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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Elegant Headwear Co., Inc.

Serial No. 76536428

Myron Amer of Myron Amer, P.C. for Elegant Headwear Co.,
Inc.

Tejbir Singh, Trademark Examining Attorney, Law Office 106
(Mary I. Sparrow, Managing Attorney).

Before Hairston, Drost, and Kuhlke, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 30, 2003, Elegant Headwear Co., Inc.
(applicant) applied to register the mark BABY'S FIRST (in
standard character form) on the Principal Register for
goods ultimately identified as "baby bibs not of paper" in
Class 25.¹

¹ The application includes a date of first use and a date of
first use in commerce of July 1, 2001. The application contains
a disclaimer of the word "Baby's."

The examining attorney² refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a prior registration for the mark BABY'S FIRST in standard character form for "infants' footwear" in Class 25.³

When the refusal was made final, applicant filed this appeal.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he 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." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

² The current examining attorney was not the original attorney in the case.

³ Registration No. 2,396,712, issued October 24, 2000. The registration contains a disclaimer of the word "Baby's."

The first factor we consider is the similarities and dissimilarities in the marks. In this case, the marks are for the identical words, "Baby's First," in standard character form. Therefore, there are no differences in the marks.

The second factor we consider is whether the goods of applicant and registrant are related. When the marks are identical, the goods and/or services do not have to be as close in order to hold that there is a likelihood of confusion. Amcor, Inc. v. Amcor Industries, Inc., 210 USPQ 70, 78 (TTAB 1981) (When both parties are using or intend to use the identical designation, "the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar"). See also In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source").

In this case, applicant has limited its identification of goods to "baby bibs not of paper." Registrant's goods are "infants' footwear." Applicant's bibs and registrant's footwear are specifically for babies/infants. Reflecting

this point, both applicant and registrant have disclaimed the term "Baby's." The examining attorney has submitted evidence to show that infants' footwear and baby bibs are related. For example, the Jordan-Marie website displays babies' shoes and bibs sold on the same page. The Elegant Baby Gift website shows a rose bib and crocheted knit booties sold on the same page. The Yellow Turtle website under "Baby Gifts and Clothing" includes the following statement: "Everything for babies including baby gifts, baby clothing, baby gift baskets, baby booties... baby slippers, baby bibs." Furthermore, the examining attorney has submitted several registrations, e.g., Nos. 2,177,579; 2,513,619; and 2,823,820, that provide some suggestion that entities have registered a common mark for baby bibs and infants' footwear. See In re Infinity Broadcasting Corp. of Dallas, 60 USPQ2d 1214, 1217-18 (TTAB 2001) ("The registrations show that entities have registered their marks for both television and radio broadcasting services. Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the services listed therein, including television and radio broadcasting, are of a kind which may emanate from a single

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source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988)".

More importantly, we observe that applicant's specimen of record for its baby bibs contains the wording "Headwrap and Ballet Slipper Set" and "SIZE: 0-3 Months." Ballet slippers are a type of footwear and, thus, applicant's own specimen indicates that it is also the source of infants' footwear. We are mindful that in "order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources."

McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001). Here, we conclude that baby bibs not of paper and infants' footwear are related and that when prospective purchasers encounter the identical mark on the identified goods they are likely to believe that there is an association between the sources of the goods.

We add that inasmuch as these products are advertised together, purchasers of baby bibs and infants' footwear would at least overlap and include parents and other people buying clothing items for babies. The evidence showing websites that sell bibs and footwear, certainly supports a conclusion that the channels of trade for these items would be similar. Also, there are no restrictions in either applicant's or registrant's identification of goods so the goods are not restricted as to price or type of baby bibs or infants' footwear. The OneStepAhead website lists the prices of a "Super Bib" as \$16.95 and various booties and footwear between \$9.95 and \$19.95. Therefore, these goods would be relatively inexpensive items.

Applicant submits (Reply Brief at 1) that the examining attorney's position is that "there is per se confusion, if the marks, as in this case, are identical." However, we do not understand that the examining attorney is arguing for a per se rule. Indeed, the examining attorney has discussed the goods of applicant and registrant and determined that they are closely related rather than arguing that there is per se confusion.

In addition, applicant argues (Brief at 3) that the "number of BABY'S FIRST-identified goods is of an extent that no reasonable purchaser would assume they originate

from the same source and thus the common use of BABY'S FIRST is not a source of consumer confusion." We note that evidence of the weakness of the term BABY'S FIRST is not of record and, therefore, we cannot assume that BABY'S FIRST is a weak mark entitled to only a very narrow scope of protection. We add that even if evidence of third-party registrations were properly of record, they "cannot be used to justify the registration of another confusingly similar mark." In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987).⁴ We add that even a weak mark would be entitled to protection when the identical mark is used on closely related goods.

After considering the evidence and arguments of the examining attorney and applicant, we conclude that when the identical mark BABY'S FIRST is used on baby bibs not made of paper and infants' footwear, confusion is likely. If we had any doubts on this issue, we must resolve them against applicant. In re Pneumatiques, Caoutchouc Manufacture et

⁴ Applicant also refers to a prior decision of the TTAB involving the same mark of applicant for additional goods (Serial No. 76409880). Apparently, the prior application at one time contained even more goods in different classes and the examining attorney cited other registrations as a bar to registration. It is not clear why there would be no confusion in the instant application because different registrations were cited against other goods for which applicant sought registration.

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Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729
(CCPA 1973).

Decision: The refusal to register under Section 2(d)
of the Trademark Act is affirmed.