

This Opinion is not a
Precedent of the TTAB

Mailed: September 29, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Zen Marketing, LLC

Serial No. 86487195

Luke Brean of the BreanLaw LLC,
for Zen Marketing, LLC

Tricia L. Brown, Trademark Examining Attorney, Law Office 121,
Michael W. Baird, Managing Attorney.

Before Kuhlke, Ritchie and Pologeorgis,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Zen Marketing, LLC (“Applicant”) seeks registration on the Principal Register of the mark ZEN TEA TRADERS and design (TEA TRADERS disclaimed), as displayed below,



for “Black tea; Earl Grey tea; Fruit teas; Green tea; Japanese green tea; Oolong tea; Rooibos tea; Tea; Tea for infusions” in International Class 30.¹

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, when used in connection with the identified goods, so resembles the following two marks (owned by different registrants) registered on the Principal Register:



for “tea” in International Class 30 (hereinafter referred to as the “First Cited Mark”);² and

¹ Application Serial No. 86487195 filed on December 20, 2014, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming January 2008 as both the date of first use and the date of first use in commerce.

² Registration No. 4220746, registered on October 9, 2012. The description of the mark reads as follows: The color(s) light green, light brown, orange and dark brown is/are claimed as a feature of the mark. The mark consists of the term “Zen tea” with the letter “Z” in orange, a dark brown “E”, a light green “N” and “tea” in dark brown. The term “Experience the Zen of Tea” appears directly below in light green. The design of a leaf appears above the wording in the colors light green, light brown and orange.

MY ZEN TEA (in standard characters; TEA disclaimed) for “Tea, herbal tea, tea-based beverages, coffee, sugar, spices” in International Class 30 (hereinafter referred to as the “Second Cited Mark”).³

When the refusal was made final, Applicant appealed. The appeal is briefed. We reverse the refusal to register.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. *Relatedness of the Goods and Trade Channels.*

Turning first to the goods, we must determine whether their degree of relatedness to the goods in the cited registrations rises to such a level that consumers would mistakenly believe the goods emanate from the same source. The comparison must be based on the identifications in the applications and the cited registrations. *See*

³ Registration No. 4571029, registered on July 22, 2014.

Stone Lion Capital Partners, LP v. Lion Capital LLP, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). If likelihood of confusion exists with respect to any of Applicant's identified goods in a particular class, the refusal of registration must be affirmed as to all goods in that class. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Here, Applicant's International Class 30 "tea" is identical to "tea" identified in both of the cited registrations. Furthermore, Applicant's remaining International Class 30 goods, i.e., "Black tea; Earl Grey tea; Fruit teas; Green tea; Japanese green tea; Oolong tea; Rooibos tea; Tea for infusions" are encompassed by each of the cited registrations more broadly defined "tea," and are, therefore, identical in part to the goods identified in the cited registrations.

In view thereof, the *du Pont* factor relating to the similarity of the goods weighs in favor of likely confusion. Applicant does not dispute this finding.

Because Applicant's "tea" goods are identical to the goods in the cited registrations, and since Applicant's remaining International Class 30 goods are identical in part to goods identified in both of the cited registrations, it is presumed that Applicant's goods and the goods identified in each cited registration are offered in the same channels of trade and to the same class of purchasers normal for those goods. *See In re Viterra Inc.*, 101 USPQ2d at 1908 (the Board may rely on this legal presumption in determining likelihood of confusion). *See also Paula Payne Products*

Co. v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.”).

B. Comparison of the Marks

We next address the *du Pont* likelihood of confusion factor focusing on “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quotation omitted).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d

1005, 212 USPQ 233, 234 (CCPA 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.”). On the other hand, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Nat’l Data*, 224 USPQ at 751.

Applicant’s mark consists of the wording ZEN TEA TRADERS in white, stylized font. The term ZEN is depicted in large, stylized font with a handwritten appearance on the line above “TEA TRADERS,” which appears in smaller, more standard font. The literal elements of the mark overlay a black oval with a white border. Stylized green tea leaves appear along the outside edges of the oval.

The First Cited Mark is ZEN TEA and appears in a different color scheme consisting of pastel yellow, brown, and green with the tagline “EXPERIENCE THE ZEN OF TEA.” The First Cited Mark also includes a design element consisting of a stylized leaf.

The Second Cited Mark consists solely of the wording “MY ZEN TEA,” absent any design element.

While we recognize that Applicant’s mark and the cited marks each include the term ZEN and the generic wording TEA, we must nonetheless look at Applicant’s mark, in its entirety, in our analysis herein, including the disclaimed wording TEA TRADERS. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1676 (Fed. Cir. 2015) (inadequate consideration given to the word JUICE in

mark for juice bar services). Turning to this disclaimed wording, we agree with Applicant that the term TEA TRADERS evokes the idea of entrepreneurs who travel the world in search of the finest teas, and connects Applicant's brand with an ancient means of commerce, namely, traveling and trading goods. We therefore find that the inclusion of the wording TEA TRADERS in Applicant's mark creates a commercial impression that is absent from both of the two cited marks.

Moreover, the color schemes and leaf designs incorporated in Applicant's mark and the First Cited mark differentiate the marks visually. Similarly, the tagline "EXPERIENCE THE ZEN OF TEA" included in the First Cited Mark highlights the nature of the tea itself and therefore creates a different commercial impression when compared to Applicant's mark.

The Second Cited Mark consists simply of the wording "MY ZEN TEA" without any design elements. The inclusion of the term "MY" in the Second Cited Mark conveys a differing commercial impression that the registrant's tea is personalized and is designed to fit the specific needs of each consumer.

While we recognize that there are certain similarities between the Applicant's mark and the cited marks, we nonetheless find that the differences in appearance and commercial impression of the marks, when viewed in their entirety, outweigh any similarities and therefore, find that Applicant's mark, considered in its entirety, to be sufficiently dissimilar to both of the cited marks.

The first *du Pont* factor thus does not support a finding that confusion is likely.

Applicant also argues that the term ZEN is weak when used in connection with International Class 30 goods. In support of this contention, Applicant has submitted copies of the following third-party registrations:

Registration No. 4519841 for the mark ZEN (in standard characters) for “pudding, live culture non-dairy organic dessert puddings,”



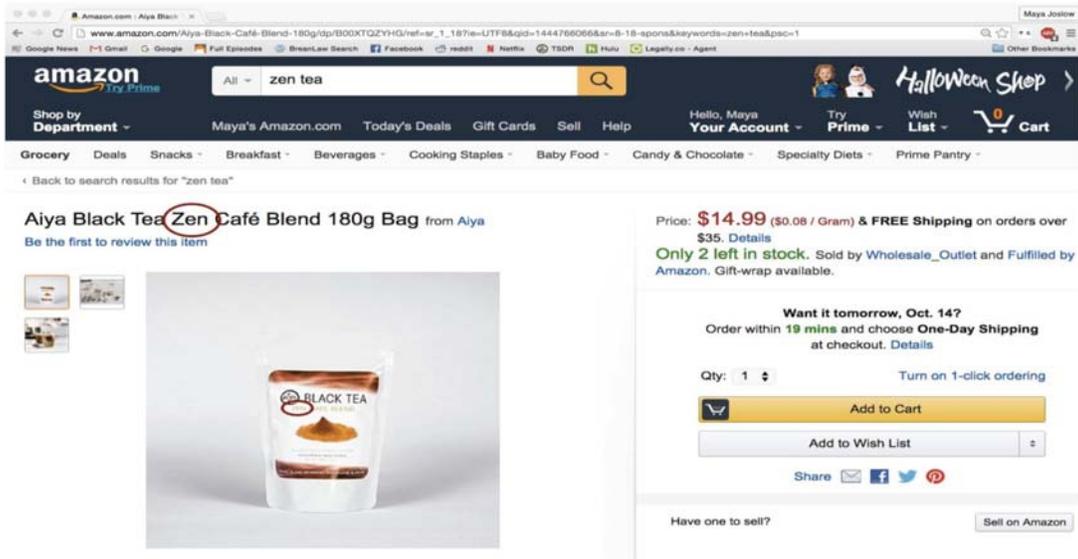
Registration No. 3340888 for the mark  for “food seasonings, salt, seasoning blends, seasoning mixes, spices, spice blends, spice mixes,”

Registration No. 4229434 for the mark JEN’S ZEN (in standard characters) for “toppings and treats,” and



Registration No. 4470031 for the mark  for “tea.”

Additionally, Applicant has submitted screen shots from the Amazon.com website displaying advertisements for various teas sold by third-parties that include the term ZEN as a source indicator for the goods. The screenshots are displayed below:



The screenshot shows the Amazon.com product page for 'Tea Zen, Instant Green Tea Latte, 145 g (14.5 g x 10 sticks)'. The product is by Tea Zen and is priced at \$26.22 with free shipping. It is currently in stock, with only 10 units left. The seller is beststorebykk. The page includes a search bar with 'zen tea', a navigation menu, and a 'Halloween Shop' banner. A 'Share' button and social media icons are visible. The quantity is set to 1, and there is an 'Add to Cart' button. A shipping address of PORTLAND, OR 97201 is shown. There is also an 'Add to Wish List' button and a 'Sell on Amazon' button.

Product Description

Instant Green Tea

The screenshot shows the Amazon.com product page for 'Tazo Zen Green Tea 2-pack; 40 Tea Bags'. The product is from Tazo Teas, Zen, Green Tea, 20 Filterbags, 1.5 oz. It has a 4.5-star rating from 31 customer reviews. The price is \$12.09 (\$0.60 / Count) with free shipping on orders over \$35. It is in stock on October 15, 2015. The page includes a search bar with 'zen tea', a navigation menu, and a 'Halloween Shop' banner. A 'Share' button and social media icons are visible. The quantity is set to 1, and there is an 'Add to Cart' button. A shipping address of PORTLAND, OR 97201 is shown. There is also an 'Add to Wish List' button and a 'Sell on Amazon' button. The 'Other Sellers on Amazon' section lists three sellers: ViaCafe at \$9.27, Livamed at \$12.12, and Revolving Front at \$12.49.

About the Product

The Federal Circuit has stated that evidence of the extensive registration and use of a term by others can be “powerful” evidence of weakness. *See Jack Wolfskin*

Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U., 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) and *Juice Generation, Inc. v. GS Enters. LLC*, 115 USPQ2d at 1674. Moreover, under the sixth *du Pont* factor, the Board must consider evidence of “[t]he number and nature of similar marks in use on similar goods.” *In re E.I. du Pont de Nemours & Co.*, 177 USPQ at 567. The type of strength (or its inverse, weakness) addressed by the sixth *du Pont* factor is sometimes referred to as market or commercial strength. This is the degree of association in the mind of the consumer of the mark with the source of the goods or services based on the exclusivity (and sometimes renown) of the mark in the relevant market. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881 (TTAB 2006).

In evaluating the strength or, in this instance, the weakness of the term ZEN when used in association with tea or tea-related products, the Board initially notes that three of the four third-party registrations submitted by Applicant are of limited probative value because they do not cover tea or tea-related products. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (the third-party registrations are of limited probative value because the goods identified in the registrations appear to be in fields which are far removed from the goods at issue).

That being said, however, we find that the co-existence of the third-party

registration for the mark  for “tea” with the two cited registered marks also for “tea,” coupled with the advertisements submitted by Applicant for various teas sold by other third-parties that include the term ZEN as a source indicator for the goods, tends to show that the term ZEN is relatively weak as a source indicator for tea. In light of the relevant weakness of the term ZEN in connection with “tea,” we find that the differences between Applicant’s mark and the marks in the cited registrations are sufficient to distinguish them. Accordingly, the *du Pont* factor concerning the commercial strength (or in this case, the weakness of the term ZEN) also supports a finding that confusion is unlikely.

C. Conclusion.

On balance, after considering all the evidence and arguments bearing on the *du Pont* factors, including the evidence and arguments that we have not specifically discussed herein, we conclude that, although Applicant’s mark and the cited marks share some similarities, the differences in appearance and commercial impression, as well the relative weakness of the term ZEN in connection with tea, is sufficient to distinguish the marks so that confusion between the marks is not likely.

Decision: The refusal to register Applicant’s ZEN TEA TRADERS and design mark under Section 2(d) of the Trademark Act is reversed.