

AMENDMENT	Attorney Docket No.: TM2243US00
Applicant:	EKLIPSE LUMINAIRE ARCHITECTURAL INC.
Serial No:	87404872
Filed:	April 10, 2017
For:	ADENA
Examining Attorney:	Martha L. Fromm
Law Office:	106

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
USA

Dear Examining Attorney,

These written arguments are filed in response to the Office Action issued June 30, 2017.

Registration of the applied-for mark is refused under Trademark Act Section 2(d) because of a likelihood of confusion with U.S. Registration No. 5303327 for ADAINA (hereinafter, “the cited mark”). The mark ADAINA was pending registration at the moment of issuing the Office Action but has since then been registered on October 3, 2017. In addition, the identification of goods of the applied-for mark is indefinite and must be clarified. For the reasons stated below, Applicant respectfully requests that the Examining Attorney withdraw the refusals to register and approve the application for publication.

Likelihood of Confusion

(Trademark Act Section 2(d))

A. Both marks are not confusingly similar in appearance, sound, meaning and commercial impression

Applicant respectfully submits that both marks are not confusingly similar in appearance, sound, meaning and commercial impression.

It is well-settled law that “Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different

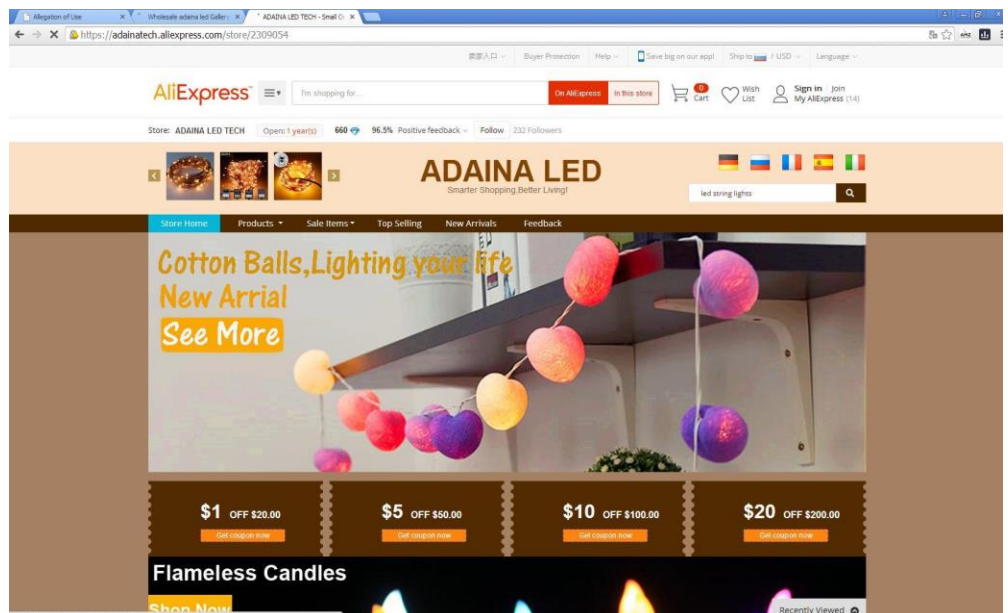
commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted” *TMEP* § 1207.01(b)(iii) (October 2017), referring to *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (*Emphasis added*).

In the case at hand, applied-for mark bears five letters while the registered marks six and their pronunciations are different: applied-for mark is written with an “E” and is pronounced “A-DEE-NA” while the cited mark is written with the letters “AI” and is pronounced “A-DAY-NA”.

The meanings of the marks are also very different. While the cited mark represents a genus of moth in the family *Pterophoridae* (see definition attached in the Evidence section of the Response, in **Exhibit A**), applied-for mark is the first name for a girl, meaning “slender” in Hebrew and “she has saved” in African (see definition attached in the Evidence section of the Response, in **Exhibit B**).

Furthermore, to ascertain the manner or use and the commercial impression engendered by the term sought to be registered, one must look at the specimen of record (see *In re Wakefern Food Corp.*, 205 USPQ; *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 216 (CCPA 1976); *In re Restonic Corp.*, 189 USPQ 248, 249 (TTAB 1975)).

Based on the specimens of use provided to the USPTO for both marks below, the visual impression that the marks create to the consumer «somehow in rush» is very different:



The intention is not to make a side-by-side comparison of the marks, but to demonstrate that the idea and meaning conveyed by both marks differ and therefore consumers cannot be confused by both marks because of their divergent commercial impressions.

B. The goods covered by both marks have different functions, both marks use different trade channels and do not target the same class of consumer

The TMEP advises Examining Attorneys that “[t]he issue is not whether the respective marks themselves, or the goods or services offered under the marks, are likely to be confused but, rather, whether there is a likelihood of confusion as to the source or sponsorship of the goods or services because of the marks used thereon” *TMEP* § 1207.01 (October 2017), referring to *Paula Payne Prods. Co. v. Johnson’s Publ’g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973) (*Emphasis added*).

The TMEP further states that “if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely” *TMEP* § 1207.01(a)(i) (October 2017), referring to *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (*Emphasis added*).

Applicant respectfully submits that both marks do not use the same trade channels, they are not marketed in a such a way that the goods would be encountered by the same persons and they do not target the same class of consumer.

On the one hand, the cited mark’s owner, He Xinxing, for ADAINA (hereinafter, “Registrant”) sells entry-level ready-made lighting of visible light source via different retailers and distributors, such as *AliExpress*, *Ebay*, *Amazon* and *K-Mart* (this is based on their description of goods on the USPTO, their specimen of use provided (see above) and an Internet search (see Internet search attached in the Evidence section of the Response, in **Exhibit C**).

On the other hand, Applicant specifically sells high performance specialty accent light bridges of hidden light source for high-end retail jewelry stores (*Applicant has requested*

an amendment to the identification of its goods to that extent, as discussed in more detail below). The ADENA product's detailed sheet can be found only on Applicant's website where the prices are voluntarily not displayed (<http://www.eklipseighting.com/adena>). Consumers who want to purchase Applicant's goods need to directly contact the company for a quote, by filling out particular information and obtaining an ordering code (the goods are tailor-made), as shown below:

ORDERING CODE

MODEL <input checked="" type="radio"/> Adena	VOLTAGE <input type="radio"/> 12 volts <input type="radio"/> 24 volts	WATTAGE / FOOT <input type="radio"/> 3 W / foot <input type="radio"/> 3.5 W / foot <input type="radio"/> 4 W / foot <input type="radio"/> 4.5 W / foot <input type="radio"/> 5 W / foot <input type="radio"/> 5.5 W / foot <input type="radio"/> 6 W / foot <input type="radio"/> 6.5 W / foot <input type="radio"/> 7 W / foot <input type="radio"/> 7.5 W / foot	LENGTH 10 inches	STEM HEIGHT 1 inches	FINISH <input type="radio"/> Chrome <input type="radio"/> Brushed Chrome <input type="radio"/> Black Chrome <input type="radio"/> Anodized black <input type="radio"/> Gold <input type="radio"/> Brushed Brass <input type="radio"/> Custom	RESOLUTION <input checked="" type="radio"/> Distinct	COLOR <input type="radio"/> 2700 K <input type="radio"/> 3000 K <input type="radio"/> 3500 K <input type="radio"/> 4000 K <input type="radio"/> Custom	WIRE EXIT <input type="radio"/> Left <input type="radio"/> Right
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GET ORDERING CODE ▶

No product is sold in-store, but via a network of lighting professionals (designers, architects, furniture manufacturers, etc.) who are careful, knowledgeable purchasers and would not be confused by Registrant's mark or goods. The marks therefore cannot be found side by side in stores.

Please refer to the list below summarizing the important differences between the products covered by each mark (applied-for mark vs. the cited mark):

- Hidden light source vs. visible light source
- High pricing vs. modest pricing
- Specialty lighting vs. multi-purpose general lighting
- Sold via the company directly vs. via retailers and distributors
- Tailor-made vs. ready-made

In view of these reasons, Applicant respectfully requests favorable reconsideration and withdrawal of this rejection.

Finally, in order to be more specific in the description of goods of its applied-for mark, Applicant requests to amend its goods in International Class 011 as follows (additions are underlined and deletions are crossed out):

Lighting apparatus of hidden light source, namely, high performance accent light bridges specifically designed for specialty applications in high-end retail jewelry stores, ~~lighting installations, lighting fixtures, LED lighting systems and lighting tracks;~~
~~LED (light emitting diodes) lighting fixtures;~~
~~LED (light emitting diodes) lighting fixtures for use in display, commercial, industrial, residential and architectural accent lighting applications;~~
~~LED (light emitting diodes) linear lighting fixtures, surface mounted, suspended or recessed, with or without bus system;~~
~~LED (light emitting diodes) light engines;~~
~~LED (light emitting diodes) luminaires;~~
~~LED (light emitting diodes) lighting fixtures for indoor and outdoor lighting applications;~~
~~LED (light emitting diodes) lighting systems, namely, LED modules, power supplies and wiring;~~
~~LED (light emitting diodes) luminaires;~~
~~accent lights for indoor use.~~

In view of the fact that the marks are similar but not identical, that their meanings are different, that there is no likelihood of confusion between the marks and considering that the identification of goods of the applied-for mark has been clarified, it is submitted that the application is now in good form for approval, which is respectfully requested.

Respectfully submitted,

/Mihaela Dumitrean/

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Date: December 29, 2017