

THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: KABBALAH CENTRE INTERNATIONAL, INC.
SERIAL NO: 88/264,061
FILED: January 16, 2019
MARK: KABBALAH ONE CI. 41

RESPONSE

This is a Response to the Office Action dated April 7, 2019. The time period for Response extends to and includes October 7, 2019.

AMENDMENTS

Claims of Acquired Distinctiveness in Part Under 2(f)

Please amend the Application as follows:

-- The term "KABBALAH" has become distinctive as used in connection with Applicant's services through the Applicant's substantially exclusive and continuous use in commerce for at least twenty eight years immediately before the date of this statement. --

Claim of Ownership

Applicant is the owner of U.S. Registration Nos. 5,766,955, 5,766,954, 5,766,952, 5,077,099, 5,077,098, 5,067,942, 5,067,941, 5,067,940, 5,063,816, 5,063,811, 4,920,736, 4,831,887, 4,778,004, 4,769,313, 4,706,328, 4,248,744, 4,249,008, 4,248,926, 3,844,114, 2,885,663 and others.

REMARKS

Applicant has included Claims of Acquired Distinctiveness in Part and a Claim of Ownership of United States Trademark Registration Nos. 5,766,955, 5,766,954, 5,766,952, 5,077,099, 5,077,098, 5,067,942, 5,067,941, 5,067,940, 5,063,816, 5,063,811, 4,920,736, 4,831,887, 4,778,004, 4,769,313, 4,706,328, 4,248,744, 4,249,008, 4,248,926, 3,844,114, 2,885,663 and others.

Disclaimer Requirement

In the Office Action, the Examining Attorney is requiring that Applicant disclaim the term "KABBALAH" apart from the mark as shown on the basis that the wording is allegedly merely descriptive of Applicant's intended services, which are educational services, namely, providing classes, events, lectures, teaching and instruction in the field of religion and spirituality and the organization of events in the field of religion and meditation for education purposes.

Applicant respectfully submits that the subject mark is entitled to registration on the basis that the term KABBALAH has acquired distinctiveness through both Applicant's substantial use, advertising and promotion of its services offered under the subject mark, as well as through Applicant's use of its family of **KABBALAH** Marks in connection with its goods and services, including its educational services in Class 41. Applicant submits herewith the Declaration of Jules Redlich, the General Counsel and Authorized Signatory of Applicant, The Kabbalah Centre International, Inc. (the "Redlich Decl."), in support of Applicant's claim of acquired distinctiveness in part.

Applicant's mark KABBALAH ONE is entitled to registration on the Principal Register on the grounds that it has acquired distinctiveness in part under Section 2(f) of

the Lanham Act, 15 U.S.C. § 1501 et. seq. Applicant submits that the subject mark is one of a family of **KABBALAH** marks owned by Applicant, which Applicant has used in connection with its world famous international, non-profit, religious organization for over 28 years in connection with Applicant's goods and services, including educational services (Redlich Decl. at 3). Applicant's world famous organization was founded in 1922 in Israel and teaches the ancient wisdom of Jewish spirituality and its mission includes the improvement of people's lives through the spiritual principles and teachings of Judaism. (Id. at 4). Applicant's organization is one of the most widely recognized religion groups in the world. (Id.). Applicant's educational services are open to all persons and Applicant's classes are regularly attended by Jewish and non-Jewish persons alike. (Id.). Applicant's organization has attracted numerous celebrity students to attend its classes, such as Madonna, Demi Moore, Ashton Kutcher and Rosanne Barr (just to name a few). (Id. at 5). Many of Applicant's celebrity students have openly discussed their affiliation with Applicant in interviews and during public appearances over the years. (Id.). Applicant has received a tremendous amount of unsolicited media coverage throughout the United States. (Id.).

Applicant's various social media pages have amassed great numbers of followers and likes. (Id. at 6). For example, Applicant's Facebook® page has been liked by over 1,384,000 people and is followed by over 1,383,000 people, Applicant's Instagram® page has over 62,000 followers, Applicant's Twitter® has over 28,000 followers and Applicant's YouTube® Channel has over 22,000 subscribers. (Id.). Printouts from TESS of each of Applicant's above-referenced social media pages are attached to the Redlich Decl. at **Exhibit A**.

In connection with Applicant's world famous organization, Applicant is the owner of a family of **KABBALAH** marks that it uses in connection with a wide variety of goods and services. (Id. at 7). Based upon Applicant's substantial use and promotional efforts, these marks have acquired substantial consumer recognition and good will. (Id.). Applicant is the owner of the following United States Trademark and Service Mark Registrations on the Principal Register for its family of **KABBALAH** marks, many of which cover highly related goods and/or services that are closely related to the services set forth in the subject application and many of which have achieved incontestable status:

<u>Reg. No.</u>	<u>Mark</u>	<u>International Class</u>
5,766,955	THE KABBALAH CENTRE and Design	16
5,766,952	THE KABBALAH CENTRE and Design	41
5,766,954	THE KABBALAH CENTRE and Design	45
5,077,099	THE 72 NAMES OF GOD KABBALAH and Design	9
5,077,098	KABBALAH CHILDREN'S ACADEMY and Design	41
5,067,942	THE KABBALAH CENTRE CHARITABLE CAUSES and Design	36
5,067,941	THE KABBALAH CENTRE CHARITABLE CAUSES	36
5,067,940	THE KABBALAH CENTRE ZOHAR PROJECT and Design	35
5,063,816	THE KABBALAH CENTRE and Design	41
5,063,811	KABBALAH UNIVERSITY and Design	45

4,920,736	KABBALAH CHILDREN'S ACADEMY EDUCATING THE MIND IGNITING THE SOUL	41
4,831,887	KABBALAH CENTRE PUBLISHING and Design	16
4,778,004	THE KABBALAH CENTRE and Design	16
4,706,328	THE KABBALAH CENTRE and Design	41
4,769,313	THE LIVING KABBALAH SYSTEM	9
4,252,840	KABBALAH WATER and Design	32
4,248,744	KABBALAH UNIVERSITY and Design	45
4,249,008	KABBALAH: THE BEST KEPT SECRET and Design	41
4,248,926	THE KABBALAH CENTRE LEARN TRANSFORM CONNECT and Design	41
4,103,949	THE KABBALAH MUSEUM and Design	45
4,256,416	KABBALAH UNIVERSITY	45
4,249,025	THE KABBALAH CENTRE	41
4,086,044	THE KABBALAH MUSEUM	45
4,450,030	KABBALAH PUBLISHING and Design	16
4,386,338	THE KABBALAH CENTRE	16
3,958,807	THE KABBALAH CENTRE LEARN TRANSFORM CONNECT and Design	9
3,958,806	THE KABBALAH CENTRE LEARN TRANSFORM CONNECT and Design	16
3,844,114	THE KABBALAH CENTRE LEARN TRANSFORM CONNECT and Design	41
3,705,292	THE KABBALAH CENTRE BOOKSTORE	35

3,672,040	KABBALAH: THE BEST KEPT SECRET	41
2,977,456	KABBALAH WATER	32
2,885,663	THE KABBALAH CENTRE and Design	41
3,061,462	THE POWER OF KABBALAH	41
2,383,241	THE KABBALAH CANDLE	11
2,381,449	THE KABBALAH COLLECTION and Design	11
2,499,273	KABBALAH	16
2,416,725	THE KABBALAH CENTRE and Design	16
2,264,214	THE KABBALAH CENTRE	16

(Id. at 8). Printouts from TESS of each of Applicant's above-referenced Registrations are attached to the Redlich Decl. at **Exhibit B**.

Applicant has invested a substantial amount of time, money and other resources advertising, promoting and marketing its goods and services provided under its family of **KABBALAH** marks throughout the United States, including through use of its website located at www.kabbalah.com. (Id. at 9). As a result of Applicant's substantial advertising, marketing and promotional efforts, Applicant's family of **KABBALAH** marks has acquired substantial consumer recognition and good will. (Id. at 10). Applicant's family of **KABBALAH** marks has become an important source indicator which identifies the quality goods and services provided by Applicant. (Id. at 11).

Additionally, Applicant has conducted annual advertising campaigns for its goods and services provided under its family of **KABBALAH** marks continuously for many years. (Id. at 12). Applicant has expended substantial sums of money publishing advertisements in national publications such as The New York Times, The Los Angeles

Times, The Jewish Journal, The Chicago Tribune and many others. (Id. at 13). Applicant has additionally expended substantial sums of money conducting local advertising campaigns in cities throughout the United States and elsewhere throughout the world. (Id. at 14). In addition, Applicant has advertised its goods and services provided and sold under its family of **KABBALAH** marks through direct mail and email campaigns, as well as the widespread distribution of its newsletters (both in print and electronically), that have reached millions of people. (Id. at 15).

Applicant prominently advertises and promotes its goods and services provided under its family of **KABBALAH** marks on Applicant's web site, located at www.kabbalah.com. (Id. at 16). Applicant's web site receives a substantial amount of web traffic, receiving approximately 1,700,000 page visits and over 5,000,000 page views per year. (Id.). Moreover, Applicant's online store (located at store.kabbalah.com) through which many of Applicant's goods are sold, receives over 680,000 unique visitors per year. (Id.). By virtue of the substantial traffic Applicant's web site and online store receives, it is clear that consumers encounter and view Applicant's prominent usage of its family of **KABBALAH** marks online. (Id.).

Applicant operates establishments under the name and mark THE KABBALAH CENTRE in major cities throughout the United States, including, for example, New York City, Los Angeles, Miami, Boca Raton and others. (Id. at 17). Applicant also prominently utilizes its family of **KABBALAH** marks in connection with bookstores, satellite groups and/or study groups that it operates in other major cities throughout the United States, including Dallas, Boston, Washington DC, Houston, St. Louis, San Diego, Chicago, Cleveland, Minneapolis, Indianapolis, Las Vegas, San Francisco and others. (Id. at 18).

Applicant has conducted extensive marketing, promotional and advertising campaigns in each of the cities in which Applicant's THE KABBALAH CENTRE establishments and/or study groups are located. (Id. at 19). In addition, when a search of "KABBALAH ONE" is conducted on Google®, every reference on the first page of search results refers to Applicant. (Id. at 20).

For all of the foregoing reasons, it is beyond dispute that consumers have come to associate Applicant's family of KABBALAH marks and by extension the mark KABBALAH ONE with Applicant. (Id. at 21).

For all of the foregoing reasons, it is respectfully submitted that Applicant's mark KABBALAH ONE has acquired distinctiveness in part and that no disclaimer of "KABBALAH" should be required.

All issues raised in the Office Action are believed to have been addressed. Favorable action is respectfully requested.