

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Serial Number: 88/238,635 )  
Applicant: ORION CORPORATION )  
Mark: CALI O! )  
Office Action Date: March 20, 2019 )  
Examining Attorney: Ms. Bridget A. McCarthy )  
Law Office 125 )

**RESPONSE TO OFFICE ACTION OF MARCH 20, 2019**

On behalf of ORION CORPORATION (“Applicant”), please enter the following amendment and consider the following response to the Office Action.

**AMENDMENT**

**I. Identification Of Goods**

Applicant amends the identification of goods in International Class 30 to read as follows:

**Class 30:** Flour; preparations made from cereals, **namely, bread, cookies**; confectionery, **namely, confectionery made of sugar, frozen confectionery, snack foods, namely, chocolate**; gum, **namely, chewing gum, bubble gum**; buns; rice cakes; biscuits; bread; cream puffs; ice cream; ~~iced tea~~; bars of sweet jellied bean paste (**Yohkan**); confectionery in jelly form, **namely, fruit jelly candy**; chocolate products, **namely, chocolate cakes, chocolate chips, chocolate candies**; chocolate; custard; candy; cocoa; cookies; crackers; hot dogs, **namely,** {sausages in a bread roll}

Applicant has amended the identification to clarify the nature of the goods in line with the Examining Attorney’s suggestions. Applicant has also deleted certain goods that were deemed in the Office Action as being related to the goods identified in the registration cited on likelihood of confusion grounds. Because the amended identification is fully within the scope of the original, such an amendment is appropriate, and should be accepted. 37 CFR §2.71(a); TMEP § 1402.06.

## REMARKS

### **I. No Likelihood Of Confusion Exists Between Applicant's Mark And The Registered Mark Cited By The Examining Attorney**

The Examining Attorney has preliminarily refused registration of Applicant's mark CALI O! under Trademark Act Section 2(d), 15 U.S.C. §1052(d). As the basis for the refusal, the Examining Attorney cited a registration for KALI-O'S JUICE BOX (Reg. No. 5343933) covering the following beverage-related goods: "*Smoothies; Smoothies; Smoothies containing grains and oats; Apple juice beverages; Coconut juice; Mixed fruit juice; Non-alcoholic fruit juice beverages; Orange juice; Pineapple juice beverages; Prepared entrees consisting of fruit drinks and fruit juices, fruit-based beverages, non-alcoholic beverages containing fruit juices, non-alcoholic fruit extracts used in the preparation of beverages, non-alcoholic fruit juice beverages, vegetable juices, vegetable-fruit juices and smoothies.*"

Applicant respectfully requests that the question of likelihood of confusion be reconsidered in this case. All relevant factors, including the differences between the parties' marks and goods, need to be considered in this likelihood of confusion analysis. *In re DuPont de Nemours and Co.*, 177 USPQ 563 (CCPA 1973) ("DuPont"). First, in light of the deletions to and narrowing of Applicant's identification of goods, there is no longer any potential for overlap with the different and non-competitive goods identified in the cited registration. Additionally, Applicant's mark is not identical to and differs in sound, appearance, meaning, and overall commercial impression from the cited mark. Furthermore, the relevant consumers are sophisticated, making confusion even less likely in the marketplace. For all of these reasons, no confusion is likely to arise in this case and the Applicant's mark should be approved for publication.

**A. The Goods Of The Parties Are Not Closely Related Or Provided In Circumstances Likely To Lead To Confusion**

The differences between the parties' respective goods are readily apparent and this *DuPont* factor, therefore, weighs in favor of the Applicant. If the goods 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. *See, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field).

The Office Action asserts that “many companies . . . sell both iced tea, like [A]pplicant, and juice products, like registrant” “under the same mark.” However, Applicant has now deleted “iced tea” from its identification of goods, and none of the remaining goods in Applicant’s application overlap or are competitive with the beverage-related goods identified in the cited registration. Indeed, the parties’ goods are not even classified in the same international class. Moreover, as discussed below, the parties’ respective marks are **not** “the same.”

Applicant’s goods are distinguishable from those identified in the cited registration such that no likelihood of confusion exists, especially in light of the sophistication of the parties’ consumers and the differences between their respective marks. Simply put, Applicant’s goods and those identified in the cited registration are not directly competitive or even similar. This factor, thus, weighs against a finding of likelihood of confusion.

## **B. The Marks Are Not Confusingly Similar**

It is well settled that a likelihood of confusion determination turns on a comparison of the marks in their entireties. *See Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399 (CCPA 1974). The parties' marks must be viewed as a whole, not dissected. *In re National Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985). As discussed below, Applicant's mark differs from the cited registered mark in appearance, sound, meaning, and overall commercial impression.

### **1. The Parties' Marks Differ In Appearance**

In the present case, the marks are visually quite distinct, as the Registrant's mark appears with additional wording, differing in its end portion from Applicant's mark.

The comparison of marks must be made on a case-by-case basis, without reliance on mechanical rules of construction. Furthermore, the different overall commercial impressions of the marks should not be overlooked. *See, Shen Mfg. Co.*, 73 USPQ2d 1350 (RITZ and THE RITZ KIDS create different commercial impressions); TMEP § 1207.01(b)(iii). Indeed, in many cases the TTAB and courts have held that marks as a whole are not confusingly similar even where one contains the entirety of the other, which is not even the case at hand. For example, in *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282 (TTAB 2009), the TTAB held that VOLTA for vodka infused with caffeine was not likely to be confused with TERZA VOLTA and Design for wines, since the design feature and the term TERZA in the registered mark made it visually distinguishable from the applicant's mark VOLTA.

Here, Applicant's mark consists of the distinctive wording "CALI O!". The cited registered mark comprises the different wording "KALI-O'S JUICE BOX." The marks clearly differ in appearance, and consumers will look to the existing differences in determining that both of these marks are separate and individual source identifiers. The additional components of the

Registrant's mark and the different visual appearances of the sole portion of both marks that could arguably be deemed somewhat similar, create a unique and distinctive commercial impression.<sup>1</sup> When compared in their entireties, as they must be, the parties' respective marks differ significantly in appearance and are not confusingly similar. As such, consumers will view Applicant's mark as creating a commercial impression distinct from that of the cited registered mark.

## **2. The Parties' Marks Differ In Sound**

When the parties' marks are considered in their entireties, as they must be, Applicant's mark, comprising a single term separated by a space and having just three syllables, differs substantially from the cited registered mark, which consists of three separate terms with a total of five syllables. When spoken, the phonetic differences between the parties' respective marks as a whole will serve to avoid a likelihood of confusion.

## **3. The Parties' Marks Differ In Meaning**

The addition of the words "JUICE BOX" to the Registrant's mark indicates to consumers that the underlying goods are juices and beverages. Indeed, those are the goods covered by the cited registration. Applicant's mark conveys no such meaning, but instead imparts the meaning of being a source indicator for Applicant's different goods in Class 30. The parties' sophisticated consumers will understand that the different marks identify the source of the parties' respective different goods.

According to the Registrant's website, the portion "KALI-O'S" in its mark is derived from the names of the two co-founders and sisters – **K**erry and **A**lli **O**'Neill (see <https://www.kaliosjuicebox.com/who-is-kali>, attached hereto as Exhibit 1). Additionally, the

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<sup>1</sup> Even though the Registrant has disclaimed the wording "JUICE BOX" in its mark, the mark must still be regarded as a whole, including the disclaimed portion, in evaluating similarity to other marks. *See* TMEP § 1213.10.

specimens of use submitted by the Registrant to the USPTO during prosecution of its trademark application and Registrant's own website confirm that its goods of interest are juices and smoothies (not staple food products as more typically found within Class 30), and in particular those that are healthy and made from whole fruit and with other fresh ingredients (Exhibit 2). Thus, the meaning or connotation conveyed by the Registrant's mark is very specific as that of a source indicator for Registrant's goods.

As explained in TMEP § 1207.01(b)(v), "The meaning or connotation of a mark must be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance [which is not even the case here] may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion." *See, e.g., In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies' sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant's bras, whereas "CROSSOVER," as applied to registrant's goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear . . . or the line between two seasons"); *In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) (holding PLAYERS for men's underwear and PLAYERS for shoes not likely to cause confusion, agreeing with applicant's argument that the term "PLAYERS" implies a fit, style, color, and durability suitable for outdoor activities when applied to shoes, but "implies something else, primarily indoors in nature" when applied to men's underwear); *In re Sydel Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (holding BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's clothing not likely to cause confusion, noting that the wording connotes the

drinking phrase “Drink Up” when applied to men’s clothing, but does not have this connotation when applied to ladies’ and children’s underwear).

In the current instance, the Applicant’s and Registrant’s respective marks differ in appearance, sound, and meaning, and further convey sufficiently different commercial impressions when applied to the respective parties’ different goods such that there is no likelihood of confusion.

**C. Sophistication Of The Parties’ Respective Consumers Lessens The Likelihood Of Confusion**

Applicant and the Registrant provide their different goods under their respective different marks to sophisticated consumers. The more sophisticated the consumers, the less likely they are to be misled by similarity in marks. *See Cadbury Beverages, Inc. v. Cott Corp.*, 37 USPQ2d 1508, 1513 (2d Cir.1996). This factor, too, heavily favors a finding of no likelihood of confusion. The Registrant’s goods are provided to sophisticated and knowledgeable consumers who seek healthy and nutritional beverage items. Such consumers are savvy and will be able to differentiate between the goods being offered under the Registrant’s mark and the different non-beverage goods being offered under the Applicant’s different mark. Similarly, Applicant’s consumers will shop around and pay attention to consumer reviews and ingredients before purchasing its different goods. These are not impulse purchases.

Although Applicant acknowledges that purchasers’ sophistication and knowledge with respect to a particular field does not make them immune from source confusion, great weight should nonetheless be afforded Applicant in this instance. The parties’ respective marks differ in sound, appearance, meaning, and overall commercial impression, and their goods also differ. TMEP §1207.01(d)(vii) states that “circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion.” This is precisely the situation at hand. As such, source

confusion is not likely. Since preventing buyer confusion is the ultimate goal in a likelihood of confusion analysis, this factor weighs against a finding of likelihood of confusion.

#### **D. Conclusion**

To support a refusal on likelihood of confusion grounds, there must be more than a mere possibility of confusion; instead, a demonstrated probability or likelihood of confusion must exist. *See Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), quoting from *Witco Chemical Company, Inc. v. Whitfield Chemical Company, Inc.*, 164 USPQ 43 (CCPA 1969) as follows: “We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.” *See also, Triumph Machinery Company v. Kentmaster Manufacturing Company 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. Here, the possibilities for confusion are, if anything, quite remote. Accordingly, for all the foregoing reasons, Applicant submits that there is no likelihood of confusion between the cited registered mark on the one hand and Applicant’s mark on the other.

#### **II. Information Request**

The Examining Attorney has requested that Applicant “explain whether the wording in the mark ‘CALI O!’ has any significance in the food and/or confectionery trade or industry or as applied to [A]pplicant’s goods, or if such wording is a ‘term of art’ within [A]pplicant’s industry.” Applicant responds that the wording “CALI O!” has no significance within the relevant trade or industry or as applied to Applicant’s products, and the wording is not a “term of art” within the relevant trade or industry.



As Applicant has now suitably addressed all of the issues raised in the Office Action, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) refusal, and approve the subject mark CALI O! for publication.

Respectfully submitted,



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