

Gemini-AI input

Our law school legal clinic assisted a client to file a registration application for a trademark. Recently the USPTO issued a non-final Office Action denying registration.

It was stated in the Office Action that the main reason for denial was likelihood of confusion, namely, that our client's applied-for mark is so similar to a previously registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the services of the parties.

SUMMARY OF OUR CLIENT'S APPLICATION:

Our client wants to register the following standard character mark:

"MISS Q COFFEE". The serial number assigned by the USPTO is 98866557. The application stated that the goods and services to be sold were described as follows:

Class 030: Coffee; Coffee and coffee substitutes; Coffee based beverages; Coffee beans; Coffee capsules containing coffee for brewing; Coffee capsules, filled; Coffee drinks

Class 043: Coffee shop services; Coffee shops

SUMMARY OF PREVIOUSLY REGISTERED MARK

According to the Office Action the previously registered mark "MISS Q" registration number: 98697038. In the registration certificate the description of the goods being sold was stated as follows:

CLASS 5: Medicinal herbs; Herbs for medicinal purposes; Medicinal herb extracts, other than essential oils; Plant and herb extracts, other than essential oils, for medicinal purposes; Preparation for the relief of pain; Pain relief medication; Muscle-rub preparations for the relief of pain; Herbal tinctures for medical purposes. Herbal teas for medicinal purposes; Medicinal teas; Moxa sticks for moxibustion

SUMMARY OF OFFICE ACTION REASONING.

In the Office Action the examining attorney alleged that the goods and services being sold were similar. He said the following:

Here, applicant's goods and services, "Coffee; Coffee and coffee substitutes; Coffee based beverages; Coffee beans; Coffee capsules containing coffee for brewing; Coffee capsules, filled; Coffee drinks," and "Coffee shop services; Coffee shops" are closely related to registrant's goods in the previously registered mark, namely, "Herbal teas for

medicinal purposes; Medicinal teas.”

What would be the best approach in responding to the Office Action?

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Based on the information provided, the best approach to responding to the Office Action would involve arguing against the likelihood of confusion, specifically challenging the examining attorney's assertion that the goods and services are "closely related." Here's a breakdown of the key arguments and a strategic approach:

Core Argument: Lack of Relatedness Between Goods/Services

The fundamental flaw in the examining attorney's reasoning is the leap from "Coffee" and "Coffee shop services" to "Herbal teas for medicinal purposes; Medicinal teas." These are generally not considered related goods or services in a way that would lead to a likelihood of confusion for consumers.

Detailed Arguments to Develop:

1. **Distinct Commercial Impressions and Target Consumers:**
 - **"MISS Q COFFEE":** Evokes a common beverage and social experience. Target consumers are those seeking a general refreshment, social gathering, or daily caffeine fix.
 - **"MISS Q" (for medicinal teas/herbs):** Evokes health, wellness, and therapeutic benefits. Target consumers are likely those seeking remedies for ailments or specific health benefits.
 - The purchase motivations and contexts are entirely different. One is for enjoyment and social interaction; the other is for health and medicinal purposes.
2. **Difference in Trade Channels and Marketing:**
 - **Coffee/Coffee Shops:** Sold in cafes, grocery stores, restaurants, and dedicated coffee shops. Marketing emphasizes taste, aroma, atmosphere, and lifestyle.
 - **Medicinal Teas/Herbs:** Typically sold in pharmacies, health food stores, specialty health clinics, or online wellness platforms. Marketing focuses on health benefits, ingredients, and medicinal claims.
 - Consumers would not expect to find medicinal teas in a coffee shop, nor

would they expect to find regular coffee or coffee shop services in a pharmacy or a dedicated medicinal herb store.

3. **Absence of Overlap in Function or Purpose:**

- The primary function of coffee is as a beverage for consumption, energy, or social enjoyment.
- The primary function of "herbal teas for medicinal purposes" and "medicinal teas" is to provide health benefits or treat ailments. While both are "teas" in a broad sense, their *purpose* is entirely distinct. The presence of the word "medicinal" is crucial here.

4. **Sophistication of Consumers (if applicable):** While perhaps not the strongest standalone argument, you could subtly suggest that consumers purchasing medicinal products are often more discerning and less likely to be confused about the source of a therapeutic good versus a general beverage.

5. **Weakness of "Tea" as a Connecting Factor:** The examining attorney's connection relies solely on the loose category of "tea." However, "herbal teas for medicinal purposes" and "medicinal teas" are significantly different from "coffee" and coffee-related goods/services. It's akin to saying "fruit juice" and "medicinal cough syrup" are related because both are liquids derived from plants.

Strategic Approach to the Response:

1. **Clearly State Disagreement:** Begin by clearly stating that the client disagrees with the finding of likelihood of confusion.
2. **Address Each DuPont Factor (Implicitly/Explicitly):** While the Office Action focuses on relatedness of goods, you should implicitly or explicitly address the *DuPont* factors for likelihood of confusion, particularly:
 - **Similarity of the marks:** Acknowledge the "MISS Q" element but argue that the addition of "COFFEE" significantly alters the commercial impression, especially when combined with the distinct goods/services.
 - **Similarity or Relatedness of the Goods/Services:** This is your strongest argument. Elaborate on all the points above regarding distinctness.
 - **Similarity of Trade Channels:** Emphasize the differences in how the goods are marketed and sold.
 - **Conditions of Sale and Sophistication of Purchasers:** Argue that consumers are unlikely to be confused given the distinct nature of the products.
 - **Fame of Prior Mark (if applicable):** If the prior "MISS Q" mark is not famous, you can state that, as fame would increase the likelihood of confusion. (Assume it's not famous unless you have information to the contrary).
3. **Provide Evidence (if possible, though often not needed for this type of**

argument):

- You likely won't need extensive evidence for this type of argument, but if you can find any third-party registrations for "coffee" or "coffee shops" that co-exist with "medicinal tea" marks without confusion, it could be mildly supportive. However, the primary focus should be on the inherent differences.
4. **Emphasize the Commercial Context:** Always bring the argument back to how consumers actually perceive and interact with these products in the marketplace.
 5. **Request Reconsideration:** Conclude by formally requesting reconsideration of the Office Action and withdrawal of the refusal.

Example Snippets for Your Response:

- "The Examining Attorney asserts that Applicant's goods and services are closely related to Registrant's goods, specifically stating a connection between 'Coffee' and 'Coffee shop services' with 'Herbal teas for medicinal purposes; Medicinal teas.' Applicant respectfully disagrees with this assertion, as the goods and services in question are commercially distinct and occupy entirely different market segments."
- "Consumers purchasing 'Coffee' and utilizing 'Coffee shop services' do so for reasons of refreshment, enjoyment, and social interaction.¹ Conversely, consumers seeking 'Herbal teas for medicinal purposes' or 'Medicinal teas' are primarily motivated by health concerns and the desire for therapeutic benefits.² These divergent motivations lead to distinct commercial impressions and expectations."
- "The channels of trade for coffee and coffee shop services are vastly different from those for medicinal herbs and teas. Coffee is ubiquitous in cafes, restaurants, and grocery stores, while medicinal teas are typically found in pharmacies, health food stores, or specialized wellness outlets. There is no natural overlap in these distribution channels that would lead to consumer confusion."

By focusing on the fundamental differences in the nature, purpose, trade channels, and consumer perceptions of these goods and services, you can build a strong case against the likelihood of confusion and overcome this Office Action.