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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/527093

MARK: ROOBI



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

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<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Gastroceuticals, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

T/5527-3

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

The Office has reassigned this application to the undersigned trademark examining attorney.

INTRODUCTION

The applicant, Gastroceuticals, LLC, has appealed the trademark examining attorney's refusal to register the trademark ROOBI on the grounds that there is a likelihood of confusion with the registered mark RUBYY owned by Rubyy, LLC, in U.S. Registration No. 3415865. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

STATEMENT OF FACTS

On July 21, 2008, the applicant filed an intent to use application seeking registration of the mark ROOBI in standard characters for "water enhanced with antioxidants" in Class 032.

In the Office action dated September 8, 2008, the initial examining attorney refused registration of the applied-for mark under Section 2(d) of the Trademark Act because of a

likelihood of confusion with the registered mark RUBYY for “energy drinks; non-alcoholic beverages containing fruit juices” in Class 032 in U.S. Registration No. 3415865. The examining attorney provided (1) Internet evidence from an online beverage retail demonstrating that the applicant’s goods and the registrant’s goods are sold in similar channels of trade, (2) Internet evidence from an energy drink and bottled water company demonstrating that the applicant’s goods may be sold in direct competition with the registrant’s goods, (3) third party U.S. registrations and Internet evidence demonstrating that the goods at issue are of a type that may emanate from a single source and (4) evidence from the Merriam-Webster online dictionary defining the term “antioxidant” demonstrating that the applicant’s goods and the registrant’s goods are similar in nature and may be sought by consumers for a similar purpose. Additionally, within this same Office action, the examining attorney determined that the applicant’s identification of goods was unacceptable because it was indefinite and the applicant needed to specify the common commercial or generic name for the goods.

Within its response dated March 6, 2009, the applicant argued against the likelihood of confusion refusal, submitting as evidence third party U.S. registrations for marks containing the term RUBY for “fruit juices” and Internet evidence from the registrant’s web site. Additionally, within this same response, the applicant amended the identification of goods to “drinking water enhanced with antioxidants” in Class 032.

On March 18, 2009, the examining attorney accepted the applicant’s amended identification of goods and made final the refusal to register the proposed mark under Trademark Act Section 2(d). The examining attorney submitted third party U.S. Registrations for similar goods as those of the applicant and registrant in this case

demonstrating that the goods at issue are similar because they are of the type of drinks that may emanate from a single source and are marketed under a single brand.

Additionally, the examining attorney provided Internet evidence from drink manufacturers demonstrating (1) that within the beverage industry, manufacturers commonly use a single brand on drinking water and fruit juice drinks or energy drinks, and (2) that the applicant's goods and the registrant's goods are similar in nature because they both contain antioxidants.

On September 15, 2009, the applicant, through newly appointed counsel, filed separately a Notice of Appeal with the Trademark Trial and Appeal Board and a request for reconsideration of the final refusal. In the request for reconsideration, the applicant reiterated its arguments that the marks at issue are different and argued that consumers of beverages are sophisticated. In support of the claim of consumer sophistication, the applicant submitted as evidence Wikipedia pages defining "bottled water" and describing global sales of bottled water as well as Internet evidence from other web sites describing bottled water sales, energy drinks and water. The applicant also submitted a TESS search results page for registered marks covering bottled water at the USPTO.

On September 21, 2009, the examining attorney denied the request for reconsideration arguing that the applicant's mark and the registrant's mark are similar in appearance and sound. Additionally, the examining attorney rejected the applicant's claim that its consumers are sophisticated because the applicant's evidence does not support such a claim. Finally, the examining attorney objected to the applicant's submission of a printout of TESS search results from the USPTO web site because the applicant merely provided the search results and not the copies of the USPTO registrations. The

examining attorney informed the applicant that the mere submission of a list of registrations does not make such registrations part of the record. The applicant has failed to properly submit this evidence and therefore the examining attorney objects to the admission of this evidence. [Please see page 18 of this brief.]

On December 4, 2009, the applicant filed an Appeal Brief with the Trademark Trial and Appeal Board. On December 7, 2009, the application was forwarded to the initial examining attorney for a brief in accordance with Trademark Rule 2.142(b). On January 14, 2010, the Office reassigned the application to the undersigned examining attorney.

ISSUE

The sole issue on appeal is whether, under Section 2(d), there is a likelihood of confusion between the applicant's mark ROOBI in standard characters for "drinking water enhanced with antioxidants" and U.S. Registration No. 3415865, RUBYY in standard characters for "energy drinks; non-alcoholic beverages containing fruit juices."

ARGUMENT

THE APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO THE REGISTRANT'S MARK AND THE GOODS ARE CLOSELY RELATED SUCH THAT A LIKELIHOOD OF CONFUSION EXISTS UNDER SECTION 2(d) OF THE TRADEMARK ACT.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and

registrant. See 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). See TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods. See *In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

A. ROOBI is Confusingly Similar to RUBYY

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); see TMEP §1207.01(b).

The applicant's mark is ROOBI. The registrant's mark is RUBYY. The applicant's mark is highly similar to the registrant's mark because the marks are essentially phonetic

equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975); *see* TMEP §1207.01(b)(iv). There is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 484 (TTAB 1985); TMEP §1207.01(b)(iv); *see In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983). Here, the marks in question, ROOBI and RUBYY, could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *See RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975); TMEP §1207.01(b)(iv).

The applicant argues that the marks at issue are distinguishable because the applicant's mark contains the letters "OO" and "I" where as the registrant's mark is spelled with the letters "U" and "Y." [See Applicant's Brief pg. 13, TTABVUE pg. 14.] The applicant also alleges that the examining attorney does not dispute that the marks do not appear visually similar. [See Applicant's Brief pg. 14, TTABVUE pg. 15.] However, the applicant's characterization of the examining attorney's arguments with respect to the visual similarity between the marks at issue is mistaken and the applicant's arguments are not persuasive.

Throughout the course of examination of the instant application, the examining attorney has argued that the marks at issue are similar in appearance, sound, meaning, connotation and commercial impression. [See Examining Attorney's Office Actions

dated September 8, 2008, March 18, 2009 and September 21, 2009.] With respect to appearance, the proposed mark ROOBI is similar to the registered mark RUBYY because both marks are comprised solely of one term beginning with the letter “R” containing vowels after the letter “R” and before the letter “B” in the terms. Additionally, both the applicant’s mark and the registrant’s mark are presented in standard characters and could therefore appear in the same typeface with the same stylization. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element itself and not in any particular display. TMEP §1207.01(c)(iii); *see* 37 C.F.R. §2.52(a).

Next, the applicant argues that the marks at issue create a different commercial impression. [*See* Applicant’s Brief pg. 14.] First, the applicant argued that given the number of trademark registrations for marks containing the term “RUBY,” consumers would look to other elements in the applicant’s mark, i.e. the “OO,” and to the additional letter “Y” in the registrant’s mark. [*See* Applicant’s Brief pg. 14, TTABVUE pg. 15.] Additionally, the applicant argued that the registrant’s mark conveys an image of the intense color of the ruby blood orange and is therefore descriptive of the registrant’s goods where as the applicant’s mark is not descriptive of the color of the applicant’s goods. [*See* Applicant’s Brief pg. 14, TTABVUE pg. 15.] However, these arguments are not persuasive. First, as stated above, similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975); *see* TMEP §1207.01(b)(iv). The applicant’s mark and the registrant’s mark are phonetic equivalents and thus, similar in sound. The only difference between

the marks at issue is the letters “O” and “I” in the applicant’s mark and the letters “U” and “Y” in the registrant’s mark. This difference does not change the commercial impression of the marks. Rather, the marks ROOBI and RUBYY could clearly be pronounced the same. In fact, the marks both appear to be novel spellings of the term “ruby.” As such, the applicant’s mark and the registrant’s mark both create the connotation and impression as that conveyed by the term “ruby.” Furthermore, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b). Here, ROOBI and RUBYY are phonetic equivalents and indistinguishable when spoken. Thus, the average purchaser will remember the same sounding words when asking for the goods.

Additionally, the applicant argues that the registrant’s mark is weak and only entitled to a limited scope of protection. [See Applicant’s Brief pgs. 14 – 17, TTABVUE pgs. 15-18.] This argument is not persuasive. First, the Court of Appeals for the Federal Circuit

and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); *see King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975). Here, as evidenced by U.S. Registration No. 3415865, the registrant’s mark RUBYY is registered on the Principal Register without a claim of acquired distinctiveness under Section 2(f). [See U.S. Registration No. 3415865 attached to Examining Attorney’s First Office Action dated September 8, 2008.] The examining attorney concludes therefore that the registered mark RUBYY is an inherently distinctive source identifier for energy drinks and non-alcoholic beverages containing fruit juices owned by the registrant. Next, on the continuum of distinctiveness, a mark is suggestive if some imagination, thought or perception is needed to understand the nature of the goods and/or services described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods and/or services. *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); TMEP §1209.01(a); *see In re Shutts*, 217 USPQ 363, 364 (TTAB 1983). Here, the registered mark RUBYY is not merely descriptive of the registrant’s goods. Considering the registrant’s web site evidence submitted by the applicant concerning the argument of descriptiveness, it is necessary to view the statements quoted by the applicant in the

context of the registrant's use on the web site. [See Exhibit B attached to Applicant's March 6, 2009 Response to Office Action.] The web site reveals the registrant introducing the concept for its product by stating that "[t]he origin of Rubyy is a hybrid of the exotic, the scientific and the mystic. Rubyy takes its name from the deep, rich flavor and color of the ruby blood orange. Found in the sun-dense latitudes of Italy, Spain, the South of France, and the North of California, the blood orange is known for its vibrant, distinctive and explosive citrus flavor." [See Exhibit B attached to Applicant's March 6, 2009 Response to Office Action.] This creative promotional language used by the registrant does not describe the actual color and flavor of the registrant's goods but rather calls upon the consumer's imagination evoking ideas of warmth, heat and vibrancy offered by the sunny exotic regions of southern Europe and northern California. Consequently, this wording is suggestive of the applicant's goods. Furthermore, the record is devoid of any evidence of the definition of the term "ruby" as a particular color or flavor and devoid of any evidence of the definition of ruby blood oranges. Moreover, the applicant's argument that the additional letter "Y" in the registrant's mark likely conveys that the product exudes an intense level of color supports the determination that RUBY is not merely descriptive but suggestive of the registrant's goods. [See Applicant's Brief pg. 14, TTABVue pg. 15.] The idea of an energy drink or fruit juice drink exuding an intense level of color does not immediately describe a characteristic of the beverages but rather requires some imagination, thought or perception to understand the nature of the goods. Any doubts surrounding the descriptiveness of a mark are to be resolved in the applicant's favor. *In re The Rank Organization Ltd.*, 222 USPQ 324, 326 (TTAB 1984); *In re Conductive Sys.* 220 USPQ 84 (TTAB 1983). Thus, any doubt

surrounding the descriptiveness of the registered mark is to be resolved in the favor of the registrant.¹

Furthermore, the applicant's argument that existence of third party registrations containing the term RUBY limits the scope of protection for the registered mark is not persuasive. [See Applicant's Brief pgs. 14-16, TTABVUE pgs. 15-17.] With respect to the third party registrations submitted by the applicant, the examining attorney notes that U.S. Registration Nos. 2664686 and 2214712 are cancelled and therefore should not be considered. [See Exhibit A attached to Applicant's March 6, 2009 Response to Office Action.] Next, the marks contained in these third party registrations are distinguishable from the applicant's mark and the registrant's mark. First, the marks in the third party registrations are all composite marks, i.e. they are marks containing more than one element. [See Exhibit A attached to Applicant's March 6, 2009 Response to Office Action.] Thus, these marks contain other literal elements involved in comparing the marks under a likelihood of confusion analysis. The other elements in the these third party registrations may explain their coexistence on the register and not support a finding that marks containing the word "ruby" are entitled to a narrow scope of protection as alleged by the applicant. [See Applicant's Brief pg. 15, TTABVUE pg. 16.] Moreover, the additional elements in these third party registrations help consumers differentiate between those marks and the registrant's mark. By contrast, the marks at issue in the instant case ROOBI and RUBYY are solely comprised of the single similar sounding phonetic equivalent term. There is no other wording in the applicant's mark to distinguish it from the registrant's mark. Additionally, the marks in the third party

¹ In any event, it is not proper in an ex parte proceeding to collaterally attach a registration. Again, the cited mark is a viable registration on the Principal Register and therefore enforceable as such. TMEP §1207.01 (d)(iv).

registrations all contain the actual, correctly spelled term RUBY. However, the applicant's mark and the registrant's mark do not. Rather, the marks at issue contain novel spellings for made up terms which sound similar to the term "ruby." Next, none of the remaining active registrations submitted by the applicant containing the term RUBY are used in connection with energy drinks. [See Exhibit A attached to Applicant's March 6, 2009 Response to Office Action.] Thus, the applicant failed to demonstrate that the registrant's mark RUBY is weak or diluted in relation to energy drinks. Similarly, none of the active registrations submitted by the applicant containing the term RUBY are used in connection with drinking water enhanced with antioxidants. [See Exhibit A attached to Applicant's March 6, 2009 Response to Office Action. For example, U.S. Registration No. 1631048 for the mark RUBY KIST and U.S. Registration No. 2743109 for the mark RUBY-MANGO.] Thus, the applicant failed to demonstrate that marks referred to by the applicant as "RUBY-related marks" are weak in relation to the applicant's applied-for goods. Consequently, the applicant has not demonstrated successfully that the registered mark RUBY is entitled to a narrow scope of protection.

Finally, the applicant argues that the co-existence of multiple "RUBY-related" registrations shows a precedent at the Patent and Trademark Office with respect to treatment of "RUBY-related" marks. [See Applicant's Brief pgs. 17-18, TTABVue pgs. 18-19] However, prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406,

177 USPQ 268, 269 (C.C.P.A. 1973); *In re Int'l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994).

As argued above, the applicant's mark ROOBI and the registrant's mark RUBY are confusingly similar in sound, appearance, meaning, connotation and commercial impression. The marks are identical sounding phonetic equivalents both beginning with the letter "R" containing vowels before the letter "B" which create the same overall commercial impression.

B. Drinking Water Enhanced with Antioxidants is Closely Related to Energy Drinks and Non-alcoholic Beverages Containing Fruit Juices

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination requires that the goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi). Additionally, the goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline*

Inc. v. Am. Online Inc., 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Here, the applicant's drinking water is closely related to the registrant's energy drinks and fruit juice drinks because they are similar in nature, the type of beverages that commonly emanate from a single source and are marketed and sold together within the beverage industry market.

Similar in Nature

The applicant's goods and the registrant's goods are similar in nature because they are all beverages containing antioxidants sought by consumers to increase their consumption of antioxidants. [See Web Pages Attached to Examining Attorney's First Office Action dated September 8, 2008.] The evidence from the antioxidant drink manufacturer Optivim Health Solutions at www.opcstore.com and the evidence from the energy drink manufacturer Hydrive Energy at www.hydriveenergy.com show that antioxidant enhanced drinks and energy drinks both contain antioxidants and serve to replenish consumers with essential vitamins and minerals to consumers. [See Web Pages attached to Examining Attorney's Final Office Action dated March 18, 2009.] Thus, the applicant's goods and the registrant's goods are similar in nature and sought out by consumers for similar purposes, e.g. to improve antioxidant defenses.

The applicant argues that the goods at issue are functionally different because energy drinks are marketed and designed to increase consumer's mental alertness and physical performance where as water is meant to quench one's thirst. [See Applicant's Appeal Brief pg. 11, TTABVUE pg. 12.] This argument is not persuasive. By definition, an antioxidant is "a substance (as beta-carotene or vitamin C) that inhibits oxidation or

reactions promoted by oxygen, peroxides, or free radicals.” [See Dictionary Evidence Attached to Examining Attorney’s First Office Action dated September 8, 2008.] Both the applicant’s goods and the registrant’s goods contain antioxidants. [See Applicant’s Response to Office Action dated September 15, 2009 and Exhibit B attached to Applicant’s March 6, 2009 Response to Office Action.] The applicant’s goods consist of drinking water enhanced with antioxidants. Similarly, energy drinks and fruit juices contain antioxidants. [See Exhibit B attached to Applicant’s March 6, 2009 Response to Office Action.] Energy drinks are promoted and recognized within the beverage industry as containing antioxidants. [See Web Pages attached to Examining Attorney’s Final Office Action dated March 18, 2009.] Furthermore, according to the registrant’s web site, the registrant’s energy drink contains vitamins. [See Exhibit B attached to Applicant’s March 6, 2009 Response to Office Action.] Thus, the applicant’s goods are closely related to the registrant’s goods because they share the similar function of inhibiting oxidation or reactions promoted by oxygen, peroxides or free radicals by replenishing the consumer’s vitamins and minerals. Thus, consumers seeking to increase their consumption of antioxidants would drink enhanced water (applicant’s goods) or fruit juices or energy drinks (registrant’s goods).

Next, the applicant argues that the goods at issue are different because the applicant’s goods do not contain any fruit juices and the registrant’s goods are used as a cocktail mixer. [See Applicant’s Brief pgs. 9-10, TTABVUE pgs. 10-11.] However, these arguments are not persuasive. First, the goods of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP

§1207.01(a)(i). Thus, the fact that the applicant's goods do not contain fruit juice does not obviate that the goods at issue are related. Under a likelihood of confusion analysis, it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984). As demonstrated supra and infra, the applicant's goods and the registrant's goods are similar because they both are a source of antioxidants, are of the type of beverages made and sold by a single source and the type of beverages that are commonly marketed and sold together. Secondly, likelihood of confusion is determined on the basis of the goods and/or services as they are identified in the application and registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 1207 n.4, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); TMEP §1207.01(a)(iii). Here, the applicant's goods as identified in the application are "drinking water enhanced with antioxidants" and the registrant's goods as identified in the registration are "energy drinks and non-alcoholic beverages containing fruit juices." [See Registration attached to Examining Attorney's First Office Action dated September 8, 2008.] The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the

registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); *see* TMEP §1207.01(a)(iii). Thus, the registrant is presumed to be the owner of RUBY for energy drinks and non-alcoholic beverages containing fruit juices. As previously discussed, energy drinks are similar to drinking water enhanced with antioxidants because energy drinks are a source of antioxidants to consumers. [See Web Pages attached to Examining Attorney's Final Office Action dated March 18, 2009.] The evidence from www.redbullusa.com and www.drinknation.com, shows that energy drinks may also serve as a cocktail mixer. [See Web Pages attached to Examining Attorney's Final Office Action dated March 18, 2009.] However, the potential use of the registrant's energy drinks as a cocktail mixer does not nullify their consumption as an energy drink with all other product qualities and uses of all standard energy drinks including serving as a source of antioxidants.

Goods that May Emanate from a Single Source

Next, the applicant argues that the applicant's goods and the registrant's goods are not related because the goods at issue fall into two distinct beverage product categories. [See Applicant's Brief pg. 10, TTABVUE pg. 11.] However, this argument is not persuasive. Namely, the applicant's drinking water and the registrant's energy drinks and fruit juice drinks are all types of beverages that are made by the same company and encountered by the same class of purchasers. First, the third-party registrations of record offered by the examining attorney show marks used in connection with the same or similar goods as

those of the applicant and registrant in this case. [See U.S. Registration Nos. 3229753, 3390462, 3420521, 3438203, 3420462, 3532485 attached to Examining Attorney's Final Office Action dated March 18, 2009.] These printouts have probative value to the extent that they serve to suggest that the goods listed therein, namely drinking water, energy drinks and beverages with fruit juices, are of a kind that may emanate from a single source. *In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). Additionally, the commercial evidence from www.snapple.com demonstrates that drinking water enhanced with antioxidants and fruit juice drinks are made and sold by the same company under the same brand SNAPPLE. [See Web Sites attached to Examining Attorney's Final Office Action dated March 18, 2009.] Thus, the third party evidence of record shows that beverage manufacturers commonly use a single brand on both (a) drinking water and (b) energy drinks or fruit juice drinks. This evidence demonstrates that the manufacturing practices and marketing conditions surrounding the goods at issue would give rise to the mistaken belief that the goods come from a common source. Hence, consumers familiar with the registrant's RUBY energy drinks and fruit juice drinks may assume albeit falsely, that the applicant's ROOBI drinking water originates with the registrant.

Marketed and Sold Together within the Beverage Industry

The applicant's drinking water and the registrant's energy drinks and fruit juice drinks may be marketed and sold together within the same channels of trade. A determination of whether there is a likelihood of confusion is made solely on the basis of the goods

and/or services identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); *see* TMEP §1207.01(a)(iii). If the cited registration describes the goods and/or services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods and/or services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii). In the instant case, neither the application nor the registration contains any limitations regarding trade channels for the goods and therefore it is assumed that registrant's and applicant's goods are sold everywhere that is normal for such items, i.e., grocery stores, beverage shops, on-line beverage retailers. Thus, it can also be assumed that the same classes of purchasers shop for these items and that consumers are accustomed to seeing them sold under the same or similar marks. *See Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); TMEP §1207.01(a)(iii). Here, the evidence from www.coffeeforless.com shows that enhanced drinking water and energy drinks are commonly marketed and sold together. [*See* Web Pages Attached to Examining Attorney's First Office Action dated September 8, 2008.] Moreover, the press release evidence from www.prlog.org shows that bottled water and energy drinks are in fact competitive within the beverage market. [*See* Web Pages Attached to Examining Attorney's First Office Action dated September 8, 2008.] Thus, the applicant's goods may not only be marketed and sold together with the registrant's goods,

but also may be in direct competition with them. According to Advanced Beverage Technologies Corporation (“ABT”), within the beverage market, energy drinks and water are “ever-competitive” which prompted this particular beverage company to expand its line of energy drinks to include enhanced drinking water. [See Web Pages Attached to Examining Attorney’s First Office Action dated September 8, 2008.] Evidence that third parties offer the goods and/or services of both the registrant and applicant suggest that it is likely that the registrant would expand their business to include applicant’s goods and/or services. In that event, customers are likely to believe the goods and/or services at issue come from, or are in some way connected with, the same source. *In re 1st USA Realty Prof’ls*, 84 USPQ2d at 1584 n.4; see TMEP §1207.01(a)(v). Any goods or services in the registrant’s normal fields of expansion should be considered when determining whether the registrant’s goods and/or services are related to the applicant’s goods and/or services. TMEP §1207.01(a)(v); see *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1584 (TTAB 2007). Thus, enhanced drinking water should be considered within the registrant’s normal field of expansion thereby increasing the likelihood that consumers will mistakenly believe the applicant’s goods come from or are in some way connected with the registrant.

Next, the applicant argues that consumers of the applicant’s goods are sophisticated. [See Applicant’s Brief pgs. 11-13, TTABVUE pgs. 12-14.] However, this argument is not persuasive. First, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); see *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ

558 (TTAB 1983). Secondly, the applicant has failed to demonstrate that consumers of enhanced drinking water are sophisticated. The examining attorney objects to the applicant's submission and discussion of registered marks for bottled water with the USPTO. [See Exhibit L attached to Applicant's Brief and Applicant's Brief pg. 12, TTABVUE pg. 13.] As previously rejected and explained by the examining attorney, these third party registrations are not of record because the applicant has submitted a list of registrations. [See Examining Attorney's Denial of Request for Reconsideration dated September 21, 2009.] The mere submission of a list of registrations or a copy of a private company search report does not make such registrations part of the record. See, e.g., *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1561 n.6 (TTAB 1996). Because the applicant failed to submit copies of the third party registrations, these registrations are not part of the record and should not be considered as evidence in the instant case. To make third party registrations part of the record, an applicant must submit copies of registrations from USPTO records only. E.g., *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002); *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 n.2 (TTAB 1998); TBMP §1208.02; TMEP §710.03. The record in an application must be complete prior to the filing of an appeal. Because the proposed evidence was not timely submitted, this evidence should not be considered. 37 C.F.R. §2.142(d); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1059 n.2 (TTAB 2002); *In re Trans Cont'l Records Inc.*, 62 USPQ2d 1541, 1541 n.2 (TTAB 2002); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

Next, the applicant's Internet evidence fails to show that consumers of enhanced drinking water are sophisticated. First, the applicant argues that its consumers are

discriminating based on the fact that the U.S. is the largest consumer market for bottled water in the world. [See Applicant's Brief pgs. 11-12, TTABVUE pgs. 12-13.]

However, the applicant's statistics supporting this claim actually exclude enhanced water from the defined bottle water market segment and therefore do not support the applicant's conclusions. [See Exhibit I attached to Applicant's Brief, TTABVUE pgs. 91-93 and Exhibit K attached to Applicant's Brief.] Namely, the applicant's statistics regarding the U.S. bottled water market and 2008 bottled water sales in the U.S. cited from Wikipedia and www.beveragemarketing.com actually apply to goods outside of those at issue in the instant case and explicitly exclude enhanced water. [See Applicant's Brief pgs. 11-12, TTABVUE pgs. 12-13, Exhibit I attached to Applicant's Brief, TTABVUE pgs. 91-93, and Exhibit K attached to Applicant's Brief.] The applicant's goods are for drinking water enhanced with antioxidants where as the bottled water market segment discussed in the applicant's evidence includes "retail PET, bulk, home and office delivery, vending, domestic, sparkling and imports" but excludes "flavored and enhanced water." [See Exhibit I attached to Applicant's Brief, TTABVUE pgs. 91-93 and Exhibit K attached to Applicant's Brief.]

Next, assuming *arguendo* that the applicant's bottled water evidence encompasses the applicant's goods, the evidence actually shows there is a greater likelihood of confusion between the applicant's goods and the registrant's goods. According to the Wikipedia evidence submitted by the applicant, bottled water in the U.S. costs between \$0.25 and \$2 per bottle. [See Exhibit I attached to Applicant's Brief, TTABVUE pg. 91.] Thus, bottled water is an inexpensive product. According to the evidence from www.coffeeforless.com, the cost for an energy drink case consisting of 12 cans is \$25,

i.e. approximately \$2 per can. [See Web Site attached to Examining Attorney's First Office Action dated September 8, 2008.] Thus, energy drinks are an inexpensive product. The risk of likelihood of confusion is increased for inexpensive products that are purchased on impulse. Therefore, in a likelihood of confusion determination, purchasers of such products are held to a lesser standard of purchasing care. *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984). Thus, consumers of the applicant's goods and the registrant's goods are not sophisticated but held to a lesser standard of purchasing care.

As argued above, the applicant's drinking water is closely related to the registrant's energy drinks and fruit juice drinks because the goods are similar in nature, the type of beverages that commonly emanate from a single source and are types of drinks that are marketed and sold together within the beverage industry market. Additionally, the likelihood of confusion is greater in the instant case because consumers of drinking water and energy drinks may purchase these goods on impulse.

Finally, the overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

CONCLUSION

The marks of the applicant and registrant are confusingly similar and the goods of the parties are closely related. For the foregoing reasons, the refusal to register on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), for the reason that there is a likelihood of confusion with the mark in U.S. Registration No. 3415865, should be affirmed.

Respectfully submitted,

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