

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79058324
LAW OFFICE ASSIGNED	LAW OFFICE 113
MARK SECTION (no change)	
ARGUMENT(S)	
<p>Applicant is submitting this Request for Reconsideration from Final Refusal concurrently with an appeal to the Trademark Trial and Appeals Board (TTAB).</p> <p>The Examining Attorney has maintained her refusal to register Applicant's mark because of SAI® (Reg. No. 3,178,053) for "litigation consultancy", owned by Statistical Analysis, Inc. Applicant respectfully maintains its position that there is no likelihood of confusion between SAI for "litigation consultancy" and SAI GLOBAL, in light of further amendments to its descriptions of goods and services, and for the reasons given below.</p> <p>The DuPont factors govern the analysis of likelihood of confusion. <u>In re E.I. Du Pont de Nemours & Co.</u>, 476 F.2d 1357 (C.C.P.A. 1973). Two of the thirteen DuPont factors—similarity of the appearance of the marks and similarity of the goods and services—have been cited in the Examining Attorney's refusal to register Applicant's mark. However, Applicant asserts that a third DuPont factor is not only relevant, but should be given significant weight in the analysis, and hereby provides additional evidence in support of its position.</p> <p>The paramount factors used to analyze whether likelihood of confusion exists between Applicant's and Registrant's marks should be the conditions under which and the buyers to whom sales are made. Registrant Statistical Analysis, Inc. claims "litigation consultancy" in its registration. Litigation consultants help attorneys prepare for litigation. They may work with attorneys to develop overall case strategies and tactics, assist in preparing courtroom exhibits, perform jury analysis, conduct mock trials, manage or examine documents, and provide expert testimony and analysis in technical areas outside the scope of expertise of attorneys. (See Exhibits A-1 through A-3) As a litigation consultant, Registrant Statistical Analysis, Inc. offers quantitative analysis and expert witness support to law firms who are involved in litigation. To this end, it provides expert witnesses for analysis, depositions, and court testimony involving statistical issues of construction defects, discrimination, personal injury, fraud, patent infringement, defective product claims, and a variety of economic issues. It also conducts surveys regarding consumer satisfaction, likelihood of confusion, change of venue, product interest, political opinion, and name bias, among others. It provides consulting support for studies of social and environmental conditions and the probable effects of changes in such conditions. Finally, it has</p>	

produced studies on a variety of military-related matters. (see Exhibits B-1 through B-9)

However, because “litigation” necessarily involves legal representation, it therefore follows that the market for Registrant’s claimed “litigation consultancy” services will be lawyers and law firms exclusively. Indeed, examination of Registrant’s client list on its website indicates that almost 100% of them are attorneys and law firms (see Exhibit B-9). On the other hand, Applicant’s clients include industrial businesses ranging from large global corporations to single site organizations for which it provides information services and solutions for managing risk, support for complying with governmental and industry mandates and guidelines, and facilitating business improvement (see Exhibit C-1). Its services are not directed at lawyers, law firms, or entities being represented by lawyers.

Applicant’s and Registrant’s customers are completely distinct markets, making consumer confusion highly unlikely, if not impossible. Moreover, Applicant’s and Registrant’s consumers are both sophisticated, and are apt to exercise significant care and deliberation in making their purchasing decisions. Because of this, any similarity in the marks themselves is significantly outweighed by consumer sophistication, their deliberation in making a purchasing decision, and the fact that Applicant and Registrant serve completely distinct markets. Likelihood of confusion between Applicant and Registrant’s marks is therefore exceedingly improbable under these conditions.

Applicant also respectfully disagrees with Examiner’s position that there is overlap in the scope of services encompassed within “litigation consulting”. Specifically, Applicant respectfully disagrees with the Examining Attorney’s assertion that its advisory and consultancy services in Class 45 would include litigation advisory and consultancy services relating to various laws and regulations, because this would amount to the unlicensed practice of law. As Applicant has argued above, “litigation consultancy” encompasses support services that are explicitly restricted to litigation. However, litigation consultants do not offer advice regarding laws, regulations, or regulatory compliance to its clients. Advising clients who are involved in litigation regarding laws and regulations is properly the province of an attorney or a law firm, not the litigation consultant. To that extent, Registrant is prohibited by law from offering either legal or regulatory advice to clients involved in litigation. Rather, litigation consultants offer expert advice and technical support to attorneys and law firms in areas other than laws and regulations. Moreover, Applicant has amended its description of goods and services to clarify that, while it reviews and advises clients regarding government and industry mandated best practices and standards, this does not amount to providing legal services or rendering legal advice, as such terms are understood in the United States. Applicant provides advice regarding industrial laws, regulations, and other government and industry mandated best practices and standards in the same manner that an accounting firm would advise business clients regarding tax and accounting issues.

Examiner cites similarity of the marks as another reason for refusing registration. While acknowledging that SAI is a common element of both marks, and that the word element in a composite mark is more likely to be impressed upon a purchaser’s memory, Applicant asserts that the SAI® and SAI GLOBAL are nevertheless distinguishable and that any similarity in the word element is significantly outweighed by the conditions under which purchases of goods and services are made. A consumer visiting Registrant’s homepage www.stat-analysis.com quickly learns that SAI stands for “Statistical Analysis, Inc.” The consumer’s mental association with statistics is further reinforced by the blue bell curve design element accompanying the word element.

On the other hand, Applicant’s mark is derived from its corporate name, Standards Australia

International, Ltd. (see Exhibit C-2). Applicant agrees with Examiner that although the disclaimed term "GLOBAL" is given less distinguishing significance, it cannot be ignored entirely. Applicant asserts that the word GLOBAL does serve to distinguish the marks because the disclaimed term suggests to the consumer the global nature of applicant's operations. Thus, consumers who compare Registrant's logo with Applicant's word mark would likely generate an association with statistical analysis from the former, and an association with a multi-national company from the latter.

Finally, Applicant has further amended its description of goods and services in an attempt to address the Examining Attorney's objections based on similarity of certain services. Specifically, although Applicant has argued above that there is no conflict between it and Registrant's goods and services as they relate to "law", "regulations", and "regulatory compliance" as a field or subject matter, it has broken out these specific goods and services in the event of their final rejection by the Examining Attorney and the TTAB, in order to preserve any remaining non-objectionable fields or subject matter.

Although no one DuPont factor is dispositive in determining whether there is a likelihood of confusion, Examiner has based her rejection primarily on the similarity of the marks themselves and similarity of the goods and services. Applicant respectfully submits, however, that conditions under which and the buyers to whom sales are made should weigh very heavily in the analysis. Likelihood of confusion does not exist between Applicant's and Registrant's marks because of the distinct markets in which they operate, the sophistication of their customers, and the care and deliberation used by their customers in making contracting and purchasing decisions. Applicant respectfully urges the Examining Attorney, in light of its further amendments, arguments, and evidence submitted herewith, to reconsider and withdraw her final rejection, and approve the mark for publication at the earliest opportunity.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	<u>evi 747245226-144418721 . Exhibit A-1.pdf</u>
CONVERTED PDF FILE(S) (1 page)	<u>\\TICRS\EXPORT10\IMAGEOUT10\790\583\79058324\xml2\RFR0002.JPG</u>
ORIGINAL PDF FILE	<u>evi 747245226-144418721 . Exhibit A-2.pdf</u>
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ORIGINAL PDF FILE	<u>evi 747245226-144418721 . Exhibit A-3.pdf</u>
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ORIGINAL PDF FILE	<u>evi 747245226-144418721 . Exhibit B-1.pdf</u>
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ORIGINAL PDF FILE	<u>evi 747245226-144418721 . Exhibit B-3.pdf</u>
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ORIGINAL PDF FILE	<u>evi 747245226-144418721 . Exhibit B-8.pdf</u>
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ORIGINAL PDF FILE	<u>evi 747245226-144418721 . Exhibit B-9.pdf</u>
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ORIGINAL PDF FILE	<u>evi 747245226-144418721 . Exhibit C-1.pdf</u>
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DESCRIPTION OF EVIDENCE FILE	Exhibits A-1 through A-3: background information on services offered by litigation consultants; Exhibits B-1 through B-9: excerpts from Registrant Statistical Analysis, Inc.'s website Exhibits C-1 through C-2: excerpts from Applicant SAI Global Ltd's website
GOODS AND/OR SERVICES SECTION (009)(current)	
INTERNATIONAL CLASS	009
DESCRIPTION	
Downloadable on-line electronic publications in the field of business, business systems, auditing, finance, law, business improvement, environmental issues, education and training, regulation, regulatory compliance, quality management, risk management, ethics, health and safety, information security, quality systems and standards, technical information about military parts, logistics, metal grades, properties, suppliers and manufacturers, non-metallic materials, products and manufacturers, and common intelligence; software for the management of standards and technical information; pre-recorded CDs, DVDs and other discs and recording media, namely, optical discs and cassette tapes, all in the field of business, finance, law, business improvement, environmental issues, education and training, regulation, regulatory compliance, quality management, risk management, ethics, health and safety, information security, quality systems and standards, technical information about military parts, logistics, metal grades, properties, suppliers and manufacturers, non-metallic materials, products and manufacturers, and common intelligence; pre-recorded CDs, DVDs and other discs and recording media namely optical discs and cassette tapes, all containing information, databases and updates relating to standards and technical information about business, finance, law, business improvement, environmental issues, education and training, regulation, regulatory compliance, quality management, risk management, ethics, health and safety, information security, quality systems and standards, technical information about military parts, logistics, metal grades, properties, suppliers and manufacturers, non-metallic materials, products and manufacturers, and common intelligence	
GOODS AND/OR SERVICES SECTION (009)(proposed)	
INTERNATIONAL CLASS	009
DESCRIPTION	
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