

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

September 24, 2019

Applicant : Powerficient, LLC
Mark : **ETERNA**
Serial No. : 88/237,346
Int'l Class : 009
Filed : December 20, 2018
Examiner : Nicholas A Coleman
Law Office : 107
Our File No. : 12551.6701

**AMENDMENT AND RESPONSE
TO OFFICE ACTION MAILED MARCH 24, 2019**

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

Responsive to the Office Action dated March 24, 2019, please consider the enclosed amendment and remarks. Applicant submits that the application is in condition for publication.

Serial No. 88/237,346
September 24, 2019
Page 2 of 11

IN THE IDENTIFICATION OF GOODS

Please amend the identification of goods in International Class 009 to read as follows:

“Uninterruptible power systems for data centers and mission critical power facilities”

REMARKS

The Office Action mailed March 24, 2019 has been carefully considered. Applicant appreciates the Examining Attorney's efforts in conducting a comprehensive examination. Registration was initially refused based on the Examining Attorney's determination that Applicant's mark ETERNA (stylized), used in connection with uninterruptable power supplies, is likely to be confused with the prior registered mark Aeterna, registered in connection with a host of goods including *power supply connectors*. Further, the Examining Attorney identified a prior pending application for ETERNA that raised a potential for an additional likelihood of confusion refusal.

I. THERE IS NO LIKELIHOOD OF CONFUSION

In considering the differences in the marks, the focus should be on the effect of the sight, sound, meaning, and commercial impression created by the respective marks. *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

Although the weight given to the relevant *du Pont* factors may vary, the following two factors are key considerations in any likelihood of confusion determination: (a) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; and (b) the relatedness of the goods or services as described in the application and registration(s). *See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) ; *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB

2010); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1244 (TTAB 2010) ; *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) .

A significant factor in determining likelihood of confusion involves the overall commercial impressions created by the respective marks. In comparing the marks, they should not be dissected, but rather the total commercial impression of each mark should be considered. *Franklin Mint Corp. v. Master Mfg. Co.*, 212 U.S.P.Q. 233 (C.C.P.A. 1981). Applicant submits that the analysis conducted by the Examining Attorney involves dissection of the marks and thus fails to attribute proper weight to the overall commercial impression conveyed by the respective marks.

A. The Marks are Dissimilar in Overall Appearance, Pronunciation, and Commercial Impression.

Applicant's mark ETERNA differs substantially from the cited mark AETERNA in appearance, pronunciation and commercial impression such that there is no confusing similarity between the respective marks.

The Examining Attorney relies on a line of cases directed to incorporation of the entirety of one mark within another, e.g. California Concept / Concept; Bengal Lancer / Lancer; Barr Group / Barr etc. In each of the cited cases the mark at issue incorporates an entire word from a previously registered or filed mark as a stand-alone word. Such is not the case here. Applicant's mark has not incorporated AETERNA. The Examining Attorney's analysis resorts to dissecting

the cited mark AETERNA by removing the “A” to reach a conclusion of similarity.

Initially, Applicant notes that the fact that two marks share an identical term is not an automatic basis for a finding of likelihood of confusion. *See, Colgate-Palmolive Company v. Cater-Wallace Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (PEAK PERIOD not confusingly similar to PEAK); *Application of Ferrero*, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973)(TIC TAC for candy not confusingly similar to TIC TAC TOE for ice cream). By way of example, in the field of hotel services, the USPTO has allowed registration of JOHNSON & WALES for hotel services (Reg. No. 2,220,475), notwithstanding the prior registration of HOWARD JOHNSON for hotel services (Reg. No. 1,506,553). Similarly, in the field of banking services, the USPTO has allowed registration of FRIENDLY PEOPLE FOR TODAY’S BANKING (Reg. No. 2,911,289), STRONG, CONSERVATIVE, FRIENDLY (Reg. No. 2,969,372), and YOUR FRIENDLY, BILLION-DOLLAR BANK (Reg. No. 2,542,947), notwithstanding the common use of the term “FRIENDLY.” It is thus submitted that the mere commonality of portions of Applicant’s mark with portions of the cited mark alone fails to support refusal under Section 2(d).

In *Oakville Hill Cellars, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376 (Fed. Cir. 2016), the Federal Circuit again cautioned that marks must be considered in their entirety where the marks at issue were MAYARI and MAYA, both used in connection with identical goods. In that case the Federal Circuit found no basis for dissecting MAYARI into MAYA- and -RI, and there was no reason for a customer to view the mark logically as MAYA plus RI, rather than as a

single unitary expression. *Id.* Even assuming that consumers were to dissect MARARI into separate components, there was a failure to demonstrate why the dissection would be “MAYA-RI,” not “MAY-ARI” or “MY-YARI.” *Id.* Applicant submits that the Examining Attorney’s analysis in this case is identical to the flawed analysis discussed by the Federal Circuit in the Oakhill Cellars case. More particularly, the Examining Attorney has improperly dissected the mark AETERNA into “A” and “ETERNA” when determining a likelihood of confusion, and there is no basis to find that even if consumers were to dissect that mark that the dissection would not be “AE-TERNA” or “AET-ERNA” or even “AETER-NA”.

Further, consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ.2d 1895, 1897 (TTAB 1988)(“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions). In this case, Applicant’s mark begins with an “E” wherein the cited mark begins with an “A.” Thus, the marks remain dissimilar, overall, because of the such differences.

The inclusion of an “A” at the beginning of the cited mark AETERNA further results in differences in the pronunciation as the “A” results in the pronunciation of a long “E” (whereby the pronunciation would be similar to “eat-erna”). In contrast, Applicants mark ETERNA is pronounced with a short “E” (whereby the pronunciation is similar to “et-erna”).

The marks must be considered in the way in which they are perceived by the relevant public, and not considered after hyper-technical dissection. *In Re Shell Oil Company*, 992 F.2d 1204, 1206 (Fed. Cir. 1993) (The marks must be considered in the way in which they are perceived by the relevant public); *See, also In re Best Products, Co., Inc.* 231 USPQ 988 (TTAB 1986) (BEST JEWELRY and design for retail jewelry store services held not likely to be confused with JEWELERS' BEST for jewelry). Further, phonetic similarity alone is insufficient to establish likelihood of confusion. *See, Old Tyme Food, Inc. v. Roudy's Inc.*, 961 F.2d 200, 203 (Fed. Cir. 1992).

Upon application of the principles set forth above, Applicant submits that its mark ETERNA conveys a dissimilar commercial impression relative to the cited mark AETERNA. Applicant respectfully submits that the Examining Attorney's analysis fails to attribute proper weight to distinct differences in appearance, sound, and commercial impression.

Accordingly, the differences between the marks in overall appearance, pronunciation, meaning, and commercial impression are sufficient to avoid a likelihood of confusion. Applicant respectfully requests that the refusal under Section 2(d) be withdrawn.

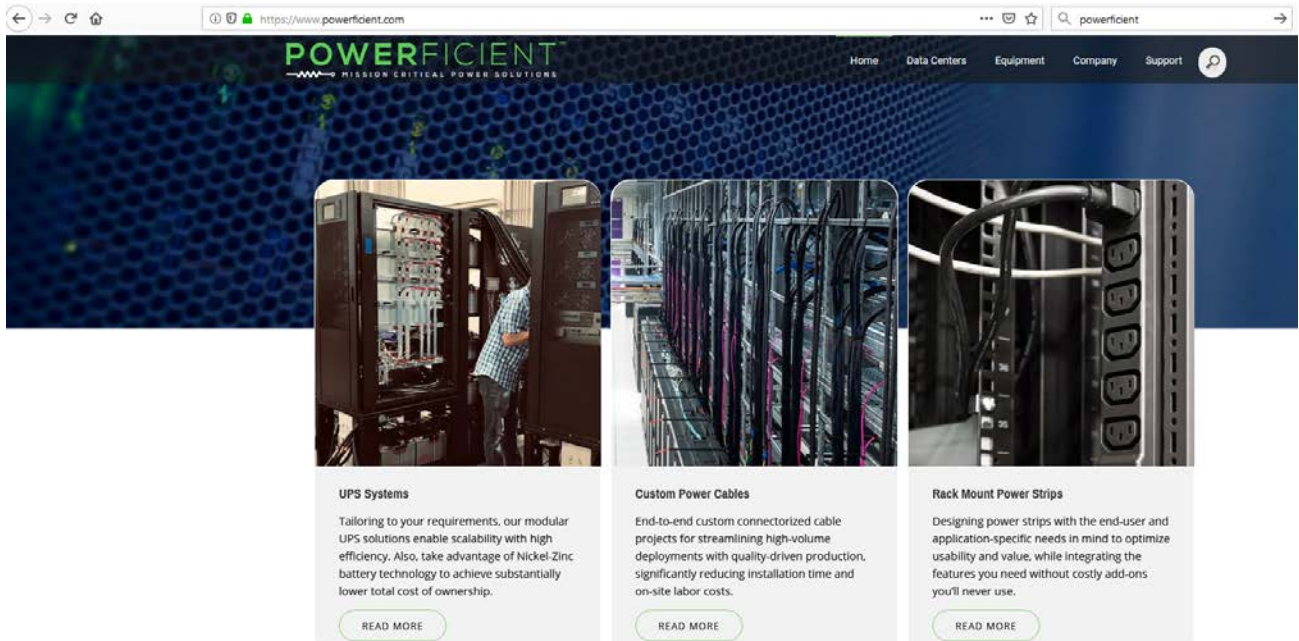
B. Differences in the Respective Goods and Channels of Trade.

The cited AETERNA mark is registered in connection with a variety of relatively low-cost consumer goods, namely:

3D spectacles; Cabinets for loudspeakers; Camcorders; Cameras; Carrying cases, holders, protective cases and stands featuring power supply connectors, adaptors, speakers and battery charging devices, specially adapted for use with handheld digital electronic devices, namely, cell phones, MP3 players, personal

digital assistants; Computer mouse; Computer peripheral devices; Earphones; Electrical annunciators; Global positioning system (GPS); Goggles for sports; Head guards for sports; Headphones; Microphones; Pedometers; Protective helmets for sports; Radios; Rechargeable batteries; Smartphones; Sunglasses; Telescopes; Time recording apparatus; Tripods for cameras; Video baby monitors

Applicant has amended the recitation of goods to more narrowly define the goods used in connection with its mark ETERNA as “*uninterruptable power systems for use in data centers and mission critical power facilities.*” Applicant’s goods are industrial scale uninterruptable power systems as evidenced by the screenshot below taken from Applicant’s website. See, www.powerficient.com.



Applicant’s uninterruptible power systems are produced in high voltages such as 208v/120v (3 phase), 415v/240v (3 phase), 480v/277v (3phase), with rated power capacities up to 300kVA, far above anything that a purchaser of computer peripherals would purchase. A screen shot taken from Applicant’s website (www.powerficient.com) evidencing the industrial scale of Applicant’s goods is shown below. Accordingly, the relevant consumer of Applicant’s goods is an industrial consumer, whereas the relevant consumer of goods associated with the cited mark are individual retail consumers. The differences in respective goods and relevant consumers is sufficient to avoid any likelihood of confusion.

	208V / 120V (3 PHASE) 10KVA - 300KVA		415V / 240V (3 PHASE) 25KVA - 300KVA		480V / 277V (3 PHASE) 20KVA - 200KVA		
Modular UPS System Rated Capacities (kVA)	20kVA	30kVA	50kVA	60kVA	120kVA	180kVA	300kVA
Modular UPS System Rated Capacities (kW)	20kW	30kW	50kW	54kW	108kW	162kW	270kW
Power Module Capacity	10kVA / 10kW			30kVA/27kW			

The respective marks are clearly linked and purchased through different markets, by different consumer classes, and for different uses and purposes.

C. Consumers of Food Products Exercise Care and Thought in Their Purchase

The sophistication of the purchaser for Applicant's and registrant's goods is a highly relevant factor regarding lack of consumer confusion. If goods or services are purchased by consumers that are known to exhibit particular care in purchasing, there is less likelihood of confusion. *In re Ship*, 4 U.S.P.Q.2d 1174, 1176 (TTAB 1987). As noted above, Applicant's goods are designed for and installed in industrial applications wherein electrical engineers provide detailed specifications as to the requirements for such goods. The purchasers of Applicant's goods thus exercise particular care in selecting Applicant's goods. The high degree of care exercised by consumers weighs against a finding of likelihood of confusion.

CONCLUSION

Applicant has fully responded to the issues and requirements raised by the Examining Attorney. It is believed that the application is in immediate condition for publication.

Serial No. 88/237,346
September 24, 2019
Page 11 of 11

Should the Examining Attorney feel that a telephone interview would expedite the registration of this application, he is respectfully requested to telephone the undersigned.

Respectfully submitted,

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Date: September 24, 2019

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