

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

May 16, 2021

Barbara Gaynor
Trademark Examining Attorney

Re: Serial No: 90121688
Mark: Chocolate
Applicant: Chocolate by Kwaku Bediako LLC
Office Action of: December 14, 2020

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RESPONSE TO OFFICE ACTION

The following is the response of Applicant, by Counsel of Office Action dated December 14, 2020 and addressing the claims therein.

Summary of Refusal

The Examining Attorney has partially refused registration of Applicant’s mark for CHOCOLATE (and Design) in the stylized form (“**Applicant’s Mark**”) in connection with “Shirt; Trousers; Caftans; Dresses; Kaftans” under Section 2(d) of the Lanham Act because of a perceived likelihood of confusion with:

- 1) the standard character mark CHOCOLETTE (U.S. Registration No. 5460234) in connection with “Clothing and footwear for children and infants, namely belts, blouses, bonnets, coats, cardigans, dresses, dressing gowns, footwear, gloves, hats, headband, jackets, leggings, nightgowns, pants, sandals, shirts, shoes, shorts, skirts, slippers, socks, scarves, sweaters, bathing suits, tights, T-shirts, baby bibs not of paper” in Class 25 and “Retail store services and online retail store services featuring clothing, shoes and related accessories” in Class 35; (the “**Cited Registration 1**”) and
- 2) the standard character mark CHOCOOLATE (U.S. Registration No. 6133771) in connection with, *inter alia*, “Clothing for athletic use, namely, padded pants; Clothing for athletic use, namely, padded shirts; Clothing for athletic use, namely, padded shorts; Clothing items, namely, adhesive pockets that name be affixed directly to the body as a decorative piece of clothing with utility” (the “**Cited Registration 2**”) and
- 3) the pending U.S. Application Serial No. 88723727 for “Chocolate” in connection with, *inter alia*, “Computer hardware; Computer hardware and peripheral devices and software for playback, streaming, transmitting, receiving audio-visual media content via the Internet...” in Class 9, “Clothing, namely, shirts pans, coats, suits, dresses; casual, children’s, evening, exercise, rain, sports and beach footwear...” in Class 25, “Provision of information and advisory services relating to e-commerce; provision of information relating to market studies; provision of market research information...” in Class 35, and “Production of radio and

television programmes; film production; educational research services; education and training services..." in Class 41 (the "Pending Mark 1"); and

- 4) the pending U.S. Application Serial No. 9007828 for "Chocolate Athletics" in connection with "Clothing; Headwear; Footwear; Swimwear; Sleepwear" in Class 25 (the "Pending Mark 2", together with Cited Registration 1, Cited Registration 2, and Pending Mark 1, the "Previous Marks").

For the following reasons, Applicant respectfully disagrees with the findings and requests that the Examining Attorney reconsiders the refusal and allow registration of the Applicant's Mark.

Section 2(d) Refusal – Likelihood of Confusion

The Examining Attorney uses the analysis provided in In re E.I. du Pont de Nemours & Co., 476 F. 2d 1361, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) and has indicated that the following factors are the most relevant in the likelihood of confusion between the Applicant's Mark and the Previous Marks: the similarities between the compared marks and the relatedness of the compared goods and/or services.

In setting forth the factors, however, the DuPont court cautioned that, with respect to determining likelihood of confusion, "there is no litmus rule which can provide a ready guide to all cases." Id. at 1361, 177 USPQ at 567. Summarily, the Applicant's Mark and the Previous Marks are vastly different in their marks, overall commercial impressions, trade channels, consumer sophistication and therefore they do not present a likelihood of confusion. Furthermore, there are numerous other brands that use a mark that is visually and/or phonetically identical or similar to the Previous Marks, which negates any likelihood of confusion for marks with even slight variations.

A. There is Extensive Third-Party Use of Marks that are Phonetically Similar or Identical to the Cited Registration and Pending Mark

It is well-established by case law that "extensive third-party use of a mark can weaken a mark and negate a likelihood of confusion". Bd. of Supervisors for Louisiana State Univ. Agric. & Mech. Coll. V Smack Apparel Co., 550 F. 3d 465, 479 (5th Cir. 2008). The Applicant's application was rejected due to the similarity of the literal elements of the Applicant's Mark and the Previous Marks, namely, the phonetic similarity of CHOCOLATE, CHOCOLETTE, CHOCOOLATE, and CHOCOLATE ATHLETICS. However, on numerous occasions, the Court has found that the extensive third-party use of a mark is impressive evidence that there would be no likelihood of confusion. Sun Banks of Florida, Inc. v Sun Fed. Sav. & Loan Ass'n, 651 F.2d 311, 316 (5th Cir. 1981); See, e.g., Amstar Corp. v Domino's Pizza, Inc., 615 F.2 252, 260 (5th Cir. 1980) (numerous third-party registrations of the mark "Domino"); Armstrong Cork Co. v. World Carpets, Inc., 597 F.2d 496, 505 (5th Cir. 1979) (multiple uses of the mark "World"); American Heritage Life Ins. Co. v Heritage Life Ins. Co., 494 F.2d 3, 7 (5th Cir. 1974) (multiple uses of the work "Heritage"); Holiday Inns, Inc. v Holiday Out in America, 481 F.2d 445 (5th Cir. 1973) (multiple uses of the mark "Holiday"); El Chico, Inc. v El Chico Café, 214 F.2d 721 (5th Cir. 1954) (27 third-party registrations of the mark "Chico", "El Chico" and other similar names).

In Armstrong Cork Co. v World Carpets, Inc., the Court stated that the existence of multiple "different carpet companies using without objection from [Registrant] the word WORLD in their business not to mention [Registrant's] toleration of [Applicant's] own use of the term... militates against the finding of likelihood of confusion." Restatement of Torts s 729, Comment (g), at 596 (1938) ("The greater the

number of identical or more or less similar trade-mark already in use...the less is the likelihood of confusion.”). Armstrong Cork Co. v World Carpets, Inc., *supra*.

Knowing that “widespread use of the term militates against a finding of likelihood of confusion” (Sun Banks of Florida, Inc. v Sun Fed. Sav. & Loan Ass’n, *supra*), it is important for the Trademark Examiner to be advised of the extensive widespread use of the word Chocolate (or marks/brands phonetically similar to it) as it relates to apparel and other products and services. Exhibit A shows that there are at least 26 uses, other than the Previous Marks, of the word Chocolate in commerce. The Court has informed us that “All third-party use of a mark, not just use in the same industry as a plaintiff, may be relevant to whether a plaintiff’s mark is strong or weak.” Bd. of Supervisors for Louisiana State Univ. Agric. & Mech. Coll. 550 F.3d 465, 480 (5th Cir. 2008). In El Chico Inc. 27 third-party uses of the common word(s) was sufficient for a finding against likelihood of confusion, so we would expect the 26 uses that are documented in Exhibit A meet that threshold. In addition, there is at least one other registration of a mark that is phonetically similar to Cited Registration 1, but spelled differently and in a stylized format, which are also the same two factors that differentiate the Applicant’s Mark.

B. The Similarity of the Marks and the Services Are Not Dispositive

Although the Applicant’s Mark and Previous Marks contain words that are phonetically similar to “Chocolate”, in reversing the district court’s ruling, the Court has reject the argument that common word usage tends to immediately suggest a connection between the two institutions when there is extensive third-party use of a mark. Sun Banks of Florida, Inc. v Sun Fed. Sav. & Loan Ass’n, at 317 (5th Cir. 1981). Furthermore, when there was extensive third-party use of the mark, the Court held that the “degree of similarity between [the services] is but one factors to be evaluated in assessing the likelihood of confusion. We do not find it to be the dispositive factor.” Id. at 318.

Here, the dispositive factor is in the fact that extensive third-party use, which the courts consistently find as strong evidence against likelihood of confusion. Courts have repeatedly reverse lower courts for not giving extensive third-party use the weight it deserves. Amstar Corp v. Domino’s Pizza, Inc., at 260 (5th Cir. 1980) (holding that “The extensive third-party uses documented in this case were entitled to much greater weight than were accorded them by the district court.”); Sun Fed. Sav. & Loan Ass’n, at 316 (“...we reversed a finding of likelihood of confusion, in part because the district court failed properly to weigh the impact of extensive third-party uses of the “Domino” mark.”).

C. The Applicant’s Mark is Distinctive Because of the Different Spelling and Design of the Mark

The Trademark Examiner should also find that the Applicant’s Mark is distinctive from the Previous Marks because of the added elements of a different spelling and the unique design of the Applicant’s Mark. “Whether an addition is sufficient to prevent confusion in a particular instance depends upon the strength of the main part of the mark and the distinctiveness of the additional feature. Where a trademark itself is weak, minor addition may effectively negate any confusing similarity.” Sun Banks of Florida, Inc. v Sun Fed. Sav. & Loan Ass’n, *supra*. “Extensive use of the words brings it within the classification of a weak trade name which could be used without infringement in the absence of actual confusion or intent to deceive...” El Chico, Inc. v. El Chico Café, at 725 (5th Cir. 1954). Common use of a term by third parties in the same industry could support a claim that the mark is conceptually weak. See Moose Creek, Inc. v Abercrombie & Fitch Co., 331 F.Supp. 2d 1214, 73 U.S.P.Q.2d 1287 (C.D. Cal. 2004), *aff’d*, 114 Fed. Appx. 921 (9th Cir. 2004).

Comparing the mark and the goods alone is insufficient to find confusing similarity, especially in this case with extensive third-party use. See Plus Products v. Star-Kist Foods, Inc. 220 U.S.P.Q. 541, 544, 1983 WL 51884 (TTAB 1983) (Third-party use may be relevant to show that the mark or a portion of the mark is descriptive, suggestive, or frequently used so that customers will look to other elements to distinguish the source of goods or services). It is well-established that “(s)imilarity of appearance is determined on the basis of the total effect of the designation, rather than on a comparison of individual features.” Sun Banks of Florida, Inc. v Sun Fed. Sav. & Loan Ass’n, 651 F.2d 311, 318 (5th Cir. 1981). Here, there are major (not minor) additions to the Applicant’s Mark which differentiate it and create a different commercial impression than the Previous Marks. The Applicant’s Mark consists of stylized wording of the word “CHOCOLATE” in all medium-large capital letters and the second “C” is a large block-letter with rounded edges with three “drips” on the bottom – one small drip, a big drip and a medium sized drip (in that order). In contrast, Cited Registration 1 (U.S. Reg. No. 5460234) is simply the word “CHOCOLETTE” and Cited Registration 2 (U.S. Reg. No. 6133771) is simply the word “CHOCOOLATE”, each with standard characters without claim to any particular font style, size, or color.

Taking each of the three marks in its entirety, the complete design of the Applicant’s Mark in its unique presentation is very different from the Previous Marks, in spelling and/or visually, creating a different commercial impression. It is extremely unlikely that consumers will mistake one brand for the other given the obvious and drastic differences of the marks. See Sun Banks of Fla. V. Sun Fed. Sav. & Loan, 651 F.2d 311 (5th Cir. 1981) (no likelihood of confusion between the parties’ use of the word “sun”, and little evidence of actual confusion).

D. Marketing Channels and the Degree of Purchaser Care

In the present case, marketing channel are also different, which eliminates any likelihood of confusion. The Applicant sells [apparel and methods of selling]

Unlike Previous Marks, the Applicant’s use of the Applicant’s Mark is tailored to an audience that enjoys contemporary West African clothing.

Further, the Previous Marks do not appear to be presently advertised as CHOCOLETTE or CHOCOOLATE, respectively, anywhere online nor do they seem to have e-commerce stores that would cause confusion with the Applicant’s online store (<http://www.chocolateclothesglobal.com>).

While both are technically “apparel”, the trade channels and presentation to consumers could not be more different. Accordingly, there is no risk that consumers would think that the product come from a common source.

Prior Pending Application

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bathing suits, tights, T-shirts, baby bibs not of paper” in Class 25 and “Retail store services and online retail store services featuring clothing, shoes and related accessories” in Class 35; (the “**Cited Registration 1**”) and

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For the following reasons, Applicant respectfully disagrees with the findings and requests that the Examining Attorney reconsiders the refusal and allow registration of the Applicant’s Mark.

Sections 1 and 45 Specimen Refusal

Please see attached new specimens showing the mark in use in commerce for the Class 25 goods identified in the application. Please note the new specimens were in use in commerce at least as early as the filing date of the application or prior to the filing of the amendment to allege use.

Color Claim and Mark Description

The Applicant would like to amend the color claim and mark description as follows:

Color claim: The colors brown, tan, and black are claimed as a feature of the mark.

Mark description: The mark consists of the tan stylized wording “CHOCOLATE”, where the second letter “C” is shown in brown with black lining and black drippings at the bottom of the letter and is outlined in tan.

Other

Amendment to Application: Disclaimer

Notwithstanding any of the foregoing arguments, we would like to amend our application to add a disclaimer that no claim is made to the exclusive right to use of “chocolate” apart from in the Applicant’s Mark as shown.

Conclusion

Section 2(d) Refusal – Likelihood of Confusion

The Previous Marks are weak due to the extensive use of the word “chocolate” or words that are phonetically identical to it in commerce, especially in connection with apparel. Therefore, minor additions to the mark effectively negates a finding of likelihood of confusion, which is supported by a substantial amount of case law.

The Applicant has a very different spelling than the Previous Marks which is obvious to any consumer, and even more the Applicant’s Mark is a design mark, made up of very distinct features that can separate it from any other brand that may use any variation of the word “chocolate” including the Previous Marks. The Court’s former decisions support the fact that these variations are sufficient to be distinctive due to the weak nature of the Previous Marks.

In the light of the foregoing, the Applicant respectfully submits that all of the bases for rejection of its mark have been overcome, and that this application is therefore in a prima facie condition for allowance. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register the Applicant's Mark, and allow this applicant to pass to publication towards registration.