

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jack Henry Spirits, LLC)
Serial No.: 88/095,430)
Mark: HOLA)
Filed: August 28, 2018)
International Class: 33)
Examining Attorney: Omolayo Adebayo)

RESPONSE TO OFFICE ACTION

The following remarks are submitted in response to the Office Action received on October 16, 2019.

I. REMARKS

Under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), the Office Action refused registration of Applicant’s HOLA mark because of an alleged likelihood of confusion with the marks HOLA in U.S. Registration No. 5,676,332 and HOLA SOL in U.S. Registration No. 5,657,452.

As discussed in greater detail below, Applicant amends the identification of goods. Moreover, Applicant respectfully traverses the rejection under Trademark Act Section 2(d) because there is no likelihood of confusion between Applicant’s HOLA mark for distilled blue agave liquor and mezcal and the cited marks HOLA and HOLA SOL for wine.¹

¹ Importantly, Applicant asserts the cited marks are invalid and should never have been registered in the first place, as an exhaustive search could not verify or otherwise determine these marks are actually in use in commerce. For example, the specimens submitted to obtain registration of the cited marks appear to be doctored fakes, potentially created fraudulently. *See Evidence No. 1 – Specimens of Cited Marks*. Furthermore, wines such as those purportedly offered for sale in commerce under the cited marks are subject to strict labeling regulation by the U.S. Department of Treasury’s Alcohol and Tobacco Tax and Trade Bureau (“TTB”) (see <https://www.ttb.gov/wine/labeling>); however, it is clear that the specimens of the cited marks do not comply with these requirements (e.g. no health warning statement, no name and address of importer or bottler, and no sulfite declaration). *See Evidence No. 2 – TTB Wine Labeling Requirements*. Moreover, as search of the TTB’s approved label COLA Registry does not show approval of labels for the wines supposedly offered for sale under the cited marks. *See Evidence No. 3 - TTB Approved Label Search for Labels Including the Term "hola"*. Given these facts, Applicant respectfully asserts that the Trademark Act Section 2(d) rejection is improper because the registrations for the cited marks are void, invalid, and likely fraudulent.

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A. Amendment to the Identification of Goods

Applicant amends the identification of goods in International Class 33 as follows:

Tracked Version of Amended Identification of Goods: ~~Spirits and liqueurs~~ distilled blue agave liquor; mezcal

Clean Version of Amended Identification of Goods: distilled blue agave liquor; mezcal

B. No Likelihood of Confusion with the Cited HOLA and HOLA SOL Marks

Applicant's trademark application is for registration of the mark HOLA in connection with "distilled blue agave liquor; mezcal" in International Class 33, as currently amended herein. The cited prior registrations are for the marks HOLA and HOLA SOL in connection with "wines" in International Class 33.

In determining whether a likelihood of confusion exists, the principal factors are laid out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973). As the Examining Attorney pointed out, two of these factors are the similarity of the marks and the similarity of the goods. Significantly, it is the similarity or dissimilarity of the marks *in their entirety*, and not just a portion of the marks, that is relevant in determining whether a likelihood of confusion exists. *In re National Data Corp.*, 753 F.2d 1056, 1060 (Fed. Cir. 1985). That is, the ultimate determination in a comparison of the marks should rest on the marks *as a whole*. See, e.g., *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915 (CCPA 1976) (TEKTRONIX and DAKTRONICS); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) (RESPONSE and RESPONSE CARD); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS).

1. Applicant's HOLA Mark is Dissimilar from the HOLA SOL Mark

Applicant's HOLA mark and the cited HOLA SOL mark differ in appearance, sound, meaning, and commercial impression. Applicant's HOLA mark is four letters long. In contrast, the cited mark HOLA SOL is seven letters long, including ending with the unshared term "SOL." Additionally, Applicant's mark is two syllables, "HO-LA," whereas the cited HOLA SOL mark is three syllables "HO-LA-SOL." As a result, Applicant's mark and the cited HOLA SOL mark differ with respect to their last syllables, thereby only sharing in common their first two syllables. Thus, Applicant's HOLA mark has a different sound and appearance from the cited HOLA SOL mark thereby ensuring that consumers will readily distinguish between these marks. This is especially the case given that Applicant's mark lacks the term "SOL." Accordingly, Applicant's HOLA mark and the cited HOLA SOL mark, taken as a whole, do not give rise to a likelihood of confusion because they do not have potentially confusing literal and phonetic similarities.

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Moreover, the marks differ in meaning and connotation. Applicant's HOLA mark is of Spanish origin which, as the Examining Attorney has pointed out in a prior Office Action, translates to "hello" in English. In contrast, the translation of the cited mark HOLA SOL is "hello sun". See *Evidence No. 1 – Google Translation of "hola sol."* Furthermore, the registration certificate for the HOLA SOL mark indicates this same translation. See *Evidence No. 2 – Registration Certificate of HOLA SOL*. Nevertheless, the Office Action asserts that HOLA SOL has "a similar sound, appearance, and connotation, thus creating a similar overall commercial impression"; however, Applicant respectfully asserts that the Office Action's evidence of this similarity is insufficient, if not entirely unsubstantiated. Given these differences, the cited HOLA SOL mark provides a connotation and commercial impression that differs from Applicant's HOLA mark. Accordingly, because the marks have different meanings and commercial impressions, consumers are not likely to be confused. See *Aries Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926, 1932 (TTAB 1993).

2. Applicant's Goods are Dissimilar from the Goods of the Cited Marks

There is no *per se* rule that goods or services sold in the same field or industry are similar or related for purposes of likelihood of confusion. See *Cooper Industries, Inc. v. Repcoparts USA, Inc.*, 218 USPQ 81, 84 (TTAB 1983); *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993) (reversing likelihood of confusion cancellation of LLOYD's for barbecued meats based on LLOYD's for restaurant services).

Here, the relevant goods of the respective marks are neither identical, nor overlapping. Although both identifications of goods relate to the broad product category of alcoholic beverages, Applicant's identified "distilled blue agave liquor; mezcal" goods do not overlap with the goods of the cited marks, namely "wine." The Office Action asserts the respective goods could give rise to the mistaken belief that they emanate from the same source. However, just because such goods may emanate from the same source does not mean that they do in this case with respect to Applicant's HOLA mark and the cited marks. Quite the contrary, the cited marks cover "wine" but not "distilled blue agave liquor; mezcal," thus the likely inference is that the common owner of the registrations of the cited marks does not market alcoholic beverages other than wine under that mark. Conversely, Applicant's HOLA mark covers "distilled blue agave liquor; mezcal" but not "wines" and Applicant does not intend to market wines under its HOLA mark. In this case, relevant consumers are not likely to be confused because they would be able to distinguish between wines sold under the cited marks and distilled blue agave liquor and mezcal sold under the Applicant's mark. Accordingly, the Trademark Act Section 2(d) rejection should be withdrawn.

II. CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that its HOLA mark is entitled to registration and requests that it be promptly allowed for publication. If the Examining Attorney requires any changes in the application that could be made by an Examiner's Amendment, Applicant respectfully requests that the Examining Attorney contact Applicant's attorney of record.

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Respectfully submitted,

/Seth W. Black/

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