Response to Office Action

MARK:	KUDOS
SERIAL NO.:	88495798
APPLICANT:	DELGADO, MIKE
FILING DATE:	July 01, 2019
INTERNATIONAL CLASS:	010
TO:	Megan Aurand Examining Attorney USPTO, Law Office 128

Applicant, DELGADO, MIKE ("Applicant") respectfully submits this Response to the Office Action issued on September 26, 2019 against Application Serial No. 88495798 for the KUDOS mark (for "*Back supports for medical purposes; Massage stones*" in Class 010) (the "Applicant's Mark").

The Examiner has refused registration on the ground that Applicant's Mark is likely to cause confusion with the following trademarks bearing Registration Nos. (collectively, the "Cited Marks"):

- 4004600 (KUDU in class 010) (the "'600 Mark"), and
- 5245574 (KOUDOU in class 010) (the "'574 Mark").

Applicant maintains that, for the reasons set forth below, this confusion is unlikely, and therefore the Cited Mark should not pose a bar to registration.

As each issue in the Office Action letter of September 26 has been addressed, Applicant respectfully requests that the KUDOS mark be granted registration.

I. Likelihood of Confusion Refusal

1. Likelihood of Confusion Standard

Likelihood of confusion is determined on a case-by-case basis, with application of the factors identified in *Application of E. I. DuPont DeNemours & Co*., 476 F.2d 1357 (C.C.P.A. 1973). The likelihood standard means that it must be probable that confusion as to source will result from the simultaneous registration of two marks; it is not sufficient that confusion is merely possible. Trademark law is "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." *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp*., 954 F.2d 713 (Fed. Cir. 1992), quoting *Witco Chemical Co. v. Whitfield Chemical Co*., 418 F.2d 1403 (C.C.P.A. 1969). As such, no per se rule exists that confusion is automatically likely between marks merely because they share similar wording. Moreover, registrations for identical marks (which Applicant's mark and Cited Mark are not) for closely related goods and services may coexist when the totality of the circumstances indicates there is no likelihood of confusion.

2. Applicant's Mark Is Visually and Aurally Dissimilar from The Cited Mark and The Marks Create Distinct Commercial Impressions In Their Respective Contexts

Applicant's Mark is dissimilar from the Cited Mark in appearance and overall commercial impression.

In determining likelihood of confusion, marks being compared should be considered in their entireties. *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005 (C.C.P.A. 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). It is improper to focus on a single portion of a mark and decide likelihood of confusion only upon that feature, ignoring all other elements of the mark. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974).

In determining the commercial impression created by a mark, the mark must be viewed in its entirety. *See Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974). Further, a mark that contains in part the whole of another mark will not be found to pose a likelihood of confusion where the marks differ in overall commercial impression. In *In re Hearst Corp.*, 25 U.S.P.Q. 2d 1238 (Fed. Cir. 1992), the court found that the Trademark Trial and Appeal Board had erred in holding that there was a likelihood of confusion between VARGAS and VARGA GIRL, both for use on calendars, stating that although "Vargas" and "Varga" were similar, "the marks must be considered in the way they are used and perceived … and all components thereof must be given appropriate weight." The court went on to say that "[b]y stressing the portion 'varga' and diminishing the portion 'girl', the Board inappropriately changed the mark." *In re Hearst Corp.* at 1239, *see also Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107 (C.C.P.A. 1972) (ALL CLEAR not likely to cause confusion with ALL, both for household cleaning products).

The Examining Attorney, in their letter of September 26, submits that Applicant's Mark, KUDOS, in standard characters, is over similar to the '600 Mark, KUDU, in standard characters, and the '574 Mark, KOUDOU, also in standard characters.

Respectfully, Applicant submits that this analysis overlooks the extent to which the variation in spelling, likely pronunciation, and meaning or lack thereof behind the marks alter the immediate commercial impression of the compared marks. Applicant's Mark consists of the word "KUDOS," a known term that is defined as "praise given for achievement" (*see* https://www.merriam-webster.com/dictionary/kudos). The '600 Mark consists of the word "KUDU," which is defined as a type of African antelope (*see* https://www.merriam-webster.com/dictionary/kudu). The '574 Mark consists of the word "KOUDOU," which is a variant of the word "koodoo," itself a "less common spelling of "kudu," defined above (see https://www.merriam-webster.com/dictionary/koudou, https://www.merriam-webster.com/dictionary/koodoo). Consumers without prior knowledge as to African antelopes would most likely perceive the KUDU and KOUDOU marks as invented words, whereas consumers are highly likely to recognize the Applicant's Mark as an existing and widely used word. Not only does this make Applicant's Mark more distinguishable than the Cited Marks, but the positive connotation of the word "KUDOS" itself will likely cause the consumers to have a positive impression of the mark, as compared to a neutral impression of the Cited Marks since no context is embedded in their meanings. This contributes to the difference in immediate commercial impression of the compared marks.

In combination, respectfully these differences between the marks result in distinct commercial impressions, making confusion between them unlikely.

3. Applicant's Goods and the Cited Mark's Goods Are Sufficiently Unrelated To Render Consumer Confusion Unlikely

In assessing the relatedness of the goods and/or services, the more similar the marks at issue, the less similar the goods or services need to be to support a finding of likelihood of confusion. *In re Shell Oil Co*., 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A*., 100 USPQ2d 1584, 1597 (TTAB 2011) ; *In re Iolo Techs., LLC,* 95 USPQ2d 1498, 1499 (TTAB 2010); *In re Opus One Inc*., 60 USPQ2d 1812, 1815 (TTAB 2001). If the marks of the respective parties are identical or virtually identical, the relationship between the goods and/or services need not be as close to support a finding of likelihood of confusion as would be required if there were differences between the marks. *Shell Oil*, 992 F.2d at 1207, 26 USPQ2d at 1689; *In re Davey Prods. Pty Ltd*., 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Thor Tech, Inc*., 90 USPQ2d 1634, 1636 (TTAB 2009). TMEP 1207.01(a).

Applicant's goods are "*Back supports for medical purpose; massage stones*" in Class 10.

The '600 Mark's goods are "*Equipment and accessories for disabled persons, namely, adapted chair seats, standing frames, adapted toilet chairs and parts thereof*" in Class 10.

The '574 Mark's goods are "*massage apparatus*" in class 10.

Although Applicant's and the '600 Mark Registrant's goods overlap in that they both fall under the category of supportive accessories, there is in reality very little that Applicant's goods and Registrant's goods have in common. Registrant in this case uses the '600 Mark for a singular product, namely a wheelchair for disabled children.[1] Moreover, the design on the wheels of Registrant's product has the likeness of the Kudu animal itself, further obviating confusion. Applicant's goods, on the other hand, consist of back supports and massage stones. A consumer seeking a wheelchair for a disabled child would not be confused upon coming across a back support without a wheelchair or massage stones, and vice versa.

While goods represented by the '574 Mark and Applicant's Mark fall under the broad categories of massage equipment, they are unlikely to be confused as massage stones are a very specific subset of massage equipment. A search for "massage apparatus" on Amazon leads to numerous results for electronic devices used to physically massage the body.[2] A search for "massage stone" immediately populates results of stones used for hot stone massages.[3] Indeed, a hot stone massage is a specific type of massage, and the stones, rather than being used as a general "massage apparatus" would be used to physically massage the body, are heated and placed on points of the body (*see* https://www.medicalnewstoday.com/articles/317675.php#What-is-hot-stone-massage-therapy). Additionally, the '574 Registrant's goods include several other categories of items, including health monitoring devices, ear plugs, bandages, and other medical devices. Massage stones are not likely to cause confusion for a consumer seeking these items from Registrant.

Thus, a consumer seeking a massage apparatus would not be confused when coming across Applicant's massage stones, and vice versa.

Further, given the significantly more meaningful distinctions between the Cited Marks, described above, the Office must show a proportionally higher degree of relatedness to support a finding that the

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[1] http://www.r82.co.uk/kudu/; http://www.r82.co.uk/media/297167/kudu_flyer_final.pdf
[2] https://www.amazon.com/s?k=massage+apparatus&ref=nb_sb_noss_2
[3] https://www.amazon.com/s?k=massage+stones&ref=nb_sb_noss_1

marks would overall be confused in the marketplace.

Applicant respectfully maintains that in light of the forgoing arguments these goods are not sufficiently related to warrant the finding of 2(d) confusion.

4. The Channels of Trade and Conditions Under Which Sales Are Made Render Consumer Confusion Unlikely

Conditions under which purchases of a particular kind of good or service are made are to be considered in determining likelihood of confusion. TMEP § 1207.01, citing *In re E.I. DuPont de Nemours & Co*., at 1360-62. *See also Jet, Inc. v. Sewage Aeration Systems*, 165 F.3d 419, 423, 43 Fed. R. Serv. 3d 231, 1999 FED App. 0003P (6th Cir. 1999) (citing *Homeowners Group, Inc. v. Home Marketing Specialists, Inc*., 931 F.2d 1100, 1111 (6th Cir. 1991)); *See also, In re American Olean Tile Company Inc*., 1 U.S.P.Q.2d 1823, 1986 WL 83338 (T.T.A.B. 1986) (no confusion between MILANO for ceramic tile sold to trade and MILANO for wooden doors sold to the public); *In re Shipp*, 4 U.S.P.Q.2d 1174, 1987 WL 123841 (T.T.A.B. 1987) (PURITAN for professional dry cleaning machine filters not likely to cause confusion with PURITAN for dry cleaning services sold to public). Additionally, where goods or services move in different channels of trade, confusion as to source is unlikely. *See Electronic Design & Sales, Inc. v. Electronic Data Systems Corp*., 21 U.S.P.Q. 2d 1388 (Fed. Cir. 1992) (no likelihood of confusion between opposer's mark E.D.S. for computer services and applicant's mark EDS for power supplies and battery charges where the respective goods and services were sold to different purchasers within similar markets).

Applicant’s Mark and the Cited Marks are unlikely to be confused for the reasons set forth above, and because the associated goods travel through different channels of trade. Applicant’s target market consists of people with back problems and may benefit from supportive accessories and hot stone massage. The ‘600 Registrant’s target market is children with disabilities rendering them in need of a wheelchair. The ‘574 Registrant’s target market, while less clear, appears to be those who wish to utilize massage equipment on themselves and those who are seeking medical equipment. This indicates that consumers will not be confused by Applicant’s Mark and the Cited Marks, as the two entities will not cross channels.

Therefore, the channels of trade and the conditions under which the respective products are sold are distinct, and the 2(d) refusal should be withdrawn.

II. Conclusion

Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant’s Mark and approve the Application for publication. If a telephone call will assist in the prosecution of this Application, the Examining Attorney is invited to call 917-933-3895.

Respectfully submitted,

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