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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

H2O TO GO, LLC
v.
Todd Kenton Cook

Cancellation No. 92044068

Shawn K. Look of Look Law Firm LLC for H2O TO GO, LLC

Gerard T. Gallagher of Baker & Daniels LLP for Todd Kenton Cook.

Before Hohein, Holtzman and Kuhlke, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Petitioner, H2O TO GO, LLC, has filed a petition to cancel a registration on the Principal Register owned by Todd Kenton Cook (respondent) for the mark H2O TO GO (in typed form) for "water treatment equipment, namely, filters, pumps, conditioners, water coolers and water softeners" in Class 11; and "retail water stores providing water and environmental treatment equipment,

systems and supplies; water dispensers and coolers" in Class 35.¹
The term H2O is disclaimed.

As its ground for cancellation, petitioner alleges priority and likelihood of confusion under Section 2(d) of the Trademark Act. In particular, petitioner alleges that respondent's mark, when applied to respondent's goods and services, so resembles petitioner's previously used and registered marks PURIFIED WATER TO GO and WATER TO GO as to be likely to cause confusion. Petitioner identifies these registrations as Registration No. 2720719 for the mark PURIFIED WATER TO GO and Registration No. 1949803 for the mark WATER TO GO for retail stores featuring bottled water, juices, water coolers, crocks and crock stands; franchising services, namely, offering technical assistance in the establishment of such retail stores.

Respondent has filed an answer denying the salient allegations in the petition.

The record includes the pleadings and the file of the involved registration. In addition, petitioner has submitted the testimony, with exhibits, of Ronald Quinn, petitioner's predecessor; and Joseph Ventresca, managing member of petitioner. Petitioner has also submitted notices of reliance on evidence

¹ Registration No. 2310252, issued January 25, 2000; Section 8 affidavit accepted.

which includes certified copies showing that the following pleaded registrations are subsisting and owned by petitioner:

Registration No. 1949803, on the Supplemental Register, for the mark **WATER TO GO** (typed form) for "retail stores featuring bottled drinking water, juices, ice, water coolers, crocks and crock stands; wholesale distributorships featuring bottled drinking water, juices, ice water coolers [sic] crocks and crock stands" in Class 42; WATER is disclaimed;² and

Registration No. 2720719, on the Principal Register under Section 2(f), for the mark **PURIFIED WATER TO GO** (typed form) for "ice" in Class 30; "bottled drinking water, juices" in Class 32; and "retail stores featuring bottled drinking water, juices, ice, water coolers, crocks and crock stands; wholesale distributorships featuring bottled drinking water, juices, ice, water coolers, crocks and crock stands; franchising services, namely, offering technical assistance in the establishment of retail stores featuring water, ice, juice and related accessories" in Class 35.³

Respondent's record consists of the testimony, with exhibits, of Todd Kenton Cook; and several notices of reliance.

Both parties have filed briefs.

Standing

Petitioner's standing is established by its proof of ownership of subsisting Registration Nos. 1949803 and 2720719.

For purposes of our analysis on the merits of this case we will focus on the registration of petitioner which is closest to the involved registration, namely Registration No. 1949803 for the mark WATER TO GO on the Supplemental Register for "retail

² Issued January 16, 1996; renewed.

³ Issued June 3, 2003.

stores featuring bottled drinking water, juices, ice, water coolers, crocks and crock stands; wholesale distributorships featuring bottled drinking water, juices, ice water coolers [sic] crocks and crock stands" in Class 42.

Priority

In a cancellation proceeding, where both parties own registrations, petitioner must prove priority of use. See *Brewski Beer Co. v. Brewski Brothers, Inc.*, 47 USPQ2d 1281 (TTAB 1998) and cases cited therein. In the case of a registration on the Principal Register, petitioner may rely on its registration as proof that the mark was in use as of the filing date of the underlying application. See *J. C. Hall Company v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 437 (CCPA 1965) ("The presumption of use emanating from the fact of registration relates back to the filing date of the application on which the registration is predicated").

However, in the case of a registration on the Supplemental Register, a plaintiff is not entitled to rely on the underlying filing date as proof of priority. A registration issued on the Supplemental Register cannot be afforded any statutory presumptions under Section 7(b) of the Trademark Act and is therefore incompetent as evidence to establish priority of use. See *Aloe Creme Laboratories, Inc. v. Johnson Products Co., Inc.*, 183 USPQ 447, 447 (TTAB 1974); and *In re Federated Department Stores Inc.*, 3 USPQ2d 1541 (TTAB 1987) (a Supplemental Register

registration is evidence of nothing more than the fact that the registration issued on the date printed thereon). On the other hand, where a Supplemental Registration is concerned, a plaintiff need not also establish distinctiveness of its mark prior to the defendant's first use. It is clear, under *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981), that a plaintiff relying on an unregistered mark, cannot prevail on a likelihood of confusion claim unless it shows that its term is distinctive of its goods or services, "whether inherently or through the acquisition of secondary meaning or through whatever other type of use may have developed a trade identity."

Here, however, petitioner is not relying on an unregistered mark. Moreover, we note that the Court in *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1042 (Fed. Cir. 1990), cited an exception to the general rule set forth in *Otto Roth*. That exception involves the situation where a plaintiff alleging likelihood of confusion owns a Supplemental Register registration. The Court stated that: "[L]ikelihood of confusion can be found even if a term is merely descriptive and does not identify source: Registration on the Supplemental Register is sufficient, and a showing of trade identity rights in the form of secondary meaning is unnecessary." *Towers*, *id.*, citing *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978) and *In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49 (Fed. Cir.

1986). See also *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1138 n.12 (TTAB 1992)

Under the circumstances, we find that petitioner is not required to prove, in addition to priority, that its mark WATER TO GO was distinctive of its services prior to respondent's first use of its mark. Moreover, we find that although petitioner's mark as a whole, while perhaps inherently weak, is not entirely without distinctiveness.

We turn then to the question of priority of use. Mr. Quinn, petitioner's predecessor, testified that the first retail store opened under the name PURIFIED WATER TO GO in Las Vegas, Nevada in 1993. Mr. Quinn introduced a yellow pages advertisement for the store dated 1996, showing the mark and the sale of such goods as crocks, coolers, water and water bottles, and also showing that there were three store locations in Las Vegas at that time, which Mr. Quinn confirmed. It can be seen from this advertisement, as well as most all of petitioner's other records of use, that the term WATER TO GO consistently appears in large, bold letters, in contrast to the word "Purified" which appears in tiny cursive writing either above or to the left of WATER TO GO. It is clear that WATER TO GO is used in a manner that creates a commercial impression separate and apart from its use in the phrase PURIFIED WATER TO GO.

Petitioner's testimony and supporting documentation are sufficient to demonstrate petitioner's prior and continuous use

of the mark WATER TO GO in connection with retail stores featuring water and water-related products since at least 1996, which is prior to the August 11, 1997 filing date of respondent's underlying application and the April 1997 date of first use established by respondent.

Likelihood of confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Services/Trade channels/Purchasers

In our evaluation of these *du Pont* factors, we are bound by the goods and services as identified in the involved registration. In the absence of any restrictions or limitations in the registration, we must assume the goods and services are sold through all the normal and usual trade channels for such goods and services to all the usual purchasers of such goods and services. See Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and Octocom Systems

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

Respondent's goods and services are identified as "water treatment equipment, namely, filters, pumps, conditioners, water coolers and water softeners"; and "retail water stores providing water and environmental treatment equipment, systems and supplies; water dispensers and coolers." Petitioner operates the same type of retail stores featuring same the types of products, i.e., water, water bottles, water coolers and other water-related products.⁴ Thus, the parties' respective services are essentially the same.

Furthermore, petitioner's retail water stores are closely related to respondent's goods, which include water, bottled water, crocks and coolers. It is well settled that the likelihood of confusion may result from the use by different parties of the same or similar marks in connection with goods, on the one hand, and services which deal with or are related to those goods, on the other. See *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988); and *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983). Furthermore, the record shows that petitioner itself applies its WATER TO GO mark on goods such

⁴ We construe the term "water" in the phrase "providing water and environmental treatment equipment" as referring to drinking water rather than "water treatment equipment" and respondent's testimony and evidence clearly supports this view, showing that respondent in fact sells bottled and/or filtered water. See, e.g., *Cook Dep.*, p. 21; and *Exhs. 1 and 2*; *Int. Resp. Nos. 2, 4*.

as water bottles, crocks and coolers, some of the products for which respondent's mark is registered.

Because there are no restrictions in the registration, we must presume, based on the nature of the identified goods and services, that respondent's retail stores and at least some of the products sold in the store, e.g., water, which is broad enough to encompass bottled water, and water coolers, would be directed to and purchased by ordinary consumers. See *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998). In fact, the evidence shows that both parties advertise and promote their products and services to the general public in the same types of print media, such as Yellow Pages directories, handouts and fliers which contain discount coupons for water fills or refills; and both parties' stores are selling products that may be purchased by ordinary consumers. For example, Mr. Cook testified that he sells countertop water filters which hook to the kitchen sink for home use. (Dep., p. 33.)

Strength of petitioner's mark

Petitioner has used the mark WATER TO GO in connection with its retail water stores and water-related products for more than 10 years. Petitioner currently has 60 stores in 20 states, and Mr. Ventresca states that approximately 20 more stores are in the process of opening. Petitioner has promoted the mark primarily through print advertising such as newspapers, fliers and phone books, and through the Internet. More recently, the mark has

been displayed on a water bottle-shaped hot air balloon which has been flown at large public events attended by hundreds of thousands of people. The mark is also prominently displayed on petitioner's storefronts and on its product labels and on all of its promotional materials. The evidence of record also shows that petitioner has successfully franchised its stores, having been consistently recognized by the trade publication *Entrepreneur Magazine* as one of its "Franchise 500" for all but one year since 1997.

In addition, petitioner has submitted evidence of its sales and advertising expenditures for the 2¹/₂-year period from 2004 to the first half of 2006. Although the specific amounts are confidential, we can say they are substantial.

Petitioner has also successfully policed its mark. In particular, petitioner's predecessor received a preliminary injunction against a potential competitor's use of a similar mark.⁵

The evidence of record is sufficient to persuade us that petitioner's mark WATER TO GO, although perhaps initially weak, has achieved some degree of strength and recognition in the

⁵ As respondent points out, this evidence is not probative of the question of likelihood of confusion. However, contrary to respondent's contention, the decision granting the preliminary injunction is admissible by notice of reliance as either a public record or as an official record of the court from which it issued (United States District Court for the District of Colorado (Civil Action No. 97-S-1966)); and moreover this evidence is probative of petitioner's efforts to police its mark.

marketplace, and that it functions as a significant indicator of source. Accordingly, we find that the mark is entitled to a broader, rather than a narrower, scope of protection.

We also note that there is no evidence of any third-party use or registration of the same or similar marks in the record or any other evidence which might tend to suggest that purchasers would be accustomed to making distinctions between the WATER TO GO mark and others based on more subtle differences in the marks.

The marks

We turn then to a comparison of respondent's mark H2O TO GO with petitioner's mark WATER TO GO, keeping in mind that when marks would appear in connection with services that are identical, the degree of similarity between the marks necessary to support a finding of likelihood of confusion declines. *Century 21 Real Estate v. Century Life*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Furthermore, it is well established that, in proceedings before the Board, the question of likelihood of confusion must be decided on the basis of the mark "exactly as shown" in the registration regardless of how the mark is actually used. *Jim Beam Brands Co. v. Beamish & Crawford, Ltd.*, 937 F.2d 729, 19 USPQ2d 1352, 1356 (2d Cir. 1991) (distinguishing infringement proceedings from Board proceedings). See also *Kimberly-Clark Corp. v. H. Douglas Enterprises*, 774 F.2d 1144, 227 USPQ 541 (Fed. Cir. 1985). Consequently, respondent's arguments regarding

the trade dress used in association with its mark are irrelevant. Moreover, and in any event, the wording WATER TO GO in petitioner's mark creates a commercial impression apart from any trade dress.

We also point out that the standard for evaluating descriptive marks or marks on the Supplemental Register is not whether the marks are "substantially identical" as respondent claims. See *In re Southern Bell Frozen Foods, Inc.*, 48 USPQ2d 1849 (TTAB 1998) (clarifying *In re Hunke & Jocheim*, 185 USPQ 188 (TTAB 1975), on which respondent has relied). The same standard applies regardless of the nature of the mark or the register on which it appears. We note that the Court addressed and rejected a similar argument in *In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 341 (CCPA 1978):

Appellant next posits a requirement that citation of marks on the Supplemental Register under §2(d) be limited to marks identical to that sought to be registered. No reason exists, however, for the application of different standards to registrations cited under §2(d). The level of descriptiveness of a cited mark may influence the conclusion that confusion is likely or unlikely, ...but that fact does not preclude citation under §2(d) of marks on the Supplemental Register.

With the above principles in mind, when we compare respondent's mark H2O TO GO with petitioner's mark WATER TO GO, in their entireties, as used on identical retail water stores and closely related products, we find that the marks are similar in sound, appearance, meaning and in their overall commercial

impression. While there are some differences between the marks, the similarities outweigh those differences.

The shared phrase TO GO is aurally and visually a significant part of both marks. While the marks begin with different words, WATER and H₂O, when those words are combined with TO GO the marks as a whole are still visually similar and they have a similar sound and cadence due primarily to the two word phrase TO GO.

The marks H₂O TO GO and WATER TO GO as a whole are highly similar, if not identical, in meaning and commercial impression. The term "water" is defined as "A clear, colorless, odorless, and tasteless liquid, H₂O, essential for most plant and animal life and the most widely used of all solvents." The American Heritage Dictionary (Fourth Edition) (Pet's. Third Not. of Rel., Exh. 10.) H₂O is a commonly known symbol for water, and consumers would recognize WATER and H₂O as equivalent terms. Respondent argues that merely because a dictionary mentions the chemical formula of water is not persuasive that consumers will understand that meaning. However, the dictionary does not even refer to H₂O as a chemical formula, which suggests that H₂O would be recognized by consumers as another term for "water." Even Mr. Cook testified that he had to disclaim the term H₂O "because it was a common everyday thing." (Dep., p. 16.)

Viewed in their entireties, we find that the marks are similar. The high degree of similarity between the marks in

terms of connotation and commercial impression significantly outweighs any dissimilarities between the marks in terms of appearance and sound.

As we have found, petitioner's mark is a relatively strong one and as such is entitled to more than a narrow scope of protection. However, even assuming the mark is weak, it is well settled that even weak marks are entitled to protection against registration of similar marks for identical and/or closely related goods and services. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 USPQ 108, 109 (CCPA 1974) (likelihood of confusion "is to be avoided, as much between 'weak' marks as between 'strong' marks, or as between a 'weak' and a 'strong' mark"); and *The Clorox Co.*, supra at 341 (ERASE for a laundry soil and stain remover held confusingly similar to STAIN ERASER, registered on the Supplemental Register, for a stain remover).

Contrary to respondent's apparent contention, it is not dispositive or even relevant that the examining attorney did not cite petitioner's registered mark WATER TO GO against respondent's pending application for H2O TO GO.⁶ See *Miss Universe L.P. v. Community Marketing Inc.*, 82 USPQ2d 1562 (TTAB 2007). This would defeat the purpose of the cancellation

⁶ Petitioner's objections to respondent's reliance on petitioner's pending application Serial No. 78868826 and the file for the application, as well as the file for petitioner's pleaded Registration No. 2720719 (PURIFIED WATER TO GO) are well taken. That evidence was never made of record during respondent's testimony period. This untimely evidence has not been considered.

proceeding. We must base our conclusions on the entire record and arguments presented in this inter partes proceeding. Cf. *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Furthermore, as petitioner points out, it can be seen from the registration file for the involved registration that the examining attorney's search strategy was not calculated to find any marks that used the word "water" instead of "H2O."

Actual confusion

Respondent argues that despite the fact that the marks have been in contemporaneous use for nearly 10 years there is no evidence of any actual confusion during that time. However, the parties' stores are located in different geographic regions. Apparently, petitioner's closest stores are located in Michigan, approximately 120 miles from respondent's two stores which are located in Hicksville and Antwerp, Ohio. Thus, it is unclear whether a meaningful opportunity for actual confusion has ever existed. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). There must be evidence showing that there has been an opportunity for instances of actual confusion to occur, and here the record is devoid of any such proof, so this factor is neutral. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000).

Conclusion

We find that purchasers who are familiar with petitioner's retail water stores, and its relatively strong and distinctive

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mark WATER TO GO would be likely to believe, upon encountering respondent's highly similar mark H2O TO GO also used on retail water stores and on products that are closely related thereto, that such services and goods originated with or are in some way associated with or sponsored by petitioner.

Decision: The petition to cancel is granted, and Registration No. 2310252 will be cancelled in due course.