

**To:** MAX MOSKOWITZ([tm@ostrolenk.com](mailto:tm@ostrolenk.com))  
**Subject:** U.S. Trademark Application Serial No. 97388141 - RÊVE LAB CREATED DIAMOND  
**Sent:** November 28, 2023 08:22:42 PM EST  
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**Attachments**

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**United States Patent and Trademark Office (USPTO)  
Office Action (Official Letter) About Applicant's Trademark Application**

**U.S. Application Serial No.** 97388141

**Mark:** RÊVE LAB CREATED DIAMOND

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UNITED STATES

**Applicant:** DHOLAKIA LAB GROWN DIAMONDS LLC

**Reference/Docket No.** N/A

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**REQUEST FOR RECONSIDERATION AFTER FINAL ACTION DENIED**

**Issue date:** November 28, 2023

**Applicant's request for reconsideration is denied.** See 37 C.F.R. §2.63(b)(3). The trademark examining attorney has carefully reviewed applicant's request and determined the request did not: (1) raise a new issue, (2) resolve all the outstanding issue(s), (3) provide any new or compelling evidence with regard to the outstanding issue(s), or (4) present analysis and arguments that were persuasive or shed new light on the outstanding issue(s). TMEP §§715.03(a)(ii)(B), 715.04(a).

Accordingly, the following requirement(s) and/or refusal(s) made final in the Office action dated June 9, 2023 are **maintained and continued**:

- Likelihood of confusion

See TMEP §§715.03(a)(ii)(B), 715.04(a).

Applicant's mark is "RÊVE LAB CREATED DIAMOND" in stylized form, ("LAB CREATED DIAMOND" disclaimed), in International Class 14 for: "Lab created diamonds."

The registration subject to this refusal is "REVE" in standard character form in International Class 14 for: "Earrings; Jewelry; Jewellery; Jewellery chain of precious metal for bracelets; Jewellery chains; Jewellery charms; Jewellery foot chains; Jewellery made of precious metals; Jewellery plated with precious metals; Jewellery, precious and semi-precious stones; Jewelry made in whole or significant part of gold, silver, precious metals or alloys; Jewelry plated with gold, silver, rhodium; Women's jewelry; Bracelets; Costume jewelry; Gold jewelry; Rings"

As to the marks, applicant's mark incorporates the whole of registrant's wording, places it in the first word position and adds highly descriptive wording later in word sequence. "REVE" is dominant in applicant's mark.

### Mark Comparison Arguments

Applicant argues that the doctrine of foreign equivalents should be applied in this mark comparison to yield consumers translating "REVE" to "DREAM" and that there are a number of "DREAM" formative marks for jewelry. The argument is not persuasive for a number of reasons. First and foremost, the marks subject to the refusal, and to pending appeal, share the same *French* term, "REVE," and therefore, there is no reason to apply the doctrine of foreign equivalents. Non-French speaking U.S. consumers will recall the French term "REVE" when using their recollection upon encountering the marks in a normal manner, not the English word "DREAM." French speakers will understand the definition of "REVE" and will conclude that they share the same connotation. *See Brown Shoe Co. Inc. v. Molly D. Robbins*, 90 USPQ2d 1752 (TTAB 2009)(analyzing the mark from the standpoint of non-foreign language speaking consumers as well as those proficient in the applicable language).

Given this, consumers are more likely to conclude, (correctly), that the shared terms are simply foreign words that are in fact spelled the same way, and likely mean the same thing. *Bottega Venetta, Inc. v. Volume Shoe Corp. et al*, 226 USPQ 964, 970 (TTAB 1985)(Both marks are composed of two Italian or ... Italian-sounding words...[C]onsidering the fallibility of purchasers in their ability to recall trademarks accurately, it seems to us that American purchasers especially those not versed in foreign languages in general, or Italian in particular, not having an opportunity to make a side-by-side comparison of opposer's and applicant's handbags, or of the marks, might easily be misled or mistaken on see "BORSA VENETO" handbags into believing that they were the same as or emanated from the same source as those previously seen advertised or on sale under the mark "BOTTEGA VENETA."); *Safeway Stores, Inc. v. Bel Canto Fancy Foods, Inc.*, 5 USPQ2d 1980, 1982 (TTAB 1987)("this Board does not think it proper to take the French expression "bel air" and the Italian expression "bel aria" and then convert both into English and compare the English translations to determine whether there is similarity as to connotation, especially in this case"). "When both conflicting marks are in the same language, in some cases, the confusion may be judged on visual and phonetic similarity to the English-speaking customer." *See* 4 McCarthy on Trademarks and Unfair Competition §23:40 (5th Ed. 2023).

Secondly, as to the TESS lists of "DREAM" formative marks in Class 14 that applicant reproduced in the Request for Reconsideration, the examining attorney also objects as applicant has not made any of these third-party registrations of record. TESS listings are insufficient to make the listed registrations, (or applications), part of the record. *See Edom Labs, Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB

2012).

### Conceptual Weakness Argument

Applicant also makes an argument under the sixth *Du Pont* factor that "REVE" is conceptually weak for jewelry based on third-party registration evidence. In support, again applicant references its TESS list of marks and also made of record three third-party registrations, and one third-party pending application.

As to the TESS list of "REVE" formative marks, the examining attorney again objects to the listed third-party marks therein that applicant has not made of record.

To make third party registrations part of the record, an applicant must submit copies of the registrations, or the complete electronic equivalent from the USPTO's automated systems, prior to appeal. *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2064 (TTAB 2013); TBMP §1208.02; TMEP §710.03. Accordingly, the registrations not made of record will not be considered.

As to the attached application for "RÊVE RICHE," (U.S. Serial No.: 88604350), third-party applications are evidence only that the applications were filed; they are not evidence of use of the mark. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *see In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009); TBMP §1208.02; TMEP §710.03. This evidence is not probative on the question of conceptual weakness.

As to the remaining third-party "REVE" formative marks to show that "REVE" in the cited registration is inherently or conceptually weak and should not be afforded a broad scope of protection. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, SLU*, 797 F.3d 1363, 1374, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at \*22 (TTAB 2021) (quoting *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017)); TMEP §1207.01(d)(iii).

A large number of active use-based third-party registrations including the same or similar term or mark segment for the same or similar goods may be relevant to prove, in the same way dictionaries are used, that a term or mark segment has "a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak" and entitled to only a narrow scope of protection. *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, SLU*, 797 F.3d at 1374, 116 USPQ2d at 1136 (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d at 1339, 115 USPQ2d at 1675); *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at \*22 (citing *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d at 1057).

Of the third-party registrations applicant submitted, only three appear to be active and based on use in commerce. Evidence comprising only a small number of active use-based third-party registrations including the same or similar component is generally entitled to little weight in determining the strength of a mark. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 1328-29, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017); *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). These few registrations are "not evidence of what happens in the market place or that customers are familiar with them." *Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, at \*9 (TTAB 2020) (quoting *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d at 1406, 177 USPQ at 269). Thus, the few use-based third-party registrations submitted by applicant are insufficient to establish that the mark or portion of the mark is inherently or conceptually weak.

### Consumer Sophistication Argument

Applicant also addresses the relatedness of the goods and makes the argument that lab-created diamonds are relatively new in the jewelry marketplace and can cost hundreds of thousands of dollars, requiring careful thought by consumers before purchasing. This argument is not persuasive. The evidence in the record shows that both diamonds, and jewelry containing such diamonds can be very expensive. Registrant's identification contains no limitations and its goods are assumed to travel in all normal trade channels and encompass applicant's target consuming class. *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1357 (Fed. Cir. 2000); *Squirco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983). The scope of registrant's identification includes expensive items.

Additionally, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). Further, where the purchasers consist of both professionals and the public, the standard of care for purchasing the goods is that of the least sophisticated potential purchaser. *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) (citing *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. at 1325, 110 USPQ2d at 1163), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 375518 (Fed. Cir. 2019). The evidence of record suggests strongly that consumers who are going to purchase a piece of jewelry that will include a diamond of their choosing will carefully scrutinize the stone as well as other aspects of the piece, such as the setting, setting materials, etc. The argument is not persuasive.

### Applicant's Other Arguments

Lastly, applicant notes that the Office has approved its co-pending application for "RÊVELATION LAB CREATED DIAMONDS" in stylized form, and contends that this should be grounds for passing the instant application to publication. However, this is not persuasive as the dominant term in the co-pending application is not the French word "REVE" but the English word "revelation" which is an English word that refers to the act of unveiling or uncovering something. (*See, e.g.*: <https://www.ahdictionary.com/word/search.html?q=revelation>).

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For these reasons, the refusal to register applicant's mark based on Section 2(d) of the Trademark Act is maintained and continues to be made FINAL.

**The Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).**

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