

SOLEI (AND DESIGN)



Classes 3, 5, 29, 30, 31, 32, and 34

Application No. 88/425564

Office Action Response

I. Amendment of Listed Goods

The Examiner requested amendment to the listed goods in within the Application. In response, Applicant has amended the goods recited in the Application, as set out herein.

Classes 3

Bath additives, namely, bath herbs, bath oils, bath oils for cosmetic purposes; beauty care cosmetics; beauty creams for body care; beauty gels; beauty lotions; body and beauty care cosmetics; body creams; body oils; cosmetic creams; cosmetic oils; cosmetics and make-up; face and body lotions; face and body milk; face lotion; hair care preparations; hair styling preparations; hand cream; hand lotions; non-medicated lip care preparations; lip conditioners; lip glosses; non-medicated liquid soaps; massage creams; massage oils; non-medicated bubble bath preparations; non-medicated preparations for the care of hair; non-medicated preparations for the care of skin; non-medicated preparations for the care of the scalp; non-medicated skin care preparations; oils for toiletry purposes; skin care preparations; skin creams; skin emollients; skin lotions; skin soap; soaps for body care, namely cream soaps, bath soaps, bar soaps, paper soaps; soaps for personal use namely, cream soaps, bath soaps, bar soaps, paper soaps; each of the foregoing containing permissible delta-9 THC concentrations as set forth in applicable federal legislation of the United States

Class 5

Hemp cannabidiol derived products, namely, oils, salves, concentrated pastes, topical tinctures; oils, salves, concentrated pastes, topical tinctures, each containing resins and oils derived from hemp or derivatives thereof and for medical use; topical skin creams, bar and liquid soaps, bath additives in the nature of bath melts, bath herbs, and bath oils; body creams, body oils, face and body lotions, face and body milk, face lotion, and skin care preparations for the relief of pain, for relaxation, for reducing stress and fatigue, for mood enhancement, for maintaining general health and well-being, for relieving anxiety, for relieving depression, and as a sleep aid; personal sexual lubricants; transdermal patches for the relief of pain, for relaxation, for reducing stress and fatigue, for mood enhancement, for maintaining general health and well-being, for relieving anxiety, for relieving depression, as a sleep aid and for management of opioid addiction and relief of epilepsy; hemp cannabidiol or derivatives thereof for topical medicinal use; hemp cannabidiol derived product, namely, oils for topical medicinal use for the relief of pain, for relaxation, for reducing stress and fatigue, for mood enhancement, for maintaining general health and well-being, for relieving anxiety, for relieving depression, as a sleep aid and for management of opioid addiction and relief of epilepsy; oils derived from hemp for topical medicinal use for the relief of pain, for relaxation, for reducing

stress and fatigue, for mood enhancement, for maintaining general health and well-being, for relieving anxiety, for relieving depression, as a sleep aid and for management of opioid addiction and relief of epilepsy; each of the foregoing containing permissible delta-9 THC concentrations as set forth in applicable federal legislation of the United States

Class 29

Oils and resins derived from hemp for use as comestibles; hemp or cannabidiol related product, namely, oils for use as comestibles; oils derived from hemp or cannabidiol for use as comestibles; food products containing hemp, cannabidiol, resins and cannabidiol oils, namely, butter; each of the foregoing containing permissible delta-9 THC concentrations as set forth in applicable federal legislation of the United States

Class 30

Food products containing hemp, cannabidiol or derivatives thereof, namely, chocolates, cookies, brownies, candy and food energy bars; tea, namely, teas containing hemp, cannabidiol or derivatives thereof, and teas containing hemp, cannabidiol or derivatives thereof; each of the foregoing containing permissible delta-9 THC concentrations as set forth in applicable federal legislation of the United States

Class 31

Live hemp plants; hemp seeds; each of the foregoing containing permissible delta-9 THC concentrations as set forth in applicable federal legislation of the United States

Class 32

Smoothies, fruit beverages and fruit juices, carbonated soft drinks, and energy drinks each containing hemp, cannabidiol or derivatives thereof; each of the foregoing containing permissible delta-9 THC concentrations as set forth in applicable federal legislation of the United States

Class 34

Smokers' articles, namely, grinders for use with hemp; dried hemp; derivatives of hemp, namely, resins and oils, not for medical use; hemp cannabidiol and hemp for recreational use; smokers' articles, namely, smoking pipes, pouches for use with hemp, lighters for smokers, oral vaporizers for smokers, each of the foregoing for use with articles containing permissible delta-9 THC concentrations as set forth in applicable federal legislation of the United States

II. Controlled Substances Act / Cannabis Related Goods Refusal

The Examiner has refused registration on the basis that the Applicant cannot have a bona fide intent to lawfully use the applied-for mark in commerce with respect to the listed goods. Applicant respectfully asserts that this basis for refusal is moot in light of the amended recitations of goods adopted herein.

III. FDCA Refusal

The Examiner alleges that the Applicant does not have a bona fide intent to lawfully use the applied-for mark in commerce with relation to the goods identified in Classes 5, 29, 30 and 32 because pursuant to the FDCA it is unlawful to introduce food or beverages containing added CBD into interstate commerce or to market CBD as, or in, dietary and nutritional supplements, regardless of whether the substances are hemp-derived. However, applicant notes that it has a bona fide intent to lawfully use the applied-for mark in commerce because it is authorized to import products containing CBD into the United States in furtherance of one or more FDA-approved clinical trials.

IV. Drug Paraphernalia Refusal

The Examiner has refused registration for certain goods in Class 34 because Applicant allegedly does not have a bona fide intent to lawfully use the applied-for mark in commerce. However, Applicant respectfully asserts that this basis for refusal is moot in light of the amended recitations of goods adopted herein.

V. English Translation Inquiry

Applicant hereby notes that “SOLEI” has no meaning in a foreign language.

VI. Likelihood of Confusion Refusal

The Examiner has refused Applicant’s Mark for use in connection with goods in Classes 3, 5, and 30. Specifically, the Examiner has refused Applicant’s Mark based on a likelihood of confusion with three registrations (collectively, the “Cited Marks”), as depicted below:

Reference	Cited Mark	Owner	Cited Goods/Services
Cited Mark #1	 SOLEI (Reg. No. 4834781)	4E GLOBAL S.A.P.I. DE C.V.	Class 3: Liquid soaps
Cited Mark #2	SOLEIL (Reg. No. 5005017)	RED WEDDING, LLC	Class 5: Nutritional and dietary supplements formed and packaged as bars; Nutritional supplement meal replacement bars for boosting energy
Cited Mark #3	SOLEIL (Reg. No. 5129153)	RED WEDDING, LLC	Class 29: Fruit-based organic food bars, also containing nuts, seeds, and vegetables; Nut-based food bars

For the reasons discussed herein, Applicant asserts that there is no likelihood of confusion and requests that the Application proceed to publication.

A. The Cited Mark Are Dissimilar Such That There Is No Likelihood Of Confusion

When considering the similarity of the marks, all relevant facts pertaining to the appearance, sound, meaning, goods and services at issue, and overall commercial impression must be considered. TMEP § 1207.01. *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000). In evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of the marks. *Id. See Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106, 108 (T.T.A.B. 1975). Furthermore, under the anti-dissection rule, the validity and distinctiveness of a composite trademark is determined by viewing the trademark as a whole, as it appears in the marketplace. *Official Airline Guides, Inc. v. Goss*, 6 F.3d at 1392; *California Cooler, Inc. v. Loretto Winery Ltd.*, 774 F.2d 1451, 1455 (9th Cir.1985). *See also 2 J.T. McCarthy, McCarthy on Trademarks and Unfair Competition*, Sec. 23.15[a], at 23-82, 83.

i. Appearance and Sound

Applicant notes that the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services, *see Zheng Cai v. Diamond Hong, Inc.*, ___ F.3d ___, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018). The marks at issue are the following:

Applicant's Mark	Cited Mark #1	Cited Marks #2 and #3
		SOLEIL

Significantly, Applicant's Mark contains highly distinctive elements consisting of a highly stylized cursive-like font on top of a circular shaded background that is shaded densely in the middle of circle and varies in density in the outer parts of the circle. Cited Mark #1 also contains a highly distinctive visual element consisting of a shaded circle with a lighter colored border with a shiny appearance. The literal element is also depicted in a stylized font in a light block letters which, when superimposed on the two concentric circles, creates a distinct visual appearance. The Applicant's Mark creates a distinctive impression that distinguishes itself from Cited Mark #1, due to the contrast in styles. Applicant's Mark contains a highly stylized curvise font that creates a softer look, whereas Cited Mark #1 utilizes stylized thick block lettering. In addition, Applicant's Mark consists of a circle that is uniquely shaded and varies in density and when the stylized font is layered on top of the shading, Applicant's Mark appears flat and has a softer appearance. On the other hand, Cited Mark #1 has a circle with hard borders that do not vary in shading like the Applicant's. Furthermore, the light colored stylized block lettering, when superimposed on the two circles, pops the lettering out in a way that creates a more three dimensional image. Cited Mark #1 has a harder appearance due to its use of block lettering with edges and hard borders on the circles, which creates a different look than Applicant's softened and curvy font laid flat on a softly shaded circle. As such, all of these differentiating elements create clear differences with respect to appearance of the marks. Thus, the marks at issue are sufficiently different in appearance and are not likely to be confused with one another.

In regard to Cited Marks #2 and #3, Applicant's Mark contains a highly distinctive elements, whereas Cited Marks #2 and #3 are in standard characters. Applicant also notes that while Applicant's mark shares the first five letters in common with the Cited Marks, the Cited Marks differ in spelling as it contains an L. As such, all of these differentiating elements create clear differences with respect to appearance of the marks. Thus, the marks at issue are sufficiently different in appearance and are not likely to be confused with one another.

ii. Overall Commerical Impression

Moreover, the touchstone of a likelihood of confusion determination is the impression created by the proposed mark upon the general purchasing public when buying under normal market conditions and exercising the usual amount of care associated with a purchase within the class of goods or services. *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 202 U.S.P.Q. 81, 92 (2d Cir. 1979). The essential determination is whether the ordinary consumer is likely to conclude that an applicant's product or service and the goods or services sold under a registered mark come from the same source. *Am. Optical Corp. v. Siemens Aktiengesellschaft*, 213 U.S.P.Q. 510, 516 (TTAB 1982); *In re Whittaker Corp.*, 200 U.S.P.Q. 54, 55 (TTAB 1978).

The mere possibility of confusion is not enough to justify a refusal to register Applicant's Mark. In a Section 2(d) determination, the concern is not "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." *Witco Chem Cp. v. Whitfield Chem. Co.*, 164 U.S.P.Q. 43, 44-45 (CCPA 1969); *see also GAF Corp. v. Tappan Co.*, 197 U.S.P.Q. 696, 701 (TTAB 1977). Therefore, the Lanham Act precludes registration of a mark only where confusion as to source or origin is likely, not where merely a possibility of such confusion exists. *In re Hughes Aircraft*, 222 U.S.P.Q. 263, 264 (TTAB 1984).

Even marks that are identical in sound 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. *In re Sydel Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (holding the mark BOTTOMS UP for ladies' and children's underwear and the mark BOTTOMS UP for men's clothing were not likely to cause confusion, noting that the term "Bottoms Up" connotes the drinking phrase "Drink Up" when applied to men's clothing, but does not have the same connotation when applied to ladies' and children's underwear). Here, the marks at issue in their entireties are visually different and convey significantly different commercial impressions.

It is well settled that "[a]dditions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted." TMEP § 1207.01(b)(iii).

Notably, Applicant's Mark consists of both a distinctive shaded circle and a highly stylized font that, when viewed together, creates a distinctive appearance that overall creates a flat and softened look. By contrast, Cited Mark #1 contains block lettering with hard edges and circles with clear borders, which has a distinct hardened impression that directly contrasts with Applicant's Mark. Similarly, the lack of stylized elements in Cited Marks #2 and #3 creates different commercial impressions when compared to the highly stylized elements in Applicant's Mark. Thus, the overall commercial impressions created are significantly different from each other, such that confusion among the relevant consumers is not likely.

In light of the above, the amendments to Applicant's goods, and because Applicant's Mark and Cited Mark differ in overall meaning and commercial impression, Applicant respectfully requests that the Examiner withdraw the likelihood of confusion refusal.

VII. Prior-Filed Application Advisory

Applicant elects not to submit arguments in connection with the prior pending application identified by the Examiner at this time but reserves the right to file arguments if the prior pending application matures into a registration and a likelihood of confusion refusal is issued.

For all of the foregoing reasons, Applicant respectfully requests that the Examiner withdraw the refusal and allow the application to proceed.