

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark : SUNDAZE

Serial No. : 88000808

Owner : Koko Life LLC

Examining Attorney : Nancy L. Clarke

Law Office : 102

RESPONSE TO THE FINAL OFFICE ACTION DATED JANUARY 8, 2020

The Examining Attorney issued a Section 2(d) refusal to register application Serial No. 88167731 (“the Application”) for the mark SUNDAZE (“Applicant’s Mark”) on the basis of U.S. Registration No. 5723548 for SOL DAZE (“Cited Mark”). Koko Life LLC (“Applicant”) respectfully argues this refusal is in error and should be reversed. First, there is no likelihood of confusion because the doctrine of foreign equivalents should not apply, and the marks are sufficiently different from one another. Second, there is no likelihood of confusion because the goods themselves are different.

I. THE MARKS ARE NOT SO SIMILAR THAT CONFUSION WOULD BE LIKELY.

When considered in their entireties, the Applicant’s mark and the Cited Mark are not so similar in sight, sound, connotation, or commercial impression that confusion is likely. Similarity alone is not the test; whether similarity is likely to cause consumer confusion is the critical question. *Pfizer, Inc. v. Astra Pharmaceutical Prods*, 33 U.S.P.Q.2d 1545, 1559 (S.D.N.Y. 1994) (citing *McGregor-Doniger Inc. v. Drizzle, Inc.*, 202 U.S.P.Q. 81 (2nd Cir. 1979)). This is because the commercial impression of a trademark is derived from the mark as a whole, not from its elements separated and considered in detail. *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 U.S.P.Q.2d 1471, 1473 (Fed. Cir. 1992) (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545-6 (1920)). Applicant’s mark, SUNDAZE, and the Cited Mark (“SOL DAZE”) are not so similar in sight, sound, connotation, or commercial impression that confusion would be likely.

The examiner concludes that the marks themselves are confusingly similar solely in light of the doctrine of foreign equivalents. Under this doctrine, foreign words from modern, common languages are translated into English to determine similarity with their English counterpart. *See Palm Bay Import, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The doctrine is applied only when it is likely that “the ordinary American purchaser would ‘stop and translate’ [the term] into its English equivalent.” *Palm Bay, supra* at 1696, quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976). With respect to the likelihood of confusion determination, the doctrine has been applied generally in the situation where the wording in one mark is entirely in English and the wording in the other mark or marks is entirely in a foreign language. *See, e.g., In re Perez*, 21 USPQ2d 1075 (TTAB 1991); *In re Am. Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987); *In re Hub Distrib., Inc.*, 218 USPQ 284 (TTAB 1983). The Board has yet to apply the doctrine in a precedential decision where the wording in one or more of the marks being compared consists of a combination of English and foreign-language words, but here, the Cited Mark is partially in Spanish, and the Applicant’s Mark is entirely in English. *See In re Monfrere*, Serial No. 88004556 (March 2, 2020) [not precedential] (reversing the refusal to register and finding MONFRÈRE FASHION not likely to cause confusion with MY BROTHER when the English translation of MON FRÈRE is MY BROTHER and the marks covered legally identical goods); TMEP § 1207.01(b)(vi)(A).

A. The Doctrine of Foreign Equivalents Does Not Apply Because The Marks are in Spanish and English.

The examiner wrongly applies the doctrine of foreign equivalents to this case because it is likely that the ordinary American purchaser would take Applicant’s mark “as it is” and unlikely this purchaser would “stop and translate” Applicant’s mark. Importantly, the doctrine of foreign equivalents has evolved into a guideline, not an absolute rule, and is applied only when these two qualifications are met. *See Palm Bay*, 73 USPQ2d at 169. Consumers are likely to take Applicant’s mark “as it is” and not “stop and translate” in cases where the mark is comprised of foreign and English words. *See French Transit, Ltd. v.*

Modern Coupon Sys., Inc., 818 F.Supp. 635, 29 USPQ2d 1626 (S.D.N.Y. 1993) (doctrine of foreign equivalents does not apply to LE CRYSTAL NATUREL because it includes both French (LE and NATUREL) and English (CRYSTAL) terms; *Cf. In re Aquamar, Inc.*, 115 USPQ2d 1122, 1127 (TTAB 2015) (applying foreign equivalents doctrine after finding that Spanish is a common language in the U.S. and that ordinary purchasers would stop and translate the mark – a single Spanish word – MARAZUL into English).

In re Universal Package Corporation, 222 USPQ 344 (TTAB 1984) is also on point. There, the Board held the inclusion of the French article “LE” in LE CASE changed the commercial impression of the mark, which makes it less likely that a consumer would translate the mark. “Translation of an entire compound word mark is more likely to take place in the marketplace than is the translation of only part of the mark.” *Id.* at 347. Thus, we can conclude that translation between SOL DAZE and SUNDAZE is unlikely to occur because translation of the entire mark would be illogical, and consumers will take the Applicant’s mark “as it is.” Therefore, the doctrine of foreign equivalents does not apply here.

B. SOL DAZE and SUNDAZE are Different in Sight, Sound, Meaning, and Commercial Impression.

“The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.” *Opryland USA Inc. v. The Great American Music Show Inc.*, 23 U.S.P.Q.2d 1471, 1473 (Fed. Cir. 1992) (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545-6 (1920)). Furthermore, the Board has found that “it is the first part of a mark which is most likely to be impressed upon the mind of a purchaser and be remembered by the purchaser.” *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). Still, an examining attorney must assess the overall commercial impression of the marks, not just the individual components. *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ 2d, 1442 (9th Cir. 1987). In addition to reiterating its arguments from its first Response, Applicate argues the following points.

SOL and SUN, which are the first parts of the marks at issue, differ notably in sight and sound, with the only similarity being that they start with an “s.” The remaining two letters give each part of the

mark a unique phonetic characteristic. Important here is that consumers will not see the Applicant's product bearing the words SOL DAZE (or SOLDAZE). The mark is SUNDAZE. This is how consumers will perceive the mark, and even in cases where marks contain similar or even identical elements, confusion is not *per se* likely – no one feature of a mark should be ignored. *See In re Electrolyte Laboratories, Inc.*, 929 F.2d 645, 16 USPQ 2d 1239 (Fed. Cir. 1990) (The K+ and Design mark for a dietary potassium supplement is not likely to be confused with K+EFF (stylized) for the same goods). Slight differences are enough to distinguish marks even for related or legally equivalent goods.

To this point, the board has held CITIBANK not confusingly similar to CAPITAL CITY BANK, *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ 2d 1645, 1664 (TTAB 2010), and GENUINE SKIN not confusingly similar to GENUINE RIDE SKIN CARE, *Truescents LLC v. Ride Skin Care LLC*, 81 USPQ 2d 1334, 1341 (TTAB 2006). Further examples include finding ALL CLEAR and ALL not confusingly similar for household cleaners, *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107 (CCPA 1972) and PLUS and NATURE'S PLUS not confusingly similar for vitamins, *Plus Prods. v. Natural Organics, Inc.*, 204 USPQ 773 (TTAB 1979).

When consumers encounter SOL DAZE and SUNDAZE they will immediately recognize the spelling difference in the primary part of the mark, as well as the spacing rendering the Applicant's Mark a unitary mark and the Cited Mark a two-word mark. It also strains credulity to suggest that the ordinary American consumer will "stop and translate" the Applicant's mark, SUNDAZE, into a half-Spanish amalgamation immediately upon seeing it, as discussed above. Therefore, there is no likelihood of confusion.

C. A Mere Finding of Related Goods Not Sufficient to Sustain a Likelihood of Confusion Refusal.

The examiner found the Applicant's Mark and the Cited Mark cover legally identical goods. When the marks themselves are different in their entireties, even though they cover identical goods and have (assumed) identical channels of trade and classes of consumers, this is not enough to uphold a finding of likelihood of confusion. *See Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *duPont* factor may not be

dispositive.”); *In re Monfrere*, Serial No. 88004556 (March 2, 2020) [not precedential] (refusing to apply the foreign equivalents doctrine and finding no confusion even when goods were legally identical). A rejection for likelihood of confusion is proper only when “circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods] emanate from the same source.” *Coach Svcs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369.

Upon review of the relevant goods, there is no basis for the conclusion that consumers will mistakenly believe the goods came from the same source. SUNDAZE is a mark covering “sunscreen preparations” only. Sunscreen reduces or blocks harmful sunlight from damaging the skin while one is outside. SOL DAZE is a mark specifically for “indoor and outdoor non-medicated skin tanning preparations.” Sunscreen and indoor tanning lotion are practically opposites, and though these goods may seem related, this difference is sure to be significant and recognizable in the eyes of consumers as they encounter the different marks on their respective products. And, in any event, the marks are different enough on their face to warrant registration of Applicant’s Mark.

2. CONCLUSION.

In conclusion, there is no likelihood of confusion between Applicant’s mark and the Cited Mark. SUNDAZE is different in sight, sound, connotation, or commercial impression, and simply, the marks cover different goods. Consumers are not likely to stop and translate SUNDAZE into SOLDAZE or SOL DAZE into SUN DAZE, but they are likely to appreciate the differences they see in each mark. Even if the covered goods are related, the differences in the marks themselves outweigh any likelihood of confusion. Accordingly, the Section 2(d) refusal should be withdrawn and the Application should proceed to publication and registration.