

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Bradley Peltz

SERIAL NO.: 88211068

FILED: November 29, 2018


MARK: MOLO

RESPONSE TO OFFICE ACTION

This is to respond to the objections raised in the office action issued by the USPTO in connection with the proposed trademark application no. 88211068 for the mark “**MOLO**”. The Applicant herein responds to all the grounds of objections taken by the Examining Trademark Attorney.

LIKELIHOOD OF CONFUSIONS - SECTION 2(D) REFUSAL

The Examiner has refused registration of the applied-for mark “**MOLO**” because of a likelihood of confusion with the marks in U.S. Registration Nos. 4843252 and 4967083 for the

marks “” and “**MOLO**” respectively. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

The Applicant respectfully submits that the applied for mark “**MOLO**” is substantially different from the marks under Registration Nos. 4843252 and 4967083 and is unlikely to result in any confusion whatsoever.

As noted by the Examining Attorney, determination of likelihood of confusion is made on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). As observed in *In re E. I. du Pont de Nemours & Co.*, “reasonable men may differ as to the weight to give specific evidentiary elements in a particular case. In one case it will indicate that confusion is unlikely; in the next it will not. In neither case is it helpful or necessary to inject broad maxims or

references to "the public interest" which do not aid in decision making. Only the facts can do that. In every case turning on likelihood of confusion, it is the duty of the examiner, and this court to find, upon consideration of all the evidence, whether or not confusion appears likely. That determination ends the decisional process."

At the outset, it is respectfully submitted that the Applicant's proposed mark "MOLO" has been applied for in International Class 14 under the goods classification "Jewelry" whereas



the cited registered mark "moLo" with registration no. 4843252 has been granted in International Class 25 under the goods classification - "Children's and infants' apparel, namely, shirts, pants, jackets, jumpers, shorts, tops, sweaters, blouses, robes, dresses, underwear, sleepwear, pyjamas, cloth bibs, bathing suits, footwear, hats, mittens, and scarves" and the cited registered mark "MOLO" with registration no. 4967083 has been granted in International Classes 9, 25 and 35 under the following classification of goods:

International Class 9 - Spectacles; sunglasses, goggles for sports, including ski goggles; spectacle cases.


International Class 25 - Clothing, namely, underwear, shirts, sweaters, sweatshirts, vests, pants, skirts, dresses, jeans, shorts, blouses, blousons, overcoats, body stockings, suits, waistcoats, waterproof clothing in the nature of waterproof jackets, waterproof coats, waterproof trousers, coats, pullovers, trousers, jackets, scarves, ties, braces in the nature of suspenders, gloves, belts, stockings, tights, socks, bathing suits, bath robes; footwear; headgear, namely, hats, caps, earmuffs, kerchiefs; all of the aforesaid goods being goods for babies and children.

International Class 35 - Retail services, namely, retail store services, wholesale store services and on-line retail store services featuring clothing, footwear, headgear, all of the aforementioned goods being goods for babies and children.

In contrast, the Applicant's mark has been applied under a totally different classification of goods as compared to the cited registered marks. The Applicant's mark will be used in connection with Jewelry related goods *whereas the goods classified in the cited registered marks are aimed at babies and children, who typically do not wear or purchase jewelry*. The same can be established from a mere perusal of the classification of goods described above for the cited registered marks. On this ground alone, the Examiner is respectfully requested to set aside the objections raised in the Office Action as the likelihood of confusion between

the Applicant's mark and the cited registered marks is highly unlikely and the consumers will not be led to believe in any manner that the goods are emanating from the same source.

To further corroborate the above argument, the Applicant provides herewith a list of marks with the term "MOLO" which are registered in different international classes and are peacefully co-existing with the cited registered marks. The Examiner is respectfully requested to consider the following list of marks and allow registration of the Applicant's mark.

Trademark	Registration No.	IC Classification & Goods
MOLO	5128412	IC 41; Educational services, namely, training courses, seminars and workshops in the field of solid waste management.
	5011122	IC 3: Body and beauty care cosmetics; Cleansing creams; Cosmetic creams; Cosmetic creams for skin care; Cosmetic hand creams; Cosmetic nourishing creams; Cosmetic oils; Cosmetic preparations for body care; Cosmetic preparations for skin care; Cosmetic sun oils; Face creams for cosmetic use.
MOLO	4584272	IC 21: Cooking steamers; Cookware for use in microwave ovens; Cookware, namely, steamers; Dish covers
MOLO	5736641	IC 18: Travelling bags; vanity-cases sold empty; rucksacks; bags, namely, clutch bags, pouches and bags for sports; handbags; beach bags; shopping bags, namely, mesh, canvas or textile shopping bags; shoulder bags; school bags; sports bags, none of the aforementioned goods of leather
MOLO	86472204 (pending registration)	IC 5: Nasal spray containing medicinal product for treatment of respiratory disorders; medical device being nasal spray device sold with medicine in it IC 10: Medical device being nasal spray device, sold empty.

The above chart does not even include the numerous pending applications for marks that consist of or contain the term "MOLO", nor does it include the numerous common law trademark uses of the term MOLO in the marketplace. As immediately apparent from the above chart, the cited MOLO marks currently co-exist with each other and several other MOLO formative marks.


Accordingly, because the purchasing public is familiar with a variety of MOLO marks, the difference in goods between Applicant's mark and the marks in the cited registrations are sufficient to avoid any likelihood of confusion.


Comparison of marks


In response to the above refusal, Applicant submits that the proposed mark is not confusingly similar to the registered marks as the criterion to establish a cause of likelihood of confusion has not been met in this case. The examiner states that “*in a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression*” and that “*similarity in any one of these elements may be sufficient to find a likelihood of confusion*”. Using the below analysis, Applicant will show below that the proposed mark has no similarity in sound, appearance, meaning or commercial impression with the registered marks.

Similarity in Sound: Applicant disagrees with the assumption that the fact that both marks include the term “MOLO” is a sufficient ground to establish likelihood of confusion between the marks. Further, as stated in the case of *First Int’l Servs Corp. v. Chuckles Inc.* (5 U.S.P.Q. 2d 1628, 1632 T.T.A.B 1988) “*sound is less important if the prospective purchases are likely to encounter the marks visually rather than orally*”. Therefore, similarity in sound plays at best a minimal role in determining likelihood of confusion in this case. Similarity in appearance and overall commercial impression of the mark will need to be established in order to find a likelihood of confusion ruling.

Similarity in Appearance: Applicant respectfully submits that the proposed mark and the

registered mark “” vary widely in their appearance as the cited mark contains design elements that are far from similar to the proposed mark. Applicant respectfully disagrees with the conclusion drawn in this case and disputes the notion that if placed side by side, the marks are similar in appearance. Applicant submits that the cited mark,

 is a device mark which consists of a black and light gray rectangle wherein the term “molo” appears in the black section in white letters and a dark grey handprint in the light gray section of the rectangle. This clearly distinguishes the registered mark from the proposed mark. Furthermore, Applicant draws the attention of the Examiner to the case of *Packman v. Chi Tribune*, (267 F3d. 628 60 U.S.P.Q 2d 1245, 1255) where it was held that “*although the words on the parties’ products are the same, the words’ appearances do not resemble each other and are not likely to cause confusion. Different packaging, coloring and labeling can be significant factors*”. The Applicant respectfully submits to the examiner that

the design of the registered mark  is completely different and can be easily distinguished from the Applicant’s mark. Such marks have both visual and oral facets and with such marks there are “*no general rules as to whether letters or design will dominate*”. (In re

Electrolyte Labs, Inc., 929 F.2d 645, 647, 16 U.S.P.Q. 2d 1239, 1240). For the reasons given above, Applicant submits that the marks cannot be held to be similar in appearance.

Similarity in Meaning or Connotation: Applicant submits that the customers are not likely to confuse the marks as they have different meanings and connotations. In the case of *Floss Aid Corp. v. John O Butler Co.*, (205, U.S.P.Q. 274, 285) it was held that the issue is whether the consumers are likely to make the mental effort to reach the nexus. Applicant submits that since the proposed mark and the registered marks cater to a very different segment of customers with clearly distinguishable goods, it is not likely that the average customer will sense the significance or make the mental effort sufficient to reach the nexus between the two marks and the corresponding products associated with the marks.

Similarity in Commercial Impression: The office action states that the test is “*whether the marks will create the same overall commercial impression*”. Applicant submits that considering all the circumstances including the marketing channels and identity of the prospective consumers, the proposed mark cannot be confused with the registered marks as the proposed mark is marketed in different channels from that of the registered marks, and also the consumers of the products are not the same. Based on the class description of the registered marks, the registrants provides its goods in areas, namely,

International Class 25 - Children's and infants' apparel, namely, shirts, pants, jackets, jumpers, shorts, tops, sweaters, blouses, robes, dresses, underwear, sleepwear, pyjamas,

cloth bibs, bathing suits, footwear, hats, mittens, and scarves, for the mark



under Registration No. 4843252.

International Class 9 - Spectacles; sunglasses, goggles for sports, including ski goggles; spectacle cases for the mark “MOLO” under Registration No. 4967083.

International Class 25 - Clothing, namely, underwear, shirts, sweaters, sweatshirts, vests, pants, skirts, dresses, jeans, shorts, blouses, blousons, overcoats, body stockings, suits, waistcoats, waterproof clothing in the nature of waterproof jackets, waterproof coats, waterproof trousers, coats, pullovers, trousers, jackets, scarves, ties, braces in the nature of suspenders, gloves, belts, stockings, tights, socks, bathing suits, bath robes; footwear; headgear, namely, hats, caps, earmuffs, kerchiefs; all of the aforesaid goods being goods for babies and children for the mark “MOLO” under Registration No. 4967083.

International Class 35 - Retail services, namely, retail store services, wholesale store services and on-line retail store services featuring clothing, footwear, headgear, all of the aforementioned goods being goods for babies and children “MOLO” under Registration No. 4967083.


On the other hand, Applicant provides its goods in the field of Jewelry for the mark “MOLO” in **International Class 14**.

The office action further states that the goods/services of the proposed and registered marks have to be only *“related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.”* Applicant submits that the consumer is not likely to be confused that the marks come from the same source as the proposed mark is dealing in goods related to Jewelry. The goods of cited marks are completely different from the Applicant’s mark and cater to a completely different set of consumers, hence should not be found to be similar enough to meet the standard of likelihood of confusion. The applicant further points out that in *Shen Manufacturing Co. v. Ritz Hotel Ltd. (393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004)* it was held that *“if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely”*.

Comparison of the Goods and/or Services

The Applicant respectfully submits that upon encountering Applicant’s and Registrants’ marks, consumers are likely to be confused and mistakenly believe that the respective goods emanate from a common source. It is submitted that the Applicant’s goods are sufficiently distinguishable from Registrants’ goods to avoid any likelihood of confusion. If the goods and services offered are dissimilar, then there is less likelihood of confusion. TMEP § 1207. Where goods or services are non-competing, the degree of trademark similarity needed to establish likelihood of confusion is increased. TMEP § 1207.01(a)(i). In fact, when the goods and services are sufficiently dissimilar, even identical marks may not cause confusion. In the instant case, Applicant’s goods are clearly and entirely distinguishable from the goods in the cited registrations. In this regard, Applicant’s goods and the goods listed in the cited registrations are listed below:

APPLICANT’S GOODS	International Class 14 - Jewelry for the mark “MOLO”.
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<p>GOODS LISTED IN CITED REGISTRATION NUMBERS: 4843252 & 4967083</p>	<p>International Class 25 - Children's and infants' apparel, namely, shirts, pants, jackets, jumpers, shorts, tops, sweaters, blouses, robes, dresses, underwear, sleepwear, pyjamas, cloth bibs, bathing suits, footwear, hats, mittens, and scarves, for the mark  under Registration No. 4843252.</p> <p>International Class 9 - Spectacles; sunglasses, goggles for sports, including ski goggles; spectacle cases for the mark "MOLO" under Registration No. 4967083.</p> <p>International Class 25 - Clothing, namely, underwear, shirts, sweaters, sweatshirts, vests, pants, skirts, dresses, jeans, shorts, blouses, blousons, overcoats, body stockings, suits, waistcoats, waterproof clothing in the nature of waterproof jackets, waterproof coats, waterproof trousers, coats, pullovers, trousers, jackets, scarves, ties, braces in the nature of suspenders, gloves, belts, stockings, tights, socks, bathing suits, bath robes; footwear; headgear, namely, hats, caps, earmuffs, kerchiefs; all of the aforesaid goods being goods for babies and children for the mark "MOLO" under Registration No. 4967083.</p> <p>International Class 35 - Retail services, namely, retail store services, wholesale store services and on-line retail store services featuring clothing, footwear, headgear, all of the aforementioned goods being goods for babies and children "MOLO" under Registration No. 4967083.</p>
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Finally, though Applicant does not believe that it is necessary to amend its identification of goods to avoid a likelihood of confusion with the cited MOLO marks, Applicant is willing to do so if that will obviate the §2(d) likelihood of confusion refusal. Specifically, Applicant is willing to state that Applicant's goods do not include Registrants' goods. Applicant is also willing to work with the Examining Attorney on the appropriate wording for any amendment if necessary.

Applicant respectfully submits that based on the arguments advanced and cases cited above, the proposed mark is not confusingly similar to the registered marks, and the goods/services of the Applicant and the Registrants are not related. Furthermore, the distribution of goods/services of both the Applicant and Registrants will not travel through the same channels of trade, or target the same customers. Applicant, therefore, respectfully submits that the criterion to establish a cause of likelihood of confusion has not been met and accordingly solicits allowance of the mark “*MOLO*”.

Conclusion

It is submitted that the Applicant believes differences between the marks and peaceful co-existence of various other *MOLO* formative marks on the Register in various international classes are sufficient to avoid a likelihood of confusion. The Applicant submits that if the Examining Attorney believes that amendment of certain goods/services from Applicant’s application is necessary to resolve the likelihood of confusion refusal (i.e. that Applicant’s products are not specifically aimed at babies and children), Applicant encourages the Examining Attorney to contact Applicant informally with a proposal. Applicant would likely be amenable to an amendment of its list of goods/services, if necessary.