

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: AYOHOKAY

Serial No. : 86895424

For : Zhou, Jing

Examiner : Michael Ebaugh

Law Office : 108

ARGUMENTS IN RESPONSE TO LIKELIHOOD OF CONFUSION:

In the Office Action of May 25, 2016, the examining attorney refused registration under Trademark Act Section 2(d), on the ground that the applicant's mark, when used on or in connection with the identified goods, so resembles the marks in U.S. Registration No. 3237425 and U.S. Application Serial No. 86887807 as to be likely to cause confusion, to cause mistake, or to deceive. Applicant does not agree with this conclusion and in further support of its original application ("Application"), hereby submits this Response and requests that the examining attorney reconsider their refusal of the Application.

The Marks Concluded by the Examining Attorney that could lead to confusion, mistake, or deception under 15 U.S.C. 1052(d).

1) U.S. Registration No. 3237425

The mark covered by this registration is a word mark containing the words, "A-O-K".

The application fits into International Class 001- Fertilizers

2) U.S. Application Serial No. 86887807

The mark covered by this application is a stylized mark containing the words, "A-OK POWER EQUIPMENT".

The application fits into International Class 035- On-line retail store services featuring outdoor power equipment and Construction related tools; Retail store services featuring outdoor power equipment and Construction related tools.

A. Explanation of the DuPont Multi-Factor Test for the Purpose of Determining Whether Confusion, Mistake, or Deception is Likely.

The test for likelihood of confusion is whether a 'reasonably prudent consumer' in the marketplace is likely to be confused as to the origin of the good or service bearing one of the marks. *In re E.I. DuPont de Nemours and Co.*, 177 U.S.P.Q. 563 (C.C.P.A 1973). Consequently, the Federal Circuit Court

of Appeals articulated thirteen factors for the purpose of deciding likelihood of confusion on a case-by-case basis, otherwise known as the *DuPont* factors.

B. Application of the DuPont Factors to the Pending Application

Applying the DuPont factors to the instant case, Applicant hereby submits the following arguments in response to Examiner's potential refusal to register Serial No. **86895424**.

1) Similarity as to Appearance, Sound, Connotation, and Commercial Impression

a) Appearance

The applicant respectfully submits that the applicant's mark is AYOHOKAY while the registrant's mark is A-O-K and the prior-filed mark is A-OK POWER EQUIPMENT. Here, the applicant's mark AYOHOKAY consists of four parts "A" "YO" "HO" "KAY" while the registrant's mark A-O-K consists of only three letters "AOK". In addition, the applicant's mark AYOHOKAY is totally different from the prior-filed mark A-OK POWER EQUIPMENT. The presence of the applicant's mark AYOHOKAY makes a clear visual difference the consumers are likely to notice while looking at the mark. As a result, the visual impact of the marks when compared to each other is considerably different. The clear difference in spelling of the prior filed mark is so distinguish it from applicant's mark as to render confusion unlikely.

b) Sound

In the present case the difference in the phonetics should also be taken into account. The applicant's mark consists of the term AYOHOKAY while the cited marks consist of A-O-K and A-OK POWER EQUIPMENT. The only similar sound of the three marks is A and K. It sounds different as to the three marks.

c) Connotation/Commercial Impression

Another factor in determining whether likelihood of confusion exists requires an examination into the meaning or connotation of the atissue marks. In fact, it has been held that even *where marks share similar appearances and sound*, the connotation and/or commercial impression derived from the marks may be sufficiently different enough where likelihood of confusion is not established. See, e.g., *In re Sears, Roebuck and Co.*, 2 U.S.P.Q.2d 1312 (TTAB 1987) (finding that CROSS-OVER when applied to bras carried different connotation and/or commercial impression from CROSSOVER as applied to women's sportwear); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (TTAB 1984) (finding that PLAYERS for men's underwear carried different connotation and/or commercial impression from PLAYERS for shoes); *In re Sydel Lingerie Co., Inc.*, 197 U.S.P.Q. 629 (TTAB 1977) (finding that

BOTTOMS UP for ladies' and children's underwear held a different connotation and/or commercial impression from BOTTOMS UP for men's clothing). Furthermore, such connotation and/or significance can be determined based upon a mark holder's current use in commerce. *In re Nationwide Industries*, 6 USPQ2d 1882, 1! 884 (TTA B 1984) ("Thus, it is settled that evidence of the context in which a mark is used on labels, packaging, advertising, etc., is probative of the significance which the mark is likely to project to Ser No. 764198257 purchasers").

When comparing a mark, the consumers are likely to look at the mark in relation to its goods and services and the provider of such goods in order to derive an overall commercial impression. Consumers are accustomed to seeing marks with regard to the owner behind it which create a strong brand impression. In this case, the applicant's mark creates an entirely different connotation and commercial impression since the marks are so different and it is very unlikely that the public will associate the applicant's mark with the cited marks together.

2) Similarity as to Nature of Goods and Services/ Trade Channels

Examiner also notes the similarities in goods and services as a basis for refusal. However, even where marks are placed within the same class, it is possible to avoid likelihood of confusion where the goods and/or services vary. See, e.g., *Taj Mahal Enterprises, Ltd. v. Trump*, 16 U.S.P.Q. 2d 1577 (D.N.J. 1990). In *Taj Mahal*, the marks under scrutiny were TAJ MAHAL for an Indian restaurant and TAJ MAHAL for a casino-hotel resort. The court held that the mark TAJ MAHAL for restaurants is suggestive of Indian food, while TAJ MAHAL for casino-hotel evokes images of grandeur, opulence and extravagance. Therefore, despite both falling under the same class of services for the purposes of registration, the *Taj Mahal* court found that there was no likelihood of any confusion.

In this case, the goods for Registrant's mark "A-O-K" is fertilizers in Class 1, and On-line retail store services featuring outdoor power equipment and Construction related tools; Retail store services featuring outdoor power equipment and Construction related tools for the prior-filed mark "A-OK POWER EQUIPMENT". The examiner held that gardening tools and fertilizer are related, but the two cited marks can coexist without any refusal of likelihood of confusion. The goods for applicant's mark "AYOHOKAY" is Adjustable spanners; Gardening tools, namely, trowels, weeding forks, spades, hoes; Hammers; Hand-operated cutting tools; Hand-operated ski sharpening instruments; Hand tools, namely, tap and die sets; Hand tools, namely, graving tools; Hand tools, namely, punches; Pliers; Screwdrivers in Class 8. The three marks differs from classes and identification of goods. From this point of view, there is no similarity as to the nature of goods.

3) The Number and Nature of Similar Marks in use on Similar Goods or Services

A vital consideration must be made in determining "strong" or "weak" marks in order to determine the scope of protection to be accorded. Strong marks are widely protected, as contrasted to weak marks. *Amstar Corp. v. Domino's Pizza Inc.*, 615 F.2d 252, 259 (C.A.Ga. 1980). If the registered mark is not a coined word, or is not purely fanciful, it is not to be accorded the same degree of protection given to such coined and fanciful terms as "Kodak" or "Xerox." *Id.* at 260. A weak mark is a mark that is a meaningful word in common usage or is merely a suggestive or descriptive trademark. A strong mark is entitled to a greater degree of protection than is a weak one, because of its unique usage. *Alpha Indus., Inc. v. Alpha Tube & Shapes, Inc.*, 616 F.2d 440, 445-46 (9th Cir.1980).

Moreover, extensive third-party use is relevant in showing pre-existing dilution of the mark because "third-party uses of a mark on similar goods are relevant for the purposes of showing a 'crowded field' and that the mark is therefore weak." *Lexington Management Corp. v. Lexington Capital Partners*, 10 F.Supp.2d 271, 281 (S.D.N.Y. 1998). In *Michael Caruso and Co., Inc. v. Estefan Enterprises, Inc.*, 994 F.Supp. 1454, 1458 (S.D. Fla.1998), the court held that a clothing manufacturer's "Bongo" mark was weakened by extensive third party use of the term. The primary indicator of trademark strength measures logical correlation between name and product; if seller of product or service would naturally use a particular name, it is weakly protected. *Caruso, supra* at 1458.

Where the primary term is considered a weak mark, minor alterations could effectively negate any confusingly similarity between the two. *Freedom Sav. & Loan Ass'n*, 757 F.2d 1176, 1183 (C.A.11 Fla.1985). The mere fact that two marks incorporate a form of a common identifying word does not render the marks too similar. *See, e.g., Freedom Sav. & Loan Ass'n*, 757 F.2d at 1183 ("Freedom Savings and Loan" and "Freedom Realty" marks "lack ... confusing similarity"); *Sun Banks of Florida, Inc. v. Sun Federal Sav. and Loan Ass'n* , 651 F.2d 311, 316 ("Sun Federal and Savings Loan Association" not confusingly similar to "Sun Banks"); *Amstar*, 615 F.2d at 260 ("Domino's Pizza" not similar to "Domino sugar"); *Bell Laboratories, Inc. v. Colonial Prods., Inc.*, 644 F.Supp. 542, 547 (S.D.Fla.1986) ("Final Flip" and "Flip" marks for same product are "ultimately different and different sounding"); *In re Hearst Corp.*, 982 F.2d 493, 494 (Fed.Cir.1992) ("Varga girl" and "Vargas" are "sufficiently different in sound, appearance, connotation, and commercial impression, to negate likelihood of confusion"); *Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co.*, 781 F.2d 884, 888 (Fed.Cir.1986) ("Romanburger" and "Roman" marks for food products "are not similar in appearance"); *Little Caesar Enterprises*, 834 F.2d 568, 571 ("Pizza Caesar U.S.A." not similar to "Little Caesar's"); *Conde Nast Pubs., Inc. v. Miss. Quality, Inc.*, 507 F.2d 1404, 1407 (CCPA 1975) ("Country Vogues" and "Vogue" publications "do not look or sound alike"); *Pacquin-Lester Co. v. Charmaceuticals, Inc.*, 484 F.2d 1384 (CCPA 1973) ("Silk 'n' Satin" beauty and bath lotion and oil not similar to "Silk" face cream).

Ultimately whether an addition is sufficient to prevent confusion in a particular instance depends upon the strength of the main part of the mark and the distinctiveness of the additional feature. *Bell Laboratories, supra*, at 548.

Applicant notes that similarity in the applicant's mark AYOHOKAY and both the cited registered marks A-O-K and A-OK POWER EQUIPMENT is weak due to excessive third party uses. As such, it is submitted that these differences between the applied-for mark and the registered marks references herein create a separate and distinctive commercial impression.

CONCLUSION:

In the office action, the Examiner contends that likelihood of confusion exist where Applicant's mark shares similarities in appearance, sound, and commercial impression. However, Applicant asserts that an examination of the DuPont factors shows clear differentiation when comparing Applicant's mark and services to the prior mark cited. Thus, for all of the other reasons set forth above, the Applicant contends that there is no likelihood of confusion, mistake, or deception in the marketplace. The examiner may hence approve the mark for publication in the Official Gazette.

Respectfully submitted:
/Jing Zhou/
Jing Zhou
Owner