

This is in response to the office action dated July 9, 2020 in connection with application serial number 88867894. The trademark office has refused registration on the grounds that the applied-for mark, VANGUARD, for “insurance administration services, namely, assisting others with adjusting insurance claims” in class 36 is likely to be confused with several U. S. Trademark Registrations and pending Applications for VANGUARD, largely covering financial and investment services. The application serial numbers cited by the examining attorney are as follows:

74328301, for VANGUARD for fund investment in class 36;

77698754, for VANGUARD for “full line of financial and investment services” etc. in class 36;

77712848, for VANGUARD (Design) for “full line of financial and investment services” etc. in class 36;

77961336, for VANGUARD (motion mark) for “providing services in the investment and financial fields, namely, mutual fund investment services” etc. in class 36;

78015650, for VANGUARD.COM for “financial services, namely for the provision of financial investment information by means of a global computer network,” in class 36;

78734231, for VANGUARD (design) for “financial services, namely mutual fund services, brokerage services, funds and vesting services, financial management services, and securities brokerage services” in class 36; and

88977882, for VANGUARD DIGITAL ADVISER for “investment of funds; investment management, financial asset management;...” etc. in class 36.

The Trademark Office rests its conclusion that the marks are confusingly similar based on the similarity of their appearance together with the position that “the services are closely related.” Applicant respectfully disagrees that insurance administration services, namely assisting others with adjusting insurance claims” is closely related to financial and investment services such that confusion is likely. Applicant does not provide, or claim to provide, “financial and investment services.” And, the Trademark Office’s statement on page 2 of the office action that applicant’s insurance services are a “more specific” description of financial and investment services is patently false. The Nice Classification (8th Edition) delineates four distinct service groups within class 36 “Insurance; Financial Affairs; Monetary Affairs; and Real Estate Affairs.” One is not a more specific description of another.

Nonetheless, applicant has amended its description of services to “claims adjustment in the field of insurance,” which is an acceptable description from the Trademark Office’s Identification of Goods/Services Manual. To that end, applicant notes that there is not a single reference to the word “claims” or “adjustment” services (or any services that arguably could be considered similar) in any of the cited registrations and applications; and for good reason-- The Vanguard Group does not provide such services. The services are distinct. Claims adjustment services are directed to consumers desiring to make a claim for insurance coverage after a covered loss -- to assist consumers in evaluating the damage done, available coverage, and the amount of the repair claim. Financial and brokerage services, on the other hand, have absolutely nothing to do with a claims adjustment services business. Indeed, the only reference to insurance services in only a few of the cited registrations and applications is related to the administration of employee pension plans concerning insurance and finance and

insurance consulting services, which are services that are designed to *provide* insurance policies, not make claims against them, which is a wholly separate, and frankly adverse business.

The single piece of third party evidence supplied by the Trademark Office in support of its claim that the applicant's services are "commonly offered in the relevant industry with more general financial services," is equally deficient. The Hartford Group, provides advice on making investments and acquiring insurance for its customers. Like The Vanguard Group, it does not provide claims adjustment services, as the offering of such services would be in direct conflict with its relationships with insurance companies to sell insurance policies. Simply put, claims adjusters are adverse to insurance companies. The Trademark Office has provided no evidence whatsoever that claims adjustment services are "commonly offered" in the same relevant industry with more general financial services, because they simply are not.

It is noteworthy that applicant and The Vanguard Group have coexisted in the marketplace for almost 25 years, based on the evidence of record, without any incidences of actual confusion either received by applicant or reported to applicant by The Vanguard Group. This evidence is significant because this is not a case where one party is on the East Coast and another is on the West Coast. The parties' respective headquarters are less than 35 miles apart.

These undeniable facts of record underscore the only conclusion here which is that the services, as amended, are polar opposite of one another and, as a result, the parties have enjoyed ~25 years of coexistence using the VANGUARD mark in the same geographic region with no reported instances of confusion, no objection The Vanguard Group, and no reported adverse commercial impact on The Vanguard Group.

For the foregoing reasons, applicant respectfully requests withdrawal of the refusal to register and an early notice of publication.