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December 14, 2010

Ms. Elissa Garber Kon
Trademark Examining Attorney
Law Office 106

Re: Response to Office Action dated 6/14/2010 on Application of Raymond
Jáquez to Register DE MI PAIS SALVADORENO, Serial No. 77690836

Dear Ms. Kon:

I write on behalf of Mr. Raymond Jáquez in response to the above Office Action.

As you may recall, applicant has applied to register DE MI PAIS
SALVADORENO in international class 029 for “processed beans” Registration has been
provisionally refused under Trademark Act §2(d), 15 U.S.C. §1052(d), on the ground that
DE MI PAIS SALVADORENO, when used on or in connection with the identified
products, so resembles:

Global Barlic, Inc.’s (“Global”) mark DE MI PAIS[®], registered in
class 030 for “Bread” and class 031 for “Unprocessed beans”

Because of a likelihood of confusion and that the applied-for-mark so resembles a
registered mark that it is likely that a potential consumer would be confused or mistaken
or deceived as to the source of the goods and/or services of the applicant and registrant.
See 15 U.S.C. §1052(d).

In support of its position that DE MI PAIS SALVADORENO should be
registered, Applicant makes the arguments set forth below:

Section 2(d) Refusal: There is No Likelihood of Confusion Between DE MI PAIS
SALVADORENO and DE MI PAIS of Global.

In re E.I. DuPont de Nemours & Co., 476 F.2d 1357 (C.C.P.A. 1973), enumerates
thirteen factors an Examining Attorney may consider in evaluating likelihood of
confusion under Section 2(d) of the Trademark Act. Several of these factors clearly
support Applicant’s conclusion that Global’s DE MI PAIS mark cited in the Office
Action.

A. Likelihood of Confusion with Global's DE MI PAIS.

B. The marks are Dissimilar in Sight, Sound and Meaning.

A primary factor in a likelihood of confusion analysis is the "similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. See *In re E.I. DuPont de Nemours*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) and *In re Hearst Corp.*, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir 1992)(When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely.); *In re Electrolyte Labs, Inc.*, 16 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990)("No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone."). The first factor to be considered is the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression. Applying this factor to DE MI PAIS SALVADORENO clearly indicates that it will not be confused with DE MI PAIS. Applicant presents the following arguments with respect to DE MI PAIS SALVADORENO.

First, while the appearance of the leading components of Applicant's mark, DE MI PAIS SALVADORENO is visually somewhat similar to the appearance of DE MI PAIS, Applicant respectfully submits that DE MI PAIS is in fact a commonly used term that rises to a level of a colloquialism or cliché' in common usage as an assertion of patriotism and allegiance. In this regard, the scope of protection granted to Global's mark DE MI PAIS should be weak as it is neither suggestive nor arbitrary in nature. In contrast, Applicant respectfully submits that the addition of SALVADORENO is distinct relative to Global's DE MI PAIS so as to immediately distinguish DE MI PAIS SALVADORENO from DE MI PAIS. Further, the brevity of DE MI PAIS mark distinguish its application and past use.

Second, Applicant's DE MI PAIS SALVADORENO mark has distinct additional sounds/syllables of "SAL", "VA" and "DORENO" sounds that are phonetically distinct from the DE MI PAIS mark.

Third, Applicant's DE MI PAIS SALVADORENO mark has a different connotation than DE MI PAIS because Applicant's use of "SALVADORENO" is a significant departure in specificity from that of Global's DE MI PAIS wherein the term is vague and undefined relative to these Global's product.

For all of these reasons, Applicant's DE MI PAIS SALVADORENO mark creates a distinct and dissimilar general impressions that fosters a distinct commercial impressions in the minds of consumers such that Applicant's DE MI PAIS SALVADORENO mark is not likely to be confused with Global's DE MI PAIS.

1. Applicant's DE MI PAIS SALVADORENO Looks and Sounds Dissimilar From Global's DE MI PAIS.

When assessing the appearance and sound of marks, the similarity in appearance for a word mark arises from the overall impression of the word or words composing the mark. See *In re White Swan Ltd.*, 8 U.S.P.Q. 2d 1534, 1535 (TTAB

1988). Marks at issue must be compared in their entirety. See *In re Electrolyte Labs., Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990).

As such, likelihood confusion is not automatic when a junior user's mark includes part or all of a senior user's mark. See *General Mills, Inc. V. Kellog Co.*, 824 F.2d 622, 627 (8th Cir. 1987) which states the "The use of identical, even dominant words in common does not automatically mean that two marks are similar;" OATMEAL RAISEN CRISP and APPLE RAISEN CRISP, both for cereal, not confusingly similar. *Iowa Paint Mfg. Col, Inc. V. Hirshfield's Paint Mfg., Inc.*, 296 F. Supp. 2d 983 (S.D. Iowa 2003) "confusion is not automatically likely where a junior user has a mark that contains in part the whole of another's mark;" PROWALL and PRO-WALL, both for paint not confusingly similar. *Alltel Corp. v. Actel Integrated Communications, Inc.*, 42 F. Supp. 2d 1265, 1271 (S.D. Ala. 1999) Use of an identical word is not dispositive, especially if the word would naturally be used in association with a particular product." Similarly, it was held in *In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364 (T.T.A.B. 1974), for example, the court held that MMI MENSWEAR for "fashion consulting and promotional services, including investigations, analyses and predictions concerning fashion trends and development in the mean's ready wear field" was not confusingly similar to MEN'S WEAR for a "semimonthly [fashion] magazine." In addition, in *Colgate-Palmolive Co. v. Carter Wallace, Inc.*, 432 F.2d 1400 (C.C.P.A. 1970), the court held that PEAK PERIOD for deodorant was not confusingly similar to PEAK for dentifrice. The court noted:

We agree with the board that the mere presence of the word "peak" in the trademark PEAK PERIOD does not by reason of that fact alone create a likelihood of confusion or deception. That determination must arise from a consideration of the respective marks in their entireties. The difference in appearance and sound of the marks in issue is too obvious to render detailed discussion necessary. In their entireties they neither look nor sound alike.

Id. At 1402.

Applicant also draws the Examiner's attention to the previously registered mark MI PAIS, U.S. Registration No. 3251212 registered on June 12, 2007 and before the filing of Global's DE MI PAIS.

These principles compel the conclusion that Applicant's mark DE MI PAIS SALVADORENO will not cause confusion with Global's DE MI PAIS mark, when viewed in its entirety. See *Gruner + Jahr USA Publ'g v. Meredith Corp.*, 991 F.2d 1072 (2d Cir. 1993). PARENTS and PARENTS DIGEST not confusingly similar for magazines; *Plus prods. V. General Mills*, 188 U.S.P.Q. 520 (T.T.A.B. 1975). PROTEIN PLUS for breakfast cereal not confusingly similar to PLUS for vitamins and minerals; *In re Ferraro*, 479 F.2d 1395 (C.C.P.A. 1973) TIC TAC for candy not confusingly similar to TIC TAC TOE for ice cream and sherbet; *Lever Bros. Co. v. Barcelone Co.* 463 F.2d 1107 (C.C.P.A. 1972); ALL CLEAR for household cleaner not confusingly similar to

ALL for household cleansing products. Alltel, 42 F. Supp. 2d at 1271 similarly found ALLTEL and ACTEL not confusingly similar for telephone services; In re the Mercy Hospital of Pittsburgh, 2002 WL 432957, *3 (T.T.A.B. 2002) wherein OPERATION SAFETY NET and SAFETY NET not confusingly similar for providing different types for health care services for needy patients. This single difference alone is dispositive on likelihood of confusion and in particular “especially when that single factor is the dissimilarity of the marks,” as held in CRYSTAL CREEK AND CRISTAL CHAMPAGNE, both for wines, were not confusingly similar.

Second, as alluded to above, Applicant’s DE MI PAIS SALVADORENO mark is distinguishable from Global’s DE MI PAIS because the pronunciation or sound of each mark is significantly different. As in the case with the appearance of these marks, the mere fact that both incorporate a common word does not render them similar in sound. See Bell Labs., Inc. v. Colonial Prods., Inc., 644 F. Supp.542, 546-47 (S.D. Fla. 1986) (FINAL FLIP and FINAL for same product are “ultimately different and different sounding”). Similarly, minor additions to a mark that include a common term, can dispel any confusing similarity between the marks. See Ocean Bio-Chem Inc. v. Turner Network Television, Inc., 741 F. Supp. 1546, 1557 (S.D. Fla. 1990)(STARBRITE BATTERIES and STAR BRITE not confusingly similar sounding when subjected to an auditory characteristics test due to the addition of the word “Batteries”). The inclusion of “DE MI PAIS SALVADORENO” at the conclusion of Applicant’s mark adds five distinct syllables that create a different sound from the abbreviated DE MI PAIS.

2. The DE MI PAIS SALVADORENO Mark is Distinct in Meaning and Commercial Impression From Global’s DE MI PAIS.

Applicant’s DE MI PAIS SALVADORENO mark is not likely to be confused with Global’s DE MI PAIS for the following additional reason: as per above, the common element between the marks is weak. The cumulative effect of this difference, coupled with the visual and aural dissimilarities, is that the marks create completely different commercial impressions.

The likelihood of confusion between DE MI PAIS SALVADORENO and DE MI PAIS is unlikely because the component “DE MI PAIS,” is the weaker element of the marks, while “SALVADORENO” is a dominant element that completes an open ended mark. When an element of a mark, such as “DE MI PAIS” is in widespread usage, the scope of protection given that element must necessarily be narrower. Extensive third party registrations should be given considerable weight in determining the strength of a mark. Ocean Bio-Chem, 741 F. Supp. At 1556. Thus, even though a mark must be assessed as a whole, a dominant portion of a trademarks is entitled to greater weight. See Universal Money Ctrs. V. AT&T, 22 F.3d 1527, 1531 (10th Cir. 1994) (AT&T UNIVERSAL CARD for combination telephone and retail credit card and UNIVERSAL MONEY CARD for a plastic debit card are not confusingly similar for phone services).

Applicant respectfully submits that the above arguments are reasoned, thorough and show that Applicant’s DE MI PAIS SALVADORENO mark can be placed onto the

principal register without creating a likelihood of confusion with Global's DE MI PAIS due to the brevity, common usage and weak nature of DE MI PAIS. Applicant respectfully submits that Applicant's visual (extended word and family basis related) and sound (addition of a five syllable closing word has a distinctively different sound) render a distinct impression that bars a likelihood of confusion even with the common term DE MI PAIS.

2. Conclusion

For the reasons set forth above, Applicant requests that its application to register the mark DE MI PAIS SALVADORENO on the Principal Register be approved for publication.

It is sincerely hoped that this letter adequately addresses the matters raised in the Office Action. If anything further is needed in order to approve this application for publication, please call on contact me at the number/address below:

Respectfully submitted,

/Harold G. Furlow/

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