

Response to Office Action

1. Introduction

In the Office Action mailed March 15, 2019, Applicant's DISCOVERY mark for "*Furniture; tables with built-in topside storage units*" in Int'l Class 20 ("Applicant's Mark") stands refused registration on the grounds that the Examining Attorney believes that Applicant's Mark is confusingly similar to the registered mark DISCOVERY, Reg. No. 3,102,624 for "*Bedroom and living room furniture*" in Int'l Class 20 (the "First Cited Mark")(emphasis added) and provisionally refused registration as potentially confusingly similar to the following mark



Reg. App. No. 87/116,438 for "*Home décor, namely, mirrors, pillows, picture frames; camping and fishing articles, namely, sleeping bags, chairs, cots*" in Int'l Class 20 (the "Second Cited Mark")(emphasis added).¹

2. The Fact that the Second Cited Mark was Allowed for Publication in View of the Registration of the First Cited Mark Undermines the Argument that Applicant's Mark is Confusingly Similar to the First Cited Mark.

As a preliminary matter, and solely comparing the First Cited Mark with the Second Cited Mark, there is a clear and obvious overlap in identifiers. More specifically, and notwithstanding the fact that the Second Cited Mark is identical in sound, and nearly identical in sight to the First Cited Mark, the First Cited Mark is registered for "*Bedroom and living room furniture*" and the Second Cited Mark includes "*chairs*" and "*cots*", which begs the question – are not "cots" and "chairs" oft times found in "bedrooms" and "living rooms," respectively? ²

The Applicant's Mark relates to highly specialized goods, i.e. "*tables with built-in topside storage units*". As is clear from Applicant's website, it is a vendor of tables and seating combinations of the type that are not found in "bedrooms and living rooms".³

That said, the identifier of the Applicant's Mark has been amended, as stated in Section 3 below, to eliminate the word "*Furniture*" which significantly narrows the goods to which the Applicant's Mark will be applied. The goods have been further narrowed by Applicant's identification of the settings within which the goods will be used, which are clearly not bedrooms and living rooms. Applicant respectfully submits that a continued refusal to register the Applicant's Mark cannot be reconciled with the overlap in goods recognized above relative to the identifiers under the First Cited Mark and the Second Cited Mark.

On this basis alone, Applicant's Mark should not be refused registration.

¹ See attached Exhibit A and note that the owners of the First and Second Cited Marks are different.

² With the additional common knowledge that "chairs" can be found in both bedrooms and living rooms.

³ See www.palmerhamilton.com and Exhibit E attached hereto and referenced in Section 5 *infra*.

3. Amendment to Applicant's Identifier of Goods

As alluded to in Section 2 above, Applicant hereby amends its identifier of goods to the following:

~~“Furniture; tables with built-in topside storage units for educational and commercial use”~~ in Int'l Class 20.

Using this amended identifier clearly narrows the scope of the goods and clearly distinguishes the goods of the Applicant's Mark with the goods of the First Cited Mark, the latter being clearly for home use as opposed to the clear non-home use of the former. Accordingly, the customers to whom the goods are to be sold and the trade channels within which the goods will be sold are substantially and distinctively different.

4. Further TESS Evidence Supporting Applicant's Arguments in Sections 2 and 3

A federally registered DISCOVER mark⁴ for “*Classroom furniture, namely, chairs, desks and combination chair-desks*” in Int'l Class 20 further supports allowance of the Applicant's Mark over both the First Cited Mark and the Second Cited Mark. With respect to the marks mentioned herein, it is clear that this Office has drawn a distinction between the following types of furniture:

<i>Chairs, desks, and combination desk chairs</i>	Reg. 3,513,078
<i>Bedroom and living room furniture</i>	First Cited Mark
<i>Chairs and cots et al.</i>	Second Cited Mark

In view of the above-mentioned distinctions, Applicant's Mark, drawn to highly specialized *tables* – not chairs, not desks, not combination desk chairs, not cots and not bedroom or living room furniture – should be allowed registration as well.

5. Confusion Is Unlikely Under the Du Pont Factors as Well

The Court in *In re E.I. Du Pont De Nemours & Co.*, 476 F.2d 1357 (C.C.P.A 1973), articulated thirteen factors to consider in determining whether there is a likelihood of confusion between two marks, adding that there is “no litmus rule” for determining likelihood of confusion. Not all of the *Du Pont* factors will be relevant to every case. Only those factors of relevance to each case need to be weighted and considered. See 4 McCarthy, Trademarks and Unfair Competition, Section 23:79 (5th Ed. 2019).

There is no hard and fast rule that likelihood of confusion must automatically be found to exist if there is a similarity in any one of these elements. *In re Software Design, Inc.*, 220 U.S.P.Q. 662 (T.T.A.B. 1983). Each case must be decided on its own facts, based upon an

⁴ Which is also a standard character mark. See TESS printout attached hereto as Exhibit B.

examination of all of the elements and a consideration of any similarities or differences between the goods and/or services to which the respective marks are applied. *Id.* (citations omitted).

However, the second factor – the goods to which the respective marks are applied – is paramount in this case. And that position does not rest on a judgment concerning the goods at the outset. Instead, the following is recognized:

The statement that, “The goods and services of the parties are related,” is not an observation that can be made off the cuff at the beginning of the analysis. Rather, it is a conclusion to be made after a full analysis of the facts shows that there is a likelihood of confusion as to source, affiliation, sponsorship or connection because of the similarity of the marks and other facts in the case (emphasis added).

4 McCarthy, Trademarks and Unfair Competition, Section 24:24 (5th Ed. 2019).

In *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108 (2nd Cir. 2006), the court observed:

The similarity of the marks is a key factor in determining likelihood of confusion. To apply this factor, courts must analyze the mark’s overall impression on a consumer, considering the context in which the marks are displayed and the totality of factors that could cause confusion among prospective purchasers (citations omitted; emphasis added). 454 F.3d at 116-17.

In applying this test to the instant case, there can be no confusion because, when the “totality of factors” is considered, the First Cited Mark is purportedly displayed to the public as follows ⁵



⁵ As per the specimen filed with a renewal application for the First Cited Mark filed June 1, 2016. The mark shown in the specimen is more akin to the mark shown in Reg. No. 2,996,563. See attached **Exhibit C**. See also footnote 6 *infra*.

Although the Applicant's Mark and the First Cited Mark are both standard character Marks, the First Cited Mark, as used, is highly distinctive as compared with a standard character version, such as the Applicant's Mark. Therefore, the marks are distinguishable when the Marks are looked at in their entireties, as is required when comparing two Marks.

It is also clear that the "test" applied is based on "the similarity or dissimilarity and nature of the goods" (emphasis added). 4 McCarthy, Trademarks and Unfair Competition, Section 23:79 (5th Ed. 2019). The "nature" of the goods, by this Office's own perspective and prosecution of other marks, undeniably demonstrates that the nature of the goods are different. By simply looking at the home page for the owner of the First Cited Mark, the owner's "mission statement" is as follows:

"To design, manufacture and maintain sufficient inventory to facilitate consistent just-in-time wholesale delivery of quality youth bedroom furniture, that meets the highest consumer safety standards, with styling that appeals to the mass market and provides unparalleled function at prices reflecting the absolute best value in the furniture industry." (emphasis added) ⁶

By comparison, the Applicant's website states the following:

Palmer Hamilton offers the most extensive and diverse selection of cafeteria tables available to meet all needs and budgets. Choose from high quality mobile bench tables, round stool tables or wall pocket systems.

* * *

Flexible furniture for flexible spaces. Contract mobile, storeable, functional furniture for higher education, corporate, healthcare, libraries and hospitality markets. ⁷

Clearly, the "nature" of the goods are different as are the channels of trade and the customers who visit the respective websites of the owners in those channels of trade.

6. Conclusion

Applicant respectfully submits that, based on the database of this Office and the arguments and evidence presented herein, confusion of its mark with the First Cited Mark is not likely.

In view of the foregoing, Applicant respectfully requests that this application be approved for prompt publication. Kindly reconsider.

⁶ See attached Exhibit D, which is the home page of www.discoveryworldfurniture.com.

⁷ See attached Exhibit E, which is the home page of www.palmerhamilton.com.

EXHIBIT A



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Word Mark	DISCOVERY
Goods and Services	IC 020. US 002 013 022 025 032 050. G & S: Home décor, namely, mirrors, pillows, picture frames; camping and fishing articles, namely, sleeping bags, chairs, cots
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	01.07.01 - Globes with outlines of continents
Serial Number	87116438
Filing Date	July 26, 2016
Current Basis	1B
Original Filing Basis	1B
Published for Opposition	October 24, 2017
Owner	(APPLICANT) Discovery Communications, LLC LIMITED LIABILITY COMPANY DELAWARE One Discovery Place Silver Spring MARYLAND 20910
Attorney of Record	Anthony V. Lupo
Description of Mark	Color is not claimed as a feature of the mark. The mark consists of the word "DISCOVERY" adjacent from the left to a globe design, superimposed over the letter "D" in "DISCOVERY".
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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EXHIBIT B



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DISCOVER

Word Mark	DISCOVER
Goods and Services	IC 020. US 002 013 022 025 032 050. G & S: Classroom furniture, namely, chairs, desks, and combination chair-desks. FIRST USE: 20080225. FIRST USE IN COMMERCE: 20080225
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	77035617
Filing Date	November 2, 2006
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	June 5, 2007
Registration Number	3513078
Registration Date	October 7, 2008
Owner	(REGISTRANT) Artco-Bell Corporation CORPORATION TEXAS 1302 Industrial Blvd. Temple TEXAS 76504
Attorney of Record	Cynthia R. Adwere
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20180430.
Renewal	1ST RENEWAL 20180430
Live/Dead Indicator	LIVE

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EXHIBIT C



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Word Mark	DISCOVERY WORLD FURNITURE
Goods and Services	IC 035. US 100 101 102. G & S: Wholesale distributorship featuring furniture. FIRST USE: 20040108. FIRST USE IN COMMERCE: 20040108
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	01.07.02 - Globes with meridians and parallels only 01.07.25 - Globes, other 26.01.02 - Circles, plain single line; Plain single line circles 26.01.12 - Circles with bars, bands and lines
Serial Number	76572578
Filing Date	January 27, 2004
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	June 28, 2005
Registration Number	2996563
Registration Date	September 20, 2005
Owner	(REGISTRANT) Waterfall Industries, Inc. CORPORATION FLORIDA 915 Cornwall Road Sanford FLORIDA 32773
Attorney of Record	William M. Hobby, III
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "FURNITURE" APART FROM THE MARK AS SHOWN
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20150925.

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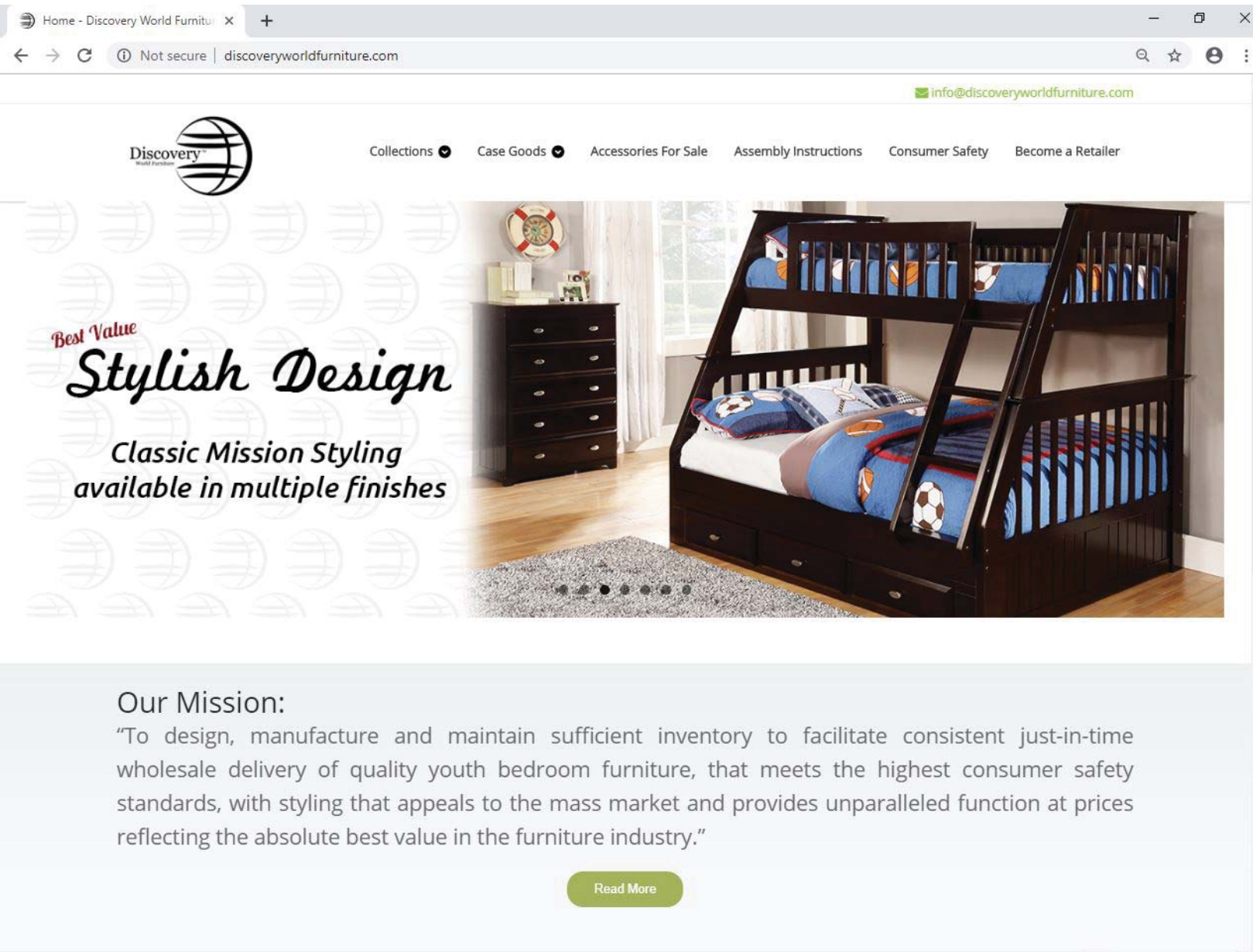
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EXHIBIT D



The screenshot shows a web browser window with the URL discoveryworldfurniture.com. The page features a navigation menu with links for Collections, Case Goods, Accessories For Sale, Assembly Instructions, Consumer Safety, and Become a Retailer. The main content area displays a dark wood bunk bed set with a blue and white patterned bedding. To the left of the image, the text reads: "Best Value Stylish Design Classic Mission Styling available in multiple finishes". Below the image, there is a "Read More" button. In the bottom right corner, there is a "Leave a Message" button.

Home - Discovery World Furniture x +

Not secure | discoveryworldfurniture.com

info@discoveryworldfurniture.com

Discovery World Furniture

Collections Case Goods Accessories For Sale Assembly Instructions Consumer Safety Become a Retailer

Best Value
Stylish Design
Classic Mission Styling
available in multiple finishes

Our Mission:
"To design, manufacture and maintain sufficient inventory to facilitate consistent just-in-time wholesale delivery of quality youth bedroom furniture, that meets the highest consumer safety standards, with styling that appeals to the mass market and provides unparalleled function at prices reflecting the absolute best value in the furniture industry."

Read More

Leave a Message

EXHIBIT E

The screenshot shows a web browser window with the URL palmerhamilton.com. The page features a navigation bar with links for Company, Resources, Find a Rep, Contact, and a phone number 800.788.1028. The main content area includes the palmerHAMILTON logo, a menu with 'All Products' and 'Markets & Settings', and a hero image of a cafeteria with tables and chairs. The hero image has the text 'Mobile, Flexible, Storable Dining Solutions'. Below the hero image is the PHabLAB logo with the tagline 'Empowering Educators, Engaging Students' and a note 'Available in November. Please click here for more information.' The page is divided into three columns: the left column features the palmerHAMILTON logo and text about cafeteria tables; the middle column features the nomad logo and text about flexible furniture; the right column features the PHDesign logo and text about turn-key design services. A Windows taskbar is visible at the bottom of the browser window.

palmerHAMILTON

All Products Markets & Settings palmerHAMILTON nomad PHDesign

Mobile, Flexible, Storable Dining Solutions

PHabLAB

Empowering Educators, Engaging Students

Available in November. Please [click here](#) for more information.

palmerHAMILTON

Palmer Hamilton offers the most extensive and diverse selection of cafeteria tables available to meet all needs and budgets. Choose from high quality mobile bench tables, round stool tables or wall pocket systems.

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nomad
by palmerHAMILTON

Flexible furniture for flexible spaces. Contract mobile, storeable, functional furniture for higher education, corporate, healthcare, libraries and hospitality markets.

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PHDesign

Palmer Hamilton Design provides a turn-key service, including pre-design consultation with students and staff, design presentations of layout and graphics and selection of furnishings all the way through manufacturing and installation– all coordinated and managed by one team. Generate ideas and be inspired with our **PH Design Before and After Book**.

2:31 PM
9/16/2019