IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of ZOA Energy, LLC Serial No.: 90/073,011 Filed: July 24, 2020 Mark: ZOA	Examining Attorney Dominic R. Fathy Law Office 104

RESPONSE TO NON-FINAL OFFICE ACTION

This responds to the Office Action issued on November 16, 2020, ("Office Action"), in which the Examining Attorney refused the applied-for trademark under Section 2(d) of the Trademark Act.

REQUEST TO AMEND THE IDENTIFICATION

Applicant's goods may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. The Applicant requests "coffee and tea" in Class 30 be deleted from the identification, and the application proceed with "energy drinks" in Class 32.

The following responds to the refusal based on the amended identification.

SECTION 2(D) – LIKELIHOOD OF CONFUSION REFUSAL

When refusing a mark under Section 2(d) of the Trademark Act, the issue is not whether the respective marks, or goods and services offered under the marks, are likely to be confused but rather, whether there is a likelihood of confusion as to the source or sponsorship of the goods and services because of the marks used thereon. *See Paula Payne Prods. Co. v. Johnson's Publ'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973). A determination that there is no likelihood of confusion may be appropriate, even where the marks are identical or substantially

similar, because other factors, such as differences in the nature of the goods and services, the relevant trade channels in which the services travel and the circumstances surrounding the purchase of the goods and services are dissimilar enough to avoid a potential for confusion in the market. *See* TMEP §1207.01.

In the case at hand, the Examining Attorney refused registration of Applicant's mark, ZOA, arguing that under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d) it is likely to be confused with ZOA (Reg. No. 6003063) and ZOA EATERIES (Reg. No. 6069878). While the Applicant recognizes that both Applicant's and Registrant's marks share the common element, ZOA, there is no likelihood of confusion under the test set forth in *In re E.I. DuPont de Nemours & Co*., 476 F.2d 1357, 1361 (C.C.P.A. 1973) and other cases evaluating the likelihood of confusion test under Section 2(d) of the Lanham Act. It is clear that there is no likelihood of confusion in the market because (1) the parties market and provide their respective and disparate goods and services in distinctive channels of trade and (2) the evidence did not establish that there was *something more*, as required when establishing relatedness of the food/beverage products and restaurant services.

I. <u>The Parties Market and Provide their Respective Goods and Services in Distinctive Channels of Trade.</u>

The Examining Attorney argues that Applicant's goods, namely, "energy drinks" are confusingly similar to the cited Registrant's services, namely, "restaurant and café services." Applicant respectfully disagrees. There is no *per se* rule that food or beverage products and restaurant services are confusingly similar. The marketplace reality and evidence further establishes that the goods and services are distinguishable from one another. *See Lloyd's Food*

Prods., Inc. v. Eli's, Inc., 987 F.2d 766, 768, 25 USPQ2d 2027, 2030 (Fed. Cir. 1993); *In re Opus One Inc.*, 60 USPQ2d 1812, 1813 (TTAB 2001).

According to the *DuPont* factors, we consider "[t]he similarity or dissimilarity and nature of the [goods and services] as described in an application or registration…." *DuPont*, 177 USPQ at 567. "This factor considers whether 'the consuming public may perceive [the respective services of the parties] as related enough to cause confusion about the source or origin of the services.'" *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014). "Energy drinks" are a type of beverage, containing stimulants, and advertised as providing consumers with mental and physical stimulation (energy). *See attached definition from Wikipedia* https://en.wikipedia.org/wiki/Energy_drink. According to the National Center for Complementary and Integrative Health, energy drinks are the most popular dietary supplement consumed by American teens and young adults, with almost one-third of teens between 12 and 17 indicating they drink them regularly. Further, men between the ages of 18 and 34 years comprise the largest market to consume energy drinks. Not surprisingly, energy drinks are not consumed in leisurely café and restaurant settings. Rather energy drinks are a staple in the lives of many students and young adults who are quickly downing the contents in an effort to get as much caffeine as possible to boost their mental and physical actions.

Given that energy drinks have a specific function that is tied to stimulating alertness and maintaining stamina, they are marketed differently than an average beverage. *See, article from Fast Company,* It's a (Red) Bull Market After All*, available at http://www.fastcompany.com/64658/its-red-bull-market-after-all* (discussing branding expert options of the marketing successes of energy drinks vs. other beverages); *article from Comprehensive Reviews in Food and Science and Food Safety,* Energy Drinks: An Assessment

of Their Market Size, Consumer Demographics, Ingredient Profile, Functionality, and Regulations in the United States, available at http://onlinelibrary.wiley.com/doi/10.1111/j.1541-4337.2010.00111.x/pdf (identifying the energy drinks from nutritional and nutraceutical beverages in defining the energy drink market). Energy drinks, such as Applicant's product, are most often sold in convenience stores, student markets and grocery stores. They are not generally available for sale at restaurants or cafes. Alternatively, "restaurants and cafes" are food-centric establishments that offer meals and refreshments, to be enjoyed at a leisurely pace. *See attached definitions from Merriam Webster Dictionary. https://www.merriam-webster.com/dictionary/restaurant; https://www.merriam-webster.com/dictionary/cafe.* Both food and beverage are offered at cafes and restaurants as prepared foods, made onsite and served to the customer – as opposed to being offered in a can on a shelf at a market.

Restaurants and cafes tailor their menus, decors and themes to specific neighborhoods and potential diners, unlike energy drink providers who create a product that can be plucked from a convenience store shelf anywhere. As such, marketing and key demographics related to restaurant and café services largely depend on the food and the stated target market. *See https://rapidboostmarketing.com/restaurant-marketing-defining-customer-profiles-for-your-restaurant/* In the case at hand, it appears that the Registrant's ZOA/ZOA EATERIES is part of restaurant group located in Houston, Texas, and is primarily focused on providing Moroccan food. *See https://www.zoamoroccan.com/menus/.* According to the restaurant/café menu, there are no energy drinks offered at this establishment. *See Id.* It is clear that the relevant trade channels and target consumers of the Applicant and Registrant are different.

II. The Evidence does not Establish that there was *Something More*, as Required When Establishing Relatedness of the Food/Beverage Products and Restaurant Services.

Relatedness of the energy drinks, restaurant, and café services may not be assumed and the evidence of record must show "*something more*" than that similar or even identical marks are used for food products and for restaurant services. *In re Opus One Inc.,* 60 USPQ2d 1812, 1813 (TTAB 2001) (holding when it comes to restaurant services and beverages, we often state that "something more" is required (over and above a showing that the goods and services are offered together) because the relatedness of the parties' respective goods and services may not be evident.

Other than the provision of third-party registrations, the Examiner did not provide additional evidence to demonstrate a relatedness of the goods and services in the marketplace. Third party registrations may be of probative value, but they fail to establish *something more*, to demonstrate a relatedness of the "energy drinks" and "restaurant and café services."

Popular energy drinks, like the one Applicant intends to supply, include brands such as, (1) Monster, (2) Red Bull, (3) Zipfizz, (4) 5-Hour Energy, (5) Rockstar, etc. *See attached article from Top10Supps. https://top10supps.com/best-energy-drinks/* These brand owners strictly focus on provision of energy drinks and do not offer restaurant or café services. *See attached evidence from https://www.monsterenergy.com/, https://www.redbull.com/us-en/energydrink/red-bull-energy-drink, https://www.zipfizz.com/, https://5hourenergy.com/, and https://rockstarenergy.com/.* Clearly, energy drinks are outside the realm of restaurant and café services and do not overlap in a way that might suggest a relatedness that could rise to the level of consumer confusion in the market.

Where additional evidence cannot be established that there is some additional relatedness of the goods and services, the marks cannot be said to be confused. In *Steve's Ice Cream v. Steve's Famous Hot Dogs*, the TTAB held:

> As to the goods and services of the parties in the case at hand, while it may well be that ice cream may be served in restaurants, it does not necessarily follow that consumers expect a single source to be responsible for both restaurant services and ice cream. There is no evidence in the record before us that applicant makes or sells ice cream, or that any one business makes and sells ice cream under the same mark in connection with which it renders restaurant services. Without evidence, we cannot simply assume that purchasers expect a common source to provide both these goods and these services, even if the marks used to identify them were identical.

See 3 USPQ2d 1477, 1478 (TTAB 1987).

When the goods and services at issue are not related…then, even if the marks are identical, confusion is not likely. *See, e.g., In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers). Consequently, the differences in the goods and services obviate any relatedness of the marks, or any confusion by consumers as to the source of the goods and services.

Accordingly, due to the differences in the nature of the goods/services and the distinct trade channels, coupled with the lack of evidence establishing the relatedness of the goods/services, the Applicant respectfully requests that the Section 2(d) refusal be withdrawn and the ZOA mark be issued to publication.

Respectfully submitted,

By: /Rebecca E. McDougall/

Rebecca E. McDougall
Brittany A. Estell
Morgan, Lewis & Bockius LLP
1111 Pennsylvania Ave. NW
Washington, DC 20004
202.739.5385

Emails: trademarks@morganlewis.com
rebecca.mcdougall@morganlewis.com
brittany.estell@morganlewis.com

Attorneys for Applicant,
ZOA Energy, LLC