

## Response to Office Action

MARK: YANA  
SERIAL NO.: 88088550  
APPLICANT: JHL INVESTMENTS LLC  
FILING DATE: August 22, 2018  
INTERNATIONAL CLASS: 044  
TO: Rebecca T. Caysido  
Examining Attorney  
USPTO, Law Office 123

Applicant, JHL INVESTMENTS LLC (“Applicant”) respectfully submits this Response to the Office Action issued on May 21, 2019 against Application Serial No. 88088550 for the YANA mark (for *Healthcare services to treat and diagnose mental illness* in Class 044) (the “Applicant’s Mark”).

The Examiner has refused registration on the ground that the Applicant’s Mark is likely to cause confusion with the trademark bearing Registration No. 88062628 (THE YANA HEALING CIRCLE in Class 045) (“Cited Mark”). Applicant maintains that, for the reasons set forth below, this confusion is unlikely, and therefore the Cited Mark should not pose a bar to registration.

As each issue in the Office action letter of May 21<sup>st</sup> have been addressed, Applicant respectfully requests that the YANA mark be granted registration.

### I. Likelihood of Confusion Refusal

#### 1. Likelihood of Confusion Standard

Likelihood of confusion is determined on a case-by-case basis, with application of the factors identified in *Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The likelihood standard means that it must be probable that confusion as to source will result from the simultaneous registration of two marks; it is not sufficient that confusion is merely possible. Trademark law is “not concerned 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.” *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713 (Fed. Cir. 1992), quoting *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 1403 (C.C.P.A. 1969). As such, no per se rule exists that confusion is automatically likely between marks merely because they share similar wording. Moreover, registrations for identical marks (which Applicant’s mark and Cited Mark are not) for closely related goods and services may coexist when the totality of the circumstances indicates there is no likelihood of confusion.

#### 2. The Applicant's Mark Is Visually and Aurally Dissimilar From The Cited Mark and The Marks Create Distinct Commercial Impressions In Their Respective Contexts

The Applicant's Mark is dissimilar from the Cited Mark in appearance and overall commercial

impression.

In determining likelihood of confusion, marks being compared should be considered in their entirety. *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005 (C.C.P.A. 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). It is improper to focus on a single portion of a mark and decide likelihood of confusion only upon that feature, ignoring all other elements of the mark. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974).

In determining the commercial impression created by a mark, the mark must be viewed in its entirety. See *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974). Further, a mark that contains in part the whole of another mark will not be found to pose a likelihood of confusion where the marks differ in overall commercial impression. In *In re Hearst Corp.*, 25 U.S.P.Q. 2d 1238 (Fed. Cir. 1992), the court found that the Trademark Trial and Appeal Board had erred in holding that there was a likelihood of confusion between VARGAS and VARGA GIRL, both for use on calendars, stating that although “Vargas” and “Varga” were similar, “the marks must be considered in the way they are used and perceived ... and all components thereof must be given appropriate weight.” The court went on to say that “[b]y stressing the portion ‘varga’ and diminishing the portion ‘girl’, the Board inappropriately changed the mark.” *In re Hearst Corp.* at 1239, see also *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107 (C.C.P.A. 1972) (ALL CLEAR not likely to cause confusion with ALL, both for household cleaning products).

The Examining Attorney, in their letter of May 21<sup>st</sup>, submits that Applicant’s Mark YANA in standard characters, is overly similar to the Cited Mark bearing Application Serial No. 88299695, THE YANA HEALING CIRCLE.

Admittedly, Applicant’s Mark and the Cited Mark overlap in the word YANA. However, in the Cited Mark, YANA is preceded by the word THE which makes it likely that consumers will interpret the word YANA in the noun form. As a noun, YANA “refers to a mode or method of spiritual practice in Buddhism, and in particular to divisions of various schools of Buddhism according to their type of practice.”<sup>1</sup> This interpretation of YANA follows logically in the Cited Mark because the last portion of the mark is “HEALING CIRCLE” which automatically conveys a sense of spiritualism and ritual. Conversely, in Applicant’s Mark, YANA is an abbreviation for the words, YOU ARE NOT ALONE. This is suggested by Applicant’s separately applied-for mark and logo bearing Application Serial No. 88299719, for YANA YOU ARE NOT ALONE.<sup>2</sup> Further, YANA standing for YOU ARE NOT ALONE is supported by the description of Applicant’s services as “Healthcare services to treat and diagnose mental illness,” because “YOU ARE NOT ALONE” is a phrase commonly associated with mental health support.

More importantly, the last two words of the Cited Mark, HEALING CIRCLE does not necessarily associate with the healthcare industry. Traditionally, healing circles consist of “people who sit together in a talking circle, in prayer, in ceremony, and are committed to helping one another and to each other’s healing.”<sup>3</sup> Healing circles are tied to ceremony, prayer, and spiritualism rather than to science. Healing

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<sup>1</sup> <https://www.definitions.net/definition/yana>

<sup>2</sup> The applicant entities listed for this applied-for mark bearing Application Serial No. 88088550 (YANA in Class 044) and for the applied-for mark bearing Application Serial No. 88299719 (YANA YOU ARE NOT ALONE. in Class 009) are in fact owned by the same person.

<sup>3</sup> [https://www.google.com/search?ei=etH3XK7EJ8ia\\_Qb-lZGIBw&q=healing+circle+definition&oq=healing+circle+definition&gs\\_l=psy-ab.3.0j0i22i30i2.411.1433..1608...0.0..0.99.892.11.....0....1..gws-wiz.....0i67.I9uOII9UqyY](https://www.google.com/search?ei=etH3XK7EJ8ia_Qb-lZGIBw&q=healing+circle+definition&oq=healing+circle+definition&gs_l=psy-ab.3.0j0i22i30i2.411.1433..1608...0.0..0.99.892.11.....0....1..gws-wiz.....0i67.I9uOII9UqyY)

circles do not solely focus on mental wellness, but rather, healing circles promote all forms of healing, emotional, physical, and mental.

In combination, respectfully, the above-mentioned differences between the marks result in distinct commercial impressions, making confusion between them unlikely.

3. The Applicant's Goods/Services and Cited Mark's Goods/Services Are Sufficiently Unrelated To Render Consumer Confusion Unlikely

In assessing the relatedness of the goods and/or services, the more similar the marks at issue, the less similar the goods or services need to be to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 USPQ2d 1584, 1597 (TTAB 2011) ; *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010) ; *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001) . If the marks of the respective parties are identical or virtually identical, the relationship between the goods and/or services need not be as close to support a finding of likelihood of confusion as would be required if there were differences between the marks. *Shell Oil*, 992 F.2d at 1207, 26 USPQ2d at 1689; *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009). TMEP 1207.01(a).

Applicant's services are not related to the Cited Mark's services. The Cited Mark's services are for *Providing emotional counseling in the nature of grief counseling; Conducting emotional support groups in the field of lifestyle wellness and personal development, namely, self-improvement, self-fulfillment, and interpersonal communication, the foregoing excluding emotional support groups in the field of addiction recovery* in Class 045.

Applicant's services are *Healthcare services to treat and diagnose mental illness* in Class 044.

It is important for Applicant to point out that the Cited Mark, bearing Application Serial No. 88062628, was issued a Section 2(d) first refusal on November 25, 2018 based on likelihood of confusion with registered trademark bearing Registration No. 2635192, YANA. In response, Cited Mark agreed to limit the scope of its services to grief counseling, emotional support, and encouragement in personal development. Subsequently, the Examining Attorney in that case accepted the amendment on May 14, 2019. Since Cited Mark's services were amended to be narrowly defined, there would not be a likelihood of confusion with Applicant's goods and services in this case because they are distinct. Of course, Examining Attorney is not bound by prior decisions, but Applicant is respectfully pointing out Cited Mark's narrowly defined services to help guide Examining Attorney's decision.

Applicant's services and Cited Mark's services overlap because mental illness counseling, broadly, could include emotional counseling because many individuals who suffer from mental illness also require emotional support. However, Applicant's services are primarily medical services for mental illness diagnosis and treatment, in Class 044. On the other hand, Cited Mark's services are basically personal and social services in Class 045, providing individuals with group support for emotional grief and personal development. Further, given the significantly more meaningful distinctions between the two marks, described above, the Office must show a proportionally higher degree of relatedness to support a finding that the two marks would overall be confused in the marketplace.

4. The Channels of Trade and Conditions Under Which Sales Are Made Render Consumer Confusion Unlikely

Conditions under which purchases of a particular kind of good or service are made are to be considered in determining likelihood of confusion. TMEP § 1207.01, citing *In re E.I. DuPont de Nemours & Co.*, at 1360-62. See also *Jet, Inc. v. Sewage Aeration Systems*, 165 F.3d 419, 423, 43 Fed. R. Serv. 3d 231, 1999 FED App. 0003P (6th Cir. 1999) (citing *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1111 (6th Cir. 1991)); See also, *In re American Olean Tile Company Inc.*, 1 U.S.P.Q.2d 1823, 1986 WL 83338 (T.T.A.B. 1986) (no confusion between MILANO for ceramic tile sold to trade and MILANO for wooden doors sold to the public); *In re Shipp*, 4 U.S.P.Q.2d 1174, 1987 WL 123841 (T.T.A.B. 1987) (PURITAN for professional dry cleaning machine filters not likely to cause confusion with PURITAN for dry cleaning services sold to public). Additionally, where goods or services move in different channels of trade, confusion as to source is unlikely. See *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 21 U.S.P.Q. 2d 1388 (Fed. Cir. 1992) (no likelihood of confusion between opposer's mark E.D.S. for computer services and applicant's mark EDS for power supplies and battery charges where the respective goods and services were sold to different purchasers within similar markets).

The Applicant's Mark and the Cited Mark are unlikely to be confused for the reasons set forth above, and because the associated services are distinct. Applicant's Mark is associated with medical services aimed to diagnose and treat mental illness whereas Cited Mark is associated with emotional support and personal development services. These are classes of services to which consumers are likely to exercise a heightened degree of care in purchasing. A consumer seeking mental illness diagnosis, treatment, and counseling would not be confused as to the source of those services if they encountered Cited Mark's services for emotional grief support groups and personal development support. Conversely, consumers who are seeking emotional grief counseling and self-improvement would not be confused as to the source of those services if they encountered Applicant's services for medical mental illness diagnosis and treatment.

Therefore, the channels of trade and the conditions under which the respective products are sold are distinct, and the 2(d) refusal should be withdrawn.

## II. Conclusion

Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's Mark and approve the Application for publication. If a telephone call will assist in the prosecution of this Application, the Examining Attorney is invited to call 917-933-3895.

Respectfully submitted,

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