To:	Alejandro García Pérez (JeffMFurr@FurrLawFirm.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 79165761 - OKENE - N/A
Sent:	11/17/2015 6:52:15 PM
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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 79165761

MARK: OKENE

79165761

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CORRESPONDENT'S REFERENCE/DOCKET NO :
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OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 11/17/2015

INTERNATIONAL REGISTRATION NO. 1248516

The Office has reassigned this application to the undersigned trademark examining attorney.

INTRODUCTION

This Office action is in response to applicant's communication filed on October 27, 2015 , where applicant:

- Provided arguments against the Section 2(d) Refusal
- Amended the identification of goods
- Partial Refusal and Requirement Advisory
- Partial Abandonment Advisory

The trademark examining attorney has thoroughly reviewed applicant's response and has determined the following:

- Applicant's argument s are unpersuasive to overcome the Section 2(d) refusal, and the refusal is **continued and maintained**
- Applicant's amended identification for Class 25 is acceptable and made of record
- Applicant's amended identification for Class 5 still contains indefinite wording. As certain amendments were not previously required, there are **new issues** concerning the Class 5 identification to which applicant must respond

The trademark examining attorney issues the following **new** requirement in the summary of issues below. *See* 37 C.F.R. §2.64(a); TMEP §714.04. The trademark examining attorney's arguments and evidence from the initial Office action are incorporated by reference.

SUMMARY OF NEW ISSUES that applicant must address:

- Identification of Goods Requirement – Specified Class 5 Goods Only
- Advisory – Response to Applicant's Arguments against the Section 2(d) Refusal

IDENTIFICATION OF GOODS REQUIREMENT – CLASS 5 ONLY

Applicant's Class 5 identification, as amended, is "Oils for medical use, namely, lavender oil; medicinal oils for babies; poultices; herbal compounds for medicinal use; decoctions of medicinal plants; decoctions for pharmaceutical use for treating the colic of infants; homeopathic drugs for treating the colic of infants; medicinal herbal extracts; plant extracts for pharmaceutical use; medicinal plant extracts".

The wording "Oils for medical use, namely, lavender oil" in the identification of goods must be clarified because it is too broad and could include goods in other international classes. *See* TMEP §§1402.01, 1402.03. Specifically, "lavender oil" is classified in Class 3. Although the identification specifies that the goods are for medical use, applicant must more precisely specify that the goods are medicated or medicinal, or specify what disease or condition the oils are intended to treat to ensure that the goods are correctly classified.

The wording "herbal compounds for medicinal use" in the identification of goods is indefinite and must be clarified because the nature of the compounds is unclear. *See* TMEP §1402.01. "Compounds" could refer to, for instance, a drug delivery agent, a pharmaceutical compound, a disinfecting compound, or a rubbing compound. Applicant must identify the type of compound with more specificity.

The wording "decoctions of medicinal plants" in the identification of goods is indefinite and must be clarified because it does not specify the disease or condition to be treated. *See* TMEP §1402.01. Applicant must indicate the intended use of the decoctions.

Applicant may adopt the following identification of goods, if accurate:

- **International Class 5:** Oils for medical use, namely, **medicinal** lavender oil; medicinal oils for babies; poultices; herbal **rubbing** compounds for medicinal use; decoctions of medicinal plants **for treating the colic of infants**; decoctions for pharmaceutical use for treating the colic of infants; homeopathic drugs for treating the colic of infants; medicinal herbal extracts; plant extracts for pharmaceutical use; medicinal plant extracts
- **International Class 25:** Clothing for babies, namely pajamas; children's clothing, namely, pajamas **[acceptable as written]**

See TMEP §1402.01.

An applicant may only amend an identification to clarify or limit the goods, but not to add to or broaden the scope of the goods. 37 C.F.R. §2.71(a); *see* TMEP §1904.02(c)(iv). In an application filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau). 37 C.F.R. §2.85(f); TMEP §§1402.07(a), 1904.02(c). If an applicant amends an identification to a class other than that assigned by the International Bureau, the amendment will not be accepted because it will exceed the scope and those goods will no longer have a basis for registration under U.S. law. TMEP §§1402.01(c), 1904.02(c).

In addition, in a Section 66(a) application, an applicant may not change the classification of goods from that assigned by the International Bureau in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1402.01(c). Further, in a multiple-class Section 66(a) application, an applicant may not transfer goods from one existing international class to another. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1402.01(c).

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable *U.S. Acceptable Identification of Goods and Services Manual* at http://tess2.uspto.gov/netahtml/tidm.html. *See* TMEP §1402.04.

SECTION 2(D) REFUSAL – CONTINUED AND MAINTAINED

Because applicant's arguments against the Section 2(d) refusal are not persuasive, the Section 2(d) refusal is **continued and maintained.** The trademark examining attorney has provided a preliminary response to applicant's arguments below.

Response to Arguments

Concerning the similarity of the marks, the standard for assessing whether the marks are similar is based on the overall impression of the marks, not specific differences. When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112

USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon* , 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

Applicant first argues that the marks are not confusing because they are dissimilar in appearance. Although the marks are not identical, they are confusingly similar in appearance because both marks begin with the identical and unusual letter combination "OKE". Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions).

In this case, purchasers with a general recollection of the marks are unlikely to recall the particular spelling of the marks, but will remember marks with wording that begins with the distinctive "OKE" letter combination. Thus, despite the particular differences in spelling, the overall appearance of the marks is similar.

Applicant also argues that the marks will be pronounced differently because applicant's mark is likely to be pronounced as a three-syllable word, O-KEH-NE, rather than the two-syllable O-KEEN. This argument is unconvincing because purchasers may *not* pronounce applicant's mark as applicant suggests. There is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. *See Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *In re The Belgrade Shoe Co.*, 411 F.2d 1352, 1353, 162 USPQ 227, 227 (C.C.P.A. 1969)); TMEP §1207.01(b)(iv).

Both "-EAN" and "-E[consonant]E" are common spellings of a long "e" sound. The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.* , 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Finally, applicant argues that the goods and trade channels are different because applicant sells children's pajamas, which would be sold at children's stores, but registrant sells shoes, which would be sold at shoe stores. However, neither the application nor the registration contains any limitations regarding trade channels for the goods and therefore it is assumed that registrant's and applicant's goods are sold everywhere that is normal for such items, i.e., clothing and department stores. Thus, it can also be assumed that the same classes of purchasers shop for these items and that consumers are accustomed to seeing them sold under the same or similar marks. *See Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); TMEP §1207.01(a)(iii). Moreover, children's clothing stores commonly sell children's shoes as well clothing. As registrant has broadly identified "shoes," a term that encompasses children's shoes, applicant's and registrant's trade channels are likely to overlap, despite the limitations in applicant's identification. Also, children's clothing manufacturers commonly produce and sell both children's pajamas and children's shoes under the same mark. Thus, purchasers are accustomed to encountering both applicant's and registrant's goods emanating from the same source.

The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988). As applicant has not overcome doubt regarding the likelihood of confusion, the refusal is **continued and maintained.**

PARTIAL REFUSAL AND REQUIREMENT ADVISORY

The Section 2(d) refusal refers to International Class25 only and does not bar registration in the other class.

The stated refusal refers to the following goods and does not bar registration for the other goods: "Oils for medical use, namely, lavender oil; herbal compounds for medicinal use; decoctions of medicinal plants".

Applicant may respond to the stated refusal by submitting evidence and arguments against the refusal. In addition, applicant may respond by doing one of the following:

(1) Deleting the class and goods to which the refusal and requirement pertains; or

(2) Filing a request to divide out the goods that have not been refused registration, so that the mark may proceed toward publication for opposition in the class to which the refusal does not pertain. *See* 37 C.F.R. §2.87. *See generally* TMEP §§1110 *et seq*. (regarding the requirements for filing a request to divide). If applicant files a request to divide, then to avoid abandonment, applicant must also file a timely response to all outstanding issues in this Office action, including the refusal. 37 C.F.R. §2.87(e).

PARTIAL ABANDONMENT ADVISORY

If applicant does not respond to this Office action within the six-month period for response, the following goods in International Classes 5 and 25 will be deleted from the application: "Oils for medical use, namely, lavender oil; herbal compounds for medicinal use; decoctions of medicinal plants" in Class 5; "Clothing for babies, namely pajamas; children's clothing, namely, pajamas" in Class 25 (entire class will be deleted). The application will then proceed with the following goods in International Class 5 only: "Medicinal oils for babies; poultices; decoctions for pharmaceutical use for treating the colic of infants; homeopathic drugs for treating the colic of infants; medicinal herbal extracts; plant extracts for pharmaceutical use; medicinal plant extracts." *See* 37 C.F.R. §2.65(a)-(a)(1); TMEP §718.02(a).

RESPONSE GUIDELINES

For this application to proceed toward registration, applicant must explicitly address each refusal and requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options for responding to a refusal and should consider such options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements.

If applicant does not respond to this Office action within six months of the issue/mailing date, or responds by expressly abandoning the application, the application process will end, the trademark will fail to register, and the application fee will not be refunded. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a), 2.209(a); TMEP §§405.04, 718.01, 718.02. Where the application has been abandoned for failure to respond to an Office action, applicant's only option would be to file a timely petition to revive the application, which, if granted, would allow the application to return to active status. *See* 37 C.F.R. §2.66; TMEP §1714. There is a $100 fee for such petitions. *See* 37 C.F.R. §§2.6, 2.66(b)(1).

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal and requirement in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

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All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at http://tsdr.uspto.gov/. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

IMPORTANT NOTICE REGARDING YOUR U.S. TRADEMARK APPLICATION

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **11/17/2015** FOR U.S. APPLICATION SERIAL NO. 79165761

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(1) TO READ THE LETTER: Click on this link or go to http://tsdr.uspto.gov, enter the U.S. application serial number, and click on "Documents."

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(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **11/17/2015** (*or sooner if specified in the Office action*). For information regarding response time periods, see http://www.uspto.gov/trademarks/process/status/responsetime.jsp.

Do NOT hit "Reply" to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the ABANDONMENT of your application. For more information regarding abandonment, see http://www.uspto.gov/trademarks/basics/abandon.jsp**.**

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