

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
EXAMINING DIVISION**

MARK: INFINITY BLUE WATER and Design
APPLN. NO.: 88583984
FILING DATE: AUGUST 19, 2019
APPLICANT: AQUA LIVENS GROUP, S.A.
IC: 032
LAW OFFICE: 108
**EXAMINING
ATTORNEY:** WILLIAM H. DAWE, III

RESPONSE TO OFFICE ACTION OF NOVEMBER 25, 2019

The Examiner has initially refused registration of this Application on the basis of likelihood of confusion, pursuant to §2(d) of the Trademark Act, with two prior registrations: US Registration No. 2782007 for INFINITY WATER and US Registration No. 5229968 for BLUEWATER.

1. Procedural Requirements

a. Identification of the Goods

Applicant amends the term “water” to “drinking water”.

b. Whether “BLUE” has any meaning or significance in the industry in which the goods are manufactured, or if such wording is a “term of art” within applicant’s industry, and to provide additional information regarding the significance of the term BLUE.

The geographic location from which Applicant’s water is obtained in Nicoya, Costa Rica, is known as a “blue zone”. Blue zones are specific geographic areas in a number of countries known for the unusual longevity of their residents, who tend to live well into their nineties or over 100 years of age. These blue zones are located in Okinawa, Japan, Sardinia, Italy, Nicoya, Costa Rica, Icaria, Greece, and Loma Linda, California. The concept derived from a demographic study conducted in 2002-2003

by a team of gerontologists who used a compass and blue pen to create concentric circles around the areas in issue, and called these areas “blue zones”¹.

Nicoya has been recognized by the Costa Rican government as an official blue zone and Applicant is licensed by the Costa Rican government to withdraw and bottle water from wells in Nicoya. Thus, the term BLUE as used in Applicant’s Mark is to indicate that the Applicant’s water is drawn and bottled from a source in an official blue zone.

c. Amendment to the Description of the Mark

Applicant adopts the Examiner’s suggested wording and amends the description of the Mark as follows:

The mark consists of the wording INFINITY BLUE WATER and design; the wording and design are in blue; the term INFINITY appears above the design and the wording BLUE WATER appears below the design; the design has the top left curve beginning in a dark blue point and broadening until it reaches the mid-point of the descent and then narrowing and turning a lighter shade of blue as it curves back around and under the mid-point of the descending line and then forms a fanciful wave design as the bottom left curve, with the wave edges in dark blue and the middle in the lighter blue; and the off white in the drawing represents background and is not part of the mark.

Applicant believes it has now met the three procedural requirements set forth in the Office Action, and respectfully requests that the Examiner withdraw those requirements.

2. No likelihood of confusion with the Prior Registration for BLUEWATER

Based on the foregoing description of the meaning of the term BLUE as to Applicant’s goods, Applicant submits that, coupled with the remainder of the Mark – namely the word INFINITY and

¹ Poulain, Michel; Pes, Giovanni Mario; Grasland, Claude; Carru, Ciriaco; Ferrucci, Luigi; Baggio, Giovannella; Franceschi, Claudio; Deiana, Luca (2004-09-01). "Identification of a geographic area characterized by extreme longevity in the Sardinia island: the AKEA study", *Experimental Gerontology*. 39 (9), 2004.

the fanciful design of an infinity symbol -- there is, and can be, no likelihood of confusion with the prior cited US Registration No. 5229968 for BLUEWATER.

“[C]onflicting marks must be compared in their entireties. A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important. As the Supreme Court observed: ‘The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.’ Thus, as Judge Newman observed: ‘It is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue.’”
McCarthy on Trademarks, §23:41, 5th Ed. (Citations omitted).

The prior cited registration is for the word mark


BLUEWATER

Applicant’s mark is a composite mark consisting of the word the large blue fanciful design of an infinity symbol above the blue word INFINITY in large type in turn above the blue words BLUE WATER in much smaller type:



It is clearly distinguishable from the mark of the prior registrant under the “sound, appearance and meaning” test. Applicant’s Mark consists of seven (7) syllables and is dominated by the large blue fanciful graphic infinity symbol that is the equivalent of the word INFINITY above the word INFINITY in large blue type. Thus, the consumer essentially encounters a large *blue* **INFINITY** *twice* before even getting to the words in issue, which are in substantially smaller typeface, i.e. **BLUE WATER**, and obviously subordinate to the primary portion of the Mark. The prior cited registered mark consists solely of the telescoped term **BLUEWATER**, in three syllables.

“A verbal component is especially likely to dominate a pictorial component when the pictorial component reinforces the connotation of the verbal component.” Callman, *Unfair Competition, Trademarks and Monopolies*, §21:18. “If a composite mark has a dissimilar dominant part, that feature effectively dispels confusing similarity.” *Id.*, citing *Playboy of Miami, Inc. v. John B. Stetson Co.*, 426 F.2d 394 (CCPA 1970); *In re Electrolyte Laboratories, Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990) (“More dominant features will, of course, weigh heavier in the overall impression of a mark.” In this case of conflicting word-design marks, held that the dissimilar designs predominated and there was no likelihood of confusion.). Applicant submits that **INFINITY INFINITY BLUE WATER** differs in sound from **BLUEWATER**.

The Marks, as described above, are also visually dissimilar. Applicant’s use of “**BLUE WATER**” in two words is in comparatively tiny type, in blue, and under a large blue graphic infinity symbol  and large blue word **INFINITY**. Registrant’s mark is a single word, **BLUEWATER**, in regular type.

Applicant submits that the two marks in issue:



and **BLUEWATER**

simply do not look at all alike and are thus visually dissimilar. The immediate dominant visual aspect of Applicant’s mark is the large blue infinity graphic and the large blue word INFINITY:



The immediate visual aspect of the prior registered mark is:

BLUEWATER.

Additionally, Applicant's Mark has a completely different meaning than that of the prior registered mark. According to Dictionary.com², "Infinity" means:

noun, plural in·fin·i·ties.

the quality or state of being infinite.

something that is infinite.

infinite space, time, or quantity.

an infinite extent, amount, or number.

an indefinitely great amount or number.

Mathematics.

1. the assumed limit of a sequence, series, etc., that increases without bound.
2. infinite distance or an infinitely distant part of space.

As applied to Applicant's goods, "INFINITY" is arbitrary. It has no immediate connection to drinking water or bottled water, nor does it suggest or allude to the nature or quality of the goods. BLUEWATER (or BLUE WATER) clearly means water that is blue or, as in Applicant's case, suggests water that originates from a blue zone.

The anti-dissection rule is based upon a common sense observation of customer behavior: the typical shopper does not retain all of the individual details of a composite mark in his or her mind, but retains only an overall, general impression created by the composite as a whole. Moreover, it should be noted that under the overall impression analysis, there is no rule that confusion is automatically likely if a junior user has a mark that contains in part the whole of another's mark. McCarthy, *supra* at §23:41 and cases cited therein.

² Exhibit A

Applicant further submits that the prior registered BLUEWATER mark is weak as applied to the prior registrant's goods, namely "Flavoured waters; aerated water; soda water; still water; bottled drinking water", as there are at least 11 co-existing prior and subsequent registrations and published applications for BLUEWATER and BLUEWATER-variant marks all related to water, water related goods or services, or other beverages in some manner, and all of which emphasize BLUEWATER as the sole or dominant portion of their marks³:

OWNER	MARK	REG./APP NO. REG./PUB. DATE	GOODS/SERVICES
MillerCoors, Ltd. Chicago, IL	FROM THE LAND OF SKY BLUE WATERS	0611870 09/06/1955	Beer
Nexom, Inc. Grafton, WI	BLUE WATER TECHNOLOGIES	3023179 12/06/2005	Water treatment and purification units for removal of ... from ... drinking water
The Wolverine State Brewing Company Ann Arbor, MI	BLUEWATER	4250794 11/27/2012	Beer
Blue Water Resources, LLC Denver, CO	BLUE WATER RESOURCES and design	4457673 12/31/2013	Providing industrial water delivery services
Blue Water Resources, LLC Denver, CO	BLUE WATER RESOURCES	4461112 01/07/2014	Providing industrial water delivery services
Warner's Brother Holdings, LLC Los Angeles, CA	SKY BLUE WATERS	5317426 10/24/2017	Bottled artesian water
Bluewater Bio Ltd. London, UK	BLUEWATER BIO	5663461 01/29/2019	(Various water treatment, purifying and processing equipment, etc.); (treatment, purification, and recycling, etc., of water, etc.)
Granger Plastics Company Middletown, OH	BLUEWATER	5754760 05/21/2019	Water treatment and purification
Bluewater Distilling Everett, WA	BLUEWATER	5888109 10/22/2019	Distilled spirits

³ Exhibit B

Graystone Limited LLC North Easton, MA	BLUEWATER FARMS CRANCRAFTED	87588886 01/30/2018	Non-alcoholic fruit juice beverages
Bluewater Sweden AB Stockholm, SW	BLUEWATER and design	88234433 11/26/2019	Water purifiers for ..drinking water; (various equipment for purification of drinking water)

Importantly, the prior registration for BLUEWATER was issued *in spite* of a prior registration for SKY BLUE WATERS for “Bottled artesian water” and *despite* one prior BLUEWATER BIO registration for water purification and treatment and two prior registrations for BLUEWATER for industrial water delivery services. When one considers that bottled drinking water first needs to go through a purification process and is then distributed, all three of the prior BLUEWATER registrations are far more closely related and likely to cause confusion with the prior cited registration than is Applicant’s mark. Similarly, two different BLUEWATER marks for water purification were approved by the USPTO – one registered and one published -- subsequently to the issuance of the prior cited registration. Finally, three BLUEWATER marks have issued for beer and distilled spirits, all co-existing not only with each other but, again, with the prior cited registration. None of these marks are even remotely similarly to Applicant’s Mark, yet all co-exist with the prior registration. The prior cited registration is clearly a weak mark, entitled only to a narrow scope of protection.

Applicant’s Mark is a strong Mark that is clearly distinguishable from the prior cited registration. Accordingly, on the basis of all of the foregoing, Applicant submits that there is no likelihood of confusion with the prior cited registration for BLUEWATER, and respectfully requests that the Examiner withdraw his refusal to register the Mark on the basis of US Registration 5229968.

3. Both Prior Cited Registrations Are the Subject of Pending Cancellation Actions and Suspension is Requested

Finally, Applicant wishes to advise the Examiner that both cited prior registrations are the subject of pending cancellation actions. Cancellation No. 92072918 was filed by Applicant on December 3, 2019 against the '007 registration on the grounds of abandonment. Cancellation No. 92070049, brought by a third party, is presently pending against the '968 registration. Accordingly, Applicant requests that further examination of this Application be suspended pending resolution of Cancellation No. 92072918.

In the event the Examiner does not withdraw the refusal to register in light of prior cited Registration No. 5229968, then Applicant similarly requests that this Application be suspended pending resolution of Cancellation No. 92070049.

Respectfully submitted,

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