

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Water Babies Limited

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Serial No. 79163879

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

Tina H. Mai, Trademark Examining Attorney, Law Office 117 (Hellen Bryan Johnson, Managing Attorney).

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

Opinion by Masiello, Administrative Trademark Judge:

Water Babies Limited (“Applicant”) filed an application for extension of protection to the United States of its International Registration of the mark shown below:¹



The goods and services identified in the application are as follows:

¹ Application Serial No. 79163879 was filed on August 26, 2014 under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a), based on International Registration No. 1243895 dated August 26, 2014, with a priority filing date of May 19, 2014. No claim is made to the exclusive right to use BABIES apart from the mark as shown. The colors blue and white are claimed as a feature of the mark.

Printed instructional and teaching material in the field of swimming instruction; stationery; printed matter, namely, brochures, booklets and teaching material in the field of swimming instruction; printed matter in the nature of books, leaflets, pamphlets, and manuals containing information, instruction and coursework in the field of swimming classes, techniques and/or routines; photographs; photographs of babies; photographs of babies for car windscreens; stickers; stickers for car bodywork; underwater photographs; cards, namely, blank cards, greeting cards, note cards, business cards; car stickers; car stickers affixed by suction, in International Class 16;

Training services relating to swimming for infants and babies, and/or entertainment services in the form of live exhibitions, all relating to swimming for infants and babies; training services relating to aerobics, exercise and/or exercise activities performed in water by women before or after their pregnancy, and/or entertainment services in the form of live exhibitions, all relating to aerobics, exercise and/or exercise activities performed in water by women before or after their pregnancy; 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; aerobics, and exercise instruction and/or instruction relating to exercise activities performed in water by women before or after their pregnancy; teaching of aerobics, exercise and/or exercise activities performed in water by women before or after their pregnancy; training of teachers for aerobics, exercise and/or exercise activities performed in water by women before or after their pregnancy; teaching of swimming; training of swimming teachers; training of photographers; physical fitness training services; educational services in the form of classes and instruction, teaching, instruction and training services in the field of swimming; education, teaching, instruction and/or training services in the fields of aerobics and exercise classes and instruction and/or classes and instruction in the field of exercise activities performed in water by women before or after their pregnancy; providing of

training services, being the provision of aerobics and exercise classes and instruction and/or classes and instruction in the field of exercise activities performed in water by women before or after their pregnancy; organizing and conducting entertainment and/or educational events relating to aerobics, exercise and/or exercise activities performed in water by women before or after their pregnancy; classes, lessons, schools and/or entertainment and/or educational shows in the fields of aerobics, exercise and/or exercise activities performed in water by women before or after their pregnancy; entertainment in the nature of shows in the fields of aerobics, exercise and/or exercise activities performed in water by women before or after their pregnancy; instruction in aerobics, exercise and/or exercise activities performed in water by women before or after their pregnancy; presentation of live performances in the fields of aerobics, exercise and/or exercise activities performed in water by women before or after their pregnancy; personal coaching services in the fields of aerobics, exercise and/or exercise activities performed in water by women before or after their pregnancy; entertainment in the nature of performances in the fields of aerobics, exercise and/or exercise activities performed in water by women before or after their pregnancy; education, teaching and/or instructional services, being the provision of swimming classes and instruction; providing of training services, being the provision of swimming classes and instruction; provision of swimming classes and instruction; physical education services; organizing and conducting educational and/or entertainment events relating to swimming; swimming classes, lessons, schools and/or educational and/or entertainment shows; entertainment in the nature of swimming shows; 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 swimming performances; consultancy, advisory and information services for or in relation to any or all of the aforementioned services for entertainment and/or educational purposes, in International Class 41.

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as used in connection with Applicant's goods and services, so resembles the registered mark WATERBABIES in standard characters as to be likely to cause confusion, or to cause mistake, or to deceive. The cited mark is registered for "Swimming instruction," in International Class 41.² When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration and this appeal proceeded. Applicant and the Examining Attorney have filed briefs. We affirm in part and reverse in part.

1. USPTO error as ground for appeal.

Applicant's brief is limited to arguing that the cited registration was issued in error because Applicant owns an application that should have blocked the cited registration's issuance. Applicant points out that the application underlying the cited registration (the "Underlying Application") was filed on January 17, 2013; and that Applicant owns application Serial No. 79147272 (the "'272 Application"), filed under the Madrid Protocol, for the mark WATER BABIES (in stylized form in the colors blue and white), which was entitled to a priority filing date of October 23, 2012. *See* 15 U.S.C. § 1141g. At the time the International Bureau notified the USPTO of the '272 Application on May 29, 2014, the Underlying Application had already been published for opposition, on March 18, 2014.³ Nonetheless, the

² Reg. No. 4595259, issued September 2, 2014.

³ The relevant USPTO records have been made of record in this appeal. Applicant's response of June 1, 2016.

Underlying Application proceeded and the registration now cited against Applicant issued.

The examination procedures of the Trademark Office contemplate the possibility that the USPTO may receive notice of a Madrid Protocol application entitled to a priority filing date after the USPTO has already approved another application having a later filing date:

In some cases, another U.S. application filed after the §66(a) applicant's priority date may proceed to publication or registration because the request for extension of protection for the §66(a) application was not yet of record in the United States when the examining attorney searched USPTO records for conflicting marks. If the USPTO learns that a §66(a) application is entitled to priority over another pending application before the other mark registers, the USPTO will take appropriate action to give the §66(a) application the priority to which it is entitled. The §66(a) applicant may bring the priority-date issue to the USPTO's attention by submitting a letter of protest in the other pending application. See TMEP §1715 regarding letters of protest.

If an examining attorney discovers a conflicting application entitled to priority under §66(a) after taking action in a case, the examining attorney must issue a supplemental action correcting the situation. If the mark has been published, the examining attorney must request jurisdiction before issuing the action. See TMEP §§1504.01 and 1504.04(a) regarding the examining attorney's jurisdiction.

However, if the conflicting mark has already registered, the USPTO does not act to cancel the registration *sua sponte*. The §66(a) applicant may seek to cancel the registration by filing a petition for cancellation with the Trademark Trial and Appeal Board.

TMEP § 1904.01(e) (2016).

Applicant contends that, if the USPTO had taken note of the existence of the '272 Application, it would have found it to be in conflict with the Underlying Application; and would therefore have suspended the Underlying Application and allowed the '272 Application to be processed first. We need not determine whether the '272 Application should have blocked the approval of the Underlying Application, because, regardless, in the case now before us, the Examining Attorney's refusal of registration under Section 2(d) was procedurally sound and required by the statute. An argument similar to Applicant's was rejected in *In re House Beer, LLC*, 114 USPQ2d 1073, 1076 (TTAB 2015), noting "[w]e cannot give the internal examining procedures of the USPTO such primacy over the statutory law."

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.⁴ 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*

⁴ Section 2(d) *does* give regard to filing dates of underlying applications where a concurrent use registration is at issue; but that provision is not relevant to the case before us.

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.”) A cancellation proceeding, in which the cited Registrant is a party, would be an appropriate forum for a claim based on priority of use. “It bears noting, however, that mere error in the examination of the Underlying Application would not be a valid ground for an *inter partes* challenge to the cited registration.” *In re House Beer, LLC*, 114 USPQ2d at 1077.

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

2. Refusal under Section 2(d).

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion as set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services at issue. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

(a) The marks.

We first consider the similarity or dissimilarity of the marks at issue in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The wording of the two marks is

identical in sound and meaning. In appearance, the marks' wording differs only by virtue of the space between WATER and BABIES in Applicant's mark, and this difference is insignificant to distinguish the marks. Further, marks must be considered in light of the fallibility of memory. *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014), and this minor difference might well be overlooked or not remembered. The marks also differ in appearance by virtue of the design element of Applicant's mark, the stylized lettering of its wording, and its blue and white color scheme. However, "[i]n the case of a composite mark containing both words and a design, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed." *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (internal quotations omitted). Moreover, the cited mark is registered in standard characters, is not limited to any particular form of display, *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983), and could be displayed in styles and colors similar to those of Applicant's mark.

Overall, we find that the two marks create highly similar commercial impressions. Accordingly, the *du Pont* factor of the similarity or dissimilarity of the marks weighs in favor of a finding of likelihood of confusion.

(b) The goods and services.

We next consider the similarity or dissimilarity of the goods and services as identified in the application and the cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-62 (Fed. Cir. 2014);

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Octocom Sys. Inc. v. Houston Computers Servs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Registrant's services are "swimming instruction," and Applicant's services in Class 41 include "instruction in swimming." Thus, with respect to the Class 41 portion of the application, 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).

As Applicant's swimming instruction services are legally identical to those of Registrant, we must presume that they move in the same channels of trade and are offered to the same classes of consumers. *See In re Viterro 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, for purposes of Class 41, the *du Pont* factors relating to the similarity or dissimilarity of services, the trade channels, and the classes of customers favor a finding of likelihood of confusion.

We next compare Applicant's Class 16 goods to Registrant's services. Applicant's goods are various paper goods, including stationery, and various kinds of printed matter, including "Printed instructional and teaching material in the field of swimming instruction." In order to demonstrate that such goods are commercially related to Registrant's services, the Examining Attorney has submitted the following relevant use-based third-party registrations:

<u>Reg. No.</u>	<u>Mark</u>	<u>Relevant goods</u>	<u>Relevant services</u>
3634813	FUELING THE MULTISPORT LIFESTYLE	Printed educational and instructional materials on the subject of athletic competitions involving swimming, biking and running	Health club and wellness center services, namely, providing instruction and equipment in the field of swimming, biking and running, and physical exercise
3722391	[design mark]	Stationery, etc.	Providing instruction and training in juggling, clowning, acrobatics, gymnastics, dance and swimming
4026802	QUEEN ELIZABETH	Books, magazines, newsletters, brochures in the fields of travel, food and beverage, entertainment and leisure and maritime; stationery	Entertainment services, namely, ... swimming competitions; health club services, namely, providing instruction, classes and equipment in the field of physical exercise
4411257	SQUAW VALLEY	Printed brochures, pamphlets and booklets featuring information about ... ski and snowboard instructional materials, resort sports and recreational activities	Providing recreational facilities for and instruction in ... swimming

Third-party registrations which individually cover different goods and services and are based on use in commerce may serve to suggest that the listed goods and services are of types which may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). However, the nature and quantity of

these few registrations do not persuade us that paper goods or printed matter regarding swimming are commercially related to swimming instruction, such that customers would believe that they emanate from the same source. The goods and services in several of these third-party registrations are not a good approximation of the goods and services of Applicant and Registrant. The business of providing swimming instruction is far different in nature from the writing and publishing of printed teaching materials, and there is no reason for us to assume, without evidence, that such goods and services would be provided by a single entity. There is even less inherent similarity between swimming lessons and paper goods like stationery, stickers, and greeting cards. Thus, with respect to Applicant's Class 16 goods, the *du Pont* factor of the similarity or dissimilarity of the goods and services does not support a finding of likelihood of confusion.

We note the Examining Attorney's argument that "[a]bsent restrictions in an application and/or registration, the identified goods and/or services are 'presumed to travel in the same channels of trade to the same class of purchasers.'"⁵ However, the logic of this presumption holds only where the identified goods or services are identical. This presumption cannot be made with respect to Applicant's paper and printed goods and Registrant's swimming instruction services.

(c) Conclusion.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. With respect to

⁵ Examining Attorney's brief, 8 TTABVUE 6.

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Applicant's identified services in International Class 41, 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. With respect to Applicant's goods in International Class 16, the Examining Attorney has not demonstrated a likelihood of confusion.

Decision: With respect to Applicant's services in Class 41, the refusal to register is AFFIRMED. With respect to Applicant's goods in Class 16, the refusal to register is REVERSED.