

Office Action Responses
Serial No. 88244299
MOTA

I. Translation of the Mark.

In the present Office Action, the Examining Attorney has requested that Applicant submit an English translation of all wording in the mark that appears to be foreign. The Examiner suggests “the marijuana” as the translation. However, this suggested translation is incorrect. The translation of the wording MOTA from Spanish to English is “weed.” The English word “marijuana” translates into the Spanish word “marihuana,” not “mota.” Accordingly, Applicant submits herewith an accurate translation from Spanish to English.

II. Section 2(d) - Likelihood of Confusion.

In the present Office Action, the Examining Attorney has preliminarily refused registration of Applicant’s Mark MOTA, for use in connection with “Clothing, namely, shirts, t-shirts, sweatshirts, hooded sweatshirts, sweaters, polo shirts, tank tops, pullovers, cardigans, jackets, coats, vests, pants, sweat pants, leggings, shorts, skirts, socks, and scarves; headwear namely, hats, beanies, caps, skull caps, headbands, and visors” in Class 25, under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with the following registered mark (hereinafter the “Cited Mark”):

<u>Mark:</u>	#MOTA
<u>Reg. No.:</u>	5245907
<u>Owner:</u>	Making Opportunities Through Anything, LLC (“Registrant”)
<u>Goods/Services:</u>	<i>Class 25</i> - Baseball caps and hats; Sweatshirts; T-shirts; Bottoms; Hooded sweatshirts; Jackets; Short-sleeved or long-sleeved t-shirts; Tops <i>Class 41</i> - Entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings; Entertainment services in the nature of live musical performances; Entertainment services in the nature of live hiphop, rap and acting performances; Entertainment services, namely, providing non-downloadable playback of music via global communications networks; Music composition services; Screenplay writing; Entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings.

Applicant respectfully disagrees with the Examining Attorney’s position, and submits that there is no likelihood of confusion between Applicant’s Mark and the Cited Mark.

In assessing a likelihood of confusion, the courts have repeatedly said, “it is the duty of the examiner * * * to find, upon consideration of *all* the evidence, whether or not confusion appears likely.” *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 568 (CCPA

1973) (emphasis in original). A determination of likelihood of confusion requires more than a finding that two marks are similar or even that the goods/services are related. It requires a finding that consumers will likely be confused as to the source of origin or sponsorship of the goods/services due to the use of the mark with the goods/services. According to the Trademark Manual of Examining Procedure (“TMEP”), even if the marks are identical, confusion is not likely if the goods/services are not related or marketed in such a way that will create confusion as to source. TMEP § 1207.01.

In the present case, consideration of all the evidence and all the relevant factors shows that confusion between Applicant’s Mark and the Cited Mark is unlikely, and favors allowing Applicant’s Mark to proceed to publication. Applicant’s Mark and the Cited Mark are used on different goods and services, and the manner in which they are used (or intended to be used) avoids any likelihood of confusion. Also, Applicant’s Mark and the Cited Mark are different in appearance, sound, and meaning and convey different commercial impressions.

A. Applicant’s Goods and Registrant’s Services and Promotional Goods are Different.

First, Applicant’s goods and Registrant’s goods and services are different in nature. Among the relevant factors in the likelihood of confusion analysis is “the similarity or dissimilarity and nature of the goods or services.” *See Du Pont*, 476 F.2d 1357; TMEP § 1207.01(a). The U.S. Patent and Trademark Office (“USPTO”) and the courts have allowed a number of similar and identical marks to coexist in connection with various goods and services. *See, e.g., Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ 2d 1460 (TTAB 1992) (EDS and EDSA as used in connection with computer software may coexist).

Although Applicant and Registrant both list goods in Class 25, the parties’ respective businesses are different in nature. When considering the alleged similarity of the parties’ respective goods and services, the question of likelihood of confusion must be determined based on an analysis of the goods recited in Applicant’s application versus *all* the goods and services recited in Registrant’s registration. *See, e.g., Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Registrant’s registration is primarily for services in Class 41, “Entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings; Entertainment services in the nature of live musical performances; Entertainment services in the nature of live hiphop, rap and acting performances; Entertainment services, namely, providing non-downloadable playback of music via global communications networks; Music composition services; Screenplay writing; Entertainment services by a musical artist and producer, namely, musical composition for others and production of musical sound recordings.”

Registrant’s use of its mark on goods in Class 25 is purely ornamental, as demonstrated by Registrant’s specimens of use (*See* Exhibit 1, attached hereto and made a part hereof by this reference, consisting of Registrant’s specimens of use, downloaded on September 20, 2019 from the USPTO TSDR database):



In light of the purely decorative and ornamental use of the Cited Mark demonstrated by Registrant itself, the registration of the Cited Mark in Class 25 only serves a promotional or source-indicating function through its use with goods or services *other than those that are ornamental* – i.e. as a “secondary-source.” *See* TMEP § 1202.03(c). The status of the use as reference to a secondary source makes clear that it is Registrant’s entertainment services which are primary to Registrant and known to Registrant’s consumers and potential consumers. Registrant is not a clothing company; it is an entertainment company that offers clothing to a select group of consumers who are familiar with its entertainment services, to promote its entertainment services.

Applicant’s goods are intended to be clothing under the MOTA brand, a primary indicator of the source of the clothing products. Applicant does not offer entertainment services, nor would a fan of Registrant’s entertainment services seek out a third party clothing brand that did not convey or depict the promotional message of Registrant.

It is also worth noting that the specimens of use offered by Registrant to support its application in December, 2016 were screen shots dated July 6, 2014, August 1, 2014, September 9, 2014, and January 31, 2015 (*see* dates set forth in Exhibit 1). Accordingly, the uses offered by Registrant at the time of its application were not current uses in commerce at that time. Moreover, the Instagram account depicted in Registrant’s specimens of use no longer exists (as of September 23, 2019, no such user comes up when searching Instagram).

If the goods/services in question are unlikely to be encountered by the same purchasers in situations that would create a mistaken assumption as to the source of the goods/services, then,

even if the marks are identical, confusion is unlikely. *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947–48 (Fed. Cir. 2006); *see also, e.g., Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various electrical products used in the photocopying field). Confusion is also unlikely if the respective goods/services are marketed to different classes of purchasers. *See, e.g., 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 & Design for advertising services in the plumbing field).

In the present case, confusion is unlikely because Registrant's customers are fans of its entertainment services, and Applicant offers no such similar services. Registrant's customers presumably buy its promotional apparel products after attending a live musical performance or listening to sound recording. Registrant's fans are not Applicant's customers; and a dedicated fan would not mistakenly purchase a shirt of a third party that has no connection to or with the music performer of that fan's following. The parties' respective goods/services are not advertised or sold to the same consumers and cannot act as meaningful replacements for each other. They are not substitutes for each other. Therefore, the parties do not compete in the marketplace, which makes confusion between the parties' respective marks unlikely.

B. The Parties' Respective Marks are Different in Appearance, Sound, and Meaning and Convey Different Commercial Impressions.

Here, Applicant's Mark and the Cited Mark are not identical; they are different in appearance, sound, and meaning. The Cited Mark contains the additional symbol “#” which is read aloud as “hashtag.” The additional symbol in the Cited Mark imparts a strong visual and aural impression, distinguishing the Cited Mark from Applicant's Mark. The Cited Mark is read aloud as “hashtag mota” which sounds completely different than MOTA when read aloud. Also, the letters in the Cited Mark are clearly an acronym for or abbreviation of Registrant's name, “Making Opportunities Through Anything.” Registrant's fans who buy its promotional merchandise will know the acronym, and would not mistake “MOTA” alone for “Hashtag Making Opportunities Through Anything.”

Another factor in the analysis of the appearance of the marks is that the hashtag symbol is at the beginning of the Cited Mark. The first-seen and first-heard element creates a different appearance and sound. The first syllable or word of a mark is generally the more dominant element of the mark. *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895 (TTAB 1988) (first part of mark most likely to be impressed on mind of purchaser); *see also, e.g., Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (first word in the mark is the prominent feature); *Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006). Consumers seeing the Cited Mark will immediately associate it with the use of hashtags online to link to and promote a particular musical act. The difference in appearance and sound cause the Cited Mark to project a different commercial impression and makes confusion between Applicant's Mark and the Cited Mark unlikely.

The Trademark Trial and Appeal Board's ("TTAB") finding in *In re RBR, LLC* (TTAB 2010) (covering marks with goods in Class 25 and containing the same word with additional wording, stylization, and/or design elements) is applicable here. *In re RBR* demonstrates how the TTAB compares marks in their entireties (including when determining whether a likelihood of confusion exists). In *RBR*, the Examining Attorney refused registration of the mark CURRENT/ELLIOTT for jeans, pants, shirts, jackets, t-shirts, dresses, and skirts in Class 25. The refusal was based on a likelihood of confusion with two registered marks, namely, the mark CURRENT for scarves, hats, t-shirts, socks, sweatshirts, pantyhose, ties, and cloth baby bibs in Class 25, and the mark ELLIOT for men's and boys' shirts in Class 25. The Examining Attorney argued that applicant's addition of one word to either of the cited marks did not create a distinct or separable commercial impression, nor did it create a mark with a different meaning. The TTAB disagreed with the Examining Attorney's position regarding the similarities of the respective marks and reversed the refusal to register applicant's mark. The TTAB found that applicant's use of additional wording with a slash created a different connotation and overall commercial impression sufficiently distinct from the single word CURRENT or the single word ELLIOT, as used in each of the cited marks. This was especially true with respect to the cited mark ELLIOT, as applicant's mark *began with* a different word (i.e., CURRENT), making the respective marks very different in appearance.

In re Wet Seal, Inc., Serial No. 76338469 (TTAB 2004) also demonstrates how the TTAB compares marks in their entireties, including marks containing the same wording as well as additional and/or different wording, stylization, and/or design elements, when determining whether a likelihood of confusion exists. In *Wet Seal*, the Examining Attorney refused registration of the mark SEAL for various goods, including handbags, purses, backpacks, briefcases, cosmetic bags and toiletry cases sold empty, vanity cases sold empty, wallets, and change purses in Class 18. The refusal was based on a likelihood of confusion with various registered marks, including SEAL PAK for fanny packs, hip packs, and waist packs in Class 18 and SEALCO for mail order services in the field of luggage in Class 42. The Examining Attorney argued that confusion was likely because the cited marks all contained the wording "SEAL" and the only differences were the addition of arguably descriptive or generic wording, such as "PAK" or "CO." The TTAB disagreed with the Examining Attorney's finding and reversed the refusal to register applicant's mark. The TTAB found that there were obvious differences between the respective marks in both sound and appearance, and when considered in their entireties, the marks were dissimilar in commercial impression. Also, the use of "SEAL" with additional wording in each of the cited marks, even the disclaimed wording "PAK" or the descriptive wording "CO," conveyed different meanings than applicant's use of "SEAL" alone:

The connotation of applicant's mark also differs from the connotation of the cited marks for the respective goods in Class 18 and services in Class 42. Applicant's mark SEAL suggests the texture or composition of its handbags and purses. The mark SEAL PAK, however, suggests a function of registrant's fanny packs and waist packs, in particular, the tight closure of the packs and security of the items contained therein. The mark SEALCO for mail order services in the field of luggage suggests a company name rather than any intrinsic characteristic of the services.

Wet Seal at 7. The TTAB's finding in *Wet Seal* is on point and the same analysis should be applied in the present case. Here, the mark #MOTA connotes the functional use of hashtags online, particularly in social media, to link to or bring attention to a person, entity, or issue. In Registrant's case, #MOTA is used to promote its entertainment/music services, and to function as an acronym for its full name, Making Opportunities Through Anything. The hashtag itself may not be independently source-identifying, but as part of the mark as a whole, it is understood by consumers to function as a means of promotion and linking, immediately understood to refer to online social media "hype." Consumers will say "hashtag" when reading the Cited Mark to themselves.

When considered in their entirety, including the additional symbol used in the Cited Mark, and resulting differences in sound and meaning, Applicant's Mark and the Cited Mark create overall commercial impressions sufficiently distinct from each other.

Applicant's Mark and the Cited Mark are different in sound, appearance, and meaning, and do not project the same commercial impression. Compared in their entirety and placing appropriate emphasis on their differences, the respective marks are sufficiently different to avoid consumer confusion.

C. Conclusion.

Confusion is unlikely given the circumstances at issue here. Registrant's clothing goods are promotional in nature, and the Cited Mark is used on those goods ornamentally as a secondary source indicator. On the other hand, Applicant intends to use its mark as a brand identifier for its clothing products. In addition to the parties' respective goods/services being different in nature, the marks themselves are different in sound, appearance, and meaning, and create different commercial impressions. Compared in their entirety with appropriate emphasis on the relevant details of Applicant's Mark and the Cited Mark (all of which are evident from the USPTO's records), it is clear that confusion between the respective marks is unlikely. For the foregoing reasons, Applicant respectfully requests that the Examining Attorney remove the likelihood of confusion refusal and approve Applicant's application for publication.