


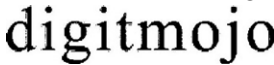
Serial No.: 88314323

Mark: MOJO (design)

Applicant: P. Gopaldas Limited

To be filed electronically

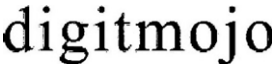


The Office has refused registration of the mark  on the grounds that the mark is likely to cause confusion with third party registrations for  and **MT. MOJO**. In this Response, Applicant submits that no likelihood of confusion exists with the cited registrations.

Likelihood of confusion with **DIGITMOJO (design)**, U.S. reg. no. 5505438

Applicant respectfully disagrees that there is a likelihood of consumer confusion between its mark,




, and , U.S. reg. no. 5505438.

First, Applicant's mark and the cited registration are not identical and there are a number of similar but non-identical marks registered and in use on the same or related goods and services. Attached as Exhibit A are copies of 5 other registrations and 1 use-based application for which a 2(d) refusal was not issued, along with evidence of use, for marks containing the term MOJO in conjunction with the same or related goods and services, as listed below. All are owned by different entities.

- **MOJO MAKEOVER** for, among other services, "Computerized on-line ordering services in the field of adult sexual aids, cosmetics, lingerie; Multi-level marketing business services; Shop-at-home parties featuring adult sexual aids, cosmetics, lingerie."
- **SEX E MOJO** for "On-line retail store services featuring body lotions, body oils and sexual stimulation aids."
- **SACRED MOJO** for "Body creams; Essential oils; Massage oils; Non-medicated skin care creams and lotions. Herbal male enhancement capsules; Herbal supplements; Herbal supplements for enhancing sexual arousal; Medical lubricant, namely, vaginal lubricants; Medicated massage oils; Medicinal herb extracts; Medicinal herbal preparations; Personal lubricants; Sexual stimulant gels; Topical preparations, namely, gels, sprays and creams for enhancing sexual arousal; Vitamin and mineral supplements."



-  for "Personal sexual lubricants; Sexual stimulant gels; Water-based personal lubricants; Gels for use as personal lubricant; Sexual stimulant sprays; Topical preparations, namely, sprays, gels and creams for enhancing sexual arousal; Pharmaceutical preparations for reducing sexual activity."



- for, among other services, “Educational services, namely, conducting trainings, lectures, speeches, classes, and seminars in the field of sex, and distribution of training materials in connection therewith.”
- **MT. MOJO** for “condoms.”

These preexisting marks show “that customers have become so conditioned by a plethora of such similar marks that customers ‘have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” (*Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1694 (Fed. Cir. 2005) (quoting Board opinion). Thus, it is unlikely that confusion will occur between the Applicant’s mark and the cited registration.

Second, the marks need to be assessed as to their dissimilarity in appearance, sound and connotation. Applicant’s mark is a two-syllable, dictionary word combined with distinctive design elements, being upper case, sans-serif letters within a shaded rectangular box. The cited mark is a four-syllable, fanciful word, created by joining together two ordinary words, with the dominant, first two syllables being “DIGIT,” which does not appear in Applicant’s mark. The cited mark also has different design elements, being lower case, serif letters. The marks therefore look and sound dissimilar. The marks also differ significantly in terms of connotation. Applicant’s mark, containing the ordinary dictionary word “mojo,” as noted by the Office, means “a magic charm, talisman, or spell, while Registrant’s mark is a fanciful word of no clear meaning, although the dominant part is “digit,” which means “finger,” “toe,” or a “symbol of a number system.” (See <https://www.dictionary.com/browse/digit?s=t> - attached as Exhibit B).

The marks share only one common feature – the lettering of MOJO. This is not sufficient to establish confusing similarity. A well-known treatise on the subject of trademark law provides numerous examples where a likelihood of confusion was not found despite the fact that the marks were similar in part, including cases where the marks shared common last words. (See e.g., FLIP and FINAL FLIP; JET and AEROB-A-JET, and VOGUE and COUNTRY VOGUES, J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (5th edition), vol. 4, § 23:57 (2019) (hereinafter “MCCARTHY”), copy attached as Exhibit C). Furthermore, it is the impression created by the mark as a whole, and not by its parts, which is important. (See *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399 (C.C.P.A. 1971); *Sun Banks of Florida, Inc. v. Sun Federal Savings and Loan Association*, 651 F.2d 311 (5th Cir. 1981); and *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622 (8th Cir. 1987)(“[I]n analyzing the similarities of sight, sound and meaning between two marks, a court must look to the overall impression created by the marks and not merely compare individual features.”)).

As detailed above, the marks are dissimilar in each of appearance, sound and connotation. It is therefore unlikely that confusion will occur.

Likelihood of confusion with **MT. MOJO**, U.S. reg. no. 5505438

Applicant respectfully disagrees that there is a likelihood of consumer confusion between its mark,



, and **MT. MOJO**, U.S. reg. no. 5471099.

First, Applicant's mark and the cited registration are not identical and there are a number of similar but non-identical marks registered and in use on the same or related goods and services. Attached as Exhibit D are copies of 5 other registrations and 1 use-based application for which a 2(d) refusal was not issued, along with evidence of use, for marks containing the term MOJO in conjunction with the same or related goods and services, as listed below. All are owned by different entities.

- **MOJO MAKEOVER** for, among other services, "Computerized on-line ordering services in the field of adult sexual aids, cosmetics, lingerie; Multi-level marketing business services; Shop-at-home parties featuring adult sexual aids, cosmetics, lingerie."
- **SEX E MOJO** for "On-line retail store services featuring body lotions, body oils and sexual stimulation aids."
- **SACRED MOJO** for "Body creams; Essential oils; Massage oils; Non-medicated skin care creams and lotions. Herbal male enhancement capsules; Herbal supplements; Herbal supplements for enhancing sexual arousal; Medical lubricant, namely, vaginal lubricants; Medicated massage oils; Medicinal herb extracts; Medicinal herbal preparations; Personal lubricants; Sexual stimulant gels; Topical preparations, namely, gels, sprays and creams for enhancing sexual arousal; Vitamin and mineral supplements."



- **MOJU MOJO** for "Personal sexual lubricants; Sexual stimulant gels; Water-based personal lubricants; Gels for use as personal lubricant; Sexual stimulant sprays; Topical preparations, namely, sprays, gels and creams for enhancing sexual arousal; Pharmaceutical preparations for reducing sexual activity."



- **MOJO MUSES** for, among other services, "Educational services, namely, conducting trainings, lectures, speeches, classes, and seminars in the field of sex, and distribution of training materials in connection therewith."
- **digitmojo** for, among other goods, "condoms; massage apparatus."

These preexisting marks show "that customers have become so conditioned by a plethora of such similar marks that customers 'have been educated to distinguish between different [such] marks on the bases of minute distinctions.'" (*Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1694 (Fed. Cir. 2005) (quoting Board opinion). Thus, it is unlikely that confusion will occur between the Applicant's mark and the cited registration.

Second, the marks need to be assessed as to their dissimilarity in appearance, sound and connotation. Applicant's mark is a two-syllable, dictionary word combined with distinctive design elements, being upper case, sans-serif letters within a shaded rectangular box. The cited mark is a three-syllable, two-word mark, with the dominant, first word being "MT.," which is the ubiquitous and universally understood abbreviation for "mountain." The marks therefore look and sound dissimilar. The marks also differ significantly in terms of connotation. Applicant's mark, containing the ordinary dictionary word "mojo," as noted by the Office, means "a magic charm, talisman, or spell, while Registrant's mark has clear connotation of being the name of a mountain. This connotation is enhanced by there being, in fact, a

“Mount Mojo” (See attached Exhibit E - Google Maps web page showing such mountain <https://www.google.com/maps/place/Mount+Mojo/@37.9067581,15.043745,16z/data=!4m5!3m4!1s0x13141d93112886f5:0x6bcea18daa3625ea!8m2!3d37.9085!4d15.0479>).

The marks share only one common feature – the lettering of MOJO. This is not sufficient to establish confusing similarity. A well-known treatise on the subject of trademark law provides numerous examples where a likelihood of confusion was not found despite the fact that the marks were similar in part, including cases where the marks shared common last words. (See e.g., FLIP and FINAL FLIP; JET and AEROB-A-JET, and VOGUE and COUNTRY VOGUES, MCCARTHY vol. 4, § 23:57, copy attached as Exhibit C). Furthermore, it is the impression created by the mark as a whole, and not by its parts, which is important. (See Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399 (C.C.P.A. 1971); Sun Banks of Florida, Inc. v. Sun Federal Savings and Loan Association, 651 F.2d 311 (5th Cir. 1981); and General Mills, Inc. v. Kellogg Co., 824 F.2d 622 (8th Cir. 1987)(“[I]n analyzing the similarities of sight, sound and meaning between two marks, a court must look to the overall impression created by the marks and not merely compare individual features.”)).

As detailed above, the marks are dissimilar in each of appearance, sound and connotation. It is therefore unlikely that confusion will occur.

In conclusion, in light of the dissimilarity of the marks, and the ability of consumers to distinguish between marks containing MOJO, Applicant respectfully requests that the Office withdraw the Section 2(d) refusals and allow the application to proceed to publication.