

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Newport Apothecary, Inc. )  
Serial No.: 87283381 )  
Filed: December 28, 2016 )  
Int'l Class: 004, 018, 021 )  
Mark: ZEUS )  
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**INTRODUCTION**

The Applicant, Newport Apothecary, Inc. (hereinafter referred to as "The Applicant") has received and reviewed the Office Action dated March 27, 2017 regarding ZEUS, Serial No: 87283381 (hereinafter "The Mark") and makes its responses thereto.

The examining attorney refused registration of The Mark based on likelihood of confusion with the following mark:

- "ZEUS" Reg No. 4103879 (hereinafter "The Registrant").

The Applicant respectfully disagrees, and makes its case below why The Mark deserves to be on the principal register, and the rejection of the registration should be reversed.

**REFUSAL UNDER SECTION 2(d) - Likelihood of Confusion**

Refusal of Applicants mark should be reversed because based on (1) the type of goods sold, (2) the marketing channels used, (3) the sound, translation and spelling of the word ZIUE, and (4) the number of ZEUS trademarks registered, there is not a likelihood of confusion among consumers between the unrelated products sold under these two marks.

**1. Men's Beard Grooming Products Are Not Related to Equestrian Accessories**

The reviewing attorney determined that due to both marks' use of "leather goods," the goods and services were similar and thus rejected Applicant's registration. However, men's grooming products are in no way related to equestrian accessories, and there is no chance of these

different products causing confusion among consumers. The examining attorney must compare the goods or services sold in order to determine whether they are related, or whether the activities surrounding their marketing are likely to cause confusion among consumers. *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Here they not.

The goods and services of the two marks in question are not related, and thus are not likely to cause confusion. *See Exhibits 1 & 2*. The Applicant's goods include beard oils, leather shaving cases, combs, and beard trimmers. The Registrant's consist solely of equestrian goods and accessories such as bridals, reins, halters, and horse collars, all in connection with horseback riding. These goods and services are so completely different from the Applicant's goods the rejection must be reversed. A consumer looking to purchase a beard trimmer under the ZEUS mark would in no way be confused when coming across a horse bridal as to whether they were related products.

The goods and services relating to these two marks have nothing in common, and thus there is not a likelihood of confusion among consumers as to either the goods or the services. The only similarity is the International Class and the use of leather. However, Applicant's sole use of leather is for its leather cases used for its men's grooming kits, while the Registrant uses leather on the majority of its equestrian products. The use of leather is not similar because the products are unrelated, and consumers are not likely to confuse goods related to shaving and personal men's grooming with horseback riding and equestrian goods, regardless of the material used. Registrant does not even market a leather bag on its website. *See Exhibit 2*.

Thus, the reviewing attorney erred in refusing the registration based on both prongs of the likelihood of confusion analysis, and the rejection should be reversed.

## **2. The Marketing Channels Used Make the Differences in Products Clear**

The marketing channels used and the differences between the respective purchasers further limit any chance of a likelihood of confusion among consumers. Applicant's website makes it clear that they sell beard grooming products and are solely a beard grooming company. *See Exhibit 1*. In contrast, Registrant's website consists solely of photographs of horses and the accessories used in connection with riding them. *See Exhibit 2*.

Thus, not only is a likelihood of confusion virtually nonexistent, but both marks specifically market their products to a very select group of consumers who would not be confused as to the source of either of the goods; men with beard grooming needs and horseback riding enthusiasts respectively.

## **3. There are Numerous ZEUS Registrations with No Likelihood of Confusion Found**

The examining attorney analyzed the case in two steps to determine whether there is a likelihood of confusion; he analyzed the similarity of the marks, and compared the types of goods and services sold.

Here, the examining attorney refused registration on the first ground because it is alleged that the applicant's mark is nearly identical in appearance and commercial impression. However, while it is undisputed that the word mark is similar, due to the amount of registrations using ZEUS, the similarity of the words alone is not sufficient to refuse the registration. Even identical marks may be registered where the goods and services are so dissimilar that a likelihood of confusion is unlikely, as is the case here.

There are numerous valid registrations filed consisting solely of the word "ZEUS" or using a version of the word without any likelihood of confusion found. "Sufficient evidence of third-party use of similar marks can "show that customers ... 'have been educated to distinguish between different ... marks on the basis of minute distinctions.' " Juice Generation, Inc. v. GS Enterprises LLC, 794 F.3d 1334, 1338 (Fed. Cir. 2015) (quoting 2 McCarthy on Trademarks and Unfair Competition § 11:88 (4th ed.2015)).

Here, there is no likelihood of confusion with the registrations due to the vast number of other registered marks that use "ZEUS," as customers have been educated to distinguish between the many registered marks, and thus the focus is on the goods and services of the mark rather than the word itself. Further, due to the amount of registered marks using the term ZEUS, consumers are less likely to associate it with a single registration.

### **Prior Filed Applications**

The Mark was also rejected because of an alleged likelihood of confusion with a pending application, Serial No.: 86956134. However, the application has been abandoned, and therefore cannot be used as a basis to refuse registration of The Mark. Therefore, the rejection must be reversed.

**CONCLUSION**

For all the foregoing reasons, Applicant submits that the Examiner's refusal should be withdrawn and the Application to register this mark should be passed to publication.

Dated: September 27, 2017

COHEN IP LAW GROUP, P.C.

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