Corp. v. Custom Electronic Design & Installation Assoc.*, Cancellation No. 92042327, (TTAB 2007) (non-precedential).

⁶⁶ *Calypso Technology, Inc. v. Calypso Capital Management, LP*, 100 USPQ2d 1213, 1223 (TTAB 2011).

⁶⁷ See *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 717-18, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992); See *In re Brar Business Enterprises*, Serial No. 85641460, (TTAB 2014) (non-precedential) (“extent of potential confusion also concerns the number of people who are likely to be confused”).