

SKP4-59403
App. No. 88/017,454
OXLEY

REMARKS

Applicant's counsel thanks the Examiner for the careful consideration given the application. Registration of Applicant's mark has been refused on the grounds of an asserted likelihood of confusion with the mark in US Registration No. 5528231 for OXLEY'S EXTRA and Design, for non-alcoholic cocktail mixes, in Class 32. However, upon more careful consideration, it is clear that there is no likelihood of confusion. The reasons are as follows.

First, the marks must be compared for similarities in appearance, sound, meaning and commercial impression.

When the marks are compared for similarities in appearance, the marks are quite different. Applicant's mark is for the single word OXLEY. Registrant's mark includes an "S" at the end of OXLEY, includes the additional word EXTRA, and is surmounted by the massive head of an oxen. Due to the extra wording and the prominence of the oxen image, the ordinary consumer is unlikely to confuse registrant's mark with applicant's OXLEY mark, since applicant's mark has no corresponding wording and design component.

Next, the marks must be compared for similarities in sound. In this regard, registrant's mark includes the sounds of the "S" and the EXTRA; applicant's mark has no corresponding sound components.

Next, when the marks are compared for similarities in meaning, applicant has no components corresponding to the large image of the oxen and the word EXTRA in registrant's mark, so that the marks are quite different in meaning.

Finally, when the marks are compared for similarities in commercial impression, applicant's mark has no commercial impression, since OXLEY is a coined term. On the other hand, registrant's mark has the commercial impression of a massive oxen, as indicated in the design component of registrant's mark.

In summary, when the marks are compared for similarities in appearance, sound, meaning and commercial impression, it is clear that there are prominent differences between the two marks, such that there is clearly no likelihood of confusion.

Next, the goods of the marks must be compared for relatedness. Applicant's goods are gin and gin-based beverages in Class 33; registrant's goods are non-alcoholic cocktail mixes in Class 32. The fact that the goods of the two marks are in different International Classes is already indicative of the fact that the ordinary American consumer is aware

that alcoholic and non-alcoholic beverages are generally produced by different entities under different marks.

Furthermore, the ordinary American consumer would notice the word EXTRA in registrant's mark and would believe and expect that the EXTRA would be referring to the extra flavor and extra taste in registrant's cocktail mixes. The ordinary American consumer is completely unfamiliar with a beverage company distributing both gin and cocktail mixes under a mark which includes the word EXTRA. When the ordinary American consumer sees the word EXTRA, they instinctively recognize that the mark would be used only for the cocktail mix and not for the gin.

For all the reasons set forth above, when you compare the marks and the goods for similarity and relatedness, it is clear that the only conclusion which can be drawn is that there is no likelihood of confusion between the two marks.

Since all open items have now been resolved, it is requested that the application now be passed to publication.