

UNITED STATES PATENT AND TRADEMARK OFFICE

**U.S. Application Serial No.:** 88361875

**Mark:** JADE

**International Class:** 009

**Applicant:** Vante, Inc.

**Examining Attorney:** Martha Santomartino

**RESPONSE TO NONFINAL OFFICE ACTION**

Applicant Vante, Inc. (“Applicant”) respectfully submits this response to the Office Action issued against Application Serial No. 88361875 for the standard character mark JADE (“Mark”).

Summary of issues in the Office Action:

- Refusal of registration on the grounds that Applicant's mark is confusingly similar to a registered mark.
- Identification of goods requires clarification and amendment

Applicant’s response follows.

**Amendment of Identification of Goods**

An amendment to the identification of goods has been required. Concurrently herewith, the identification of the goods has been amended to read as follows:

*Electronic heating and temperature control apparatus used in medical manufacturing applications to facilitate sealing, forming and molding thermoplastic materials.*

The amended language is substantially similar to that recommended by the Examining Attorney. The amendment does not expand the description or add goods. Instead, the qualifying language clarifies the Applicant’s goods.

**Response to Section 2(d) Refusal**

Registration was initially refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), on the grounds that Applicant's mark is confusingly similar to the registered trademark JADE (Reg. No. 3994730) for “Electronic controllers for regulating building ventilation, heating, cooling and air-conditioning; Sensors that determine and report the humidity and temperature in the environment.” Admittedly, the Mark and registered mark are comprised of the same word – JADE; however, the marks are applied to very different goods.

The Office Action indicated the Applicant’s *original* description was broadly worded and could therefore, potentially include the building systems controllers of the registered mark. As noted above, the Applicant has amended the description of its goods to clarify that its goods are used in medical manufacturing for processing thermoplastic materials. After the amendment, Applicant’s

goods can no longer be presumed to encompass those in the registered mark. Instead, the comparison of goods is between equipment used in medical manufacturing and controllers and sensors for building air systems.

In the Office Action, the Examining Attorney considered the following *du Pont* factors to be most relevant: similarity of the marks and similarity of the goods. All relevant facts of the particular case must be taken into account. *See, e.g., In re Dixie Restaurants, Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). Given the nature of the respective goods, the channels of trade and classes of purchasers also differ. In general, manufacturing is a discrete area and the related tools and equipment are not the type of products marketed to the general public. Because Applicant's goods are used in *medical* manufacturing, the pool of purchasers is even smaller.

In contrast, the registrant's goods would be purchased by builders or building owners for a specific use. This class of purchasers does not overlap with Applicant's market. Accordingly, there is no likelihood that consumers will be confused by registrant's and Applicant's use of a similar mark.

Based on the foregoing, Applicant requests the application be passed on to publication.

Dated: December 11, 2019

Respectfully submitted,

/jmott/

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