

To: Beacon Equity Partners, LLC (trademark@mbbp.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85901142 - BEACON EQUITY PARTNERS - BCEPTM05
Sent: 2/26/2014 7:45:56 PM
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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 85901142

MARK: BEACON EQUITY PARTNERS

85901142

CORRESPONDENT ADDRESS:

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APPLICANT: Beacon Equity Partners, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO :

BCEPTM05

CORRESPONDENT E-MAIL ADDRESS:

trademark@mbbp.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: **2/26/2014**

This Office action is being issued in response to applicant's communication filed January 30, 2014. Applicant's arguments have been carefully considered. However, the Section 2(d) refusal as to U.S. Registration No. 4253883 is maintained and continued. Additionally, prior-pending U.S. Application Serial No. 85682493 has since registered. Therefore, registration is refused under Section 2(d) on the basis of this registration as well.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 4405660 and 4253883. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration for U.S. Registration No. 4405660. A copy of U.S. Registration No. 4253883 was sent previously.

Applicant's mark is **"BEACON EQUITY PARTNERS"** for, as amended, "Financial investment in the field of securities excluding such services in connection with real estate asset management, real estate investment trust services, real estate leasing services, real estate and property management, real estate acquisition services, real estate investment administration and management, real estate financing services, financial investment in the field of real-estate related securities, and financial advisory services in the field of real-estate related securities; Financial investment in the field of intellectual property asset management and renewal".

The marks in the cited registrations are as follows:

U.S. Registration No. 4405660 for the mark **"BEACON INNOVATION GROUP"** for "Consulting in the field of intellectual property licensing; Intellectual property consultation; Providing information in the field of intellectual property legal services; Providing information in the field of intellectual property".

U.S. Registration No. 4253883 for the mark **"BEACON FINANCIAL GROUP"** for "Registered investment advisory services; Financial consultancy, namely, financial planning and investment advisory services and insurance consultancy; Financial advisory services; Financial services, namely, a total portfolio offering for clients consisting of both separate accounts that hold stocks, bonds, Electronically Traded Funds, Unit Investment Trusts, direct participation programs such as Real Estate Investment Trust and mutual funds for equity and fixed income investments; Financial planning; Advisory services in the field of employee benefits for group healthcare and business insurance offered to employees in addition to standard benefits such as medical, dental, life insurance including short term disability, long term disability, cancer insurance, accidental death, long term care and dismemberment; Financial planning and investment advisory services; Financial planning for retirement; Financial services, namely, providing an investment option available for variable annuity and variable life insurance products; Financial services, namely, wealth management services relating to financial planning and investment advisory services; Financial trust planning; Investment advisory services; Investment management; Investment management of and distribution of annuities; Investment management of and distribution of variable annuities; Providing advice in the field of finance, financial investments, financial valuations, and the financial aspects of retirement; Strategic financial advisory services".

ANALYSIS

The marks are similar in commercial impression, and the goods and services are related. Therefore, a likelihood of confusion determination is warranted.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or 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). The court in *In re E. I. du Pont de Nemours & Co.* 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be

considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

Similarity of the Marks

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

In the present case, the marks are similar in commercial impression because the dominant element in each mark is “BEACON”. The marks are compared in their entireties under a Trademark Act Section 2(d) analysis. *See* TMEP §1207.01(b). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *see* TMEP §1207.01(b)(viii), (c)(ii).

Applicant's mark and each of the cited marks contain the word “BEACON” along with additional words. However, in each case, the additional words are descriptive or generic. Therefore, the dominant word in each mark is “BEACON.”

Similarity of the Services

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

In the present case, applicant's services and the services in U.S. Registration No. 4253883 are related because registrant's “investment advisory services; financial consultancy, namely, financial planning and investment advisory services and insurance consultancy, financial advisory services, and other identified

services are the same in most cases and/or are encompassed by registrant's services.

Applicant's services involving "financial investment in the field of intellectual property asset management and renewal" are related to the services in U.S. Registration No. 4405660, which involve consulting in the field of intellectual property licensing, intellectual property consultation, providing information in the field of intellectual property legal services, and providing information in the field of intellectual property," because intellectual property consultation encompasses finance related issues involving intellectual property.

For these reasons, the services are related.

Applicant's Argument :

Applicant argues that the consistency initiative applies in this case. However, following the consistency initiative in this case would be inappropriate because it would be a clear error not to issue a Section 2(d) refusal because the marks are similar in commercial impression and the services are the same in some instances and overlap in other instances. Therefore, applicant's arguments are unpersuasive.

Conclusion

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration.

If there are questions regarding this action or the application in general, the undersigned examining attorney can be contacted at the telephone number below.

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All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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