

Mark: HONEY OFFERS
Serial No: 87/827,666

RESPONSE TO OFFICE ACTION

The Office refuses registration of the proposed mark stating that it is likely to cause confusion with U.S. Registration Nos. 3,967,345 for HONEY MONEY & Design for customer loyalty services and customer club services, for commercial, promotional and/or advertising purposes for convenience store merchandise; 5,123,287 for HONEY MONEY for providing incentive award programs through issuance and processing of loyalty points for purchase of a company's goods and services; and 4,506,830 for HONEY TALK for advertising services; publicity and sales promotion relating to goods and services, offered and ordered by telecommunication or the electronic way; publicity and sales promotion services; sales promotion for others provided through the distribution and the administration of privileged user cares; sales promotion services. The Applicant respectfully disagrees and traverses the refusals.

The Office states that the dominant portion of the cited marks is HONEY, and that the advertising and promotion services identified in the registrations, include Applicant's narrow services. The Applicant respectfully disagrees.

The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) set forth various factors to consider when analyzing likelihood of confusion. The most common factors include similarity of the marks, and relatedness of the goods or services. However, the court also listed several other factors, and cautioned that "[t]here is no litmus rule which can provide a ready guide to all cases." *Id.* at 1361, 177 USPQ at 567, TMEP 1207.01. Indeed, the court noted that the significance of a particular factor may differ from case to case. *See du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567-68. Here, the Applicant contends that a combination of several of the factors, including consumer familiarity with the term HONEY, as well as a prior existing registration owned by Applicant, weighs in favor of a finding of no likelihood of confusion.

In the present case, the cited marks are HONEY MONEY & design, HONEY MONEY (word) and HONEY TALK & design. These marks each follow the same structure, namely, the word HONEY followed by another term. The Applicant contends its proposed mark, HONEY OFFERS, is registrable, especially in light of the coexistence of the cited marks.

The Applicant notes that the cited marks are owned by unrelated third parties. In particular, HONEY TALK is owned by Zhong Xue Huang, an individual, and the HONEY MONEY marks are owned by Honey Farms, Inc. A review of the file wrapper for each mark reveals that each mark was allowed with no refusals, despite the existence of another registration. Specifically, the application for HONEY TALK, filed on November 19, 2012, was allowed despite the registration of the HONEY MONEY '345 registration. Similarly, the HONEY MONEY word mark, now registration number 5,123,287, filed on May 31, 2016, was allowed without even a reference to HONEY TALK, which was already registered. If each of these marks was allowed to register, then the Office decided that (1) either the marks are not likely to cause confusion, despite the inclusion of the word HONEY in each mark, or (2) the goods and services are not related, or (3) both.

Indeed, the Applicant contends that the designs of the HONEY MONEY and HONEY TALK registrations cannot be dismissed. The design of the HONEY MONEY mark encompasses the wording such that it is an integral part of the design and not separable. Further, the mark claims specific colors, namely, red, yellow and orange, wherein the mark consists of a yellow outline of a circle containing an orange interior with a dollar sign (\$) that is tilted to the left and the words "Honey Money" in red superimposed across the interior of the circle with a slant in the same direction as the dollar sign. The superimposition of the wording over a dollar sign reinforces the word MONEY. Similarly, the mark HONEY TALK includes "a drink device and a stripe ellipse which are inside a circle, wherein the stylized wording "Honey Talk" resides right of the device."



If these two marks can coexist, then the Applicant contends that its proposed mark can also coexist. Further, as stated above, the '287 registration for HONEY MONEY is without claim to font or stylization. Accordingly, this "broader" mark was allowed despite the existence of HONEY TALK and a prior registration for HONEY owned by Applicant (discussed below). If this mark was allowed despite the existence of Applicant's prior registration and the existence of

the HONEY TALK registration, the Applicant contends that its current application is also allowable.

Applicant contends that the term HONEY is commonly encountered by consumers, and encountered in this manner, that is, HONEY followed by another term. The Applicant submits search results demonstrating that the term HONEY in association with consumer retail services is included in 162 records and 91 live records. Exhibit 1. Many of the registrations are directed to online retail or e-commerce, services strongly related to incentive programs or loyalty programs for consumer products. For example, some of the registered marks are HONEY MOON Reg. No. 3724248; HONEY QUEENS Reg. No. 5257756; HONEY MAMA'S Reg. No. 5016997; HONEYBRAINS Reg. No. 5347568; and HONEY BIRDETTE Reg. No. 4787939. *Id.* This demonstrates that consumers easily distinguish and differentiate between HONEY marks, further supporting the rationale for the registration of each of the cited marks. In the present case, the Applicant's mark poses no more risk of confusion than any of these already coexisting marks, especially in light of the alleged overlap of the services in each of these registrations.

The Office states that the "broad wording to describe advertising and promotion services" existing in the registrations will encompass Applicant's "more narrow 'promoting the goods and services of others by featuring product information, discount information and rewards information'." If this is true as the Office contends, then it is baffling how the cited registrations coexist. Indeed, the HONEY MONEY '345 registration includes loyalty services for advertising and/or promotion for store merchandise, HONEY MONEY '247 services are incentive award programs, and finally HONEY TALK services include advertising services. As stated above, HONEY TALK registered after HONEY MONEY '345, and HONEY MONEY '247 registered after HONEY TALK. None of these applications were refused for any other mark. If these registrations can coexist, and the Office's statements are taken as true, Applicant's proposed mark must also be entitled to registration as there is simply no reasoning that differentiates Applicant's proposed mark such that it should be refused.

In further support that the proposed mark is not likely to cause confusion, the Applicant submits a copy of its registration for HONEY stylized, U.S. Registration No. 4,640,667 (Exhibit 2). Applicant's prior registration for HONEY is directed to goods that are related to the services identified in the present application, namely, computer application software for mobile phones,

namely, software for e-commerce transactions; computer e-commerce software to allow users to perform electronic business transactions via a global computer network.

Applicant's HONEY stylized mark has been in use since at least as early as November 14, 2012, prior to the filing and use of the HONEY TALK mark, and prior to the filing of the HONEY MONEY '287 registration. The first use of the HONEY MONEY marks is alleged as March 24, 2011, and the first use of HONEY TALK is alleged as December 1, 2012. Thus, with the exception of the HONEY MONEY '287 registration, these marks have all coexisted on the register since November 18, 2014, the registration date for Applicant's stylized HONEY mark. The '287 registration for HONEY MONEY registered much later, namely, on January 17, 2017, but notably registered without claim to font or stylization. The coexistence of these marks on the register has been about four (4) years, and the coexistence in the marketplace has been since November 2012, about six (6) years. Clearly, there is no likelihood of confusion between these marks, and thus, there would be no likelihood of confusion between Applicant's currently proposed mark, especially as it already has a registration for HONEY for goods related to the services identified in the present application.

Evidence of Applicant's contention that there is no likelihood of confusion is further found in the identification of services for HONEY MONEY '345 registration and the specimen of use, which effectively establishes the channel of trade for this oldest existing registration. Exhibit 3. The identification of services specifically states that the "customer loyalty services and customer club services" are for "convenience store merchandise." A convenience store is not an online venue. It requires customers to physically drive or walk to the location, thus, the services will not be nationwide, but rather, only in proximity to where the convenience store is located. Indeed, the specimen further supports this fact as it is a loyalty card that is used at the store, and a webpage advising consumers to register their loyalty card to use at the specific store. While the Office notes that likelihood of confusion is based on the description of goods and services and not on actual use, here, the actual use supports the limitations clearly set forth in the identification of goods and services, namely, that the channel of trade is convenience stores, a narrow marketplace that closely identifies the mark with the services. Indeed, consumers are extremely aware that loyalty programs are specific to particular sources. For instance, consumers would not confuse a Vons loyalty card with a Jons loyalty card, despite both being grocery stores. Exhibit 4. In vast contrast to this registration, Applicant's services are limited to

consumers making purchases within a website or application. Accordingly, there is no overlap in the channels of trade with respect to this registration.

Finally, the marks do not create the same commercial impression. The HONEY MONEY marks, especially the design mark with the dollar sign, allude to savings, and is commercially different from HONEY TALK with its design of a drink and striped ellipse. The proposed mark simply does not create the same commercial impression as either of these vastly different marks. Indeed, while HONEY MONEY may allude to savings, and HONEY TALK may allude to chatter, the proposed mark may allude to available deals. Regardless, the meanings do not overlap.

Clearly, the marks do not present the same, the connotations of each mark differ, and the commercial impressions are different. Further, Applicant's prior registration for HONEY for related goods has established Applicant in the marketplace such that its proposed mark, which will be encountered by consumers from the Applicant's website joinhoney.com, will not associate the proposed mark with any source other than Applicant. As stated in *Du Pont*, "each case must be decided on its own facts." *Du Pont*, 476 F.2d at 1361, 177 USPQ at 567. In this instance, the Applicant contends that the combination of factors weighs against a finding of a likelihood of confusion, and respectfully requests the refusal be withdrawn, and the mark passed to publication.

The Office further states that the term OFFERS must be disclaimed. Although the Applicant respectfully disagrees and traverses the refusal, to expedite allowance of the application, the Applicant has amended the application to disclaim the term OFFERS apart from the mark as shown.

The Applicant believes all the outstanding issues have now been resolved. Accordingly, the Applicant respectfully requests the Office pass the application to publication.