

An Office Action issued on February 19, 2019. The Office Action provided for a time period of six months to respond or by August 19, 2019.

In the Office Action dated February 19, 2019, the Examiner raised the following issues:

1. Prior-Filed Applications
2. Section 2(d) Refusal – Likelihood of Confusion
3. Clarification Required – Entity Indefinite
4. Amendment Required – Identification of Services
5. Multiple-Class Application Requirements

In response, Applicant submits the following:

I. Prior Filed Applications

The Office Action indicates that the applied-for mark presents a potential likelihood of confusion with the mark ARC CAPITAL (Application Serial No. 87651412) and with the mark ARQ WEALTH ADVISORS (Application Serial No. 87910752).

In *E.I. du Pont de Nemours & Co.*, the U.S. Court of Customs and Patent Appeals set forth several factors which are relevant to a determination of a likelihood of confusion. 476, F.2d 1357 (C.C.P.A. 1973). Two factors which are considered to be key considerations in determining likelihood of confusion in the present case are as follows: 1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression and 2) the relatedness of the goods or services as described in the application and registrations.

With respect to the mark ARC CAPITAL, Applicant notes that a Notice of Default was entered on July 17, 2019 against the applicant of the mark ARC CAPITAL in an Opposition proceeding (Opposition No. 91248401). Therefore, there is a reasonable expectation that the application for the mark ARC CAPITAL will be abandoned.

With respect to the mark ARQ WEALTH ADVISORS, Applicant respectfully submits that Applicant's mark ARC and the cited mark ARQ WEALTH ADVISORS are sufficiently dissimilar such that a reasonable consumer would not likely be confused by the source or sponsorship of the services associated between the two marks. First, Applicant notes that the marks when considered in their entirety present a significant difference in sound and appearance particularly considering that the cited mark includes the additional words WEALTH and ADVISORS whereas the applied for mark only consists of the word ARC. In addition, the first word of the cited mark ARQ ends with the letter Q whereas the applied for mark, ARC ends with the letter C. According to TMEP §1207.01(b) in citing the Court of Appeals for the Federal Circuit, "The basic principle in determining confusion between marks is that the marks must be compared in their entirety...". Moreover, "...likelihood of confusion cannot be predicated on dissection of a mark, that is, only part of a mark." The marks when viewed in their entirety also provide markedly different commercial impressions in that the cited mark includes the term WEALTH ADVISORS which is descriptive and has a specific connotation, meaning and association with financial planning and investment advisory services, whereas Applicant's mark ARC does not include any additional terms which describe the type of services that are provided. According to TMEP §1207.01(b)(iii), "[a]dditions or deletions to marks may be sufficient to avoid a likelihood of confusion if the marks in their entirety convey significantly different commercial impressions...". In the present case, Applicant respectfully submits that the absence of additional descriptive terms within the applied for mark creates a significantly different commercial impression in that the services associated with the mark ARC are not readily apparent at first glance.

In view of the remarks set forth above, Applicant respectfully submits that a reasonable consumer viewing the two marks in their entirety and considering the differences noted above with respect to sound and appearance would readily conclude that the services associated with the cited mark and the applied for mark originate from different sources.

II. Section 2(d) Refusal – Likelihood of Confusion

The applied-for mark was rejected in view of an alleged likelihood of confusion with the mark ARC COMPREPORT in U.S. Registration No. 3480447. A review of the status of the trademark for ARC COMPREPORT reveals that the registration has been canceled because the registrant did not file an acceptable declaration under Section 8. Therefore, Applicant respectfully submits that the Section 2(d) Refusal based on likelihood of confusion with respect to the trademark for ARC COMPREPORT is moot.

III. Clarification Required – Entity Indefinite

The Office Action notes that the Applicant, Valmark Financial Group, LLC, includes the designation “LLC” for limited liability company in its name but was identified as a corporation within the initial application. Therefore, the Office Action requires that the Applicant specify whether it is a limited liability company or a corporation and to amend the application accordingly.

In response, Applicant respectfully submits that its legal entity status is that of a limited liability company organized under the laws of Ohio. An amendment to the application to reflect this status is provided with this response.

IV. Identification of Goods and Services

The Office Action indicates that the identification of goods and services is indefinite and must be clarified.

In response, Applicant has elected class 36 and hereby amends the description of goods/services for class 36 to adopt the classification and identification proposed by the Examining Attorney. The amendment to the description of goods/services is as follows:

Class 36: Financial planning services for retirement

Because the description of goods and services has been amended in accordance with the Examining Attorney’s recommendation, Applicant respectfully requests that the rejection of the identification of goods and services be withdrawn.

V. Multiple-Class Application Requirements

The Office Action indicates that the application references services based on use in commerce in multiple international classes, namely, international classes 35, 36 and 45. In response, Applicant has elected to pursue registration in class 36 for “financial

planning services for retirement”. Applicant notes that the current specimen on file has been deemed acceptable for class 36. In view of the fact that Applicant has elected to pursue registration for a single class, namely class 36, for which an acceptable specimen is on file, Applicant respectfully submits that the refusal based on multiple class requirements has been rendered moot.

CONCLUSION

Having thus responded to all outstanding issues raised in the Office Action, Applicant respectfully requests that Application No. 88/212,642 be approved.