IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :		ZERO DROP
Serial No.	:	88410497
For	:	remarkable.legal
Examiner	:	O'BRIEN, JENNIFER LYNN
Law Office	:	120

RESPONSE TO OFFICE ACTION DATED 07/23/2019

This is responsive to Office Action dated 07/23/2019. The Applicant respectfully requests that the application be reconsidered.

BACKGROUND

Applicant Park, James seeks registration of U.S. Serial No.88410497 for ZERO DROP in relation to "Neck pillows; Pillows" in International Class 20. The Examining Attorney has refused registration of the mark.

The Examining Attorney alleges that the applied for mark is likely to be confused with the mark(s) listed below. Trademark Act Section 2(d), 15 U.S.C. § 1052(d); see TMEP § § 1207.01 et seq.

•U.S. Registration No. 5323427 for MEMORYZERO covering "Beds; Beds, mattresses, pillows and bolsters; Bolsters; Chairs; Cushions; Furniture; Mattresses; Moldings for picture frames; Pillows; Seats; Sofas" in International Class 20.

•U.S. Registration No. 5010137 for ZEROBUGS covering "Mattresses and pillows; beds; bed bases; padded bed headboards; sofa beds; sleeping mats; cushions" in International Class 20.

•U.S. Serial No. 88252816 for ZERO PRESSURE covering "Chairs; Furniture of metal; Mattresses; Office furniture; Pet cushions; Pillows; Straw plaits; Works of art of wood, wax, plaster or plastic" in International Class 20.

•U.S. Serial No. 88180578 for ZERO SLEEP covering "Mattresses; Pillows" in International Class 20.

APPLICANT'S ARGUMENT THAT THE MARK PRESENTS NO LIKELIHOOD OF CONFUSION

Applicant respectfully disagrees with the Examining Attorney's decision for the reasons discussed below.

The Standard for Determining Likelihood of Confusion

A determination of likelihood of confusion between two marks is determined on a case by case basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The Examining Attorney is to apply each of the applicable thirteen factors set out in *In re E.I. DuPont DeNemours & Co*., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant DuPont factors as they relate to likelihood of confusion in this case are reviewed below.

The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression;

In comparing two trademarks for confusing similarity, the Examining Attorney must compare the marks for resemblances in sound, appearance and meaning or connotation. *In re E.I. DuPont de Nemours & Co.,* 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Similarity in one respect - sight,

sound, or meaning - does not support a finding of likelihood of confusion, even where the goods or services are identical or closely related. TMEP §1207.01(b)(i).

It has long been established under the "anti-dissection rule" that "the commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." *Estate of P. D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46, 64 L. Ed. 705, 40 S. Ct. 414 (1920). It violates the anti-dissection rule to focus on the "prominent" feature of a mark, ignoring other elements of the mark, in finding likelihood of confusion. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974). See *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 U.S.P.Q. 233 (C.C.P.A. 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."); *Sun-Fun Products, Inc. v. Suntan Research & Development, Inc.*, 656 F.2d 186, 213 U.S.P.Q. 91 (5th Cir. 1981) (the test is "overall impression," not a "dissection of individual features").

1. No Explicit Rule that Likelihood of Confusion Applies Where Junior User's Mark Contains the Whole of Another Mark.

There is no explicit rule that likelihood of confusion automatically applies where a junior user's mark contains in part the whole of another mark. See*, e.g., Colgate-Palmolive Co. v. Carter-Wallace, Inc*., 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (PEAK PERIOD not confusingly similar to PEAK); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972) (ALL

CLEAR not confusingly similar to ALL); *In re Ferrero*, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973) (TIC TAC not confusingly similar to TIC TAC TOE); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 U.S.P.Q. 422 (C.C.P.A. 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); *In re Merchandising Motivation, Inc*., 184 U.S.P.Q. 364 (T.T.A.B. 1974) (there is no absolute rule that no one has the right to in-corporate the total mark of another as a part of one's own mark: MMI MENSWEAR not confusingly similar to MEN'S WEAR); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520 (T.T.A.B. 1975) (PROTEIN PLUS and PLUS not confusingly similar*).* See *Monsanto Co. v. CI-BA-GEIGY Corp.*, 191 U.S.P.Q. 173 (T.T.A.B. 1976) (use of portion of another's mark to indicate that defendant's product contains plaintiff's product held not likely to cause confusion). Even the use of identical dominant words or terms does not automatically mean that two marks are similar. *Luigino's Inc. v. Stouffer Corp*., 50 USPQ2d 1047, the mark LEAN CUISINE was not confusingly similar to MICHELINA'S LEAN 'N TASTY though both products were similar low-fat frozen food items and both shared the dominant term "lean." Finally, "marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight." *In re Hearst*, 982 F.2d 493, 494 (Fed.Cir. 1992). In *Hearst*, Applicant registered VARGA GIRL for calendars and was refused registration by the Trademark Trial and Appeal Board because of earlier registration of VARGAS for posters, calendars, and greeting cards. The Federal Circuit reversed the refusal on appeal. The higher court found that the Board inappropriately changed the mark by diminishing the portion of "girl." When the mark was reviewed in its entirety, there was no likelihood of confusion. Here, the marks share the term "ZERO" in common but this common term is not enough to support a finding of likelihood of confusion, particularly where there are a number of differentiating factors.

2. Marks Differ in Sight, Sound, and Commercial Impression

a. Marks Differ in Sight

A visual examination of the literal elements of the conflicting marks supports a finding that they are different. Applicant's mark consists of the wording ZERO DROP. In contrast, Registrant's mark consists of MEMORYZERO and ZEROBUGS; Prior Pending Marks consist of ZERO PRESSURE and ZERO SLEEP. Given the significantly different literal elements discussed above, there is little likelihood of confusion.

b. Marks Differ in Sound

Here, the marks vary substantially in sound. Applicant's mark is pronounced with three syllables whereas Registrant's marks are pronounced with five and three syllables respectively; Prior Pending marks are pronounced with four syllables and three syllables. As such, these marks sound little alike and have an entirely different phonetic profile.

However, even where two marks are phonetically similar, no likelihood of confusion exists if other differentiating factors can be established. See *National Distillers & Chemical Corporation v. William Grant and Sons, Inc.*, 505 F.2d 719 (finding that DUVET and DUET did not raise likelihood of confusion where other differentiating factors existed such as the term "duet" was a com-mon word whereas "duvet" was not). As stated above, the visual differences between Applicant's mark and the

Registrant's mark provide one of many differentiating factors that do not support a claim of likelihood of confusion.

c. Marks Differ in Commercial Impression

The marks in this case vary substantially in commercial impression. The term ZERO DROP is commonly known to describe a type of running shoe, it literally means that there is no angle change from the heel to the toes. Exhibit 1. This definition of no drop, means that it does not go beyond or it just doesn't fall. Applicant's mark in relation to pillows for sleeping; Pillows denotes this idea of a comfortable sleep, where the head is not lifted from the bed in relation to the rest of the body.

On the other hand, Registrant's MEMORYZERO encourages an entirely different view. The word MEMORY is often used in this context in reference to the memory foam material famous for taking the form of the individual using it. Exhibit 2. Consequently, a person looking at MEMORYZERO could arguably think this mattress does not take your form, as it won't remember your form.

Registrant's ZEROBUGS for Mattresses and pillows; beds; bed bases; padded bed headboards; sofa beds; sleeping mats; cushions, is a very descriptive mark that literally gives the impression the products are bug proof. Especially considering people don't want bed bugs in their sleep.

Finally, Prior-Pending mark's ZERO SLEEP and ZERO PRESSURE for pillows provide a similar idea that contrasts with applicant's trademark. For ZERO SLEEP the idea seems to be that of a pillow that will not help you get a good night's sleep, no sleep at all. While ZERO PRESSURE communicates the idea of a pillow that provides no pressure, a pressure free pillow. Given the

significant differences in commercial impressions, there is little likelihood of confusion between the marks.

The number and nature of similar marks in use on similar goods;

Marks may contain elements in common without creating consumer confusion if the common matter is merely descriptive or diluted. See *In re Shawnee Milling Co*., 225 USPQ 747 (TTAB 1985) (Holding that GOLDEN CRUST for flour not likely to be confused with ADOLPH'S GOLD'N CRUST AND DESIGN for coating and seasoning for food items). In *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986), the Federal Circuit found no likelihood of confusion existed between the marks BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL. Not only were the marks not confusingly similar in sound or appearance, but because that record showed a "large number of variously named 'bed and breakfast' services," the Applicant's mark would be unlikely to cause consumer confusion. *Id*. at 159. *In The Plak-Shack, Inc. v. Continental Studios of Georgia*, Inc., 204 USPQ 242 (TTAB 1979), The Trademark Trial and Appeal Board found no likelihood of confusion existed between PLAQUE VILLAGE and PLAK-SHACK. The Board cited the descriptive nature and dilution of the word "plaque," listing marks such as PLAK-A-RAMA, PLAK-TIME, PLAKTIQUE, COUNTRY MALL PLAQUE SHOP, DAISY TREE SHOPS PLAKS, THE FINISHING TOUCH PLAQUE SHOP, PLACK-BOUTIQUE, YE OLD PLAK SHOP, PLAQUE SHOP, and THE PLAQ PLACE.

Dilution of a common element can be shown by the existence of several third-party registrations, or by evidence of actual third party use. *AMF Inc. v. American League Products, Inc*., 474 F.2d 1403, 1406, 177 USPQ 268, 269-7- (CCPA 1973) (The multiplicity of fish names used to designate a variety of boats may serve to weaken the distinctiveness of any particular fish name as part of a mark for a

boat); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) (Existing, widespread third-party use of "VEUVE" on alcoholic beverages could serve to indicate the weakness of the term in the context of its source-identifying significance).

Here, the word ZERO, much like the terms cited in the examples above, is common between the marks and diluted as applied to the field of pillows in class 020. Applicant attaches evidence showing the existence of various other marks containing the word ZERO in the relevant classes, including but not limited to:

- **ZERO G**, Reg. No. 3803995- (beds) Exhibit 3
- **ZERODIS**, Reg. No. 5535353 (bath pillows) Exhibit 3
- **ACARZERO**, Reg. No. 5051708 (mattresses and pillows of any kind) Exhibit 3
- **MEMORYZERO**, Reg. No. 5323427 (pillows) Exhibit 3
- **SLEEPZERO**, Reg. No. 4443008 (sleep products, namely, mattresses, spring mattresses, box springs and mattress foundations) Exhibit 3
- **ZERO MOTION,** Reg. No. 1922056 (mattresses) Exhibit 3
- **ZERO GRAVITY FOAM**, Ser. No. 87914305 (pillows; mattress toppers) Exhibit 3
- **SUBZERO**, Ser. No. 88261535 (mattresses; pillows) Exhibit 3

Consumers are inundated by the word ZERO with respect to these goods and services, and will not assume that goods or services stem from the same source merely because marks share this single term. The term is individually diluted and weak, and should be given even less weight in a likelihood of confusion analysis regarding marks which share it.

Given the significant dilution of the word ZERO for the relevant market, there is little likelihood of confusion.

CONCLUSION

For the reasons listed above, Applicant respectfully requests that the Examining Attorney should remove all refusals for the trademark ZERO DROP (U.S. Serial No. 88410497) and approve the mark for publication.

Respectfully submitted:

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