

RESPONSE TO OFFICE ACTION dated April 18, 2019

Serial No. 88284080

On April 18, 2019, the Trademark Examining Attorney issued an Office Action (“OA”) citing a Section 2(d) Refusal for Likelihood of Confusion with U.S. Registration No. 4580834 (“NEW ROAD”). Applicant hereby submits his timely response. Applicant's mark is NÜRODÉ in standard characters for the following goods: Blouses; Coats; Denim jackets; Denim jeans; Denims; Dresses; Footwear; Gloves; Hats; Hoodies; Hoods; Jackets; Jeans; Leather hats; Men's and women's jackets, coats, trousers, vests; Pants; Shirts; Shoes; Skirts; Skirts and dresses; Sweat pants; T-shirts; Top hats; Trousers; Vests; Women's clothing, namely, shirts, dresses, skirts, blouses; Women's hats and hoods, in International Class 25. The cited mark for the Section 2(d) refusal is NEW ROAD in standard characters for the following goods: Footwear; clothing, namely, t-shirts, shirts and exercise clothing, namely, sweat pants, sweat shirts, training shirts, training shorts, caps, and sun visors; bicycle clothing, namely, shorts, pants, padded shorts, padded bib shorts, jerseys, ride shirts, tights, cycling knickers, cycling pants, jackets, vests, cycling base layers, socks, shoe covers for use when wearing cycling shoes, arm warmers, leg warmers, knee warmers; headwear, cycling caps, cycling hats; gloves, namely, cycling gloves, in International Class 25.

The Examining Attorney has concluded that Applicant’s mark, NÜRODÉ, and Registrant’s mark, NEW ROAD, are confusingly similar in part because the two marks *may* be pronounced the same. Contrary to the Examining Attorney's determination, the marks are not phonetic equivalents and cannot be pronounced in the same way. Applicant’s mark is specifically accentuated by two diacritics, “Ü” and “É” specifically, to highlight the correct pronunciation of Applicant’s mark to purchasing consumers. The umlaut over the “U” (Ü) and acute accent over the “E” (É) in Applicant’s mark stand out visually from the rest of the mark due to the diacritics which appear above the plane of the other letters in the mark and purchasing

consumers are likely to pay closer attention to the accented vowels and their exact pronunciations.

The Examining Attorney proposes that the “Ü” in Applicant’s mark is pronounced with a long-o sound similar to “ooh,” supported by evidence from www.dummies.com. However, Applicant submits evidence from several other sources (<https://www.studying-in-germany.org/german-umlauts/>; <https://www.thegermanprofessor.com/how-to-pronounce-o-and-u/>; and <https://www.expath.de/how-to-pronounce-the-umlaute-a-o-and-u-in-german/>) on par with www.dummies.com that better explain the correct pronunciation of “Ü”. See **Exhibit A** (pertinent sections have been highlighted with a red box for ease of reference). According to each of these sources, “Ü” is pronounced in conjunction with a long-e sound “ee” as in “see” or “cheese.” Audio clips demonstrating this pronunciation can be found in links on the websites referenced above. Thus, the correct pronunciation of Applicant’s mark as clearly indicated by the “Ü” in its mark is distinguishable from the pronunciation of “NEW” in Registrant’s mark which is pronounced with the long-o sound “oo”.

The Examining Attorney also proposes that “rode” [sic] in Applicant’s mark is pronounced exactly the same as “road” in Registrant’s mark. Yet, the Examining Attorney seems to have overlooked the acute accent over the letter “E” in Applicant’s mark (“É”) in reaching this conclusion. As explained by the well-known dictionary Merriam-Webster, the acute accented “E” (É) indicates to readers that the vowel is pronounced ending with the long-a sound “-ay”. See **Exhibit B** (pertinent sections have been highlighted with a red box for ease of reference). The difference in pronunciation is exemplified by comparing the pronunciations of “resume” (pronounced as “ri-’züm”) with “résumé” (pronounced as “re-zə-’mā”), or “expose” (pronounced as “ik-’spōz”) with “exposé” (pronounced as “ek-spō-’zā”). See **Exhibit C** and **Exhibit D** (pertinent sections have been highlighted with a red box for ease of reference). The unaccented “e” at the end of “resume” and “expose” is silent in both cases, whereas the acute accent over the last “é” in “résumé” and “exposé” is distinctively pronounced as a long-a (“-ay”)

sound which adds an extra syllable to each of the accented words. Moreover, the clearly pronounced, accented “é” is used in Applicant’s mark thereby adding an extra pronounced syllable in Applicant’s mark compared to Registrant’s mark just as in the foregoing examples. Although the Examining Attorney has stated that “road” in Registrant’s mark and “rode” in Applicant’s mark are both pronounced as “rÅ·d”, this is incorrect as it ignores the acute accent over the last letter-e in Applicant’s mark. While the “road” portion of Registrant’s mark is pronounced as a single syllable “rÅ·d”, the “-rodé” portion of Applicant’s mark is pronounced as two distinct syllables “rä-dā”. (See below for the correct pronunciation of “-RO-“ in NÜRODÉ.) The two marks clearly differ in the number of syllables and do not even rhyme.

Further still, the second syllable of Applicant’s mark (“-RO-“) is pronounced as “rä” (just like the first syllable in “robin” pronounced “rä-bøn”) which is markedly different from the “ro” (pronounced as “rÅ”) in “road” of Registrant’s mark. This correct pronunciation of Applicant’s mark NÜRODÉ is supported by the fact that this mark is a derivation of six existing registered marks owned by Applicant, Catwalk to Sidewalk, Inc. Applicant’s registered marks are RO & DE (Registration No. 4606683), RO & DE (Registration No. 4842533), RO + DE (Registration No. 4952362), RO & DE NOIR (Registration No. 4952362), ROBIN & DEVIN BY RO & DE (Registration No. 5765109), and SINCEREMENT BY RO & DE (Registration No. 5765110). Registration certificates and a TESS search results page displaying the current status of Applicant’s existing registered marks referenced above are attached as **Exhibit E**. the “RO” and “DE” in Applicant’s aforementioned registered marks stems from the names of Applicant’s founder’s children, Robin and Devin, and the syllables are meant to be pronounced as they are in the names “Robin” and “Devin.” This correct pronunciation is further solidified in the minds of purchasing consumers who view Applicant’s mark by the aforementioned diacritics found in Applicant’s mark.

Thus, not only do Registrant’s mark NEW ROAD and Applicant’s mark NÜRODÉ appear dissimilar, they also sound very different from one another. The two marks do not even

contain the same number of syllables, nor do they even rhyme. Furthermore, as explained above, none of the syllables in Applicant's mark matches any syllable found in Registrant's mark. Registrant's mark consists of two separate monosyllabic words NEW and ROAD that combined together express literally a "new road" that may convey the commercial impression of "[a]n open, generally public way for the passage of vehicles, people, and animals" that was "made of [has] come into being only a short time ago." In contrast, Applicant's mark is one made-up word in three-syllables that is a conjunction of NÜ as used in the urban scene denoting re-envisioning of art forms (music, film, fiction, etc.) with specific attention to pop-culture references and image as part of the creative process, RO (the first syllable of Applicant's founder's daughter's name, Robin), and DÉ (the first half of Applicant's founder's son's name, Devin, pronounced "deh" or "dé"). Unlike Registrant's NEW ROAD, Applicant's mark is a fanciful term that has no meaning, nor does it consist of any known words that would convey or suggest any known meaning to consumers. Thus, the two marks are not similar in sound, appearance, or commercial expression.

Therefore, for the foregoing reasons, Applicant respectfully requests that the Examining Attorney allow Applicant and Registrant to co-exist and allow Applicant's application to proceed to registration.

Date: 11/20/2019

Signed By: /Gi Nam Lee/
Gi Nam Lee,
Attorney for Applicant