


UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: White Oak Global Advisors, LLC

Mark:  **WHITE OAK**
Serial No. 88/032,055
Classes: 35 and 36

Examining Attorney:
Yatsye I. Lee

REQUEST FOR RECONSIDERATION

This communication is in response to the Examining Attorney’s Suspension Notice, dated May 15, 2019.

The Examining Attorney has cited U.S. Application Serial No. 87/705,454 for the mark WHITE OAKS WEALTH ADVISORS, INC & Design (the “Cited mark”) against registration of Applicant’s WHITE OAK & Design mark based on a likelihood of confusion. The Examining Attorney also maintained her refusal of the specimen submitted in connection with Applicant’s Class 35 services. Applicant responds as follows:

I. **LIKELIHOOD OF CONFUSION**

A. **Letter of Consent**

Concurrent herewith, and attached as **Exhibit A**, Applicant is submitting a consent agreement by and between Applicant and the owner of the Cited mark, White Oak Wealth Advisors, LLC (“Wealth Advisors”). As shown in the Letter of Consent, the document sets forth the reasons why the parties believe there is no likelihood of confusion. In particular, the Letter of Consent reflects an agreement between both parties, includes a clear indication that the consumers of the parties’ respective services are sophisticated and capable of distinguishing between the goods and services offered under the parties’ respective marks, and highlights that the parties use

distinctive logos to further differentiate the source of their respective services. Further, the parties have used their respective marks in commerce for a significant period of time without any evidence of actual confusion. The parties have agreed that they will make efforts to prevent confusion, and cooperate and take steps to avoid any confusion that may arise in the future.

Because Applicant and Wealth Advisors have entered into a bilateral agreement regarding the use and registration of the applied-for mark, public confusion is presumed to be prevented, and the Examiner should permit Application Serial No. 88/032,055 to proceed to registration.

B. Likelihood of Confusion

In addition to the foregoing, and for the reasons set forth below, Applicant respectfully disagrees that there is a likelihood of confusion between the Cited Mark and Applicant's WHITE OAK & Design mark in Class 35 and 36.



As an initial matter, where two parties enter into an agreement “reflecting [the] parties’ views on the likelihood of confusion in the marketplace, they are in much better position to know the real-life situation,” and the agreements “carry great weight. . . .” *Amalgamated Bank of N.Y. v. Amalgamated Trust & Sav. Bank*, 842 F.2d 1270, 1274 (Fed. Cir. 1988). Here, Applicant and Wealth Advisors—the parties most familiar with the use of their respective marks in the market place, and most interested in precluding confusion—have entered into a bilateral agreement designed to avoid it. A “mere assumption” that confusion is likely to occur, cannot “prevail against uncontroverted evidence from those on the firing line that it is not.” *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1363 (C.C.P.A. 1973) (“When those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted” against the finding of confusion).

Additionally, the parties have used their respective marks in commerce for a significant period of time without any evidence of actual confusion. Indeed, Applicant has used its WHITE

OAK & Design mark since at least as early as August 2014, and has used the WHITE OAK word mark (through its predecessor in interest) since at least as early as June 2007. During this entire period of time, Wealth Advisors used the Cited Mark in connection with the services stated in its application. Neither party is aware of any confusion in the marketplace, despite many years of continuous and concurrent use of their respective marks. Applicant respectfully submits that if the marks were previously capable of coexistence in commerce, the marks can continue to coexist without confusion.

Further, consumers of the parties' services are sophisticated and capable of distinguishing between the goods and services offered under the parties' respective marks. Consumers of business advisory, strategic planning, and financial consulting and advisory services are likely to exercise great care in choosing the provider of the services, putting thought and research into their decision. *See, e.g., Peoples Fed. Sav. Bank v. People's United Bank*, 672 F.3d 1, 14 (1st Cir. 2012) (affirming District Court's conclusion that "banking customers 'ordinarily gather information before choosing a bank and make their decision based on substantive factors (other than a bank's name)"); *First Nat. Bank in Sioux Falls v. First Nat. Bank, South Dakota*, 153 F.3d 885, 887 (8th Cir. 1998) ("[C]onsumers tend to exercise a relatively high degree of care in selecting banking services. As a result, customers are more likely to notice what, in other contexts, may be relatively minor differences in names."). Where circumstances suggest care in purchasing, the likelihood of confusion is minimized. *See In re N.A.D., Inc.*, 754 F.2d 996, 999-1000 (Fed. Cir. 1985) (because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion despite the similarity between the marks); *accord* TMEP §1207.01 (d)(vii). Sophistication of the consumers of the services offered by both Applicant and Wealth Advisors, weights against the likelihood of confusion.

Finally, the parties use distinctive logos to further differentiate the source of their respective services. Marks should be viewed in their entireties, taking into account their appearance, sound, connotation and commercial impression. *In re E.I. DuPont deNemours & Co.*, 177 USPQ 563, 567 (CCPA 1973); *Stone Lion Capital v. Lion Capital*, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014). As shown in the side-by-side comparison below, the Cited Mark prominently features an abstract, stylized outline of a leaf, along with the wording “WHITE OAKS WEALTH ADVISORS, INC.” contained inside the leaf. By contrast, Applicant’s mark consists of a detailed drawing of a white oak tree to the left of the wording “WHITE OAK.” The stark differences in the overall appearance and commercial of the two marks weighs against a likelihood of confusion.

Applied-for Mark	Cited Mark
	

In view of the foregoing, Applicant submits that consumers are not likely to believe that Applicant’s services emanate from the same source as the services offered under the Cited Mark, and requests that the suspension be lifted and the Applied-for Mark proceed to publication.

II. CLASS 35 SPECIMEN REFUSAL

In response to the Examining Attorney’s refusal of the Class 35 specimen, Applicant hereby amends the filing basis for Class 35 to intent to use under Section 1(b). This amendment has been submitted through TEAS.

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark:  **WHITE OAK**

Ser. No.: **88/032,055**

Applicant: **White Oak Global Advisors, LLC**

Examiner: **Yatsye I. Lee, Law Office 107**

LETTER OF CONSENT



This letter will serve as a letter of consent on behalf of White Oak Wealth Advisors (“Wealth Advisors”), owner of U.S. Trademark Application Serial No. 87/705,454 for the mark WHITE OAKS & Design, to White Oak Global Advisors (“Global Advisors”) regarding the use and registration of the WHITE OAK & Tree Design mark in Classes 35 and 36, which is the subject of Application Serial No. 88/032,055.

Global Advisors and Wealth Advisors acknowledge and agree that, for the reasons set forth below, it is unlikely that the sources of the goods and services offered by Wealth Advisors and Global Advisors, respectively, would be confused by consumers, and that it is unlikely that purchaser would be confused as to one party’s association, affiliation, or connection with, or endorsement, sponsorship, or approval of, the other party or its goods.

5. Each party believes, based upon years of knowledge in their industries, and based upon their respective knowledge of each other’s businesses, that no confusion, mistake, or deception exists or will exist between Global Advisors’ use or registration of the WHITE OAK & Tree Design mark for business advisory, business management, and financial consulting and investment services, and Wealth Advisors’ use and registration of the mark WHITE OAKS & Design for the business and financial services listed in Application Serial No. 87/705,454 for the reasons that:

a. Consumers of the parties’ services are sophisticated and capable of distinguishing between the goods and services offered under the parties’ respective marks; and

b. The parties use distinctive logos to further differentiate the source of their respective services. As shown in the side-by-side comparison below, Wealth Advisors’ mark prominently features an abstract, stylized outline of a leaf along with the wording “WHITE OAKS WEALTH ADVISORS, INC. By contrast, Global Advisors’ mark consists of a detailed drawing of a white oak tree to the left of the wording “WHITE OAK.”

Wealth Advisors	Global Advisors
	

6. The parties have used their respective marks in commerce for a significant period of time without any evidence of actual confusion. Indeed, Global Advisors has used its WHITE OAK & Tree Design mark since at least as early as 2014, and has used the wording WHITE OAK since at least as early as June 2007 in connection with the Class 35 and 36 services stated in its application. During this entire period of time, Wealth Advisors used its WHITE OAKS & Design mark in connection with its Class 35 and 36 services stated in its application. Neither party is aware of any confusion in the marketplace, despite over 12 years of continuous and concurrent use of their respective marks.

7. The parties agree that in the unlikely event they become aware or are informed of confusion arising from their respective uses of the WHITE OAKS & Design and WHITE OAK & Tree Design trademarks, they will inform one another of such confusion within a reasonable time period, and agree to work together in good faith to eliminate or minimize such confusion. Each party further agrees that it will not attempt to associate itself with the other party in any way in the future, and represents and warrants that it has not done so in the past.

8. The parties believe themselves to be in the best position to judge whether confusion is likely to result. For the reasons set forth above, neither party believes that confusion is likely to result from the use and registration of each party's respective trademark for their respective goods and services.

In view of the foregoing, each party hereby consents to the other's respective use and registration of the marks WHITE OAK & Tree Design and WHITE OAKS & Design for their respective goods and services, including the registration of Global Advisor's pending Application Serial No. 88/032,055.

Respectfully submitted,

**White Oak Global Advisors, LLC, a
Delaware limited liability company**

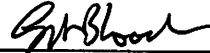
By: 

Name: Barbara J.S. McKee

Title: Manager

Date: 12/2/2019

**White Oaks Wealth Advisors, Inc., a
Delaware corporation**

By: 

Name: SHARON WOODWORTH

Title: CEO

Date: 12/11/19