

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: March 23, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

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In re Gaia Herbs, Inc.
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Serial Nos. 90052133, 90052135, 90052144, and 90052150
—————

Janet W. Cho of Williams Mullen,
for Gaia Herbs, Inc.

Carlita Solano, Trademark Examining Attorney, Law Office 128,
Travis Wheatley, Managing Attorney.

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Before Lykos, Pologeorgis, and English,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Notice of Correction

On September 26, 2022, the Board issued a final decision in this consolidated ex parte appeal wherein the Board reversed the Section 2(d) refusal against all four of the involved applications. This decision is hereby amended as follows: The sentence “We hasten to add that each of Applicant’s registrations have coexisted with the cited registration for more than five years, contrary to the Examining Attorney’s position.” (located at the bottom of page 19 and running over to the top of page 20 of the decision)

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is deleted. This deletion does not affect the ultimate disposition of this consolidated ex parte appeal.

A copy of the amended decision is attached.

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Before Lykos, Pologeorgis, and English,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Gaia Herbs, Inc. (“Applicant”) seeks registration on the Principal Register of the marks listed below, all for “Nutritional supplements in the form of gummies; herbal supplements in the form of gummies; dietary supplements in the form of gummies” in International Class 5.

- GAIA KIDS (KIDS disclaimed; standard characters)¹

—————
¹ Application Serial No. 90052133 filed on July 14, 2020, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming June 15, 2020 as both the date of first use and the date of first use in commerce.

-  (HERBS disclaimed);²
- GAIA HERBS (HERBS disclaimed; standard characters);³ and
- GAIA (standard characters).⁴

The Trademark Examining Attorney refused registration of Applicant’s marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the standard character mark GAIA GREEN registered on the Principal Register for “mineral supplements” in International Class 5.⁵

When the refusals were made final, Applicant appealed and requested reconsideration in each application. The Examining Attorney denied Applicant’s requests for reconsideration, and the appeals resumed. The appeals are fully briefed and were consolidated on May 23, 2022.⁶ For the reasons explained below, we reverse the refusals to register.

² Application Serial No. 90052135 filed on July 14, 2020, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming June 15, 2020 as both the date of first use and the date of first use in commerce.

³ Application Serial No. 90052144 filed on July 14, 2020, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming June 15, 2020 as both the date of first use and the date of first use in commerce.

⁴ Application Serial No. 90052150 filed on July 14, 2020, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming June 15, 2020 as both the date of first use and the date of first use in commerce.

⁵ Registration No. 6103075 issued on July 14, 2020. The cited registration also lists goods in International 1, but these goods are not subject to these appeals.

⁶ 4 TTABVUE in Application Serial No. 90052133.

The TTABVUE and Trademark Status and Document Retrieval (“TSDR”) citations refer to the docket and electronic file database for the involved application. All citations to the TSDR

I. Preliminary Matter - Evidentiary Objection

We initially turn to an evidentiary objection lodged by the Examining Attorney.⁷ Specifically, the Examining Attorney objects to Exhibits A-D attached to Applicant's appeal briefs because this evidence was submitted for the first time as exhibits to the briefs.

It is well-settled that the record in an ex parte proceeding should be complete prior to appeal. Trademark Rule 2.142(d); 37 C.F.R. § 2.142(d). Exhibits that are attached to a brief but not made of record during examination are untimely, and will not be considered. *See In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1059 n.2 (TTAB 2002); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 1203.02(e) and 1207.01 (2022). To the extent Applicant wished to introduce additional evidence after its appeal had been filed, Applicant should have filed a separately captioned written request with the Board to suspend the appeals and remand the applications for further examination pursuant to Trademark Rule 2.142(d). Applicant did not do so. Accordingly, the Examining Attorney's evidentiary objection is sustained, and we give no consideration to the evidence submitted for the first time with Applicant's appeal briefs.

II. 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

database are to the downloadable .pdf version of the documents. We refer to the record in Serial No. 90052133, unless otherwise indicated.

⁷ Examining Attorney's Brief, p. 3 (10 TTABVUE 3).

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confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor that is relevant or for which there is evidence and argument of record. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”). There is no mechanical test for determining likelihood of confusion; “each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973) (internal citations removed).

As a general proposition, two key considerations are the similarities between the marks and the similarities between the goods, the first and second *DuPont* factors. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). However, in some instances, a single *DuPont* factor other than these factors may be pivotal. As explained further below, such is the case here.

A. Relatedness of the Goods

We first turn to the comparison of the goods, the second *DuPont* factor. In making our determination regarding the relatedness of the goods, we must look to the goods as identified in Applicant’s applications and the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162

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(Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”)); *see also In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

It is well-settled that the goods need not be identical or competitive to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (citation omitted); *Hilson Research, Inc. v. Soc’y for Human Res. Mgmt.*, 27 USPQ2d 1423, 1432 (TTAB 1993). The issue here, of course, is not whether consumers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of these goods. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984).

Here, Applicant’s identification of goods reads as follows: “Nutritional supplements in the form of gummies; herbal supplements in the form of gummies; dietary supplements in the form of gummies.” The goods in the cited registration are

“mineral supplements.”

Applicant argues that the parties’ respective goods are not related because it has found extrinsic evidence to show that Registrant’s actual use is not for the goods as described in the registration, but instead are horticultural products and solutions that are used globally for domestic and commercial purposes.⁸ Applicant’s argument is unavailing.

The Federal Circuit has held that when analyzing an applicant’s and registrant’s goods for relatedness, the determination is based on the description of the goods stated in the applications and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)). The goods described in the registration are “mineral supplements,” without any restrictions or limitations, and to accept Applicant’s argument would impermissibly limit the scope of the goods described in the registration and therefore limit Registrant’s trademark rights.

In other words, the crux of Applicant’s argument constitutes a collateral attack based on extrinsic evidence of non-use by Registrant of the goods as described in the registration, including the impermissible evidence attached to its brief. Applicant further, and incorrectly, insists that the Examining Attorney should base its conclusion about the relatedness of the goods based on Applicant’s extrinsic evidence about the composition of the goods themselves and not on the goods as described in

⁸ Applicant’s Appeal Brief, p. 7 (6 TTABVue 8).

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the registration and applications. However, evidence and arguments that constitute a collateral attack on a cited registration, such as information or statements regarding a registrant's nonuse of its mark, are not relevant during ex parte prosecution. *See In re Dixie Rests.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) §1207.01(d)(iv) (July 2022).

Notwithstanding the foregoing, we note that both Applicant and Registrant provide supplements under their respective marks. "Supplement" is defined as "something added to a food or a diet to increase its nutritional value."⁹ A "nutritional supplement" is defined as "vitamins, **minerals**, herbs, meal supplements, sports nutrition products, natural food supplements and other related products used to boost the nutritional content of the diet."¹⁰ (emphasis added). Thus, Applicant's broadly-worded "nutritional supplements" encompasses supplements with minerals. Moreover, Registrant's broadly-worded "mineral supplements" include mineral supplements in the form of gummies. Thus, these particular goods are legally identical in part.

Even if the goods were not legally identical, the Examining Attorney has submitted ample evidence in the form of third-party uses and third-party registration

⁹ Medical-dictionary/thefreedictionary.com. We take judicial notice of this definition. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

¹⁰ Medical-dictionary/thefreedictionary.com.

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evidence from manufacturers such as Nature's Bounty and Nature Made demonstrating that a single entity provides both dietary or herbal supplements and mineral supplements under the same mark. *See generally* November 2, 2020 Office Action (TSDR pp. 12-14 and 16-17); May 25, 2021 Final Office Action (TSDR pp. 49-85); February 23, 2022 Denial of Request for Reconsideration, (TSDR pp. 7-76).

In view of the foregoing, we find that Applicant's and Registrant's goods are legally identical in part and/or otherwise related. Accordingly, the second *DuPont* factor heavily favors a finding of likelihood of confusion.

B. Similarity of Trade Channels

Next we consider established, likely-to-continue channels of trade, the third *DuPont* factor. Because the identifications of Applicant's and Registrant's goods have no restrictions as to channels of trade or classes of customers and since Applicant's goods and Registrant's goods are legally identical in part, we must presume that these legally identical in part goods travel through the same channels of trade and are offered to the same or overlapping classes of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

As for the related goods, i.e., dietary or herbal supplements and mineral supplements, the evidence of record demonstrates that these goods are offered via online retailers such as the Vitamin Shoppe who specialize in health supplements for human consumption. *See generally* November 2, 2020 Office Action (TSDR pp. 12-14

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and 16-17); May 25, 2021 Final Office Action (TSDR pp. 49-85); February 23, 2022 Denial of Request for Reconsideration, (TSDR pp. 7-76). Thus, certain goods identified in Applicant's involved applications and listed in the cited registration travel in overlapping trade channels and are offered to overlapping consumers, i.e., customers interested in improving their health. Accordingly, the third *DuPont* factor also weighs heavily in favor of finding a likelihood of confusion.


C. Similarity of the Marks

We next consider the first *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). Similarity as to any one of these factors may be sufficient to support a finding that the marks are confusingly similar. *See Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion."); *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019) ("Similarity in any one of these elements may be sufficient to find the marks confusingly similar.") (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

"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." *i.am.symbolic*, 123 USPQ2d at 1748 (quoting *Coach Servs. Inc.*

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v. Triumph Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)) (internal quotation marks omitted). Furthermore, because Applicant's goods are legally identical in part to Registrant's goods, the degree of similarity between the marks that is required to support a finding of likelihood of confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applicant's marks are (1) GAIA KIDS (KIDS disclaimed; standard characters), GAIA HERBS (HERBS disclaimed; standard characters),  (HERBS disclaimed), and GAIA (standard characters). The cited mark is GAIA GREEN in standard characters. Given that Applicant's marks begin with the identical wording as the cited mark, i.e., GAIA, the marks are similar in sound, appearance, connotation and commercial impression.

Furthermore, it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered when making purchasing decisions. *Palm Bay Imps.*, 73 USPQ2d at 1692; *see also Presto Prods., v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). As such, consumers will focus more on the GAIA portion of Applicant's marks as the source-indicator for Applicant's goods. This especially holds true since the inclusion of the descriptive, if not generic, and disclaimed wording KIDS and HERBS in three of Applicant's proposed marks will not detract from the overall similarities between Applicant's mark and the cited mark GAIA GREEN. Disclaimed matter that is descriptive of or generic for a party's goods or services is typically less significant or less dominant when comparing marks.

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Detroit Athletic, 128 USPQ2d at 1050 (citing *In re Dixie Rests.*, 41 USPQ2d at 1533-34); TMEP § 1207.01(b)(viii).

Additionally, even if potential purchasers realize the apparent differences between the parties' respective marks, they could still reasonably assume, due to the overall similarities in sound, appearance, connotation, and commercial impression due to the shared, initial term GAIA, that Applicant's goods sold under the proposed marks constitute new or additional product lines from the same source as the goods sold under the registered mark with which they are acquainted or familiar, and that Applicant's marks are merely a variation or derivative of Registrant's mark. *See, e.g., In re Comexa Ltda.*, 60 USPQ2d 1118, 1121 (TTAB 2001) (applicant's use of term "AMAZON" and parrot design for chili sauce and pepper sauce is likely to cause confusion with registrant's "AMAZON" mark for restaurant services); *SMS, Inc. v. Byn-Mar Inc.* 228 USPQ 219, 220 (TTAB 1985) (applicant's marks ALSO ANDREA and ANDREA SPORT were "likely to evoke an association by consumers with opposer's preexisting mark [ANDREA SIMONE] for its established line of clothing."); *In re Collegian Sportswear, Inc.*, 224 USPQ 174 (TTAB 1984).

As to stylization, Registrant's GAIA GREEN mark is a standard character mark, and marks appearing in standard character form may be displayed in any font style, color and size, including the identical stylization or font of Applicant's

The logo for 'gaia HERBS' features the word 'gaia' in a lowercase, serif font with a slightly irregular, hand-drawn appearance. Below it, the word 'HERBS' is written in a smaller, uppercase, sans-serif font. The entire logo is enclosed in a thin rectangular border.

mark, because the rights reside in the wording and not in any particular display or rendition. *See SquirtCo v. Tomy Corp.*, 216 USPQ 937, 939 (Fed. Cir. 1983) ("[T]he argument concerning a difference in type style is not viable where


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one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a difference cannot legally be asserted by that party.”); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186-87 (TTAB 2018). Thus, because Registrant’s standard character mark GAIA GREEN may be displayed in the

identical manner as Applicant’s  mark, the mere stylization of the wording GAIA HERBS in Applicant’s mark is insufficient to distinguish the marks.

Lastly, there is no evidence that the cited mark GAIA GREEN has any meaning or significance when applied to Registrant’s listed goods. Also, there is no evidence of use or registration by third parties of similar marks on similar goods that might dilute the source-identifying capacity of GAIA GREEN for those goods. Moreover, to the extent the term GAIA has any meaning with regard to the involved goods, there is no evidence of record to support a finding that the term would have a different meaning as applied to Applicant’s goods than it would when applied to the goods listed in the cited registration.¹¹

¹¹ Applicant argues that the inclusion of the term GAIA in its proposed marks is reference to the 300 ginko trees that greet visitors upon entering Applicant’s business establishment, where Applicant researches and tests organic planting and cultivation methods, as well as produces over 3 million individual plants, representing 20-40 species of herbs. Applicant further asserts that the farm also includes a large grove of hawthorn trees and numerous echinacea trees. *See* Applicant’s Reply Brief, p. 4 (11 TTABVUE 5). Applicant further contends that these tree families taken together are represented by the term “gaia,” which in turn is a reference to the goddess of life. *Id.* Accordingly, Applicant concludes that the commercial impression of “gaia” as used in its involved marks is a reference to and calls forth, the inherent connection between people and the earth, and the collective power of both to heal. *Id.* Applicant, however, did not submit any evidence to substantiate the foregoing allegations. Mere attorney argument is not evidence. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (“Attorney argument is no substitute for evidence) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir.

In sum, while there are some specific differences between Applicant's and Registrant's marks, i.e., the inclusion of the words KIDS and HERBS in three of Applicant's marks, the addition of the term GREEN in the cited mark, and the particular stylization in one of Applicant's proposed marks, namely, , we nonetheless find that, in their entireties, the marks are more similar than dissimilar in appearance, sound, and connotation due to the common presence of the identical term GAIA. The first *DuPont* factor thus favors a finding of likelihood of confusion.

D. Lack of Actual Confusion

The seventh *DuPont* factor is the “nature and extent of any actual confusion,” while the eighth *DuPont* factor considers the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567.

Applicant asserts that it “has used the formative GAIA since 1987 to identify its products.”¹² Applicant further maintains that it is an industry leader in growing plants and herbs and in the promotion and sale of its products.¹³ Despite the widespread reach of Applicant's GAIA Mark, Applicant argues that it has never encountered, nor been presented with, any evidence of consumer confusion between

2005)); *In re Simulations Publ'ns, Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975) (“Statements in a brief cannot take the place of evidence”).

¹² Applicant's Appeal Brief, p. 10 (6 TTABVUE 11).

¹³ *Id.*

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Applicant's and Registrant's marks and that the co-existence of Applicant's and Registrant's marks for years with no confusion constitutes strong evidence that there is no likelihood of confusion.¹⁴

Applicant's allegations that the involved marks have been in use without evidence of actual confusion are unsupported. The record before us is devoid of any specifics regarding the geographic extent or overlap of Applicant's or Registrant's goods. *See In re Guild Mtg. Co.*, 2020 USPQ2d 10279, at *6 (TTAB 2020) ("The eighth du Pont factor, by contrast . . . requires us to look at actual market conditions, to the extent there is evidence of such conditions of record."). *See also In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971).

Furthermore, the fact that an applicant in an ex parte proceeding is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis. There has been "no opportunity to hear from Registrant about whether it is aware of any reported instances of confusion. We therefore are getting only half the story." *Guild Mtg.*, 2020 USPQ2d 10279, at *7 (citing *In re Opus One, Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001) ("The fact that an applicant in an ex parte case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual

¹⁴ *Id.*

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confusion to have occurred.”)) (citations omitted). *See also Detroit Athletic*, 128 USPQ2d at 1053 (“[T]he relevant test is likelihood of confusion, not actual confusion.”); *In re i.am.symbolic*, 123 USPQ2d at 1747 (“[A] showing of actual confusion is not necessary to establish a likelihood of confusion.”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

The seventh and eighth *DuPont* factors are neutral.

E. Priority of Use

We find unpersuasive Applicant’s argument that it has priority of use over the cited registration. It is well established that an applicant’s assertion of priority of use may be given no consideration in an *ex parte* proceeding when registration has been refused under Section 2(d) of the Act in view of a subsisting registration. *See In re Calgon*, 168 USPQ at 280 (“As the board correctly pointed out, ‘the question of priority of use is not germane to applicant’s right to register’ in this *ex parte* proceeding.”); *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373, 1375 n.3 (TTAB 2001). The rationale behind these decisions is that the portion of Section 2(d) which proscribes registration of a mark likely to be confused with a mark registered in the Patent and Trademark Office does not speak of priority but of a “mark registered”; and that an applicant’s assertion of priority of use in such a case constitutes a collateral attack upon the cited registration, which attack cannot be entertained in an *ex parte* proceeding. *In re Calgon*, 168 USPQ at 280.

F. Thirteenth *DuPont* Factor

The thirteenth and final *DuPont* factor pertains to “any other established fact

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probative of the effect of use.” *DuPont*, 177 USPQ at 567. Rarely invoked, this factor “accommodates the need for flexibility in assessing each unique set of facts....” *In re Strategic Partners Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012). This includes a variety of circumstances such as an applicant’s ownership of a previously registered mark. *See, e.g., Inn at St. John’s*, 126 USPQ2d at 1748 (citing *Strategic Partners*, 102 USPQ2d at 1399 (no likelihood of confusion found with the registered mark ANYWEAR BY JOSIE NATORI and design where the applicant’s previously registered mark ANYWEARS was substantially similar to the applied-for mark ANYWEAR for identical goods and had been registered for over 5 years)).

During prosecution of its involved applications, Applicant, relying on *In re Strategic Partners*, 102 USPQ2d 1397 (TTAB 2012), advanced the argument that since it owns two prior registrations for the mark GAIA for identical or highly related goods to those identified in its involved registrations and which predate the registration date of the cited mark, there cannot be any likelihood of confusion.¹⁵ The two prior registrations are identified below:

- Registration No. 2410679, registered on December 5, 2000, for the typeset mark **GAIA**¹⁶ for “Dietary supplements, namely, liquid herbal extracts, liquid herbal extracts in vegetable-based capsules, and solid herbal extracts.”
- Registration No. 4722198, registered on April 21, 2015, for the standard character mark GAIA for goods including “Organic or herb-based energy and antioxidant aids in the form of dietary supplements; Organic or

¹⁵ See Applicant’s April 27, 2021 Response to Office Action (TSDR 3-4).

¹⁶ Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed or typeset mark is the legal equivalent of a standard character mark. TMEP § 807.03(i).

herb-based cough syrup; Organic or herb-based digestive aids in the form of dietary supplements; Organic or herb-based ear drops; Organic or herb-based diuretics; Botanical derived iron in the form of a liquid dietary supplement.”

Although Applicant raises its prior registrations in its appeal brief, it does not specifically argue that our decision in *Strategic Partners* is applicable here. We, in our discretion, however, will entertain the prior registration legal theory under the *Strategic Partners* decision, particularly since the Examining Attorney, during prosecution, addressed the merits thereof and found the argument unpersuasive.¹⁷

As an initial matter, we note that Applicant claimed ownership of these additional prior registrations in its involved applications:¹⁸


- Registration No. 3985225 for the standard character mark GAIAKIDS on the Principal Register for “dietary supplements, namely, liquid herbal extracts, liquid herbal extracts in vegetable-based capsules, and solid herbal extracts for consumption by children,” in International Class 5;¹⁹
- Registration No. 2397913 for the typeset mark GAIA HERBS (HERBS disclaimed) on the Principal Register for “dietary supplements, namely, liquid herbal extracts, liquid herbal extracts in vegetable-based capsules, and solid herbal extracts,” in International Class 5;²⁰ and

¹⁷ See May 25, 2021 Final Office Action (TSDR p. 5)

¹⁸ “If an applicant includes a claim of ownership of a prior registration, or a pending application, in the application as filed, the examining attorney **must accept the claim without further proof of ownership** and must not cite the registration for likelihood of confusion under §2(d) of the Act or advise the applicant that there may be a conflict with the earlier-filed application.” (emphasis added). TMEP § 812.01. We also note that the main purpose of claiming ownership of a prior registration is “to provide the examining attorney with information necessary for proper examination.” TMEP § 812.

¹⁹ Issued on June 28, 2011. Applicant claimed ownership of this prior registration in its involved Application Serial No. 90052133 for the mark GAIA KIDS.

²⁰ Issued on October 24, 2000. Applicant claimed ownership of this prior registration in its involved Application Serial No. 90052144 for the mark GAIA HERBS.

- Registration No. 3930562 for the mark  (HERBS disclaimed) on the Principal Register for “dietary supplements, namely, liquid herbal extracts, liquid herbal extracts in vegetable-based capsules, and solid herbal extracts,” in International Class 5.²¹


In *Strategic Partners*, the applicant owned a registered mark that had coexisted with the cited mark for over five years. Because applicant’s prior registration was over five years old, it was not subject to challenge by the owner of the cited registration based on a Section 2(d) claim of likelihood of confusion. *Strategic Partners*,¹⁰² USPQ2d at 1399. In finding no likelihood of confusion in *Strategic Partners*, the Board explained:

[T]he present case involves the unique situation presented by the coexistence of applicant’s existing registration with the cited registration for over five years, when applicant’s applied-for mark is **substantially similar to its existing registered mark**, both for identical goods. When we consider these facts under the thirteenth *du Pont* factor, we find in this case that this factor outweighs the others and leads us to conclude that confusion is unlikely.

Id. at 1400. (emphasis added).

When determining whether the coexistence of an applicant’s prior registration with another party’s registration weighs against citing the latter registration in a Section 2(d) refusal of the applicant’s mark, we consider: (1) whether the applicant’s prior registered mark is the same as applicant’s mark or is otherwise not meaningfully different; (2) whether the identification of goods or services in the

²¹ Issued April 14, 2015. Applicant claimed ownership of this prior registration in its involved

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application and the applicant's prior registration are identical or identical in relevant part; and (3) the length of time the applicant's prior registration has coexisted with the registration being considered as the basis for the Section 2(d) refusal. *Strategic Partners*, 102 USPQ2d at 1400; TMEP § 1207.01. The duration of coexistence is not dispositive as to whether a Section 2(d) refusal should issue; instead, this factor should be considered together with all the other relevant *DuPont* factors. See *id.*; *cf. Inn at St. John's*, 126 USPQ2d at 1748 (finding that applicant's earlier registration of a partially similar mark was a neutral factor in the Section 2(d) analysis, because the mark in the application was more similar to the cited registered mark than applicant's previously registered mark); *USA Warriors Ice Hockey Program*, 122 USPQ2d 1790, 1793 (TTAB 2017) (distinguishing *Strategic Partners* and finding that the three and-a-half year coexistence of applicant's prior registration and the cited registration was a relevant consideration but did not cause the thirteenth factor to outweigh the other relevant *DuPont* factors).

Here, all of Applicant's prior registrations identified above are over five years old, meaning that they are impervious to a petition to cancel under Trademark Act Section 2(d). See Trademark Act § 14, 15 U.S.C. § 1064. Compare *In re USA Warriors Ice Hockey Program*, 122 USPQ2d at 1793 (finding "a key factual distinction from *Strategic Partners*" that applicant's prior registration was less than five years old, making it still subject to a cancellation action by registrant based on likelihood of confusion).

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We next consider whether the marks subject to these prior registrations are “substantially similar” to the proposed marks at issue in this appeal. Here, the marks subject to Applicant’s claimed prior registrations are identical to the marks it now seeks to register.²² As for the goods, we find that the goods listed in Applicant’s prior registrations are identical in-part, i.e., dietary supplements, and, therefore, are sufficiently similar to the goods identified in its involved applications.


We acknowledge that prior decisions and actions of other trademark examining attorneys are not binding on the USPTO or the Board. *See In re Davey Prods. Pty. Ltd.*, 92 USPQ2d 1198, 1206 (TTAB 2009); *USA Warriors Ice Hockey Program*, 122 USPQ2d at 1793 & n.10. Notwithstanding the USPTO’s allowance of the cited registration over Applicant’s prior registrations, we do not hold that we are bound by a decision made by the involved examining attorney that there was no likelihood of confusion between the cited GAIA GREEN mark and the marks in Applicant’s prior registrations. Instead, we conclude that under the particular circumstances of this case, where: (1) Applicant owns prior registrations for a substantially similar marks covering goods nearly identical to those in the involved applications; and (2) the examining attorney who examined the cited registration did not refuse registration of that mark based on a likelihood of confusion with the mark in Applicant's prior registration, we give the fact that no likelihood of confusion was found due weight in

²² Applicant’s prior registration for the mark GAIKIDS does not constitute two words like its pending mark GAIA KIDS. The presence or absence of a space between two terms, however, is an inconsequential difference that, even if noticed by consumers, would not serve to distinguish the marks. *See In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010) (finding ACTIVECARE and ACTIVE CARE confusingly similar).

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our analysis as support that confusion is unlikely. Thus, we find that the thirteenth *DuPont* factor heavily favors a finding that confusion is not likely.

III. Conclusion

After considering all of the evidence and arguments, we find that although the first, second, and third *DuPont* factors weigh in favor of finding likelihood of confusion, we nevertheless find, as in *Strategic Partners*, that the thirteenth *DuPont* factor tips the scale and outweighs them all, making confusion unlikely under the specific facts of this case. See *Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286, 1290 (Fed. Cir. 2016) (“[A] single DuPont factor may be dispositive in a likelihood of confusion analysis[.]”) (citation omitted); *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998) (“[O]ne DuPont factor may be dispositive in a likelihood of confusion analysis. Simply put, the fact that the USPTO permitted the cited registration to issue over Applicant’s prior registrations for identical marks and in-part identical goods, buttresses our ultimate conclusion that there is no likelihood of confusion between Applicant’s proposed GAIA KIDS, GAIA HERBS, , and GAIA marks and the cited GAIA GREEN mark.

Decision: The refusals to register Applicant’s marks under Section 2(d) of the Trademark Act are reversed.