In response to the Office Action dated September 6, 2009, please reexamine the application in view of the concurrent amendment and the remarks provided below.

AMENDMENT

The Identification of Services has been amended to read: --Financial services, namely banking--. The previous inclusion of "insurance brokerage, and investment of funds for others" has been deleted.

REMARKS

The applicant seeks to register the mark “DO WHAT’S RIGHT” for, as amended, banking services. The Office Action has refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that the applicant’s mark, when used in connection with the previously identified services, is likely to be confused with an earlier-registered mark. The cited mark is “DO WHAT’S RIGHT. DO IT WELL.” for insurance underwriting services in the

The applicant respectfully submits that there is no likelihood of confusion between its mark used with banking services and the cited mark used with insurance underwriting services in the fields of property and casualty. The U.S. Court of Appeals for the Federal Circuit, which hears appeals from the U.S. Patent and Trademark Office (PTO) in trademark application cases pursuant to 15 U.S.C. § 1071, considers the following factors pertinent to likelihood of confusion:

1. Similarity or dissimilarity of marks in their entirety (appearance, sound, commercial impression);
2. Similarity or dissimilarity of goods or services;
3. Similarity or dissimilarity of trade channels;
4. Conditions of sale (impulse v. planned), i.e., sophistication of purchasers;
5. Fame of prior mark (sales, advertising, length of use);
6. Number of prior marks in use on similar goods or services;
7. Nature and extent of actual confusion;
8. Length of time and conditions of concurrent use without evidence of actual confusion;
9. Variety of goods or services on which mark is or is not used;
10. Market interface between applicant and owner of prior mark;
11. Extent of applicant’s right to exclude others from use of mark;
12. Extent of potential confusion; and
13. Any other established fact probative of the effect of use.


The Office Action improperly considered only the first two factors, summarizing its analysis by stating: “Because of the similarity of the marks and the related nature of the goods or services, confusion is likely in the mind of the public, and registration is accordingly refused.”

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1 The Federal Circuit holds that likelihood of confusion is an issue of law which it reviews de novo on appeal. In re Bed & Breakfast Registry, 229 USPQ 818, 819 (Fed. Cir. 1986) (TTAB decision on likely confusion reversed as a legal issue subject to independent appellate review without deference).
Office Action at page 3, paragraph 3. In fact, the Office Action did not consider any other factors.

The applicant submits that the Office Action failed to assess properly the differences in the marks and the differences in services. Moreover, the Office Action overlooked entirely other important factors including the different channels of trade, the sophistication of purchasers, the number of similar marks in use, and the variety of goods or services on which other marks including the phrase “Do What’s Right” are used. Thus, the Office Action accorded too much weight to the similarity between the marks and services and applied a deficient legal analysis.

1. Similarities in Marks

The applicant highlights the very substantial differences between the marks “DO WHAT’S RIGHT” and “DO WHAT’S RIGHT. DO IT WELL.” when those marks are each considered as a whole. It is critically important that marks be reviewed and compared “in their entireties.” It is not proper to separate portions of a mark for a comparative analysis. Packard Press, Inc. v. Hewlett-Packard Co., 56 USPQ2d 1351 (Fed. Cir. 2000) (although stating that it had considered the marks in their entireties, the PTO Trademark Trial and Appeal Board (TTAB) erred by dissecting marks when determining likelihood of confusion and, therefore, failing to consider the whole marks). Accordingly, all the words in the applicant’s mark and in the cited registration must be considered as part of the analysis.

The applicant’s mark has only three words, while the Fireman’s Fund registered mark has six words (twice as many). The words of the applicant’s mark are not presented in a sentence format, while the Fireman’s Fund registered mark consists of two, full sentences including the first sentence “Do What’s Right.” and the second sentence “Do It Well.” Thus, the applicant’s mark is only the start (and, literally, only half) of the registrant’s mark. Moreover, the period after the phrase “Do What’s Right.” in the registered mark prompts the purchaser to

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2 See also 4 J. McCarthy, McCarthy on Trademarks & Unfair Competition, § 23.41 at 23-179 to -183 (2009) (“McCarthy”) (stating “Conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison” and citing Estate of P.D. Beckwith, Inc. v. Commissioner of Patents, 252 U.S. 538, 345-46 (1920), in support of this “anti-dissection” rule).
anticipate the second sentence; consumers are accustomed to having one sentence follow another.

The Office Action erred by focusing on the common first phrase found in both the applicant’s and the registrant’s marks. It has been held to be a violation of the anti-dissection rule to focus on the “prominent” feature of a mark and decide likely confusion solely upon that feature, ignoring the other elements of the mark. See McCarthy, § 23:41 at 23-183 (and cases cited). For a long list of example cases finding the absence of any likelihood of confusion between marks which were similar in part, see McCarthy, § 23:57. The applicant respectfully submits that the overall commercial impression, as defined by the connotation or meaning of the applicant’s and the registrant’s respective marks, is dispositive in this case.

The connotation or meaning of the words “Do What’s Right” in the applicant’s mark, taken alone and without the subsequent sentence “Do It Well.” found in the registrant’s mark, is a double entendre (i.e., a figure of speech in which a spoken phrase is devised to be understood in either of two ways). Specifically, “Do What’s Right” connotes both (1) an ethical or moral imperative suggesting that the services offered under the mark comply with business and societal ethics; and (2) a statement that the services offered under the mark are correct and accurate (i.e., “right”). The first connotation is especially important for the applicant’s services in the current political climate surrounding the banking industry. In contrast, the inclusion of the second sentence “Do It Well.” in the registrant’s mark focuses the connotation only on the second of the two meanings listed above: correctness and accuracy.

The meaning or connotation of a mark must be determined in relation to the named services. Even marks that are identical in sound, appearance, or both may create sufficiently different commercial impressions when applied to the respective parties’ goods or services so that there is no likelihood of confusion. See, e.g., In re Sears, Roebuck & Co., 2 USPQ2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies’ sportswear, the Board finding that the term was suggestive of the construction of applicant’s bras, but was likely to be perceived by purchasers either as an entirely arbitrary designation or as being suggestive of sportswear that “crosses over” the line between informal and more formal wear when applied to ladies’ sportswear); In re British Bulldog, Ltd., 224 USPQ 854 (TTAB 1984) (PLAYERS for men’s underwear held not likely to be confused
with PLAYERS for shoes, the Board finding that the term PLAYERS implies a fit, style, color
and durability adapted to outdoor activities when applied to shoes, but “implies something else,
primarily indoors in nature” when applied to men’s underwear); In re Sydel Lingerie Co., Inc.,
197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies’ and children’s underwear held not
likely to be confused with BOTTOMS UP for men’s clothing, the Board finding that the term
connotes the drinking phrase “Drink Up” when applied to men’s suits, coats and trousers, but
does not have this connotation when applied to ladies’ and children’s underwear). See T.M.E.P.
§ 1207.01(b)(v).

The Office Action erred by applying to the subject “sentence” marks the analysis
of “word” marks. Thus, the Office Action states, on the bottom of page 2:

Applicant’s mark, DO WHAT’S RIGHT, is very similar in sound,
spelling, appearance, and commercial impression to the mark used in the cited
prior registration, DO WHAT’S RIGHT. DO IT WELL. Consumers are generally
more inclined to focus on the first word, prefix or syllable in any trademark or
service mark. See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison
Fondee En 1772, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005);
see also Mattel Inc. v. Funline Merch. Co., 81 USPQ2d 1372, 1374-75 (TTAB
2006); Presto Prods., Inc. v. Nice-Pak Prods., Inc., 9 USPQ2d 1895, 1897 (TTAB
1988) (“it is often the first part of a mark which is most likely to be impressed
upon the mind of a purchaser and remembered” when making purchasing
decisions). In this case, the proposed mark is identical to the first phrase of the
registered mark.

The cases cited by the Office Action all involve conflicting marks which have a first word in
common, with a different remaining second word that is non-distinctive. In Palm Bay Imps.,
Inc., the Federal Circuit held the applicant’s mark “VEUVE ROYALE” for wine likely to cause
confusion with the opposer’s mark “VEUVE CLICQUOT” for champagne. Important to the
court’s analysis was that VEUVE was prominent in both marks because it was the first word,
arbitrary and therefore strong as applied to wine and champagne, and more significant than the
more laudatory and less source-indicating word ROYALE. 73 USPQ2d at 1692. Also important
was the finding that the opposer’s mark was famous. Id. at 1695. Here, the first sentence of the
registrant’s mark is no more prominent than the second, the second sentence is just as distinctive
as the first, and the mark is not famous.

In Mattel Inc., the TTAB granted Mattel’s petition to cancel the registration of
“RAD RODS” (“RODS” disclaimed) for toy vehicles based on a likelihood of confusion with
Mattel’s prior registration of “RAD RIGS” (“RIGS” disclaimed) for toy vehicles. In *Presto Prods., Inc.*, the TTAB sustained the opposition against registration of “KIDWIPES” based on prior use and registration of “KID STUFF.” Both marks were used for identical pre-moistened disposable towelettes. In both *Mattel Inc.* and *Presto Prods., Inc.*, the conflicting marks comprised only two words each and the different remaining second words were non-distinctive and perhaps even descriptive of the parties’ goods.

Also noteworthy as undermining the relevancy of the three cited cases to the present analysis is the fact that, in all three cases, the parties’ respective goods were identical or nearly so. This is not true for the applicant’s and registrant’s services (see the next section of these Remarks). The degree of similarity of the marks needed to prove likely confusion varies with the difference in the goods and services of the parties. See, e.g., *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004) (“Because the goods are related, the degree of similarity [in the marks] necessary to support a conclusion of likely confusion declines.”) (citation omitted); 3 *McCarth}* § 23:20.50 (and cases cited).

The three cited cases are also distinguishable because the applicant’s mark differs from the registered mark in an entire sentence. Regardless, more relevant cases abound where even word (not sentence) marks have been held sufficiently different to avoid any likelihood of confusion based on the different connotations or meanings of those words. In some situations where a word has different meanings in different contexts, even the use of the same word as a mark will not be likely to cause confusion. See, e.g., *Viacom Int’l Inc. v. Komm*, 46 USPQ2d 1233, 1238 (TTAB 1998) (no conflict between MY-T-MOUSE THE SOFTWARE THAT MAKES YOUR MOUSE A MOUSE THAT TYPES! for software and MIGHTY MOUSE for a cartoon character merchandised for use on toys which could include computer toys and games; although MY-T-MOUSE is the dominant part of the applicants’ mark, “the marks have different connotations . . . that consumers will perceive”); see also *McCarth}* § 23:28 (and cases cited).

3 In *Shen Mfg. Co., Inc.*, the Federal Circuit reversed the TTAB’s decision to sustain an opposition against registration of “THE RITZ KIDS” for gloves based upon a likelihood of confusion with “RITZ” for barbeque mitts. The Board found the marks similar because the word “THE” has virtually no significance and the word “KIDS” simply indicates that the gloves are designed for kids. Stated the court: “We cannot sanction the board’s dissection of RHL’s mark. . . . Thus, taking into consideration the ‘appearance, sound, connotation, and commercial impression of the two marks,’ we reverse the board’s finding that THE RITZ KIDS is similar to RITZ.” 73 USPQ2d at 1356-57.
For a long list of example cases which rejected the contention of similarity of meaning and held the marks not confusingly similar, see McCarthy, § 23:30.

More analogous to the present analysis are cases such as Fruit of Loom, Inc. v. Fruit of Earth, Inc., 3 USPQ2d 1531, 1533 (TTAB 1987), and Omaha Nat'l Bank v. Citibank (South Dakota), N.S., 229 USPQ 51 (D. Neb. 1986). In Fruit of Loom, Inc, the TTAB held that differences in the meanings of the words “Earth” and “Loom” created distinct commercial impressions for the parties’ respective marks and rendered confusion unlikely between “FRUIT OF THE LOOM” for a variety of clothing and “FRUIT OF THE EARTH” for hair and skin care products. The TTAB so held despite the presence of factors -- fame of the former mark, sales by both parties in the same channels of trade, and advertisements in the same media -- absent in the present case.

In Omaha Nat'l Bank, ONB asserted trademark infringement based on a likelihood of confusion with its trade name and service mark “BANK-IN-A-BILLFOLD.” Citibank placed newspaper advertisements stating “Now, the bank in your wallet is cash in your hand,” and “At last, a bank that fits in your wallet.” Citibank also distributed brochures that displayed “BANK IN A WALLET” on the cover. Both parties offered “essentially the same” banking services. 229 USPQ at 54. The district court focused on the brochure and noted that “Plaintiff’s mark and defendant’s designation, when viewed merely in a printed form, are quite similar. Both include the words “Bank-In-A” and include a fourth term which is virtually synonymous.” Id. Nevertheless, the district court found no likelihood of confusion given the distinct commercial impression created by Citibank’s designation in the context of its brochure. Similarly, the commercial impression of the applicant’s mark is completely different from that of the registrant’s mark.

Finally, the “similarity [of marks] is not a binary factor but a matter of degree. Because there are significant differences in the design of the two marks, the finding of similarity is a less important factor in establishing a likelihood of confusion than it would be if the two marks had been identical in design or nearly indistinguishable to a casual observer.” In re Coors Brewing Co., 68 USPQ2d 1059 (Fed. Cir. 2003).

court reversed the TTAB’s finding of likelihood of confusion between Electronic Data’s mark EDS for “computer programming services including the design, implementation, and management of electronic data processing programs and telecommunications services” sold to customers in the medical field and the applicant’s mark E.D.S. for power supplies or battery chargers often incorporated into medical instruments and devices. Some of the same factors that the court found persuasive in Electronic Design militate against a finding of likelihood of confusion in this application.

2. Differences in Services

As amended, the applicant intends to offer banking services under its mark; the registrant offers insurance underwriting services. The applicant’s and registrant’s respective services are entirely different and unrelated. Perhaps most important, the respective services are noncompetitive.

The only relation between the services is that both types of services are broadly classified within International Class 36. Of course, the classification of services has no bearing on the question of likelihood of confusion. Rather, it is the manner in which the applicant and registrant have identified their services that is controlling. Jean Patou Inc. v. Theon Inc., 29 USPQ2d 1771, 1774 (Fed. Cir. 1993); National Football League v. Jasper Alliance Corp., 16 USPQ2d 1212, 1216 n.5 (TTAB 1990); T.M.E.P. § 1207.01(d)(v). Noteworthy is the fact that International Class 36 itself separately identifies both “insurance” (the registrant’s services) and “monetary affairs” (which encompasses the applicant’s banking services).

Both the Federal Circuit and the TTAB have rejected the view that a relationship exists between goods or services simply because each falls within the same general field. See, e.g., Clayton Mark & Co. v. Westinghouse Electric Corp., 148 USPQ 672 (CCPA 1966) (no likelihood of confusion arises between MARK for electrical conduit and MARK 75 for industrial circuit breakers); Fossil Inc. v. Fossil Group, 49 USPQ2d 1451 (TTAB 1998) (no likelihood of confusion raised between FOSSIL for watches and THE FOSSIL GROUP for clocks); Information Resources v. X*Press Info. Servs., 6 USPQ2d 1034 (TTAB 1988) (X*PRESS for a news service transmitted through cable television to a personal computer not likely to cause confusion with EXPRESS for information analysis computer programs); In re Quadram Corp.,
228 USPQ 863 (TTAB 1985) (Board found no confusion between FASER for software for energy conservation and MICROFAZER for hardware buffers).

In *Electronic Design*, the TTAB made the same mistake evident in the Office Action. Recognizing a similarly tenuous relationship between goods and services (both were in the broad category of the medical field), the TTAB nevertheless concluded that the applicant’s “goods are sufficiently related [to opposer’s services] . . . so that confusion is likely.” 21 USPQ2d at 1390. The Federal Circuit unequivocally corrected the Board: “The Board’s conclusion . . . incorporated doubtful fact findings concerning the relatedness of the goods and services and, in any event, is incorrect as a matter of law.” *Id.*


In *Astra*, the parties marketed and sold goods marked with the name “ASTRA” to the same purchasing institutions—large hospitals. 220 USPQ at 790. Although both parties manufactured goods “in the same broad health care field,” *id.* at 793, Astra sold pharmaceutical products to hospital pharmacies and Beckman sold laboratory instrumentation to hospital laboratories. *Id.* at 790. In affirming a grant of summary judgment of no infringement, the court held that use in the same broad field “is not sufficient to demonstrate that a genuine issue exists concerning likelihood of confusion.” *Id.* at 790.

*Electronic Design*, 21 USPQ2d at 1390-91. Thus, in both *Electronic Design* and *Astra*, the appellate court found goods and services like those at issue in this application insufficiently related to support a determination that confusion was likely.

Also pertinent is the Board’s own decision in *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1461 (TTAB 1992). Electronic Data opposed the application of EDSA Micro Corp. to register the mark EDSA for computer programs for electrical distribution analysis and design. As grounds for opposition, Electronic Data asserted likelihood of confusion with its EDS mark for computer programs for performing systems and design. The Board found no likelihood of confusion and dismissed the opposition. Despite the similarity of the parties’ marks and the conceded fame of the opposer’s mark, the Board found the opposer’s computer data processing programming services insufficiently related to the applicant’s computer programs that consumers would be likely to associate them with a single source. *Id.* at 1463
("We decline to interpret the concept of related goods so broadly."). That same factor — a clear difference in services — is of paramount importance in the present application.

Moreover, the Office Action bears the burden to provide evidence showing that the services are more particularly related than falling under the same broad category of services to support a conclusion of likelihood of confusion. T.M.E.P. § 1207.01(a)(vi). An overlap must exist among individual purchasers of the respective services. This requirement has not been met.

The Office Action attached and referred to printouts from the USPTO X-Search database that show third-party registrations of marks used in connection with both banking and insurance underwriting. The registrations are summarized in the table below.

<table>
<thead>
<tr>
<th>MARKS</th>
<th>REG. NO.</th>
<th>REG. DATE</th>
<th>SERVICES</th>
<th>FUSE DATE</th>
</tr>
</thead>
<tbody>
<tr>
<td>NATIONWIDE FINANCIAL NETWORK</td>
<td>3,319,683</td>
<td>10/23/07</td>
<td>Life insurance underwriting (banking services NOT listed)</td>
<td>10/31/04</td>
</tr>
<tr>
<td>V</td>
<td>3,446,502</td>
<td>06/10/08</td>
<td>Banking and travel insurance underwriting services</td>
<td>01/01/06</td>
</tr>
<tr>
<td>CAPITAL PRESERVATION PLUS LIFETIME INCOME</td>
<td>3,156,526</td>
<td>10/17/06</td>
<td>Life insurance underwriting (banking services NOT listed)</td>
<td>03/01/05</td>
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<tr>
<td>INCOME IN TIME</td>
<td>3,192,850</td>
<td>01/02/07</td>
<td>Life insurance underwriting (banking services NOT listed)</td>
<td>12/01/00</td>
</tr>
<tr>
<td>LIVESTRONG</td>
<td>3,493,993</td>
<td>08/26/08</td>
<td>Insurance underwriting (banking services NOT listed)</td>
<td>05/30/06</td>
</tr>
<tr>
<td>ING. YOUR FUTURE. MADE EASIER.</td>
<td>3,189,505</td>
<td>12/26/06</td>
<td>Life insurance underwriting (banking services NOT listed)</td>
<td>12/08/05</td>
</tr>
<tr>
<td>RISKSWAP</td>
<td>3,302,079</td>
<td>10/02/07</td>
<td>Insurance underwriting (banking services NOT listed)</td>
<td>11/03/05</td>
</tr>
<tr>
<td>QUIETLY CONQUERING THE WORLD OF FINANCE</td>
<td>3,433,165</td>
<td>05/20/08</td>
<td>Banking and life insurance underwriting services</td>
<td>06/05/06</td>
</tr>
<tr>
<td>A UNIFI COMPANY</td>
<td>3,324,195</td>
<td>10/30/07</td>
<td>Banking and underwriting services</td>
<td>01/01/06</td>
</tr>
<tr>
<td>Applicant</td>
<td>Registration Number</td>
<td>Filing Date</td>
<td>Services Provided</td>
<td>Registration Date</td>
</tr>
<tr>
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</tr>
<tr>
<td>CHARTER BENEFITS GROUP</td>
<td>3,236,832</td>
<td>05/01/07</td>
<td>Investment banking and insurance underwriting consultation services</td>
<td>07/01/99</td>
</tr>
<tr>
<td>STATE FARM INSURANCE AUTO LIFE FIRE LIKE A GOOD NEIGHBOR, STATE FARM IS THERE</td>
<td>3,378,675</td>
<td>02/05/08</td>
<td>Banking and insurance underwriting services</td>
<td>09/07/05</td>
</tr>
<tr>
<td>RSRS/RETIREMENT SOLUTIONS FOR PLASTIC SURGEONS</td>
<td>3,365,830</td>
<td>01/08/08</td>
<td>Investment banking and insurance underwriting services</td>
<td>07/03/06</td>
</tr>
<tr>
<td>STRATEGIC PORTFOLIO SOLUTIONS</td>
<td>3,559,155</td>
<td>01/06/09</td>
<td>Banking and insurance underwriting services</td>
<td>05/17/06</td>
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<td>LET'S THRIVE</td>
<td>3,451,434</td>
<td>06/17/08</td>
<td>Insurance underwriting (banking services NOT listed)</td>
<td>08/01/06</td>
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<td>GOLDWATER BANK</td>
<td>3,403,934</td>
<td>03/25/08</td>
<td>Banking and insurance underwriting services</td>
<td>03/31/05</td>
</tr>
</tbody>
</table>

The registrations ostensibly show, per the Office Action, that buyers will mistakenly assume that there is a relation or affiliation between the applicant’s DO WHAT’S RIGHT banking services and the registrant’s DO WHAT'S RIGHT. DO IT WELL. underwriting services. There are three main problems with this syllogism. First, the Federal Circuit and the Board itself have often criticized the evidentiary weight of registrations as evidence of buyer perceptions, even in the very cases cited by the Office Action in support of its position: In re Infinity Broad. Corp., 60 USPQ2d 1214, 1217-18 (TTAB 2001); In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); and In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); see T.M.E.P. §1207.01(d)(iii). These three cases completely fail to support the stated position.

The facts of In re Infinity Broad. Corp. undermine the applicability of that case. The applicant sought to register “KYNG” for “radio broadcasting services.” The Trademark Examining Attorney refused registration under Section 2(d) based on the previously registered marks “KING-TV” for “television broadcasting services” and “KING FM” for “radio broadcasting services.” The Board noted: “As is obvious, registrant itself renders both types of services under virtually identical marks (differing only in the descriptive and/or generic
designations ‘TV’ and ‘FM’).” *Id.* at 1217. Evidence of third-party registrations was at best redundant and, at worst unnecessary, given that critical fact. In contrast, Fireman’s Fund’s registration is for insurance underwriting services in the fields of property and casualty only; the registrant itself does not offer banking services.

The Board actually reversed the refusal of the Trademark Examining Attorney to register the applicant’s mark under Section 2(d) in the second case, *In re Albert Trostel & Sons Co.* The applicant sought to register “PHOENIX” for leather sold in bulk. The refusal was based on likelihood of confusion with a prior registration for the identical mark used on all-purpose sports bags, luggage, attaché cases, portfolio briefcases, and handbags. The Board considered evidence of third party registrations and, obviously (in view of the decision), found such evidence unpersuasive. In fact, the Board found the evidence of “very limited” probative value. 29 USPQ2d at 1786. Similarly, in the third case cited by the Office Action, *In re Mucky Duck Mustard Co.*, the Board gave evidence of third party registrations “little weight.” 6 USPQ2d at 1470 n.6.

The second problem with the syllogism stated by the Office Action is that, in the context of the cited registrations, the conclusion is false just about as often as it is true. Each of the fifteen cited registrations encompasses insurance underwriting. About half (namely, eight) of those registrations also encompass banking services. The other half (namely, seven) do not. Thus, consumers would not necessarily expect banking services to emanate from the same source as insurance underwriting services.

The third problem with the syllogism stated by the Office Action is that it is illogical. Using only the registrations cited in the Office Action as a sample universe, the fallacy of the position is illustrated. Some of the cited registrations recite completely unrelated services in the same registration.

<table>
<thead>
<tr>
<th>MARK</th>
<th>REG. NO.</th>
<th>REG. DATE</th>
<th>EXAMPLE SERVICES</th>
<th>1st USE DATE</th>
</tr>
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<tbody>
<tr>
<td>CHARTER BENEFITS GROUP</td>
<td>3,236,832</td>
<td>05/01/07</td>
<td>Securities trading and administration of healthcare plans</td>
<td>07/01/99</td>
</tr>
<tr>
<td>RSPS/RETIREMENT SOLUTIONS FOR PLASTIC SURGEONS</td>
<td>3,365,830</td>
<td>01/08/08</td>
<td>Securities brokerage and administration of healthcare plans</td>
<td>07/03/06</td>
</tr>
</tbody>
</table>
If Party A were to have registered a mark for Services A and Party B sought to register the same mark in connection with completely unrelated Services B and Party C happened to have registered another mark (distinguishable from the mark of Parties A and B) for Services A and B, then, according to the PTO’s logic, Party B’s application should be rejected--despite the fact that Services A and B are clearly unrelated. Using the two cited registrations listed above as concrete examples, if Party A had registered the hypothetical mark “INVESTOR” for securities trading or brokerage, then Party B could not register the same mark “INVESTOR” to administer health-care plans because the unrelated mark “CHARTER BENEFITS GROUP” (or “RSPS/RETIREMENT SOLUTIONS FOR PLASTIC SURGEONS”) of Party C was registered in connection with both securities trading or brokerage services and the services of administering health-care plans. Such a result is clearly wrong (depending, of course, on how other DuPont factors might affect the likelihood of confusion analysis).

3. Different Channels of Trade

On the highlighted banner of its web site, www.firemansfund.com, Fireman’s Fund explains that it provides “insurance solutions through independent agents to help customers manage risks and opportunities.” Specifically, “Fireman’s Fund Insurance Company is a premier property and casualty insurer, providing personal and commercial insurance products nationwide.” Id. Fireman’s Fund relies on selected independent agents to provide its policyholders with the advice and consulting support they need. Id. Fireman’s Fund focuses exclusively on insurance services; it does not offer any banking services. Thus, the registrant’s services are purchased from independent agents by customers who seek insurance to manage risks.

In contrast, the applicant will offer under its mark traditional banking services such as checking accounts, savings accounts, CD’s, IRA’s, and money market accounts. See www.thebeneficial.com. The applicant’s services are offered through on-line banking and at branch office locations. These services are purchased by individuals and businesses who wish to invest their money with the hopes of making money.

The applicant respectfully submits that there is no likelihood of confusion between its DO WHAT’S RIGHT mark for banking services offered through traditional banking
trade channels and the registrant’s mark “DO WHAT’S RIGHT. DO IT WELL.” for insurance underwriting services offered through independent insurance agents. The applicant’s mark is used with services (1) in the banking field which is different from the insurance field where the services of the cited mark are provided, (2) which are sought by consumers many of whom are different from the consumers who use the services of the cited mark, and (3) which have a purpose (investment to make money) different from and unrelated to the function performed by the services of the cited mark (insurance against risk). Moreover, there is a significant difference in the cost of the services. Customers are often not charged for the applicant’s services; rather, the applicant pays the customers via interest for use of the customers’ investments. Customers pay Fireman’s Fund for the insurance underwriting services offered under the cited mark.

Considering purchasers from the very same institutional customers (hospitals), the Federal Circuit again adopted, in *Electronic Design*, the reasoning of the U.S. Court of Appeals for the First Circuit:

> The First Circuit’s holding [in *Astra*] recognized that “[t]he ‘hospital community’ is not a homogeneous whole, but is composed of separate departments with diverse purchasing requirements, which, in effect, constitute different markets for the parties’ respective products.” 220 USPQ at 791.

*Electronic Design*, 21 USPQ2d at 1391. Thus, both appellate courts found the individual departments in hospitals to be separate and independent purchasers establishing disparate trade channels. The applicant’s and registrant’s respective fields are even more disparate in that they encompass separate and independent purchasers establishing disparate trade channels.

4. **Sophistication of Purchasers**

The Office Action apparently failed to consider, and certainly failed to address, the sophistication of the purchasers who buy the applicant’s and registrant’s respective services. This is legal error: it is especially harmful error because that *Du Pont* factor “is important and often dispositive,” *Electronic Design*, 21 UPSQ2d at 1392, as the applicant contends it is in this case. Sophisticated purchasers may be expected to exercise greater care and, because they are discriminating, sophisticated purchasers are unlikely to be confused by similar marks. *Id.; see also Palm Bay Imports, Inc.*, 73 USPQ2d 1689 (“Purchaser sophistication may tend to minimize
likelihood of confusion.”); T.M.E.P. § 1207.01(d)(vii) (“circumstances suggesting care in purchasing may tend to minimize likelihood of confusion”).

“Just from the record description of goods and services here one would expect that nearly all of [the] purchasers would be highly sophisticated.” Electronic Design, 21 USPQ2d at 1392. Both the applicant’s and the registrants’ services are sold to people who are investing their money -- albeit for entirely different purposes (to make more money, in the cases of the applicant’s banking services, and to protect against risks, in the case of the registrant’s services). These consumers carefully select the company who will advise and assist them in making investment decisions; a great deal of trust is involved in the provision of both banking and insurance underwriting services. Therefore, relevant consumers make purchases only after careful consideration. Omaha Nat’l Bank, 229 USPQ at 53 (“The testimony and evidence indicates purchasers and potential purchasers of the banking services ONB and Citibank provide . . . exercise a relatively high degree of care when choosing between providers . . . .”); Checkpoint Sys., Inc. v. Check Point Software Technologies, Inc., 60 USPQ2d 1609, 1629 (3d Cir. 2001) (“Many investors are sophisticated parties who exercise a high degree of care in making investment decisions.”).

Such care is assured by the importance of investment decisions. Large sums of money can be made or lost depending upon the decision. Moreover, the registrant’s services are relatively expensive. “[T]here is always less likelihood of confusion where goods [or services] are expensive and purchased after careful consideration.” Electronic Design, 21 USPQ2d at 1392 (citing Astra, 220 USPQ at 790).

The First Circuit’s comment, upon considering similarly sophisticated purchasers in the medical field, applies to this application: “it is simply inconceivable that purchasers of the parties’ respective [services] could be confused as to the source of those [services], or even about the relationship between [the] companies.” Astra, 718 F.2d 1207, 220 USPQ at 791. Even assuming that the Office Action were correct in finding sufficient relatedness between the marks and services, therefore, the relevant purchasers are sophisticated enough that the likelihood of confusion is remote.
5. Many Similar Marks

Evidence of third-party use falls under the sixth DuPont factor: the number and nature of similar marks in use on similar goods or services. If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods or services, this evidence “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imports, Inc.*, 73 USPQ2d at 1693; *see also* T.M.E.P. § 1207.01(d)(iii). Thus, the evidence provided in Exhibits A, B, and C (discussed more fully below) is probative of the applicant’s contention that the cited registered mark is “weak” and entitled to only a narrow range of protection. *Lloyd’s Food Products, Inc. v. Eli’s, Inc.*, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993).

The following table lists six exemplary third-party registrations for “DO WHAT’S RIGHT . . .” marks.

<table>
<thead>
<tr>
<th>MARK</th>
<th>REG.NO.</th>
<th>REG.DATE</th>
<th>GOODS/SERVICES</th>
<th>1st USE DATE</th>
</tr>
</thead>
<tbody>
<tr>
<td>DO WHAT TASTES RIGHT</td>
<td>3,095,550</td>
<td>05/23/06</td>
<td>Restaurant services</td>
<td>05/25/05</td>
</tr>
<tr>
<td>DO WHAT’S RIGHT BECAUSE IT’S RIGHT</td>
<td>3,254,323</td>
<td>06/19/07</td>
<td>Wide variety of goods in classes 09, 14, 18, and 25</td>
<td>06/08/98</td>
</tr>
<tr>
<td>DO WHAT’S RIGHT</td>
<td>3,654,498</td>
<td>07/14/09</td>
<td>Publications in the specialty metals business</td>
<td>12/00/08</td>
</tr>
<tr>
<td>WISE MONKEYS JUST DO WHAT’S RIGHT</td>
<td>3,640,567</td>
<td>06/16/09</td>
<td>Tote bags, handbags, purses, and luggage</td>
<td>12/00/05</td>
</tr>
<tr>
<td>DO WHAT’S RIGHT</td>
<td>3,603,717</td>
<td>04/07/09</td>
<td>Educational and entertainment services</td>
<td>09/21/08</td>
</tr>
<tr>
<td>DO WHAT’S RIGHT</td>
<td>2,478,408</td>
<td>08/14/01</td>
<td>Series of publications on the subject of various business issues</td>
<td>05/01/99</td>
</tr>
</tbody>
</table>

Printouts of the PTO records supporting these third-party registrations are collected in Exhibit A. Use of the registered marks above is supported by the attached Internet printouts collected in Exhibit B. Among the goods and services, with which the mark DO WHAT’S RIGHT (alone and not in combination with other terms) is used, are publications in the specialty metals business, educational and entertainment services, and a series of publications on the subject of various business issues. Thus, no one (including the cited registrant, Fireman’s Fund) using a
mark including the words DO WHAT’S RIGHT can be afforded a wide scope of protection and there is room for the applicant’s use and registration without any likelihood of confusion.

An Internet search also uncovered additional users of the mark DO WHAT’S RIGHT who may have common law trademark rights. Indeed, a search directed to the phrase “Do What’s Right” uncovered about 358,000 uses of the phrase. Printouts showing these search results are provided in Exhibit C. The fact that all of these users are able to coexist using the same or a similar mark without causing consumer confusion indicates that consumers do not necessarily assume a relationship between different marks based on the presence of the phrase “Do What’s Right.”

In Lloyd’s Food, the TTAB cancelled Lloyd’s Food’s registration based upon a likelihood of confusion between Lloyd’s Food’s registered trademark and the registration of a mark owned by Eli’s, Inc. Lloyd’s Food offered evidence of third-party use of the mark. The Federal Circuit found that “for all intents and purposes the board ignored this evidence. It thus rejected Lloyd’s Food’s contention that the mark was ‘weak’ and entitled to a narrow range of protection.” Lloyd’s Food, 25 USPQ2d at 2029. Finding that “the board erred in its treatment of the evidence in the record,” id., the court vacated the TTAB’s decision.

The TTAB and Federal Circuit have often based a legal conclusion of no likelihood of confusion on evidence of third-party use of a designation. See, e.g., In re Broadway Chicken Inc., 38 USPQ2d 1559 (TTAB 1996) (wide-spread third party use of “broadway” warrants finding that confusion is not likely between contemporaneous use of “Broadway Chicken” and “Broadway Pizza” marks); Al-Site Corp. v. VSI Int’l, Inc., 50 USPQ2d 1161, 1176 (Fed. Cir. 1999) (no reasonable juror could have found likely confusion between MAGNIVISION and MAGNA•DOT) (quoting case finding “the extensive third-party use of the word ‘Sun’ impressive evidence that there would be no likelihood of confusion between Sun Banks and Sun Federal”). The applicant respectfully submits that the evidence of third-party use should carry similar weight in this case.

6. **Other Factors**

None of the remaining DuPont factors appears relevant at this time to consideration of the pending application. Fireman’s Fund claims a first use date of 2006 for the cited mark. It is highly unlikely that Fireman’s Fund’s mark has become famous after so short a
period of use. The applicant has filed an intent-to-use application. Accordingly, such factors as actual confusion and concurrent use do not play a role in determining likelihood of confusion in this case.

7. Summary

"In every case turning on likelihood of confusion, it is the duty of the examiner . . . to find, upon consideration of all the evidence, whether or not confusion appears likely." In re E.I. DuPont, 177 USPQ at 568 (emphasis in original). Although the Office Action made specific factual findings on two of the thirteen factors set forth in DuPont, the Office Action failed to assess properly the differences in marks, the differences in the services offered under the marks, the differences in channels of trade, and the sophistication of the relevant purchasers.

Moreover, the Office Action overlooked entirely the number of similar marks in use on other goods and services.

In view of the foregoing amendment and remarks, it is respectfully submitted that the service mark application identified above should be passed to publication. The Trademark Attorney is invited to call the applicant's undersigned representative if any further amendment will expedite the prosecution of the application or if she has any suggestions or questions concerning the application or the present Response.

Respectfully submitted,

Kevin R. Casey
Attorney for Applicant

Enclosures: Exhibits A-C