

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

hello

Mark:

Serial No.: 88657943

Our Ref: HLLO 1902610

RESPONSE TO OFFICE ACTION

This is in response to the non-final Office action issued on February 3, 2020. The Office action (i) refused registration to Applicant’s mark HELLO (Stylized) in Class 44 only, because of a purported likelihood of confusion with the marks HOLA DENTAL for “Dental services; oral surgery and dental implant services; Orthodontic services; Teeth whitening services” in



Class 44 and

for “Orthodontic services” in Class 44 (the “Cited Marks”) and

(ii) required amendments to the identification of goods in Class 3. Applicant respectfully disagrees with the contention that there is a likelihood of confusion with the Cited Marks in Class 44, and submits an amendment to the identification of goods in Class 3 with this Response.

ARGUMENT

I. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT’S MARK AND THE CITED MARKS IN CLASS 44

Applicant’s mark and the Cited Marks are different in sound, appearance, and meaning. The Office action’s singular basis for finding any similarity amongst the Cited Marks and Applicant’s mark is the shared term HELLO or a term that translates to the English word “hello.”

With respect to the HELLO ORTHO NAPA and Design registration, the Office action states that both marks share the identical first term HELLO and consumers are generally more inclined to focus on the first word. However, the Federal Circuit has cautioned that there is no general rule that the letter portion of the mark will form the dominant portion of the mark, and it is also well-settled that no single feature of a mark can be ignored. *In re Electrolyte Labs., Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990) (citing *In re Burndy Corp.*, 300 F.2d 938, 940 (C.C.P.A. 1962) (holding that two composite marks, K+ and K+ EFF, are not likely to cause consumer confusion and stating that the T.T.A.B. erred in its dominant focus on “K+” in both marks, particularly in light of the design component of the applicant’s composite mark)). In its comparison of Applicant’s mark and the HELLO ORTHO NAPA and Design mark, the Office action dismisses the term ORTHO because it is disclaimed, and entirely disregards the term NAPA, which, while disclaimed, nonetheless contributes to the overall commercial impression of the mark. The Office action does not even acknowledge the prominent, distinctive, and distinguishing design features in the HELLO ORTHO NAPA and Design mark. In addition to the stark visual differences between this registration and Applicant’s mark, the marks also sound different, given the two additional terms used in this registration.

In improperly dissecting the HELLO ORTHO NAPA and Design mark, to leave only the term HELLO, the Office action concludes that “that marks are identical in part,” and thus, “are confusingly similar.” The Office action’s analysis fails to consider the multiple distinguishing features in the HELLO ORTHO NAPA and Design mark, including the prominent design element, relying solely on the term HELLO in both marks. The Office action also ignores the unique stylization of Applicant’s mark. “It has been held to be a violation of the anti-dissection rule to focus upon the ‘prominent’ feature of a mark and decide likely confusion solely upon that

feature, ignoring all other elements of the mark.” *Little Caesar Enters., Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 571 (6th Cir. 1987) (quoting McCarthy §23:41). Overall, the marks are aurally and visually dissimilar and are not likely to cause confusion. *See Rite Aid Corp. v. Rite-Way Disc. Corp.*, 508 F.2d 828, 829 (C.C.P.A. 1975) (holding that RITE WAY and DESIGN is not confusingly similar to RITE AID or RITE AID and DESIGN and noting that the allegation that the term “RITE WAY” is visually similar to the word mark RITE AID is an improper dissection of appellee’s mark, since the visual impression likely to be remembered by purchasers includes the design as well as the words).

The Court of Appeals for the Federal Circuit has repeatedly admonished that (a) trademarks should be viewed in their entirety as they are perceived by consumers, and (b) trademarks should not be dissected into fragments, with entire elements disregarded. For example in *In re Hearst Corp.*, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992), the Federal Circuit held that there was no likelihood of confusion between VARGA GIRL and VARGAS, both for calendars. In reversing the Trademark Trial and Appeal Board (TTAB), the Federal Circuit stated: “The Board erred in its analytic approach. Although undoubtedly “varga” and “vargas” are similar, the marks must be considered in the way they are used and perceived. Marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight.” *Id.*, *see also Juice Generation, Inc. v. GS Enters. LLC*, 115 U.S.P.Q.2d 1671 (Fed. Cir. 2015) (reversing TTAB decision, and finding that there is no likelihood of confusion between PEACE LOVE JUICE and Design (JUICE disclaimed) for juice bar services, and the word mark PEACE and LOVE for restaurant services). Thus, when the HELLO ORTHO NAPA and Design mark is considered in its entirety, rather than dissected to focus on HELLO, consumer confusion with Applicant’s mark is not likely.

With respect to the registration for HOLA DENTAL, the Office action states that because the term HOLA translates to HELLO, “the first term in the marks are equivalent.” This conclusion, again, ignores the distinct stylization of Applicant’s mark. Relying on the Doctrine of Foreign Equivalents, the Office action concludes that “the ordinary American purchaser would likely stop and translate the mark because the Spanish language is a common, modern language spoken by an appreciable number of consumers in the United States (more than 41 million).” However, it is unlikely that American purchasers would stop and translate HOLA to the English word “Hello,” given the fact that HOLA is a familiar term to American consumers, including those who are not Spanish speakers. See **Exhibit A**, which reflects the inclusion of the term “hola” in the Merriam-Webster Dictionary, and the online dictionary at www.dictionary.com.

The Doctrine of Foreign Equivalents typically will not be applied where the record indicates that it is unlikely purchasers would translate the mark because of “marketplace circumstances or the commercial setting in which the mark is used.” Trademark Manual of Examining Procedure (“TMEP”), § 1207.01(b)(vi)(B); *see also* 809.01(b)(i) (“It is generally unnecessary to provide a translation of a foreign term if the term appears in an English dictionary (e.g., croissant, fiesta or flambé.)”); *In re Tia Maria, Inc.*, 188 U.S.P.Q. 524, 525-26 (T.T.A.B. 1975) (holding TIA MARIA (which translates to “Aunt Mary”) for restaurant services, and AUNT MARY’S for canned fruits and vegetables, not likely to cause confusion, because, *inter alia*, a person dining at the TIA MARIA restaurant surrounded by its Mexican décor and Mexican food, would be likely to accept “TIA MARIA” as it is and not translate it into “AUNT MARY”). Similarly, given American consumers’ understanding of the term HOLA, they would be likely to accept HOLA DENTAL as it is, without translating it to HELLO DENTAL. Given

the overall aural and visual differences in the mark HELLO and HOLA DENTAL, consumer confusion is not likely.

Even if the Doctrine of Foreign Equivalents were applied, it is only one part of the process of determining whether the marks being compared are confusingly similar. TMEP § 1207.01(b)(vi)(C). “Appearance, sound, meaning, and overall commercial impression are also factors to be considered when comparing marks,” and “[s]imilarity of the marks in one respect – sight, sound, or meaning – does not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. *Id.* In the present case, HOLA DENTAL and



sound and look different, have a different number of words, and convey different commercial impressions. HOLA DENTAL, when considered in connection with the identified services, conveys the impression that Spanish-language services are available. In fact, this is confirmed by the Yellow Pages entry for Hola Dental, which indicates “Spanish” in the “Languages Spoken” section. *See Exhibit B.* This impression of the availability of Spanish-language services is entirely absent from Applicant’s mark and is an important distinguishing factor that makes consumer confusion unlikely.

Moreover, Applicant’s search of the Trademark Office records reveals that the Cited Marks are already coexisting with not only each other, but with other HELLO- formative marks (or terms that translate to HELLO) for the relevant services. Thus, these third-party registrations suggest that Applicant’s mark can coexist with the Cited Marks as well.

TM/AN/RN/Disclaimer	Status/Key Dates	Goods/Services	Owner Information
ALOHA ORTHODONTICS RN: 3473210 SN: 77139295 Disclaimer: "ORTHODONTICS"	Renewed July 22, 2018 Int'l Class: 44 First Use: January 15, 2008 Filed: March 23, 2007	(Int'l Class: 44) orthodontic services	Chelian, Naren (United States Citizen) 6592 N. Decatur Blvd. Ste. 160 Las Vegas Nevada 89131

TM/AN/RN/Disclaimer	Status/Key Dates	Goods/Services	Owner Information
	Registered: July 22, 2008		
HELLOSMILE RN: 4710412 SN: 86098322	Registered March 31, 2015 Int'l Class: 44 First Use: December 1, 2009 Filed: October 22, 2013	(Int'l Class: 44) dentist services; orthodontic services; pediatric health care services	Smile Generation, LLC, Dba Hellosmile (New York Limited Liability Company) 43-12 43rd St. Sunnyside New York 11104
JAMBO KIDS RN: 5795869 SN: 88021032 Disclaimer: "KIDS" The English translation of the word "jambo" in the mark is "hello".	Registered July 2, 2019 Int'l Class: 44 First Use: January 1, 2019 Filed: June 29, 2018	(Int'l Class: 44) Dentistry services; orthodontic services; cosmetic dentistry; pediatric dentistry	Tw Lone Peak Master LLC (Delaware Limited Liability Company) 4643 S. Ulster Street, Suite 300 Denver Colorado 80237

TSDR records for these registrations are attached as **Exhibit C**.

II. AMENDMENTS TO IDENTIFICATION OF GOODS AND SERVICES

Applicant submits the below amendments together with this Response.

Class 3: Refill containers sold filled with toothpaste; non-medicated solid toothpaste tablets; **non-medicated** mouthwash tablets; deodorants and antiperspirants for personal use

CONCLUSION

Applicant respectfully submits that there is no likelihood of confusion with the Cited Marks, and with the amendment to the identification of goods in Class 3, all issues have been fully addressed. Accordingly, Applicant respectfully requests that the likelihood of confusion refusal be withdrawn and that the application be approved for publication.