

**This Opinion is Not a
Precedent of the TTAB**

Mailed: August 1, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re TOELL Co., Ltd.
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Serial No. 86888544
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Rebecca Gan of Wenderoth LLP
for TOELL Co. Ltd.

Marco Wright, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

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Before Cataldo, Bergsman and Lykos,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

TOELL Co. Ltd. (“Applicant”) seeks registration on the Principal Register of the mark displayed below for “drinking water” in International Class 32.¹



¹ Application Serial No. 86888544, filed January 27, 2016 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce.

The colors yellow, green, gray, blue, white, red, and purple are claimed as features of the mark. The description of the mark is as follows:

The mark consists of blue water with a green and gray mountain in the distance; starting from left to right, a design element comprising of: a predominately red flower, a green leaf, a yellow and white flower, a red and white flower, green palm leaves, a red flower, a yellow and purple flower, two red flowers, and more green leaves; in the center in stylized white font are the words: "PURE HAWAIIAN WATER".

The application includes a disclaimer of the wording PURE HAWAIIAN WATER apart from the mark as shown.

Registration was refused under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant's applied-for mark so resembles the following two registered marks, that, when used on or in connection with Applicant's identified goods, it is likely to cause confusion or mistake or to deceive:²

Registration No. 1983462, owned by Menhune Water Company, Inc. for the mark



issued on the Principal Register for "purified drinking water" in International Class 32, with a disclaimer of HAWAII WATER. The stippling shown in the drawing is a feature of the mark and is not intended to indicate color.³

² Following Applicant's response to the Examining Attorney's information request, the Examining Attorney withdrew the refusals that the mark comprises geographically deceptive and primarily geographically deceptively misdescriptive matter in relation to the identified goods. Trademark Act Sections 2(a) and 2(e)(3), 15 U.S.C. §1052(a), (e)(3).

³ Registered July 2, 1996; renewed.

Registration No. 4280890, owned by an individual, Faber D. Dewar, for the standard character mark PURE HAWAIIAN, issued on the Supplemental Register for “bottled drinking water; bottled water” in International Class 32, with a disclaimer of PURE.⁴

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the Request for Reconsideration, the appeal was resumed and is now briefed.

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”). *See also, In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors, and the other relevant *du Pont* factors, are discussed below.

Applicant concedes, and we agree, that the involved goods are legally identical, and that as such, we must presume that these goods travel in the same channels of trade to the same classes of consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). Applicant’s Brief, p. 3 footnotes 1 and 2; 8 TTABVUE 10. This decision therefore turns on the similarities of the marks and the strength of the marks in the cited registrations.

⁴ Registered January 22, 2013.

I. Similarity of the Marks

We compare the similarity or dissimilarity of the marks 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 proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012).

Applicant argues that the Examining Attorney improperly focuses on the wording in Applicant’s mark without giving due consideration to the design and appearance. In Applicant’s view, the applied-for mark’s “unique colorized floral design “catches the eye.” *See Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012, 1016 (TTAB 2007) (“...the design is very noticeable and has the effect of catching the eye and engaging the viewer before the viewer looks at the word BODYMAN.”). Applicant’s Brief, p. 14; 8 TTABVUE 20. Continuing, Applicant maintains that “the elaborate colorized tropical floral design conjures images of Hawaii’s isolated land masses, tropical and rainy climate, and volcanic rock formations which combine to create a uniquely filtered and mineral rich water.” *Id.* at 16; 8 TTABVUE 22. Applicant also argues that in the Internet age, the appearance of the mark may be more important than how it is pronounced, given consumer propensity to seek product information online.

We disagree that the Examining Attorney has improperly dissected the involved marks. The design element in Applicant's mark depicting a tropical mountain landscape surrounded by water serves to emphasize the literal meaning of the wording "Pure Hawaiian Water." With regard to Registration No. 1983462, while the design element is not identical to the design in Applicant's mark, it does project a highly similar commercial impression in its depiction of a tropical mountainous landscape. We hasten to add that because the registered mark has no color claim, in theory it could be used with the same or similar color scheme as depicted in Applicant's mark. This, coupled with the display of the wording HAWAII WATER at the forefront renders the marks similar in sound, appearance, meaning and commercial impression. That is to say, both convey the impression that their respective drinking water products are derived from the tropical island water surrounding the state of Hawaii.

As to Registration No. 4280890, the wording PURE HAWAIIAN WATER in Applicant's mark subsumes the entirety of the cited mark. In calling for the goods, consumers are more likely to focus on this verbal portion of Applicant's mark. Indeed the first word "pure" is likely to be critical in the minds of consumers, given the nature of the products. And while Applicant's mark includes a rather prominent design, we do not find it sufficient to outweigh the similarities in the mark, given that the tropical island design enhances the connotation of pure drinking water.

Keeping in mind that where the goods are identical, the degree of similarity between the marks necessary to support a determination that confusion is likely

declines (*see Bridgestone Americas Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012), we find Applicant’s mark similar in sound, connotation and commercial impression to each cited mark. This factor, along with the legal identity of the goods and established, likely-to-continue channels of trade noted above, weighs in favor of finding a likelihood of confusion.

II. Strength of the Cited Marks

We now address Applicant’s arguments that both cited registrations are inherently weak, in light of the disclaimer of the wording HAWAII WATER in the composite mark, and registration of the mark PURE HAWAIIAN on the Supplemental Register with a disclaimer of PURE. As Applicant contends, “Hawaii” and “Hawaiian” as they appear in each mark are geographic indicators of origin. In further support of the assertion that the marks are weak, Applicant made of record two use based third-party registrations for various drinking water products: Registration No. 4361043 HAWAII VOLCANIC & Design and Registration No. 3223499 MAHALO HAWAII DEEP SEA).⁵ Thus, it is Applicant’s contention that if these HAWAIIAN-formative marks can co-exist, then Applicant’s mark should be allowed for registration as well.

⁵ Applicant also made of record three applications to show that the cited registrations are weak. Applications are “not evidence of anything except that they were filed.” *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1956 n.9 (TTAB 2014), *vacated and remanded on other grounds, Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015); *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1360 (TTAB 2014) (evidence only that applications were filed, thus incompetent to show common third-party use), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014).

In an *ex parte* appeal, “[t]he purpose of [an applicant] introducing third-party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different such marks on the bases of minute distinctions.” *Palm Bay*, 73 USPQ2d at 1694. *See also 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); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015) (internal citations omitted). Evidence of extensive registration and use by others of a term on the same or very similar goods can be “powerful” evidence of weakness. *See Jack Wolfskin*, 116 USPQ2d at 1136; *Juice Generation*, 115 USPQ2d at 1674. Active third-party registrations may also be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used in a particular industry that the public will look to other elements to distinguish the source of the services. *See Juice Generation*, 115 USPQ2d at 1674-75. *See also Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987).

Here the third-party registrations submitted by Applicant are of limited probative value in establishing weakness because of the obvious differences in the marks as well as the paucity in number. In addition, Applicant has not submitted any evidence of actual third-party marketplace use by others of the cited marks or similar marks in connection with the same or related goods.

That being said, when we examine the cited marks themselves, we agree that the literal portions are inherently or conceptually weak. As noted above, Applicant disclaimed the exclusive right to use the words “Pure Hawaiian Water,” and the Registrant for the cited HAWAII WATER and design mark disclaimed the exclusive right to use the words “Hawaii Water,” and the registered mark PURE HAWAIIAN was registered on the Supplemental Register which is a concession that PURE HAWAIIAN is merely descriptive. *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) (“when appellant sought registration of SUPER BLEND on the Supplemental Register, it admitted that the term was merely descriptive of its goods ... and acknowledged that it did not have an exclusive right therein at the that time.”); *In re Municipal Market Data, Inc.*, 229 USPQ 472, 473 (TTAB 1986); *In re Consolidated Foods Corp.*, 200 USPQ 477, 478 n.2 (TTAB 1978). Unlike fanciful or arbitrary marks, where a party chooses a mark that is inherently weak, it will not enjoy the wide latitude of protection afforded to owners of strong trademarks. As such, this *du Pont* factor weighs against finding a likelihood of confusion.

III. Conclusion

In summary, we have carefully considered all of the evidence of record pertaining to the relevant *du Pont* likelihood of confusion factors, as well as Applicant’s arguments with respect thereto. As explained above, the similarity of the marks and legal identity of the goods and trade channels weigh in favor of finding a likelihood of confusion. There are instances, however, where a single *du Pont* factor is dispositive

(see, e.g., *Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991)) as to outweigh these other *du Pont* factors. Such is the case here where the descriptive terminology in the cited marks renders them conceptually weak such that “the public will look to other elements to distinguish the source of the services.” See *Juice Generation*, 115 USPQ2d at 1674-75. See also *Tektronix, Inc. v. Daktronics, Inc.*, 189 USPQ at 694-95. Balancing these factors, we find no likelihood of confusion. Consumers encountering Applicant’s mark are likely to perceive it as merely another entrant in the consumer market for “Hawaiian” water.

Decision: The Section 2(d) refusal to register Applicant’s mark is reversed.