

This Opinion is not a
Precedent of the TTAB

Mailed: February 21, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Water Babies Limited

Serial No. 79147272

Cathleen E. Stadecker and Peter B. Kunin of Downs Rachlin Martin PLLC,
for Water Babies Limited

John M.C. Kelly, Trademark Examining Attorney, Law Office 119,
J. Brett Golden, Managing Attorney.

Before Zervas, Heasley, and Lynch,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Water Babies Limited (“Applicant”) has applied for extension of protection to the
United States of its International Registration of the stylized mark:

The logo consists of the words "water" and "babies" stacked vertically in a blue, rounded, sans-serif font. The letters are slightly irregular and have a soft, water-like texture. The word "water" is on top and "babies" is below it, both in a similar blue color.

Its Application identifies goods and services in International Classes 5, 9, 10, 16,
18, 21, 24, 25, 28, and 35, as well as the following services in Class 41:

Educational services, namely, classes and seminars in the field of swimming; providing of training in the field of swimming; entertainment in the nature of live swimming exhibitions; entertainment training and tuition services, namely, providing swimming classes and workshops for infants and babies; education and training services relating to photography, namely, providing classes and workshops about photographing swimming infants and babies; photography; photography services; portrait photography; underwater photography; provision of swimming bath and swimming pool facilities; swimming instruction; teaching of swimming; training of swimming teachers; training of photographers; physical fitness training services; educational services, namely, providing classes in the field of swimming; teaching, instruction and training services in the field of swimming; education, teaching and instructional services, namely, providing swimming classes and instruction in the field of swimming; providing of training services, namely, providing swimming classes and instruction in the field of swimming; provision of swimming classes and instruction; physical education services; organising and conducting events relating to swimming; educational services, namely, providing swimming classes; educational services, providing classes featuring lessons in the field of swimming; providing swimming schools; entertainment in the nature of swimming shows; entertainment in the nature of live swimming performances; instruction in swimming; presentation of live swimming performances; personal coaching services in the field of swimming; entertainment services, namely, providing a website featuring non-downloadable playback of MP3 recordings of digital music and non-downloadable videos in the field of swimming; entertainment in the nature of live swimming performances; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this class.¹

A Section 66(a) application is subject to the same examination standards as any other application for registration on the Principal Register. 15 U.S.C. § 1141h(a)(1);

¹ Application Serial No. 79147272 was filed on April 18, 2013 under Trademark Act Section 66(a), 15 U.S.C. § 1141f, based on International Registration No. 1203817, with a priority filing date of Oct. 23, 2012. No claim is made to the exclusive right to use BABIES apart from the mark as shown. The color(s) blue (pantone 299) and white are claimed as a feature of the mark. The lettering “water babies” appears in blue (Pantone 299). The mark consists of the blue (Pantone 299) lettering “water babies” with a white shaded circle appearing in the dot of the lowercase letter “t”.

TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1904.02(a) (Oct. 2018). If the proposed mark is not registrable on the Principal Register, the extension of protection must be refused. 15 U.S.C. § 1141h(a)(4).

The Trademark Examining Attorney refused registration as to certain goods and services in Classes 5, 9, 10, 16, 18, 25, 28, 35, and 41 under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the registered mark WATERBABIES in standard characters for “swimming instruction” in Class 41.² When the Examining Attorney made the partial refusal final, Applicant appealed and requested reconsideration.³ On remand, the Examining Attorney withdrew the refusal as to the goods and services in Classes 9, 10, 16, 18, 25, 28, and 35, and maintained the final refusal as to the following Class 41 services:⁴

Educational services, namely, classes and seminars in the field of swimming; providing of training in the field of swimming; entertainment training and tuition services, namely, providing swimming classes and workshops for infants and babies; provision of swimming bath and swimming pool facilities; swimming instruction; teaching of swimming; training of swimming teachers; physical fitness training services; educational services, namely, providing classes in the field of swimming; teaching, instruction and training services in the field of swimming; education, teaching and instructional services, namely, providing swimming classes and instruction in the field of swimming; providing of training services, namely, providing swimming classes and instruction in

² Registration No. 4595259, issued on the Principal Register on Sept. 2, 2014. *See* Sept. 7, 2017 Office Action. Page references to the application record are to the .pdf version of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions and orders on appeal are to the Board’s TTABVUE docket system.

³ Applicant’s request for reconsideration, 4 TTABVUE.

⁴ Examining Attorney’s response to request for reconsideration, 5 TTABVUE. Although the Examining Attorney’s response to Applicant’s request for reconsideration does not expressly withdraw the refusal as to Applicant’s Class 5 goods, we infer such a withdrawal, as the final refusal is maintained solely as to certain services in Class 41, and the Examining Attorney does not address the Class 5 goods in his brief.

the field of swimming; provision of swimming classes and instruction; physical education services; organising and conducting events relating to swimming; educational services, namely, providing swimming classes; educational services, providing classes featuring lessons in the field of swimming; providing swimming schools; instruction in swimming; personal coaching services in the field of swimming; consultancy, advisory and information services for or in relation to any or all of the aforementioned services in this class.

The Class 41 services that were not refused registration are:

Entertainment in the nature of live swimming exhibitions; education and training services relating to photography, namely, providing classes and workshops about photographing swimming infants and babies; photography; photography services; portrait photography; underwater photography; training of photographers; entertainment in the nature of swimming shows; entertainment in the nature of live swimming performances; presentation of live swimming performances; entertainment services, namely, providing a website featuring non-downloadable playback of MP3 recordings of digital music and non-downloadable videos in the field of swimming; entertainment in the nature of live swimming performances.

After the Examining Attorney maintained his final refusal on remand and denied the request for reconsideration, the appeal resumed and has been fully briefed. We affirm the partial refusal as to Class 41 for the reasons set forth below.

I. Priority

Applicant claims that its Application has priority over the cited Registration. Its Application has a priority filing date of October 23, 2012, it observes, whereas the application underlying the cited Registration was filed nearly three months later, on January 17, 2013. “The USPTO could have, and should have, refused registration based on the Application, which has an earlier priority filing date,” Applicant insists.⁵

⁵ Applicant’s brief p. 1, 7 TTABVUE 3.

The USPTO did just that with another application from the same owner as the cited registration, Serial No. 86186832 for WATER BABIES AQUATIC PROGRAM, which was filed even later, in February 2014, and was withdrawn from publication based on Applicant's subject prior Application.⁶ "The USPTO could have, and should have, withdrawn [the application underlying the cited Registration] from publication" Applicant argues. "Instead, the USPTO took no action."⁷

Furthermore, Applicant argues, the effect of the USPTO's failure to withdraw the cited Registration was compounded by the Examining Attorney's failure to cite it in his first Office Action. "It was not until March 9, 2015, long after the Cited Registration issued, that the USPTO issued a second Office Action refusing registration based on the Cited Registration. Thus, the USPTO missed more than one opportunity to take appropriate action that would have prevented the Cited Registration from issuing," Applicant contends.⁸ "The Cited Registration should never have issued, and should not be cited against the Application," it maintains.⁹

The Examining Attorney agrees that the October 23, 2012 priority filing date of the Application preceded the January 17, 2013 filing date of the application underlying the cited Registration.¹⁰ However, Applicant was aware of the publication of the underlying application, as it filed a request for extension of time (which was

⁶ *Id.* at 2-3, 7 TTABVUE 4-5.

⁷ *Id.* at 2, 7 TTABVUE 4.

⁸ *Id.* at 3, 7 TTABVUE 5.

⁹ *Id.* at 1, 7 TTABVUE 3.

¹⁰ Examining Attorney's brief, 9 TTABVUE 3.

granted) to oppose its registration, yet filed no opposition or letter of protest against it.¹¹ See TMEP § 1715.01(a)(6) (letter of protest based on application filed under Section 66(a) with an earlier filing date or priority claim). The underlying application subsequently matured into the Registration that has been cited against Applicant's Application.

Once it matured into a registration, the Examining Attorney points out, the cited Registration was entitled to a presumption of validity under 15 U.S.C. § 1057(b), and could be cited against the Application under 15 U.S.C. § 1052(d) ("a mark registered in the Patent and Trademark Office," can be cited as a ground for refusal).¹² "Now that the cited registration has issued, applicant cannot effectively challenge its validity in an *ex parte* appeal proceeding," the Examining Attorney notes.¹³ In sum, the Examining Attorney concludes, Applicant's priority argument constitutes an impermissible collateral attack on the cited Registration.¹⁴ We agree.

An argument similar to Applicant's was rejected in *In re House Beer, LLC*, 114 USPQ2d 1073 (TTAB 2015). In that case, the application's priority date preceded that of the cited registration. *Id.* at 1075. Nonetheless, the Board found, Section 2(d) of the Trademark Act:

makes no reference to the filing date of the application underlying the registration cited as the basis for the refusal. If the mark is registered, it may be cited as grounds for refusing registration. ... Applicant asks us to

¹¹ *Id.*, 9 TTABVUE 13-14 (citing (Electronic Record of Application Serial Number 85825878, April 17, 2014 First 90 Day Request for Extension of Time to Oppose for Good Cause and Extension of Time Granted).

¹² *Id.*, 9 TTABVUE 12, 14.

¹³ *Id.*, 9 TTABVUE 14.

¹⁴ Examining Attorney's brief, 9 TTABVUE 11.

find that a refusal that is clearly authorized by Section 2(d) is invalid because certain examination procedures were not followed during the independent examinations of Applicant's application and the Underlying Application. We cannot give the internal examining procedures of the USPTO such primacy over statutory law. ... [T]he owner of the cited registration is not a party to the appeal now before us, and we can neither cancel nor ignore the registration.

Id. at 1076-77.

The principles set forth in *House Beer* were applied to another one of Applicant's applications in *In re Water Babies Limited*, No. 79163879, 2016 WL 7646383 (TTAB 2016) (nonprecedential). In that case, the same registration, Registration No. 4595259 for WATER BABIES, was cited as a basis for refusing registration of



. There, as here, Applicant argued that approval of the cited Registration should have been blocked by Applicant's present Application No. 79147272, which had priority. *Id.* at *3. Nonetheless, the Board found:

Section 2(d) provides for refusal on the basis of a mark's resemblance to "a mark *registered* in the Patent and Trademark Office...." 15 U.S.C. § 1052(d) (emphasis added). This provision of the statute makes no reference to the filing date of the application underlying the registration cited as the basis for the refusal. If a confusingly similar mark already is registered, it must be cited as grounds for refusing registration. The Examining Attorney's refusal under Section 2(d) is procedurally valid even though certain examination procedures were not followed during the independent examinations of Applicant's '272 Application and the Underlying Application. *In re House Beer*, 114 USPQ2d at 1076. Now that the cited registration has issued, Applicant cannot effectively challenge its validity in this *ex parte* appeal proceeding. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) ("It is true that a prima facie presumption of validity may be rebutted. [Citations omitted.] However, the present *ex parte* proceeding is not the proper forum for such a challenge.")

Id. at *4.

Even though Applicant lost the procedural argument in that appeal, it now argues that "the priority issue should be reviewed again because the USPTO errors took

place during examination of the application at issue in this appeal....”¹⁵ Nonetheless, the applicable principles remain the same. Regardless of any procedural irregularities in the cited Registration’s path to registration, once registered, it was and is entitled to a presumption of validity under 15 U.S.C. § 1057(b). *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1410 (TTAB 2018). It cannot be collaterally attacked in this ex parte proceeding. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1053 (Fed. Cir. 2018).

For these reasons, we find that the Examining Attorney’s partial refusal under Section 2(d) is procedurally valid. We turn, therefore, to the merits of the refusal.

II. Likelihood of Confusion

We base our determination of likelihood of confusion under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. ___, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Section 2(d), which are to prevent confusion as to source, and to protect registrants from damage caused by registration of confusingly similar marks. *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ

¹⁵ Applicant’s brief p. 1, n. 1, 7 TTABVUE 3.

at 566. We have considered each *DuPont* factor that is relevant, and have treated any other factors as neutral. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).


Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations are the similarities between the marks and the similarities between the services. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002) (“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 [or services].”)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

A. Similarity of the Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s and Registrant’s marks in their entireties, taking into account their 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 Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014).



Again, Applicant’s stylized mark is  and Registrant’s mark is the standard character WATERBABIES. Applicant argues that there is no likelihood of confusion between the marks, if they are considered in their entirety:

Here, although the marks share the literal wording WATER and BABIES, the overall commercial impression of the respective marks is not sufficiently similar to cause confusion. Appellant’s mark is presented with a space between the words and in a specific stylization. The distinctive design elements include: a specific color blue, the depiction of “water” on the first line and “babies” slightly shifted right on the second line, the use of a curvy lowercase font, shading in the dot over the letter “T” to suggest a bubble, and an overall curved shape, also suggesting a water bubble. Even though the Cited Mark is registered in standard character format, it is registered as all one word. The lack of a space between “water” and “babies” in the Cited Mark means it cannot be displayed with Applicant’s distinctive bubble shape. Applicant’s design elements, and the fact that the Cited Mark is all one word are therefore sufficient to avoid confusion.¹⁶

We agree with the Examining Attorney, however, that the marks are highly similar. Both consist of the same literal wording, WATER BABIES. In Applicant’s mark, the word WATER appears above and to the left of BABIES, so consumers would naturally tend to read and pronounce the words in that order, just as they would with Registrant’s mark, WATERBABIES. The absence of a space in Registrant’s mark, WATERBABIES, is not pronounced, and does not meaningfully distinguish the

¹⁶ Applicant’s brief, p. 4, 7 TTABVUE 6.

marks. *See In re Omaha Nat. Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) (affirming the Board’s finding that FirsTier is the phonetic equivalent of “first tier”); *Stock Pot, Inc., v. Stockpot Rest., Inc.*, 220 USPQ 52, 52 (TTAB 1983), *aff’d* 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (“There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical.”); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016) (MINI MELTS essentially identical to MINIMELTS). The marks are thus phonetic equivalents, identical in sound, and that similarity alone may establish confusing similarity. *Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“the dominant factor for consideration is the likelihood of confusion arising from the similarity in sound of the two words when spoken.”).

The stylization of Applicant’s mark does not suffice to differentiate it from Registrant’s. The wording of a mark is normally accorded greater weight than its stylization or design because it is likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the services. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). If anything, Applicant’s blue stylized lettering—the color of water—merely reinforces the literal term WATER BABIES, such that the words convey the same connotation and commercial impression. *See In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1185 (TTAB 2018). Moreover, because the cited mark is registered in standard characters, it is not limited to any particular form of display; its lettering could be

displayed in blue, curvy, stylized lettering similar to Applicant's mark. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). Even if, as Applicant suggests, the marks are not depicted identically in appearance, "Considering the substantial similarities between the marks in this case, it seems to us that a purchaser who sees one mark and later encounters the other is likely to think, if the two marks are applied to the same or related goods and/or services, that the second mark is the same mark he had seen earlier, or, if he realizes that there are some differences in the marks, that the second is simply a slightly varied version of the first, with both serving to indicate origin in the same source." *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1468 (TTAB 1988).

Taken in their entirety, then, the two marks are highly similar. Accordingly, the first *DuPont* factor weighs in favor of finding a likelihood of confusion.

B. Similarity of the Services, Channels of Trade, and Classes of Customers

The second *DuPont* factor concerns the "similarity or dissimilarity and nature of the goods or services as described in an application or registration..." while the third *DuPont* factor concerns the "similarity or dissimilarity of established, likely-to-continue trade channels." *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners v. Lion Capital*, 110 USPQ2d at 1159, 1161.

As the Examining Attorney observes, Applicant's brief presents no arguments pertaining to the services of the parties.¹⁷ Registrant's services are "swimming instruction," and Applicant's services in Class 41 include "instruction in swimming."

¹⁷ Examining Attorney's brief, 9 TTABVUE 11.

Thus, the services are identical in part. For purposes of finding likelihood of confusion, it is sufficient if confusion is likely with respect to use of the mark for any service within a given class. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Since Applicant's swimming instruction services are legally identical to Registrant's, we must presume that they move in the same channels of trade and are offered to the same classes of consumers—in this case, parents seeking swimming instruction for their young children. *See In re Viterra Inc.*, 101 USPQ2d at 1908 (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). Accordingly, the second and third *DuPont* factors, relating to the similarity or dissimilarity of services, the trade channels, and the classes of customers, favor a finding of likelihood of confusion.

C. Conclusion

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *DuPont* factors. With respect to Applicant's identified services in International Class 41 that were subject to final refusal, we find that Applicant's mark so resembles the cited registered mark as to be likely to cause confusion, mistake or deception as to the source of Applicant's services. 15 U.S.C. § 1052(d).

Decision: The partial refusal to register Applicant's mark in International Class 41 is affirmed. In due course, the application containing the remaining goods and services that were not subject to final refusal will be published for opposition.