

Response to Section 2(d) refusal:

Applicant respectfully disagrees that the cited G GEMSTONE mark is a bar to registration of the GEMSTONE FINANCIAL ENGINEERING service mark. The overall differences between the marks, services, channels of trade and consumers are such that confusion is not likely.

The Trademark Office has impermissibly parsed out and ignored part of Applicant's mark, and has relied on the alleged similar components of the marks to find the marks are confusingly similar. This dissection of Applicant's mark is contrary to established precedent. When viewed in its entirety, GEMSTONE FINANCIAL ENGINEERING is not confusingly similar to the cited mark.

It is well settled that marks must be compared as a whole, rather than by breaking them apart and looking at their component parts for comparison. *Recot Inc. v. M.C. Becton*, 54 USPQ2d 1894 (Fed. Cir. 2000) (reversing the Board for improperly dissecting marks to determine if the commercial impression was confusing); *In re National Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985) ("Likelihood of confusion cannot be predicated on dissection of a mark, that is, only on part of a mark."); *Massy Junior College, Inc. v. Fashion Institute of Technology*, 181 USPQ 272, 273-274 (CCPA 1974) ("That the marks must be considered in their entireties in determining whether there is likelihood of confusion or mistake is a basic rule in comparison of marks.") It is the impression as a whole created by the mark that is important.

Applicant's mark GEMSTONE FINANCIAL ENGINEERING is different in appearance, sound and meaning from the cited mark. While both marks may incorporate the word "Gemstone", that is where any similarity ends. When the marks are viewed in their entireties, as they must, the overall differences between the marks avoids confusion. Applicant's mark consists of three distinct words; the cited mark is a letter and a word. The marks also sound different when they are spoken. Phonetic differences can be enough to avoid confusion. *The Coca-Cola Co. v. Essential Products Co., Inc.*, 164 USPQ 628 (CCPA 1970).

Applicant's mark also has a different meaning and creates a different commercial impression from the cited mark, particularly when the marks are considered in relation to the relevant services. Using the definition in the Office Action, "Financial Engineering" means using "math to solve financial problems." The allusion is that consumers can solve their financial problems and increase the value of their investments by using Applicant's services. This connotation is supported by the definition of "Financial Engineering" relied on by the Trademark Office, and Applicant's services, which feature a "fee structure that transfers risk from investor to investment manager." The same commercial impression is not created by the cited mark.

This difference in commercial impression is enough to find no likelihood of confusion. The Trademark Trial and Appeal Board has found that a difference in commercial impression is sufficient to find no confusion, even if the marks at issue have phonetic and visual similarities. *In re Nobody's Perfect Inc.*, 44 USPQ2d 1054, 1057 (TTAB 1997) ("[N]otwithstanding the substantial phonetic and visual similarities in the respective marks and the closely related nature of applicant's services and registrant's goods, ..., in light of the significant differences in connotation, [NOBODY'S PERFECT] is sufficiently distinguishable in commercial impression from [NO BODY'S PERFECT] that confusion as to origin or affiliation is not likely.")

The overall differences between the marks by itself can support the conclusion that confusion between Applicant's mark and the cited mark is not likely. *Kellogg Co. v. Pack'em Enterprises, Inc.*, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive."); *Keebler Co. v. Murray Bakery Products*, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) (the "more important fact for resolving the issue of likelihood of confusion ... is the dissimilarity in commercial impression between the marks.") Here, all three elements - appearance, sound, and commercial impression - are different. Confusion is not likely.

There are however other factors that favor a finding of no likelihood of confusion. Applicant's services as amended are different from the services covered by the cited mark. Applicant offers "Securities, futures, and derivatives funds investment services featuring a fee structure that transfers risk from investor to investment manager." These services are considerably different from "Real estate brokerage; real estate investment services; real estate management of resort properties; real estate management services; leasing of real estate." Applicant's funds investment services as amended are for securities, futures, and derivatives. Applicant's services do not cover, and are not related to, real estate investment services.

A further factor that favors a finding of no likelihood of confusion is the sophistication of the consumers of the respective services. The respective services are the type that would be purchased after careful thought and investigation. Applicant's services are not purchased on a whim without first determining in advance the nature and source of the services and the credentials of the providers of the services. Purchasers of Applicant's services are also sophisticated. In fact, purchasers of Applicant's services are required to meet certain regulatory standards for financial sophistication due to Applicant's registrations with its government regulators, the Securities and Exchange Commission, the Commodity Futures Trading Commission, and the National Futures Association. Where as here the services are purchased after careful consideration and the consumers are sophisticated, confusion as to source is unlikely. *In re Homeland Vinyl Products, Inc.*, 81 USPQ2d 1378, 1383 (TTAB 2006) ("notwithstanding the identity of the goods, that considering the narrow scope of protection to which registrant's mark is entitled and the relative sophistication of the purchasers for the goods, the marks are sufficiently dissimilar to avoid a likelihood of confusion").

A balancing of the relevant factors clearly demonstrate that Applicant's GEMSTONE

FINANCIAL ENGINEERING mark is not likely to be confused with the cited registration. The marks are different, the services are unrelated, are not competitive and are not impulse purchases, and the consumers are sophisticated. Under these facts, the cited mark is not a bar to registration of GEMSTONE FINANCIAL ENGINEERING for the services as amended.

With respect to the pending application for GEMSTONE TOKEN, Applicant elects to wait to submit arguments at this time. Applicant understands that its election does not limit its right to address the issue at a later date should a refusal under Section 2(d) issue.

For all the foregoing reasons, Applicant respectfully requests that the Section 2(d) refusal and the cited registration be reconsidered and withdrawn. And, in view of the amendment of Applicant's services, Applicant requests that the citation of the pending application be reconsidered and withdrawn.