

87/931,178 for STRAWBERRY

Earlier Filed Application

The Office Action has identified Application No. 87/241,130 in the Office Action. Seeing as how this application covers myriad products in many classes, Applicant will reserve its right to respond in the future as the recited goods and classes may be decreased to the point that the '130 application becomes a moot issue.

Section 2(d) Refusal

The Office Action has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, citing a likelihood of confusion with U.S. Registration Nos. 4,634,640 for STRAWBERRY.

The Office Action has apparently based its assertion of the likelihood of confusion with the mark in the cited registration on the doctrine of foreign equivalents, in which foreign language marks are translated into English when "it is likely that an ordinary American purchaser would 'stop and translate' the foreign term into its English equivalent." Palm Bay, 396 F.3d at 1377, 73 USPQ2d at 1696; TMEP §1207.01(b)(vi)(A).

Yet the leading authority has stated that "[t]he doctrine of foreign equivalents should not be transformed into a mechanical and rigid doctrine." 4 McCarthy on Trademarks and Unfair Competition § 23:36 (4th ed.) The Federal Circuit has also stated that "the doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline." McCarthy also observes that a consumer does not really "see" the English translation of a foreign word mark, but "sees only a foreign word mark compared to an English word mark."

This sort of analysis was evident in *Continental Nut Company v. Le Cordon Bleu*, 494 F.2d 1395 (Court of Customs and Patent Appeals 1974). In that case, the marks BLUE RIBBON and LE CORDON BLEU were compared and found not to create any likelihood of confusion based on their different commercial impressions, even though the words LE CORDON BLEU translate exactly into BLUE RIBBON in English. The Court stated that "we are of the opinion that "Blue Ribbon" and "Cordon Bleu" would not have the same significance to the American public." *Id.* at 1396.

No evidence has been provided to demonstrate that the wording LAFRAISE is as well known to Americans as the French term Le Cordon Bleu. It is very unlikely that the average consumer would translate LA FRAISE into English, thus, no confusion with the mark in the cited registration would result.

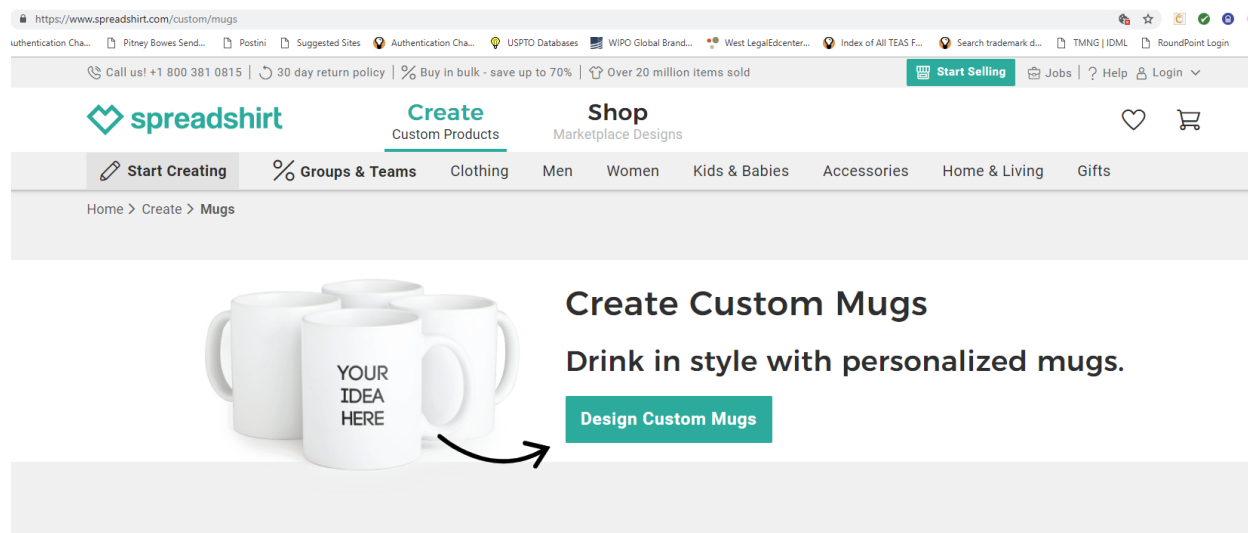
Moreover, this is not a case in which the French term resembles its English translation, as was the case in *In re Anderson* 101 U.S.P.Q. 2d 1912 (Trademark Trial and Appeal Board 2012) (likelihood of confusion found where Applicant's mark FUTURE was refused based on pre-existing registration for FUTURA). Indeed, the appearance and sound of the English word STRAWBERRY in the cited marks bear no resemblance to Applicant's mark, LAFRAISE. Applicant submits that the different commercial impression created by the differences in sound and appearance make a rigid application of the doctrine of foreign equivalents inappropriate in this case.

Additionally, Applicant tried to locate goods in the form of mugs corresponding to use of the LA FRAISE mark. The URL for the registrant’s website in English can be found at:

https://www.spreadshirt.com/#?redirectFrom=de_DE&redirectToken=&affiliateId=1209203

But, the only reference Applicant could find to mugs was a service for creating custom mugs, and in any event makes no reference to LA FRAISE: <https://www.spreadshirt.com/custom/mugs>

A photo of a screenshot of the above referenced page is depicted below:



Based on the foregoing factors, Applicant respectfully asserts that confusion between Applicant’s mark and the marks in the cited registrations and prior pending application are unlikely and requests that the application be passed for publication.

Descriptiveness Refusal

Applicant has modified its description to remove the language “Sets of tasting cups for experiencing different coffee flavor profiles; Tasting cups for experiencing specific coffee flavor profiles; Cups for detecting flavor notes in gourmet coffees; Cups for detecting flavor notes in specialty coffees; Cups for detecting flavor notes in coffees. Applicant is of the belief that this will address the descriptiveness refusal.

Response to Request for Information

A physical specimen of a cup that Applicant intends to sell bearing the STRAWBERRY mark is not yet available. However, Applicant submits similar documentation for goods of the same type in the form of the attached professional photograph of a cup intended to be sold by Applicant bearing the mark

COCOA on its bottom. Applicant expects that the cup it eventually sells bearing the STRAWBERRY mark will be depicted in essentially the same manner, as a word mark with some accompanying similar logos, and on the bottom of the cup. As with the example image, other than the writing on the bottom of the cup, the cup would not include other writing or ornamentation. The cup itself may have a different ornamental shape as compared to the depicted cup, but it is unknown whether any such change in shape would lead to a change in function. As to channels of trade, the cup is principally intended for sale in coffee shops and are directed to consumers that have a sophisticated knowledge of coffees and coffee related equipment.

Espro, Inc., the Applicant, plans to use the STRAWBERRY mark as a source indicator for a coffee cup similar to the illustrated coffee cup. STRAWBERRY is known as a flavor note that can be detected in certain coffees, depending on how the coffee is roasted and brewed. However, the actual cup sold by Applicant that is pictured, or any other cup that Applicant would plan to sell bearing the STRAWBERRY mark, to Applicant's knowledge, would not physically function to enhance STRAWBERRY flavor notes in coffees.

Ornamental Refusal Possible - Advisory

Applicant plans to use the applied for mark in a manner similar to the attached photograph. It is believed that because of this, the STRAWBERRY trademark acts as a source indicator, and not "merely a decorative or ornamental feature of the goods."