

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Jack Henry Spirits, LLC )  
Serial No.: 88/095,430 )  
Mark: HOLA )  
Filed: August 28, 2018 )  
International Class: 33 )  
Examining Attorney: Omolayo Adebayo )

**RESPONSE TO OFFICE ACTION**

The following remarks are submitted in response to the Office Action received on December 19, 2018.

**I. REMARKS**

Under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), the Office Action refused registration of Applicant’s HOLA mark because of an alleged likelihood of confusion with the mark HELLO VODKA in U.S. Registration No. 5,033,751. The Office Action also provided a prior pending application advisory regarding the mark HOLA in U.S. Application No. 87/695,734 and the mark HOLA SOL in U.S. Application No. 87/709,429. Additionally, the Office Action required a translation statement.

As discussed in greater detail below, Applicant respectfully traverses the rejection under Trademark Act Section 2(d) because there is no likelihood of confusion between Applicant’s HOLA mark and the cited mark HELLO VODKA. Additionally, Applicant provides the translation statement required by the Office Action.

**A. No Likelihood of Confusion Regarding the HOLA Mark**

Applicant’s trademark application is for registration of the mark HOLA in connection with “Spirits and liqueurs” in International Class 33. The cited prior registration is for the mark HELLO VODKA in connection with “Vodka” in International Class 33.

In determining whether a likelihood of confusion exists, the principal factors are laid out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973). As the Examining Attorney pointed out, two of these factors are the similarity of the marks and the similarity of the goods.

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Significantly, it is the similarity or dissimilarity of the marks *in their entireties*, and not just a portion of the marks, that is relevant in determining whether a likelihood of confusion exists. *In re National Data Corp.*, 753 F.2d 1056, 1060 (Fed. Cir. 1985). That is, the ultimate determination in a comparison of the marks should rest on the marks *as a whole*. See, e.g., *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915 (CCPA 1976) (TEKTRONIX and DAKTRONICS); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) (RESPONSE and RESPONSE CARD); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS).

### **1. Applicant's HOLA Mark is Dissimilar from the HELLO VODKA Mark**

The respective marks differ in appearance, sound, meaning, and commercial impression. Applicant's HOLA mark is four letters long, beginning with the unshared letters "HO". In contrast, the cited mark HELLO VODKA is ten letters long, beginning with the letters "HE" and including the unshared term "VODKA." Additionally, Applicant's mark is two syllables, "HO-LA," whereas the cited mark is four syllables "HELL-O VOD-KA." Furthermore, Applicant's HOLA mark is in the Spanish language and would be pronounced in the Spanish language manner, whereas the cited mark is in the English language. As a result, Applicant's mark and the cited registration differ with respect to their syllables, terms, and language of origin. Thus, Applicant's mark has a different sound and appearance from the cited mark thereby ensuring that consumers will readily distinguish between the marks. This is especially the case given that the beginning of the respective marks, which is the first thing a consumer perceives, is different between the two. Accordingly, the respective marks as a whole do not give rise to a likelihood of confusion because they do not have potentially confusing phonetic and literal similarities.

Moreover, the marks differ in meaning and connotation. Applicant's HOLA mark is of Spanish origin which, as the Office Action points out, translates to "hello" in English. In contrast, the origin of the cited mark HELLO VODKA is English, but the addition of the term VODKA creates a substantial difference in meaning and connotation between the respective marks, as the Applicant's mark does not include this term. Indeed, Applicant does not intend to use its HOLA mark with vodka, but instead intends to use this mark with other spirits and liqueurs, such as, for example, "mescal; distilled blue agave liquor," and possibly more. Thus, if the Examining Attorney deems it appropriate to further this case towards allowance, the Applicant would be willing to amend its identification of goods to more narrowly specify the particular types of spirits and liqueurs that it intends to use with its HOLA mark. Nevertheless, given these differences, the cited mark provides a connotation and commercial impression that differs from Applicant's mark. Accordingly, because the marks have different meanings and commercial impressions, consumers are not likely to be confused. See *Aries Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926, 1932 (TTAB 1993).

### **2. Applicant's Goods are Dissimilar from the Goods of the HELLO VODKA Mark**

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There is no *per se* rule that goods or services sold in the same field or industry are similar or related for purposes of likelihood of confusion. See *Cooper Industries, Inc. v. Repcoparts USA, Inc.*, 218 USPQ 81, 84 (TTAB 1983); *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993) (reversing likelihood of confusion cancellation of LLOYD's for barbecued meats based on LLOYD's for restaurant services).

Here, the relevant goods of the respective marks are neither identical, nor overlapping. Although both identifications of goods relate to the broad product category of alcoholic beverages, Applicant's identified "Spirits and liqueurs" goods were not intended to overlap with the goods of the cited mark, namely "Vodka." Applicant would gladly amend its goods identification, if the Examining Attorney believes that would further this case to allowance, in order to specify alcoholic beverages other than vodka, such as, for example, "mescal; distilled blue agave liquor," and possibly more. Accordingly, because the respective marks are intended for dissimilar goods, consumers are not likely to be confused.

**B. Translation Statement**

In response to the Office Action's requirement for a translation statement, Applicant submits the following:

The English translation of "HOLA" in the mark is "hello".

**II. CONCLUSION**

In view of the foregoing remarks, Applicant respectfully submits that its HOLA mark is entitled to registration and requests that it be promptly allowed for publication. If the Examining Attorney requires any changes in the application that could be made by an Examiner's Amendment, Applicant respectfully requests that the Examining Attorney contact Applicant's attorney of record.

Dated August 24, 2019.

Respectfully submitted,

/Seth W. Black/

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