



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
RESPONSE TO OFFICIAL OFFICE ACTION**

Mark: 
Serial Number: 87/022,131
Applicant: Kretek International, Inc.
Examining Attorney: Sandra Snabb
Law Office: 120
Office Action Mailing Date: February 12, 2018

In response to that Office action dated February 12, 2018, Applicant provides the following:

**I. APPLICANT’S MARK IS NOT CONFUSINGLY
SIMILAR TO BLACK VOODOO**

The Examining Attorney has refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), claiming that Applicant’s mark  is confusingly similar to the pre-existing registration for the word mark BLACK VOODOO, U.S. Registration No. 5246714 (the “Cited mark”).

The factors to be applied when evaluating likelihood of confusion between two trademarks are found in *In re E.I. DuPont de Nemours & Co.*, 476 F. 2d 1357 (CCPA 1973). Among the premier factors to be considered under *DuPont* are the similarity of the marks and the goods and the channels of commerce in which they travel. However, in order to refuse registration under Section 2(d), there must be shown more than a mere possibility or confusion; instead, there must be demonstrated a probability or likelihood of confusion. *See Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F. 2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992). “We are not concerned with mere theoretical possibilities of confusion, deception, or mistake with de minimus situations but with the practicalities of the commercial world, with which the trademark laws deal.” *Id.* quoting from *Witco Chemical Co., Inc. v. Whitfield Chemical Co., Inc.*, 418 F. 2d 1403, 164 USPQ 43 (CCPA 1969); see also, *Triumph Machinery Co. v. Kentmaster Manufacturing Co., Inc.*, 1 USPQ2d 1826 (TTAB 1987). The Trademark Act does not speak in terms of remote possibilities of confusion, but rather, the likelihood of such confusion occurring in the marketplace. There is no litmus test for assessing confusion.

[T]rademark law must necessarily be flexible responding to particular circumstances disclosed by particular fact situations thereby making a hard and fast rule in these cases anathema to its concept and application. That is, this is contrary to the principle of trademark law that each case must be decided on the basis of relevant facts which include the mark and the goods as well as the marketing environment in which a purchaser normally encounters them and the experience generated as a result of their use in the marketplace providing such use has been sufficient in length and depth to make an impact in the market.

Interstate Brands Corp. v. Celestial Seasonings, Inc., 196 USPQ 321, 324 (TTAB 1977).



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A. Comparison of the Marks

1. The Marks Must Be Compared In Their Entirety And Cannot Be Dissected

In the Office action, the Examining Attorney argues that the word “VOODOO” is the dominant focus of the two marks, in addition to arguing that Applicant’s design element in its mark does not obviate the similarity between Applicant’s mark and the Cited mark. However, this conclusion ignores precedent that marks may not be dissected and must be considered in their entirety.

The law is well-settled that marks must be viewed in their entirety, especially when the marks comprise words or initials combined with logos. *First Franklin Financial Corp. v. Franklin First Financial, LTD.*, 356 F. Supp. 2d 1048 (ND Cal. 2005) (court found no likelihood of confusion when both marks had the words “First” and “Franklin” where one mark included a logo resembling a house and the other mark had a logo incorporating an image of Benjamin Franklin).

The Examining Attorney has improperly focused on the word “VOODOO”—arbitrarily calling it the “dominant source identifying feature” of the marks – and relying on those words as the basis for the Section 2(d) refusal. See *Mejia & Assoc. Inc. v. IBM Corp.*, 920 F. Supp. 540, 547 (S.D.N.Y. 1996) (“[M]arks are not ‘similar’ for purposes of assessing likelihood of confusion simply because they contain an identical or nearly identical word.”). Indeed, marks are not to be dissected for purposes of comparing the component parts of each other in order to determine whether confusing similarity exists. *Bausch & Lomb Optical Co. v. Overseas Finance Co.*, 112 U.S.P.Q. 6 (Comm’r Pat. 1956). Instead, it is the whole impression of a mark on purchasers in the marketplace, and not the individual parts thereof, that should be considered. *Clinique Lab. v. Dep Corp.*, 945 F. Supp. 547, 553 (S.D.N.Y. 1996).

Indeed, numerous cases have held that no likelihood of confusion exists for marks that contain a common word. See, e.g., *Freedom Savings & Loan Ass’n v. Way*, 226 U.S.P.Q. 123, 127 (11th Cir. 1985) (no confusion between FREEDOM REALTY and FREEDOM SAVINGS AND LOAN ASSOCIATION because “[t]he use of an identical word, even a dominant word, does not automatically mean that two marks are similar”); *Little Caesar Enters., Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568 (6th Cir. 1987) (LITTLE CAESARS not confusingly similar to PIZZA CAESAR USA); *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386 (Fed. Cir. 1989) (PECAN SHORTEES not confusingly similar to PECAN SANDIES); *Land-O-Nod Co. v. Paulison*, 220 U.S.P.Q. 61 (T.T.A.B. 1983); CHIROPRACTIC and CHIRO-MATIC not confusingly similar); *In re Bed & Breakfast Registry*, 791 F.2d 157 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL not confusingly similar); *Wooster Brush Co. v. Prager Brush Co.*, 231 U.S.P.Q. 316 (T.T.A.B. 1986) (POLY PRO and POLY FLO not confusingly similar); *In re Gunn GP LLC*, 2006 WL 3227263 (T.T.A.B. Oct. 30, 2006) (GUNN SMARTCHOICE SERVICE not confusingly similar to SMART CHOICE or AMERICA’S SMART CHOICE).



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The Federal Circuit's decision in *In re Hearst Corp.*, 982 F.2d 493 (Fed. Cir. 1992) is particularly instructive on the issue of improper dissection of a mark. In that case, the Federal Circuit concluded that the marks VARGA GIRL and VARGAS were not confusingly similar. The Federal Circuit observed that although VARGA and VARGAS are similar, “the marks must be considered in the way they are used and perceived. Marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight.” *Id.* at 494 (citations omitted) (emphasis added). The court reasoned that “[b]y stressing the portion ‘varga’ and diminishing the portion ‘girl,’” the Board had “inappropriately changed the mark.” *Id.* Finding that the marks, when considered in their entirety, were sufficiently different in sound, appearance, connotation, and commercial impression to avoid a likelihood of confusion, the Court reversed the Board's refusal to register VARGA GIRL. Similarly, by stressing the portion “VOODOO” and exclusively focusing on the word “VOODOO,” the Examiner is inappropriately changing the marks. With the distinctive design elements, the stylization and other differences, the marks are dissimilar.

Besides improperly focusing only on the single word “VOODOO,” the Examining Attorney's Section 2(d) analysis also improperly dissected the distinctive design portion of the Applicant's mark from the word portion. The Examining Attorney ignored the design features of Applicant's mark which is distinctive and unique. The Federal Circuit, however, has made it clear that “[t]here is no general rule as to whether letters or design will dominate in composite marks.” *In re Electrolyte Labs., Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990). Instead, the “nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur.” *Id.* (emphasis added); *see also* 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:47 (4th ed. 2011) (“[A] design element is dominant if more conspicuous than accompanying words.”).

Here, the design elements of Applicant's mark is dominant and more conspicuous than the “VOODOO” word. A side-by-side comparison of Applicant's mark and the Cited mark only points to a conclusion that the two marks are distinctly different and dissimilar. Looking at the two marks as a whole and in their entirety, it is obvious that the two marks are completely dissimilar. *First Franklin Financial Corp.* 356 F. Supp. 2d at 1052. Thus, this factor weighs heavily against similarity between the marks.

2. The Marks Differ in Commercial Impression

The mark  when properly viewed in its entirety is sufficiently dissimilar in commercial impression from the Cited mark BLACK VOODOO, as to avoid any consumer confusion. Despite sharing the word “VOODOO,” Applicant's mark and the Cited mark leave distinct commercial impressions upon purchasers, and, therefore, purchasers are not likely to be confused by the marks.



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While the Examining Attorney cites case law to assert that the word portion “VOODOO” of the mark is impressed on the purchaser’s memories and is to be afforded greater weight, these cases are not applicable. Here, because the design is dominant over the wording in Applicant’s mark, it is unlikely that the wording “VOODOO” in Applicant’s mark will be impressed upon the mind of a purchaser. The design and font are significant in forming the commercial impression of the Applicant’s mark.



The highly stylized, prominent, and conspicuous the design here dominates Applicant’s mark and is not likely to be confused with the Cited mark. See *In re PM Investigations, Inc.*, 2009 T.T.A.B. LEXIS 682, at *11 (T.T.A.B. Dec. 2, 2009) (“In the present case, the design portion of Applicant’s mark is visually prominent and distinctive and, to our eye, the design clearly dominates the overall commercial impression of the mark.”); *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 U.S.P.Q.2d 1477 (T.T.A.B. 1987) (no likelihood of confusion between “highly stylized” design mark including the word STEVE'S and word mark STEVE'S); *In re Benedent Corp.*, 2011 T.T.A.B. LEXIS 71, at *13 (T.T.A.B. Mar. 14, 2011) (“In the context of the marketing of these goods, the strong dissimilarities in the visual appearances of the marks and the consequent differences in commercial impressions outweigh the similarity in pronunciation and meaning of the words contained within the marks.”)

As has been noted by the TTAB, the Examining Attorney cannot resort to various mechanical rules of construction when comparing the marks. *In re TSI Brand, Inc.*, 67 U.S.P.Q. 2D 1657 (TTAB 2002) [non-precedential] (TTAB rejected such generalizations and held that visually the respective marks contained significant distinguishing design elements). In sum, the overall visual dissimilarities of these two marks are significant.

3. The Marks Differ in Sight, Sound and Meaning

A comparison of the marks shows that they are not similar in appearance, sound, meaning or commercial impression. As to the sound of the marks, there is a big difference. The Cited mark has two words “BLACK” and “VOODOO.” The first word in the Cited mark is completely different. With the word “BLACK” in the Cited mark, the two marks have distinctly dissimilar sounds and are not phonetic equivalents. The addition of the word “BLACK” in the Cited mark creates a different impression and meaning. Applicant’s mark with the design elements and the pin with the skull head going through the mark as if it is sewn through the word VOODOO makes the



marks different.

For all of these reasons, the law and evidence do not support the conclusion that the marks are similar.



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B. Comparison of the Goods

In addition to the marks being dissimilar, the goods are also sufficiently dissimilar. It is the object of Section 2(d) to protect against confusion, not to protect the Registrant. *See In re E.I. DuPont*, supra. As the court noted in *Witco Chemical Co.*, supra, “[w]e are not concerned with the mere theoretical possibilities of confusion, deception, or mistake with de minimis situations but with the practicalities of the commercial world, with which the trademark law deals.”

Applicant’s mark is for Class 34 goods of “Hookahs; Hookah tobacco; Hookah parts and accessories, namely, hookah foil, hoses, bowls, stems, hose tips, and tongs; Smokers’ articles, namely, hookah charcoal; Hookah steam stones; Electronic hookahs; Electric hookah parts, namely, electronic hookah hoses; Electronic shisha pens; Butane torch lighters; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form used to refill electronic cigarette cartridges and electronic smoking devices.”

The Cited mark is for Class 1 and 30 goods of “Electronic cigarette liquid (e-liquid) comprised of propylene glycol; Electronic cigarette liquid (e-liquid) comprised of vegetable glycerin” and “Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form used to refill electronic cigarette cartridges.”

The Examiner cites third party registrations in support of the goods being related. There is no *per se* rule that two products move in the same channels of trade to the same class of purchasers.

Taken to its absurd extreme, if third-party registrations alone are considered sufficient to prove that goods and services are related, then virtually all consumer products and services would be related. Accordingly, a *per se* rule regarding the relatedness of goods and services is contrary to trademark law which requires that each case be decided on the basis of all of the relevant facts in evidence.

CNL Tampa Int’l Hotel Partnership LP v. Palazzolo, 2007 WL 760521 at *5 (TTAB 2007) (citations omitted). In sum, the cited third party registrations offer little or no probative value to support a finding that there is a likelihood of confusion and the Examiner has not met its burden.

II. CONCLUSION

Here, the differences in the marks and the goods assure that there will be no likelihood of confusion as to the source of the Applicant’s goods. Accordingly, the refusal to register under Section 2(d) should be withdrawn.



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Respectfully submitted,

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