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Mailed: January 24, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dean C. Vafiadis D.D.S.

Serial No. 78509712

John Zaccaria of Notaro & Michalos P.C. for Dean C.
Vafiadis D.D.S.

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(Chris A. F. Pedersen, Managing Attorney).

Before Holtzman, Kuhlke and Cataldo, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Dean C. Vafiadis D.D.S. seeks registration on the
Principal Register of the mark SMILEWATER (standard
character claimed) for goods ultimately identified as
"mineral water distributed in the dental field" in
International Class 32.¹

Registration has been refused under Section 2(d) of
the Trademark Act, 15 U.S.C. §1052(d), on the ground that

¹ Application Serial No. 78509712, filed November 2, 2004,
alleging a bona fide intention to use the mark in commerce under
Trademark Act Section 1(b). 15 U.S.C. §1051(b).

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applicant's mark, when used with its identified goods, so resembles the registered mark shown below



for "soda water" in International Class 32 as to be likely to cause confusion, mistake or deception.²

When the refusal was made final, applicant filed this appeal and requested reconsideration. In a separate filing, applicant also requested remand from the Board for consideration of its amendment to restrict the original identification of goods, "mineral water," to "mineral water distributed in the dental field." The examining attorney denied the request for reconsideration and as to the amendment stated that "[r]egistrant has no trade channel restrictions ... [t]herefore, applicant and registrant's goods could still travel in the same channels."³ The appeal was resumed and briefs have been filed. We reverse the refusal to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative

² Registration No. 2933084, issued March 15, 2005.

³ While the examining attorney did not specifically state that the amendment was acceptable, we deem the amendment accepted.

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facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, 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). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to a consideration of the goods identified in the application and the cited registration. It is well settled that goods and services need not be similar or competitive in nature to support a finding of likelihood of confusion. The question is not whether purchasers can differentiate the goods and services themselves, but rather whether purchasers are likely to confuse the source of the goods and services. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Further, we must consider the cited registrant's goods as they are described in the application and registration. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and

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Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987).

In support of his position, the examining attorney submitted evidence in the form of third-party use-based registrations that support his argument that applicant's mineral water is related to registrant's soda water. See, e.g., Reg. No. 2971330 (MORNING RICE for, inter alia, soda water and mineral water); Reg. No. 2977666 (PERRIER for, inter alia, soda water and mineral water); Reg. No. 2570227 (MAXFIELD PARRISH for, inter alia, soda water and mineral water); and Reg. No. 2835374 (SUN'S UP for, inter alia, soda water and mineral water). Third-party registrations which individually cover a number of different items, and which are based on use in commerce, serve to suggest that the listed goods are of a type which may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993). However, given the amendment to applicant's goods, this evidence has little probative value. "Distributed in the dental field" implies not only a restriction in trade channels but also a restriction as to the purpose and function of the goods, at a minimum, to the extent that they are sold in the dental field. None of the third-party registrations includes "mineral water distributed in the dental field." Therefore, we do not

find the examining attorney's evidence persuasive on this point.

Further, considering the channels of trade, we cannot agree with the examining attorney that applicant's amendment restricting applicant's goods to distribution in the dental field does not obviate a likelihood of confusion. The examining attorney correctly states that the Section 7(b) presumptions accorded a registration include the presumption "that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services." However, it is important to keep in mind that we are looking at the "normal" channels of trade for registrant's goods and, on its face, "the dental field" cannot be considered to be part of the "normal" channels of trade for soda water. We take judicial notice of the following dictionary definition for "soda water" provided by applicant: water charged under pressure with carbon dioxide gas, used in making ice-cream sodas, mixed drinks etc.⁴ Webster's New Twentieth Century Dictionary (2nd ed. 1983). The "normal" channels of trade for soda water would

⁴ The Board can take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

include grocery stores and convenience stores, but not a dentist's office. Therefore, as amended, applicant's goods and registrant's goods cannot be considered to travel in the same channels of trade.⁵ Moreover, even if we were to interpret applicant's identification, mineral water distributed in the dental field, to include mineral water sold next to toothpaste and other dental products in the supermarket, this factor still would not lead to the conclusion that confusion would arise under such conditions. See *Federated Foods, Inc. v. Fort Howard Paper Company*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

In view of the above, the du Pont factors of the similarity of the goods and the channels of trade do not favor a finding of likelihood of confusion.

As to the class of purchasers, they would overlap to the extent that purchasers of registrant's soda water would be from the general public which would include dental patients and dentists.

⁵ The examining attorney's argument that applicant's amendment restricting its channels of trade in its identification of goods is an attempt to limit the scope of applicant's and/or registrant's goods through extrinsic evidence is misplaced. Applicant's amendment to its identification of goods is not extrinsic evidence or argument. Compare *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764-765 (TTAB 1986) (applicant may not restrict the scope of its application or the cited registration by evidence of the pricing of applicant's wine given the unrestricted identification of goods in the application and cited registration).

We turn now to the first du Pont factor, i.e., whether applicant's mark SMILEWATER and registrant's mark  are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. The analysis is not whether the marks can be distinguished when compared side-by-side. Rather, we must determine whether the marks are sufficiently similar that there is a likelihood of confusion as to source and, in making this determination, we must consider the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

The examining attorney argues that the term SMILE is the dominant part of applicant's mark as well as registrant's mark because "the term 'WATER' is merely descriptive of the applicant's goods" and "the word portion [of registrant's mark] is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods." Applicant disagrees with this assessment, contending that "[a]pplicant's mark is both unique and incongruous. It is likely to be remembered as a whole as a clever new word combination that's suggestive of water

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which has a fun aspect and which makes a person smile [and t]here is no basis for concluding that the design is any less memorable than the word. The smiley face design creates a significant commercial impression which readily distinguishes the cited mark in its entirety from applicant's mark." Br. p. 5. Further, as to connotation applicant argues that "[a]pplicant's mark, taken in its entirety, suggests that a patient's visit to a dentist can be a pleasant experience with the result that the patient will want to show her or [sic] teeth by smiling ... and in view of applicant's goods, mineral water distributed in the dental field, connotes the impression of a natural, healthy smile." Br. p. 11.

We begin by noting that the marks differ substantially in appearance. Registrant's mark includes a prominent and distinctive design of a moon-shaped face with a cherubic figure standing in the hook of the S in SMILE. The marks also differ in sound in that applicant's mark includes the additional word WATER. As to connotation, the examining attorney argues that the word SMILE has the same connotation and commercial impression in both marks. However, we must make this assessment in the context of the relevant goods and applicant's goods are directed to a specific industry, the dental field. Thus, applicant's

mark gives the impression of being good for a consumer's teeth, something to improve your smile, in contrast to registrant's mark which simply connotes a smile or a smiling face. While it is true that generally the literal portion of a mark may dominate the design portion because it is by the words that the consumer will call for the goods and descriptive elements are often given less weight, we still must consider the marks in their entireties. In view of the visually prominent design element in registrant's mark and the difference in connotation and overall commercial impression of the literal portions of the marks in the context of applicant's goods, we find that, despite both marks including the word SMILE, the differences are sufficient to distinguish applicant's mark from registrant's mark. Thus, the factor of the similarity of the marks does not weigh in favor of a finding of likelihood of confusion.

In making our determination, we have given no weight to applicant's argument that "the word 'smile' is used and registered by several parties for beverages, and thus, the consuming public is accustomed to distinguishing SMILE marks as to source." Br. p. 15. Applicant's evidence has little probative value. Only two examples are live, use-based registrations and they contain other distinguishing

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elements, U'SMILE and STRAWBERRY SMILE. The remaining are either pending applications, expired registrations or registrations based on Section 44, none of which have probative value for this point. More importantly, third-party registrations are not evidence of use and, thus, are of little probative value in an analysis of the strength of the marks. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). The only evidence of use of the word SMILE consists of printouts from two third-party websites showing SMOOTHIE SMILE for juice smoothies and SOUTHERN SMILE for a drink recipe. This evidence does not support a finding that SMILE is widely used on similar goods.

Third-party registrations may be "useful to demonstrate the sense in which a term is used in ordinary parlance and they can show that a particular term has been adopted by those engaged in a certain field or industry and that said term has less than arbitrary significance with respect to certain goods or services." *In re Dayco Products-Eaglemotive, Inc.*, 9 USPQ2d 1910, 1912 (TTAB 1988) (IMPERIAL adopted by others in the vehicular field to refer to that term's ordinary significance as a laudatory designation). However, we do not find the two above-noted registrations sufficient evidence upon which to make a

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determination that the term SMILE has a particular significance in the field of mineral or soda water and is, thus, deserving of a limited scope of protection.

In conclusion, we find that because of the differences in the goods and channels of trade and the dissimilarities in the marks, confusion is not likely between applicant's mark and the mark in the cited registration.

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