

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Alexandria, VA 22313-1451
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Mailed: October 8, 2014

Opposition No. 91205483

Baba Slings Pty Ltd

v.

BabaSlings Limited

Before Bucher, Lykos and Gorowitz,
Administrative Trademark Judges.

By the Board:

On September 6, 2011, BabaSlings Limited (“Applicant”) filed a Request for Extension of Protection pursuant to Trademark Act § 66(a), to register the following mark:



for the following International Class 18 goods:

bags, namely, all purpose carrying bags, baby carrying bags, and bags for carrying babies’ accessories; trunks and traveling bags; carriers for babies and children worn on the body; slings for carrying babies and children; back frames for carrying babies and children; sling bags for carrying babies and children; baby changing bags in the nature of bags for carrying babies’ accessories; nappy bags in the nature of diaper bags; baby care bags in the nature of bags for carrying babies’

accessories sold empty; travel bags; backpacks; suitcases; reusable shopping bags; reusable shopping bags in frames on wheels; umbrellas; parasols; structural parts and fittings for all the aforementioned goods.¹

Baba Slings Pty Ltd. (“Opposer”) opposes registration on the ground of priority and likelihood of confusion pursuant to Trademark Act § 2(d) (Notice of Opp., para. 7 and 12),² and on the ground that applicant is not owner of the mark (Notice of Opp., para. 5). Opposer pleads common law rights in the mark BABA SLINGS, and ownership of an application to register BABA SLINGS (standard characters; the word “Slings” disclaimed) for

(Based on Use in Commerce) baby carriers worn on the body; baby carrying bags; bags for carrying babies’ accessories; sling bags; sling bags for carrying infants; slings for carrying infants (Based on 44(e)) sling bags for carrying infants; slings for carrying infants.³

Opposer moved for summary judgment pursuant to Fed. R. Civ. P. 56(a) with respect to standing, priority and likelihood of confusion. Within its responsive brief, Applicant sets forth a cross-motion for summary judgment with respect to these issues.⁴

¹ Application Serial No. 79103197 was filed on September 6, 2011. The mark consists of the wording “theBabaSling” below a design of a crescent moon holding a baby.

² Opposer’s cursory reference to Trademark Act Section 2(a) in the notice of opposition, and listing of two additional grounds for opposition under that provision, namely, deceptiveness and false suggestion of a connection, do not constitute a pleading of those grounds. *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009); *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007).

³ Application Serial No. 85633700 filed May 23, 2012, on the basis of 1) Trademark Act § 1(a), asserting a date of first use in commerce of October 2002 for all the listed goods, and 2) Trademark Act § 44(e) for “sling bags for carrying infants; slings for carrying infants.”

⁴ The parties redacted lengthy portions of their briefs and exhibits, and Applicant’s reply brief is redacted in its entirety. Consequently, in this decision the Board must

Analysis

Summary judgment is appropriate where the movant shows that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be true or is genuinely disputed must support its assertion by either 1) citing to particular parts of materials in the record, or 2) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact. *See* Fed. R. Civ. P. 56(c). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

Evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472.

refer to confidential matters generally. However, inasmuch as the Board denies the cross-motions as to priority and likelihood of confusion, and the parties shall proceed to trial, the parties should note that a rule of reasonableness dictates what information should be redacted, and only in very rare instances should an entire submission be deemed confidential. *See* TBMP § 412.04 (2014), and cases cited therein. Applicant is allowed until thirty days from the mailing date of this order to submit a properly redacted reply brief in which only truly confidential information is deleted, failing which the original reply brief will become part of the public record. *See, e.g., Morgan Creek Prod. Inc. v. Foria Int'l Inc.*, 91 USPQ2d 1134, 1136 n.9 (TTAB 2009).

The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1544. *See* TBMP § 528.01 (2014), and cases cited therein.

The party seeking judgment in its favor carries the burden of proof. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986). Merely because both parties have moved for summary judgment does not necessarily mean that there are no genuine disputes of material fact, and does not dictate that judgment should be entered. *See University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994).

Standing

Opposer must establish that it has a “real interest,” i.e., a direct and personal stake, in the outcome of the proceeding, as well as a “reasonable basis” for its belief of damage. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). The Court of Appeals for the Federal Circuit has enunciated a liberal threshold for determining whether a belief in damage has a reasonable basis in fact and reflects a real interest in the case. *See Ritchie v. Simpson*, 50 USPQ2d at 1025-26); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Opposer has alleged a claim of likelihood of confusion that is plausible and is not wholly without merit. *See Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002). Moreover, Opposer has demonstrated that

it owns a pending application to register its mark (motion, p. 12; McIvor decl., para. 4-5, Exh. 5), and the record reflects that Applicant's application has been cited as a potential bar to registration under § 2(d).⁵ See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 648 (Fed. Cir. 1983).

On this record, Opposer has established that it has a "real interest," *i.e.*, a direct and personal stake, in the outcome of the proceeding, as well as a "reasonable basis" for its belief of damage.

For completeness, we note Applicant's argument that "there is a factual dispute regarding standing, in light of Opposer's admission as to the descriptive and/or generic nature of its purported mark, and also a factual dispute as to likelihood of confusion" (Applicant's brief, p. 2). This argument misses the point. A determination of standing is distinct from a determination on the merits. See *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987). Whether Opposer's mark is descriptive, and whether Opposer can demonstrate likelihood of confusion, are not issues that negate Opposer's

⁵ The Office action citing Applicant's application as a potential bar to registration of Opposer's mark issued September 19, 2012, *after* Opposer filed this opposition. Accordingly, the notice of opposition does not allege the citation of Applicant's application.

standing, or that operate to disprove Opposer's real interest in this proceeding.⁶

On this record, Opposer has carried its burden of demonstrating that there is no genuine dispute with respect to its standing.

Priority

Opposer claims priority of use on its identified goods as of October 2002, based on common law use by its predecessor-in-interest and sole owner and director, Shanti McIvor. To establish its earliest use of the mark in commerce, Opposer, submits "records of sales made to United States customers," consisting of emails between Opposer and its customers. The earliest available emails are dated October 22, 2002, and February 2003 through August 2005 (McIvor decl., para. 24, Exh. 12). Opposer also submits a sales invoice list covering July 2007 through June 2011 (McIvor decl., para 31, Exh. 13).

Applicant challenges Opposer's priority, arguing that Opposer's use of its mark was not and has not been lawful use in commerce due to failure to comply with applicable U.S. regulatory requirements. Applicant submitted excerpts from Opposer's discovery deposition that include statements regarding Opposer's past and present efforts to comply with U.S. regulations that govern children's products. (McIvor depo., p. 117-119). Applicant cites,

⁶ Applicant's argument that Opposer's rights in the mark "were somehow transferred" (Applicant's brief, p. 10) is unclear and is not supported by the transcript on which Applicant relies. The argument fails to raise a genuine dispute against the clear evidence of record which demonstrates that Opposer has standing.

inter alia, *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270 (TTAB 1992).

In reply, Opposer argues, *inter alia*, that it has been compliant with U.S. regulations, that Ms. McIvor's deposition concerned compliance with voluntary or proposed regulations that are not yet in effect, and that it intends to be compliant with certain regulations so that United States importers can accept Opposer's goods (reply brief, p. 7-8).

On this record, neither party has carried its burden of demonstrating there is no genuine dispute with respect to whether Opposer has priority. Opposer's evidence of its earliest use of the mark, in support of its asserted priority date, consists only of emails. For its part, Applicant has come forward with statements in a discovery deposition that indicate the existence of a dispute regarding whether Opposer's use was and has been lawful use in commerce.

In view of this record, the parties' cross-motions for summary judgment are denied with respect to priority.

Likelihood of confusion

To prevail, either party must demonstrate that there is no genuine dispute with respect to whether the contemporaneous use of the parties' respective marks on their respective services would be likely to cause confusion, mistake or to deceive consumers regarding the source of the goods and services. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60

USPQ2d 1733, 1735 (TTAB 2001). Consideration of this issue in the context of summary judgment motions involves an analysis of all of the probative facts in evidence that are relevant to the thirteen factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont* factors”). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We look to whether there are genuine disputes with respect to any of these factors which would be material to a decision on the merits.

Opposer argues that the marks are highly similar, and that the parties’ goods are the same or highly related and overlapping, that is, baby carriers and related products. It also asserts that there is evidence of actual confusion, and in support thereof submits seven email inquiries it received from consumers who referenced, inquired about, or sought clarification regarding applicant’s products or advertisements (McIvor decl., para. 48, Exh. 10).

Applicant argues that the design element in its mark is prominent, and that Opposer’s mark is weak, pointing to alleged admissions in Opposer’s testimony as to its awareness of third-party users of variations of the wording “baba sling” (Applicant’s brief, p. 10-11; McIvor depo. p. 22-24).

On this record, neither party has carried its burden of demonstrating that there is no genuine dispute as to likelihood of confusion. At a minimum, the record reflects that a genuine dispute exists regarding the material issue of

the similarity or dissimilarity of the marks, the first *du Pont* factor. Furthermore, there exists genuine dispute regarding the scope of protection to be afforded the wording BABA SLING or BABA SLINGS.⁷

In view of this record, the parties' cross-motions for summary judgment are denied with respect to likelihood of confusion.

Summary

Summary judgment is granted with respect to Opposer's standing. Inasmuch as neither party has carried its burden, the cross-motions for summary judgment are denied with respect to priority and likelihood of confusion.

Schedule

Proceedings are resumed. Opposer's trial period, and subsequent trial dates, are reset as follows:

Plaintiff's 30-day Trial Period Ends	11/28/2014
Defendant's Pretrial Disclosures	12/13/2014
Defendant's 30-day Trial Period Ends	1/27/2015
Plaintiff's Rebuttal Disclosures	2/11/2015
Plaintiff's 15-day Rebuttal Period Ends	3/13/2015

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within

⁷ The evidence submitted in connection with the motions for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See, e.g., Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1438 n.14 (TTAB 2007); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). Also, the fact that we have identified certain issues in dispute

thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

should not be construed as a finding that these are necessarily the only issues which remain for trial.