

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: :
App. Ser. No. 88/828118 : Trademark Attorney
Applicant: Advance Magazine Publishers Inc. : Laura M. Wright
Mark: VOGUE :
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I. REMARKS

In the Office Action dated May 20, 2020 (“Office Action”), the Examining Attorney refused registration of the Applicant’s Mark under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), based on the conclusion that Applicant’s mark “VOGUE” is likely to be confused with the marks shown in U.S. registration numbers 4873414, 4873416, 3806735, and 5380703.

Applicant respectfully traverses the Examining Attorney’s assertion that the Applicant’s Mark is likely to be confused with the registered marks. For the reasons provided herein, Applicant respectfully requests that the Examining Attorney approve the Application for registration.

II. REGISTRATIONS NUMBER 4873414 AND 4873416

Applicant is deleting goods from the application that overlap with the cited registrations.

III. REGISTRATION NUMBER 5380703

Applicant has started a cancelation proceeding under the number 92075772 against this registration based on a non-use and fraud.

IV. REGISTRATION NUMBER 3806735 - LIKELIHOOD OF CONFUSION

Marks are compared along the axes of their “appearance, sound, connotation and commercial impression.” *In re E.I. du Pont de Nemours & Co.* at 1361. “The commercial

impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail.” *Estate of P.D. Beckwith, Inc., v. Comm’r of Patents*, 252 U.S. 538, 545–46 (1920).

The unitary mark TABLEVOGUE has a different appearance, sound and connotation from VOGUE. The accent is on the first part of the mark, which is the word “TABLE”. The word “VOGUE” comes second and is not a dominant part of the mark. Moreover, applicant’s goods will be instantly associated with Applicant’s famous magazines and media products, Vogue, which carry over 100 years of goodwill and consumer recognition of source. Applicant’s goods will be sold in media outlets and retail establishments associated with Vogue magazine and Conde Nast, the publisher of the magazine.

Further, the Applicant owns more than nine hundred active trademarks for “VOGUE” in the US and internationally. Applicant’s fame of the “VOGUE” trademark overcomes and undermines likelihood of confusion with Registrant mark “TABLEVOGUE”.

With the foregoing in mind, any overlap between the trade channels at hand is *de minimis*.

For these reasons, Applicant respectfully asks that the 2(d) rejection is withdrawn and the application allowed to proceed to publication.

V. PRIOR-FILED APPLICATION ADVISORY

The Examining Attorney advised the Applicant of possible likelihood of confusion refusal in connection with the prior-filed applications with the serial numbers 88264831, 88451444, and 88827511. Applicant notes that the first two applications have been abandoned. Applicant does not wish to submit arguments in connection with the application number 88827511, at this point.

Notwithstanding, Applicant reserves the right to address the issue later if the referenced application register and/or if the USPTO issues the refusal under section 2(d).

VI. AMENDMENT OF CLASSIFICATION OF GOODS

Based on the Examining Attorney's suggestion, the Applicant wishes to amend the description on the record as follows:

Class 11: Lighting fixtures, namely, chandeliers, table lamps, floor lamps, sconces;

Class 20: Decorative spheres of plaster, plastic and wood for use as home décor.

VII. CONCLUSION

In light of the foregoing, Applicant respectfully requests that its Application Serial No. 88/828118 be cleared for publication. If the Examining Attorney has any further questions regarding this application, Applicant respectfully notes that the Examining Attorney may contact the undersigned at the telephone number provided below.

Respectfully,

ADVANCE
One World Trade Center
New York, New York 10007
(Attorneys for Applicant)

By: /s/Natasa Saciri
Natasa Saciri

Dated: November 20, 2020
Telephone: (212) 381-7140