

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: April 4, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Naterra International, Inc.*

*v.*

*Samah Bensalem*  
—

Cancellation No. 92074494  
—

David W. Carstens of Carstens & Cahoon LLP,  
for Naterra International, Inc.

Jeffrey Sturman of Sturman Law, LLC,  
for Samah Bensalem.

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Before Lykos, Larkin, and Lebow,  
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Samah Bensalem (“Respondent”) owns a registration on the Principal Register for the standard character mark BABIES’ MAGIC TEA (“BABIES” and “TEA” disclaimed) for “medicated tea for babies that treats colic and gas and helps babies

sleep better” in International Class 5.<sup>1</sup>

Naterra International, Inc. (“Petitioner”) seeks cancellation of Respondent’s registration on the grounds that the mark BABIES’ MAGIC TEA for the identified goods is likely to be confused with, and is likely to dilute by blurring, Petitioner’s mark BABY MAGIC, which is registered in three registrations in typed form<sup>2</sup> on the Principal Register for “body powder, body oil and skin cleanser”;<sup>3</sup> “hair shampoo”;<sup>4</sup> and “skin lotion”;<sup>5</sup> and in a fourth registration in standard characters on the Principal Register for “baby hair conditioner; baby lotion; baby oil; baby powder; baby shampoo; baby wipes; bath soaps in liquid, solid or gel form; bubble bath; cologne; non-medicated bath preparations; non-medicated diaper rash cream; non-medicated diaper rash ointments and lotions; skin cleansers; skin conditioners; sun screen”;<sup>6</sup> all in International Class 3.<sup>7</sup>

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<sup>1</sup> Registration No. 4771300 (“Respondent’s Registration”) issued on July 14, 2015 from an application filed on March 19, 2014 and claiming a date of first use anywhere and first use in commerce of March 8, 2013, and has been maintained.

<sup>2</sup> A typed mark is the legal equivalent of a standard character mark. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2014).

<sup>3</sup> Registration No. 1228079 issued February 22, 1983 from an application filed on June 12, 1981, and claiming a date of first use anywhere and in commerce of January 1966; renewed.

<sup>4</sup> Registration No. 1055375 (in typed form), issued January 4, 1977, from an application filed on April 8, 1976, and claiming a date of first use anywhere and first use in commerce of September 26, 1975; renewed.

<sup>5</sup> Registration No. 0580657 (in typed form), issued October 6, 1953, from an application filed on February 11, 1950, and claiming a date of first use anywhere and first use in commerce of January 3, 1950; renewed.

<sup>6</sup> Registration No. 3890083 (in standard characters), issued December 14, 2010, from an application filed on April 28, 2010, and claiming a date of first use anywhere and first use in commerce of January 31, 2009; renewed.

<sup>7</sup> We refer to Petitioner’s four pleaded registrations collectively as “Petitioner’s Registrations.”

Respondent's Answer denied the salient claims of the Petition for Cancellation.<sup>8</sup>

Petitioner and Respondent filed briefs. Petitioner, as plaintiff in this proceeding, bears the burden of establishing its statutory entitlement to a cause of action and Section 2(d) claim by a preponderance of the evidence. *See Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007).

We deny the petition.

### **I. The Record**

The record includes the pleadings, the file of Respondent's Registration by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), and the following evidence made of record by the parties:

Petitioner submitted a notice of reliance on Respondent's responses to Petitioner's discovery requests, including interrogatories and requests for admissions;<sup>9</sup> the

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<sup>8</sup> Applicant also asserted laches and estoppel by acquiescence as affirmative defenses in its Answer but did not pursue them in its final brief, so they are waived. *See TPI Holdings, Inc. v. TrailerTrader.com LLC*, 126 USPQ2d 1409, 1413 n.28 (TTAB 2018); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.).

<sup>9</sup> 8 TTABVUE 5-13 (interrogatories), 15-20 (requests for admissions). Because denials of requests for admission cannot be submitted under notice of reliance, we have considered only Respondent's admissions. Trademark Rule 2.120(k)(3)(i), 37 C.F.R. § 2.120(k)(3)(i); *see also*, *e.g.*, *Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1395 n.9 (TTAB 2016); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 704.10 (June 2021).

Citations in this opinion to the briefs and other docket entries on appeal refer to TTABVUE, the Board's online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear. Citations to the prosecution history record in these proceedings refer to the online database of the USPTO's Trademark Status & Document Retrieval ("TSDR") system and, specifically, to the downloaded .pdf versions of the documents in the USPTO TSDR Case Viewer.

testimony declaration of Jon Song, Petitioner's Executive President, with an exhibit listing Petitioner's BABY MAGIC trademark registrations worldwide;<sup>10</sup> the testimony declaration of Tongil Kim, Ph.D., Petitioner's expert witness, with exhibits, including copies of Respondent's Registration, Petitioner's Registrations, printouts from the Office's TSDR database showing their status and title, and a list of eight journal articles referenced in his declaration.<sup>11</sup>

Respondent submitted a notice of reliance on official records consisting of copies of 395 third-party registration certificates for marks that contain the word "magic," and printouts from various third-party websites that use the word "magic" in the course of describing various goods.<sup>12</sup>

## **II. Petitioner's Objections to Respondent's Evidence**

In an appendix to its brief, Petitioner objects to the entirety of the evidence contained in Respondent's notice of reliance and requests that it be excluded from consideration.<sup>13</sup> In particular, with regard to the evidence of third-party registrations, Petitioner argues that (1) Respondent impermissibly dissected Petitioner's marks; (2) the marks in the third-party registrations do not contain both words "baby" and "magic"; and (3) to rely on them "to support the position that Petitioner's marks are weak, [Respondent] was required to provide testimony corroborating the allegations

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<sup>10</sup> 9 TTABVUE 2-10 ("Song Decl."), 11-15 (registration list).

<sup>11</sup> 10 TTABVUE 2-10 ("Kim Decl."), 21-76 (registrations), 77-78 (article list).

<sup>12</sup> 13 TTABVUE 1-19, 25-332 and 14 TTABVUE 2-62 (third-party registrations), 63-192 (third-party websites).

<sup>13</sup> 15 TTABVUE 37-39.

of use for each mark,” and because Respondent did not do so, the evidence is irrelevant.<sup>14</sup> Petitioner argues that Respondent’s Internet evidence should be excluded for the same reasons, as well as because “numerous pages contained within each exhibit contain no connection to [Petitioner’s] Marks,” and further, that such evidence is “needlessly cumulative and outweigh (sic) any probative value they may have.”<sup>15</sup>

Petitioner’s contention that Respondent may not rely on third-party registrations without corroborating use evidence of the marks in such registrations is erroneous. Even without proof of use, third-party registration evidence may bear on conceptual weakness of a plaintiff’s mark if a term is commonly registered for similar goods or services. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015).

We need not rule on the remainder of Petitioner’s objections to Respondent’s evidence, which are directed to its weight, rather than its admissibility, and are not outcome-determinative. “[B]ecause a [cancellation] proceeding is akin to a bench trial, the Board is capable of assessing the proper evidentiary weight to be accorded the ... evidence, taking into account the imperfections surrounding the admissibility of such ... evidence.” *Grote Indus., Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1200 (TTAB 2018) (quoting *U.S. Playing Card Co. v. Harbro LLC*, 81 USPQ2d 1537, 1540 (TTAB 2006)). We “simply accord the evidence whatever probative value it deserves,

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<sup>14</sup> *Id.* at 37-38.

<sup>15</sup> *Id.* at 39-39.

if any at all ... and this precludes the need to strike” the evidence. *Hunt Control Sys. Inc. v. Koninklijke Philips Elecs. N.V.*, 98 USPQ2d 1558, 1564 (TTAB 2011); *see also Poly-Am., L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1510 (TTAB 2017) (where the objections refer to probative value rather than admissibility and the evidence that is subject to the objections is not outcome-determinative, “we choose not to make specific rulings on each and every objection”)).

### III. Entitlement to a Statutory Cause of Action<sup>16</sup>

A petitioner’s entitlement to invoke a statutory cause of action for cancellation of a registration is a necessary element in every cancellation proceeding even if, as here, the respondent does not contest the petitioner’s entitlement. *Chutter*, 2021 USPQ2d 1001, at \*10 (citing *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*6-7 (Fed. Cir. 2020), *cert. denied*, \_\_\_ U.S. \_\_\_, 141 S. Ct. 2671, 210 L. Ed. 2d 833 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at \*3 (Fed. Cir. 2020), *cert. denied*, \_\_\_ U.S. \_\_\_, 211 L. Ed. 2d 16 (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 134 S. Ct. 1377, 188 L. Ed. 2d 392, 109 USPQ2d 2061, 2067 n.4 (2014)). Petitioner may seek to cancel Respondent’s Registration if its claim falls within the zone of interests protected by the statute, 15 U.S.C. § 1064, and Petitioner has a

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<sup>16</sup> Board decisions previously analyzed the requirements of Sections 13 and 14 of the Trademark Act under the rubric of “standing.” Although “[w]e now refer to what previously had been called standing as ‘entitlement to a statutory cause of action,’ ... our prior decisions and those of the Federal Circuit interpreting ‘standing’ under §§ 13 and 14 remain applicable.” *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at \*10 n.39 (TTAB 2021) (citing *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at \*2 (TTAB 2020)).

reasonable belief in damage that is proximately caused by the continued registration of Respondent's mark. *Chutter*, 2021 USPQ2d 1001, at \*10 (citing *Spanishtown Enters.*, 2020 USPQ2d 11388, at \*1).

Petitioner's claim of damage (and priority, as discussed below) is based primarily on ownership of its pleaded registrations. Therefore, we must determine whether those registrations are properly of record. There are several ways of properly introducing pleaded registrations into the record in an inter partes proceeding. Under Trademark Rule 2.122(d), a plaintiff may introduce its pleaded registration(s) by: (1) attaching to its complaint Office records showing the current status and title of the registrations; (2) appropriate identification and introduction during testimony; or (3) filing a notice of reliance during trial accompanied by Office records showing the current status and title of the registrations. Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d); *United Global Media Grp. v. Tseng*, 112 USPQ2d 1039, 1041-42 (TTAB 2014) (explaining the ways in which a pleaded registration may be made of record).

"These rules are simple and clear, but [Petitioner] did not follow them." *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991). Petitioner did not attach Office records showing the current status and title of its pleaded registrations to the complaint (method (1)), nor did Petitioner submit such documents through a notice of reliance (method (3)). Instead, Petitioner attached copies of the registrations, along with printouts from the Office's TSDR database showing their title and status, as exhibits to the testimony declaration of its expert witness, Tongil Kim, Ph.D., who merely states that he "studied" them in preparation

for his testimony.<sup>17</sup> This is not “appropriate identification and introduction [of the registrations] during testimony” (method (2)) as contemplated by Rule 2.122(d), since Dr. Kim, an expert witness, not a fact witness, did not also testify as to their current status and ownership, or even that he had the personal knowledge required to introduce the registrations as a fact witness. *See* Fed. R. Evid. 602 (“A witness may not testify to matter unless evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter.”).

On the other hand, Petitioner’s Executive President, Song Kim, did state in his declaration that:

**4. Petitioner owns several valid and subsisting U.S. trademark registrations (the “BABY MAGIC Mark”) including U.S. trademark Reg. No. 1,228,079 for the mark BABY MAGIC in connection with “body powder, body oil and skin cleanser” in International Class 3, which was registered on the Principal Register on February 22, 1983.**

5. Petitioner owns U.S. Trademark Reg. No. 1,055,375 for BABY MAGIC in connection with “hair shampoo” in International Class 3, which was registered on the Principal Register on January 4, 1977.

6. Petitioner owns U.S. Trademark Reg. No. 0,580,675 for BABY MAGIC in connection with “skin lotion” in International Class 3, which was registered on the Principal Register on October 6, 1953.

7. Petitioner owns U.S. Trademark Reg. No. 3,890,083 for BABY MAGIC in connection with “baby hair conditioner; baby lotion; baby oil; baby powder; baby shampoo; baby wipes; bath soaps in liquid, solid or gel form; bubble bath; cologne; laundry detergent; non-medicated bath preparations; non-medicated diaper rash cream; non-medicated diaper rash ointments and lotions; skin cleansers; skin conditioners; sun screen” in International Class 3, which was registered on the Principal Register on December 14, 2010.<sup>18</sup>

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<sup>17</sup> 9 TTABVUE 3-4 (Kim Decl., ¶ 4).

<sup>18</sup> 9 TTABVUE 3-4 (Kim Decl.) (emphasis added).



Notably, Mr. Kim only specifically testifies that Registration No. 1228079 is valid and subsisting.

Nonetheless, registrations owned by a party “may be deemed by the Board to be of record in the proceeding, even though the registration[s] [were] not properly introduced in accordance with the applicable rules, if the adverse party in its brief, or otherwise, treats the registration[s] as being of record,” TBMP § 704.03(b)(1)(A), which Respondent does in this case. For example, Respondent argues that “Petitioner's Trademarks contains two words, one of which is descriptive of Petitioner’s goods, and has been disclaimed by Petitioner on their trademark registrations.”<sup>19</sup> Respondent also argues that “[t]he weakness in the term ‘baby’ is established prima facie by the disclaimer for the term on Petitioner’s Trademark Registrations.”<sup>20</sup>

We treat Respondent’s statements and its failure to object to Petitioner’s reliance on its pleaded registrations as an admission that Petitioner’s pleaded registrations are valid and owned by Petitioner, and are therefore entitled to the presumptions accorded by Section 7(b) of the Trademark Act. *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1654 (TTAB 2010), *aff’d*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) (treating current status and title of registrations as stipulated where applicant did not contest ownership or question whether they were still in force); *Riceland Foods Inc. v. Pac. E. Trading Corp.*, 26 USPQ2d 1883, 1885 (TTAB

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<sup>19</sup> 16 TTABVUE 9 (Respondent’s Brief).

<sup>20</sup> *Id.* at 13.

1993) (“[A]pplicant ... treats the registration as if properly of record. In view thereof, we have treated opposer’s registration to be of record.”); *see also* TBMP § 704.03(b)(1).

Because Petitioner’s pleaded registrations for the mark BABY MAGIC are deemed of record, and they form the basis for Petitioner’s claim of likelihood of confusion with Applicant’s mark BABIES’ MAGIC TEA, “which is not wholly without merit,” *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982), Petitioner’s entitlement to petition for cancellation of Respondent’s Registration is established. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (party’s ownership of pleaded registration establishes standing).<sup>21</sup>

#### **IV. Priority**

That Petitioner’s Registrations are deemed of record does not mean that Petitioner established priority on its likelihood of confusion claim. “In a cancellation proceeding such as this one where both parties own registrations, priority is in issue.” *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1474

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<sup>21</sup> To the extent Petitioner also intended to rely on common law rights acquired in the BABY MAGIC mark for the purpose of establishing either its entitlement to bring a statutory cause of action in this proceeding or its priority, Petitioner’s attempt to do so is insufficient. Although Petitioner, in its petition for cancellation, alleged that it “used in commerce ... its BABY MAGIC mark in commerce well before Respondent’s March 19, 2014 filing date and Respondent’s March 8, 2013 date of first use in commerce,” 1 TTABVUE 8, Petitioner does not identify any particular goods or services in association with that statement. Additionally, Mr. Kim, Petitioner’s only fact witness, testified only generally in his declaration about Petitioner’s early use its marks. The closest he comes to asserting prior use at common law is the statement, “Below are some video stills of Baby Magic commercials between the 1960s and 2010s,” which refers to four still photos embedded in his declaration showing the mark BABY MAGIC on baby lotion, baby oil and bubble bath products. 9 TTABVUE 6. But there is no specific indication where those marked products were advertised, and whether such advertising was even in the United States.

(TTAB 2014). *See also Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1169 (TTAB 2011) (“With respect to the petition to cancel North Atlantic’s ... mark, Top must prove that it has a priority interest in [its] mark ... and that interest was obtained prior to either the filing date of North Atlantic’s [underlying] application for registration or North Atlantic’s date of first use.”).

Under Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c), a party may rely upon the filing date of the application underlying its registration for purposes of priority as its constructive use date. *See Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1140 (TTAB 2013); *Larami Corp. v. Talk to Me Programs, Inc.*, 36 USPQ2d 1840, 1844 (TTAB 1995) (parties may rely on the constructive use i.e. filing dates for purposes of priority). A party may, of course, rely on an earlier priority date based on common law rights including the date of first use set forth in its registration or in any statement made during the prosecution history of the underlying application; however, any such earlier priority date must be established by competent evidence.

In this case, Petitioner relies on the filing date of the underlying applications that matured into Petitioner’s Registrations, all of which precede the March 19, 2014 filing date of Respondent’s Registration,<sup>22</sup> as its constructive use dates to prove priority. *Brewski Beer Co. v. Brewski Bros. Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998) (“petitioner or respondent may rely on its registration for the limited purpose of

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<sup>22</sup> *See* notes 3-6, *supra*. Respondent did not introduce any evidence of actual use prior to Petitioner’s constructive use dates.

proving that its mark was in use as of the application filing date”). Accordingly, Petitioner has demonstrated priority.

We therefore proceed to consider the merits of Petitioner’s claims.

## **V. Likelihood of Confusion**

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at \*3 (Fed. Cir. 2020) (citing *Dixie Rests.*, 41 USPQ2d at 1533).

“Two key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because the ‘fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.’” *In re*

*Embiid*, 2021 USPQ2d 577, at \*10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004). See also *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

#### **A. The Strength of Petitioner’s BABY MAGIC Mark**

The fifth *DuPont* factor enables Petitioner to expand the scope of protection afforded its pleaded BABY MAGIC mark by adducing evidence of “[t]he fame of the prior mark (sales, advertising, length of use),” while the sixth *DuPont* factor allows Respondent to contract that scope of protection by adducing evidence of “[t]he number and nature of similar marks in use on similar goods.” *DuPont*, 177 USPQ at 567.

Under the fifth factor, likelihood of confusion fame is not “an all-or-nothing measure.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017). “[It] varies along a spectrum from very strong to very weak.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)).

To determine a mark’s place on that spectrum, we consider its inherent strength, based on the nature of the mark itself, and, if there is probative record evidence, its

commercial strength, based on its marketplace recognition. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength.”); *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. March 2021 update) (“The first enquiry is for conceptual strength and focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”).

### **1. Inherent Strength of the BABY MAGIC Mark**

Although Respondent does not challenge the distinctiveness of Petitioner’s mark, Respondent argues that “the first word of Petitioner’s two word trademark is a descriptive term, ‘baby’” and “[t]he weakness in the term ‘baby’ is established prima facie by the disclaimer for the term on Petitioner’s Trademark Registrations.”<sup>23</sup> Additionally, to establish weakness of the term “magic” in Petitioner’s BABY MAGIC mark, Respondent provided evidence of numerous used-based third-party registrations of marks that contain that word MAGIC for use with many of the same or similar goods identified in Respondent’s Registrations, such as the following:

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<sup>23</sup> 16 TTABVUE 13 (Respondent’s Brief).

- ABSOLUTELY MAGIC for non-medicated skin care and treatment products, namely, hand moisturizers, and body lotions;<sup>24</sup>
- NATURALLY MAGIC for, inter alia, body lotion, soap, body polish, body and foot scrub and non-medicated skin creams;<sup>25</sup>
- MOROCCAN MAGIC for, inter alia, non-medicated skin care lotions, and non-medicated skin, body and facial topical preparations in the nature of lotions and creams; soaps and shampoos;<sup>26</sup>
- GREEN MAGIC for, inter alia, hair care creams, lotions, and preparations, and hair shampoos and conditioners;<sup>27</sup>
- DOUBLE MAGIC for, inter alia, hair care creams, hair care lotions and preparations; and hair shampoos and conditioners;<sup>28</sup>
- BLACK MAGIC for, inter alia, hair care preparations, liquid soaps for hands, face and body; and skin lotions;<sup>29</sup>
- BEARD MAGIC for, inter alia, hair shampoo and conditioners, and non-medicated preparations all for the care of skin, hair and scalp;<sup>30</sup>
- AVOCADO MAGIC for skin and body topical lotions, creams and oils

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<sup>24</sup> 13 TTABVUE 26 (Reg. No. 2655006).

<sup>25</sup> *Id.* at 127 (Reg. No. 4992231).

<sup>26</sup> *Id.* at 119 (Reg. No. 5110800).

<sup>27</sup> *Id.* at 58 (Reg. No. 4349002).

<sup>28</sup> *Id.* at 51 (Reg. No. 5416758).

<sup>29</sup> *Id.* at 33 (Reg. No. 4999256).

<sup>30</sup> *Id.* at 29 (Reg. No. 5063054).

made in significant part of avocado for cosmetic use;<sup>31</sup>

- ACNE MAGIC for skin cream;<sup>32</sup>
- CLEARLY MAGIG for non-medicated hand soaps;<sup>33</sup>
- COLORADO MAGIC for skin care preparations, namely, body balm.<sup>34</sup>
- DARK MAGIC for, inter alia, skin moisturizer, sunblock and sun screen preparations;<sup>35</sup>
- DERMA MAGIC for non-medicated skin care preparations, namely, skin cream, skin moisturizing lotion, body lotion, and facial cleansers;<sup>36</sup>
- EVERYDAY MAGIC for non-medicated skin care preparations;<sup>37</sup> and
- GENTLE MAGIC for soaps, namely, beauty soap, shower soap, liquid soap for personal use, skin creams and lotions, shampoos.<sup>38</sup>

Although a mark's commercial or marketplace strength is not affected by third-party registration evidence, *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259-60 (Fed. Cir. 2010), *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009) (third-party registrations "are not evidence of third-party use of the registered marks in the marketplace"), such evidence may show that a term carries a highly

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<sup>31</sup> *Id.* at 154 (Reg. No. 4273036).

<sup>32</sup> *Id.* at 27 (Reg. No. 6018007).

<sup>33</sup> *Id.* at 41 (Reg. No. 5605343).

<sup>34</sup> *Id.* at 44 (Reg. No. 5401270).

<sup>35</sup> *Id.* at 47 (Reg. No. 6342533).

<sup>36</sup> *Id.* at 49 (Reg. No. 4462140).

<sup>37</sup> *Id.* at 55 (Reg. No. 5945642).

<sup>38</sup> *Id.* at 56 (Reg. No. 5439220).



suggestive connotation in the relevant industry and therefore may be considered somewhat weak. *Jack Wolfskin*, 116 USPQ2d at 1136; *see also Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); *Institut Nat'l Des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (“Such third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services.”).

The third-party uses can also bear on the inherent strength or weakness of a petitioner’s mark. *Juice Generation*, 115 USPQ2d at 1675. Like third-party registrations, the use of a term as, or as part of, a trademark by a number of entities can indicate that it carries a suggestive or descriptive connotation for the particular goods. *Id.* (extensive evidence of third-party use and registrations indicates that the term carries a suggestive or descriptive connotation in the particular industry). In this regard, Respondent submitted excerpts from third-party websites that use the term “magic” in some form to describe alleged magical results of using the promoted skin care products such as the lotions and soaps identified in Petitioner’s Registrations (as well as teas, such as those identified in Respondent’s Registration),<sup>39</sup> which corroborate the third-party registration evidence above showing the term “magic” to be somewhat suggestive.

We take judicial notice of the definition of “magic,” which means “possessing

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<sup>39</sup> 14 TTABVue 63-192 (Respondent’s Notice of Reliance).

distinctive qualities that produce unaccountable or baffling effects.”<sup>40</sup> This definition, along with the third-party registration evidence noted above and others in the record, show the word MAGIC to be suggestive of the qualities and/or results provided by the lotions, creams, moisturizers, soaps, shampoos, sunscreen, and other products identified in Petitioner’s Registration.<sup>41</sup> When MAGIC is combined with the descriptive and appropriately disclaimed word BABY in the mark BABY MAGIC, we find that Petitioner’s mark is somewhat conceptually weak.

Nevertheless, because Petitioner’s BABY MAGIC mark is registered on the Principal Register in Petitioner’s Registrations without claims of acquired distinctiveness under Section 2(f) of the Trademark Act, we must presume that it is inherently distinctive, i.e., that it is at worst suggestive of Respondent’s goods, and is entitled to the presumptions accorded to registered marks pursuant to Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). *See Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (“A mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the

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<sup>40</sup> THE AMERICAN HERITAGE DICTIONARY (ahdictionary.com), accessed March 21, 2022. The Board may take judicial notice of dictionary definitions from online sources when the definitions themselves are derived from dictionaries that exist in printed form or have regular fixed editions. *See In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at \*7 n.29; *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013).

<sup>41</sup> Although Applicant submitted evidence of 365 third-party registrations, not all of them are relevant. We focus here only on the marks in those registrations that end in “MAGIC” and have similar connotations for the same or similar goods. *See Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1695 (Fed. Cir. 2018) (finding the Board’s analysis under the sixth *DuPont* factor flawed because its was based on “irrelevant evidence of unrelated goods.”).

registration, that the mark is inherently distinctive for the goods.”).

## 2. Commercial Strength of the BABY MAGIC Mark

In its petition for cancellation, Petitioner alleges that “[t]hrough extensive use and promotion for over sixty-five years, Petitioner’s BABY MAGIC Mark has become distinctive and famous,” and that “Respondent’s claimed date of first use of the BABIES’ MAGIC TEA mark in connection with its medicated tea goods and its application for filing date for the BABIES’ MAGIC TEA mark were both long after Petitioner’s BABY MAGIC Mark became famous.”<sup>42</sup> In its trial brief, Petitioner argues that “[d]ecades of continuous and extensive use and promotion of [Petitioner’s] Marks has resulted in them becoming famous and among the very strongest marks in the United States and the world.”<sup>43</sup>

Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role that fame plays in the likelihood of confusion analysis, Petitioner has the duty to prove the fame of its BABY

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<sup>42</sup> 1 TTABVUE 8, ¶¶ 24-25.

<sup>43</sup> 15 TTABVUE 37. Based on context, Petitioner’s use of the term “Naterra’s Marks” in its brief appears to refer, collectively, to the BABY MAGIC mark in Petitioner’s Registrations.

MAGIC mark clearly. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).

Fame may be measured indirectly by the volume of sales of and advertising expenditures for the goods identified by the mark at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice by independent sources of the products identified by the mark, as well as its general reputation. *Bose Corp.*, 63 USPQ2d at 1305-06 and 1309.

However, as Respondent correctly notes, “[t]he record in this matter does not establish any information regarding sales or advertising expenditures in connection with Petitioners trademark,”<sup>44</sup> and it therefore also does not show the length of time those indications of commercial awareness would be evident. Nor is there evidence of any critical assessments or notice by independent sources of the products identified by the mark. Also absent is any evidence regarding the general reputation of Petitioner’s BABY MAGIC mark. Although Petitioner’s Executive President, Mr. Song, testified in his declaration that “[t]he Baby Magic Mark is immensely popular,” “has transcended multiple generations of parents that trust the quality of baby products associated with the Baby Magic Mark,” and “has a long and illustrious history that has made the mark famous in the world of baby products,”<sup>45</sup> these self-serving statements are unsupported by any corroborating evidence.

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<sup>44</sup> 16 TTABVUE 8-9 (Respondent’s Brief).

<sup>45</sup> 9 TTABVUE 4 (Song Decl, ¶ 8).

Further contextual evidence probative of the fame of a mark may include the extent of catalog and direct mail advertising, email blasts, customer calls, and use of social media platforms, such as Twitter, Instagram, Pinterest, and Facebook, identifying the number of followers; the number of consumers that the owner solicits through its advertising throughout the year; local, regional, and national radio and television advertising campaigns, freestanding print campaigns, and referrals in national publications; unsolicited media attention; and product placement in television and in movies. *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1690-91 (Fed. Cir. 2018).

Petitioner, however, provided no evidence of the extent of its advertising, the number of customers it solicits through advertising by year, unsolicited media attention, or product placement in movies. Rather, Petitioner's evidence of fame is limited to several mostly unsupported and conclusory statements made by Mr. Song in his testimony declaration, which contain only generalities about the BABY MAGIC mark and its purported fame.<sup>46</sup> For example, Mr. Song stated that “[t]he Baby Magic Mark first appeared in a commercial advertisement in Collier’s Magazine in 1952,”<sup>47</sup> but he does not mention the products promoted by that commercial. He further states that “[t]he Baby Magic Mark has been used on baby products for close to seventy

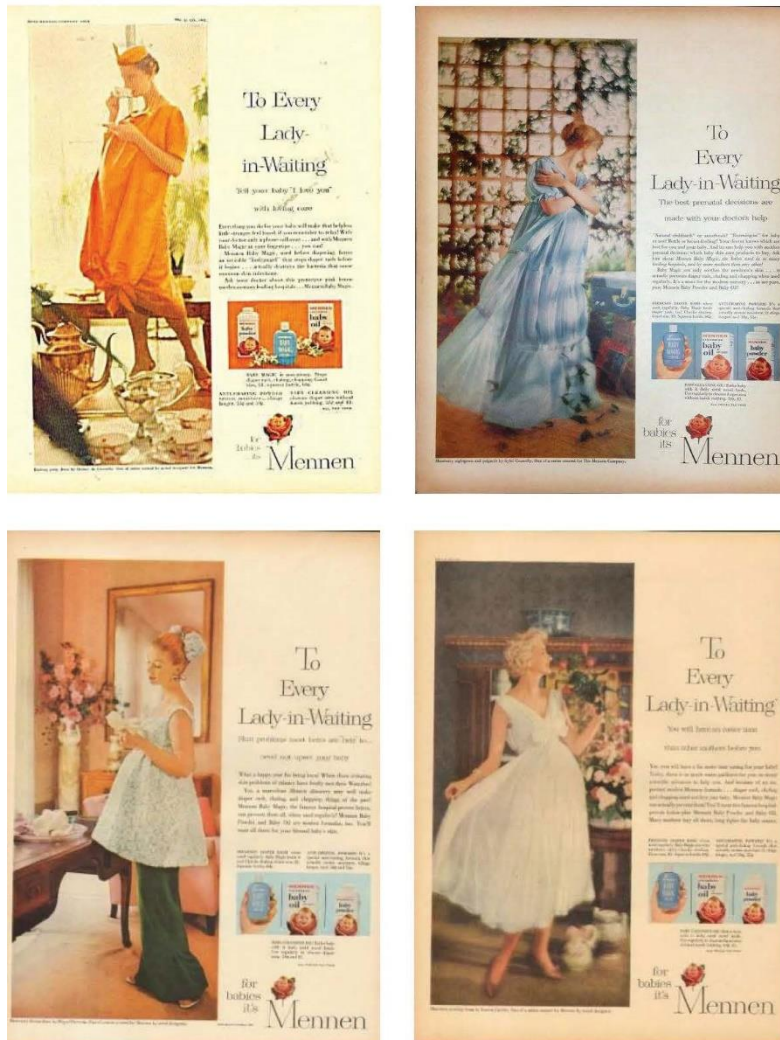
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<sup>46</sup> Although Mr. Song testified that he worked for Petitioner for six years and has personal knowledge of the facts set forth in his declaration, *id.* at 3 (¶¶ 1 and 3), he does not specifically testify that his personal knowledge regarding the history of the BABY MAGIC brand was acquired through a review of Petitioner’s files and records, thus further reducing the probative value of his testimony.

<sup>47</sup> *Id.* at 4-5 (¶ 9).

years in the United States,”<sup>48</sup> but again does not mention the products provided under the mark during that time period.

Mr. Song testified in his declaration that “[b]y 1959, the Baby Magic Mark was part of the nationwide ‘Lady in Waiting’ advertisement campaign,” which “[a]s seen below ... widely and prominently advertised the Baby Magic Mark. As seen below, the ‘Lady in Waiting’ campaign advertised the Baby Magic Mark”:<sup>49</sup>



<sup>48</sup> *Id.* at 5.

<sup>49</sup> *Id.* (¶ 10).

However, Mr. Song provides no information about the “Lady in Waiting” advertising campaign, such as the period of time it was ongoing, the platforms in which the campaign took place, the number of customers reached by that campaign, and again, the products promoted by that campaign. Furthermore, the advertisement excerpts shown above, which are reproduced here in the same size and format as they are shown embedded in Mr. Song’s declaration, are only partially legible.<sup>50</sup>

Mr. Song further testified that “[i]n 1960, the Baby Magic Mark reached vastly more consumers with the launch of the first Baby Magic television commercial,” and that “[b]y 1975, the Baby Magic Mark was widely televised to cover multiple products.”<sup>51</sup> He does not say what those multiple products are. He also provided, embedded within his declaration testimony, several “video stills of Baby Magic commercials between the 1960s and 2010” showing the BABY MAGIC mark applied to shampoo, lotion, oil, powder, and bubble bath products, but again he provides no information about the extent of the advertising, such as the particular television outlets in which the advertisements appeared, the frequency of the advertisements, or the number of customers reached relative to market standards for such advertising in the baby products industry.

Still further, Mr. Song testified that “[i]n recent years, [Petitioner] has advertised

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<sup>50</sup> The party who submits evidence must ensure that the evidence is legible. *See, e.g., RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1806 n.16 (TTAB 2018) (“Illegible evidence is given no consideration.”), *aff’d*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff’d*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1758 (TTAB 2013), *aff’d mem.*, 565 F. App’x 900 (Fed. Cir. 2014) (“Petitioner has a duty to ensure that the evidence it submits is legible.”).

<sup>51</sup> 9 TTABVUE 5-6 (¶ 11).

its products through social media, including on Facebook, Instagram, and Twitter.”<sup>52</sup> However, we do not know what is meant by “recent years,” and this statement tells us nothing about the extent of such social media advertising or the products promoted therein.

Finally, referencing a list of Petitioner’s 16 foreign registrations attached as an exhibit to his declaration, Mr. Song asserts that “the famous nature of the Baby Magic Mark has enabled [Petitioner] to expand successfully into many foreign countries.”<sup>53</sup> The mere fact that Petitioner has obtained various registrations in foreign jurisdictions does not aid our determination of whether Petitioner’s mark has achieved fame in the United States. *See Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991) (information concerning applicant’s foreign activities is not relevant to the issues in an inter partes proceeding).

Overall, Petitioner’s evidence fails to carry Petitioner’s burden to clearly show that that its BABY MAGIC mark is commercially strong, let alone famous.<sup>54</sup> Therefore,

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<sup>52</sup> *Id.* at 6.

<sup>53</sup> *Id.* at 7 (¶ 13).

<sup>54</sup> Our finding that Petitioner failed to show that BABY MAGIC is commercially strong for purposes of Petitioner’s Section 2(d) claim also precludes Petitioner’s dilution claim, in which the threshold element is proof that it owns a “famous” mark. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (“A threshold question in a federal dilution claim is whether the mark at issue is ‘famous.’”). A mark is famous for dilution if it “is widely recognized by the general consuming public of the United States as a designation of source for the goods or services of the mark’s owner.” 15 U.S.C. § 1125(c)(2)(A). By using the “general consuming public” as the benchmark, the Trademark Act eliminates the possibility of “niche fame,” which some courts had recognized under the previous version of the statute. *Coach Servs.*, 101 USPQ2d at 1372.



under the fifth *DuPont* factor, we find that Petitioner’s BABY MAGIC mark falls somewhere in the middle of the fame spectrum.

As to the sixth *DuPont* factor, Petitioner argues that “there is no evidence in the record of the use by third parties of any marks or goods similar to those of [Petitioner], so this factor also weighs in favor of Petitioner.<sup>55</sup> We agree that there is no evidence of third-party use of similar marks or goods in the record, and find this factor neutral. On this record, we accord Petitioner’s BABY MAGIC mark “the normal scope of protection to which inherently distinctive marks are entitled.” *Bell’s Brewery*, 125 USPQ2d at 1347.

## **B. Comparison of the Marks**

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Petitioner’s and Respondent’s marks in their entirety, taking into account their

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Fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing. *See* 4 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:104 at 24-290 (5th ed. 2021) (“The standard for the kind of ‘fame’ needed to trigger anti-dilution protection is more rigorous and demanding than the ‘fame’ which is sufficient for the classic likelihood of confusion test.”). While fame for dilution “is an either/or proposition” — it either exists or does not — fame for likelihood of confusion is a matter of degree along a continuum.” *Palm Bay*, 73 USPQ2d at 1694. Accordingly, a mark can acquire “sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame.” *Coach Servs.*, 101 USPQ2d at 1724 (quoting *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1722 (TTAB 2007)).

It is well-established that dilution fame is difficult to prove. *See Coach Servs.*, 101 USPQ2d at 1724 (citing *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001) (“Fame for dilution purposes is difficult to prove.”). If Petitioner cannot prove that its BABY MAGIC mark is commercially strong for purposes of analyzing likelihood of confusion, a fortiori it cannot prove it is famous for dilution purposes. Accordingly, we deny Petitioner’s dilution by blurring claim.

<sup>55</sup> 13 TTABVUE 30 (Petitioner’s Brief).

appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *Palm Bay*, 73 USPQ2d at 1692. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, (Fed. Cir. Sept. 13, 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). *Accord, Krim-Ko Corp. v. Coca-Cola Bottling 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.”) (citation omitted). Once again, Petitioner’s mark is BABY MAGIC and Respondent’s mark is BABIES’ MAGIC TEA.

Pointing out that “consumers generally fixate on the first word of a trademark,” Petitioner argues that the parties’ marks are confusingly similar because they “share nearly identical first two words in their respective marks: BABY MAGIC versus BABIES’ MAGIC,” and “[Respondent’s use of the plural form BABIES ... does not change [its] commercial impression” from being “essential identical in sound, appearance, meaning, and commercial impression” to Petitioner’s mark.<sup>56</sup> Thus, according to Petitioner, “[Respondent’s] Mark is likely to be perceived as identifying a new line or product sold under [Petitioner’s] Marks” due to “umbrella branding.”<sup>57</sup>

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<sup>56</sup> 15 TTABVUE 23-24 (Petitioner’s Brief).

<sup>57</sup> *Id.* at 24. Petitioner’s expert witness, Dr. Kim, an assistant professor of marketing at the University of Texas at Dallas, explains in his declaration that the “brand extension strategy . . . known as umbrella branding” is “[w]hen a company introduces a new product, it often uses the same brand as its old product when the old product is well-known and well-regarded among consumers.” 10 TTABVUE 5.

We find that the marks BABY MAGIC and BABIES' MAGIC TEA are more similar than dissimilar in appearance, sound, connotation and commercial impression. As Petitioner correctly notes, consumers are generally more inclined to focus on and remember the first literal portion in any mark. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”); *Palm Bay*, 73 USPQ2d at 1692; *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”).

The singular/plural distinction between the parties’ marks is insignificant, as Petitioner also points out, because the first two words of Respondent’s BABIES’ MAGIC mark and the entirety of Petitioner’s BABY MAGIC mark look and sound almost the same and have the same connotation and commercial impression. *See Wilson v. Delaunay*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957), (“[T]here is no material difference, in a trademark sense, between the singular and plural forms of the word ‘Zombie’ and they will therefore be regarded here as the same mark.”); *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2011 n.17 (TTAB 2015) (singular and plural of SWISS GRILL deemed “virtually identical”). This finding is bolstered by the principle that “marks must be considered in light of the fallibility of memory and not on the basis of side-by-side comparison.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014). *See also Neutrogena Corp. v. Bristol-Myers Co.*,

410 F.2d 1391, 161 USPQ 687, 688 (CCPA 1969) (many consumers “may have but dim recollections from having previously seen or heard one or the other of the involved marks.”).

Perhaps more importantly, because both Petitioner’s and Respondent’s marks are in typed or standard characters, we must consider that both marks may be presented in the same font, size and color. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018). As such, Petitioner’s mark could be depicted in any font size, style or color that Respondent might adopt for its mark. *In re Viterra Inc.*, 101 USPQ2d at 1909-11; *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 98 USPQ2d at 1259 (cited in *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1823 (TTAB 2015)). For example, if Respondent chose to emphasize the first two words, BABIES’ MAGIC, in larger and/or bold font, or displayed those words in a color that sets them apart from the generic term TEA, then the confusing similarity of the respective marks would be increased even further. In other words, to the extent use of the word MAGIC in Respondent’s mark appears to modify the word TEA when read as standard characters, it would not do so if the latter is set apart from the words BABIES’ MAGIC, which Respondent is entitled to do based on the nature of its registration.

In other words, Petitioner, as owner a registration for a standard character mark, may use its mark in a manner that “minimizes the differences or emphasizes the similarities between the marks.” *Anheuser-Busch*, 115 USPQ2d at 1823. By way of example, we reproduce below Respondent’s specimen of use, submitted in supported

of its September 4, 2020 declaration of continuing use of the mark under Section 8, which the USPTO accepted, showing Respondent's use of its registered BABIES' MAGIC TEA mark in a manner that emphasizes the BABIES' MAGIC portion over the TEA portion of its mark by displaying the words "Babies' Magic" in a stylized typeface considerably larger than the capitalized block letters in which the word TEA is displayed:



While we must consider the marks in their entirety, as Respondent acknowledges, quoting the Federal Circuit in *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985), "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark,

provided the ultimate conclusion rests on consideration of the marks in their entirety.” Although we acknowledge that there are differences between the respective marks in appearance and sound due to addition of the generic word TEA (for tea) in Respondent’s mark, that term is least dominant overall and entitled to the less weight in our analysis. Unlike Registrant’s mark BABY MAGIC, which is at most highly suggestive of Petitioner goods, TEA, as a generic term for “tea” in Respondent’s mark, has no source-identifying significance and “is the ultimate in descriptiveness.” *In re Serial Podcast, LLC*, 126 USPQ2d 1061, 1063 (TTAB 2018) (quoting *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)).

Overall, we find BABY MAGIC and BABIES’ MAGIC TEA to be more similar than dissimilar as to appearance, sound, connotation and commercial impression. The first *DuPont* factor thus weighs in favor of finding likelihood of confusion.

### **C. Comparison of the Goods and Trade Channels**

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration...,” and the third *DuPont* factor concerns the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567; *Stone Lion Capital*, 110 USPQ2d at 1161. “[L]ikelihood of confusion can be found ‘if the respective products are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the

same source.” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven*, 83 USPQ2d at 1724\_).

The issue here, of course, is not whether purchasers would confuse the parties’ goods, but rather whether there is a likelihood of confusion as to the source of those goods. *See Recot*, 54 USPQ2d at 1898 (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); *In re I-Coat Co., LLC*, 126 USPQ2d 1730, 1737 (TTAB 2018) (“the test is not whether consumers would be likely to confuse these goods, but rather whether they would be likely to be confused as to their source.”).

The goods identified in Petitioner’s Registrations include body powder, body oil, baby oil, hair shampoo, baby shampoo, baby hair conditioner, skin lotion, baby lotion, skin conditioners, skin cleansers, baby wipes, bath soaps, non-medicated bath preparations, bubble bath, non-medicated diaper rash cream, ointments and lotions, cologne, and sun screen, in Class 3. The single good identified in Respondent’s Registration is “medicated tea for babies that treats colic and gas and helps babies sleep better,” in Class 5.

Respondent does not argue in its brief that the parties’ goods are unrelated. At the same time, we note that Applicant does not have to make this argument; rather, it is Petitioner, as plaintiff in this proceeding, that has the burden of proving that the respective goods are related for purposes of likelihood of confusion. We reject Petitioner’s contention that because “[Respondent’s] Mark is nearly identical to

[Petitioner's] Marks, ... there only needs to be a viable relationship between the goods"<sup>58</sup> because we do not find that the marks are identical or virtually identical. See *In re L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012) (where applicant's mark is identical to opposer's mark, "there need only be a viable relationship between the goods to find that there is a likelihood of confusion"); *In re Thor Tech, Inc.*, 90 USPQ 2d 1634, 1636 (TTAB 2009) (same with respect to "virtually identical" marks).

"Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods are used together or used by the same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant's goods and the goods listed in the [involved] registration." *Embiid*, 2021 USPQ2d 577, at \*22 (quoting *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at \*5 (TTAB 2020)).

Petitioner, however, provided no such evidence. Instead, to show relatedness, Petitioner relies entirely on the declaration of its expert witness, Dr. Kim, who testified generally about the marketing concept known as "umbrella branding" and "natural zones of expansion" for companies engaging in such branding.<sup>59</sup> Dr. Kim also provides several unsupported anecdotes regarding several companies that provide goods that fall within the "categories" of goods provided by both Petitioner ("baby

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<sup>58</sup> 15 TTABVUE 25 (Petitioner's Brief).

<sup>59</sup> 15 TTABVUE 24, 26-28 (Petitioner's Brief); 15 TTABVUE (Kim Decl.).



skincare product category”) and Respondent (“baby ingestible product category”).<sup>60</sup> As discussed below, Petitioner has failed to introduce testimony or evidence sufficient to establish that the goods identified in Respondent’s Registration are the kind of goods that would be seen as affiliated or associated with, sponsored by, or emanating from, the same source as the goods identified in Petitioner’s Registrations. *See, e.g., Embiid*, 2021 USPQ2d 577, at \*22.

Petitioner does not actually argue in its briefs that providing medicated tea for babies is within its natural zone of expansion, focusing instead on the concept of umbrella branding, which Dr. Kim testified is a general strategy companies use to introduce new products under the same brand they used for a previous well-known and regarded product.<sup>61</sup> However, Dr. Kim also testified that “BABY MAGIC is an umbrella brand and Respondent’s goods fall within Baby Magic’s natural zone of expansion,”<sup>62</sup> so we discuss the doctrine of natural expansion here, and whether it applies in this case based solely on his testimony.

Generally, the doctrine of natural expansion “is used in the context of parties’ dueling claims of priority.” *Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1119 (TTAB 2015). Here, Petitioner has established its priority; we thus consider the natural expansion doctrine as “merely another facet” of the relatedness of goods inquiry. *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435,

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<sup>60</sup> 15 TTABVUE 7 (Kim Decl., ¶¶ 13-18).

<sup>61</sup> *See* note 54, *supra*.

<sup>62</sup> 10 TTABVUE 5 (Kim Decl., heading III, all caps in original). Dr. Kim’s testimony on the issue is faulty at the outset. Companies may have zones of natural expansion, but trademarks do not.

438-39 (CCPA 1965) (finding opposer likely to bridge the gap from its greeting card business to blank checks under identical mark).

“Under the doctrine of natural expansion, the first user of a mark in connection with particular goods or services possesses superior rights in the mark not only as against subsequent users of the same or similar mark for the same or similar goods or services, but also as against subsequent users of the same or similar mark for any goods or services which purchasers might reasonably expect to emanate from it in the normal expansion of its business under the mark.” *Mason Eng’g & Design Corp. v. Mateson Chem. Corp.*, 225 USPQ 956, 962 (TTAB 1985). Application of the doctrine is strictly limited to those cases where the expansion, whether actual or potential, is “natural,” that is, where the goods or services of the subsequent user, on the one hand, and the goods or services as to which the first user has prior use, on the other, are of such nature that purchasers would generally expect them to emanate from the same source. *Id.* at 962 (citing *Sheller-Globe Co. v. Scott Paper Co.*, 204 USPQ 329 (TTAB 1979)). The doctrine applies “whether or not the first user of the mark has actually expanded its use of its mark, after the commencement of the subsequent user’s use, to goods or services which are the same as or closely related to those of the subsequent user.” *Id.*; see also *May Dep’t Stores Co. v. Prince*, 200 USPQ 803, 808-09 (TTAB 1978) (finding a natural expansion from plaintiff’s health and beauty aids to shampoo).

“Among the factors to be considered in determining whether an expansion is natural are”:

- (1) whether the second area of business (that is, the subsequent user's area of business, into which the first user has or potentially may

expand) is a distinct departure from the first area of business (of the prior user), thereby requiring a new technology or know-how, or whether it is merely an extension of the technology involved in the first area of business;

- (2) the nature and purpose of the goods or services in each area;
- (3) whether the channels of trade and classes of customers for the two areas of business are the same, so that the goodwill established by the prior user in its first area of business would carry over into the second area; and
- (4) whether other companies have expanded from one area to the other.

*Mason Eng'g*, 225 USPQ at 962.

Petitioner's evidence on the issue of natural expansion, which is limited to Dr. Kim's testimony, only touches on the fourth factor and simply ignores any of the others. For example, although Dr. Kim provided several examples of "other umbrella baby brand companies" that purportedly provide certain products in both the "baby skincare product category" and the "baby ingestible product category" (factor 4),<sup>63</sup> he provides no documentary support (e.g., Internet website evidence) demonstrating the expansion of those companies from one category to another, or even the basis for his purported knowledge regarding those companies, thus rendering his opinions unsupported by underlying evidence. Apart from Dr. Kim's unsupported contention that expansion across these categories is "quite common in the marketplace,"<sup>64</sup> the record is devoid of evidence that Petitioner has even considered such expansion. Nor is there any testimony by Dr. Kim regarding medicated teas, the actual goods at issue

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<sup>63</sup> *Id.* at 7 (¶¶ 13-18).

<sup>64</sup> *Id.* (¶ 18).

in Respondent's Registration.

Dr. Kim also does not testify, or provide evidence showing, that providing medicated teas would merely be an extension of, and not a distinct departure from, providing cosmetics such as baby powder, body oils, skins lotions, soaps, baby wipes, rash creams, cologne, and sunscreens (the goods identified in Petitioner's Registrations), thereby avoiding the need for new technology or know-how to produce medicated teas (factor 1). According to Dr. Kim, "[t]he prevalence of umbrella brands in this market (e.g., baby care and child care products) then implies that the baby skincare product category and the baby ingestible product category are a good 'fit.'"<sup>65</sup> He concludes that "consumers are likely to perceive the know-how and experience in manufacturing and marketing products in a baby product category are easily transferrable to another baby product category."<sup>66</sup> Alas, Dr. Kim's contention that baby bath care and lotion products and medicated teas are a "good fit" for umbrella branding is irrelevant, and tells us nothing about whether Petitioner, specifically, has the current technology or know-how to produce medical teas. Furthermore, in the absence of evidence showing that other companies in Petitioner's industry also sell medicated teas, Dr. Kim's contention that, based on the several companies he mentioned, "[l]ogically, BABY MAGIC would expand into products that cover Respondent's goods"<sup>67</sup> is entitled to little weight.<sup>68</sup>

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<sup>65</sup> *Id.* at 8-9 (¶ 21).

<sup>66</sup> *Id.* at 9.

<sup>67</sup> *Id.* (¶22).

<sup>68</sup> Dr. Kim's opinions are based on facts that he purports to establish, including that the BABY MAGIC mark was introduced in 1951, that "BABY MAGIC has invested in various

With respect to the nature and purpose of the parties' respective goods (factor 2), the ultimate purpose is similar because both types of goods are for use by babies, but their nature (topical versus ingestible) is clearly different.

There is no dispute that the classes of customers for both parties' areas of business are the same or overlapping (i.e., parents and caregivers). Further, because the identifications of goods in both parties' registrations are unrestricted as to trade channels, such as brick-and-mortar stores, we must presume that they are or could be marketed in all normal trade channels, including in brick-and-mortar stores and online. *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1357 (Fed. Cir. 2000) ("When the registration does not contain limitations describing a particular channel of trade or class of customer, the goods or services are assumed to travel in all normal channels of trade."). Indeed, the evidence shows that both sets of goods are offered online by Walmart and Amazon.<sup>69</sup>

However, evidence that goods are available through the Internet is alone insufficient to prove that the goods may be encountered in overlapping channels of trade. The Board has long recognized that the "Internet is such a pervasive medium that virtually everything is advertised and sold through the Internet," *Bond v. Taylor*, 119 USPQ2d 1049, 1055 (TTAB 2016) (quoting *Parfums de Coeur, Ltd. v. Lazarus*, 83

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marketing campaigns over decades, including its first BABY MAGIC television commercial in 1960," and that the mark has been used for 70 years. 10 TTABVUE 8 (Kim Decl., ¶ 19). He does not establish that he has personal knowledge sufficient to establish these factual premises for his opinions, and he does not provide any supporting basis for these facts.

<sup>69</sup> 9 TTABVUE 7-9 (Song Decl., ¶¶ 15-16); 8 TTABVUE 8 (Respondent's Response to Interrogatory No. 5).

USPQ2d 1012, 1021 (TTAB 2007)), and “the mere fact that goods ... may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade.” *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1743 (TTAB 2014) (quoting *Parfums de Coeur*, 83 USPQ2d at 1021). *See also St. Helena Hosp.*, 113 USPQ2d at 1087-88 (“Advertising on the Internet is ubiquitous and ‘proves little, if anything, about the likelihood that consumers will confuse similar marks used on such goods or services.’”). Nor is the fact that Petitioner’s and Respondent’s goods are found in large general merchandise stores such as Amazon or Walmart controlling on this question. *See Squirtco v. Tomy Corp.*, 212 USPQ 304, 307 (TTAB 1981) (“The fact that opposer’s and applicant’s goods may be found in some of the same stores is not controlling on this question. It is well recognized that there are a number of commercial establishments where one can find a myriad of different items.”). Without more persuasive evidence, we cannot conclude that the trade channels are the same in this case, such that any goodwill established by Petitioner for its baby skin care products would necessary carry over to the business of providing medical teas (factor 4).

It is well settled that “when [a petitioner] as party plaintiff rests its case essentially on [ ] previously issued registration[s] [as Petitioner does in this case], it must bear a risk of not meeting its burden of proof where the goods in issue are different and the relationship between them is not readily apparent.” *Pharmacia Inc. v. Asahi Med. Co., Ltd.*, 222 USPQ 84, 86 (TTAB 1984). We find that Petitioner has failed to demonstrate that the parties’ respective goods are related in any manner, or

that they travel within the same trade channels to the same class of purchasers.

The second and third *DuPont* factors weigh against a finding of likelihood of confusion.

#### **D. Consumer Sophistication and Care**

The fourth *DuPont* factor considers “the conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567. Purchaser sophistication or degree of care may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay*, 73 USPQ2d at 1695.

Petitioner points to evidence in Mr. Song’s declaration showing products of both parties offered on Amazon for less than thirty dollars,<sup>70</sup> and argues that “[t]he relatively low price of each party’s products indicates a higher possibility of impulse buying and therefore increases the likelihood of confusion.”<sup>71</sup> “When goods are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such goods are held to a lesser standard of purchasing care.” *Recot*, 54 USPQ2d at 1899.

We agree that both parties’ identified goods appear to be relatively inexpensive. More importantly, because there are no restrictions as to purchasers or price point for the goods identified in Petitioner’s and Respondent’s registrations, we find that the purchasers of both parties’ baby products, whether parents or caregivers, are

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<sup>70</sup> 9 TTABVUE 7-9 (Song Decl., ¶¶ 15-16).

<sup>71</sup> 15 TTABVUE 29 (Petitioner’s Brief).

members of the general public, who necessarily encompass both sophisticated and unsophisticated consumers. Our decision must be based on the “least sophisticated purchasers.” *Stone Lion*, 110 USPQ2d at 1163.

At the same time, “in light of the inherent nature of the goods ... involved,” which are for use in connection with babies and, in the case of Respondent’s medicated tea for babies, are ingested by them, we find, based on the nature of the goods themselves, that “some degree of purchasing care may be exercised by [Petitioner’s and Respondent’s] potential or actual consumers.” *In re Info. Builders Inc.*, 2020 USPQ2d 10444, at \*4 (TTAB 2020). *Compare Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016) (finding that “even in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily.”).

The fourth *DuPont* factor is therefore neutral.

#### **E. Extent of Potential Confusion**

Petitioner argues under the twelfth *DuPont* factor, which considers the “extent of potential confusion, i.e., whether de minimis or substantial.” *DuPont*, 177 USPQ at 567, that “the potential for confusion is substantial” in this case because its marks “are famous and well-known throughout the United States” and “the [parties] marks are nearly identical.”<sup>72</sup> However, as discussed above, the evidence of record does not establish that Petitioner’s BABY MAGIC mark is famous or is renowned. Nor is there

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<sup>72</sup> *Id.* at 31.



any evidence, beyond the mere appearance of the parties' respective products on webpages displayed in Mr. Song's Testimony Declaration,<sup>73</sup> regarding the parties' actual use of their respective marks, leaving us unable to evaluate the extent of any potential confusion. This factor is neutral in our analysis.

#### **F. Other Factors Mentioned by Petitioner**

Petitioner asserts that "any lack of actual confusion," a consideration under the eighth *DuPont* factor, *DuPont*, 177 USPQ at 567, "is irrelevant because of the highly similar appearance and goods of the parties' marks. Petitioner's contention that greater similarity between the marks renders the absence of actual confusion irrelevant is erroneous. Nonetheless, we agree that because the parties' respective goods are not shown to be related and there is no evidence in the record regarding the extent of the parties' use, this factor is neutral.

Petitioner also asserts that "there is no market interface between [Respondent] and [Petitioner]" a consideration under the tenth *DuPont* factor. *DuPont*, 177 USPQ at 567. We agree that there is no evidence of market interface between the parties that would weigh against likelihood of confusion, nor did Respondent argue that there was. This factor is also neutral.

#### **G. Balancing the *DuPont* Factors**

Having considered each *DuPont* factor for which there is evidence and argument, *Guild Mortg.*, 129 USPQ2d at 1162-63, we conclude that Petitioner has failed to prove

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<sup>73</sup> 9 TTABVUE 7-9 (Song Decl., ¶¶ 15-16).

that the BABIES' MAGIC TEA mark in Respondent's Registration identifying medicated tea for babies that treats colic and gas and helps babies sleep better (Class 5) is likely to cause confusion with the BABY MAGIC mark in Petitioner's Registrations covering body powder, body oil and skin cleanser, hair shampoo, skin lotion, baby hair conditioner, baby lotion, baby oil, baby powder, baby shampoo, baby wipes, bath soaps in liquid, solid or gel form, bubble bath, cologne, non-medicated bath preparations, non-medicated diaper rash cream, non-medicated diaper rash ointments and lotions, skin cleansers, skin conditioners, and sun screen (Class 3).

Generally, the more similar the marks at issue, the less similar the goods need to be to support a finding of likelihood of confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). However, the record in this case is devoid of probative evidence showing the relatedness of the parties' respective goods, and when this factor is coupled with the somewhat weak inherent nature of Petitioner's BABY MAGIC mark, the lack of demonstrated commercial strength (let alone fame) and similar trade channels, it carries particular weight in this case. *See Kellogg Co. v. Pack'em Enters.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive. ... 'each [of the thirteen factors] may from case to case play a dominant role.'"). Petitioner established priority, but failed to prove a likelihood of confusion.

**Decision:** The petition for cancellation is denied.