

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE SPI WEST PORT, INC.

Serial No.: 88486680

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Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

RESPONSE TO OFFICE ACTION

Applicant respectfully submits that there is no likelihood of confusion between the applied-for mark, JÈN, and the cited Application Serial No. 88355778. Applicant's mark and the cited mark are dissimilar in their commercial impressions and overall appearance, and the goods/services provided under the marks and their trade channels are sufficiently unrelated and distinct. Applicant accordingly requests that the Examining Attorney withdraw the potential refusal and approve the mark for publication.

ARGUMENT

There is no mechanical test for determining likelihood of confusion. Instead, each case must be decided upon its own facts. TMEP § 1207.01. In determining likelihood of confusion, the threshold inquiry is "not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the goods they identify emanate from the same source." *Paula Payne Prods. Co. v. Johnson's Pub'g Co., Inc.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (CCPA 1973). The principal factors for determining whether a likelihood of confusion exists

between marks are set out in *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The court there recognized that likelihood of confusion should be determined based “upon consideration of *all* the evidence,” *Du Pont*, 476 F.2d at 1361-62, but not all factors need to be considered or given the same weight when making a decision. *In re Dixie Restaurants*, 105 F.3d 1405, 1406, 41 U.S.P.Q.2d 1531, 1533 (Fed. Cir. 1997).

Here the relevant factors to determining likelihood of confusion are dissimilarity of the marks in their commercial impressions and overall appearance, lack of relatedness of the goods/services provided under the marks, dissimilarity of trade channels, and the sophistication of the purchaser. Each of these factors weighs against likelihood of confusion, and Applicant accordingly submits that the refusal for confusion should be withdrawn.

A. Applicant’s mark and the cited mark are dissimilar in overall commercial impression

Use of identical, even dominant, words, does not automatically mean the marks are similar enough to cause confusion. *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012) (quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 U.S.P.Q.2d 1901, 1905 (T.T.A.B. 2007)). Even when marks are identical or nearly identical, differences in connotation can outweigh visual and phonetic similarity. *Coach Services, Inc.*, 668 F.3d at 1368. Determining whether there is a likelihood of confusion between marks requires careful consideration of the overall commercial impression created by each mark. TMEP § 1207.01(b)(iii).

There is no likelihood of confusion here based on the difference in commercial impression created by the Applicant's mark and the cited mark. Likelihood of confusion is avoided between otherwise confusingly similar marks when the marks in their entireties convey significantly different commercial impressions. *See, e.g.*, TMEP § 1207.01(b)(iii); *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with "CATFISH" disclaimed) for fish held not likely to be confused with BOBBER for restaurant services). "Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion." TMEP § 1207.01(b)(v). *See also In re Sears, Roebuck & Co.*, 2 U.S.P.Q.2d 1312, 1314 (T.T.A.B. 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies' sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant's bras, whereas "CROSSOVER," as applied to registrant's goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear . . . or the line between two seasons"); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854, 856 (T.T.A.B. 1984) (holding PLAYERS for men's underwear and PLAYERS for shoes not likely to cause confusion, agreeing with applicant's argument that the term "PLAYERS" implies a fit, style, color, and durability suitable for outdoor activities when applied to shoes, but "implies something else, primarily indoors in nature" when applied to men's underwear); *In re Sydel Lingerie Co.*, 197 U.S.P.Q. 629, 630 (T.T.A.B. 1977) (holding BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's clothing not likely to cause confusion,

noting that the wording connotes the drinking phrase “Drink Up” when applied to men’s clothing, but does not have this connotation when applied to ladies’ and children’s underwear).

The impression that a mark is likely to project upon consumers should be determined not only from the sight, sound, and meaning of the mark itself, but also from the context in which the mark is used. *In re Nationwide Industries, Inc.*, 6 USPQ2d 1882, 1884 (TTAB 1988). Again, “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012) (quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 U.S.P.Q.2d 1901, 1905 (T.T.A.B. 2007)). *See e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with “CATFISH” disclaimed) for fish held not likely to be confused with BOBBER for restaurant services). Courts must “make their comparison ‘in light of what happens in the marketplace, not merely by looking at the two marks side-by-side.’” *See Essentia Health v. Gundersen Lutheran Health Sys.*, No. 17-cv-100-wmc, 2017 U.S. Dist. LEXIS 53539, at *10 (W.D. Wis. Apr. 7, 2017) (finding two design marks “ESSENITIA HEALTH HERE WITH YOU” and “ESSENTIAL HEALTH CLINIC” not confusingly similar as “the two, full trademarks reveals several differences: font, the use of all caps in the Essential Health Clinic mark, varying designs to the left of the written words with the use of different colors, and the addition of the “Here with you” tag line in the Essentia mark.”).

Notwithstanding any similarity in appearance and sound, the meaning and impression of the Applicant's mark as compared with the cited mark are so dissimilar as to outweigh any similarities in appearance and sound.

Here, the Applicant's mark conveys a significantly different commercial impression than the registered mark. Applicant's mark, JÈN, when used in relation to the goods under the mark as amended,¹ creates a commercial impression of energetic, youthful, and refreshing drinks offered under the mark. As used by Applicant, "JÈN" is suggestive of the French word "jeune" meaning "young." *See Evidence.* Given the meaning implicated by the mark, Applicant's use of the term "JÈN" in connection with its "Soft drinks; Non-carbonated, non-alcoholic, ready-to-drink beverages, namely, beverages containing aloe juice" suggests a healthy ready-to-drink beverage. The fact that Applicant offers "soft drinks...namely, beverages containing aloe juice" confirms the healthy, youthful impression of the mark as aloe vera products are known for their anti-aging, skin, and digestive benefits. *See Evidence.*

Applicant's mark creates a wholly disparate commercial impression from the that conveyed by the cited mark. The cited mark JEN, when used in relation to its offered services including "retail store services featuring...food and beverages" creates no impression of youth. In fact the cited mark's "retail store services" combined with the other broad range of services offered under the cited mark in International Classes 035, 041, 043 and 044, including hotels, motels, spa, exhibitions, conferences, etc., could only show use of the word JEN is not suggestive of anything similar to the connotation created by the Applicant's mark. "JEN" can in fact be used to refer to a Confucian concept of benevolence to fellow people. *See Evidence.*

¹ Soft drinks; Non-carbonated, non-alcoholic, ready-to-drink beverages, namely, beverages containing aloe juice.

Given the apparent use of the mark by Hong Kong based mark owner Shangri-La International Hotel Management Limited in relation to hotels in Asia, consumers are thus likely to receive the impression of hotel and retail services based in the virtue of benevolence. The cited mark owner, using the mark with retail services, thus impresses essentially strong and kind service.

Accordingly, the cited mark, considering the mark in its entirety and its context of use, conveys a wholly different commercial impression. Therefore, comparing the marks as “applied to the respective parties’ goods or services,” there is no likelihood of confusion. *See* TMEP § 1207.01(b)(v). *See also In re Sears, Roebuck & Co.*, 2 U.S.P.Q.2d 1312, 1314 (T.T.A.B. 1987).

B. Applicant’s mark and the cited mark differ appearance

“The use of identical, even dominant, words in common does not automatically mean that two marks are similar . . . rather, in 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.” *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442, 1445 (8th Cir. 1987). Even “close similarity between two marks is not dispositive of the issue of likelihood of confusion.” *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1133, 202 USPQ 81, 89 (2d Cir. 1979). Rather, the slightest variation can distinguish marks and avoid a likelihood of confusion. *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 927, 198 USPQ 151 (CCPA 1978).

Even though Applicant acknowledges both marks use a common term of “JEN,” the similarity ends there as important visual aspects between the marks that differ. The parties’ marks appear as follows:

Applicant's Mark	Cited Mark
JÈN	JĚN

“Confusion can be prevented by merely requiring defendant to use the contested mark in a different type style and format.” 4 *McCarthy on Trademarks and Unfair Competition* § 23:52 (5th ed.) Further, “A standard character registration does not override the requirement that likelihood of confusion be measured by the perceptions of consumers in the marketplace.” *Hornady Mfg. Co., Inc. v. Doubletap, Inc.*, 746 F.3d 995, 1002 n.2, 110 U.S.P.Q.2d 1140 (10th Cir. 2014). Here, the differing accents of the marks set the marks apart when viewed by consumers. Applicant’s accent is a grave accent, slanting from upper left to bottom right above the “E.” *See Evidence*. This indicates that consumers should focus upon this portion of the mark, and further indicates the mark is to be pronounced with a schwa sound as “juhn.” The cited mark features an accent over the letter “J,” imparting a separate focus on the cited mark compared to Applicant’s mark and indicating the mark should, if anything, be pronounced (differently from Applicant’s mark) with a hard J sound. *See Evidence*. In virtually any language, placement of an accent in a word has the effect of creating a different word. It is highly unlikely that a brand owner would place an accent on differing parts of its mark in different contexts. Consumers viewing the parties’ marks in the marketplace will thus understand the marks are wholly separate and will not be confused precisely because they will see the accents in the marks in different places.

C. The goods/services under the marks are sufficiently unrelated to avoid confusion

Marks used for similar goods or services are not rendered confusingly similar simply because they share similar wording. *In re Bed & Breakfast Registry*, 791 F.2d at 159, (holding that BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL are not confusingly similar since “REGISTRY” and “INTERNATIONAL” have clearly different meanings).

If the goods are either not related or not marketed in a way that a person encountering them might be under the impression they came from the same source, even if the marks are identical they will not be likely to be confused. TMEP § 1207.01(a)(i); *See, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 U.S.P.Q.2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB’s holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 U.S.P.Q.2d 1156, 1158 (T.T.A.B. 1990) (finding liquid drain opener and advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 U.S.P.Q.2d 1668, 1689 (T.T.A.B. 1986) (finding that using the mark QR for coaxial cable and the mark QR in connection with photocopying and drafting machines was not likely to cause confusion because of the goods’ nature and purpose). When two marks are used for the same mode of media/product, the genres or type of media can make a distinctive difference. *M2 Software Inc. v. Madacy Entm’t*, 421 F.3d 1073, 1082 (9th Cir. 2005).

There is no *per se* rule that states what goods are related to each other, so the evidence must be evaluated as it pertains specifically to the Applicant’s goods and the cited registration.

TMEP § 1207.01(a)(iv); *In re White Rock Distilleries Inc.*, 92 U.S.P.Q.2d 1282, 1285 (T.T.A.B. 2009). It is commonly recognized that alcoholic drinks, for instance, can be categorized according to the type of alcohol and may be considered dissimilar goods. *See e.g., G.H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292, 16 U.S.P.Q.2d 1635 (Fed. Cir. 1990) (differences between beer and sparkling wine “weigh against a holding of a likelihood of confusion”). Further, the Board recognizes that not all computer products and software are similar or related. *See e.g., Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164, 1168-69 (T.T.A.B. 2001). The Board explains that “a *per se* rule relating to source confusion vis-à-vis computer hardware and software is simply too rigid and restrictive an approach and fails to consider the realities of the marketplace.” *In re Quadram Corp.*, 228 U.S.P.Q. 863, 865 (T.T.A.B. 1985).

There is further no *per se* rule that food and beverage products and restaurant or retail services featuring food and beverages are related. “Something more” than a mere conflict between a use on food and a use on restaurant services is needed, such as use on a food product of the type likely to be marketed by a restaurant. *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 1236, 212 U.S.P.Q. 641 (C.C.P.A. 1982) (“To establish likelihood of confusion a party must show something more than that similar or even identical marks are used for food products and for restaurant services.”). In *In re Coors Brewing Co.*, 343 F.3d 1340, 68 U.S.P.Q.2d 1059 (Fed. Cir. 2003), the Federal Circuit declined to hold that the relevant beer products and restaurant services were related – the court found that the required “something more” was missing because the evidence indicated that it was quite uncommon for a restaurant and a beer to share the same trademark. Similarly here, it is quite uncommon that a retail store featuring food and beverage would carry the same name as a particular soft drink containing aloe vera juice. It is virtually inconceivable that such a niche beverage product – an aloe vera drink –

would be featured prominently as a name for an entire retail food and beverage store. Thus, the goods/services at issue here are not sufficiently related. There is not “something more” to indicate that consumers would be confused when encountering the parties’ goods/services in marketplace.

D. Consumers are sophisticated enough to avoid confusion.

Consumers of goods marketed under Applicant’s mark and services under the cited mark are likely to exercise a high degree of care, thus avoiding confusion. First, there are abundance of various foods and drinks offered in supermarkets, cafes, hotels, motels, events, etc. Second, normally cited mark consumers initially base their decision on their accommodation choices and food and drink services only follow their initial choice, and thus the degree of their attention is more shifted towards the “accommodation” brand. Third, besides different tastes, people could have allergies or special needs when it comes to their food and drink consumption.

People choose their foods and drinks carefully. Consumers for Applicant’s listed goods are normally aware of aloe vera’s certain health benefits (Alkalinity, hydration, skin care, nutritious boost, etc.) *See Evidence*. In fact, they would normally base their decision on these benefits offered by Applicant’s goods. Conversely, the cited mark consumers are more focused on the main services offered including hospitality and accommodation, and the foods and drinks are just secondary to their initial decision. Cited mark consumers/guests however employ a great degree of care in choosing their accommodation as they are will spend their time in the accommodation, they leave their belongings there, they sleep there, and lastly they commute from there. Further, consumers of both marks should be alert about their food and drink diets and allergies. Thus, they have to employ a high degree in ordering or buying their drinks. For

example, if consumers are allergic to aloe vera products, they will never consume Applicant's goods.

Thus, Applicant respectfully submits that considering the huge range of accommodation and drink related goods and services offered to customers, any potential customer requires some degree of sophistication to purchase/pick the proper choice and therefore confusion is not likely.

CONCLUSION

For the foregoing reasons, Applicant respectfully submits that there is no likelihood of confusion between its mark and the cited Mark, and requests that the Examiner withdraw the potential refusal for confusion.