

NAVIGA Response to Office Action

In response to the Office Action, Applicant disagrees that the applied-for mark merely describes Applicant's services. The mark "NAVIGA" unequivocally does not describe an ingredient, quality, characteristic, function, feature, purpose or use of Applicant's services. Examiner's first piece of evidence is an apparent translation of "navigare" from Italian to English, showing the first definition is to "sail," the second definition is to "navigate," "steer," or "fly," and the third is to "browse" or "surf." "Navigare" is not the same as "NAVIGA." Furthermore, the services identified in the application are all manner of telecommunication services, including voice data, text, audio and video, as well as optical fiber networks, electronic mail services, and live streaming. The services are not simply providing internet access, and even if they were, providing access and browsing the internet are two different concepts. Some people access the internet to complete banking transactions, or to access their business desktop. Not every person who accesses the internet is "surfing."

Examiner's second piece of evidence is another online translation site conjugating the verb, "navigare," with one reference to "naviga" buried on a list of present indicative mood conjugations, and another reference in the imperative mood. Every other conjugation is something different, such as "navighi," "navigassi" or "navighiamo." The translation section at the bottom references English verbs, "to navigate" or "to sail" which is the physical travel definition, not the idea of browsing the internet.

Examiner's third piece of evidence is the online Merriam-Webster dictionary page for the term "browse," which is not Applicant's applied-for mark. The first definition for the transitive verb refers to an animal eating, as in grazing, and the second definition is to look over casually, or skim. The third definition is to access computers by means of a browser, but that is the least popular definition and it is not Applicant's mark. The intransitive verb definitions say nothing about computer access, and "browse" as a noun has no connection to computers.

If one were to introduce the term "NAVIGA" to a person living in the United States, and asked what services it provides, no one would have the slightest idea. "NAVIGA" is not an English word and it has been invented for the sole purpose of functioning as a service mark. It is a word that is unknown in the language, and is therefore fanciful. It is deserving of the highest level of trademark protection, much like PEPSI, KODAK or EXXON. Fanciful marks are inherently distinctive and are registrable on the Principal Register without proof of acquired distinctiveness. *See* TMEP §1209.01(a).

On Merriam-webster.com, a search for "NAVIGA" results in the following message: "The word you've entered isn't in the dictionary. Check on a spelling suggestion below or try again using the search bar above." The suggested spellings are: "navies," "navigate," "navvies," "navidad," "naves," "baiga," "navys," "caliga," "naveta," "navigable," "navigably," "navigated,"

“navigates,” “navigator,” “navite,” “saiga,” and “taiga.” Given the wide range of suggested words, the term “NAVIGA” is not easily connected with an alternate or similar name.

Examiner mentions the doctrine of foreign equivalents, arguing that marks with foreign terms from common, modern languages are translated into English to determine descriptiveness. However, the doctrine of foreign equivalents is more often coupled with a likelihood of confusion analysis, as opposed to a question of descriptiveness. Examiner argues that “Applicant’s mark is in Italian, which is a common, modern language in the United States,” and that “[t]he ordinary American purchaser includes those proficient in the foreign language.” The first premise of the argument is incorrect – Applicant’s mark is NOT in Italian. The fact that it may happen to translate to some obscure conjugation of a verb in that language is not relevant. There may be a number of registered trademarks in the United States that happen to match a conjugation of some other word in another language. NAVIGA was not coined by an Italian speaker and was not chosen for any possible translation.

Importantly, the doctrine of foreign equivalents is generally applied where the English translation is a literal and exact translation of the foreign wording. *See In re. Thomas*, 79 USPQ2d 1021, 1025 (TTAB 2006) (holding MARCH NOIR for jewelry likely to be confused with the cited mark BLACK MARKET MINERALS for retail jewelry and mineral store services); *In re. Am. Safety Razor Co.* 2 USPQ2d 1459, 1460 (TTAB 1987) (finding BUENOS DIAS for soap confusingly similar to GOOD MORNING for shaving cream); *In re. Ithaca Industries, Inc.*, 230 USPQ 702, 703 (TTAB 1986) (holding applicant’s mark LUPO for men’s and boys’ underwear likely to be confused with the cited registration for WOLF and design for various clothing items, where LUPO is the Italian equivalent of the English word “wolf”). Here, NAVIGA is not a literal or exact translation of the foreign wording. It is one of many conjugations of a verb with multiple meanings, and gives virtually no information about what services it represents. The Trademark Manual of Examining Procedure (“TMEP”) states that the doctrine should only be applied “[i]f the evidence shows that the relevant English translation is literal and direct, and no contradictory evidence of shades of meaning or other relevant meanings exists.” *See* TMEP, sec. 1207.01(b)(vi). Here there is not a literal and direct translation, and there is evidence of shades of meaning with respect to the Italian verb.

Where the evidence shows that the English translation is not exact, literal, or direct, the doctrine of foreign equivalents has generally not been applied to find the marks confusingly similar. *See Sarkli*, 721 F.2d at 354-55, 220 USPQ at 112-13 (holding REPECHAGE for various skin-care products, and SECOND CHANCE for face creams and other toiletries, not likely to cause confusion, where the evidence failed to show that the terms were direct foreign equivalents); *see also In re Buckner Enters.*, 6 USPQ2d 1316 (TTAB 1987) (holding DOVE with design for stoves and furnaces, and PALOMA for various forms of gas heating apparatus, not likely to cause confusion, in part because the Spanish word “paloma” and the English word “dove” are not exact synonyms in that “paloma” can be translated into either “dove” or “pigeon”). Thus, several translation dictionaries showing variations in the English meaning constitute evidence

that the foreign word or term may not have a literal and direct translation, and the doctrine of foreign equivalents should not be applied.

Moreover, despite the holding in *In re. Ithaca Industries*, which applied the doctrine of foreign equivalents to a simple, well known Italian word in 1986, Italian is no longer a very common language in the United States. According to Wikipedia, Italian is the eighth most spoken language in the United States, and of the 15,638,348 American citizens who report themselves as Italian Americans, only about 708,966 of these report speaking Italian at home according to the 2009-2013 American Community Survey. On Wikipedia's page "Demographics of the United States," the estimated population of our country is 330,149,796 as of December 16, 2019. If those numbers are accurate, then only two-tenths of a percent (0.002147) of American citizens speak Italian at home, and even they might not know all the possible conjugations of the verb, navigare. Note also that the much more popular language in America, Spanish, does not share the same translation.

At very least, NAVIGA should be deemed a suggestive mark, if not fanciful. Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. See *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread); *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985) (NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute); *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972) (DRI-FOOT held suggestive of antiperspirant deodorant for feet in part because, in the singular, it is not the usual or normal manner in which the purpose of an antiperspirant and deodorant for the feet would be described). Here, at very least, the term "NAVIGA" requires imagination, thought or perception to reach a conclusion as to the nature of the services at issue. It certainly does not "immediately tell something" about the services, like a descriptive term would.

According to TMEP, incongruity is a strong indication that a mark is suggestive rather than merely descriptive. *In re Tennis in the Round Inc.*, 199 USPQ 496, 498 (TTAB 1978) (TENNIS IN THE ROUND held not merely descriptive for providing tennis facilities, the Board finding that the association of applicant's marks with the phrase "theater-in-the-round" created an incongruity because applicant's tennis facilities are not at all analogous to those used in a "theater-in-the-round"). The Board has described incongruity in a mark as "one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark," and has noted that the concept of mere descriptiveness "should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and 'mental pause.'" *In re Shutts*, 217

USPQ 363, 364–5 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow-removal hand tool); *see also In re Vienna Sausage Mfg. Co.*, 156 USPQ 155, 156 (TTAB 1967) (FRANKWURST held not merely descriptive for wieners, the Board finding that although “frank” may be synonymous with “wiener,” and “wurst” is synonymous with “sausage,” the combination of the terms is incongruous and results in a mark that is no more than suggestive of the nature of the goods); *In re John H. Breck, Inc.*, 150 USPQ 397, 398 (TTAB 1966) (TINT TONE held suggestive for hair coloring, the Board finding that the words overlap in significance and their combination is somewhat incongruous or redundant and does not immediately convey the nature of the product); *cf. In re Getz Found.*, 227 USPQ 571, 572 (TTAB 1985) (MOUSE HOUSE held fanciful for museum services featuring mice figurines made up to appear as human beings, the Board finding that the only conceivable meaning of “mouse house,” i.e., a building at a zoo in which live and/or stuffed mice are displayed, is incongruous).

Here, NAVIGA for telecommunications services is far more distinctive than SNO-RAKE for a snow-removal hand tool, FRANKWURST for wieners, or TINT TONE for hair coloring, and at least as distinctive as MOUSE HOUSE for museum services featuring mice figurines. For example, a member of the purchasing public hearing SNO-RAKE might guess that it is a rake for removing snow, but the term “NAVIGA” would likely mean nothing. Although NAVIGA is not an incongruous combination of words, the cases finding incongruity are much more lenient than the position taken by Examiner in this case.

In fact, the term NAVIGA was previously registered as a service mark for real estate listing and brokerage of commercial property, consultation services in the field of real estate, and real estate management, in Class 036. *See* U.S. Reg. No. 3603220 (since abandoned). The Office Action in that application did not find NAVIGA to be merely descriptive. If that examiner had relied on an Italian verb for “browse,” and argued that prospective buyers typically browse real estate listings, the same arguments could have been made by that examiner. However, because the idea of browsing is so general, and can be applied to so many services or industries, the mark NAVIGA should not be deemed merely descriptive on that basis.

Even the English term “BROWSE” has been registered for services that may be browsed. For example, U.S. Registration No. 5073919 is BROWSE for “providing on-line magazines for the purpose of teaching English language.” U.S. Registration No. 5050486 is BROWSE for “printed educational materials, namely, magazines for the purpose of teaching English language.” U.S. Registration No. 5725625 is “SpeedBrowse” for “computerized on-line ordering featuring general consumer merchandise” and “on-line retail department store services.” U.S. Registration No. 3984849 is IBROWSE for “software as a service (SaaS) services, featuring software in the field of digital publishing, which enables the display of electronic versions of newspapers and magazines.” U.S. Registration No. 4396245 is BROWSE. BUY. BREATHE. for “online automobile dealership services.” Those marks required no translation and were still registered. For the same reasons, NAVIGA should be deemed a highly distinctive mark and permitted to register on the Principal Register.