

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : TRIDENT GROUP LLC
SERIAL NO.: 85/934085
LAW OFFICE: 106
EXAMINER : Sara N. Benjamin
MARK : SUBZERO

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

RESPONSE TO OFFICIAL ACTION
DATED September 7, 2013

SUBSTANTIVE REMARKS

In the September 7, 2013 Official Action, the Examining Attorney has initially refused registration of Applicant's mark, Application No. 85/934085 for the mark SUBZERO ("Applicant's Mark"), as used in with the connection with Applicant's electronic cigarette Goods because of a likelihood of confusion with the following marks:

1. Registration No. 3,454,970 owned by Blunt Wrap U.S.A., a Louisiana corporation for the mark ZERO, as used in connection with tobacco products and accessories, namely, cigars, rolling papers made out of paper and/or tobacco for cigarettes and/or

papers made out of paper and/or tobacco for cigarettes and/or cigars, and pre-rolled tobacco shells, tobacco sheets, snuff, and or cigarette papers in Class 34. ("Cited Registration #1").

2. Registration No. 4,374,558 owned by Zero Cig DBA Zerocig.com, a California corporation for the mark ZEROCIG, as used in connection with electronic cigarettes containing tobacco substitutes not for medical purposes that utilize electronic cigarette chargers and not lighters; electronic cigarettes for use as an alternative to traditional cigarettes that utilize electronic cigarette chargers and not lighters; smokeless cigarette vaporizer pipes that utilize electronic cigarette chargers and not lighters in Class 34. ("Cited Registration #2").

In view of the following arguments, however, Applicant respectfully submits that it has traversed the Examining Attorney's objections and submits that Applicant's Mark is not likely to be confused with the above Cited Registrations in view of the clear difference in sight, sound and commercial impression. Reconsideration is respectfully requested.

ARGUMENT

A. Standard On Likelihood of Confusion

The Court in In re E.I. Du Pont De Nemours & Co., 476 F.2d 1357 (C.C.P.A 1973), articulated the principal factors to consider in determining whether there is a likelihood of confusion between two marks. Chief factors being the similarity of the marks in their entireties as to appearance, sound and commercial impression, similarity or dissimilarity of the goods, and the nature of similar marks in use on similar goods. Id. See 3 J.T., McCarthy, Trademarks and Unfair Competition, Section 23:79 (4th ed. 2001).

There is no hard and fast rule that likelihood of confusion must automatically be found to exist if there is a similarity in any one of these elements. In re Software Design, Inc., 220 U.S.P.Q. 662 (T.T.A.B. 1983). Each case must be decided on its own facts, based upon an examination of all of the elements and a consideration of any similarities or differences between the goods and/or services to which the respective marks are applied. Id., citing Dor-A-Matic Division of Republic Industries, Inc. v. Doormaid, Inc., 199 U.S.P.Q. 573 (T.T.A.B. 1978) (and cases cited therein).

This Examiner cannot depart from the rule that marks should be considered in their entirety and not improperly dissected. Colgate-Palmolive Co. v. Carter-Wallace, Inc., 167 U.S.P.Q. 272 (C.C.P.A. 1970). It is the impression which the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof which is important. A determination on the issue of likelihood or confusion must be made upon consideration of the respective marks in their entirety, which in the case at bar are as follows:

Applicant's Mark: SUBZERO

Cited Registration #1: ZERO

Cited Registration #2: ZEROCIG

A comparison of the respective marks in the case at bar, evidences Applicant's Mark as being strikingly different in sight, sound and meaning than the Cited Registrations. Cited Registration #1 is a mere component of Cited Registration #2 as well as Applicant's Mark and that alone is an insufficient basis in which to support a likelihood of confusion. See, Lever Brothers Co. v. Barcolene Co., 174 U.S.P.Q. 392 (C.C.P.A. 1972) (application for "ALL CLEAR!", opposer's registration for

"ALL"); E.g., In re P. Ferrero & C.S.P.A., 178 U.S.P.Q. 167 (C.C.P.A. 1973) (application for 'TIC TAC," prior registration of "TIC TAC TOE"). See also, e.g., In re Sears, Roebuck and Co., 2 U.S.P.Q. 2d 1312 (T.T.A.B. 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear); In re British Bulldog, Ltd., 224 U.S.P.Q. 854 (T.T.A.B. 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes).

In Colgate-Palmolive, the C.C.P.A. affirmed the decision of the TTAB, dismissing an opposition by Colgate-Palmolive, registrant of the mark "PEAK" for dentifrice, against an application filed by Carter-Wallace to register "PEAK PERIOD" for personal deodorants. The C.C.P.A. agreed with the T.T.A.B.

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 530.

In a compelling case, the Eighth Circuit Court of Appeals rejected the contention that the virtually synonymous marks

HEALTHY CHOICE

HEALTHY SELECTIONS

as used in connections with food products were likely to be confused with each other. ConAgra, Inc. v. George A. Homel & Co., 990 F.2d 368 (8th Cir. 1993). See also Industrial Adhesive Co. v. Borden, Inc., 218 U.S.P.Q. 945 (T.T.A.B. 1983) where the T.T.A.B. considered applicant's application for

"WONDER BOND PLUS" (for adhesives)

and the prior registration of opposer for

"BOND PLUS" (for industrial adhesives),

which opposer contended was likely to cause confusion with its registered mark. In Industrial Adhesive Company, despite certain similarities between the parties (i.e., both parties marks are applied to similar goods, adhesives, and opposer's mark BOND-PLUS is completely encompassed within Applicant's WONDER BOND PLUS mark), the T.T.A.B. was wise enough not to believe that "contemporaneous use of these marks would be likely to cause confusion or mistake)." Id. at 951.

Furthermore, as ZERO is a mere component of Applicant's Mark, the appearances of the Applicant's Mark differs greatly from the Cited Registrations. When the appearance of the Cited Registrations is different from the appearance of the Applicant's Mark, this factor is important in determining the absence of likelihood of confusion. 3 McCarthy, Trademarks and Unfair Competition, Section 19. 58 (4th Ed. 2001). Thus while there is some similarity, in that the respective marks all use the lettering for ZERO the visual presentations of the respective marks are vastly distinct for the reasons noted above.

Similarly, comparing the sound of Applicant's Mark and the Cited Registrations, they are pronounced substantially differently, therefore, there is no similarity between the sounds of the marks.

Moreover, the differing connotations and denotations of the terms ZERO and SUBZERO as used in the Cited Registrations and Applicant's Mark respectively, clearly differ and serve to further distinguish the marks in the eyes of the consuming public. The Oxford Dictionary defines the term

subzero as an adjective meaning "lower than freezing; below freezing." (See Oxford Dictionary definition attached hereto as Exhibit A.) By way of contrast, the Oxford Dictionary defines zero as:

number (plural zeros)

- no quantity or number; nought; the figure 0: *figures from zero to nine you've left off a zero—it should be five hundred million*
- a point on a scale or instrument from which a positive or negative quantity is reckoned: *the gauge dropped to zero [as modifier]: a zero rate of interest*
- the temperature corresponding to 0° on the Celsius scale (32° Fahrenheit), marking the freezing point of water: *the temperature was below zero*
- [usually as modifier] *Linguistics* the absence of an actual word or morpheme to realize a syntactic or morphological phenomenon: *the zero plural in 'three sheep'*
- the lowest possible amount or level; nothing at all: *I rated my chances as zero*
- short for zero hour.
- *informal* a worthless or contemptibly undistinguished person: *her husband is an absolute zero*

verb (zeroes, zeroing, zeroed)

[with object]

- 1 adjust (an instrument) to zero: *zero the counter when the tape has rewound*
- 2 set the sights of (a gun) for firing: *the rifle had been zeroed at an elevation of 200*

(See Oxford Dictionary definition attached hereto as Exhibit B.)

Decisional law is clear that in comparing marks that contain additional matter, there is no likelihood of confusion if their entireties convey significantly different commercial impressions. See, Craown Overall Mfg. Co. v. Chahin 96 F. Supp. 805 (W.D. Texas 1951), aff'd 200 F.2d 935 (5th Cir. 1953). Clearly there is a marked difference between the definitions of the term SUBZERO as used in the Applicant's mark and that of ZERO as it is employed in the Cited Registrations. As these differing definitions create entirely separate commercial impressions in the minds of consumers there is not a likelihood that consumers will confuse these marks in the commercial setting.

Indeed, the Trademark Office has already determined that the terms ZERO AND SUBZERO can co-exist on related goods without a likelihood of confusion. This is evidenced by the Trademark Office's actions regarding:

1. Reg. No. 3,266,196 (SUBZERO for razor blades; razors in class 008). (see attached Exhibit C, a Registration Certificate printed from the Trademark Office's internet database).
2. Reg. No. 85/864114 (ZERO for electric hair removing apparatus for hair removal; intense pulse light epilator; electric epilatory appliances; electric pulse light apparatus for hair removal in class 008)

(see attached Exhibit D, a Notice of Allowance printed from the Trademark Office's internet database).

Certainly, even if the Examiner maintains her position that the goods are related, the Trademark Office's allowance of the SUBZERO mark where the ZERO mark already existed in connection with strikingly similar hair removal goods clearly demonstrates that the marks have already been determined to be distinct enough to co-exist without a likelihood of confusion. Considering the Trademark Office's now permanent Consistency Initiative in conjunction with its prior actions regarding the above noted marks in class 008, Applicant maintains that it would be patently unfair to approve simultaneous use of the SUBZERO AND ZERO marks listed above, but then deny Applicant's mark registration on the Principal Register. As such, reconsideration is respectfully requested.

B. The Goods of Applicant's Mark are different than the Cited Registration #1.

Applicant's identification clearly demonstrates that Applicant's goods are not related to those of the Cited Registration #1, despite the fact that they are found in the same international class of goods. Indeed, the owner of the Cited Registration

should not be accorded the wide scope of protection the Examining Attorney has bestowed upon it. On the contrary, such protection should be restricted to the particular goods for which it is registered. Applicant argues that the distinction between Applicant's goods and the goods identified in Cited Registration #1 are sufficiently different when combined with the differences in the entireties of the respective marks, as to prevent likelihood of confusion between the marks.

Applicant manufactures and sells e-cigs, while Cited Registration #1 pertains to tobacco products. Arbitrarily lumping these products together because both deliver nicotine is simply incongruous, because "[d]espite the product's name, it is not a cigarette at all. Unlike "traditional" cigarettes, their electronic "counterparts" do not contain tobacco leaves meant for combustion. Rather, they are simply nicotine delivery services". (See article attached hereto Exhibit E).

E-cigs, such as those for which the Applicant is seeking protection, are electronic devices which generally consist of a power source, an atomizer and a liquid delivery and container system. No tobacco of any kind is used in e-cigs, therefore the

Applicant's goods must be different from those in Cited Registration #1. Furthermore, the choice on behalf of some traditional cigarette producers to enter the e-cig marketplace does not ipso facto make the products related. In today's world of multinational, multibillion dollar corporations, manufacturers regularly enter into diverse product markets as a way to increase profits and minimize losses. Goods coming from the same source cannot be considered related merely by their emanation from the same corporate source, even if that particular source is known for a particular good. The nature of our complex economy dictates against the Trademark Office setting such a precedent.

C. Third Party Registrations Demonstrate That The Trademark Register's Field of marks including the term ZERO Is A Crowded Field.

It cannot reasonably be disputed that the Trademark Register is diluted for the term ZERO. The Trademark Register evidences a number of other registrations in Class 34 which utilize either the word or number ZERO and have been permitted registration on the Principal Register. All of the registrations were added to the Trademark Register subsequent to the issuance of the Cited Registration #1, even Cited Registration #2. Representative registrations and applications include:

3. Reg. No. 3,889,441 registered December 14, 2010 (ZERO STYLE for tobacco, smokers' articles, namely cigarette papers, cigarette filters, cigarette cases, not of precious metal, cigarette holders, not of precious metal; and matches in class 34) (see attached Exhibit F, a Registration Certificate printed from the Trademark Office's internet database).
4. Reg. No. 4,065,789 registered December 6, 2011 (ZERO THE NATURAL CHOICE for non-tobacco hers for use with hookah pipe in class 34) (see attached Exhibit G, a Registration Certificate printed from the Trademark Office's internet database).
5. Reg. No. 4,145,075 registered May 22, 2012 (04 for tobacco; matches; tobacco substitutes not for medical purposes; snuff and tobacco alternatives in the form of products based on vegetable fibers, for oral use, not for consumption; snuff; tobacco free snuff; herbal snuff in class 34) (see attached Exhibit H, a Registration Certificate printed from the Trademark Office's internet database).
6. Reg. No. 3,190,188 registered February 17, 2009 (07 for cigarette lighters not of precious metal in class 34) (see attached Exhibit I, a Registration Certificate printed from the Trademark Office's internet database).
7. Ser. No. 85/871398 (SIX ZERO for cigars in class 34) (see attached Exhibit J, a Notice of Allowance dated August 20, 2013 printed from the Trademark Office's internet database).

It is important to note that each of the above noted registrations and approved applications were approved by the Trademark Office after the registration of Cited Registration #1, which occurred on June 24, 2008. Indeed, even Cited Registration #2, which also contain subsumes Cited Registration

#1 in its mark, has a registration date of July 30, 2013, meaning it also registered after Cited Registration #1.

Thus, in a "crowded" field of marks, each member of the crowd is relatively "weak" in its ability to prevent use by others in the crowd. For example, the Trademark Board has said that the field of trademarks in stripe designs on sports shoes is a "crowded" field. That is, widespread use by different companies of a number of similar designs "has narrowed the breadth of protection" afforded each mark such that any one such design on sports shoes is limited to substantially that identical design.

2 J.T. McCarthy, Trademarks and Unfair Competition, Section 11:85 (4th Edition 2001). Puma-Sportschuhfabriken Rudolf Dassler, K.G. v. Superga S.p.A., 210 U.S.P.Q. 316 (T.T.A.B. 1980).

Similarly, the Ninth Circuit found that marks used to identify beauty pageants are a "crowded field" of similar marks consisting of a marital prefix and a geographic term, such as Miss U.S.A., Miss America, Mrs. America, Miss World, etc. In such a crowded field, defendant's MRS. OF THE WORLD was not so close to plaintiff's MISS WORLD as likely to cause confusion. Miss World (UK), Ltd., v. Miss America Pageants, Inc., 856 F.2d 1445 (9th Cir. 1988), See Washington Nat'l Ins. Co. v. Blue Cross & Blue Shield United, 727 F.Supp. 472 (N.D. Ill. 1990) (the suggestive term ADVANTAGE, as used

on health care programs, was held to be weak because of the extensive use by competitors.)
2 J.T. McCarthy, Trademarks and Unfair Competition,
Section 11:85 (4th Edition 2001).

While third party registrations may not be conclusive on the question of likelihood of confusion, the above registrations in the Trademark Register, evidences the significant number of registrations utilizing the term ZERO associated with goods identical or similar to those in the Cited Registrations. As noted in Smith Brothers Manufacturing Co. v. Stone Manufacturing Co., 476 F.2d 1004 (CCPA 1973), these registrations are relevant, and probative as to the myriad of different meanings or impressions available regarding marks utilizing the ZERO term. Moreover, third party registrations are competent to show that others in a particular area of commerce have adopted and registered marks incorporating a particular term. As stated in In re Hamilton Bank, 222 U.S.P.Q. 174, 177, 179 (TTAB 1984), the weaker a mark, the fewer uses that will trigger a likelihood of customer confusion. Furthermore, as the Eight Circuit observed:

Determining that a mark is weak means that the consumer confusion has been found unlikely because the mark's components are so widely used that

the public can easily distinguish slight differences in the marks, even if the goods are related. General Mills v. Kellogg Co., 824 F.2d 622 (8th Cir. 1987).

In speaking of STEVE'S for a fast food outlet, the Trademark Board said:

[T]he numerous third party uses [of STEVE'S] demonstrates that the purchasing public has become conditioned to recognize that many business in the restaurant and food store fields use the term... and that the purchasing public is able to distinguish between these businesses based on small distinctions about the marks. Steve's Ice Cream v. Steve's Famous Hot Dogs, 3 U.S.P.Q. 2d 1477 (T.T.A.B. 1987).

In the case at bar, while the owners of the Cited Registrations have some trademark rights, their rights are narrow and local in scope. How, therefore, can Applicant in good conscience and with consistent examination being a primary goal, be denied registration of Applicant's Mark when even a cursory review of the Trademark Register includes the above cited third party registrations of the word or number ZERO? This dilution evidence strongly suggests that consumers are not confused as a result of the common use of ZERO for use in connection with class 34 goods. American Hosp. Supply Corp. v. Air Prods. & Chems., Inc., 194 U.S.P.Q. 340 (T.T.A.B. 1977). Moreover, the Cited Registrations are clearly dissimilar in appearance from the Applicant's Mark.

What this case boils down to is the fact that the use of the term ZERO has weak trademark significance, which is evidenced by the widespread adoption and registration. In the case at hand, Applicant's Mark is no more likely to cause confusion with the Cited Registrations than the other marks listed above. Therefore, Applicant respectfully requests the Examiner reconsider her objections in favor of registration.

Pursuant to TMEP 1207.01 (d)(x), when the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion.

Given the dilution in the Trademark Register and the weakness of the Cited Registrations, there should be no question that the Applicant's Mark should be registered. The concept of ZERO relating to class 34 goods has been registered on numerous occasions before and it should be registered now.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Examiner withdraw the cited objection and submits that Applicant's Mark is entitled to registration and requests that the Examining Attorney pass said mark to publication.

Respectfully submitted,

THE INGBER LAW FIRM

By: 

Mark J. Ingber

Dated: November 21, 2013

MJI:mas; Encl.
SUBZERO RESPONSE TO OFFICE ACTION