

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
<b>ACCESS TO CAPITAL FOR</b>	)	
<b>ENTREPRENEURS, INC.</b>	)	Attorney: <b>Mildred Black</b>
	)	
Serial No. <b>88/210,785</b>	)	Law Office: <b>121</b>
	)	
Filed: <b>November 29, 2018</b>	)	
	)	
Mark: <b>ACE</b>	)	
	)	

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**RESPONSE TO OFFICE ACTION**

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Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

In response to the Office Action dated March 7, 2019, Applicant respectfully submits the following arguments in support of the application to register the subject trademark.

**NO LIKELIHOOD OF CONFUSION**

A likelihood of confusion inquiry is made on a case-by-case basis using the *du Pont* factors. *See In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563, 476 F.2d 1357 (CCPA 1983). While not every factor is necessarily relevant or of equal weight, the Trademark Office must consider pertinent evidence regarding any factor entered into the record. *Id.* at 568–69. The most compelling factors, namely the similarity of the goods and similarity of the marks may be outweighed by other factors, especially where there is probative fact evidence. *See* TMEP 1207.01.

The Examining Attorney has asserted that Applicant’s mark is likely to cause confusion with the three federal registrations, specifically because of perceived similarity of the marks and

the perceived similarity of the goods. Applicant contends that based upon the totality of the evidence in the record, there is no likelihood of confusion as to source of the goods. In this case, the services of the three cited registrations are marketed through channels that are different enough to obviate any likelihood of confusion.

Applicant submits the following arguments to address the Examining Attorney's assertions.

A. Cited Registration (Reg. No. 2155964) for "ACE"

*I. Different Channels Of Trade*

According to TMEP Section 1207.01(a)(i), "...if 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. This Section cites, among others, *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board's dismissal of opposer's likelihood-of-confusion claim, noting "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" though both were offered under the COACH mark).

Applicant is a non-profit organization directed towards providing loans and business development assistance for small business owners with the goal of creating job opportunities.

In contrast, the cited registration is owned by a loan company that offers "short-term consumer loans" to individuals "who does not use traditional banking services on a regular basis" (quotes taken from Ace Cash Express website). *See Exhibit A*. Examples of the services

the cited registration provides includes payday loans, check-cashing services, title loans, installment loans, and other consumer financial products and services.

Screenshots of the Applicant's website and the Registrant's website are attached hereto as Exhibit A to illustrate the differences in the services provided.

Clearly, the consumer base for these products is going to be very different given the ways the products are marketed.

## *II. Actual Confusion*

The lack of evidence of actual confusion weighs strongly against a finding of any likelihood of confusion where, as here, there *should have been* confusion if there was going to be confusion. "While evidence of actual confusion is highly probative of [the] issue [of likelihood of confusion], its absence is not, ***unless it is accompanied by evidence demonstrating that in light of the parties' actual business activities, confusion, if likely, would have occurred.***" *Ziebart International Corp. v. Z Tech Rustproofing, Car Care, & Accessories, LLC*, Opposition No. 91158809 to Application No. 78149388, 2009 WL 129481, at \*12 (TTAB Jan. 13, 2009) (emphasis added). In fact, courts have routinely found that a lack of likelihood of confusion weighs against a finding of likelihood of confusion where, as here, the parties have co-existed in the same market for years without any confusion arising. *See Cohn v. Petsmart, Inc.*, 281 F.3d 837, 842-43 (9th Cir. 2002) ("Here, however, the parties used the same trademark in the same city for six years to market closely-related goods and services. Under those unusual circumstances, some evidence of actual confusion should have become available if Petsmart's coexisting use had created a genuine likelihood of confusion."); *Plus Prods. v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1006 (2d Cir. 1983) (finding that "no evidence of confusion over a three-year period, during which substantial sales have occurred, is a strong indicator that

likelihood of confusion is minimal”); *Aktiebolaget Electrolux v. Armatron Intern., Inc.*, 999 F.2d 1, 4 (1st Cir. 1993) (finding that “the weak evidence of actual confusion weighs quite heavily against a finding of likelihood of confusion. While a showing of actual infringement is not required to establish infringement, an absence of actual confusion, or a negligible amount of it, between two products after a long period of coexistence on the market is highly probative in showing that little likelihood of confusion exists.”); *Pignongs S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 490 (1st Cir. 1981) (finding that four years of coexistence with only a “single, feeble and indirect example of possible consumer confusion” “strongly indicates” that there is no likelihood of confusion).

Here, Applicant and Cited Registrant have co-existed for more than two decades with no presented evidence of actual confusion. Because Applicant and Cited Registrant have co-existed for this length of time without evidence of any actual confusion, the lack of actual confusion is strong evidence that there is no likelihood of confusion.

B. Cited Registration (Reg. No. 1801677) for “ACES”

*II. Different Nature of Services and Trade Channels*

The Examining Attorney found that the services of Applicant and Registrant are closely related, providing evidence from the internet to show that “the same entity commonly provides the relevant services and markets the services under the same mark.”

However, Applicant’s services are not so similar to Registrant’s as to cause a likelihood of confusion, particularly since the marks are not visually identical. While both Applicant and Registrant provide services, the fact that the parties offer goods in similar broad fields, “is not sufficient to demonstrate that a genuine issue exists concerning likelihood of confusion.” *Id.* at

1391, (*quoting Astra Pharma. Prods. V. Beckman Instruments*, 220 USPQ 786, 790, 718 F.3d 1201 (1st Cir. 1983)).

Registrant's and Applicant's actual services descriptions show that they cover two very different types of services. For example, Reg. No. 1801677 for "ACES" is owned by Fannie Mae and is an acronym that stands for "Alternative Credit Enhancement Securities." These Alternative Credit Enhancement Securities are "a type of multiclass mortgage-related security in which interest and principal payments from multifamily mortgages are structured into separately traded securities."<sup>1</sup> Applicant respectfully asserts that these specific type of mortgage-related securities are not the same service as Applicant's loans and business development assistance for small business owners with the goal of creating job opportunities for underserved communities.

Screenshots taken from Registrant's website are attached hereto as Exhibit B to illustrate the differences in the services provided.

Thus, Registrant and Applicant offer different services, through different trade channels, so any similarity between the services and trade channels is insufficient to establish a likelihood of confusion.

### C. Cited Registration (Reg. No. 5023031) for "ACE PORTAL"

#### *II. Different Nature of Services and Trade Channels*

For similar reasons as cited registration 2155964 for "ACE" and cited registration 1801677 for "ACES," Registrant's and Applicant's actual services descriptions show that they cover two very different types of services. For example, Reg. No. 5023031 for "ACE PORTAL" pertains to "private placements and syndication of equity securities, loans, debt securities, equity-linked securities and limited partnership and other membership interests in private equity,

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<sup>1</sup> *Basics of Structured Transactions: Megas, REMICs, Grantor Trusts and SMBS Securities* (May 2017), <http://www.fanniemae.com/resources/file/mbs/pdf/basics-structured-transactions.pdf>.

venture capital and hedge funds; crowd funding services, namely, the matching of potential investors with a variety of companies and entities seeking funding.” Applicant respectfully asserts that services like “venture capital, hedge funds, crowd funding services, etc.” are not the same service as Applicant’s loans and business development assistance for small business owners with the goal of creating job opportunities.

D. The Widespread Registration of ACE-formative Marks in the Record, Including Registrations for Identical and Closely Related Goods, Demonstrates the Weakness of the Cited ACE-related Marks

The Federal Circuit has recognized that third party registrations can provide “powerful” evidence that a mark is weak, even when the scope of the use is not shown. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1373–1374, 116 U.S.P.Q.2d 1129, 1136 (Fed. Cir. 2015) (“[E]xtensive 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.”) quoting: *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 1339, 115 U.S.P.Q.2d 1671 (Fed. Cir. 2015) (vacating TTAB. finding that confusion was likely because the TTAB improperly discounted the third party usage evidence on the ground that there were no specifics as to the extent of sales or promotional efforts behind these uses, noting: “[t]he fact that a considerable number of third parties use similar marks was shown in uncontradicted testimony.”). Where, as here, the large number of third party registrations is well documented, the evidence supports the conclusion that the term is weak as a mark. See *Western Publishing Co. v. Rose Art Industries, Inc.*, 910 F.2d 57, 15 U.S.P.Q.2d 1545 (2d Cir. 1990) (more than 2,000 registrations incorporating the term at issue, including 113 applying to related goods and services, meant mark was weak); *Estee Lauder, Inc. v. The Gap, Inc.*, 108 F.3d

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1503, 42 U.S.P.Q.2d 1228 (2d Cir. 1997) (holding the term at issue was “not wholly original” and district court conclusion that mark was “moderately strong” was clearly erroneous in light of more than 70 registrations, pending applications for registration for renewal, or publications including the term). Here, the record also reflects more than 70 live U.S. Trademark Registrations and Applications in International Class 36—the same class covered by Applicant’s Mark and Opposer’s marks— that include ACE-formative marks. These registrations are presented below in Exhibit C.

### **CONCLUSION**

The foregoing is believed to be a full response to the Office Action. If the Examining Attorney desires to discuss any of these points by telephone to expedite the processing of this application, he is invited to call the undersigned at the number listed below.

Respectfully submitted,

/James H. Johnson, Jr./

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ES Docket: 99050-3626

JB/JHJ

## EXHIBIT A ACTUAL USE – DIFFERENT TRADE CHANNELS

### Applicant's Actual Use

ACE

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### SMALL BUSINESS LOANS

It doesn't get any easier than this. To apply for a loan, our process is simple. All you have to do is apply online. You'll be asked to provide the required documentation to ACE by fax, mail, email, or in person. A final decision will be made as quickly as possible because we mean business, just like you. The loan approval process will depend on how complete your application is and our receipt of all proper documentation in a timely manner. ACCESS TO CAPITAL FOR ENTREPRENEURS (ACE) is certified as a Community Development Financial Institution (CDFI). We are a nonprofit organization that provides loans to start and grow businesses in Georgia. Our mission is to offer our borrowers the business development resources to create sustainable businesses.

Our goal is your success.

**LOANS AVAILABLE UP TO \$50,000**

Each application will be considered on the basis of the company's unique financial needs.

- Minimum credit score of 600
- Interest rate based on market
- Terms are typically less than 6 years
- Collateral is required
- \$50 non-refundable application fee
- Loan proceeds can be used for equipment, inventory, working capital or for business or franchise acquisition
- Documentation is required.

**"WITHOUT ACE, THE CHANCES OF STARTING MY BUSINESS UP WOULD HAVE BEEN GREATLY REDUCED. THEY GO ABOVE AND BEYOND THE CALL OF DUTY."**

**MILES DAVIS,  
OWNER – CROSSFIT  
ROSWELL, GEORGIA**



## WELCOME TO ACE!

Are you small business in Georgia looking for a business loan?

In addition to taking care of your capital needs, ACE provides coaching & connections to help make your business a success!

[Apply now or learn more about our loans »](#)

The mission of Access to Capital for Entrepreneurs, Inc. (ACE) is to provide community economic development to underserved people and communities. ACE is a non-profit organization that provides loans and business development resources to help its borrowers create and grow sustainable businesses which generate jobs.

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### BUILDING YOUR BUSINESS

We assist established companies, as well as, start-ups, to help them achieve sustainability. You can easily and securely apply for a loan on our

[Get Business Advice](#)

### PERSONALIZED SUPPORT

ACE distinguishes itself from other lenders with our Business Advisory Services. We want to help our clients and their business thrive! Start

[View Our Events](#)

### EDUCATIONAL EVENTS

ACE Offers ongoing support for our clients through our resource center, as well as, special events and training sessions in English and Spanish. Click

[Make A Donation](#)

### GIVE THE GIFT OF OPPORTUNITY

Your tax-deductible donation will help ACE increase access to economic opportunity for small business owners and contribute to improved economic

## Cited Registration (Reg. No. 2155964) for “ACE” Actual Use

### Why ACE Cash Express?

We make it easy to obtain cash when you need it most. ACE Cash Express, Inc. is a leading financial services provider, specializing in short-term consumer loans, bill pay, and prepaid debit card services, as well as the largest owner operator of check cashing stores in the United States. In business since 1968, ACE Cash Express focuses on serving consumers seeking alternatives to traditional banking relationships by gaining convenient, immediate access to financial services.

### What is a Credit Services Organization (CSO) and Credit Access Business (CAB)?

Depending on the state, a Credit Services Organization (CSO) is a company that earns compensation by, among other things, helping consumers obtain loans from a lender. A Credit Access Business (CAB) is a type of CSO that helps people obtain payday loans and title loans from a lender. CSOs are not lenders and do not make loans. ACE Credit Access LLC is a CSO and a CAB that helps consumers obtain loans from an independent third-party lender. FSH Credit Services LLC is a CSO that helps consumers obtain loans from an independent third-party lender.

#### List of states where ACE Cash Express is the lender:

Arizona  
California\*  
Colorado  
Delaware  
Florida  
Georgia  
Idaho  
Indiana  
Kansas  
Louisiana  
Minnesota†  
Missouri  
New Mexico  
Oklahoma  
Oregon  
South Carolina  
Tennessee  
Virginia

*\*Installment Loans will be arranged or made pursuant to Department of Business Oversight California Financing Law.*

*†Loans in Minnesota made by ACE Minnesota Corp.*

#### List of states where ACE Credit Access LLC is a CSO and a CAB:

Texas

#### List of states where FSH Credit Services LLC is a CSO:

## Traditional banking is not the only way.

If you're someone who does not use traditional banking services on a regular basis, you are considered part of the 'under banked' population. Is that a bad thing? Absolutely not. Traditional banking services aren't the only way to manage your finances.

ACE Cash Express is built on the principle that consumers should have a choice in how they handle their financial service needs. You may choose to avoid banks, credit unions, and other similar financial institutions entirely or you might choose to use a mixture of traditional and alternative financial services. Either way, it's up to you.

Our goal is to offer you the types of services you want access to without having to go to a bank or credit union. You can choose ACE Cash Express for:

- Payday Loans
- Installment Loans
- Card Services
- Prepaid Debit Cards
- Check Cashing
- Bill Payment
- Money Orders
- Money Transfers
- ATM Services
- Title Loans
- and more.

Whatever you decide your relationship with ACE should be, you can have confidence in us based on our 50+ years of serving customers across the country. We believe our history of serving more than 38 million customers is proof positive that alternative financial services can work for you.

We invite you to learn more about ACE Cash Express by exploring our website. Use the search tool at the top of this page to find an Ace store near you. Whether you need a short-term loan or a place to pay your monthly bills, ACE is always on hand to serve you. It's what we've been doing for more than 50 years.

## EXHIBIT B

interest rate of the index, the yield of an inverse floating-rate class because its interest rate can fall to zero percent.

Moreover, changes in the level of the index may not correlate with changes in prevailing mortgage interest rates. Some indices used for floating-rate and inverse floating-rate classes are more sensitive to fluctuations in short-term rates than others. For example, LIBOR is very sensitive to short-term rates. Mortgage interest rates usually respond to longer-term rate movements. It is possible that lower prevailing interest rates, which might be expected to result in faster prepayments, could occur at the same time as an increase in the level of the index. Under these high-prepayment/high-index situations, investors in inverse floating-rate classes may not recoup their initial investment, resulting in an actual loss on the investment.

Any REMIC transaction that contains a floater will also contain an inverse floater tied to the same index.

### Multifamily REMICs

Fannie Mae Multifamily REMICs are also known in the marketplace as **ACES**<sup>®</sup> (Alternative Credit Enhancement Securities) or FNA's, as they are known on Bloomberg. Multifamily REMICs are a type of multiclass mortgage-related security in which interest and principal payments from multifamily mortgages are structured into separately traded securities. The primary source of underlying collateral is Fannie Mae DUS securities. Structures may include straight-forward pass-through or sequential structures, with fixed-rate classes and/or floater and inverse floater classes.

to meet investor demand. GEMS REMICs are distributed to the marketplace through a dealer syndicate and trade regularly in the secondary market.

### WAS REMICs

Wisconsin Avenue Securities (WAS) is the trade name for Fannie Mae senior/subordinated REMIC security in which both cash flows and credit losses are passed through to investors. Collateral may include either whole loan single-family or whole loan multifamily mortgages.


The senior bonds pass through principal and interest to investors, but do not absorb any credit losses because they are fully guaranteed by Fannie Mae.

The subordinated bonds receive principal and interest payments as well. However, if there is a loss, they will absorb credit losses from the collateral by having their balances reduced when losses are realized.

Fannie Mae guarantees the timely payment of principal and interest to investors for only the senior bonds. Fannie Mae does not guarantee the subordinated bonds issued as Wisconsin Avenue Securities (WAS). Therefore, investors in the subordinated bonds bear credit risk.



## EXHIBIT C ACE-Related Registrations



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Current Search: S2: (live)[LD] AND (ace)[COMB]and (036)[ic] docs: 73 occ: 300

#	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	88200548		ACE CASH LOANS	TSDR	LIVE
2	88279663		THE RETIREMENT ACE	TSDR	LIVE
3	88508198		ACELEND	TSDR	LIVE
4	88308863		ARCHIMEDES & ACES	TSDR	LIVE
5	88210785		ACE	TSDR	LIVE
6	88015649	5675048	ACE	TSDR	LIVE
7	87349469		ACE FLARE	TSDR	LIVE
8	87312922		ACESHARES THE ETF INCUBATOR	TSDR	LIVE
9	87312906		ACESHARES	TSDR	LIVE
10	87952461		UNIVERSAL ACE	TSDR	LIVE
11	87186646		ANCIENT ACES	TSDR	LIVE
12	87551058	5509852	FOUNDATION FOR ACE	TSDR	LIVE
13	87526810	5426581	ACE TITLE LOAN	TSDR	LIVE
14	86369983		KIT AND ACE	TSDR	LIVE
15	86661171	5177077	ACESPLUS	TSDR	LIVE
16	86661147	5177076	ACES+	TSDR	LIVE
17	86924625	5174656	PC-ACE	TSDR	LIVE
18	86296893	5023031	ACE PORTAL	TSDR	LIVE
19	86698646	4940623	ACE REALTY	TSDR	LIVE
20	86606213	4887004	ACE 4D	TSDR	LIVE
21	86238238	4767000	ACE RECALL PLUS	TSDR	LIVE
22	86360211	4707963	ACE	TSDR	LIVE
23	85725611	4568919	ACES	TSDR	LIVE
24	85358634		ACE	TSDR	LIVE
25	85358640		ACE	TSDR	LIVE
26	85358645		ACE THE HUB FOR PRIVATE PLACEMENTS.	TSDR	LIVE
27	85748231	4353311	ACE	TSDR	LIVE
28	85273322	4222659	ATP ACES FOR CHARITY	TSDR	LIVE

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29	85357851	4105182	ACE MOTOR ACCEPTANCE CORP. BHPH BUY HERE PAY HERE IN A BOX	TSDR	LIVE
30	85010721	3879663	ACES - ADVISOR COMMITMENT TO 401(K) EDUCATION AND SERVICE	TSDR	LIVE
31	85007333	4020271	ACE WORLDVIEW	TSDR	LIVE
32	85057890	3950266	ACES BUILDERS' WARRANTY	TSDR	LIVE
33	85873858	4552765	ACE INSURED.	TSDR	LIVE
34	85781504	4445030	ACE INSURED	TSDR	LIVE
35	85635423	4366933	ACE ACCELERATOR	TSDR	LIVE
36	78629432	3111643	AVENUE OF ACES	TSDR	LIVE
37	78563087	3070656	ACE SPECTRA	TSDR	LIVE
38	78441524	3034729	ACE DISASTER MORTGAGE PROTECTION	TSDR	LIVE
39	78316415	3005664	ACE TANKSAFE	TSDR	LIVE
40	77920597	4023462	ACE GPS	TSDR	LIVE
41	77939678	3865879	COMMUNITY ACES	TSDR	LIVE
42	77911685	3927524	ACE MOTOR ACCEPTANCE CORPORATION	TSDR	LIVE
43	77769664	3830412	ACE BUSINESS BROKERS	TSDR	LIVE
44	77218123	3861219	ACE BERMUDA INTERNATIONAL	TSDR	LIVE
45	77459954	3585870	ACE COMMERCIAL RISK SERVICES	TSDR	LIVE
46	77389373	3673855	ACE PRIVATE RISK SERVICES	TSDR	LIVE
47	77337953	3699582	ACE PLATINUM PORTFOLIO	TSDR	LIVE
48	77476812	3842090	ACES ADVANTAGE	TSDR	LIVE
49	77476776	3838408	ACES	TSDR	LIVE
50	76719389	5206680	ACE ELITE	TSDR	LIVE

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