

RESPONSE TO OFFICE ACTION

The Office Action issued on February 4th, 2019 being responded within the six months before it's deadline on August 4th, 2019 as follows

Likelihood of confusion Section 2(d) refusal:


The Examiner has refused Applicant's MAYA and design mark for fruits, namely, avocados, based on perceived confusing similarity with the cited registration for MAYA (No. Reg. 4952425)

Although the similarities are taken mainly, the elements as a whole must also be taken into consideration, which is not done by the authority since it only attempts in an unfounded and improper way to start from the supposed similarities without the same being true as later explained. It also shows that similarity must be assessed by imposition, that is, what at first sight or sound produces in the consumer, that is, by looking at the marks in their entirety and not comparing them side by side, as the opposition does in a way not only wrong but in a fraudulent way, making decontextualized comparisons of the details of the brands, not being the advertising impact or perception that the consumer appreciates and obtains from the brands, as well as the similarity it must be appreciated assuming that the confusion can be suffered by the average consumer, and that it pays common and ordinary attention, which does not make the meticulous study that the authority itself.

Consequently, it must be understood that it must be avoided giving a registered sign with unfounded exclusivity, as the authority tries to point, that unduly limits the other economic agents from using symbols that, due to their characteristics, cannot generate error in the public regarding the commercial origin of a service or good, because only in this way can fair competition be guaranteed in the market through the right of industrial property. For this purpose, one of the parameters that must be weighed is the greater or lesser distinctive capacity that a sign has regarding the consumer to identify the product or service to which it is applied. Therefore, it is clear that a brand must be valued for its distinctiveness, an issue that is present in the immediate case.

The registered mark MAYA (No. Reg. 4952425) within class 31 regarding will be analyzed from the perspective of three essential elements of the mark: phonetic, visual and ideological elements, the latter in relation with its commercial activity.

1. Phonetic: Pronunciation or sound, in this case the elements are the same MAYA, which pronunciation is (/ˈmaɪə/) in the same way for both trademarks, nevertheless, a wide variety of trademarks using the same distinctive element being Maya, similarly pronounced (/ˈmaɪə/) as in both, the registered and the applicant's trademarks under class 31, may be found within the USPTO's TSDR system, which submitted herewith are its's printouts of use-based trademark registrations for unprocessed fruits featuring the term "MAYA" being as follows:

 <p>MAYACROPS S.A. MAYACROPS Reg. No. 2704207</p>	<p>STANDARD CHARACTER MARK</p> <p>MAYA PINEAPPLE Reg. No. 4952426</p>	 <p>MAYA LUXURIOUS Reg. No. 5393555</p>
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<p style="text-align: center;">STANDARD CHARACTER MARK</p> <p>MAYA HAWAIIAN PLANTAIN Reg. No. 2498827</p>	<p style="text-align: center;"></p> <p style="text-align: center;">TROPICAL MAYA Reg. No. 3298503</p>	<p style="text-align: center;"></p> <p style="text-align: center;">Applicant's trademark: MAYA Serial No. 88169289</p>
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The enlisted trademark's products are similar and do use the

The applicant's distinctiveness resides in being the element MAYA a strong resemblance with the Mesoamerican Mayan civilization from the pre-Columbian Americas unlike the referred element "MAYA" (No. Reg. 4952425) which doesn't state nor relate any cultural resemblance. Additionally, the applicant has already successfully registered his trademark in Mexico, having its registration certificate submitted herewith.

Being **MAYA PINEAPPLE** (Reg. No. 4952426) composed with a descriptive element, being a fruit, PINEAPPLE under class 31, and regardless of this was considered for register. TROPICAL MAYA as well, being the description of the geographic zone where most fruits are harvested, still was considered for publication as well.

It is notable that the common, shared element between the marks cited, being "MAYA", is commonly used in association with unprocessed fruits such that the owner of the cited marks should not be given respectively the monopoly of the term MAYA when they are used as part of another party's distinctive composite mark on different goods.

Third party use of "MAYA" in connection with unprocessed fruit is evidence of the weakness and dilution of the term "MAYA" in relation unprocessed fruits and weighs in favor of narrowing the scope of its protection against subsequent applications. See *Pizza Inn, Inc. v. Russo*, 221 USPQ 281, 283 (TTAB 1983); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1722*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

2. VISUAL: The distinctiveness from the applicant's trademark from the other referred from the TSDR system, is clear enough for it to be considered. Being distinct with a particular design being drawn as a Mayan – cultural headwear used by religious and political chieftains. MAYA (No. Reg. 4952425) was granted registration even though it had both an already registered element in trademarks within the same class and with no stylistic drawing, giving the applicant a stronger distinctiveness from the one of the referred registered mark.
3. IDEOLOGIC: The applicant identified his trademark under class 31 as "fruits, namely avocados" for them to be sold while the registered trademark referred in the Office Action states: "Fresh fruit, excluding, mango, watermelon and tomato, and fresh vegetables, excluding, broccoli, cauliflower, eggplant, onion and squash; organic fresh fruit, excluding, mango, watermelon and tomato, and organic fresh vegetables, excluding, broccoli, cauliflower, eggplant, onion and squash." Considering the other two classes it was also registered, being 29 for canned fruits and vegetables; canned or bottled fruits; canned or bottled vegetables and 32 for aerated fruit juices; beauty beverages, namely, fruit juices and energy drinks containing nutritional supplements; concentrated fruit juice; concentrates for making fruit juices; frozen fruit-based beverages; fruit drinks and fruit juices; fruit juice concentrates; fruit nectars; mixed fruit juice; non-alcoholic beverages containing fruit juices; vegetable juices; and vegetable-fruit juices makes clear the referred registered mark the economic activity, being fruit and vegetables juices and

beverages, which they clearly don't make out of avocados. Being so, It's clear a different economic activity between both the applicant's MAYA (Serial No. 88169289) and MAYA (No. Reg. 4952425), making the former apt to be published for opposition without generating confusion within users.

The applicant considers, following the previous order of ideas, the USPTO mustn't consider the refusals stated in the previous Office Action as such and, therefore, proceed for publication