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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91205483
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Attachments	Reply - Motion for Summary Judgment (final - redacted).pdf(88542 bytes )



status of compliance with various voluntary and/or proposed regulations which are still not finalized. This is very clear when a less edited version of Ms. McIvor's testimony is reviewed. Regarding confidentiality, Opposer considers information regarding what testing it has completed and how far along it is in the proposed compliance process highly confidential as such knowledge would be of significant benefit to competitors of Opposer, such as the Applicant.

2. Regarding priority, despite Applicant's unsupported allegations, there is no evidence, sufficient to create a genuine issue of material of fact, as to Applicant's lawful use, and therefore priority, in U.S. Commerce. Opposer has placed into evidence years of continuing sales and shipments in U.S. commerce which pre-date Applicant's filing date. This evidence has not been challenged.

3. Regarding standing, there is no evidence, sufficient to create a genuine issue of material of fact, as to whether Opposer has standing. Standing has been clearly demonstrated by the office action and suspension notice made of record in this proceeding. Applicant's argument that Opposer lacks standing because Opposer's Baba Slings mark is not distinctive is not only incorrect, but even if the mark was considered descriptive, Opposer has presented evidence of substantially exclusive and continuous use of the Baba Slings Mark in U.S. commerce for at least twelve (12) years. This is prima facie evidence that the mark has become distinctive.

4. Regarding likelihood of confusion, there is no evidence, sufficient to create a genuine issue of material of fact, as to whether Opposer's Baba Slings mark and Applicant's theBabaSling mark (stylized and/or with design) are likely to cause consumer confusion. Applicant merely argues that Applicant's mark contains a design element and argues that Opposer's mark is weak. Applicant puts forth no additional evidence or testimony. Even in the light most favorable to the non-moving party, the two marks are nearly identical with merely an additional design element.

5. Finally, regarding Applicant's affirmative defense of acquiescence, there is no evidence, sufficient to create a genuine issue of material of fact regarding this issue. This proceeding involves a U.S. trademark application. There is no evidence that Applicant has used its applied for mark in U.S. commerce at all, let alone shown sufficient use to create an equitable defense of acquiescence. Despite the complexity of Ms. McIvor's prior business relationship with applicant, there is no genuine issue of material of fact regarding any alleged acquiescence as it would apply to this proceeding. Moreover, due to the fact that the marks in this case are essentially identical -- where confusion is inevitable -- equitable defenses such as acquiescence are not available.

### **MEMORANDUM OF LAW IN SUPPORT OF REPLY**

Applicant makes four arguments in its Opposition to the Motion for Summary Judgment. As set out below, none of these arguments create a genuine issue of material fact which would prevent summary judgment in favor of Opposer. There is no genuine dispute that: (1) Opposer has standing to maintain this proceeding; (2) Opposer has priority; and (3) contemporaneous use of the parties' respective marks on their respective goods would be likely to cause confusion, mistake or to deceive consumers. The Board should rule that theBabaSling Mark is not entitled to registration.

#### **I. Opposer Has Priority Over Applicant's Mark**

There is no genuine issue of material fact that Opposer has priority over Applicant's Mark. It is undisputed that Applicant's earliest priority date is the date of its application, namely September 6, 2011. It is also undisputed that Opposer (and its predecessor in interest) have been using the Baba Slings Mark in United States commerce since at least as early as October 2002. Opposer put in evidence nearly ten years of sales which pre-date Applicant's priority date. Opposer put in evidence as to how the Baba Slings Mark appears on its products. Opposer put

in evidence regarding its promotion and distribution deals in the United States. This evidence is undisputed.

Applicant argues, however, that Opposer's use was not lawful. Applicant specifically identifies 14(a)(2)(A) of the Consumer Product Safety Act ("CPSA") as the section Opposer possibly violated. Applicant, however, does not offer any evidence that Opposer has violated any law or regulation, except for a highly edited snippet of testimony from Ms. McIvor made to misrepresent her testimony.

What Applicant fails to disclose, however, is that the final rules for infant slings has not yet been adopted by the CSC. In fact, while proposed rules for various types of infant carriers had been issued in 2013, none had been made final rules in October 2013 when Ms. McIvor's deposition was taken. Moreover, the proposed rules for infant slings carriers were not issued until June 11, 2014 (*See* Exhibit 14) No final rules exist nor is there a timetable when final rules will issue.

Please note: the official federal register version of Exhibit 14 was not available at the time of writing this Reply. The attached copy was downloaded on June 27, 2014 from the following link:

<http://www.cpsc.gov/Global/Newsroom/FOIA/CommissionBriefingPackages/2014/SafetyStandardsforSlingCarriersProposedRuleJune112014.pdf>

As explained in Exhibit 14,

The Consumer Product Safety Improvement Act of 2008 (CPSIA, Pub. Law 110-314) was enacted on August 14, 2008. Section 104(b) of the CPSIA, part of the Danny Keysar Child Product Safety Notification Act, requires the Commission to: (1) examine and assess the effectiveness of voluntary consumer product safety standards for durable infant or toddler products, in consultation with representatives of consumer groups, juvenile product manufacturers, and independent child product engineers and experts; and (2) promulgate consumer product safety standards for durable infant and toddler products. These standards are to be "substantially the same as" applicable voluntary standards or more

stringent than the voluntary standard if the Commission concludes that more stringent requirements would further reduce the risk of injury associated with the product.

...

In this document, the Commission is proposing a safety standard for sling carriers. Section 104(f)(2)(H) of the CPSIA lists “infant carriers” as one of the categories of durable infant or toddler products identified for purposes of section 104. As indicated by a review of ASTM’s standards and retailers’ websites, the category of “infant carriers” includes hand-held infant carriers, soft infant carriers, frame backpack carriers, and sling carriers. The Commission has issued final rules for hand-held infant carriers (78 Fed. Reg. 73415 (December 6, 2013)) and soft infant carriers (78 Fed. Reg. 20511 (April 5, 2013)) and a proposed rule on frame backpack carriers (79 Fed. Reg. 28458 (May 16, 2014)). In the Commission’s product registration card rule identifying additional products that the Commission considered durable infant or toddler products necessitating compliance with the product registration card requirements, the Commission specifically identified infant slings, or sling carriers, as a durable infant or toddler product. 76 Fed. Reg. 68668 (December 29, 2009).

Exhibit 14 at Page 6, of the PDF. Thus while there were voluntary standards for sling carriers and proposed rules for some type of infant carriers at the time of Ms. McIvor’s deposition, no final rules on any type of infant carrier had gone into effect.

Please note: although the document lists the date of April 5, 2013 for soft infant carriers, that date is actually the date the proposed rules we issued (*see* Exhibit 15), the final rules for soft infant carriers (not sling carriers) were issued March 28, 2014, and do not go into effect until September 29, 2014 (*see* Exhibit 16).

As to the purported legal violation of Opposer, Applicant cites Section 14(a)(2)(A) of the Consumer Product Safety Act (“CPSA”) which states that all importers must issue a product certificate that the imported product complies with all CPSA consumer product safety rules. Without actually citing any applicable CPSA product safety rule for infant slings, Applicant simply concludes that Opposer must not be in compliance. As of the date of Ms. McIvor’s depositions (and, in fact, as of today), Opposer cannot possibly be in violation of Section 14(a)(2) as the final rules for baby sling carriers have not yet issued.

Again, as explained in the proposed rules,

Section 14(a)(2) of the Consumer Product Safety Act (CPSA) requires every manufacturer and private labeler of a children's product that is subject to a children's product safety rule to certify, based on third party testing conducted by a CPSC-accepted laboratory, that the product complies with all applicable children's product safety rules. Section 14(i)(2) of the CPSA requires the Commission to establish protocols and standards by rule for, among other things, making sure that a children's product is tested periodically and when there has been a material change in the product, and safeguarding against the exercise of undue influence by a manufacturer or private labeler against a conformity assessment body. A final rule implementing sections 14(a)(2) and 14(i)(2) of CPSA, Testing and Labeling Pertaining to Product Certification (16 CFR part 1107), became effective on February 13, 2013 (the 1107 rule). **When the sling carrier rule is finalized, sling carriers will be subject to a mandatory children's product safety rule. Accordingly, sling carriers will also be subject to the third party testing requirements of section 14 of the CPSA and the 1107 rule.** Slings are already subject to lead and phthalates testing under the 1107 Rule. This rule adds certain mechanical tests and other requirements to the third party testing requirement.

Exhibit 14 at Page 27 of the PDF, page 24 on the document, *emphasis added*. As stated clearly in the proposed rules, after the sling carrier rule is finalized, then sling carriers will be subject to mandatory safety rules and third party testing.

A review of Ms. McIvor's testimony shows that there is no evidence that Opposer is or has ever been in violation of any current U.S. law or regulation. [REDACTED]

[REDACTED] Clearly, Applicant's selected editing of Ms. McIvor's deposition place her testimony highly out of context in light of the actual state of the baby sling regulations. Moreover, while Opposer, a foreign entity, has every intention of being compliant by the effective date (whatever that date ends up being), the rules themselves apply only to U.S. manufacturers and U.S. importers. 16 CFR § 1110.7 makes this clear:

**§ 1110.7 Who must certify and provide a certificate.**

(a) Imports. Except as otherwise provided in a specific standard, in the case of a product manufactured outside the United States, only the importer must certify in accordance with, and provide the certificate required by, CPSA section 14(a) as applicable, that the product or shipment in question complies with all applicable CPSA rules and all similar rules, bans, standards, and regulations applicable to the product or shipment under any other Act enforced by the Commission.

(b) Domestic products. Except as otherwise provided in a specific standard, in the case of a product manufactured in the United States, only the manufacturer must certify in accordance with, and provide the certificate required by, CPSA section 14(a) as applicable, that the product or shipment in question complies with all applicable CPSA rules and all similar rules, bans, standards, and regulations applicable to the product or shipment under any other Act enforced by the Commission.

Opposer intends to be complaint, however, not because Opposer would be in violation of U.S. law, but so U.S. importers can accept Opposer's goods. Therefore whether Opposer is

already complaint with the new regulations, intends to be complaint, and how far along Opposer is in becoming complaint with the new regulations is highly confidential information which would be extremely valuable to Opposer's competitors who are likely courting some of the same U.S. importers as Opposer. For example, if Opposer does not complete its own testing prior to the effective date of the rules, the U.S. importer will need to perform the testing themselves. This would dramatically change the attractiveness of Opposer's product to U.S. importers.

## **II. Opposer has Standing**

There is no genuine issue of material fact that Opposer has standing to bring this Opposition. Standing has been clearly demonstrated by the office action and suspension notice made of record in this proceeding where Opposer's application has been suspended because of Applicant's theBabaSling Application (*See* Exhibit 5, BABA 0407).

Applicant does not dispute these facts, but rather argues that Opposer's Baba Slings mark is descriptive or highly descriptive. Once again, Applicant uses just a snippet of Ms. McIvor's testimony out of context and claims conclusively that baba means baby. Applicant presents no dictionary definition where "baba" means baby (if necessary, it is request that the Board take judicial notice that the dictionary definition of "baba" is a type of sponge cake). Rather, "baba" one of the first sounds any infant makes, is at most *suggestive* of baby. The left out portion of Ms. McIvor's testimony states the following:

So Baba Slings, the name came from -- it wasn't just implying baba representing baby. It was also implying that it's an endearing word the world over. In Russia it's like grandmother. In different countries it's grandmother and in other countries it's grandfather, and in India where I have spent time in India, it implies teacher.

So baba, it's an endearing word and it's also baba for baby, goo, goo, goo, the sound a baby makes. So, yeah. We were hoping that we would be able to reach out to many different cultures and use a word that's endearing to different cultures. And everyone has -- and the family can, you know, the grandmother and the grandfather can carry the baby.

McIvor Deposition, page 69 line 20 – page 70, line 11.

This is echoed in Ms. McIvor’s declaration,

11. The name Baba Slings came to me after traveling to different parts of the world. The word “baba” is often one of the first sounds every infant makes regardless of the language spoken by the baby’s parents. In different parts of the world, the word has evolved into different connotations. In Russia, it often a nickname or a term of endearment for grandmother, in India, grandfather or teacher, in Africa, father. Because of all of the connections to a family in many parts of the world, Baba Slings was the perfect name for my baby carrier.

*See* Exhibit 1 to the Motion, ¶ 11. Moreover, even if the mark was considered descriptive, Opposer has presented evidence of substantially exclusive and continuous use of the Baba Slings Mark in U.S. commerce for at least twelve (12) years. This is prima facie evidence that the mark has become distinctive. *See* Trademark Act Section 2(f), 15 U.S.C. 1052(f). Applicant has not presented evidence sufficient to rebut this presumption.

### **III. Applicant’s Mark and Opposer’s Mark are Likely to be Confused**

There is no genuine issue of material fact that Opposer’s Baba Slings mark is likely to be confused with Applicant’s thBabaSling Mark (stylized and/or with design). Applicant merely states that theBabaSlings Mark includes a design and there are some letters which are different. Applicant does not dispute that the written portion of the marks Baba Slings and theBabaSling are essentially identical. Nor does Applicant present any evidence that would tend to show the two marks are unlikely to be confused. Finally, Applicant does not challenge the evidence presented by Opposer of the similarity of the goods, the similarity of the trade channels, or actual confusion. Applicant has not presented evidence sufficient to find that a genuine issue of material fact exists requiring a trial on this issue.

### **IV. Applicant has Not Supported an Affirmative Defense of Acquiescence**

Finally, applicant argues there is some level of assent to use the mark by Applicant and

that this is sufficient to create a genuine issue of material fact as to the affirmative defense of acquiescence. Applicant simply has not set out a prima facie case for acquiescence, however. This proceeding involves a U.S. trademark application. Opposer opposed Applicant's mark soon after it was published. There is no evidence that Applicant has used its applied for mark in U.S. commerce at all, let alone shown sufficient use to create an equitable defense that Opposer has acquiesced to the use of Applicant's mark in U.S. commerce. Despite the complexity of Ms. McIvor's prior business relationship with applicant, there is no genuine issue of material of fact regarding any alleged affirmative defense acquiescence as it would apply to this proceeding. Moreover, due to the fact that the marks in question are essentially identical -- and confusion is inevitable -- equitable defenses such as acquiescence are not available. *See Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1131 (TTAB 1990) (equitable defenses such as laches and acquiescence would not preclude a judgment for plaintiff if it is determined that confusion is inevitable).

**V. Conclusion**

For all of the foregoing reasons, Opposer respectfully requests that the Board grant its motion for summary judgment and refuse registration of theBabaSling Application Serial No. 79/103197.

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **OPPOSER'S REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT AND REQUEST TO SUSPEND PROCEEDINGS** has been served on the attorney of record for the Applicant, by mailing said copy on July 2, 2014, via First Class Mail, postage prepaid, to the attorney's correspondence address of record:

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