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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Naterra International, Inc. v. Samah Bensalem

Cancellation No. 92074494

On Remand

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

Samah Bensalem, pro se.[1]

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

Opinion by Lebow, Administrative Trademark Judge:

Respondent, Samah Bensalem, owns a registration on the Principal Register for the standard-character mark BABIES' MAGIC TEA (with "BABIES'" and "TEA" disclaimed) for "medicated tea for babies that treats colic and gas and helps babies sleep better" in International Class 5 ("Respondent's Goods").[2]

[1] Respondent was represented by counsel at trial and during Petitioner's appeal (discussed infra), but discharged her counsel following issuance of the Court's mandate.

[2] Registration No. 4771300 ("Respondent's Registration"), issued July 14, 2015; renewed.

I. Background

On June 16, 2020, Petitioner, Naterra International, Inc., filed a Petition for Cancellation of Respondent's Registration under Sections 2(d) and 43(c) of the Trademark Act, 15 U.S.C. §§ 1052(d) and 1125(c), on the grounds that the mark BABIES' MAGIC TEA for "medicated tea for babies that treats colic and gas and helps babies sleep better" so resembles Petitioner's registered mark BABY MAGIC in typed or standard-character form[3] on the Principal Register for "body powder, body oil and skin cleanser";[4] "hair shampoo";[5] and "skin lotion";[6] and "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"[7] (collectively, "Petitioner's Goods"); all in International Class 3, as to cause (1) a likelihood of confusion, mistake, or deception and (2) a likelihood of dilution (by blurring).

On July 14, 2020, Respondent filed an Answer that denied the salient claims in the Petition for Cancellation.[8]

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[3] A typed mark is the legal equivalent of a standard character mark. *See In re Viterra Inc.*, 671 F.3d 1358, 1363 n.2 (Fed. Cir. 2014).

[4] Registration No. 1228079 (typed form mark), issued February 22, 1983; renewed.

[5] Registration No. 1055375 (typed form mark), issued January 4, 1977; renewed.

[6] Registration No. 0580657 (typed form mark), issued October 6, 1953; renewed.

[7] Registration No. 3890083 (standard-character mark), issued December 14, 2010; renewed.

[8] Respondent asserted laches and estoppel by acquiescence as affirmative defenses in her Answer but did not pursue them in her final brief, so they are waived. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, No. 92050879, 2013 TTAB LEXIS 347, at *6, *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.).

On April 4, 2022, the Board issued a decision denying the Petition for Cancellation following its conclusion that Petitioner had failed to prove likelihood of confusion or dilution by blurring by a preponderance of the evidence ("the Prior Decision").[9] Specifically, the Board found that Petitioner had established priority in its BABY MAGIC mark as to the goods identified in its pleaded registrations; that the parties' respective BABY MAGIC and BABIES' MAGIC TEA marks were more similar than dissimilar; and that the classes of customers for both parties' goods were the same. The Board also found that Petitioner's BABY MAGIC mark was somewhat conceptually weak; that Petitioner had failed to establish that the mark was commercially strong, let alone famous; and that the trade channels for the respective goods were different.[10] Significantly, the Board further found that the record was "devoid of probative evidence showing the relatedness of the parties' respective goods," and that "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."[11] Indeed, the Board found this factor dispositive in concluding that there was no likelihood of confusion.[12]

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[9] 19 TTABVUE.

Citations to the briefs and other materials in the record refer to TTABVUE, the Board's online docketing system. The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

[10] 19 TTABVUE 18, 24, 30, 33, 38-39, 42.

[11] 19 TTABVUE 42.

[12] *Id.* at 42.

Petitioner appealed the Prior Decision to the U.S. Court of Appeals for the Federal Circuit ("the Federal Circuit" or "Court"), "rais[ing] two issues on appeal":

> First, [Petitioner] contend[ed] that substantial evidence does not support the Board's finding that the similarity and nature of the goods (*DuPont*[13] factor two) and trade channels (*DuPont* factor three) disfavor a likelihood of confusion. …
>
> Second, [Petitioner] argue[ed] that the Board erred by failing to give greater weight to the similarity of the marks (*DuPont* factor one) and the fame of the BABY MAGIC mark (*DuPont* factor five) in its overall likelihood of confusion analysis. ….

Naterra Int'l, Inc. v. Bensalem, 92 F.4th 1113, 1117 (Fed. Cir. 2024).

On February 15, 2024, the Court vacated the Prior Decision and remanded the case for further proceedings, concluding that "the Board erred in weighing the first *DuPont* factor and failed to address relevant evidence concerning the *third* DuPont factor"; that it "[could not] discern whether the Board properly addressed relevant evidence concerning the second *DuPont* factor"; and that "the Board did not err in failing to give fame a dominant role in the overall likelihood of confusion analysis." *Naterra,* 92 F.4th at 1120.

We now consider the case on remand. In doing so, we do not revisit our findings as to *DuPont* factors that were not at issue or disturbed on appeal.

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[13] "[T]he TTAB evaluates likelihood of confusion by applying some or all of the 13 factors set out in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973)." *B&B Hardware, Inc. v. Hargis Indus.*, 575 U.S. 138, 144 (2015).

This opinion cites to the Federal Reporter (e.g., F.2d, F.3d, or F.4th) for decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals, and otherwise to LexisNexis Corporation's LEXIS legal database.

II. Evidentiary Issues

Petitioner objected to the entirety of the evidence contained in Respondent's notice of reliance (consisting of third-party registrations and Internet materials)[14] on the grounds that it is irrelevant and cumulative.[15] In the Prior Decision, the Board found that Petitioner's arguments were erroneous and overruled its objections.[16] Our evidentiary ruling was not addressed on appeal, and we incorporate it herein.

Additionally, and subsequent to the remand of this case from the Federal Circuit, Respondent filed an untitled document which, among other things, provides additional argument regarding the facts in this proceeding, as well as a document titled "Exhibit A – Testimonials and Reviews Supporting Babies' Magic Tea" that purports to provide additional evidence of "Direct Video Testimonials," "Amazon Video Review Screenshots," "Amazon Written Review Screenshots," a "Published Testimonial (Father's Article)," a "Company Video from the Founder," and "Amazon Product Listing Evidence" via Internet hyperlinks.

We grant Petitioner's subsequent motion to strike[17] what can be characterized as an improper reply brief filed by Respondent and new evidence that was not made of record during Respondent's trial period in this proceeding. *See Cai v. Diamond Hong*, Inc., 901 F.3d 1367, 1371 (Fed. Cir. 2018) (Board did not abuse its discretion in applying the plain language of the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF

[14] 15 TTABVUE 37-39 (Appendix, Petitioner's Brief).

[15] 13-14 TTABVUE (Respondent's Notice of Reliance).

[16] 19 TTABVUE 5-6.

[17] 32 TTABVUE.

PROCEDURE and excluding defendant's reply brief), *cert. denied*, 587 U.S. 938 (2019); *Sports Auth. Mich. Inc. v. PC Auth. Inc.*, No. 113785, 2002 TTAB LEXIS 65, at *5 n.4 (notices of reliance must be filed before closing date of party's testimony period).

III. 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;[18] the testimony declaration of Jon Song, Petitioner's Executive President, with an exhibit listing Petitioner's BABY MAGIC trademark registrations worldwide;[19] 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.[20]

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

[18] 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.*, No. 91211014, 2016 TTAB LEXIS 98, at *8 n.9; TTAB § 704.10 (June 2025).

[19] 9 TTABVUE 2-10 ("Song Decl."), 11-15 (registration list).

[20] 10 TTABVUE 2-10 ("Kim Decl."), 21-76 (registrations), 77-78 (article list).

course of describing goods.[21]

IV. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be established in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1373 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-28 (2014)). In the Prior Decision, the Board found that "Petitioner's entitlement to petition for cancellation of Respondent's Registration" had been "established."[22] Entitlement was not addressed on appeal, and we incorporate our prior finding herein.[23]

V. Petitioner's Section 2(d) Claim

We turn now to Petitioner's Section 2(d) claim. Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that

> [c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

A. Priority

"In a cancellation proceeding such as this one where both parties own

[21] 13 TTABVUE 1-19, 25-332 and 14 TTABVUE 2-62 (third-party registrations), 63-192 (third-party websites).

[22] 19 TTABVUE 10.

[23] In the Prior Decision, we found that "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" was "insufficient." *Id.* at 10 n.21. Our finding was not addressed on appeal, and we incorporate it herein.

registrations, priority is in issue." *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, No. 92051006, 2014 TTAB LEXIS 95, at *48. In the Prior Decision, the Board found that "the filing date of the underlying applications that matured into Petitioner's Registrations, all of which precede the March 19, 2014 filing date of the application leading to Respondent's Registration," "demonstrated its priority as to the goods in those registrations."[24] Priority was not addressed on appeal, and we incorporate our prior finding herein.

B. 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, 1361 (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, 144 (2015). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (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, 1379 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 1406 (Fed. Cir. 1997) and *DuPont*, 476 F.2d at 1361).

"Not all of the *DuPont* factors are necessarily relevant or of equal weight in a given case, and any one of the factors may control a particular case." *Naterra,* 92 F.4th at 1116 (quoting *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 1362 (Fed. Cir. 2022) (internal quotation marks omitted)). "Two key factors in every

[24] *Id.* at 11-12.

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*, No. 88202890, 2021 TTAB LEXIS 168, at *10 (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976)). "'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.'" *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322 (Fed. Cir. 2017) (quoting *Han Beauty, Inc. v. Alberto-Culver Co*. 236 F.3d 1333, 1336 (Fed. Cir. 2001),

1. The Strength of Petitioner's BABY MAGIC Mark

The strength of Petitioner's mark affects the scope of protection to which it is entitled. *Made in Nature, LLC v. Pharmavite LLC*, No. 91223352, 2022 TTAB LEXIS 228, at *24. "The fifth *DuPont* factor enables [a plaintiff] to prove that its pleaded marks are entitled to an expanded scope of protection by adducing evidence of '[t]he fame of the prior mark (sales, advertising, length of use);' the sixth *DuPont* factor allows [a defendant] to contract that scope of protection by adducing evidence of '[t]he number and nature of similar marks in use on similar goods.'" *Id.* (quoting *DuPont*, [476 F.2d at 1361], *cited in Sock It To Me, Inc. v. Fan*, No. 91230554, 2020 TTAB LEXIS 201, at *26.

The Federal Circuit observed that in the Prior Decision,

> the Board found there to be no evidence regarding "sales or advertising expenditures in connection with [Petitioner's] trademark;" no evidence regarding "critical assessments or notice by independent sources of the

> products identified by the mark;" and no evidence regarding "general reputation of [Petitioner's] BABY MAGIC mark." [Prior] Decision at *10. The Board also rejected [Petitioner's] Executive President's testimony as self-serving and "unsupported by any corroborating evidence." *Id.* at *10–11. Lastly, the Board found [Petitioner's] foreign registrations "d[id] not aid [the] determination" on fame in the United States. *Id.* at *12. Therefore, the Board did not find the BABY MAGIC mark "commercially strong, **let alone famous**," and instead found the mark "somewhat conceptually weak" and that it "falls somewhere in the middle of the fame spectrum." *Id.* at *9, *12 (emphasis added).

Naterra, 92 F.4th at 1119-20.

In its appeal of the Prior Decision, Petitioner argued "that the Board erred as a matter of law in failing to give greater weight to fame in its likelihood of confusion analysis," relying on *Recot, Inc. v. Becton*, 214 F.3d 1322, 1328 (Fed. Cir. 2000) for the proposition that "fame 'plays a dominant role' in the likelihood of confusion analysis." *See Naterra*, 92 F.4th at 1120. But the Federal Circuit contrasted the *Recot* case, where "the mark's fame was 'unquestionably established,'" with the facts here, where "fame was not unquestionably established." *Id.* Consequently, the Court found no error in the Board's analysis or weighing of the fifth *DuPont* factor, and the sixth *DuPont* factor was not at issue in the appeal. We incorporate our original findings herein.[25]

2. The Similarity of Dissimilarity of the Marks

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

[25] In the Prior Decision, we held that our finding that Petitioner failed to show that BABY MAGIC is commercially strong for purposes of Petitioner's Section 2(d) claim precluded Petitioner's dilution claim, in which the threshold element is proof that it owns a "famous" mark, and we denied Petitioner's dilution by blurring claim on that basis. 19 TTABVUE 24025. That finding was not challenged on appeal, and we incorporate it herein by reference.

appearance, sound, connotation and commercial impression. *DuPont*, 476 F.2d at 1361. In the Prior Decision, we found that "the marks BABY MAGIC and BABIES' MAGIC TEA are more similar than dissimilar in appearance, sound, connotation and commercial impression." 19 TTABVUE 27. We stand by that finding and incorporate it by reference herein. While the marks share common elements ("BABY/BABIES" and "MAGIC"), they are not identical or highly similar, as the addition of "TEA" and the possessive form create distinctions in appearance, sound, and overall commercial impression that moderate their similarity.

3. Similarity or Dissimilarity and Nature of the Goods

"The second *DuPont* factor 'considers whether the consuming public may perceive the respective goods and services of the parties as related enough to cause confusion about the source or origin of the goods and services.' *In re St. Helena Hosp.*, 774 F.3d 747, 752 (Fed. Cir. 2014) (cleaned up) (citation omitted).'" *Naterra*, 92 F.4th at 1117. "In making our determination regarding the relatedness of the goods, we must look to the goods as identified in the parties' registrations." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.2d 1356, 1369-70 (Fed. Cir. 2012) (emphasizing that relatedness turns on whether the goods, as described, would lead consumers to believe they emanate from the same source); *Octocom Sys., Inc. v. Houston Comput. Servs., Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990) ("[T]he question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods….").

The goods "need not be identical or even competitive to find a likelihood of confusion." *In re Country Oven, Inc.*, No. 87354443, 2019 TTAB LEXIS 381, at *4 (citing *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086 (Fed. Cir. 2000); *Recot*, 214 F.3d at 1329. "They need only be 'related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the [goods]] emanate from the same source.'" *Coach Servs.*, 668 F.3d at 1369 (quoting *7-Eleven Inc. v. Wechsler*, No. 91117739, 2007 TTAB LEXIS 58, at *28-29).

"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 [Respondent's] goods and the goods listed in the [involved] registration." *Embiid*, 2021 TTAB LEXIS 168, at *30 (quoting *In re Ox Paperboard,* LLC, No. 87847482, 2020 TTAB LEXIS 266, at *15). "[T]estimony that third-party companies sell both types of goods is pertinent to the relatedness of the goods." *Naterra,* 92 F.4th at 1117 (citing *Recot*, 214 F.3d at 1328-29) (finding the Board erred in declining to consider lay evidence that several companies sell both pet and human food products).

Respondent's BABIES' MAGIC TEA registration identifies

> Medicated tea for babies that treats colic and gas and helps babies sleep better,

and Petitioner's BABY MAGIC registrations identify

> 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.

Petitioner relies entirely on the testimony of its expert witness, Dr. Tongil Kim, who testified generally about the marketing concept known as "umbrella branding" and what he characterizes as "BABY MAGIC'S Natural Zone of Expansion."[26] Dr. Kim discusses umbrella branding in a global sense, rather than focusing on the U.S. market explicitly. He explains that "umbrella branding … has long been used in many industries around the world."[27] And as an example, he indicates that "Samsung sells flat-screen televisions, laptop computers, washing machines, life insurance, and even operates a theme park in South Korea."[28] After describing umbrella branding in this way, he testified that there are "many brands in baby product categories" that use umbrella branding, providing these examples:

- Vicks BabyRub Soothing Ointment and Vicks Children's Botanicals Multicare Cough Relief Liquid Combo;
- Wellements Organic All-Purpose Balm and Wellements Organic Probiotic Gripe Water;
- Comforts baby bath and skincare products, and Comforts baby food, snacks, and beverages;
- Hello Bello baby rash cream and shampoo/body wash, and Hello Bello baby formula and kid's vitamins: and

[26] 15 TTABVUE 24, 26-28 (Petitioner's Brief); 10 TTABVUE 5-6 (Kim Decl. ¶¶ 9-12) (all caps in original).

[27] 10 TTABVUE 5 (Kim Decl. ¶ 9).

[28] *Id.*

- Zarbee's Naturals baby skin balm, chest rub, and Zarbee's Natural gripe water, and cough syrup.[29]

According to Dr. Kim, "[t]he critical insight to take away from the umbrella brands mentioned above is that umbrella branding across the baby skincare product category and the baby ingestible category is quite common in the marketplace."[30] However, his testimony does not include any information about whether the mentioned umbrella brands and products are sold in the U.S., or that U.S. consumers have been exposed to them. And while he attaches copies of Petitioner's registrations, he does not attach documentary evidence about any of the third-party umbrella brands.

We are concerned only with the U.S. marketplace. That there may be mega companies in countries such as South Korea that provide goods and services in a variety of industries is not the issue. We are looking for specific evidence of the relatedness of the goods in Petitioner's and Respondent's registrations in the minds of U.S. consumers. But Dr. Kim's testimony does not address this topic or even indicate that he researched it. He provides nine-pages of testimony, but devotes just a single page to what, in essence, are anecdotal accounts of five companies that

[29] *Id.* at 7 (Kim Decl. ¶¶ 13-17).

[30] *Id.* (¶ 18). In the Prior Decision, we found "Dr. Kim's contention that baby bath care and lotion products and medicated teas are a 'good fit' for umbrella branding" to be "irrelevant," and that his testimony that "[l]ogically, BABY MAGIC would expand into products that cover Respondent's goods" should be accorded "little weight." 19 TTABVUE 36. These findings were not disturbed by the Federal Circuit on appeal. Rather, the Court indicated that it "[could not] discern whether the relevant evidence was properly evaluated," that is, whether we "also considered and rejected this testimony outside of [our] discussion of the issue of natural expansion." *Id.* at 1117. Therefore, it remanded this issue "for further consideration and explanation" of our analysis under this factor. *Id.*

provide umbrella branding, but not with respect to the U.S. market in particular or the goods at issue in this case.

We acknowledge that Dr. Kim's testimony may indicate that goods in the general categories of baby skin care (such as lotions and cleansers) and baby ingestibles (such as gripe water or vitamins) sometimes emanate from a common source under the same marks, which is relevant under *Recot,* 214 F.3d at 1328-29 (considering testimony on broader "food" categories to infer consumer expectations for pet treats and human snacks). However, on this limited evidentiary record, Dr. Kim's testimony does not support a finding that the specific goods identified in the parties' registrations are related in the mind of the U.S. consuming public as to their origin. *See Octocom*, 918 F.2d at 942; *Coach Servs.*, 668 F.3d at 1369-70 (requiring evidence that consumers would perceive the identified goods as connected). The record lacks evidence that any of the entities listed by Petitioner's expert actually offer the goods in the challenged registration ("medicated tea for babies that treats colic and gas and helps babies sleep better") or that Petitioner's toiletry goods (e.g., baby lotion, shampoo, or non-medicated diaper rash cream) are marketed or perceived as treating colic, gas, or sleep issues in a manner that would suggest common origin with medicated tea for treating those conditions. That is, the record lacks evidence that consumers would be likely to encounter the specific goods identified in the registrations offered under the same marks in a manner that would lead them to believe they emanate from a common source.

While *Recot* permits inferences from broader categories, the expert's generalizations here do not sufficiently bridge the gap to Respondent's narrowly identified medicated tea, particularly where no examples involve tea or similarly medicated beverages for infantile digestive or sleep ailments. Moreover, in this case, even as to those several products that Dr. Kim testified are provided in the categories of both the "baby skin care" and baby ingestibles" categories, the record lacks any evidence that those products were actually provided in the United States or that they are currently available. *See McCormick & Co. v. Summers*, 354 F.2d 668, 674 (CCPA 1966) ("Registrability of a mark must be determined on the basis of facts as they exist at the time when the issue of registrability is under consideration.").

Having reconsidered the testimony as the Court instructed, we again find that on this record, Petitioner has failed to show that the goods are related. *See, e.g.*, *Edwards Lifesciences Corp. v. VigiLanz Corp.*, No. 91154210, 2010 TTAB LEXIS 84, at *38-39 ("Opposer simply has not satisfied its burden of proof of showing that the goods identified in the application are sufficiently related to heart monitors as to create a [likelihood] of confusion."); *Fossil Inc. v. Fossil Grp.*, No. 98191, 1998 TTAB LEXIS 388, at *16 (dismissing opposition as to applicant's goods not shown to be related to opposer's); *Amcor, Inc. v. Amcor Indus., Inc.*, No. 73142805, 1981 TTAB LEXIS 54, at *28 ("Nonetheless, where the goods are different, it is incumbent upon plaintiff to show that they are related in some viable fashion and/or that they are marketed or promoted under circumstances and conditions that could bring them to the attention of the same purchaser or prospective purchaser in an environment that could cause

such purchaser reasonably to assume, because of the identity of the marks, that they have a common origin or sponsor or affiliation.").[31]

4. The Similarity or Dissimilarity of Trade Channels and Classes of Consumers

"The third *DuPont* factor considers '[t]he similarity or dissimilarity of established, likely-to-continue trade channels.'" *Id*. at 1118 (quoting *Detroit Athletic*, 903 F.3d at 1308 (quoting *DuPont*, 476 F.2d at 1361)). Because the identifications of goods in both parties' registrations are unrestricted as to trade channels or customer type, we 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, 1361 (Fed. Cir. 2000). The evidence in this case shows both parties goods are offered online by Walmart and Amazon.[32] Ordinarily, "the mere fact goods and services 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." *Parfums de Couer Ltd. v. Lazarus,* No. 91161331, 2007 TTAB LEXIS 36, at *31-32. But here, Respondent has admitted that the channels of trade for the goods provided under the parties' respective marks are similar, and that it sells its BABIES' MAGIC

[31] Although Petitioner did not argue that the zone of natural expansion doctrine applied in this case as a means to bridge the gap for any failure to prove relatedness of the parties' goods, Petitioner's witness did testify that "BABY MAGIC'S Natural Zone of Expansion covers Respondent's Goods." 10 TTABVUE 5, 8. Therefore, the Board did discuss the doctrine in the Prior Decision and determined that it did not aid Petitioner in overcoming its failure to establish the relatedness of the goods. We stand by that finding and incorporate it herein notwithstanding our updated finding, discussed *infra*, that the parties' channels of trade are similar.

[32] 9 TTABVUE 7-3 (Song Decl. ¶¶ 15-16).

TEA to "parents of babies and caregivers of babies,"[33] which are obviously the same customers of Petitioner's BABY MAGIC products. We therefore find that the channels of trade are similar.

5. 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*, 476 F.2d at 1361. 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 Imps.,* 396 F.3d at 1376. In the Prior Decision, we found the fourth *DuPont* factor to be neutral in our analysis. That finding was not challenged on appeal, and we incorporate it by reference herein.

6. Extent of Potential Confusion

The twelfth *DuPont* factor considers the "extent of potential confusion, i.e., whether de minimis or substantial." *DuPont*, 476 F.2d at 1361. In the Prior Decision, we found the twelfth *DuPont* factor to be neutral in our analysis. That finding was not challenged on appeal, and we incorporate it by reference herein.

7. Other Factors Mentioned by Petitioner

The eighth *DuPont* factors consider "[t]he nature and extent of any actual confusion," and the tenth *DuPont* factor considers "[t]he market interface" between the parties. *DuPont*, 476 F.2d at 1361. In the Prior Decision, we found the eighth and tenth *DuPont* factors to be neutral in our analysis. Our findings were not challenged

[33] 8 TTABVUE 17 (Respondent's answer to Petitioner Request for Admission Nos. 7-8). The Board had inadvertently overlooked Respondent's admissions in the Prior Decision.

on appeal, and we incorporate them by reference herein.

C. Balancing the *DuPont* Factors

We now weigh the *DuPont* factors for which there is evidence and argument as directed by the Court. "Not all of the *DuPont* factors are necessarily … of equal weight in a given case, and any one of the factors may control a particular case." *Naterra*, 92 F.4th at *1116-17 (citing *Tiger Lily Ventures*, 35 F.4th at 1362) (internal quotation marks omitted)). "In some cases, even a single factor may be dispositive." *Heil Co. v. Tripleye GmbH,* No. 91277359, 2024 TTAB LEXIS 494, at *96 (citing *Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 333 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive.")).

We are mindful that the two dominant factors in the likelihood of confusion analysis are similarity of the marks and similarity of the goods. *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322 (Fed. Cir. 2017). Both can and frequently do weigh heavily one way or the other in the final weighing analysis. *See, e.g., Tiger Lily Ventures*, 35 F.4th at 1362 (similarity of marks factor weighs heavily in favor of likely confusion where marks identical); *QuikTrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 1037 (Fed. Cir. 2021) (where marks "noticeably differed in appearance, sound, connotation, and commercial impression," this factor outweighed other factors pointing in the opposite direction); *Pink Lady Corp. v. L.N. Renault & Sons, Inc.*, 265 F.2d 951, 953 (CCPA 1959) (the "similarity or dissimilarity" of the goods "is logically a factor of considerable importance to be given much weight in reaching the ultimate conclusion as to whether or not there is likelihood of confusion") (citation omitted). This does not mean either factor has to be dispositive. It always depends on the facts of the

particular case. *In re Charger Ventures LLC*, 64 F.4th 1375, 1381 (Fed. Cir. 2023) ("The weight given to each factor depends on the circumstances of each case.") (citation omitted).

Here, we found the marks to be more similar than dissimilar. We did not find the marks highly similar or identical. We thus weigh the first factor of similar marks heavily in our analysis and in favor of concluding confusion is likely, but it does not deserve dispositive weight. We also weigh the third factor of similar trade channels in favor of likelihood of confusion. We weigh the lack of relatedness of the goods under the second factor heavily in our analysis and against concluding that confusion is likely. Having found Petitioner's BABY MAGIC mark is somewhat conceptually weak and lacks demonstrated commercial strength, we also weigh the fifth factor against a likelihood of confusion. The fourth, sixth, eighth, tenth, and twelfth *DuPont* factors are neutral.

On balance, the differences in the goods, coupled with the conceptual weakness of the marks, outweigh the similarity of the marks and trade channels. As the Federal Circuit has recognized, even where marks share similarities, the absence of a demonstrated relationship between the specific goods can preclude a finding of confusion. *See, e.g., Kellogg*, 951 F.2d at 333 (no likelihood of confusion between similar marks for unrelated goods like cereal and pet food); *Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 718-19 (Fed. Cir. 1992) (dissimilarity of goods dispositive despite mark similarities, as consumers would not associate batteries with computer services). That is the case here.

Consequently, we conclude that confusion is not likely. *See N. Face Apparel Corp. v. Sanyang Indus. Co.*, No. 91187593, 2015 TTAB LEXIS 328, at *53 (dismissing opposition as to classes of goods and services for which opposer did not establish relatedness to its goods); *Fossil,* 1998 TTAB LEXIS 388, at *15-19 (dismissing opposition as to applicant's goods not shown to be related to opposer's); *Itel Corp. v. Ainslie*, No. 72956, 1988 TTAB LEXIS 79, at *8-9 (dismissing opposition in which marks were nearly identical but opposer failed to prove relatedness of the goods and services).

Decision: The Petition for Cancellation is denied.