THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Hearing: July 23, 2008

Mailed: October 6, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re RIC Investments, LLC

Serial No. 78651809

Frederick H. Colen of Reed Smith LLP for RIC Investments, LLC.
Theodore McBride, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Seeherman, Walters and Taylor, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

RIC Investments, LLC has appealed from the final refusal of the Trademark Examining Attorney to register SOOTHIE in standard character form for "baby bottles, baby bottle nipples and teething rings" in Class 10 and "baby bottle brushes" in Class 21.[1] Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C.

---

[1] Application Serial No. 78651809, filed June 16, 2005, based on Section 1(b) of the Trademark Act (intent-to-use).

§1052(d), on the ground that applicant's mark, if used in connection with its identified goods, so resembles the mark SOOTHIES, registered for "glycerin pad to ease nipple pain during breast feeding,"[2] that it is likely to cause confusion or mistake or to deceive.

The appeal has been fully briefed, and an oral hearing was held before the Board.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative 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 and/or services. 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).

Here, the marks are virtually identical. SOOTHIE and SOOTHIES differ only in that the registered mark is in

[2] Registration No. 2561103, issued April 16, 2002; Section 8 affidavit accepted; Section 15 affidavit received.

plural form, with an additional letter "s." This single letter is not significant in distinguishing the marks. On the contrary, the marks are virtually identical in appearance and pronunciation. Applicant itself acknowledges that "its mark and registrant's mark are similar in sound and appearance." Response filed February 2, 2007. As for connotation, although the registered mark SOOTHIES would be understood as referencing the physical effect of the glycerin pads on a nursing mother's nipples, while SOOTHIE for applicant's baby bottles and other goods would be viewed as the emotional effect on a baby of drinking milk from a bottle, both marks convey the same connotation that the goods are soothing. This case thus differs from In re British Bulldog, Ltd., 224 USPQ 854, 856 (TTAB 1984), upon which applicant relies, because in the latter case the mark PLAYERS was found to have different connotations because of the respective goods on which the mark was used. ("PLAYERS" for shoes implies a fit, style, color, and durability adapted to outdoor activities. "PLAYERS" for men's underwear implies something else, primarily indoors in nature.) Because the connotation, appearance and pronunciation of the marks are virtually the same, they also convey the same commercial impression.

This du Pont factor of the similarity of the marks strongly favors a finding of likelihood of confusion.

We turn next to the du Pont factor of the similarity or dissimilarity of the goods. As has long been recognized, it is not necessary that the goods or services of an applicant and registrant be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). Further, "the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion." In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983).

Here, both applicant's and the registrant's goods are items that can be used by nursing mothers. Applicant has argued that the customers for its goods and those of the registrant are different, asserting that its goods would

typically not be used by non-nursing mothers. However, applicant's argument ignores the fact that nursing mothers may use bottles when they express their breast milk, or may use bottles for formula to supplement their breast milk. See, for example, the webpages from La Leche League International, www.lalacheleague.org, made of record with the second Office action, discussing supplementing breast milk with formula, and expressing breast milk. Further, an advertisement for the Avent breast pump, at the website www.aventamerica.com, also made of record with the second Office action, states that "you can pump, feed and store using any bottle or cup." As a result, applicant's goods and the registrant's goods are complementary items because nursing mothers who use glycerin pads to ease nipple pain during breast feeding may also use baby bottles, baby bottle nipples and baby bottle brushes. Moreover, these consumers will regard the goods as being used in the same process, namely, feeding their babies.

The Examining Attorney has also submitted evidence showing that breast pads and baby bottles are sold by the same companies under the same marks. For example, the Avent website features both baby bottles and breast pads that "ease[] minor discomforts you might encounter while breastfeeding." In addition, the Examining Attorney has

submitted three third-party registrations that show companies have registered a single mark for both goods of the type identified in applicant's application and those of the registrant.[3] 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 and/or services are of a type which may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993). See Registration No. 2277870 for EVENFLO for, inter alia, disposable baby bottles, nipples for baby bottles, teething rings, manual breast pumps and breast pads for nursing; Registration No. 3086003 for TIGEX for, inter alia, breast pads, baby bottles, baby bottle nipples of latex and silicone, and teething rings; Registration No. 1834153 for PUR for, inter alia, teething rings, musical baby bottles, breast shields and breast pads to prevent leakage or soreness. Although three third-party registrations is a rather insignificant number, and might not be sufficient in and of themselves to demonstrate the relatedness of the goods, the registrations

[3] The Examining Attorney submitted a large number of third-party registrations and applications that list both breast pads and baby bottles, etc. However, most of these submissions have no probative value because the registrations were not based on use in commerce, while third-party applications are probative only of the fact that they were filed.

and the other evidence showing third-party use, as well as the complementary nature of the goods, are sufficient to demonstrate the relatedness of the goods.[4]

The Examining Attorney also submitted evidence that nursing mothers will encounter baby bottles, nipples and bottle brushes in the same channels of trade in which they may purchase breastfeeding supplies. The website for BabyCatalog.com, http://infant-feeding.babycatalog.com, states that it carries baby bottles, nipples, bottle brushes, breast pumps and breastfeeding accessories. The website for The Baby Bungalow, www.babybungalow.com, features on the same page breast pumps, reusable bottles, and bottle brushes. The Babies "R" Us website, www.toysrus.com, features, under the category "breastfeeding accessories," breast pads and a Breastflow "starter set" containing baby bottles, nipples and a bottle brush. Accordingly, we conclude that the goods identified in applicant's application and the cited registration are

---

[4] The present situation differs from In re Mars, Incorporated, 741 F.2d 395, 222 USPQ 938 (Fed. Cir. 1984), on which applicant relies, in which the Court found no likelihood of confusion between CANYON for candy bars and CANYON for fresh citrus fruit, despite the Court's finding that the marks were "legally identical word marks." The Court reversed the Board because there was no evidence in the record of the relatedness of the goods, and therefore the Board's conclusion of relatedness was merely "a matter of opinion." Here, on the other hand, the Examining Attorney has submitted substantial evidence demonstrating that the goods are related.

sold in the same channels of trade, and that this du Pont factor favors a finding of likelihood of confusion.

Applicant argues that the consumers of both applicant's goods and the registrant's goods would be careful, as the products they are purchasing will be used in connection with feeding their children, and that they are sophisticated purchasers. We are not persuaded on either of these points. Generally purchasers are considered to be sophisticated because they have specialized knowledge or training. However, anyone who has or raises a child is a mother, and we think it more appropriate to consider mothers part of the general public. We agree that mothers are likely to be careful about many of the products that they use for their babies. Certainly they would be careful about the food they give them. However, products such as baby bottles and bottle brushes, although used in the feeding process, are not critical items for which one would expect the consumer to exercise great care in the purchasing process. The same is true for glycerin pads for easing nipple pain. Neither the pads nor the product in the pads will in be ingested by the babies. Moreover, even if we were to accept that the purchasers of applicant's and the registrant's goods are careful, the marks themselves are so similar that even careful

purchasers are not likely to differentiate them on the basis of the pluralization of the registrant's mark. Even if consumers were to note the difference, they are likely to assume that the marks are variations of each other, with the plural being a logical form when used in connection with a package that contains several glycerin pads.

Accordingly, we find that this du Pont factor is neutral.

One of applicant's major arguments is that it already owns registrations for SOOTHIE and WEE SOOTHIE for pacifiers; that it has used these marks coextensively with the registrant's mark for more than seven years without any evidence of confusion; and that the U.S. Patent and Trademark Office did not view these marks as being confusingly similar when it allowed applicant's prior applications despite the earlier filing date of registrant's application. Applicant argues that it should therefore be allowed to extend its mark to baby bottles, nipples, bottle brushes and teething rings because this is a natural extension from applicant's previous goods, pacifiers.

We are not persuaded by these arguments. Baby bottles, nipples, bottle brushes and teething rings are not pacifiers. Therefore, we cannot extrapolate from

applicant's assertion that there has been no evidence of actual confusion between the use of applicant's mark for pacifiers and the registrant's mark for glycerin pads that there is no likelihood of confusion between the goods for which applicant currently seeks registration and registrant's mark.[5] Compare, In re 1st USA Realty Professionals Inc., 84 USPQ2d 1581 (TTAB 2007), in which the applicant made an analogous argument, although in that case the applicant relied on its use of a variation of its currently applied-for mark, asserting that its prior mark and the registrant's mark had co-existed for over eleven years without any known instances of confusion. As the Board said in rejecting that argument, 84 USPQ2d at 1588, "we consider the present mark and the prior mark sufficiently different that we can draw no conclusions as to lack of instances of actual confusion with the present mark based on applicant's experiences with its prior mark."

For the same reason, the fact that an Examining Attorney found no likelihood of confusion between applicant's SOOTHIE and WEE SOOTHIE marks for pacifiers and the registrant's mark has no effect on whether applicant's

[5] We also point out that lack of evidence of actual confusion, even if the mark were used with the goods in the current application, is entitled to little weight in an ex parte proceeding. See In re Majestic Distilling Co., *supra*, 65 USPQ2d at 1205.

mark for its currently applied-for goods is likely to cause confusion with the registered mark.

As for applicant's argument that it is entitled to register its mark for goods that are related to those in its earlier registration, applicant has submitted no case law in support of this argument, and we are aware of none that would allow it. On the contrary, the statute clearly prohibits registration of a mark that is likely to cause confusion with a previously registered mark. If applicant's mark for its currently-identified goods is likely to cause confusion with registrant's mark, it cannot be registered, despite the fact that applicant owns a previous registration for the same mark but for goods that are not the same.

Decision: The refusal of registration is affirmed.