

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Newport Apothecary, Inc.)
Serial No.: 87283374)
Filed: December 28, 2016)
Int'l Class: 008, 025)
Mark: ZEUS)
_____)

INTRODUCTION

The Applicant, Newport Apothecary, Inc. (hereinafter referred to as "Applicant") has received and reviewed the Office Action dated March 27, 2017 regarding ZEUS, Serial No: 87283374 (hereinafter "The Mark") and makes its responses thereto.

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

- “ZEUS” Reg No. 4103879 (hereinafter “Registrant Mark 879”), and “ZIUE SKY” Reg. No. 4129611 (hereinafter “Registrant Mark 611”).

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, and (3) the number of ZEUS trademarks registered, there is not a likelihood of confusion between the unrelated products sold under these respective marks. Further, in regards to Registrant Mark 611, the average consumer would not even be aware that “ZIUE” means “ZEUS” in English, and thus any likelihood of confusion would be minimal.

1. Men’s Beard Grooming Products Are Not Related to Equestrian Products or Shoes

The reviewing attorney determined that due to both marks’ use of “leather goods,” as well as “clothing,” 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. Further, the only product apparently marketed under "ZIUE SKY" is a single pair of shoes, which does not even appear to be available to consumers. The only article of clothing marketed by Applicant are tee shirts that function as gifts to go along with their men's beard grooming kits. 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, 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, & 3*. The Applicant's goods include razors, scissors, and beard trimmers, as well as a few accessories including t-shirts, beer glasses, and flasks. The Registrant's consist solely of equestrian goods and accessories in regards to "ZEUS," and shoes in regards to "ZIUE SKY." 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 or a pair of shoes as to whether they were related products.

The goods and services relating to these marks have nothing in common, and thus there is no likelihood of confusion among consumers as to either the goods or the services. The only similarity between Applicant's products and Registrant Mark 879 is the International Class and the use of leather. However, Applicant's sole use of leather is for its leather traveling 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.

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 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 3*. In contrast, Registrant Mark 869's website consists solely of photographs of horses and the accessories used in connection with horseback riding. *See Exhibit 2*. Additionally, the term "ZEUS" does not even appear on Registrant's website, and thus consumers are not likely aware of the mark.

Further, Registrant Mark 611 has a single specimen of a pair of shoes, but has no website or store in which to purchase the product. Consumers are not only unlikely to confuse the products, but are unlikely to even come across this product in the first place.

Thus, not only is a likelihood of confusion virtually nonexistent, but the marks specifically market their products to a very select group of consumers; men with beard grooming needs and horseback riding enthusiasts respectively.

3. The Sound, Spelling, and Translation of ZIUE SKY Mark Would Not Lead to Consumer Confusion

There is further little to no likelihood of confusion in regards to the mark “ZIUE SKY” based on its pronunciation, appearance, and translation. Although the USPTO registration website notes that the English translation of “Ziue” is “Zeus,” it does not specify the language, nor did the examining attorney provide any evidence supporting this fact. In fact, a Google Translate search of the word only detects one translation, which is the Corsican term for “it was.” Nowhere does the term come up as “Zeus.”

Additionally, “ZIUE SKY” does not sound phonetically like “ZUES” in any way, and consumers are unlikely to be confused by this. It is likely a play on the term “Blue Sky,” and thus has no resemblance to “ZEUS.”

4. 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 Registrant Mark 879 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. As noted above, Registrant Mark 611's use of the word “ZEUS” in a different language makes the marks not similar, and reduces any likelihood of confusion among consumers.

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 three pending applications, Serial No.: 86956134, Serial No.: 86361818, and Serial No.: 86212676. However, both '134 and '676 have been abandoned, and therefore cannot be used as a basis to refuse registration of The Mark. In regards to '818, the pending mark is for "ZEUS AESTHETICS," and filed under Zeus Aesthetics, LLC, a company whose filing status is listed as "canceled," and which does not appear to be active. Therefore, rejection based on these pending registrations 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.

By: /s/ Michael N. Cohen

Michael N. Cohen

CA State Bar No. 225348

Attorney for Applicant

9025 Wilshire Blvd., Suite 301

Beverly Hills, CA 90211

(310) 288-4500

(310) 246-9960