

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Schumpeter Enterprises, Inc.

Serial No.: 88/801,514

Filing Date: February 18, 2020

Mark: CABANA

Examining Attorney:

Amer Raja

Law Office 121

**RESPONSE TO NON-FINAL OFFICE ACTION
DATED JUNE 5, 2020**

Applicant Schumpeter Enterprises, Inc. (“Applicant”) filed U.S. Application Serial No. 88/801,514 (the “Application”) to register the mark CABANA in connection with various goods and services in Classes 9, 39, 42, and 43 (the “CABANA Mark” or “Mark”). The Examining Attorney issued an Office Action on June 5, 2020 on the following grounds: (1) the Mark is allegedly merely descriptive of Applicant’s Class 43 services; (2) there is an alleged likelihood of confusion under Section 2(d) based on U.S. Registration No. 5,000,451 for CABANA BOAT; and (3) a potential refusal under Section 2(d) based on U.S. Application Serial No. 87/736,948 for CABANA HOTEL.

Applicant respectfully submits that the Examining Attorney erred in concluding that the CABANA Mark is merely descriptive of Applicant’s Class 43 services. In addition, based on the arguments set forth below, Applicant submits that Applicant’s Mark is distinguishable from the cited third-party marks CABANA BOAT and CABANA HOTEL, particularly in light of Applicant’s amendments to its identification of goods and services. Accordingly, Applicant requests that the Examining Attorney withdrawal the refusals and approve Applicant’s Mark for publication in the *Official Gazette*. In support of its request, Applicant states as follows:

I. AMENDMENTS TO APPLICANT’S IDENTIFICATION OF GOODS AND SERVICES

Applicant hereby amends its identification of goods and services for its Application to read as follows:

Class 9: Downloadable mobile applications for providing information about ~~motor~~ **motorized land** vehicles for temporary use; downloadable mobile applications for providing **motorized land vehicle** transportation and logistics services, bookings for **motorized land vehicle** transportation services, and dispatching ~~motor~~ **motorized land** vehicles to customers; downloadable mobile applications for use in scheduling, planning, organizing, managing, and providing temporary use of ~~motor~~ **motorized land** vehicles

Class 39: **Motorized land** vehicle rental services; reservation services for the rental and sharing of **motorized land** vehicles; provision of information and advisory and consultancy services in relation to the aforesaid services

Class 42: Providing temporary use of non-downloadable software for use in providing **motorized land vehicle** transportation and logistics services, bookings for **motorized land vehicle** transportation services, and dispatching ~~motor~~ **motorized land** vehicles to customers; providing temporary use of non-downloadable software for use in scheduling, planning, organizing, managing, and providing temporary use of ~~motor~~ **motorized land** vehicles; providing platform as a service (PAAS) services featuring software platforms for use in inventory and fleet management for use in the ~~motor~~ **motorized land** vehicle rental field; providing temporary use of non-downloadable software that provides web-based access to applications and services through a web operating system and portal interface, namely, software for use in scheduling, planning, organizing, managing, and providing temporary use of ~~motor~~ **motorized land** vehicles

Class 43: Rental of temporary accommodations **in the nature of motorized land vehicles**; booking of temporary accommodations **in the nature of motorized land vehicles**; providing online reservations and bookings for temporary lodging and accommodations **in the nature of motorized land vehicles**

The above amended identification of goods and services is hereinafter referred to as Applicant's Goods and Services.

II. APPLICANT'S MARK IS SUGGESTIVE OF APPLICANT'S CLASS 43 SERVICES.

The Examining Attorney issued a partial refusal of the Application on the basis that Applicant's Mark "merely describes a feature, characteristic, and purpose" of Applicant's identification of services in Class 43. In support of this refusal, the Examining Attorney cited dictionary evidence showing that the term "cabana" refers to a lightweight structure with living

facilities or a shelter, as well as online evidence purportedly showing that “cabana rental” services are common types of temporary accommodations. Applicant respectfully submits that the CABANA Mark cannot be considered merely descriptive for the amended services in Class 43.

A mark is merely descriptive if it conveys an immediate idea of an ingredient, quality, characteristic, function, feature, purpose, or use of the applied-for goods or services. *See In re Gyulay*, 3 U.S.P.Q.2d 1009 (Fed. Cir. 1987). The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. *In re Chamber of Commerce*, 102 U.S.P.Q.2d 1217, 1219 (Fed. Cir. 2012). The Examining Attorney has the burden of proving that a mark is merely descriptive of an applicant’s applied-for goods and/or services. Trademark Manual of Examining Procedure (“TMEP”) § 1209.02.

Further, if a mark does not immediately and directly convey descriptive information about the goods or services in connection with which it is used, but rather some sort of reasoning, imagination, or additional thought is required to understand the relationship between the mark and the goods or services in question, then the mark is deemed suggestive of the goods or services, rather than merely descriptive. TMEP § 1209.01(a).

In this case, Applicant’s identification of services in Class 43 has been narrowed and clarified to specify temporary lodging and accommodations in the nature of “motorized land vehicles,” thereby excluding the “cabana rental” type of accommodations cited by the Examining Attorney. As shown in the attached Exhibit A, Applicant’s Class 43 services involve the rental and booking of motorized land vehicles (i.e., vans) with living quarters installed inside, which function as a mobile accommodation that customers can drive to different travel destinations.

Consequently, Applicant's amended identification of services in Class 43 no longer encompasses services for providing temporary accommodations in the form of "cabana rentals." Moreover, given the unique nature of Applicant's Class 43 services, consumers would not immediately believe that the CABANA Mark refers to a temporary accommodation. The ambiguity caused by the use of Applicant's Mark in connection with motorized land vehicles causes an additional step in the average purchaser's thought process to understand the relationship between Applicant's Mark and the amended Class 43 services. This type of thought process is the hallmark of a suggestive mark.

Accordingly, Applicant's Mark should at the very least be considered suggestive of Applicant's amended Class 43 services.

III. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT'S MARK AND THE REGISTERED MARK.

The Examining Attorney initially refused registration of Applicant's Mark based on an alleged likelihood of confusion with U.S. Registration No. 5,000,451 owned by Synergy Promotions ("Registrant") for the mark CABANA BOAT for "Boat rental" services in Class 43 ("Registered Mark"). As set forth below, Applicant submits that confusion between its Mark and the Registered Mark is unlikely given the differences between the parties' marks, offerings, and trade channels, particularly in light of Applicant's amendments to its identification of goods and services.

A. Applicant's Goods and Services are distinguishable from Registrant's services.

Applicant's Goods and Services are unrelated to, and do not compete with, Registrant's services covered under the Registered Mark, especially in light of the amendments to Applicant's Goods and Services.

The Trademark Trial and Appeal Board has consistently held that if the goods or services in question are not related or marketed in a manner causing them to be encountered by the same persons in situations creating the incorrect assumption of origination from the same source, then confusion is not likely. *See, e.g., Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 U.S.P.Q.2d 1156 (TTAB 1990) (finding no likelihood of confusion between LITTLE PLUMBER for liquid drain opener and LITTLE PLUMBER & Design for advertising services); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 U.S.P.Q.2d 1668 (TTAB 1986) (finding no likelihood of confusion between QR for coaxial cable and QR for various products related to the photocopying field); TMEP § 1207.01(a)(i). One way of determining whether goods and services are “related” is to consider whether they are competitive, that is, whether they are “reasonably interchangeable by buyers for the same purposes.” 3 J.T. MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:23 at 24-43 (4th ed. 1997); *see also Beneficial Corp. v. Beneficial Capital Corp.*, 529 F. Supp. 445, 449-50, 213 U.S.P.Q. 1091, 1094-94 (S.D.N.Y. 1982).

The Examining Attorney concluded that Applicant’s Goods and Services (prior to the current amendments) are highly similar to the services covered by the Registered Mark because the Application used broad wording to describe vehicle rental services, which could encompass Registrant’s narrower description of “boat rental” services. The Examining Attorney also noted that Applicant’s software goods in Class 9 are a type of software that is commonly provided by the same source under the same mark for boat rental services. However, Applicant’s Goods and Services have been narrowed to clarify that Applicant is only using the Mark in connection with goods and services for motorized land vehicles.

Applicant’s Goods and Services (as amended) are not competitive or reasonably interchangeable with Registrant’s boat rental services. Based on the Registrant’s website and the

specimen of use submitted for the Registered Mark, it is apparent that the Registered Mark is solely associated with the rental of boats that have cabanas installed on them for lounging and recreation purposes. *See* Printouts from Registrant's website attached as Exhibit B. In contrast, Applicant's Mark is associated with a service that provides temporary use of motorized land vehicles (i.e., vans) with living quarters installed inside, which function as a mobile accommodation that customers can drive to different travel destinations. *See* Exhibit A. Consumers interested in renting a boat with cabanas for lounging and recreation on a lake will not look to a provider of van rental services, just as a customer seeking a van to sleep and travel in will not look to a provider of boat rental services. Consequently, the parties' offerings are not competitive, nor reasonably interchangeable by customers for the same purposes.

In addition, Applicant's Goods and Services are not related or marketed in such a way to be encountered by the same consumers in situations that would create the incorrect assumption that the parties' respective offerings originate from the same source. As discussed above, the parties' channels of trade and class of consumers are distinct because Registrant's boat rental services are readily distinguishable from Applicant's Goods and Services, and therefore should not be presumed to travel within the same trade channels or to the same customers. Registrant's services are marketed towards consumers who want to rent a boat for lounging or recreation on a lake. *See* Exhibit B. Applicant's Goods and Services, on the other hand, are targeted to consumers who are seeking mobile accommodations that provide them with the flexibility of having a place to sleep that can also be driven to different travel destinations. *See* Exhibit A. Given these disparate channels of trade and consumer classes, consumer confusion is not likely.

B. Applicant's Mark differs from the Registered Mark.

Applicant's CABANA Mark and Registrant's mark CABANA BOAT are not confusingly similar. When comparing marks to determine whether confusion exists, the marks

must be compared in their entireties. *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749 (Fed. Cir. 1985). In this case, when considered in their entireties, the marks are distinguishable in sight and sound.

Viewed in its entirety, Registrant's mark includes the additional term "BOAT". This additional term causes the marks to differ in overall appearance, such that confusion is not likely. *See In re N.A.D.*, 754 F.2d 996, 999, 224 U.S.P.Q. 969 (Fed. Cir. 1985) (finding no likelihood of confusion between NARKOMED for anesthesia machines and NARCO for leasing of hospital and surgical equipment); *see also Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998) (no likelihood of confusion between CRYSTAL CREEK for wine and CRISTAL for champagne).

Applicant's Mark also differs in sound from the Registered Mark. When spoken, consumers will pronounce Registrant's mark as "CABANA" together with "BOAT." Applicant's Mark, on the other hand, is simply pronounced as "CABANA." The inclusion of the term BOAT creates a stark difference in sound, such that consumers are not likely to believe that both marks emanate from the same source.

The Examining Attorney suggests that consumers encountering Applicant's Mark will believe that it is a shortened form of the Registered Mark. However, the Examining Attorney has not provided any evidence to support this position. Further, any alleged similarities between the parties' marks is outweighed by the parties' distinct offerings, which no reasonable consumer would believe emanate from the same source.

In sum, Applicant's and Registrant's offerings are unrelated and will not compete with each other. Applicant's offerings are focused on motorized land vehicles whereas Registrant's services are limited to boat rentals. Taking into account these distinct offerings and the

differences between the parties' marks, Applicant submits there is no likelihood of confusion between Applicant's Mark and the Registered Mark.

IV. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT'S MARK AND THE PENDING MARK.

The Examining Attorney indicated that Applicant's Mark may be refused registration based on a potential likelihood of confusion with U.S. Application Serial No. 87/736,948 owned by Cabana Development LLC for the mark CABANA HOTEL ("Pending Mark").

As the application for the Pending Mark is still pending, Applicant reserves the right to submit arguments pending the issuance of a registration or the abandonment of the Pending Mark. However, in light of Applicant's amendments to narrow and clarify Applicant's Goods and Services, particularly the identification of services in Class 43, Applicant respectfully submits that there will be no likelihood of confusion with the Pending Mark and requests that the Examining Attorney withdraw the notice of potential refusal based on the Pending Mark.

In particular, the application for the Pending Mark covers "Hotel, restaurant, catering, bar, and cocktail lounge services; Provision of facilities for meetings, conferences and exhibitions" in Class 43. Presumably, it is the Examining Attorney's position that the hotel services described in the application for the Pending Mark could potentially overlap with Applicant's identification of services related to the provision of temporary accommodations in Class 43. However, as discussed above, Applicant's identification of services in Class 43 has now been narrowed to specify temporary lodging and accommodations in the nature of "motorized land vehicles" (i.e., vans with living quarters installed inside). As a result, Applicant's identification of services in Class 43 does not encompass the provision of hotel accommodations, as described in the application for the Pending Mark. And since Applicant's amended services in Class 43 are not sufficiently similar or related to the hotel services covered

under the application for the Pending Mark to cause a likelihood of confusion amongst consumers, Applicant respectfully requests that the Examining Attorney withdraw the potential refusal.

V. CONCLUSION

Based upon the foregoing, Applicant respectfully requests that the Examining Attorney withdraw the refusals and approve the Application for publication in the *Official Gazette*. Should any questions remain with respect to the above, please contact the Attorney of Record.

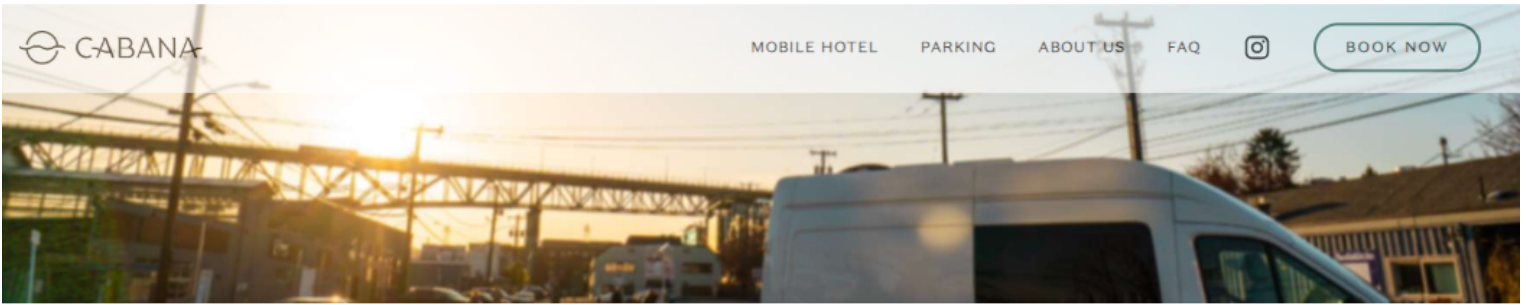
Respectfully submitted,

Dated: October 5, 2020

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Attorneys for Applicant

EXHIBIT A



The comforts of a boutique hotel packed into a van

BEDROOM

BATHROOM

KITCHENETTE

STORAGE

SOCIAL

ADD-ONS



Bed

Sleep on an 8" graphite-infused memory foam mattress—the ultimate in cooling comfort. The size is a camper queen, which means it is the width of a queen with the length of a full (74").



Entertainment

Stream entertainment on a 24" screen with Amazon Fire TV and complimentary WiFi. There are USB ports and power outlets located by the bed to charge your devices overnight.



Heater

Set the thermostat to your ideal temperature. The forced-air heating system is powered by fuel in the fuel tank. The system will automatically shut off if fuel in the tank falls below $\frac{1}{4}$.



Window Shade

Every window comes with a durable, button-up window shade. Snap them in for privacy or to keep the morning light out while you sleep.



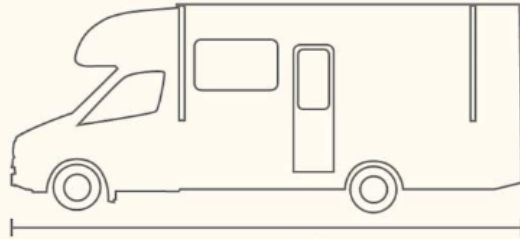


Cooling

Cool off with the ceiling fan that circulates air in and out of the van for warmer

19 ft. 8 in.

RV



25 ft. 2 in.

POWER

Your Cabana's electrical systems are powered by a combination of 2 100-Watt solar panels ,the engine (when it is running), and "shore power". Shore power means you can plug it into any standard outlet.

FUEL

Unleaded fuel powers your Cabana. **87 Octane** is just fine.

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EXHIBIT B

Cabana Boat

VIP Cabana Rentals

An Exclusive Lake Havasu Experience



Relax

on your Cabana Boat in the Channel!

Enjoy your lavishly appointed* cabana positioned on the beach in the world famous Bridgewater Channel. All you have to do is step into your own private cabana and enjoy your day! Sip a cocktail or soak up the sun on a full size daybed or Modern style day sofa. Or even better yet, soak your feet in the beautiful blue water of Lake Havasu.

*See reverse side.

Reserve Your Cabana Today!

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Cabana Boat

VIP Cabana Rentals

An Experience Un-Matched on the Water

Each Cabana is lavishly appointed with a plush day bed or modern sofas, sun loungers, private sound system, BBQ, dining table, accent seating, ice chests with ice, V.I.P. amenities, swim deck, plush carpeting, swim accessories, Aqua Lily Pads*, and Paddle Boards*.

*Additional fees may apply.

Each cabana is 280 Square feet and holds 10 to 15 guests comfortably.

Cabanas can be placed side by side for larger groups. Catered meals are also available from many of Lake Havasu's fine restaurants.

V.I.P. Cabana Hosts are on site to make sure your experience is memorable.

Call today - dates are filling fast!

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The Epitome of Cool!



Like 306 people like this. Sign Up to see what your friends like.

Cabana Boats On The Channel In Lake Havasu, Just Relax.

Enjoy your lavishly appointed cabana boat positioned on the beach in the world famous Bridgewater Channel. All you have to do is step into your own private cabana boat, turn on the tunes and enjoy your day! Sip a cocktail or soak up the sun on a full size daybed or modern style day sofa. Or even better yet, soak your feet in the beautiful blue water of Lake Havasu.



An Experience Un-Matched On The Water

Each Cabana Boat comes with:

- Day bed or modern sofa
- Sun loungers
- Private sound system
- BBQ
- Dining table
- Accent seating
- Ice chest with ice
- V.I.P. amenities
- Swim deck
- Plush carpeting
- Swim accessories

Also available:

**Additional fees may apply*

*Agua Lily Pads**

*Paddles Boards**

*SeaDoo swim jets**

Each Cabana is 280Square feet and holds 10 to 15 guests comfortably.

Cabanas can be placed side by side for larger groups. Catered meals are also available from many of Lake Havasu's fine restaurants.

V.I.P. Cabana hosts are on site to make sure your experience is memorable.

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