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CEW

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Tanning Research Laboratories, Inc.
v.
The Black Prince Distillery, Inc.

Opposition No. 91,299
to application Serial No. 74/225,123
filed on November 25, 1991

John W. Behringer and Thomas J. O'Connell of Fitzpatrick,
Cella, Harper & Scinto for Tanning Research Laboratories,
Inc.

Richard L. Kirkpatrick of Cushman, Darby & Cushman for The
Black Prince Distillery, Inc.

Before Cissel, Hanak and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Introduction

Tanning Research Laboratories, Inc. filed its
opposition to the application of The Black Prince

Distillery, Inc. to register the mark HAWAIIAN TROPICAL for "vodka."¹

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered marks HAWAIIAN TROPIC and HAWAIIAN TROPIC and various designs, as shown below, as to be likely to cause confusion under Section 2(d) of the Trademark Act.

Registration No. 1,083,788 is for the mark HAWAIIAN TROPIC for "cosmetic preparations, namely, sun screens, tanning oils and lotions and wind screens,"²

Registration No. 1,083,790 is for the mark shown below for "cosmetic preparations, namely, sun screens, tanning oils and lotions and wind screens,"³



¹ Application Serial No. 74/225,123, filed November 25, 1991, based upon the assertion of a bona fide intention to use the mark in commerce in connection with the identified.

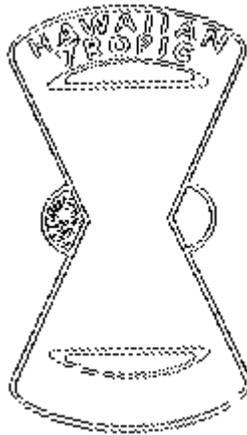
² Registered January 31, 1978 (Section 8 accepted; Section 15 filed). The registration certificate includes a disclaimer of the term HAWAIIAN apart from the mark as a whole.

³ Registered January 31, 1978 (Section 8 accepted; Section 15 filed). The registration certificate includes a disclaimer of the term HAWAIIAN apart from the mark as a whole.

Registration No. 1,239,074 is for the mark HAWAIIAN TROPIC for "hand and body lotions,"⁴

Registration No. 1,239,075 is for the mark HAWAIIAN TROPIC for "hair care products, namely, shampoo and hair conditioners,"⁵

Registration No. 1,239,081 is for the mark shown below for "suntanning oils,"⁶



Registration No. 1,485,357 is for the mark HAWAIIAN TROPIC for "clothing, namely, swimwear, caps, sun

⁴ Registered May 24, 1983 (Section 8 accepted; Section 15 filed). The term HAWAIIAN is registered under Section 2(f) of the Act.

⁵ Registered May 24, 1983 (Section 8 accepted; Section 15 filed). The term HAWAIIAN is registered under Section 2(f) of the Act.

⁶ Registered May 24, 1983 (Section 8 accepted; Section 15 filed). The term HAWAIIAN is registered under Section 2(f) of the Act.

visors, rompers, shorts, tops, tank tops, cover-ups, polo shirts, pants and dresses,"⁷

Registration No.1,678,353 is for the mark HAWAIIAN TROPIC for "sunglasses."⁸

Applicant, in its answer, denied, or indicated its lack of knowledge regarding, the salient allegations of the likelihood of confusion claim.

Motion to Amend Notice of Opposition

In its original notice of opposition, filed April 21, 1993, opposer alleged ownership of the registrations identified herein and submitted title and status copies of them, certified by the PTO, variously, on January 25, 1993, and February 23, 1993. Each indicates ownership in opposer. Applicant, during its testimony period, submitted, under notice of reliance, a copy of an assignment document in which opposer assigned to two banking institutions, *inter alia*, opposer's trademarks and the federal registrations thereof. The assignment document is dated October 7, 1992, and was recorded at the PTO on September 24, 1993. Thereafter, the Board granted opposer's motion to amend its notice of opposition to correct its allegation of ownership of the pleaded registrations to allege that it is the exclusive licensee of, and the holder of the exclusive right

⁷ Registered April 19, 1988 (Section 8 accepted; Section 15 filed). The registration certificate includes a disclaimer of the term HAWAIIAN apart from the mark as a whole.

to use, such marks. The Board directed applicant to answer the amended notice of opposition, which it did.

Additionally, the Board re-opened discovery, limiting it to issues pertaining to ownership and control, and reset the trial dates.

On March 7, 1995, during the reopened discovery period and prior to the start of trial, as reset, opposer again moved to amend its notice of opposition to allege that it is the owner of the pleaded registrations, under an agreement transferring back to opposer ownership of the marks herein and the federal registrations of those marks. The assignment document is dated September 6, 1994, was recorded at the PTO on September 28, 1994, submitted in this proceeding as an exhibit to opposer's motion, and submitted at trial under opposer's notice of reliance. In its motion, opposer indicates its belief that applicant will not be prejudiced by this amendment as opposer has previously served notice of this assignment upon applicant in response to discovery requests. Applicant filed its answer to the second amended notice of opposition.

There is no indication in the record that the Board has considered opposer's second motion to amend its notice of opposition. However, we infer applicant's implicit consent to the proposed amendment from the fact that applicant did

⁸ Registered March 10, 1992. The registration certificate includes a disclaimer of the term HAWAIIAN apart from the mark as a whole.

not object to the motion and, instead, answered the second amended notice. Further, there is no indication of prejudice to applicant as the trial proceeded herein, without objection, on the basis of the notice of opposition and answer as so amended. Therefore, we grant opposer's second motion to amend its notice of opposition.

The Record

The record consists of the pleadings; the file of the involved application; a title and status copy of each of opposer's pleaded Registrations, Nos. 1,083,788, 1,083,790, 1,239,074, 1,239,075, 1,239,081, 1,485,357 and 1,678,353, all submitted with the original notice of opposition; a copy of a termination of security interest agreement between opposer and two banking institutions,⁹ a copy of a TrademarkScan Search Report,¹⁰ and responses of applicant to opposer's first set of interrogatories and to opposer's first set of requests for admissions, all made of record by opposer's notice of reliance; copies of third-party registrations, copies of excerpts from certain printed publications, a copy of the assignment records of the PTO with respect to opposer's pleaded registrations, all made of

⁹ While not properly of record by way of notice of reliance, we will consider this agreement as part of the record as applicant has not objected either to the introduction of this evidence by notice of reliance or to opposer's claim of ownership of the registrations asserted herein. Further, applicant is not prejudiced thereby as, regardless of whether the record establishes that opposer is the owner of the marks asserted herein, the record does establish opposer's standing herein.

record by applicant's notice of reliance; and the testimony depositions of John Surrette, opposer's Vice President of Marketing and Development, and Weston Anson, the Chairman of the Board of Trademark & Licensing Associates, Inc., opposer's witness, both with accompanying exhibits. Both parties filed briefs on the case and participated in the oral arguments at final hearing.

Opposer's Pleaded Registrations

Opposer did not submit, under notice of reliance, updated status and title copies of its pleaded registrations. However, both parties treat the pleaded registrations as being of record, with opposer as owner thereof. Further, the record contains sufficient evidence regarding the transfers of ownership of the pleaded registrations since the date of opposer's submission of status and title copies of those registrations for us to conclude that the pleaded registrations are properly of record herein, and that they are presently owned by opposer.

Opposer's Expert Testimony

Weston Anson, Chairman of the Board of Trademark & Licensing Associates, Inc. testified that, on behalf of opposer, he had employed a Valumatrix™ technique¹¹ and evaluated "the potential confusion and damages as they

¹⁰ This report is not properly of record herein and will not be considered.

¹¹ A technique developed by Mr. Anson by which he looks at a number of factors to determine the strength of a mark.

affect the HAWAIIAN TROPIC trademark, and the potentially competing trademark Hawaiian Tropical" (Anson report, p. 3, opposer's trial exhibit no. 23); and, using the same technique, he had evaluated the strength of the HAWAIIAN TROPIC mark. In his report, Mr. Anson states "we have reviewed packaging, labeling and advertising materials from HAWAIIAN TROPIC and from Black Prince's Hawaiian Tropical. We also had access to revenue, and sales and marketing data from TRL. We have prepared an extensive list of questions and information requests for TRL." (Opposer's trial exhibit no. 23, p. 4.) However, Mr. Anson acknowledged, in his trial deposition (p. 56-59), that he reviewed no financial documents; that his conclusions regarding applicant's marketing plans were based only upon applicant's proposed label design (opposer's trial exhibit no. 18) and his own assumptions; and that he did not conduct a consumer survey or undertake a market sample. Rather, he based his analysis and conclusions regarding the strength of opposer's mark on information obtained from conversations with opposer's employees and several promotional brochures (Anson trial deposition, pps. 56-58).

Regarding the strength of the HAWAIIAN TROPIC marks, Mr. Anson's report contains no list of questions asked of opposer or other information about the nature of the information requested or obtained from opposer in connection

with his analysis. We do not know from this record the extent to which the information relied upon by Mr. Anson is the same as, and consistent with, the evidence before us. For this reason, we find the conclusions drawn by Mr. Anson regarding the strength of the HAWAIIAN TROPIC mark as part of his various analyses to be of extremely limited value.

Further, we find Mr. Anson's conclusions concerning likelihood of confusion and potential damages to be of no probative value. His conclusions are, essentially, opinions on the ultimate issue of whether applicant's mark is registrable. As stated by the Board in *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 919 (1983):

Such evidence on the ultimate issue . . . is of little or no probative value since the Board is charged with the responsibility of making an independent determination of the issue based on an evaluation of the evidence . . . To give significant weight to these affidavits would have the effect of substituting the opinion of the affiants for those of the Board members assigned to hear the case and would be improper. (citations omitted.)

The Parties

According to the record, applicant primarily produces distilled spirits, with the bulk of its business east of the Mississippi. Applicant has been in the distilled spirits business since the end of Prohibition, selling vodka, gin, bourbon and cordials. Applicant is planning to use the mark herein in connection with a pineapple-flavored vodka,

although the mark is not in use yet. Applicant has previously used the mark ISLAND SPLASH in connection with a tropical punch liqueur and is presently using the mark LORD'S TROPICAL COCONUT in connection with a liqueur.

Applicant markets its goods through what it characterizes as "customary" trade channels to primary wholesalers, distributors and state liquor boards. Applicant usually advertises through the distribution to retailers of point of purchase displays including coupon rebates, case cards and shelf talkers. Applicant indicated its intention to use the following label design on its product (opposer's Trial Exhibit No. 18, showing a label design in which the lettering is gold, the border around the oval is royal blue and the sky and water in the oval are, respectively, blue-green and turquoise):



According to the testimony of Mr. Jack Surrette, opposer's vice president of Marketing and Development, opposer primarily manufactures suncare products under the trademark HAWAIIAN TROPIC and its products are distributed

throughout the United States.¹² In 1969, opposer began marketing a line of five or six HAWAIIAN TROPIC suncare products and has expanded to a line of 40 products today. It's best selling products, both in 1993 and overall, are a self-tanning milk and a dark tanning lotion. Opposer's 1992 product catalog (opposer's Trial Exhibit No. 1), which is distributed to retailers, shows some of the HAWAIIAN TROPIC line of products, which are packaged in bottles in a wide variety of colors, only one of which is either a clear bottle with blue contents or a blue bottle.¹³ Each bottle prominently displays the HAWAIIAN TROPIC mark in the following format:¹⁴



Opposer manufacturers health and beauty products which are sold under marks other than HAWAIIAN TROPIC; however, in

¹² Opposer has submitted evidence to establish, also, use and registration of the mark worldwide; however, this is not relevant to our determination and will not be considered.

¹³ In addition, opposer's Trial Exhibits Nos. 19 and 20 are, respectively, a dark blue bottle of sunblock and a medium blue tube of sunblock.

¹⁴ We noted only one bottle, Opposer's trail exhibit No. 19, which depicted the HAWAIIAN TROPIC mark in a different script, although the term HAWAIIAN still appeared above the term TROPIC, which retained the palm tree-like "T."

1993 alone, opposer's HAWAIIAN TROPIC product sales accounted for more than fifty percent of opposer's total sales.¹⁵ Additionally, opposer licenses its HAWAIIAN TROPIC mark for use on products associated with suncare products, in particular, t-shirts, swimwear, hats and sunglasses, to generate exposure as well as revenue. Mr. Surrette reports total profits for all of opposer's products of \$260 million since 1969, with more than a third of that total generated in the last five years.

For the past fifteen years, opposer has vied for the number two position in the suncare products industry. Its major competitors are Schering Plough, manufacturers of COPPERTONE products, and Proctor & Gamble, manufacturers of BAIN DE SOLEIL products.

Opposer's products are sold through what Mr. Surrette describes as "traditional" trade channels, specifically, opposer sells its products to distributors, who sell, in turn, to drug stores, mass merchandisers and grocery stores, and to hotels and resorts for resale in hotel and resort stores, and by lifeguards at poolside. Opposer describes its products as relatively inexpensive, selling at retail for between five and nine dollars.

Mr. Surrette reports that opposer has spent at least \$30 million in advertising its HAWAIIAN TROPIC suncare

¹⁵ Mr. Surrette's testimony reflects various estimates regarding the percentage of opposer's total sales which represent sales of HAWAIIAN

products since 1969, with at least a third of that expenditure in the last five years. Opposer concentrates its advertising in print media nationwide, followed by advertising on radio and, regionally, on billboards. Opposer's primary target audience is females aged 25 and below, with advertising in magazines such as *Cosmopolitan*, *Mademoiselle* and *Glamour*. However, opposer is expanding its primary target audience to include males aged 25 and below, with advertising primarily in surfing magazines. Opposer's advertising imagery and theme is "fun in the sun."

Mr. Surette testified that opposer conducts promotional events, the centerpiece of which is its Miss HAWAIIAN TROPIC International beauty pageant. This contest began in 1983 and consists, each year, of numerous local and regional competitions culminating in a competition of finalists. The local and regional beauty competitions often take place in bars and beach pavilions and often have co-sponsors, including soft drink companies, beer companies, movie studios and local businesses. While Mr. Surette testified that opposer conducts many additional promotionals, including joint promotionals with alcoholic beverage companies, the evidence regarding the exact nature and duration of these promotionals is vague. The record includes evidence of a 1991 Miller Pro Beach Volleyball

TROPIC products, from a low of 50% to a high of 80%.

tournament, of which opposer was one of three cosponsors (opposer's Trial Exhibit No. 13) and photographs of auto racing promotionals featuring race cars bearing the HAWAIIAN TROPIC mark along with other marks, with written indications that the photos were taken at the 1989 LeMans auto race and at several auto races in 1991 (opposer's Trial Exhibit No. 16). The record includes printer's proofs of advertisements jointly featuring opposer's mark and Yamaha water vehicles (opposer's Trial Exhibit No. 17), Doritos Tortilla Chips and Lite Beer (opposer's Trial Exhibit No. 18), Hiram Walker Liqueur (in 1991) (opposer's Trial Exhibit No. 9), and Seagrams Seven Crown (in 1990) (opposer's Trial Exhibit No. 10). Except as indicated herein, there is no evidence as to when these advertisements appeared, for what period of time, under what circumstances, or to what extent the public was aware of these joint promotional efforts.

Mr. Surrette indicated that in 1994 opposer was involved in a joint promotional effort with Gordon's vodka featuring a "beach party" theme (opposer's Trial Exhibit No. 7). The brochure of record, directed to retailers, includes photos of point of purchase advertising displays, a banner and promotional items. Of particular interest in the brochure is a photo of what Mr. Surrette characterizes as a "sampling promotion," which is, apparently, a bottle of Gordon's vodka to be sold with a small container of

opposer's sunblock lotion attached to the front of the Gordon's bottle. The caption under the picture states ".25 oz. Hawaiian Tropic Vodka and Citrus Vodka On-Pack (Where permitted by law)."¹⁶

Priority

Inasmuch as certified copies of opposer's registrations and subsequent ownership information, as noted herein, are of record, there is no issue with respect to opposer's priority. See, *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Further, applicant does not contest opposer's priority.

¹⁶ While this advertisement would appear to show a promotion of vodka identified by opposer's mark, we note Mr. Surrette's statement (trial deposition, p. 177) that opposer has never sold or manufactured a beverage under the HAWAIIAN TROPIC trademark. Therefore, we must conclude that, in this advertisement, HAWAIIAN TROPIC is intended to identify only opposer's suncare products.

Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) must be 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. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

With respect to the marks, the only difference between applicant's mark, HAWAIIAN TROPICAL, and opposer's word mark, HAWAIIAN TROPIC, is the "AL" ending to TROPIC in applicant's mark. The marks are visually and auditorily very similar. There is no evidence that the added ending gives applicant's mark a meaning or connotation different from opposer's mark. There is no question that applicant's mark and opposer's word mark are so similar that the commercial impression of these marks is essentially the same.

Opposer's Registration Nos. 1,083,790 and 1,239,081 and evidence of use also show opposer's design marks incorporating HAWAIIAN TROPIC. We find that the words HAWAIIAN TROPIC comprise the dominant portion of such marks so that the commercial impression of applicant's mark, HAWAIIAN TROPICAL, and opposer's marks, HAWAIIAN TROPIC and various designs, remains essentially the same.

Opposer contends that applicant's proposed bottle label (opposer's Trial Exhibit No. 18), as described herein, demonstrates applicant's intent to use a label design similar to one of opposer's label designs. Applicant contends, on the other hand, that applicant has not copied opposer's marks or label design, and that applicant has not intended to copy opposer's marks or label design.

The twenty trial exhibits accompanying Mr. Surette's deposition support the conclusion that no single color dominates the marketing of opposer's suncare products.¹⁷ While blue is one color used by opposer for its suncare product bottles, the evidence shows only three such uses out of numerous different bottle color schemes in the record. In addition to what appears to be a clear bottle with bright blue contents, pictured in opposer's Trial Exhibit No. 1, opposer's Trial Exhibits Nos. 19 and 20 are, respectively, a dark blue bottle of sunblock and a medium blue tube of sunblock. Thus, it is clear that not even one particular shade of blue dominates the marketing of opposer's very few products that are actually packaged or bottled in "blue."

Likewise, opposer presents the words HAWAIIAN TROPIC in a variety of colors on the packaging for its suncare products shown in the record. While gold, the color used by

¹⁷ For example, opposer's Trial Exhibit No. 1, a brochure picturing many of opposer's suncare products, shows bottles of various colors and color schemes including pink, white/orange, white/red, white/blue, gray/green, dark brown, beige, red, and green.

applicant for the lettering on its proposed label, is one of the colors used by opposer, the evidence does not warrant the conclusion that opposer predominantly uses the color gold for the lettering on its packaging or that gold lettering dominates the marketing of opposer's suncare products.¹⁸ Thus, the fact that applicant's proposed bottle label is primarily blue with gold lettering, does not, alone, warrant a conclusion that applicant proposes to use a bottle label that is similar to, or a copy of, opposer's labels.

Further, color aside, in comparing opposer's marks, HAWAIIAN TROPIC and designs, as presented in Registration Nos. 1,083,790 and 1,239,081 and as shown in the record, to applicant's proposed label design, we conclude that applicant's proposed bottle label is not so similar, overall, to opposer's design marks as registered, or to any of its label designs in the record, as to evidence an intent to copy.

Regarding the other *duPont* factors, opposer contends that its HAWAIIAN TROPIC marks enjoy a substantial

¹⁸ For example, opposer's aforementioned advertising brochure, Trial Exhibit No. 1, presents the words HAWAIIAN TROPIC on its cover in red letters with a mustard-yellow background. The lettering appears on the different products shown in the brochure in gold, blue, silver, beige, red, black and white. Opposer's joint promotional efforts include a brochure with Gordon's vodka, wherein the words HAWAIIAN TROPIC are shown, separately, in red, silver and blue (opposer's Trial Exhibit No. 7); a proof of an advertisement with Doritos, wherein the words HAWAIIAN TROPIC are shown in red (opposer's Trial Exhibit No. 8); and a proof of an advertisement with Hiram Walker Liqueurs, wherein the words HAWAIIAN

reputation in connection with suncare products; that opposer has expanded its use of its marks through royalty-based licensing from health and beauty aids to lines of clothing, sunglasses, swimwear and wristwatches; that there are no other registrants of HAWAIIAN TROPIC for any goods or services; that, while the goods of the parties are different, both parties' goods are low-cost, impulse purchases that are likely to move through the same trade channels and be advertised in the same trade media; and that opposer heavily advertises and promotes its suncare products jointly with various brands of alcoholic beverages.

On the other hand, applicant contends that the parties' goods are substantially different; that the advertising media and channels of trade for the parties' goods differ; that neither party's goods are impulse purchases; that any renown enjoyed by opposer's marks is in connection with suncare products only; that opposer's mark is inherently weak as it is composed of descriptive words; that, in connection with both alcoholic and non-alcoholic beverages, there are many third-party registrations of marks that include HAWAII(AN) or TROPIC(AL) as these terms suggest a refreshing fruit-flavored drink; that, in connection with suncare and beauty products, there are many third-party registrations of marks that include HAWAII(AN) or TROPIC(AL)

TROPIC are shown, separately, in blue and in either gold or silver (opposer's Trial Exhibit No. 9).

because of the descriptive or highly suggestive connotations of these words; that there is no evidence that any one entity produces both sun-care products and alcoholic beverages; that joint promotions do not create trademark rights in the joint promoter's field; and that the scope of protection of this highly suggestive mark is limited and, therefore, the broad protection sought by opposer is unwarranted.

Neither party contends that their products are similar, related, or competitive - and we agree. However, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each party's goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

Both parties have addressed the question of the strength of opposer's HAWAIIAN TROPIC marks and the number and nature of similar marks in use on similar goods. In

this regard, the record shows numerous third-party registrations of marks¹⁹ that include either HAWAII(AN) or TROPIC(AL) in connection, separately, with suncare products, beauty products, fruit and beverages.²⁰ Several of these registrations include disclaimers of HAWAII(AN) and we note that each of opposer's registrations includes either a disclaimer of, or Section 2(f) claim in relation to, HAWAIIAN. Further, the articles made of record by applicant demonstrate the common use of the phrase HAWAIIAN TROPICAL in many different contexts to refer to the tropical climate of Hawaii or to suggest a tropical climate or atmosphere. We find that the individual terms HAWAII(AN) and TROPIC(AL) are commonly used in connection with the types of goods sold by opposer and intended to be sold by applicant; that, in connection with suncare products, these terms are highly suggestive of a warm, sunny climate where such goods would be used; that, in connection with beverages, these terms are

¹⁹ We have not considered opposer's copy of its search report, submitted under its notice of reliance. In order to make registrations of record, soft copies of the registrations themselves, or the electronic equivalent thereof, i.e., printouts of the registrations taken from the electronic records of the Patent and Trademark Office's (PTO) own data base, must be submitted. See, *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992).

²⁰ It is well-established that third party registrations, while incompetent to establish that the marks shown therein are in use, may be competent to show that others in a particular area of commerce have adopted and registered marks incorporating a particular term; and that such term has a normally understood meaning or suggestiveness in the trade. *In re Hamilton Bank*, 222 USPQ 174 (TTAB 1984) and cases cited therein. Of the marks represented by the third-party registrations submitted by applicant, 11 include the term HAWAII(AN) and 17 include the term TROPIC(AL) in connection with suncare products; 9 include the term HAWAII(AN) and 14 include the term TROPIC(AL) in connection with

highly suggestive of a tropical fruit flavoring for a beverage; and that these aforementioned suggestive connotations remain the same when the two words are combined, as in applicant's and opposer's marks.

However, in view of opposer's evidence of its long and extensive use of its HAWAIIAN TROPIC marks in connection with suncare products and opposer's statement that it is among the top three sellers of suncare products in the United States, we find that opposer has established that its marks enjoy a strong reputation in connection with suncare and related beauty products. We agree with applicant, however, that there is no evidence that this renown extends beyond the field of suncare products.

We note opposer's use and registration of its HAWAIIAN TROPIC marks in connection with swimwear, clothing and sunglasses and find this to be a logical expansion of opposer's business into obvious collateral products. However, we do not believe that anyone would expect the manufacture or distribution of alcoholic beverages to be within the natural scope of expansion of opposer's business, regardless of whether we consider opposer's business in connection with suncare products, other beauty products, and/or clothing and sunglasses. *See, Ritz Hotel v. Ritz Closet Seat Corp.*, 17 USPQ2d 1466, 1470 (TTAB 1990).

beauty products; 23 include the term HAWAII(AN) and 28 include the term TROPIC(AL) in connection with fruits and beverages.

While we agree with opposer that the ultimate purchaser of both parties' products is the same, namely, the general population, we agree with applicant that the parties' products are usually sold in entirely different establishments. Opposer states, and applicant does not dispute, that, in some states, the law permits distilled spirits to be sold in establishments other than liquor stores, whether operated privately or by the state, but the record contains no evidence as to the extent or circumstances of such sales. Conversely, except for the joint promotional effort with Gordon's vodka, there is no evidence that opposer's goods are ever sold by the customary sellers of distilled spirits, such as liquor retailers or state liquor boards. Opposer's primary argument concerning channels of trade appears to be that lifeguards at resort pools sell opposer's suncare products and that applicant's product could be served at bars adjacent to the same pools. However, again, opposer has submitted no evidence concerning the extent and circumstances of sales of its products poolside or the extent to which customers purchasing, at poolside, drinks containing distilled spirits are exposed to, or are aware of, the brand names of the distilled spirits contained in those drinks. Thus, we conclude that, except in a minority of situations, opposer's and applicant's goods travel in very different channels of

trade. Even if applicant's and opposer's goods are sold in some of the same stores or resorts, we doubt that this fact would augment the likelihood of consumer confusion.

Both applicant and opposer argue about whether the parties' goods are impulse purchases, although neither party submitted evidence on this point. Opposer has testified that its products are relatively low-cost items and it is likely that applicant's goods are not high price items. Thus, it is reasonable for us to conclude that the purchase of either party's goods does not require much purchasing sophistication or involve significant deliberation. However, in view of the significant differences between the goods of the parties, we do not find this factor particularly useful to our analysis.

The remaining question of any significance is whether the fact that opposer has conducted joint promotional events and co-sponsored events with alcoholic beverage companies favors a finding of likelihood of confusion in view of the strong similarities between the parties' marks and the fact that alcoholic beverages may be consumed in the same places where consumers are using opposer's suncare products.²¹ We answer this question in the negative.

²¹ While neither party directly addressed this point, there is no question that many activities, including the consumption of alcoholic beverages, take place in conjunction with the use of suncare products. However, the use of suncare products is likely to be merely incidental to the other activities, even those taking place on a beach.

In general, it is likely that consumers are accustomed to seeing co-sponsored events of the type described by opposer, with the different trademarks of the co-sponsors on display. The mere fact that consumers will see the trademarks of the co-sponsors displayed together at a single event, or as part of a joint promotional effort, does not lead to the conclusion that consumers will associate these trademarks so that confusion as to source arises. While an association may be made by consumers, absent other factors pointing to a likelihood of confusion, consumers are likely to merely associate the parties as co-sponsors of an event, or as co-advertisers, not associate the parties as a single or related source of the goods identified by the respective marks. It is common sense that joint promotional efforts will involve companies with non-competing goods and strong trademarks so that the companies will realize jointly the benefit of their shared advertising without confusing consumers as to the source of the goods jointly advertised. Similarly, a primary reason for sponsoring an event is to obtain brand exposure among the trademark owner's targeted market. The fact that two very different products may be marketed to the same group and identified by similar marks does not necessarily lead to a likelihood of confusion.

One case upon which opposer relies is *K2 Corporation v. Philip Morris, Inc.*, 192 USPQ 174 (TTAB 1976). In this

case, opposer was the largest manufacturer of skis sold in the United States, a manufacturer of related ski equipment and collateral products, and the owner of the well-known registered mark K2. Applicant, a major cigarette manufacturer and owner of the registered mark BENSON & HEDGES, applied to register the mark K2 for cigarettes. Both opposer and applicant had shared in the sponsoring of professional ski racing. In fact, applicant had sponsored a series of professional ski races under the name Benson & Hedges (100's) Grand Prix, as well as some individual races during several racing seasons. Opposer had sponsored one or more skiers in applicant's series of races and had sponsored one individual race during the same racing seasons. The Board found that, as both parties' marks were prominently and repeatedly displayed at each of the races, a substantial number of people ("millions") interested in ski racing had been exposed to the association of opposer and applicant through the use of the symbols K2 and BENSON & HEDGES; and that an association of cigarettes with professional ski racing had been fostered. In finding a likelihood of confusion, the Board concluded (at p. 178):

Among this group of persons, a significant number may assume from the sale of K2 cigarettes that applicant has acquired [opposer] . . . and has extended the use of K2 from skis and skiing equipment to cigarettes as a natural outgrowth of applicant's involvement in ski racing for a number of years. Others, who may or may not be cognizant of applicant's identity as the manufacturer of

BENSON & HEDGES cigarettes, could and probably would assume there is some kind of relationship, such as a license, between the owner of a well-known mark such as K2 for skis and the seller of a newly introduced consumer product which is identified by the identical trade symbol, particularly in the light of the established and well-publicized relationship involving a cigarette manufacturer, even one whose identity may not be known, and the manufacturers of skis and skiing equipment in the sport of skiing. Some naive persons might even believe that opposers have entered the cigarette field and are directly responsible for K2 cigarettes.

The Board found the probability for misunderstanding enhanced by the fact that skis and skiing equipment and cigarettes had been advertised at the same time in the same magazines and, thus, had been promoted to the same audience; and that applicant was a major conglomerate corporation manufacturing and selling diverse products and, thus, applicant's use of K2 for cigarettes would be perceived as an indication of an extension of its commercial interests to sporting goods (which was reinforced by applicant's long association with sporting events).

The cited case differs from this case in several important respects. First, unlike the cited case, neither party herein is a major conglomerate corporation manufacturing and selling a large range of diverse products such that the use of similar marks on very different products is likely to be perceived as an extension of the conglomerate's commercial interests.

Second, the cited case involves a distinct field, namely, professional ski racing, in which both parties were heavily involved as sponsors; with opposer's products, skis and ski equipment, being central to the sport. In this case, on the other hand, there is no distinct "field" with which both opposer and applicant, or the goods identified by their marks, are strongly associated. While opposer sponsors a beauty pageant, opposer is not strongly associated, generally, with beauty pageants and opposer's HAWAIIAN TROPIC suncare products are only, at best, tangentially related to beauty pageants.²²

Third, in the cited case, both parties' marks are well-known, with applicant's mark being well-known for cigarettes and strongly associated with professional ski racing, and opposer's mark being well-known for goods that are integral to professional ski racing. In the instant case, there is no evidence that applicant or any of applicant's marks are well-known in the alcoholic beverages field or beyond; or that applicant has associated its name or any of its marks with beauty pageants or with suncare or related beauty products. Nor is there evidence that alcoholic beverages in general, or other specific alcoholic beverage brand names, would be strongly associated with beauty pageants in general, or with opposer's beauty pageant.

²² With the exception of opposer's own promotional event, the HAWAIIAN TROPIC pageant.

The facts in this case simply do not warrant the conclusion that a significant number of people are likely to assume, mistakenly it turns out, that the products of the parties emanate from a common source, or are sponsored by or affiliated with a common source, because of the similarities between the marks. We are not persuaded otherwise by the fact that opposer has conducted a few joint promotional efforts with alcoholic beverage companies, cosponsored a few wide-ranging types of events, and held its own beauty pageant with the support of bars and many different types of companies, including beer companies. Opposer has not met its burden of proof with respect to its claim of likelihood of confusion. Based on the record before us, we conclude that, despite the similarities between the parties' marks and the strength of opposer's mark in the suncare and related beauty products field, the differences between the goods as identified and the channels of trade are sufficient that purchasers are not likely to be confused. The likelihood of confusion claimed by opposer amounts to only a speculative, theoretical possibility. *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed Cir. 1992).

Decision: The opposition is dismissed.

R. F. Cissel

E. W. Hanak

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board

Opposition No. 91,299