

Application Serial No.: 88/284,290

The logo for 'hoja' features the word in a lowercase, sans-serif font. A small, stylized leaf icon is positioned above the letter 'j'.

Mark:

Applicant: HOJA INTERNATIONAL INC.

Office Action Response

I. Section 2(d) Refusal – Likelihood of Confusion

A. Introduction

Applicant Hoja International Inc. (“Applicant”) seeks to register the mark

The logo for 'hoja' features the word in a lowercase, sans-serif font. A small, stylized leaf icon is positioned above the letter 'j'.

(“Applicant’s Mark”) for the following goods, as amended:

International Class 29: Eggs; Jellies, jams; Meat; Meat and meat extracts; Milk products excluding ice cream, ice milk and frozen yogurt; Preserved, dried and cooked fruit and vegetables; Frozen, frosted, preserved, processed, dried, cooked or crystallized fruit and vegetables extracts for use in prepared meals or food; Fruit, preserved; Meat, fish, poultry and game preserves; Meat, fish, poultry and game, not live.

International Class 30: Coffee and coffee substitutes; Coffee and artificial coffee; Honey; Honey substitutes; Ice; Rice; Sago; Sauces; Spices; Sugar; Tapioca; Tapioca flour; Tapioca pearls; Tea; Tea bags; Treacle; Black tea; Chai tea; Chamomile tea; Citron tea; Coffee and tea; Earl Grey tea; Flavored salt; Flavored sugar; Ginger tea; Ginseng tea; Green tea; Instant tea; Japanese green tea; Jasmine tea; Oolong tea; Rooibos tea; Rosemary tea; Unrefined sugar, namely, evaporated sugar cane juice.

International Class 32: Beers; Fruit drinks and fruit juices; Mineral and aerated water; 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; Syrups for beverages; Syrups for making fruit-flavored drinks; Syrups for making beverages.

(“Applicant’s Goods”). The Examining Attorney has issued an Office Action refusing to register Applicant’s Mark under the Trademark Act §2(d) and asserts that there is a likelihood of confusion between Applicant’s Mark and the following registration:

- **HOJA VERDE**, U.S. Reg. No. 5304532, for “Chocolate; Chocolate based ingredient for use in confectionery products; Cocoa; Coffee; Pastry; Tea; Chocolate for confectionery and bread; Cocoa-based ingredient in confectionery products” in Int’l Class 30, owned by Hoja Verde Gourmet Hovgo S.A (the “Cited Mark”).

Applicant respectfully requests reconsideration of this refusal to register.

B. Confusion between Applicant’s Mark and the Cited Mark is unlikely because the marks are different in appearance, sound, meaning, and overall commercial impression.



Applicant’s mark and the Cited Mark are different in appearance, sound, meaning and overall commercial impression. As a result, confusion between Applicant’s Mark and the Cited Mark is not likely.

Similarity of appearance between marks is determined by considering the overall impression of a mark using a subjective “eyeball” test. See 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, (4th ed. 1999), Section 25:21 (“McCarthy”). When they are viewed using the “eyeball” test, Applicant’s Mark and the Cited Marks are different in appearance because they incorporate numerous distinguishing features. Applicant’s Mark consists of only one word, HOJA, in a stylized font displaying the mark in lower case with a leaf extending from the letter “j” in the middle of the mark. On the other hand, the Cited Mark consist of two words, HOJA VERDE. These differences in the marks render the marks vastly different in appearance. See Champagne Louis Roederer, S.A. v. Delicato Vineyards, 148 F.3d 1373, 1374-75 (Fed. Cir. 1998) (finding dissimilarity between CRISTAL and CRYSTAL

CREEK); Citigroup Inc., v. Capital City Bank Group, Inc., 637 F.3d 1344, 1350 (Fed. Cir. 2013) (“[t]his court has found mark dissimilarity when the words are spelled differently”).

The fact that the marks share a word is not dispositive, as similarity is based on the total effect of the marks, rather than a comparison of any individual features. See In re Sweet Victory Inc., 228 U.S.P.Q. 959, 961 (TTAB 1986) (finding marks GLACE CONTINENTAL and GLACE LITE were not likely to be confused even though both marks were used in connection with sherbet, because “the overall differences in the marks are sufficient so that while source confusion may be possible, it is not likely”); Flushing Bank v. Green Dot Corp., 138 F.Supp.3d 561, 588 (SDNY 2015) (finding marks GOBANK and IGOBANKING, both with design elements, and used for banking services, despite some similarities were dissimilar when taken as a whole, reasoning that they convey different impressions, have different emphases, sound different and look different); Lebow Bros., Inc. v. LeBole Euroconf. S.p.A, 503 F. Supp. 209 (E.D. Pa. 1980) (considering the differences in the spelling and number of letters in the marks and finding no likelihood of confusion between LEBOLE and LEBOW CLOTHES); In re Reach Electronics, Inc., 175 U.S.P.Q. 734 (TTAB 1972) (finding no likelihood of confusion between REAC and REACH); J.Wiss & Sons Co. v. Gee Whiz Tool Corp., 364 F.2d 910 (6th Cir. 1966) (finding no likelihood of confusion between WIZZ and GEE WHIZ); see McCarthy, §23:22 (phonetic similarity is merely one element to consider in determining likelihood of confusion of overall impression).

The Examining Attorney must consider the effect of the entire marks, including elements other than the features that are similar to features of the Cited Mark. See In re Viterra Inc., 671 F.3d 1358, 1362 (Fed. Cir. 2012) (“marks must be viewed 'in their entirety, and it is improper to dissect a mark when engaging in this analysis”). Here, the overall appearances and sounds of the

marks are dissimilar because the Applicant's Mark contains a design element and the Cited Mark includes one additional term. These differences render Applicant's Mark sufficiently distinguishable in appearance and sound from the Cited Mark.

Further, given the additional term in the Cited Mark, the mark is different from Applicant's Mark in sound. The differences in the marks in appearances and sound support a finding that confusion is not likely. See, e.g., Sure-Fit Products Co. v. Saltzson Drapery Co., 117 U.S.P.Q. 295, 297 (CCPA 1958) (affirming Patent Office decision that marks RITE-FIT and SURE-FIT, both used in connection with slip covers, were not likely to be confused, and stating that "[t]he fact of the matter is that 'Rite' and 'Sure' do not look alike or sound alike, factors which we feel...militate against" a finding of confusion). Furthermore, as the Cited Mark is a translation of the Spanish word for leaf, the term HOJA VERDE is pronounced as "O-Ha VERDE" whereas Applicant's Mark is pronounced as "HO-JA."

In addition to being different in appearance and sound, Applicant's Mark and the Cited Mark also have different meanings, such that consumers will not associate them with the same source.

Applicant's Mark is for one word presented in a stylized format and design:



. In addition, the term HOJA is the English transliteration of the following Chinese characters “好呷” which, when taken together, mean “good.” Attached as Exhibit A is the Google translate page for the Chinese characters “好呷”.

As a result, the appearance, sound, and meanings of Applicant's Mark and the Cited Marks are distinctly different, making confusion unlikely. See, e.g., In re Park Lane Shoes Ltd., 2011 TTAB LEXIS 282, at *6-8 (TTAB 2011) (different meanings and commercial impressions

of PARK LANE versus PARK AVENUE sufficiently distinguished the marks and made likelihood of confusion unlikely, even though both marks shared the same first word and were both used in connection with footwear); In re Sears, Roebuck & Co., 2 U.S.P.Q.2d 1312, 1314 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear because of the different commercial impressions created by the marks, despite the fact that the marks are identical and the goods are related); Conde Nast Publ'ns, Inc. v. Miss Quality, Inc., 507 F.2d 1404, 1407 (C.C.P.A. 1975) (VOGUE and COUNTRY VOGUE convey different commercial impressions). In addition, considering the vast differences in the appearances, sounds and meanings of the marks, the overall commercial impressions of the marks are not similar.

Given the differences in Applicant's Mark and the Cited Mark, confusion is unlikely and Applicant's Mark should be allowed to proceed to publication.

II. Translation Inquiry

As stated above, the Applicant submits that the mark “HOJA” is the transliteration of the following Chinese characters “好呷” which, when taken together, mean “good.” Please see the Google Translate page for the Chinese characters “好呷” attached hereto as Exhibit A.

III. Conclusion

As discussed above, the Cited Mark is vastly different in appearance, sound, meaning, and overall commercial impression from Applicant’s Mark. Accordingly, Applicant respectfully requests that the Examining Attorney reconsider her refusal to register the Applicant’s Mark based upon likelihood of confusion with the Cited Mark and allow the Applicant’s Mark to proceed to publication. Further, Applicant’s Mark is the transliteration of the following Chinese characters “好呷” which, when taken together, mean “good.”

For all of the foregoing reasons, Applicant respectfully requests that the refusal to register be withdrawn and that the instant application be published for opposition.