

FILED ELECTRONICALLY
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 88/505,302
Applicant: Australian Gold, LLC
Filing Date: July 9, 2019
Law Office: 105
Examiner: Elizabeth A. O'Brien
Attorney Docket No.: 8183-1833
Mark: LITTLE JOEY & Design

RESPONSE AFTER OFFICE ACTION

BOX RESPONSE NO FEE
Commissioner for Trademarks
P.O. Box 1451
Arlington, VA 22313-1451

Dear Sir:

In response to the Office Action emailed September 5, 2019, reconsideration is respectfully requested in view of the following amendments and remarks.

AMENDMENT

Please amend the recitation of goods to the following:

Class 3: Outdoor skin tanning preparations, body wash, skin soaps and skin moisturizers

REMARKS

Clarifying Amendments to the Identification of the Goods

Applicant has amended the identification of “soaps” to clarify that the good are “skin soaps.” Withdrawal of the identification of goods objection is requested.

Likelihood of Confusion

The Office Action alleges that there is a likelihood of confusion between Applicant’s LITTLE JOEY & DESIGN mark as shown and three U.S. Registrations, namely Nos. 2,376,395; 5,291,582 and 4,910,852.



- U.S. Reg. No. 2376395 is on JOEY NEW YORK for following goods:

Class 3: cosmetics and skin care products, namely, skin creams, skin lotions, skin cleansers, skin moisturizers, skin toners, facial masks, facial moisturizers, non-medicated acne treatment, foundations, face powders, lipsticks, blush, lip gloss, lip pencils, eyebrow pencils, eye shadows, eye liners, nail polish

- U.S. Reg. No. 5291582 is on JOEY SALTS for the following goods:

Class 3: Body scrub; body lotion

- U.S. Reg. No. 4910852 is on LITTLE JOE for the following goods:

Class 5: Air deodorizing preparations¹

Applicant submits that each of the cited registrations is distinguishable from the present application based on respective differences in the marks and respective differences in the goods.



JOE And/Or JOEY Is A Weak Formative



As a threshold consideration, “JOE” and/or “JOEY” is a weak formative in a crowded field. Thus, each of the cited registrations should be interpreted narrowly. The Office Action cites registrations in classes 3 and 5. Accordingly focusing on classes 3 and 5, there are multiple “Joe” and “Joey” formative marks. For instance:²

TM/AN/RN/Disclaimer	Status/Status Date	Full Goods/Services	Owner
<u>MIGHTY JOE</u>	Allowed - Intent to Use Notice	(Int'l Class: 03) Cosmetics	Mighty Joe LLC (Wisconsin)



¹ The Office Action incorrectly indicates that this registration is in class 3.


² Copies of these registration certificates or USPTO records are submitted herewith.

TM/AN/RN/ Disclaimer	Status/Status Date	Full Goods/Services	Owner
SN: 88338803	of Allowance Issued August 27, 2019		Limited Liability Company)
LITTLE JOE RN: 4910852 SN: 79160781	Registered March 8, 2016	(Int'l Class: 05) air deodorizing preparations [class 11 omitted]	Drive Int. Ag (Switzerland Limited)
JOEY HEALY and Design  RN: 4703553 SN: 86356163	Registered March 17, 2015	(Int'l Class: 03) eyebrow pencils, eyebrow powders to give color, eyebrow gels, non-medicated eyebrow serums, and eyebrow highlighters [class 44 omitted]	Joseph Healy, Inc. (New York Corp.)
JOEY NEW YORK RN: 2376395 SN: 75331195 Disclaimer: "NEW YORK"	Renewed August 15, 2010	(Int'l Class: 03) cosmetics and skin care products, namely, skin creams, skin lotions, skin cleansers, skin moisturizers, skin toners, facial masks, facial moisturizers, non-medicated acne treatment, foundations, face powders, lipsticks, blush, lip gloss, lip pencils, eyebrow pencils, eye shadows, eye liners, nail polish [class 35 omitted]	Rar Beauty LLC (Florida Limited Liability Company)
JOEY SALTS RN: 5291582 SN: 86739143 Disclaimer: "SALTS"	Registered September 19, 2017	(Int'l Class: 03) body scrub; body lotion	Joey Hoy (United States Citizen)
CUTTER JOE'S BEARD TAMING OIL VITAMIN ENRICHED NATURALS OILS. and Design  RN: 4830778 SN: 86542919 Disclaimer: "BEARD TAMING OIL VITAMIN ENRICHED NATURAL OILS."	Registered October 13, 2015	(Int'l Class: 03) natural oils for moisturizing, conditioning, nourishing, and detangling beards	Look Good Feel Good Barbershop, Rich Beasley, U.S. Citizen (Indiana Sole Proprietorship)
CUTTER JOE'S EST. 2013 THE BEARD	Registered May 23, 2017	(Int'l Class: 03) cosmetics, namely, non-medicated beard	Richard Beasley E, Dba Cutter

TM/AN/RN/ Disclaimer	Status/Status Date	Full Goods/Services	Owner
<p>COMPANY and Design</p>  <p>RN: 5208269 SN: 87163804 Disclaimer: "CUTTER", "EST. 2013" AND "THE BEARD COMPANY"</p>		care preparations, namely, oils and balms	Joe's Beard Oil (Indiana Limited Liability Company)
<p>DR JOE LAB</p> <p>RN: 5297649 SN: 87081530 Disclaimer: "LAB"</p>	Registered September 26, 2017	(Int'l Class: 03) cosmetic creams; cosmetics; perfumes; massage oils; massage lotions; hair shampoos and conditioners; cosmetic preparations for the hair and scalp; hair care preparations consisting of organic coconut virgin oil and coconut virgin oil; bath and shower gels and salts not for medical purposes; wax for removing body hair; essential oils for use in aromatherapy; suntan oils for cosmetic purposes; wrinkle-minimizing cosmetic preparations for topical facial use; flower essences for cosmetic purposes; cosmetics, namely, compacts; cosmetics, namely, lip primer; cosmetics, namely, lip repairers; eye compresses for cosmetic purposes; eyebrow cosmetics; cosmetic rouges; cosmetic skin fresheners; cosmetic soaps; cosmetic sun milk lotions	Farah, Youssef (United States Citizen)
<p>HEY JOE and Design</p>  <p>RN: 5322526 SN: 87368988</p>	Registered October 31, 2017	(Int'l Class: 03) perfumery; essential oils; cosmetics; hair lotion; dentifrice	Matallin Conca, Daniel (Spain Citizen)
<p>JAMAICA JOE</p> <p>RN: 4210747 SN: 85202429</p>	Registered 8 Accepted September 13, 2018	(Int'l Class: 03) sunblock preparations; sunscreen preparations; skin lotions; non-medicated lip balm	Branded LLC (Georgia Limited Liability Company)
<p>JOE</p>	Renewed	(Int'l Class: 03)	Joe Grooming,

TM/AN/RN/ Disclaimer	Status/Status Date	Full Goods/Services	Owner
RN: 2700734 SN: 75799732	March 25, 2013	men's hair care products, namely, shampoos, gels and conditioners	LLC (Delaware Limited Liability Company)
JOE BLASCO COSMETICS RN: 2985801 SN: 76478775 Disclaimer: "COSMETICS"	Renewed August 16, 2015	(Int'l Class: 03) cosmetics used for both general purposes and for special effects in television and movie production, namely facial make-up, eye make-up, body make-up, prosthetic make-up, lipstick, lip gloss, and cheek covering preparations	Blasco, Joseph D. (United States Citizen)
JOE FRESH RN: 4703948 SN: 85160029	Registered March 17, 2015	(Int'l Class: 03) cosmetics; lip balm	Jfi Global Purchasing LLC (Delaware Limited Liability Company)
JOE GROOMING RN: 3042419 SN: 78206566 Disclaimer: "GROOMING"	Renewed January 10, 2016	(Int'l Class: 03) men's hair care products, namely, shampoo, conditioner, gel, pomade, grooming compound, grooming cream, [shine,] hair spray; shave cream, shave lotion; cologne, perfume	Joe Grooming, LLC (Delaware Limited Liability Company)
RODEO JOE RN: 5819111 SN: 88220815	Registered July 30, 2019	(Int'l Class: 03) Shampoo-conditioners; Shampoos; Hair shampoo; Hair shampoos and conditioners; Non-medicated hair shampoos for HUMANS	K6 Cattle Company LLC, Dba Rodeo Joe (Nevada Limited Liability Company)
SOHO JOE RN: 5225376 SN: 79191921	Registered June 20, 2017	(Int'l Class: 03) cosmetics, non-medicated toiletries, non-medicated soaps, body creams, body milks, skin lotions, eye gels, face oils and baby powders; non-medicated toilet cosmetic preparations; hair care and coloring preparations and shampoos and hair conditioners, hair lotion; toilet water; perfumes and perfumed products, namely, eau de cologne and toilet water; face packs, namely, mask pack for cosmetic purposes; non-medicated skin care preparations; bath and shower oils, gels, and bath salts, not for medical purposes; anti-perspirants; deodorants for personal use; facial cleansers; skin cleansing lotion and cleansing milk, skin toners, facial moisturizers; make-up products, namely,	Calpers Investments Limited (Cyprus Limited Liability Company)

TM/AN/RN/ Disclaimer	Status/Status Date	Full Goods/Services	Owner
		lipsticks, mascara, eye make-up, eye shadow, eye brow pencils, eye pencils, lip balms, foundations, nail enamels; baby wipes; depilatory products, namely, depilatory wax	
TRADEMARK GNARLY JOE EST. MMXVII and Design  RN: 5424884 SN: 87345198 Disclaimer: "TRADEMARK" AND "EST. MMXVII"	Registered March 13, 2018	(Int'l Class: 03) non-medicated beard care preparations, namely, creams, lotions, oils, cleaners, balms; shampoo; hair conditioner; aftershave preparations; non-medicated soaps	Timoney, John (United Kingdom Citizen)
WORKING JOE RN: 5232036 SN: 87236037	Registered June 27, 2017	(Int'l Class: 03) skin care products, namely, body lotions, skin creams, and face lotions	Working Joe Skin Care for Dudes, LLC (Michigan Limited Liability Company)
CHEMJOE NOT YOUR AVERAGE JOE .COM and Design  SN: 88057915 Disclaimer: ".COM"	Published July 2, 2019	(Int'l Class: 05) Air deodorizer; Car deodorizer; Deodorizing products, namely, all purpose deodorizer preparations for household, commercial and industrial use; Disinfectants; Disposable sanitizing wipes; Herbicides; Household deodorizer; Insecticides; Sanitizing wipes	Spano, Michael (United States Citizen)
FIREMAN JOES RN: 4419539 SN: 85663900	Registered October 15, 2013	(Int'l Class: 05) dietary and nutritional supplements	Mcrae, Inc. (Utah Corp.)
OUTDOOR JOE'S and Design	Registered 8 & 15 December 12, 2014	(Int'l Class: 05) homeopathic preparation for the treatment of skin rashes, namely, poison ivy rash, poison oak rash, and poison sumac rash	Stein, Michael F. (United States Citizen)

TM/AN/RN/ Disclaimer	Status/Status Date	Full Goods/Services	Owner
 RN: 3708441 SN: 77717251			

The common use of JOE or JOEY as a formative term indicates that consumers will not focus merely on the JOE or JOEY portion in a vacuum, but instead will incorporate other indicia and the overall impression in considering the source designated by the entirety of each mark. In a crowded field, even minor differences between the marks may be sufficient to conclude that there is not a likelihood of confusion. *See, In re Hartz Hotel Services, Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012) (precedential) (finding GRAND HOTELS NYC not likely to cause confusion with the mark GRAND HOTEL for the same services in light of numerous uses of the wording “grand hotel,” inferring that the Trademark Office has historically registered “grand hotel” marks “to different parties so long as there has been some difference, not necessarily created by a distinctive word, between the marks as a whole.”); *In re Boston Juicery, LLC*, 2018 TTAB LEXIS 313 *14 (TTAB 2018) (“Given the number of third-party registrations for the involved goods or services, consumers are conditioned to look for differences between SQUEEZE and SQUEEZE formative marks to determine the source of a given product and therefore less likely to be confused. This factor weighs against finding a likelihood of confusion.”); *Anthony's Pizza & Pasta Int'l, Inc.*, 95 U.S.P.Q.2d 1271, 1283 (TTAB 2009) (“The testimony, third-party registrations, and telephone listings are sufficient to show that the name ‘Anthony’s’ has been extensively adopted, registered and used as a trademark for restaurant

services, in particular for Italian restaurants and pizzerias, ... As a result, a mark comprising, in whole or in part, the name ‘Anthony’s’ in connection with restaurant services should be given a restricted scope of protection.”).

The Office Action’s logic is premised on the interpretation that JOE/JOEY is the dominant term of each mark. The Office Action gives the formative a broad scope of protection, while discounting the disclaimed portions of the marks:

With respect to the applied-for mark LITTLE JOEY and the registered marks JOEY NEW YORK and JOEY SALTS, these marks share the same dominant word “JOEY”. The wording “NEW YORK” and “SALTS” in the registered marks are disclaimed, and disclaimed matter that is descriptive of or generic for a party’s goods is typically less significant or less dominant when comparing marks.

Giving a broad interpretation to a weak formative is an incorrect approach.

For instance, JOEY NEW YORK and JOEY SALTS overlap on identical goods such as “skin lotion” and “body lotion.” Applying the Office Action’s focus on JOEY as the dominant portion of each mark logically compels a conclusion that the cited marks are confusingly similar to each other. However, the coexistence of the cited registrations indicates that this interpretation is incorrect. Instead, the coexistence illustrates that the Trademark Office has historically treated “Joey” as a weak formative,

Similarly, Reg. No. 4,703,553 for JOEY HEALY & Design which includes “eyebrow pencils” coexists with the cited JOEY NEW YORK registration which includes “eyebrow pencils.” Using the Office Action’s logic, JOEY would be considered the dominant portion of JOEY HEALY - “Healy” would be discounted as a surname. The Office Action’s logic would then compel a conclusion that JOEY HEALY and JOEY NEW YORK are confusingly similar to each other. Yet, the coexistence of these registrations again indicates that this logic is incorrect.

As a further example, the mark MIGHTY JOE for “cosmetics” is allowed over both JOEY NEW YORK and JOEY SALTS which each include cosmetic products. The MIGHTY JOE mark is somewhat analogous to the LITTLE JOEY mark to the extent MIGHTY JOE couples a size indicative adjective with a JOE formative. The USPTO’s allowance of MIGHTY JOE over the JOEY NEW YORK and JOEY SALTS registrations again corroborates that the interpretation and logic asserted in the Office Action is overly broad.

Further still, Reg. No. 2,700,734 for the single word JOE for men’s hair care products coexists with multiple third-party JOE-formative marks for men’s hair care products including CUTTER JOE’S, DR JOE LAB, HEY JOE, JOE GROOMING (with “grooming” disclaimed), RODEO JOE, SOHO JOE, and GNARLY JOE. The coexistence of these marks indicates that it is established USPTO practice to treat JOE and/or JOEY as a weak formative, and to allow multiple marks to coexist so long as there is at least some difference between the marks as a whole.

Because JOE and/or JOEY is a weak formative, each of the cited registrations should be construed narrowly, reducing any likelihood of confusion. *Carefirst of Maryland, Inc.*, 77 USPQ2d 1492, 1509 (TTAB 2005) (“If the common elements of conflicting marks are words that are descriptive or suggestive (i.e., ‘weak’), then this reduces the likelihood of confusion.”)

LITTLE JOEY Versus JOEY NEW YORK and JOEY SALTS

Comparing LITTLE JOEY to JOEY NEW YORK and JOEY SALTS, the marks are not literally the same in sight or sound. Each of “New York” and “Salts” contributes to the overall impression and they are radically different in sight, sound and meaning from the word “Little.” Moreover, while “New York” and “Salts” may each be disclaimed, each portion must still be

given meaningful weight as part of the whole, especially when the “Joey” portion is a weak formative.

The cited marks also differ in format. LITTLE JOEY is composed of an adjective modifying the word JOEY and the design of a koala bear in an inner tube. This is in contrast to a first word JOEY followed by either the noun NEW YORK a famous location or the noun SALTS indicating the type of product. The meaning/concept of NEW YORK is incongruous with the concept of a Koala bear, which normally is geographically associated with Australia. Similarly, the meaning/concept of SALTS is incongruous with a Koala bear

The marks also convey different meanings of the word JOEY. As mentioned in the Office Action, JOEY can be a nickname for “Joe.” Consistent with this, JOEY NEW YORK conveys the impression and has the format of a first name and last name combination with “Joey” as a first name and New York comparable to a surname. Indeed, the “Joey” portion is based on the first name of its founder Joey Chancis. Exhibit A, <https://joeynewyork.com/about.html> Similarly, JOEY SALTS has the format of “Joey” as a first name and SALTS comparable to a surname.

In contrast, rather than indicating a personal name, LITTLE JOEY refers to a young marsupial, especially in the context of Applicant’s Koala design. According to its ordinary meaning, JOEY would be understood to refer to a young koala:



- “Joey” is a specific term that is used to state a koala offspring or a koala baby. Therefore; a baby koala is called a joey. <http://koalainfo.com/a-baby-koala-is-called-joey> Exhibit B
- Like all marsupial babies, baby koalas are called joeys. <https://www.nationalgeographic.org/media/koala-and-joey/> Exhibit C
- The immature young of a marsupial, notably a junior kangaroo, but also a young wallaby, koala, etc. <https://www.yourdictionary.com/joey> Exhibit D

The use of “Little,” which is commonly used to allude to young animals, reinforces this meaning.

Consistent with USPTO practice, the differences in sight, sound and meaning between LITTLE JOEY and either and/or both of JOEY NEW YORK and JOEY SALTS are sufficient to conclude that there is no reasonable likelihood of confusion.

Comparing LITTLE JOEY to LITTLE JOE

The commercial impressions of LITTLE JOEY compared to LITTLE JOE in a crowded field and coupled with the differences in the goods discussed below is sufficient to conclude that there is no reasonable likelihood of confusion.

The respective goods are not the same or related. As emphasized by the TTAB, “it is the Examining Attorney’s burden to make a *prima facie* showing that the goods are related.” *In re Princeton Tectonics, Inc.*, 95 USPQ2d, 1509, 1512 (TTAB 2010). Here, the marks are for significantly different goods in different classes. Applicant’s goods are “Outdoor skin tanning preparations, body wash, skin soaps and skin moisturizers” in class 3, whereas the registered LITTLE JOE mark is for “Air deodorizing preparations” in class 5. Mingling the cited registrations, the Office Action asserts that the goods from all three cited registrations are related to Applicant’s goods³, saying:

The attached Internet evidence, consisting of screenshots of webpages from entities offering the applied-for tanning preparations, body wash, soaps, and skin moisturizers, and the registered air deodorizers, body scrubs, body lotions, and skin care products, establishes that the same entity commonly provides the relevant goods and markets the goods under the same mark.

When the goods are not the same, the analysis considers the circumstances in which the respective goods are sold and the relevant purchasers. The Office must show, “that

³ The Office Action’s approach treats the goods of all three cited registrations as related to each other, which again would lead to the improper conclusion that the cited registrations are confusingly similar to each other. This reinforces that the Office Action is interpreting the cited registrations too broadly.

circumstances surrounding the marketing of the respective goods would result in relevant purchasers mistakenly believing that the goods originate from the same source when the same mark is used on both types of goods.” *In re Princeton Tectonics*, 95 USPQ2d at 1511. “The burden is on the Trademark Examining Attorney to prove that there in fact is an overlap or similarity in purchasers and trade channels.” *In re Band-it-IDEX, Inc.* 2009 TTAB LEXIS 659 *16 (TTAB Oct. 20, 2009).

In support of its premise, the Office Action cites pages from five websites:

- BATH & BODY WORKS: <https://www.bathandbodyworks.com/m/about-wallflowers.html>, <https://www.bathandbodyworks.com/c/bodycare/body-wash-shower-gel>, <https://www.bathandbodyworks.com/c/body-care/body-scrub>, <https://www.bathandbodyworks.com/c/bodycare/>, body-lotion, <https://www.bathandbodyworks.com/g/home-fragrance>
- DUNHAM’S HOME: <https://bestdamnlotions.com/dunhams-home-air-fresheners-a-z/seasonal-air-fresheners/>, <https://bestdamnlotions.com/creams-lotions-moisturizers/>
- THYMES: <http://www.thymes.com/Products/Home-Fragrance-Mists/>, <http://www.thymes.com/Bath-And-Body/>
- WHISH: <https://whishbody.com/collections/skin-care-1>, <https://whishbody.com/collections/body-care>
- THE BODY SHOP: <https://www.thebodyshop.com/en-us/search?text=TANNING&autosuggest=No&typed=TANNING>, <https://www.thebodyshop.com/en-us/skin-care/view-all/c/c03208>, <https://www.thebodyshop.com/en-us/body/view-all/c/c03210>

The evidence does not support that “Outdoor skin tanning preparations, body wash, skin soaps and skin moisturizers” in class 3 are related to “Air deodorizing preparations” in class 5.

As a starting point, the cited pages from the WHISH website and THE BODY SHOP website include only skin care and body care products. The webpages do not include any air preparations whatsoever. Accordingly, they do not support that there is any relationship between Applicant’s goods and air deodorizing preparations.

The cited pages from the BATH & BODY WORKS, DUNHAM’S HOME and THYMES websites also do not include any “air deodorizing preparations.” They include air

fragrance products – but those are the opposition of “air deodorizing preparations.” By definition, a deodorizer removes odors, “deodorize: to rid of odor, especially of unpleasant odor.” <https://www.dictionary.com/browse/deodorize> Exhibit E. Instead of absorbing and removing odors from the air, air fragrances add scents to the air. For instance, the cited Bath and Body Work pages explain that the products, “make it safe & easy to keep the air fresh with your favorite scents” and “Enjoy 24/7 Room-Filling Fragrance” and “so your home is filled with fragrance.” The cited webpages do not include any odor removing preparations. Accordingly, they do not support the Office Action’s premise.

Even assuming *arguendo* that air deodorizing preparations are related to air fragrancing products, they are not shown to be related to Applicant’s goods. Even if air fragrances and skin care products are sold in the same mass market websites and/or even if they are marketed under the same umbrella house brand, they are treated as different product categories for different purposes. The cited webpages do not clearly indicate how they were generated, but the cited evidence appears to rely on manually selected individual webpages which are only viewable after using different navigation and search tools. For instance, the cited air fragrance products from the Bath & Body Works website are from the category “Home Fragrance” with sub-categories such as “candles,” “Wallflower plugs,” “Wallflower melts,” “Room Sprays & Mists” and “Car Fragrance.” In contrast, the other Bath & Body Works website pages are from the category “body care” with sub-categories such as “Body Wash & Shower Gel,” “Body Scrub,” and “Body Lotion.” Similarly, the Office Action juxtaposes pages from a category of “Seasonal Air Fresheners” from Dunham’s Home with webpages from a different category called “Lady Dunham’s Lotions, Moisturizers and More” for skin care products. The Thymes website similarly puts “Bath & Body” products and “Home Fragrance” in different categories. The cited

websites illustrate that the respective goods are not naturally grouped together, but are only individually viewable after using different navigation selections. Separate webpages juxtaposing different categories of goods do not support a conclusion that the respective goods are related. *Carl Walther GmbH v. Herriger*, 2017 TTAB LEXIS 356, *25 (TTAB Sept. 1, 2017) (rejecting “separate webpages from mass-market retailer Walmart” as insufficient “To show relatedness,” citing *Morgan Creek*).

Conclusion

Considering both the differences in the respective marks and the differences in the respective goods, Applicant asserts that there is no reasonable likelihood of confusion. Applicant requests that the refusals to register be withdrawn. Applicant submits that the mark is in condition for publication and allowance, and action towards such is respectfully requested. If there are any questions with regard to the application or this response, the Examining Attorney is invited to telephone the undersigned to expedite this application.

Respectfully submitted

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