

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Diptyque S.A.S.

Mark: SLOW DANCE

Serial No.: 88/205,638

Filing Date: November 26, 2018

Trademark Attorney: Yatsye I. Lee

Law Office: 107

RESPONSE TO OFFICE ACTION

This is in Response to the July 3, 2019, Office Action regarding the above-referenced application.

I. REMARKS REGARDING REFUSAL

The Examining Attorney refused registration of Applicant Diptyque S.A.S.’s (“Applicant”) application for SLOW DANCE based on an alleged likelihood of confusion with U.S. Reg. Nos. 5,326,583 and 5,430,822 for DANSE LENTE (the “Cited Registrations”).

As set forth below, Applicant respectfully disagrees that any likelihood of confusion exists with the Cited Registrations. In view of the Office’s prior determination that no likelihood of confusion exists between SLOW DANCE and DANSE LENTE, as well as in view of the differences in the marks and the respective goods and services (as amended), there is no likelihood of confusion. Applicant therefore respectfully requests withdrawal of the refusal of registration.

II. AMENDED IDENTIFICATION OF GOODS.

Applicant amends the goods herein. The amended identification herein is consistent with Trademark Office Examining Procedure and simply clarifies or limits the identification without expanding the scope of the recited services. *See* TMEP § 1402 *et seq.* The goods, as amended herein, are identified below:

Class 3: ~~Non-medicated toilet preparations, namely, non-medicated skin care preparations; p~~Perfumery; eau de parfum; colognes; and toilet waters

III. CONFUSION IS NOT LIKELY BETWEEN APPLICANT'S MARK AND THE CITED REGISTRATIONS

A. The Office Previously Found the Cited Registrations Could Coexist with a Prior Registration for SLOW DANCE for Perfumes, Making the Rejection Here Both Illogical and Inequitable.

The Examiner previously refused registration of Applicant's mark based on an alleged likelihood of confusion with U.S. Reg. No. 4,199,277 for SLOW DANCE for "perfumes and body sprays used as a fragrance" (the "Prior Cited Registration"). The Prior Cited Registration registered on August 28, 2012 and was canceled on March 29, 2019, based on the registrant's failure to timely file a declaration under Section 8. *See Exhibit A*. The Cited Registrations were filed in December 2015 and May 2016, respectively, and registered prior to the cancellation of the Prior Cited Registration.

As reflected in the prosecution history for the Cited Registrations, the examining attorney in those cases searched the Office records and found no similar registered or pending marks that would bar registration under Section 2(d) of the Lanham Act. *See Exhibit B*. The Trademark Office thus has already determined that the Cited Registrations were not so similar to the earlier registration for SLOW DANCE to bar registration under Section 2(d). Likewise, the Application for SLOW DANCE is not now so similar to the Cited Registrations for DANSE LENTE to bar registration.

If the Cited Registrations were allowed to register despite the existence of the senior SLOW DANCE Prior Cited Registration, how can the Examiner now state that these same registrations should block a subsequent application by Applicant for perfume-related goods far more similar to the goods in the Prior Cited Registration than the cosmetic-related services in the Cited Registrations? While each application is examined and decided on its own merits, Applicant is entitled to consistent examination of applications. *See In re Nett Designs Inc.*, 57 USPQ 2d 1564, 1566 (Fed. Cir. 2001) ("Needless to say, this court encourages the PTO to achieve a uniform standard for assessing the registrability of marks.").

If, as the Examining Attorney alleges, there may be a likelihood of confusion between the Application and the Cited Registrations, there must necessarily have been a likelihood of confusion between the Cited Registrations and the senior SLOW DANCE Prior Cited Registration. Because the Trademark Office has already determined that there was not a likelihood of confusion between the Cited Registrations and the Prior Cited Registration for SLOW DANCE, the Examining Attorney's rejection herein represents an inconsistency in examination, and asserting the rejection here is inequitable.

B. Confusion is Not Likely because of Differences between the Marks.

The Examining Attorney states Applicant's SLOW DANCE mark is identical in appearance, sound, and meaning with the Cited Registrations for DANSE LENTE because the marks are foreign equivalents and DANSE LENTE is French for "slow dance." Applicant respectfully disagrees.

In determining a likelihood of confusion, the Examining Attorney should examine the similarities in the sight, sound, and commercial impression of the marks at issue. In fact, “[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar.” TMEP § 1207.01(b).

The Doctrine of Foreign Equivalents generally only applies when evidence shows that the English translation of the mark is “literal and direct,” with “no contradictory evidence of other relevant meanings or shades of meanings...” TMEP § 1207.01(b)(vi)(B). When there is evidence that the “foreign word or term may not have a literal and direct translation,” then the “doctrine should not be applied.” *Id.* Here, the Examiner points to dictionary translations showing that DANSE LENTE is French for “slow dance.” However, the Cited Registrant provided the translation of its own mark as “dance slowly.” See Exhibits C & D. This translation of “lente” as the adverb “slowly” rather than the adjective “slow” shows contradictory evidence of other relevant meanings, and that the translation of DANSE LENTE is not “literal and direct” with SLOW DANCE. Accordingly, the Doctrine of Foreign Equivalents does not apply, and the marks are different in sight, sound, appearance, and meaning.

Even assuming the Doctrine of Foreign Equivalents does apply, however, it is still “only part of the process of determining whether the marks being compared are confusingly similar,” and “[a]pppearance, sound, meaning, and overall commercial impression are also factors to be considered when comparing marks.” TMEP § 1207.01(b)(vi)(C). Similarity of the marks in one respect such as meaning “does not automatically result in a finding of likelihood of confusion even if the goods [or services] are identical or closely related...” *Id.* Any similarity in connotation or meaning between a foreign word mark and the English word mark “must be weighed against the dissimilarity in appearance, sound, and all other factors, before reaching a conclusion on likelihood of confusion as to source.” *In re Ness & Co.*, 18 U.S.P.Q.2d 1815, 1816 (TTAB 1991) (“in applying the doctrine of foreign equivalents, it would be improper to compare a foreign word mark with an English word mark solely in terms of connotation or meaning”).

Differences in just one of these factors can serve to distinguish the mark so as to prevent consumer confusion. In addition, likelihood of confusion must be determined on the overall impression of the marks and no feature of a mark may be ignored. *In re Electrolyte Laboratories, Inc.*, 929 F.2d 645, 16 USPQ 2d 1239 (Fed. Cir. 1990) (reversing TTAB decision and holding that K+ and Design for dietary potassium supplement is not likely to be confused with K+EFF (stylized) for dietary potassium supplement).

Here, the Examiner states that the marks are identical in appearance, sound, and meaning, but improperly compares the appearance and sound of SLOW DANCE with the Examiner’s translation of DANSE LENTE. Even assuming a direct foreign equivalency in translation, the marks SLOW DANCE and DANSE LENTE are completely different in appearance and sound (pronunciation). “Slow Dance” is pronounced “sloh dānts.” DANSE LENTE is pronounced “dahns lant.” See, e.g., *In re L’Oreal S.A.*, 222 U.S.P.Q. 925, 925-26 (TTAB 1984) (HAUTE MODE and HI-FASHION found to be foreign equivalents, but not confusingly similar in part based on the “obvious and substantial” differences in “appearance and pronunciation of the marks”); *In re Ness & Co.*, 18 U.S.P.Q.2d at 1816 (noting “at the outset that the marks” GOOD-

NESS and LA BONTÉ (“the goodness”) are “totally dissimilar in terms of sight (visual appearance) and sound (pronunciation)”.

Accordingly, even if the Doctrine of Foreign Equivalents applies, Applicant’s mark differs in appearance and sound from the mark in the Cited Registrations, making confusion unlikely.

C. Confusion is Not Likely Because of Differences Between the Respective Goods and Services.

Applicant’s use of its SLOW DANCE mark in connection with the recited goods (as amended) is not likely to cause confusion with the mark in the Cited Registrations in connection with the services recited therein.

The Examining Attorney does not state the respective goods and services are themselves similar, but that they are related because companies that provide retail, wholesale, and commercial services featuring cosmetics (as recited in the Cited Registrations) also provide skincare preparations, perfumery, and colognes (as recited in the Application). Applicant respectfully disagrees.

Further, Applicant amends herein the scope of goods and deletes “non-medicated toilet preparations, namely, non-medicated skin care preparations.” *See infra*. Applicant respectfully submits that the narrowed scope minimizes any suggestion that the respective goods in the Application (perfumery and colognes) are so related to the relevant respective services in the Cited Registrations (retail, wholesale, and commercial services featuring cosmetics) to make confusion likely. In fact, while the Examiner has submitted Internet evidence from four different websites to show that companies often retail both cosmetics and perfumery and colognes and brand those goods all under the same mark, the referenced evidence shows that only one of the four companies (L’Occitane En Provence) retails and brands both cosmetics and perfumery and colognes under the same mark. Indeed, the other three websites support the opposite conclusion – namely, that it is not common for companies to both retail and brand or for consumers to encounter the retailing and branding of cosmetics and perfumery and colognes under the same marks. Accordingly, the “goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source,” and even assuming that the “the marks are identical,” confusion is still not likely. TMEP § 1207.01(a)(i).

Finally, the “greater the degree of similarity” between the respective marks, the “lesser the degree of similarity between the goods [and services] is necessary to support a finding of likelihood of confusion.” *Bd. of Regents, Univ. of Texas Sys. v. S. Ill. Miners, LLC*, 110 USPQ 2d 1182, 1189 (2014). Conversely, the lesser degree of similarity between the marks, the greater degree of similarity between the respective goods and services is necessary to support a finding of likelihood of confusion. TMEP § 1207.01(b). As described above (and even assuming the connotation of the marks is the same), the mark in the Application and the mark in the Cited Registrations are significantly different in appearance and sound, thus requiring a greater degree of similarity between the respective goods and services to support a likelihood of confusion. As

noted above, the Trademark Office has already determined that the Cited Registrations can coexist with SLOW DANCE for perfumes without a likelihood of confusion, making confusion here unlikely.

IV. CONCLUSION

Based on the foregoing, Applicant respectfully requests entry of the amended recitation of goods, withdrawal of the Section 2(d) refusal to register, and approval of the application for publication. If there are any further issues that may be resolved by Examiner's Amendment, the Examiner is invited to contact the undersigned.

Respectfully submitted,
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