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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dial Brands, Inc.

Serial No. 78/077,135

Frank T. Barber of The Dial Corporation for Dial Brands,  
Inc.

Florentina Blandu, Trademark Examining Attorney, Law Office  
104 (Janice O'Lear, Managing Attorney).

Before Cissel, Seeherman and Bucher, Administrative  
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 2, 2001, applicant, an Arizona corporation,  
filed the above-identified application to register the mark  
"TROPICAL ESCAPE" on the Principal Register for "personal  
care products, namely, hand and body soap in bar and liquid  
form, body wash, hand and body lotions and moisturizers,  
body scrubs, defoliators, facial cleansers, facial  
cleansing wipes, body deodorants and antiperspirants, and  
body sprays," in Class 3. The basis for filing this

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application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these goods.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that the same mark is registered<sup>1</sup> for, inter alia, "candles," in Class 4, and that if applicant were to use the mark on the goods listed in the application, confusion would be likely. She reasoned that the products set forth in the registration and the application are of types that emanate from the same businesses and travel through the same channels of trade to the same consumers.

Enclosed as support for these conclusions were copies of thirteen trademark registrations based on use in commerce wherein the goods listed include both candles and personal care products such as soap. Nine of these registrations are owned by third parties, but four of them are owned by applicant itself, or by applicant's parent corporation. Examples of the registrations include the following: BIZZY BODY BUBBLES is registered by applicant for "personal care products, namely soap," in Class 3, and

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<sup>1</sup> Reg. No. 2,321,157, issued on the Principal Register to Sears, Roebuck and Co. on February 22, 2000.

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for "candles," in Class 4<sup>2</sup>; MIXED-UP BERRIES is registered by applicant for "personal care products, namely skin soap," in Class 3, and for "candles," in Class 4<sup>3</sup>; STAR SHINE is registered by A.K.A. Saunders, Inc. for "shower gel," "bath crystals" and "soap for hands and body," in Class 3<sup>4</sup>; CRISP is registered by Peacock Alley, Inc. for "scented skin soap," in Class 3, and for "scented candles," in Class 4<sup>5</sup>; LAVENDER FLOWERS is registered by Bath & Body Works for "shower gel, body wash, bubble bath, hand soap, body soap, and face soap," in Class 3, and for "candles," in Class 4<sup>6</sup>; and INANNA is registered by Gloria Natale for "soap," in Class 3, and "scented candles," in Class 4<sup>7</sup>.

Applicant responded to the refusal to register with argument that confusion would not be likely because the personal care products listed in the application are unrelated to candles. Applicant noted that these goods

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<sup>2</sup> Reg. No. 2,352,768, issued on the Principal Register on May 23, 2000.

<sup>3</sup> Reg. No. 2,358,653, issued on the Principal Register on June 13, 2000.

<sup>4</sup> Reg. No. 2,263,470, issued on the Principal Register on July 20, 1999.

<sup>5</sup> Reg. No. 2,208,093, issued on the Principal Register on December 8, 1999.

<sup>6</sup> Reg. No. 2,447,247, issued on the Principal Register on April 24, 2001.

<sup>7</sup> Reg. No. 2,464,148, issued on the Principal Register on June 26, 2001.

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are, "by all measurements, mutually exclusive; they are used for mutually exclusive purposes; they are not functionally related; there is no overlapping in function; they are not competitive; and they are classified in different classes in the U.S. Patent and Trademark Office. There is an obvious competitive distance between the goods." As to the registrations encompassing candles and soap, applicant contended that the Examining Attorney had not demonstrated how this evidence could establish that these goods are related. Applicant took the position that the mere fact that one company may register its mark for goods in more than one class does not establish that the goods in those classes are related. Applicant pointed out that the owner of the cited registration, Sears Roebuck, operates department stores which feature a wide variety of otherwise unrelated products. In a similar sense, applicant contended that the fact that it has itself registered marks for many different products, including both candles and soaps, does not, by itself, establish that these goods are commercially related in such a way that the use of the same marks on them would lead consumers to assume that they have a common source.

The Examining Attorney was not persuaded by applicant's arguments, and in her second Office Action, she

continued and made final the refusal to register based on likelihood of confusion. Submitted with the final refusal were copies of sixteen applications and registrations owned by applicant wherein the goods consist of or include "candles." The Examining Attorney concluded that the fact that applicant itself apparently markets both candles and soap is an indication that consumers presented with the same mark on both products have a basis for assuming a common source for both.

In response to the final refusal to register, applicant submitted a request for reconsideration with additional evidence and argument, as well as a Notice of Appeal. Applicant made of record 49 subsisting registrations or pending applications for marks in Class 3 which contain the word "TROPICAL," and 23 such registrations or applications for marks which consist of or include the word "ESCAPE." Applicant argued that in order for the Examining Attorney to expand the scope of protection accorded to the registered mark to include "non-competing goods" such as those identified in the application, the registered mark must be a strong mark, but that the third-party applications and registrations of marks with either "TROPICAL" or "ESCAPE" in them "has

seriously eroded the scope of protection to be given to these words." (brief, p. 2).

The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for reconsideration in light of the additional evidence and argument applicant based on it. The Examining Attorney was not persuaded to withdraw the refusal to register, however. She issued a brief Office Action maintaining her position, and the application was returned to the Board, which resumed action on the appeal.

Applicant filed its brief on appeal, the Examining Attorney filed her appeal brief and applicant filed a reply brief, but applicant did not request an oral hearing before the Board. Accordingly, we have resolved this appeal based on consideration of the written arguments and record.

The sole issue to be resolved is whether confusion with the cited registered mark would be likely within the meaning of Section 2(d) of the Lanham Act if applicant were to use the mark it seeks to register in connection with the goods specified in the application. In view of the fact that the mark which applicant has chosen is identical to the registered mark, we turn to the question of whether applicant's goods are related to those listed in the cited registration in such a way that the use of the same mark on

all of them would be likely to result in confusion, mistake or deception.

As noted above, the Examining Attorney contends that the record establishes that confusion would be likely because the marks are identical and the goods specified in the application are related to those identified in the registration. Evoking the image of a candle-lit bubble bath, she argues that both candles and soap are sold through the same trade channels to the same ordinary consumers for possible use at the same time as "aromatherapy." Applicant takes the position that differences in the natures and the uses of these products mandate the conclusion that the use of the same mark on them would not be likely to cause confusion, especially in view of the fact that "the cited mark in the present case is not arbitrary and fanciful and is indeed subject to weakness created by extensive third-party usage." (reply brief, p. 3).

We cannot adopt applicant's position in this regard. Of course, the third-party registrations to which applicant refers<sup>8</sup> are not evidence of the use of the marks therein, but even more significantly, those marks are not the same

mark that applicant here seeks to register, so even if we were presented with evidence of the widespread uses of these marks, we still would not have evidence of the weakness of the cited registered mark. As the Examining Attorney points out, the only registration for the mark "TROPICAL ESCAPE" is the one she has cited as a bar under Section 2(d) of the Act. The refusal to register is not based on only the word "TROPICAL" or only the word "ESCAPE," but rather pertains to the entire mark, the combined term "TROPICAL ESCAPE," which creates a commercial impression that is distinct from the impressions created by the marks to which applicant's evidence is directed. There is absolutely no evidence of any use of the cited registered mark by third parties, much less any evidence that the use of this mark has been so extensive that consumers of the goods at issue in this appeal have become so familiar with such uses that they would not be likely to be confused by the use of the same mark on related goods.

Contrary to applicant's argument, the Examining Attorney has demonstrated that the "candles" listed in the cited registration are commercially related to the goods

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<sup>8</sup> With respect to applicant's reliance on various third-party applications, such applications are probative only of the fact that they have been filed.

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identified in the application as "soap." "Although third-party registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, nevertheless third-party registrations which individually cover a number of different items and which are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods and/or services are of a type which may emanate from a single source." In re Albert Trostel & Sons Co., 29 USPQ 2d 1783, 1784 (TTAB 1993), citing In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467 (TTAB 1988). The thirteen registrations made of record by the Examining Attorney, especially the four owned by applicant or its parent corporation, demonstrate that candles and soap are products which consumers may expect to come from a single source. In fact, the record shows not only that applicant and others have registered their marks for both of these types of products, but that in addition to the instant application listing soap, applicant has registered and applied to register a number of marks for candles. Applicant has not challenged or rebutted these facts.

In summary, because the mark applicant seeks to register is identical to the cited registered mark and because the record demonstrates that consumers have a basis

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upon which to expect that the goods specified in the application may emanate from the same source as the goods identified in the cited 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.

We do not doubt the propriety of this conclusion, but even if we did, any such doubt would have to be resolved in favor of the prior user and registrant, and against the applicant, who, as the second comer, has a duty to select a mark which is not likely to cause confusion with a mark already in use in the same field of commerce. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979).

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