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Subject: U.S. TRADEMARK APPLICATION NO. 86030490 - FINANCIALLY WISE WOMEN - N/A - EXAMINER BRIEF

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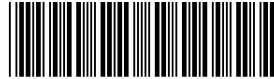
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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86030490

MARK: FINANCIALLY WISE WOMEN



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: FINANCIALLY WISE WOMEN

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

Financially Wise Women, a corporation (hereinafter referred to as "applicant") has appealed the trademark examining attorney's final refusal to register the mark FINANCIALLY WISE WOMEN based upon Section 2(d) of the Trademark Act.

FACTS

On 08/09/2013, applicant filed an application to register the mark, FINANCIALLY WISE WOMEN, for “consulting and information concerning insurance; financial advice; financial advice and consultancy services; financial advice, namely, budget planning; financial planning; financial planning and investment advisory services; insurance brokerage; insurance brokerage services; life insurance brokerage; on-line financial planning services; and workshops and seminars in the field of financial planning. Applicant alleged use of the mark for the identified services in interstate commerce.

In the first Office action mailed November 13, 2013, the examining attorney refused registration pursuant to Section 2(d) of the Trademark Act on the basis that the applicant's mark when applied to the services, so resembles the registrant's mark, WISE WOMEN WORKSHOP ("WOMEN WORKSHOP" disclaimed) for "educational services, namely, conducting workshops for women in the field of finance, namely, to help women achieve financial independence and a comfortable retirement." Registration was also refused because the specimen did not show the applied-for mark in use in commerce in connection with any services specified in the application in Class 41. Additionally, the examining attorney required a disclaimer of the wording FINANCIALLY and WOMEN.

On 5/20/15, applicant responded to the first Office action. In response to the specimen refusal for services in Class 41, applicant amended the filing basis to intent to use under Section 1(b). Applicant

submitted a disclaimer of the wording WOMEN and arguments in support of registration without a disclaimer of FINANCIALLY. Applicant also submitted arguments and evidence in support of registration.

On July 7, 2014, the examining attorney accepted the amendment to the filing basis for the services in Class 41, withdrew the specimen requirement for services in class 41, accepted the disclaimer of the wording WOMEN, withdrew the disclaimer request for the wording FINANCIALLY, and made the refusal under Trademark Act Section 2(d) final.

On 11/21/14, in response to the second Office action, applicant filed a Notice of Appeal. On January 10, 2015, applicant submitted a request for reconsideration with evidence and arguments in support of registration. On 2/7/15 the examining attorney denied the request for reconsideration and made additional evidence of record to support the refusal under Trademark Act Section 2(d). On 4/17/14, applicant filed its appeal brief.

The sole issue on appeal is whether the applicant's mark "FINANCIALLY WISE WOMEN" ("WOMEN" disclaimed) for "consulting and information concerning insurance; financial advice; financial advice and consultancy services; financial advice, namely, budget planning; financial planning; financial planning and investment advisory services; insurance brokerage; insurance brokerage services; life insurance brokerage; on-line financial planning services; and workshops and seminars in the field of financial planning," is confusingly similar to U.S. Registration No. 4367630, WISE WOMEN WORKSHOP ("WOMEN WORKSHOP" disclaimed) for "educational services, namely, conducting workshops for

women in the field of finance, namely, to help women achieve financial independence and a comfortable retirement."

ARGUMENTS

APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO REGISTRANT'S MARK AND THE RESPECTIVE SERVICES ARE RELATED

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

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