

6/12/02

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 11
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Baby Einstein Company, LLC

Serial No. 75/900,636

Stephen B. Smith of Holme Roberts & Owen LLP for The Baby Einstein Company, LLC.

Anne E. Sappenfield, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Cissel, Seeherman and Hanak, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On January 21, 2000, applicant filed the above-referenced application to register the mark shown below

baby 
santa

on the Principal Register for the following goods:

"audiovisual and audio programming designed to stimulate the learning capabilities of infants and toddlers, namely, pre-recorded videotapes, video discs, DVDs, CD-ROMs, audio cassettes, and audio CDs, all featuring music, natural sounds, spoken word, photographic images and graphic images," in Class 9.¹ The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these products.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that if applicant were to use the mark it seeks to register in connection with the goods specified in the application, it would so resemble the mark "BABY SANTA," which is registered² for "greeting cards, posters, children's story books, gift wrap paper and stationery; namely, writing paper and envelopes," in Class 16; and "clothing, namely T-shirts, sweatshirts, pajamas, shoes and

¹ Notwithstanding the inconsistent language in this clause, we interpret the language used by applicant as indicating that the audio programming does not feature "photographic images" and "graphic images."

² Reg. No. 1,686,961, issued to Al-Sheik, a partnership under the laws of the state of Michigan, on May 12, 1992. Affidavits under Sections 8 and 15 of the Act accepted and acknowledged, respectively.

socks," in Class 25, that confusion would be likely.

Another registration owned by the same partnership was also cited as a bar to registration of applicant's mark, but the Examining Attorney subsequently withdrew the refusal based on that registration.

Applicant responded to the refusal to register with argument that the mark and the goods in the cited registration are sufficiently different from its mark and goods that confusion would be unlikely. Applicant argued that the trade channels through which the products move are different, that the "purchasing environments" differ because the goods set forth in the registration are inexpensive, impulse purchases, whereas the goods in the cited registration are bought by sophisticated people after careful consideration, and that applicant's mark is part of a well-known family of trademarks incorporating the word "baby" and the name of a famous person in addition to the stylized graphic presentation of a child. No evidence in support of any of these arguments was submitted, however.

The Examining Attorney was not persuaded by applicant's arguments, and the refusal to register was made final in her second Office Action. She found the marks to be very similar because the literal portions are the same, and the design in applicant's mark does not obviate the

likelihood of confusion because the word portion is the same as the registered mark in its entirety. She also concluded that the goods specified the application are commercially related to those set forth in the cited registration. Submitted in support of this contention were copies of thirty third-party registrations. In ten of them, the identified goods include both children's books and audio visual and/or audio programming; another ten list goods which include both clothing and audiovisual and/or audio programming; and ten more specify goods which include both greeting cards and audio visual and/or audio programming.

Applicant timely filed a Notice of Appeal. Both applicant and the Examining Attorney filed appeal briefs, and applicant filed a reply brief, but applicant did not request an oral hearing before the Board.

As a preliminary matter, we note that applicant submitted additional evidence, namely copies of other registrations of which it asserts ownership, with its reply brief. Trademark Rule 2.142(d) provides that the record should be complete prior to the filing of the Notice of Appeal. Although the rule provides a procedure by which either applicant or the Examining Attorney may request permission to submit additional evidence after that time,

applicant did not follow this procedure. Accordingly, the Board has not considered the late-filed evidence attached to applicant's reply brief.

Based on careful consideration of the record before us in this appeal and the written arguments presented by applicant and the Examining Attorney, we find that the refusal to register is well taken.

The predecessor to our primary reviewing court, in the case of *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to be considered in determining whether confusion is likely. Chief among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the similarity of the goods. The more similar the marks are to each other, the less closely related the goods have to be in order to support a finding that confusion is likely. *Amcor, Inc. v. Amcor industries, Inc.*, 210 USPQ 70 (TTAB 1981).

Turning first to the marks, we note that the literal portions of these marks are the same words, "BABY" and "SANTA." We agree with the Examining Attorney that neither the design of the baby's head nor the different style lettering in applicant's mark overcomes this similarity. Generally speaking, literal portions of marks are the

dominant and most significant features of the marks because they are the portions that purchasers remember and use to call for the goods or to recommend them. In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). Applicant has essentially appropriated the registered mark in its entirety and added to it a design. Prospective purchasers of applicant's goods who are familiar with the use of the registered mark in connection with related products would be likely to assume, mistakenly, as it would turn out to be, that the design element is being used by the registrant in connection with a new line of products, or that the design is simply a new way in which registrant's established trademark is being presented. In any event, these marks create commercial impressions which are similar enough so that confusion would be likely if both marks were used on commercially related goods.

Applicant's arguments to the contrary are not well taken. As noted above, the contention that the mark in the instant application is part of a well-known family of marks is not supported by any evidence. Moreover, an applicant cannot use the contention that it has a family of marks in order to avoid a finding that confusion is likely with a previously used and registered mark. Baroid Drilling

Fluids, Inc. v. Sun Drilling Products, 24 USPQ2d 1048 (TTAB 1992).

We thus turn to consideration of the relationship between the goods specified in the application and those set forth in the cited registration. It is well settled that the goods need not be identical or directly competitive to find that confusion would be likely. They need only be related in some manner or the conditions surrounding their marketing need be such that they could be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods come from a single source. In *Re Martin's Famous Pastry Shoppe, Inc.*, 478 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); In *re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). This is the situation in the case at hand.

The thirty third-party registrations made of record by the Examining Attorney serve to suggest that the goods listed therein are of types which may emanate from a single source. See: In *re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); In *Re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988), and cases cited therein. There is no support in the record for applicant's arguments that its products bearing the mark it seeks to register will be sold in different markets from those in which the goods listed

in the cited registration are sold, or that the purchasers of applicant's goods are sophisticated consumers, rather than impulse purchasers who applicant claims buy the kinds of goods listed in the registration. We agree with the Examining Attorney that a parent presented with applicant's educational audio visual and audio programming for his or her child sold under the "baby santa" and design mark applicant seeks to register would be likely to assume that such programming emanates from the same source which is responsible for "BABY SANTA" brand children's story books, baby clothing and greeting cards.

In summary, because the marks create similar commercial impressions and the goods set forth in the application are commercially related to those identified in the registration, confusion would be likely if applicant were to use the mark it seeks to register in connection with the goods listed in the application.

Any doubt as to whether confusion would be likely must be resolved in favor of the registrant and prior user, and against the applicant, who has a legal duty to select a mark which is dissimilar to trademarks already in use in his field of commerce. In *Re Hyper Shoppes, (Ohio), Inc.*, 837 F.2d 643, 6 USPQ2d 1025 (Fed. Cir. 1988). Notwithstanding applicant's argument to the contrary, this

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record establishes that the goods specified in the application are of a type which may emanate from the same source as those listed in the cited registration, and these products would be purchased by the same class of ordinary consumers, namely parents, for related uses in connection with their children.

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