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HRW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB NOV. 29, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re California SunCare, Inc.

Serial No. 75/324,702

Norm D. St.Landau and Kristine M. Miller
of Tucker, Flyer & Lewis for California SunCare, Inc.

Gerald C. Seegars, Trademark Examining Attorney, Law Office
106 (Nancy Hankin, Senior Attorney).

Before Quinn, Walters and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

California Suncare, Inc. has filed an application to
register the mark HOT CHOCOLATE for skin care products,
namely, tanning lotions.¹

Registration has been finally refused under Section
2(d) of the Trademark Act, on the ground of likelihood of
confusion with the registered mark HOT CHOCOLATE for

cologne.² Applicant and the Examining Attorney have filed briefs and both participated in an oral hearing.

Here, as in any determination of the likelihood of confusion, two key considerations in our analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods with which the marks are being used. See *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

The marks involved are obviously identical in both sound and appearance. The only question is whether the identical mark HOT CHOCOLATE evokes a different commercial impression or conveys a different connotation when applied to the specific goods of the application and registration.

Applicant argues that its mark HOT CHOCOLATE, as used in connection with tanning lotions, brings to mind images of heat, the hot sun, and the "rich chocolate-brown color of exotic women who spend all their time basking in the island sun." (Brief pg. 2-3). By contrast, the registered mark HOT CHOCOLATE is said to imply that the cologne with which it is used has a chocolate aroma or scent or to at least evoke the image of "steaming hot chocolate and all the memories associated therewith." (Brief p. 3).

¹ Serial No. 75/324,702, filed July 15, 1997, based on an allegation of a bona fide intention to use the mark in commerce.

The Examining Attorney, on the other hand, contends that the mark HOT CHOCOLATE, whether used on a tanning lotion or a cologne, would bring to mind the beverage and the pleasant aroma thereof.

We agree that the most likely interpretation of HOT CHOCOLATE in either case would be as the name of the beverage. We see no reason for purchasers to make any distinction in connotation when viewing the mark on the two products. While "chocolate" alone might be construed as the skin color hoped to be obtained by use of a tanning lotion, we believe the term "hot chocolate" is much more likely to be perceived as a reference to the beverage. Although it is questionable whether the aroma of "hot chocolate" would be literally associated with either product, if it were, such an aroma would certainly be applicable to a tanning lotion, which often contains cocoa butter. Contrary to the cases cited by applicant, we do not find the goods involved here to be such as to lead to different commercial impressions when the identical mark is used thereon. Cf. *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312 (TTAB 1987) [different meanings are projected by the

² Reg. No. 1,252,016, issued September 27, 1983. Section 8 & 15 affidavits accepted and acknowledged, respectively.

mark CROSSOVER when used on brassieres and on ladies' sportswear, respectively].

Turning to the goods, applicant argues that the tanning lotions of applicant and the colognes of registrant are different products used for different purposes and are marketed through different channels of trade. Applicant states that its tanning lotions are only available at tanning salons and resort beach clubs, as opposed to the mass-marketing outlets such as drug stores through which cologne is sold.

There are no limitations, however, in either the application or the registration as to the channels of trade, and thus it must be presumed that the goods of both would travel in all the normal channels of trade for goods of this type. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992) and the cases cited therein. Accordingly, we proceed on the assumption that the goods of both would be encountered by the same potential purchasers in the same retail outlets.

Nor does the fact that tanning lotions and colognes are different products used for different purposes eliminate the potential for confusion. It is well settled that the respective goods need not be identical or even competitive to support a finding of likelihood of

confusion; it is sufficient if the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks used thereon, to the mistaken belief that they originate from or are in some way associated with the same source. See *Azteca Restaurant Enterprises, Inc.*, *supra* at 1210-11, and the cases cited therein. Thus, the issue narrows down to whether potential purchasers, on encountering HOT CHOCOLATE tanning lotions and HOT CHOCOLATE cologne, would be likely to believe that the two products emanate from the same source.

The Examining Attorney has made of record a total of twenty-four printouts of either pending applications or registrations in which the same mark is sought to be registered or has been registered for goods including both tanning preparations and colognes, as evidence of production by the same entity of both types of goods. Applicant has challenged the weight to be given to this evidence, noting that only one of the pending applications is based on use, as opposed to thirteen based on intent-to-use, and that six of the ten subsisting registrations are based on foreign registrations. Applicant contends that this is insufficient evidence to establish actual use of

the same mark by others for both colognes and tanning lotions, much less that the same manufacturers commonly produce both types of products. In addition, applicant has made of record five registrations of four well-known fragrance manufacturers (Calvin Klein, Ralph Lauren, Liz Claiborne and Nicole Miller) showing no expansion of use of their fragrance marks to tanning lotions, as well as the declaration of a trade investigator to the effect that these four manufacturers had been contacted and that they had stated they did not make tanning products.

The Examining Attorney, although acknowledging the minimal number of third-party applications or registrations based on use, contends that the number of intent-to-use applications is adequate to demonstrate a growing trend in the cosmetic industry for manufacturers to produce both tanning lotions and colognes. Applicant's evidence of four non-producers of both products, according to the Examining Attorney, is not indicative of the realities of the marketplace as a whole.

The Board has previously found third-party registrations and applications covering the goods and/or services of both parties to have probative value to the extent that they may suggest that the goods or services are of a type which may emanate from the same source, if based

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on use in commerce, but to be of little weight if based on foreign registrations. See *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ 1467(TTAB 1988). This is only logical since as stated in Mucky Duck, *supra* at 1470 fn.6, applications and registrations based on foreign registrations "are not even necessarily evidence of a serious intent to use the marks shown therein in the United States on all of the listed goods and services." Even third-party registrations or applications based on use are not evidence that the marks are actually being used on the goods recited therein, but only that the goods and/or services are of a type which may emanate from a single source. See *In re Azteca Restaurant Enterprises, Inc.*, *supra* at 1211.

Here, although the number of use-based registrations and applications made of record by the Examining Attorney is relatively small, they nevertheless constitute evidence which suggests that the two products are of a type which may emanate from a single source. Even if based on a minimal number of registrations and applications, we consider this evidence adequate to counterbalance applicant's evidence of non-production of both types of goods by four other sources. We hasten to add, however, that we do not find it appropriate to rely upon the intent-to-use applications as probative evidence of a growing

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trend in the industry for manufacturers to produce both tanning lotions and colognes. Similar to registrations under Section 44, the intent-to-use applications provide no basis for concluding that all of the goods identified in these applications will actually be produced and sold under the marks sought to be registered.

We conclude that when the identical mark HOT CHOCOLATE is used on both the tanning lotions of applicant and the cologne of registrant, potential purchasers may well assume that both of these products emanate from the same source.

Decision: The refusal under Section 2(d) is affirmed and registration is refused to applicant.

T. J. Quinn

C. E. Walters

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board

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