

This Opinion is not a
Precedent of the TTAB

Mailed: July 3, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Board of Trustees of the University of Arkansas
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Serial No. 87427496
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Harold J. Evans of the University of Arkansas System
for the Board of Trustees of the University of Arkansas.

Giancarlo Castro, Trademark Examining Attorney, Law Office 110,
Chris A.F. Pedersen, Managing Attorney.
—

Before Cataldo, Ritchie and Kuczma,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, the Board of Trustees of the University of Arkansas, seeks registration
on the Principal Register of the mark displayed below,



identifying “educational services, namely, providing meetings, seminars and workshops for parents, teachers, childcare providers, and public schools in the area of obesity prevention targeting young children in at-risk environments and the distribution of training material in connection therewith” in International Class 41.¹

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based upon a likelihood of confusion with three registrations issued on the Principal Register to the same entity, including Registration No. 4665725 for the mark WISE KIDS TWO (in standard characters, “KIDS” disclaimed), identifying “printed educational materials in the fields of health, wellness, nutrition, fitness, and physical activity,” in International Class 16; and “educational services for youth, namely, developing activities that promote health, wellness, nutrition, fitness, and physical activity,” in International Class 41,² as to be likely to cause confusion, to cause mistake, or to deceive.

After the Examining Attorney made the refusals final, Applicant appealed to this Board. We affirm the refusal to register.

¹ Application Serial No. 87427496 was filed on April 27, 2017 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intent to use the mark in commerce. The application includes the following description of the mark and color statements: “The mark consists of the drawing of the round face of an owl and the word ‘WISE’ in large letters to the right of the face with the long part of the ‘I’ in WISE replaced by a carrot and below ‘WISE’ are the words ‘we inspire smart eating’. “Color is not claimed as a feature of the mark.”

² Registration No. 4665725 issued on January 6, 2015.

The Examining Attorney also cited Reg. No. 4665726 for the mark WISE KIDS OUTDOORS and Reg. No. 4669686 for the mark WISE KIDS OUTDOORS TWO (both issued on the Principal Register in standard characters, “KIDS OUTDOORS” disclaimed) and both identifying substantially identical goods and services to those listed above.

Evidentiary Matter

Applicant submitted with its appeal brief evidence that is duplicative of the evidence previously submitted with its January 12, 2018 Response to the Examining Attorney's August 1, 2017 First Office Action. We need not and do not give this redundant evidence any consideration. To the extent any of the evidence submitted with Applicant's appeal brief was not previously submitted during prosecution, it is untimely and will not be considered.³ See Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); TBMP § 1203.02(e) and § 1207.01 and authorities cited therein. See also, e.g., *In re I-Coat Co.*, 126 USPQ2d 1730, 1734-35 (TTAB 2018).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d)

³ The proper procedure for an applicant or examining attorney to introduce evidence after an appeal has been filed is to submit a written request with the Board to suspend the appeal and remand the application for further examination. See Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). See also TBMP § 1207.02 and authorities cited therein.

goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

a. Focus on Cited Registration No. 4665725

For purposes of the *du Pont* factors that are relevant to this appeal we will consider Applicant’s involved mark and identified services and the WISE KIDS TWO mark that is the subject of cited Reg. No. 4665725 identifying, *inter alia*, “educational services for youth, namely, developing activities that promote health, wellness, nutrition, fitness, and physical activity.” If likelihood of confusion is found as to the mark and services in this registration, it is unnecessary to consider the other cited registrations. Conversely, if likelihood of confusion is not found as to the mark and services in this registration, we would not find likelihood of confusion as to the mark and services in the other cited registrations inasmuch as the marks in the other registrations contain additional wording that is not present in the mark in the involved application and the services recited in all three cited registrations are closely related. *See In re Max Capital Grp.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

b. Relatedness of the Services and Channels of Trade

With regard to the services, channels of trade and classes of consumers, we must make our determinations based on the services as they are identified in the application and cited registration. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004-05 (Fed.

Cir. 2002); *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). A proper comparison of the services considers whether “the consuming public may perceive [the respective goods or services of the parties] as related enough to cause confusion about the source or origin of the goods and services.” *Hewlett Packard*, 62 USPQ2d at 1004. Therefore, to support a finding of likelihood of confusion, it is not necessary that the services be identical or even competitive. It is sufficient that the services are related in some manner, or that the circumstances surrounding their marketing are such that they would be encountered by the same persons in situations that would give rise, because of the marks, to a mistaken belief that they originate from the same source or that there is an association or connection between the sources of the services. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009).

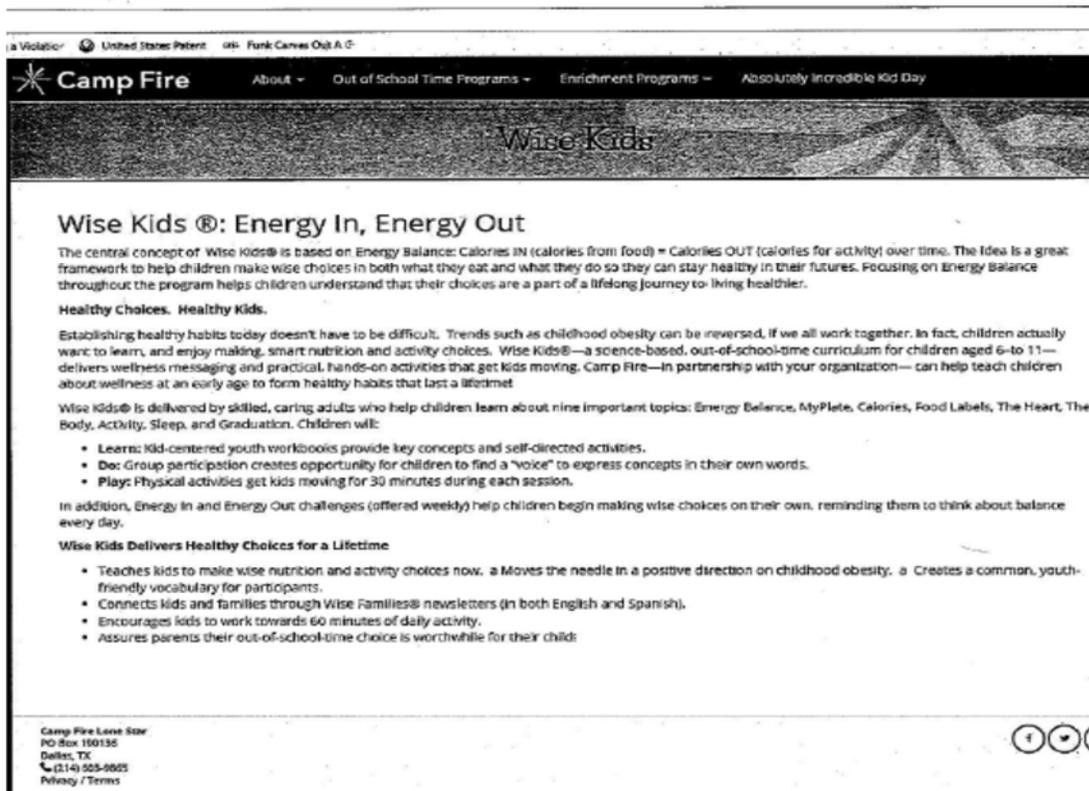
Applicant’s services are “educational services, namely, providing meetings, seminars and workshops for parents, teachers, childcare providers, and public schools in the area of obesity prevention targeting young children in at-risk environments and the distribution of training material in connection therewith” and the services in the cited registration are “educational services for youth, namely, developing activities that promote health, wellness, nutrition, fitness, and physical activity.” These services are related as identified inasmuch as both provide educational services intended to increase health and wellness among children. Applicant’s services are more narrowly identified as targeting young children in at-risk environments, which is of course a subset of the more broadly identified youth in the cited registration.

Applicant's services are specifically directed toward preventing childhood obesity and the services in the cited registration are directed toward promoting health, wellness, nutrition, fitness and physical activity, all of which prevent obesity. We find that Applicant's more narrowly identified educational programs in the field of obesity prevention among young children are essentially included among Registrant's more broadly identified educational services that promote health, wellness, fitness, nutrition and physical activity among youth. *See, e.g., Southwestern Mgmt., Inc. v. Ocinomled, Ltd*, 115 USPQ2d 1007, 1025 (TTAB 2015) (With a broad identification of services, "we must presume that the services encompass all services of the type identified").

In support of its arguments in favor of registration, Applicant introduced into the record a screenshot from the website of the owner of the cited registration, reproduced as Figure 1 below.⁴

⁴ Applicant's January 12, 2018 Response to Office Action at 17.

Figure 1:



The screenshot includes the following language:

- “Establishing healthy habits today doesn’t have to be difficult. Trends such as childhood obesity can be reversed if we all work together.”⁵
- “Wise Kids® – a science-based, out-of-school-time curriculum for children aged 6 to 11 – delivers wellness messaging and practical, hands-on activities that get kids moving.”⁶

⁵ *Id.*

⁶ *Id.* Applicant further made of record a printout from the USPTO’s Trademark Status & Document Retrieval (TSDR) database of Reg. No. 3419657, issued to the owner of the registrations cited herein for the mark WISE KIDS (in standard characters, “KIDS” disclaimed), identifying, *inter alia*, “educational consulting services for youth programming, namely, helping organizations to develop activities that promote health, wellness, nutrition, fitness and physical activity. *Id.* at 9-12.

Applicant's evidence further establishes that the owner of the cited registration provides educational services for young children in the field of obesity prevention, which are nearly identical to the services identified in the involved application.

Applicant argues that the Examining Attorney failed to introduce "any third party evidence that the respective services emanate from a single source under a single mark."⁷ However, the plain language of the respective recitations of services, combined with Applicant's evidence regarding Registrant's activities, clearly establish that the services are closely related, if not overlapping. As we noted above, our likelihood of confusion determination is based upon the services as they are identified in the application and registration at issue. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976). *See also Octocom*, 16 USPQ2d at 1787 ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

In addition, the identifications of services in the cited registration and involved application do not recite any limitations as to the channels of trade in which Applicant's or Registrant's services are or will be offered. In the absence of trade channel limitations on the services under the marks, we must presume that the services in the involved application and cited registration are offered in all customary

⁷ 4 TTABVUE 9.

trade channels. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ at 640. In addition, the services as recited appear to be offered to the same consumers, namely, educators, parents, child care providers and children seeking to prevent childhood obesity and promote health, wellness, fitness, physical activity and nutrition among children.

We find that the *du Pont* factors of the relatedness of the services, channels of trade and consumers weigh in favor of likelihood of confusion.

c. Strength of the Cited Mark / Number and Nature of Similar Marks

WISE KIDS TWO appears to be somewhat suggestive in connection with educational services directed toward smart approaches to services regarding children's health and fitness, as identified in the cited registration. Otherwise, there is no evidence of record to suggest conceptual weakness of the term WISE KIDS TWO. In the absence of any evidence to the contrary, we find that WISE KIDS TWO is inherently strong and otherwise neutral with regard to commercial strength.

This *du Pont* factor is neutral.

d. Similarity or Dissimilarity of the Marks



We consider Applicant's mark  and the registered mark WISE KIDS TWO and compare them "in their entireties as to appearance, sound, connotation and commercial impression." *Stone Lion Capital Partners, LP v.*

Lion Capital LLP, 110 USPQ2d at 1160; *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks omitted). See also *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016). Consumers may not necessarily encounter the marks in close proximity and must rely upon their recollections thereof over time. *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1468 (TTAB 1988).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); see also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular

feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Nat'l Data*, 224 USPQ at 751.



Upon evaluating the mark  and the registered mark WISE KIDS TWO, we find that a prominent feature of the applied-for mark is the term “WISE” and, similarly, “WISE” is a prominent feature of the registered mark. Because this is the first term in each mark, it is most likely to be impressed upon purchasers’ memories. *Presto Products, Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). Furthermore, the term “WISE” in Applicant’s mark appears in much larger font than the comparatively diminutive wording “we inspire smart eating” appearing below. In addition, the wording “we inspire smart eating” is an acronym for “WISE,” further emphasizing the prominence of that term in Applicant’s mark.

There is no evidence of record regarding the possible significance of “WISE” in relation to the identified services in the cited registration aside from the obvious suggestion that health, fitness and nutrition are wise choices for children. With regard to Applicant’s mark, regardless of whether consumers view “WISE” as an acronym for “we inspire smart eating,” the term remains a common English word and retains its significance as connoting that reducing childhood obesity is a wise choice for children, parents and teachers.

Moreover, for source-identifying purposes, consumers will likely focus on the term “WISE” in the registered mark than the highly descriptive and disclaimed term “KIDS.” See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion”) quoting *In re Nat’l Data*, 224 USPQ at 752; *In re Dixie Rests. Inc.*, 41 USPQ2d at 1533-34; *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”). The term “TWO” in the registered mark simply suggests this is the second educational program created by Registrant to promote health, fitness and nutrition among children and youth.

Applicant’s mark comprises both words and a design. The words are normally accorded greater weight, in part because consumers are likely to remember and use the word(s) to request the goods. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012) (“the verbal portion of a word and design mark likely will be the dominant portion”); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (holding that “if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services” and “because applicant’s mark shares with registrant’s mark that element responsible for creating its overall commercial impression, the marks are confusingly similar”). In this case, the design of an owl, an animal often viewed as a totem for wisdom, reinforces the prominence of the term “WISE” and the

carrot forming the letter “I” in “WISE” reinforces the healthy aspects of nutrition. Thus, while we do not discount the presence of the design elements in Applicant’s mark, we also recognize that they serve to reinforce the commercial impression of the wording thereof.

Consumers further are known to use shortened forms of names, and it is possible that Applicant and its services will be referred to as “WISE.” *Cf. In re Abcor Dev. Corp.*, 200 USPQ at 219 (Rich, J., concurring) (“the users of language have a universal habit of shortening full names – from haste or laziness or just economy of words”).

In sum, while we recognize the obvious differences between them, we find the marks in their entireties to be more similar than dissimilar in appearance, sound and meaning and, overall, to convey similar commercial impressions. This *du Pont* factor weighs in favor of finding a likelihood of confusion.

e. Likelihood of Confusion Summary

Considering all the evidence of record, including any evidence not specifically discussed herein, we find that the marks in their entireties are more similar than dissimilar and that the identified services are closely related if not overlapping, and will be encountered in common channels of trade by the same classes of consumers. We find therefore that Applicant’s mark is likely to cause confusion with the mark in the cited registration when used in association with the identified services.

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