

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 88188281	
Mark: EUROLUX	
Applicant: EuroLux Imports, Inc.	
Examiner: Emma Sirignano	Customer No.: 27863
Docket No.: 2069717.0000001	

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RESPONSE TO 02/21/2019 OFFICE ACTION

Dear Examiner Sirignano:

In response to the 02/21/2019 Office Action, please see the Remarks herewith respectfully submitted. Allowance of the application is respectfully requested:

Remarks begin on page 2 of this paper.

REMARKS

I. Section 2(d) Refusal – Likelihood of Confusion

Registration of Applicant's EUROLUX mark has been refused because of the 02/21/2019 Office Action asserting a likelihood of confusion with the mark EUROLUXE, U.S. Reg. No. 3763028 in view of Trademark Act Section 2(d), 15 U.S.C. §1052(d) and TMEP §§1207.01 *et seq.* Respectfully, the *DuPont* factors addressed *infra*, the prevalence of near identical terms in classes likely to bridge the gap into class 020, the frequent usage of the terms EURO and LUX in international class 020 for use with furniture and associate goods, the amended goods/services description provided herewith, and the sophisticated natures of the consumers for the goods offered under each mark support allowance of Applicant's Mark.

A. The Predominance of the *DuPont* Factors Show that Confusion is Not Likely Between Applicant's Mark and the '028 Reg.

Applicant seeks to register EUROLUX for:

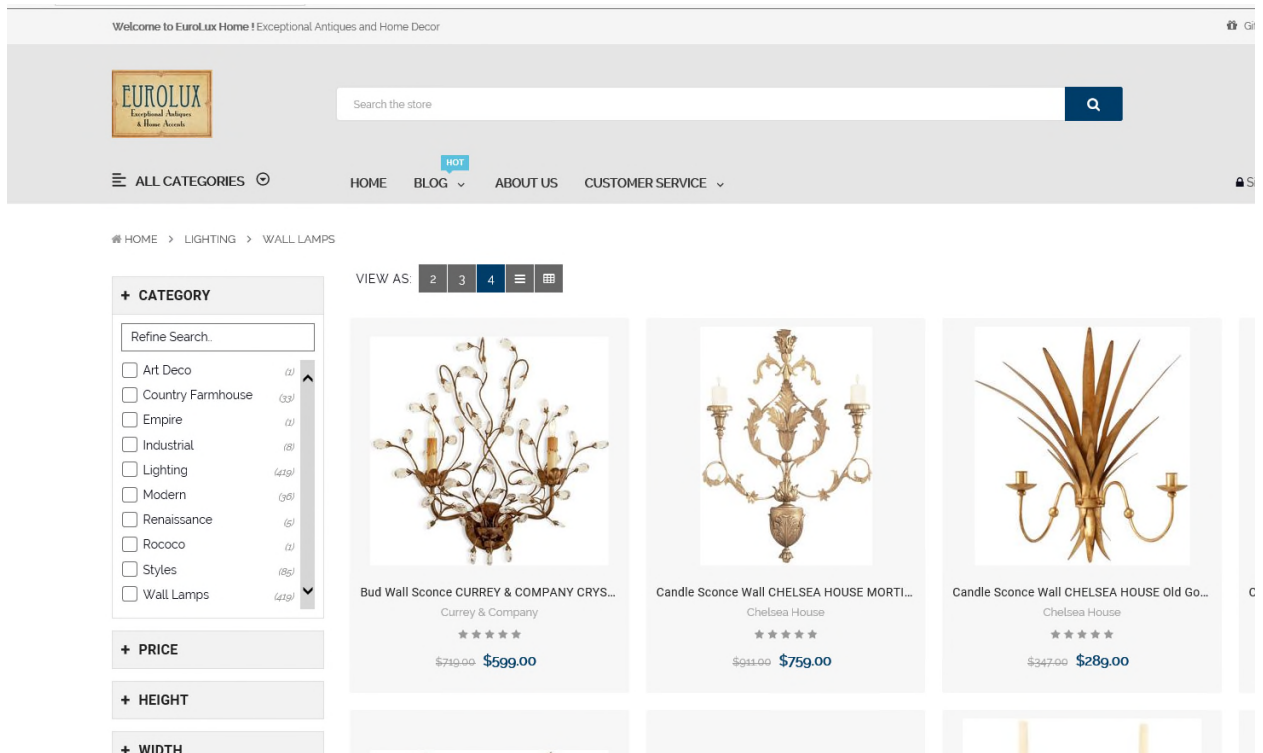
Class 11 – lighting, namely, antique, vintage lighting fixtures, including chandeliers, ceiling lights, and sconces.

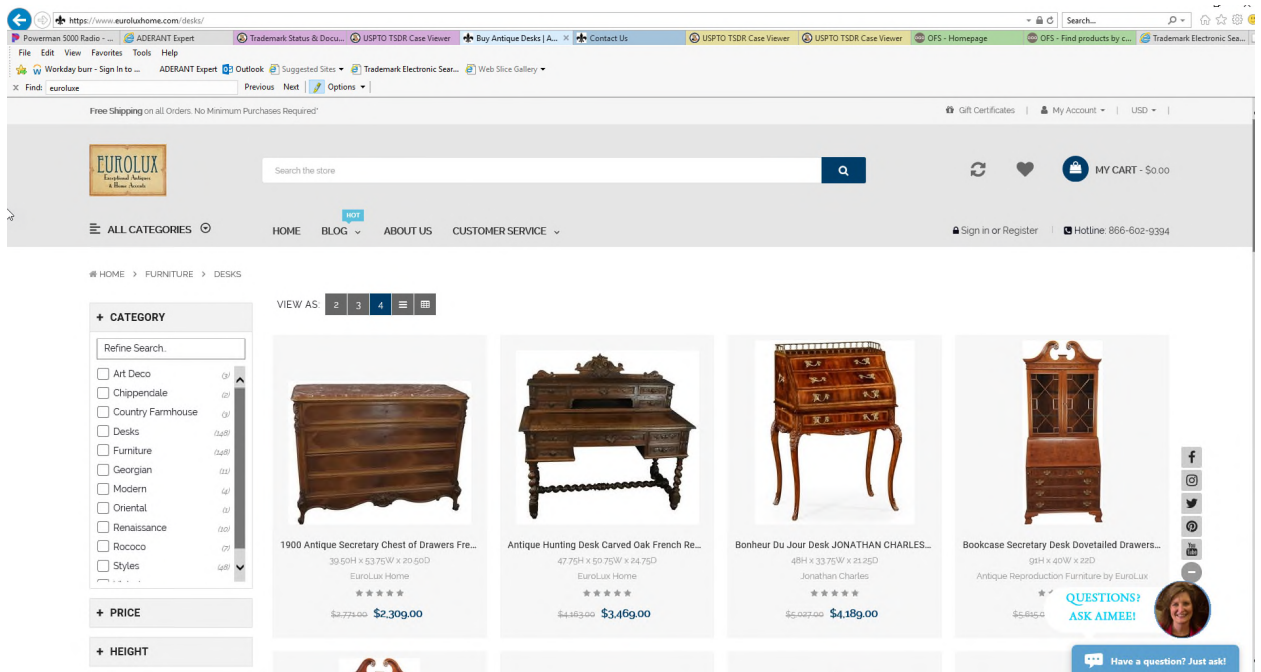
Class 35 – provision of an online marketplace for buyers of vintage imported antique home décor made by others.

(1) With respect to appearance, the marks differ from one another as Applicant's mark is EUROLUX and the '028 Reg. is for EUROLUXE. Additionally, nearly identical marks exist in classes likely to bridge the gap into class 020, see *infra*, and class 020 is replete with marks using EURO and LUX with several uses for furniture, see *infra*. Thus, the commonality of the terms would lead to weak

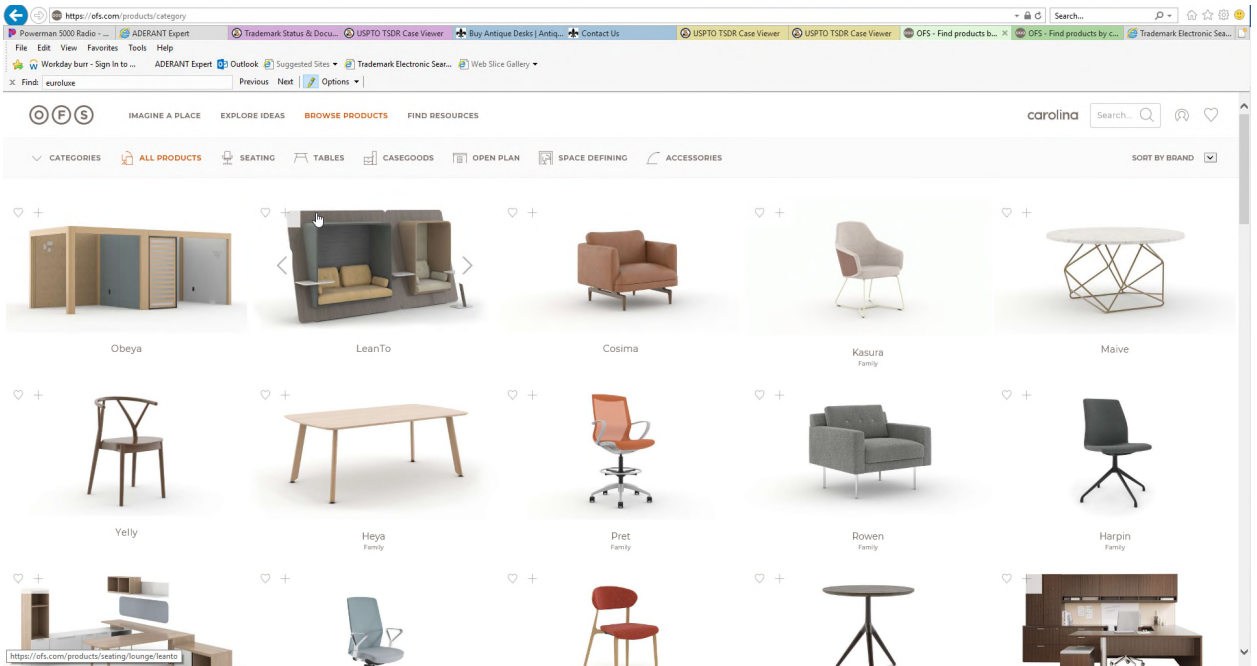
protection and cause consumers to inquire as to the source provider, especially here as the marks differ in appearance from one another, thereby preventing confusion;

(2) The goods/services offered pursuant to Applicant's mark and the '028 Reg. are not related. Applicant provides vintage, antique lighting fixtures such as sconces and an online retail marketplace for buyers of vintage, antique furniture. See below:





Meanwhile, Applicant can find no usage of the ‘028 Reg. on the owner’s website - <https://ofs.com/>. Assuming *arguendo* that the mark is still in use, which is questionable as the Section 9 for the ‘028 Reg. is awaiting completion and the owner’s website states that “our products no longer rely as heavily on wood materials” <https://ofs.com/sustainability>, the products offered on the owner’s website are the polar opposite of vintage, antique furniture:



Those seeking to buy vintage, antique furniture would not seek out the owner's products as they are ultra-modern in style. The dominant features of the goods are styled toward ergonomic and current furniture fashion styles. Consumers of the ultra-modern would not be confused by a website offering vintage, antique furniture and/or antique lighting. Clearly, the goods are not related and no confusion is likely.

(3) The similarity or dissimilarity of established, likely-to-continue trade channels are also different for the marks. While no usage of the '028 Reg. can be found, the products the owner offers are directed toward office furniture, shared spaces, and workstations, see <https://ofs.com/products/application>. Conversely, Applicant's Mark functions in the antique furniture realm and is aimed at collectors of furniture and/or those desiring an antiquity based product.

(6) As explained in more detail *infra*, Applicant's goods as well as those sold under the '028 Reg. will be purchased by sophisticated consumers making careful, deliberate purchases not impulse buys.

(7) As explained *infra*, the number and nature of marks in international class 020, as well as goods/services offered in other international classes likely to bridge the gap into class 020 under nearly identical marks to the '028 Reg., demonstrate the terms EURO and LUX are used with many similar services and goods and afforded narrow protection in class 020.

Thus, the *DuPont* factors dictate that confusion is unlikely between the marks. Therefore, registration of Applicant's mark is respectfully requested.

B. Variations of EUROLUXE are Used With a Variety of Goods/Services and Numerous Registrations using EURO and LUX Exist in Class 020.

A search of TESS for marks using *EURO* and *LUX* reveals sixteen (16) living marks using the terms together including thirteen (13) registrations. These include:

Logout Please logout when you are done to release system resources allocated for you.

Start List At: OR Jump to record: **16 Records(s) found (This page: 1 ~ 16)**

Refine Search (live)[LD] AND (*euro* and *lux*)[COMB]

Current Search: S3: (live)[LD] AND (*euro* and *lux*)[COMB] docs: 16 occ: 74

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	88188281		EUROLUX	TSDR	LIVE
2	88188278		EUROLUX EXCEPTIONAL ANTIQUES & HOME ACCENTS	TSDR	LIVE
3	88188274		EUROLUXHOME	TSDR	LIVE
4	87473126	5500694	NEUROLUX	TSDR	LIVE
5	87543387	5431774	ROMASI EUROPE LUXURY TRAVEL DESIGNERS	TSDR	LIVE
6	87543325	5431773	ROMASI EUROPE LUXURY TRAVEL DESIGNERS	TSDR	LIVE
7	87138777	5198687	EUROLUX FRAGRANCES	TSDR	LIVE
8	87032574	5118286	LUXE D'EUROPA	TSDR	LIVE
9	86515146	5120010	UNIVERSIDAD EX VERITATE LUX A EX LABOREVIRTUS EUROPEA DEL ATLANTICO	TSDR	LIVE
10	86169667	4995703	ATPLAY N. 55 LUKSURIÖSE OG MODERNE DESIGN DEN NORDEUROPEISKE STIL MED TANKER OM NATUREN	TSDR	LIVE
11	86515139	4817096	EX VERITATE LUX A EX LABORE VIRTUS UNIVERSIDAD EUROPEA DEL ATLANTICO	TSDR	LIVE
12	85138219	4013892	EURO DELUXE SERIES	TSDR	LIVE
13	85796587	4593590	EUROLUX	TSDR	LIVE
14	77799793	3763028	EUROLUXE	TSDR	LIVE
15	77341350	3467558	EUROPEAN LUXURY ORGANICS	TSDR	LIVE
16	76451801	2845980	EUROLUX	TSDR	LIVE

EUROLUX – Reg. No. 2845980 - IC 002 - Interior Paints

EUROPEAN LUXURY ORGANICS – Reg. No. 3467558 – IC 024 - Bed sheets, pillow cases, pillow shams, bed blankets, throws, bed skirts, bath sheets, bath towels, washcloths, hand towels, kitchen towels, comforters, duvet covers, blanket covers, and bedspreads; IC 025 Bath robes, robes, kimono, nightwear, pajamas, tank tops, camisoles, and slippers

EUROLUX – Reg. No. 4593590 – IC 011 - Electric toaster ovens; electric coffee makers; electric cordless tea kettles with electric hotplates; hot plates; electric cookware, namely, roasters and broilers

EURO DELUXE SERIES – Reg. No. 4013892 – IC 011 - Toilet seats

EUROLUX FRAGRANCES – Reg. No. 5198687 – IC 003 - Perfume; fragrances; cologne; body spray; non-medicated skin care preparations; After-Shave; Eau De Cologne; Eau De Toilette; Eau De Parfum; Body Lotion; Shower Gel; Personal Deodorants

Additionally, the words EURO and LUX are used extensively throughout class 020 and both are used with furniture.

A search of TESS for (euro)[MP] and (020)[IC] and live [ld] reveals Seventeen (17) living applications and registrations:

Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	88188281	EUROLUX	TSDR	LIVE
2	88188278	EUROLUX EXCEPTIONAL ANTIQUES & HOME ACCENTS	TSDR	LIVE
3	88188274	EUROLUX HOME	TSDR	LIVE
4	87473126	5500694 NEUROLUX	TSDR	LIVE
5	87543387	5431774 ROMASI EUROPE LUXURY TRAVEL DESIGNERS	TSDR	LIVE
6	87543325	5431773 ROMASI EUROPE LUXURY TRAVEL DESIGNERS	TSDR	LIVE
7	87138777	5198687 EUROLUX FRAGRANCES	TSDR	LIVE
8	87032574	5118286 LUXE D'EUROPA	TSDR	LIVE
9	86515146	5120010 UNIVERSIDAD EX VERITATE LUX A EX LABORE VIRTUS EUROPEA DEL ATLANTICO	TSDR	LIVE
10	86169667	4995703 ATPLAY N. 55 LUKSURIÖSE OG MODERNE DESIGN DEN NORDEUROPEISKE STIL MED TANKER OM NATUREN	TSDR	LIVE
11	86515139	4817096 EX VERITATE LUX A EX LABORE VIRTUS UNIVERSIDAD EUROPEA DEL ATLANTICO	TSDR	LIVE
12	85138219	4013892 EURO DELUXE SERIES	TSDR	LIVE
13	85796587	4593590 EUROLUX	TSDR	LIVE
14	77799793	3763028 EUROLUXE	TSDR	LIVE
15	77341350	3467558 EUROPEAN LUXURY ORGANICS	TSDR	LIVE
16	76451801	2845980 EUROLUX	TSDR	LIVE

These include:

EURO LOUNGER - Reg. No. 5505076 – 020 - **Furniture**

EURO REST – Reg. No. 2663759 - IC 020 - **featherbeds**

EURO FOAM – Reg. No. 2717111 - IC 020 - **Mattresses**, boxes springs and mattress foundations

EURO STAR – Reg. No. 2430066 – IC 020 – pillows

EURO TEX – Reg. No. 4576562 – IC 020 - **Mattresses**, box springs, pillows and mattress toppers

EURO RTA – Reg. No. 5057709 – IC 020 - **Kitchen cabinets**, closet cabinets, **bathroom vanities**, and parts and fittings for the aforementioned goods, namely, drawers, shelves and organizational accessories, namely, drawer organizers and non-metal fabric hanging organizers

EURO COMFORT II - Reg. 5391119 - IC 020 - Mattresses and box springs

A search for LUX shows twenty-seven (27) living and registered marks.

Start List At: OR Jump to record: **27 Records(s) found (This page: 1 ~ 27)**

Refine Search (lux)[MN] and (020)[IC] and live[lid]

Current Search: S4: (lux)[MN] and (020)[IC] and live[lid] docs: 27 occ: 81

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	88048958		DREAMBED LUX	TSDR	LIVE
2	88074379		LUX L+L LIVING	TSDR	LIVE
3	88062695		BIO-LUX MAX	TSDR	LIVE
4	88062760		BIO-LUX MARINE	TSDR	LIVE
5	87476952		BIG JOE LUX OUTDOOR	TSDR	LIVE
6	87927431		INTERNATIONAL LUX	TSDR	LIVE
7	87778637	5683582	LUX HOME	TSDR	LIVE
8	86515343	5296776	SOL-LUX	TSDR	LIVE
9	86586605	4974582	KNEE LUX	TSDR	LIVE
10	86596127	4970254	COLOR LUX	TSDR	LIVE
11	86276477	4763135	ELEGANT LUX'OURE INC	TSDR	LIVE
12	86081515	4710398	KALAMAZOO COLLEGE LUX ESTO APRIL 1833	TSDR	LIVE
13	85933295	4779813	LUX TOOLS	TSDR	LIVE
14	85137710	4471153	LUX-LOFT	TSDR	LIVE
15	85382621	4227133	LUX ESTATE	TSDR	LIVE
16	85720802	4459961	LUX BED BY AIRELOOM	TSDR	LIVE
17	85374929	4220372	ROYAL LUX PLUSH BY IDEA NUOVA	TSDR	LIVE
18	85775188	4813209	TRU-LUX	TSDR	LIVE
19	85584348	4340994	LUXES	TSDR	LIVE
20	78555283	3514067	MEMORY-LUX	TSDR	LIVE
21	78267611	2958187	BELLA LUX	TSDR	LIVE
22	77733897	3842612	LUX-GUARD	TSDR	LIVE
23	77072338	3518840	BIO-LUX	TSDR	LIVE
24	76531834	2956542	FIFTH AVENUE LUX	TSDR	LIVE
25	76447441	2843679	MIRROR-LUX	TSDR	LIVE
26	75787324	2551581	CUA DEUS LUX MEA EST	TSDR	LIVE
27	74539189	1967734	ROL-LUX	TSDR	LIVE

TESS HOME NEW USER STRUCTURED FREE FORM Browse Dict SEARCH OG PREV LIST NEXT LIST IMAGE LIST Top HELP

These include:

LUX HOME – Reg. No. 5683582 – IC 020 - **Furniture**; Mirrors

LUX TOOLS – Reg. No. 4779813 - IC 020 - **Furniture parts**, namely, legs for tables, chairs, and desks; furniture; mirrors; picture frames; drawer pulls of plastic or wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials; dowels not of metal; window fittings, not of metal; furniture

fittings, not of metal; non-metal door fittings; non-metal locks; tables; storage racks; tool chests not of metal; door snakes, namely, stuffed textile tube draft stoppers for doors; furniture cabinets; plastic shipping and storage boxes; plastic boxes; workbenches; industrial work tables; handles for tools and garden implements, not of metal; plastic key chains; non-metal clamps; non-metal fasteners, namely, bolts, screws, nuts, washers, rivets, and hooks; non-metal pallets; nonmetal and non-paper containers for storage or transport; non-metal ladders; non-metal stepladders; non-metal slides for furniture; furniture parts, namely, table and chair feet made of wood and plastic; coat hangers; non-metal furniture casters

ROL-LUX - Reg. No. 1967734 - IC 020 - roller shades for windows and doors

MIRROR LUX -Reg. No. 2843679 - IC 020 – Bathroom Mirrors

BIO-LUX - Reg. No. 3518840 - IC 020 - polyurethane foam seat and back

furniture cushions and visco-elastic foam mattresses.

LUX GUARD – Reg. No. 3842612 - IC 020 - flexible polyurethane foam seat and back furniture cushions

LUXES – Reg. No. 4340994 – IC 020 - Coffins; Funerary urns; Mattresses; Picture frames; Plastic boxes; Wood boxes; Works of art of wood, wax, plaster or plastic; Works of art of wicker

LUX ESTATE – Reg. No. 4227133 – IC 020 - Box springs; Mattresses

Given the near identical usages in classes likely to bridge the gap into class 020, as well as the dozens of registrations in class 020 that use combinations of EURO and/or LUX, EUROLUXE is entitled to narrow protection, even within its own class. This is especially true given that it restricts its goods to “furniture *featuring a wood preservative*,” which would not include lighting nor vintage, antique furniture, wherein wood preservatives are unheard of and undesired as they impact the color

and style of the wood composing the furniture. Accordingly, Applicant's Mark should be allowed and same is respectfully requested.

C. Consumers of Vintage and Antique Lighting and Furniture are Sophisticated Purchasers and Very Source Conscious.

Applicant's Mark for EUROLUX for antique lighting and an online marketplace for vintage, antique furniture is not likely to be confused with EUROLUXE as shown by the *DuPont* analysis, *supra*, and the numerous registrations using EURO and LUX, in class 020 and similar classes, see *supra*. Allowance of Applicant's Mark is further supported by the unique nature of the goods offered by Applicant coupled with the sophisticated nature of the consumers purchasing those goods.

Applicant provides antique lighting, namely, antique, vintage lighting fixtures, including chandeliers, ceiling lights, and sconces and provides an online marketplace for buyers of vintage, imported antique home décor made by others. The goods offered under the '028 Reg., which Applicant assumes *arguendo* as no usage can be found at present, is made-to-order, ultra-modern workplace furniture focused on contemporary and cutting-edge current fashion and style choices that includes a wood preservative. Clearly, purchasers of antique lighting fixtures and vintage, antique furniture would not be confused as to the goods offered under the marks.

Accordingly, the services provided under Applicant's Mark are provided to a sophisticated, specialized, knowledgeable and well-informed consumer base. Thus, the users of Applicant's services, consumers seeking imported antique furniture and lighting fixtures, would be highly discerning given the desire for antique furniture.

The same holds true for purchasers of the ultra-modern furniture provided by the owners of the '028 Reg. Thus, allowance and registration of Applicant's Mark is respectfully requested.

II. Amendment to Goods/Services

Please amend the classes to read:

Class 11 – lighting, namely, antique, vintage lighting fixtures, including chandeliers, ceiling lights, and sconces.

Class 35 – provision of an online marketplace for buyers of vintage imported antique home décor made by others.

III. Request to Hold Applicant in Abeyance

If the above arguments are not found persuasive, Applicant requests this application be held in abeyance until the EUROLUXE mark pays the requisite fees or expires.

IV. Conclusion

Applicant respectfully submits that the application is in condition for allowance. Favorable action thereon is respectfully requested. The Examiner is encouraged to contact the undersigned should any questions arise regarding this matter or if any additional information is required.

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Respectfully submitted,

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