

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Plaza Izalco, Inc.

Serial No.: 86/029,611

Mark: COFAL

Law Office 108
Jason F. Turner, Examiner

2800 S.W. Third Avenue
Historic Coral Way
Miami, Florida 33129

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir:

Responsive to the Office Action dated February 1, 2016, Applicant submits the following:

REQUEST FOR RECONSIDERATION

The Examining Attorney has issued a final action contending that the Applicant's mark, "COFAL" is likely to cause confusion with the mark shown in U.S. Registration No. 3,540,972, namely, "KOFAL-T" for use in connection with analgesic balm. Applicant appreciates the opportunity to respond, and submits that there is no likelihood of confusion based upon the differences the Applicant's mark and the mark shown in the cited registration and the weak nature of the term "KOFAL-T".

As the latest objection has been made final, the Applicant has enclosed a Notice of Appeal, as well as the required fee, in the event the following arguments fail to persuade the Examining Attorney.

R E M A R K S



08-05-2016

I. NO LIKELIHOOD OF CONFUSION.

As set forth in In re E.I. DuPont de Nemours, 177 USPQ 563 (TTAB 1973), several factors must be considered in deciding whether or not to allow the registration of a mark, including:

- (1) The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression; and
- (2) The number and nature of similar marks in use on similar goods. Id.

As discussed below, a close examination of these factors reveals that the Applicant's "COFAL" mark is unlikely to be confused with the registered "KOFAL-T" marks.

A. DISSIMILARITY OF THE MARKS IN THEIR ENTIRETIES.

When examining two marks, attention is properly focused on the impression that a mark as a whole makes on the consumer. 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §23.41 (2007). Further still, more weight may be given to a particular word or feature of a mark when that word or feature has a greater impact in creating a commercial impression than any other word or feature. *In re Kayser-Roth Corp.*, 29 USPQ2d 1379, 1385 (TTAB 1993); *Kangol, Ltd., v. KangaROOS U.S.A., Inc.*, 794 F.2d 161, 23 USPQ2d 1945 (C.A.F.C. 1992). Therefore, it is well settled that if the common element of two marks is "weak" in that it is merely descriptive (or a surname) it is unlikely that consumers will be confused unless the overall combinations have other commonality. See TMEP 1207.01(b)(viii).

The marks being compared in this case are "COFAL" and "KOFAL-T." As previously noted, the PTO has taken the position that "KOFAL" is primarily merely a surname and, therefore, conditioned the right of a party to register this term on a showing of acquired distinctiveness. See **Exhibits A and B** to Applicant's initial Response. The Examining Attorney neither disputes that the phrase KOFAL is primarily merely a surname nor provides any evidence that COFAL is also a surname. Instead, the Examining Attorney contends that "the mere deletion of wording from a registered mark [is] not sufficient to overcome a likelihood confusion." Unlike the case cited by the Examining Attorney for this proposition (which compared "OPTIQUE" and "OPTIQUE BOUTIQUE") the marks being compared in this case do not incorporate the identical term. *In re Optica Int'l*, 1977 TTAB LEXIS 119 (Trademark Trial & App. Bd. 1977); see also *In re Mighty Leaf Tea*, 601 F.3d 1342 (Fed. Cir. 2010) (comparing "ML" to "ML MARK LEES"). Accordingly, this argument is inapposite to this case.

It is axiomatic that a significant distinctiveness can be created even if the marks in question differ only with respect to a single letter. See e.g., *Champagne Louis Roederer S.A.*, 47 USPQ2d 1459 (Fed. Cir. 1998) (CRISTAL and CRYSTAL CREEK on identical goods not conflicting); *In re Hearst Corp.*, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992) (THE VARGA GIRL was sufficiently different from the registered mark VARGAS to permit registration, even when the marks were for virtually identical products); *Jacobs v. International Multifoods Corporation*, 212 USPQ 641 (C.C.P.A. 1982) (BOSTON SEA PARTY and BOSTON TEA PARTY);

Like the surname "KOFAX", the term "KOFAL" invites a distinct phonetic pronunciations than "coffee", "coffers", "coffin", or "COFAL." These distinctions are even more pronounced when one considers the inclusion of the "T" (which comprises the third syllable in the cited registrant's mark.) In addition to creating visual and phonetic distinctions, the presence of the "K" and "T" in "KOFAL-T" relay a distinct connotation that alters the meaning of the mark entirely. Specifically, while "KOFAL" relays the impression of a surname, the phrase KOFAL-T conveys the commercial impression of a personal name. See TMEP 1211.01(b)(iii) (holding that the combination of a surname with an initial (such as "T") "generally conveys the impression of a personal name"); see also *In re P.J. Fitzpatrick*, 95 USPQ2d 1412, 1414 (TTAB 2010) (holding that the initials P.J. coupled with surname Fitzpatrick would be perceived as a given name). Thus, the commercial impression relayed by the Applicant's mark is distinct to that conveyed by the registrant's KOFAL-T mark.

For the foregoing reasons, Applicant respectfully submits that the dissimilarity between the marks in appearance, sound, and meaning will allow consumers to readily distinguish between "COFAL" and "KOFAL-T". See *Champagne Louis Roederer S.A.*, 47 USPQ2d at 1459 ("CRISTAL" and "CRYSTAL CREEK" on identical goods not conflicting).

II. CONCLUSION.

It is respectfully asserted that no likelihood of confusion will ensue due to the distinct connotations and commercial impression relayed by the respective marks. Having addressed the Examining

Attorney's concerns, Applicant asserts that the Application is now in condition to be passed to publication, and the same is respectfully requested.

Respectfully submitted,

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By: /s/Francisco J. Ferreiro
Francisco J. Ferreiro

Date: August 1, 2016

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Dear Madam:

CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451 Alexandria, VA 22313-1451, this 1st day of August 2016.

Respectfully submitted,

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