TRADEMARK
KNA01 T-112

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examining Attorney	:	Florentina Blandu
Law Office	:	117
Serial No.	:	88/055,263
Filing Date	:	July 27, 2018
Applicant	:	Workrite Ergonomics, LLC
Mark	:	ADVENT & design
Attorney Docket No.	:	KNA01 T-112

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

RESPONSE

Responsive to the Office Action e-mailed November 22, 2018, having a period of response ending May 22, 2018, please enter the following amendment and remarks:

REMARKS

Receipt of the Office Action e-mailed November 22, 2018 (the "Office Action") is acknowledged with appreciation. Reconsideration of the application is respectfully requested.

Amendment to the Identification of Goods

In response to refusal by the Office to register the applied-for mark in connection with desks and standing desks, Applicant, without conceding in the propriety of the rejection and merely to advance the prosecution, hereby would like to amend the listing of goods associated with the applied-for mark, as follows:

> Office desks; Standing desks for offices; all of the foregoing excluding furniture for babies and young children. (Class 20)

Refusal to Register Under Section 2(d) of the Trademark Act

The Examining Attorney has initially refused registration of the mark ADVENT & design in connection with desks and standing desks, on the Principal Register under Trademark Act §2(d), alleging that the proposed mark presents a likelihood of confusion with the mark AVENT & design of U.S. Reg. No. 5,343,144 ("the '144 registration"), and with the mark AVENT of U.S. Reg. No. 5,038,324 ("the '324 registration"). Both the '144 registration and the '324 registration are in connection with various goods for babies and young children (or for the parents or caretakers of babies and young children), including baby furniture and furniture for young children in Class 20.

In the Office Action, the Examining Attorney cites alleged similarity of the marks, similarity in nature of the goods, and similarity of the trade channels as the main contributing factors to support a conclusion by the Office that likelihood of confusion may occur. Applicant respectfully submits that the differences in the marks, the differences in the goods as-amended, the differences in the relevant purchasers, and the differences in the trade channels are more than sufficient to avoid any likelihood of confusion that would bar registration of Applicant's mark under Section 2(d) of the Trademark Act. Accordingly, the Examining Attorney's refusal to register under §2(d) is respectfully traversed.

A. Similarity of the Marks

Applicant respectfully submits that, despite the terms being the foreign equivalents of one another, an ordinary American purchaser would not stop and translate the foreign wording in a mark into its English equivalent and vice versa, because there are several possible and relevant connotations or variations in meaning for the English "ADVENT" and the French "AVENT", such that there is not an unambiguous, literal, and direct English translation for the French word "AVENT". That is, Applicant's mark and the cited marks are not clear and unambiguous synonyms that would be unambiguously translated into one another, particularly since neither the goods of Applicant's mark nor the goods of the cited marks would suggest that the marks would be translated as equivalents, as discussed in the next section of this Response.

"[T]he doctrine of foreign equivalents has evolved into a guideline, not an absolute rule, and is applied only when the 'ordinary American purchaser' would 'stop and translate' the foreign wording in a mark into its English equivalent" (emphasis added).[1] For example, the Federal Circuit reversed the holding of likelihood of confusion where the marks were VEUVE ROYALE (the French equivalent of "Royal Widow") and THE WIDOW, deeming it improbable that American purchasers would stop and translate "VEUVE" into "widow".[2]

The Office relies on the reasoning that since the French language is a common, modern language spoken by an appreciable number of consumers in the United States, the ordinary American purchaser would likely stop and translate the mark. No further evidence or explanation was provided by the Office as to what would prompt an ordinary American purchaser to "stop and translate".

"[T]he English translation evidence is a critical factor for the Board and the courts when determining whether to apply the doctrine"[3], and Applicant respectfully submits that the conclusion made by the Office Action, that an "ordinary American purchaser" would likely "stop and translate" the mark, is flawed for the reasons set forth below.

The T.M.E.P. explicitly states that "[w]here the evidence shows that the English translation is not exact, literal, or direct, the doctrine of foreign equivalents has generally not been applied to find the marks confusingly similar."[4] For instance, the TTAB has held that DOVE for stoves and furnaces, and PALOMA for various forms of gas heating apparatus, were not likely to cause confusion, because, *inter alia*, the Spanish word "paloma" and the English word "dove" are not exact synonyms in that "paloma" can be translated into either "dove" or "pigeon".[5]

In this case, the English word "advent" literally translates into the French language as "avènement". Second, the word "avent" in French means Christian "Advent" in English, i.e.

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[1] T.M.E.P. 1207.01(b)(vi)(A)
[2] *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en* 1772, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005); T.M.E.P. 1207.01(b)(vi)(A)
[3] T.M.E.P. 1207.01(b)(vi)(B)
[4] *Id.*
[5] *In re Buckner Enters*., 6 USPQ2d 1316 (TTAB 1987); T.M.E.P. 1207.01(b)(vi)(B)

holiday season in Christianity before Christmas (arrival of Christ), whereas the word "advent" in English can also mean "a coming into place, view, or being; arrival."[6] Finally, the word "avént" in French is a less common word to also mean "advent". When it is unlikely that an American buyer will translate the foreign mark and will take it as it is, then the doctrine of foreign equivalents will not be applied.[7] Applicant respectfully submits that the ordinary American purchaser would not stop and translate "AVENT" into "ADVENT," as suggested in the Office Action, at least for the reason that there are several other relevant connotations or variations in meaning, such that there is not an unambiguous, literal, and direct English translation for the word "AVENT".

Thus, since the French word "avent" of the cited registration and the English word "advent" of the applied-for mark are not exact synonyms, the doctrine of foreign equivalents should not been applied to find the marks confusingly similar. Furthermore, Applicant also respectfully submits that the two marks contain clear differences in appearance, sound, connotation, and commercial impression so as to further avoid a likelihood of confusion that would bar registration of Applicant's mark under Section 2(d) of the Trademark Act. Moreover, Applicant's ADVENT & design mark presents stark differences in appearance as compared to AVENT & design of the '144 registration.

B. Comparison of the Goods

"When determining the appropriate English translation of the foreign wording in the mark, ***an examining attorney should view the translations in the context of*** any significant features in the mark, such as design or wording elements, ***the identified goods*** and/or services ***in the application***, the relevant marketplace, and the specimen" (emphasis added).[8]

"Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so

[6] *See* https://www.dictionary.com/browse/advent
[7] *In re Tia Maria, Inc*., 188 U.S.P.Q. 524 (T.T.A.B. 1975)
[8] T.M.E.P. 1207.01(b)(vi)(B)

that there is no likelihood of confusion."[9] For example, the TTAB has held that CROSS-OVER for bras and CROSSOVER for ladies' sportswear are not likely to cause confusion because of the different connotations of the terms when applied to the different (albeit related) goods.[10] The TTAB has further held that PLAYERS for men's underwear and PLAYERS for shoes are not likely to cause confusion, also because of the different connotations of the terms when applied to the different (albeit related) goods.[11] The TTAB has further held that BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's clothing not likely to cause confusion, because of the different connotations of the terms when applied to the different (albeit related) goods.[12]

In order to more clearly distinguish Applicant's goods from the furniture for babies and small children, to which the '144 and '324 registrations are directed, Applicant has amended its listing of goods to be "Office desks; Standing desks for offices; all of the foregoing excluding furniture for babies and young children." Thus, for similar reasons that the TTAB has held CROSS-OVER for bras to *not* be confusingly similar to CROSSOVER for ladies' sportswear, PLAYERS for men's underwear to *not* be confusingly similar to PLAYERS for shoes, and BOTTOMS UP for ladies' children's underwear to *not* be confusingly similar to and BOTTOMS UP for men's clothing, Applicant respectfully submits that its mark ADVENT & design for office desks and standing desks for offices, all excluding furniture for babies and young children, would not be confusingly similar to the cited AVENT marks of the '144 and '324 registrations.

Applicant further asserts that the goods of the registered mark are marketed to very different types of purchasers and often travel through different channels of trade as compared to the goods of the applied-for mark, which even further eliminates the possibility of consumer confusion as to the source of origin of the goods.

Accordingly, Applicant respectfully submits that registration of ADVENT & design in connection with office desks and standing desks for offices, all excluding furniture for babies

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[9] T.M.E.P. § 1207(b)(v)
[10] *In re Sears, Roebuck & Co*., 2 USPQ2d 1312, 1314 (TTAB 1987)
[11] *In re British Bulldog, Ltd*., 224 USPQ 854, 856 (TTAB 1984)
[12] *In re Sydel Lingerie Co*., 197 USPQ 629, 630 (TTAB 1977)

and young children, would not present a likelihood of confusion with AVENT of the '144 and '324 registrations because:

1) The doctrine of foreign equivalents is not applicable and the marks are sufficiently dissimilar;
2) Applicant's goods are readily distinguishable from those of the registrant's mark; and
3) The goods of the Applicant and Registrant are marketed to very different purchasers and are for very different purposes, and often travel through different channels of trade.

Request for Publication

In summary, in view of the above amendment to the identification of goods, the established law, and the lack of any registered or pending mark that should bar registration hereof, it is respectfully submitted that ADVENT & design is registrable on the Principal Register. Accordingly, it is respectfully submitted that this application is now in condition for allowance, and publication and a notice to that effect are earnestly and respectfully requested.

Respectfully submitted,

WORKRITE ERGONOMICS, LLC

Date: May 22, 2019

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