

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Hearing:
April 28, 2004

Mailed:
August 18, 2004
Seeherman

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re St. Tropez, Inc.

Serial No. 76069661

Marvin H. Kleinberg of Kleinberg & Lerner, LLP for St.
Tropez, Inc.

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Before Seeherman, Quinn and Walters, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

St. Tropez seeks to register, under the provisions of
Section 2(f) of the Trademark Act, the mark ST.TROPEZ and
design, as shown below, for the following goods, as
amended:

Sun tanning preparations, namely, sun
tan gel, sun tan lotion and sun tan
oil, skin gels, oils and lotions for
accelerating tans; sun screening
preparations, sun tan accelerator
products and preparations, skin and

body creams, skin and body lotions and non-medicated skin and body balms.¹



ST. TROPEZ

The application is based on Section 1(a) of the Trademark Act, asserting first use and first use in interstate commerce as early as January 15, 1993. The application is also based on Section 44(e) of the Trademark Act, based on applicant's ownership of two UK registrations and a registration in the Office for Harmonization in the Internal Market (Community Trademark).²

¹ Application Serial No. 76069661, filed June 13, 2000. The original application identified the goods as "soaps; perfumery; essential oils; cosmetics; hair lotions; hair care preparations; shampoos; dentifrices; toothpastes; sun tanning preparations; sun screening preparations; sun tan accelerator products and preparations; anti-perspirants; deodorants for personal use; creams, lotions and balms for the skin and for the body; hand creams; dermatological preparations and substances." After interim amendments to address issues of indefiniteness, applicant amended its application to those listed above with a request for remand filed at the same time as its appeal brief.

² In the Office action mailed October 4, 2001, the Examining Attorney stated that the application was filed on the basis of Section 1(b) (intent-to-use) and Section 44(e). Apparently the Examining Attorney made this statement because applicant had previously submitted a declaration that it had a bona fide intention to use the mark in commerce. This statement was in turn made in response to the original Examining Attorney's

Registration has been finally refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark TROPEZ, in the stylized form shown below, and previously registered for "cosmetics, namely, face powder; lipstick; mascara; rouge; eyeshadow; lip covering; lip gloss; face blusher powder; highlighter rouge; liquid facial make-up; nail polish; nail hardener; nail polish remover; rouge blusher; eyebrow, eyeliner and lipliner pencils,"³ that, when applied to applicant's identified goods, it is likely to cause confusion or mistake or to deceive.

The image shows the word "Tropéz" written in a highly stylized, cursive script. The letters are thick and black, with a fluid, interconnected quality. The 'T' is particularly large and prominent, with a long, sweeping tail that extends to the right. The 'z' at the end is also large and has a similar sweeping tail. The overall appearance is that of a handwritten signature or a brand logo.

Applicant has appealed, and has filed an appeal brief, a supplemental appeal brief and, in response to the Examining Attorney's appeal brief, a reply brief. Applicant also requested an oral hearing at which both its attorney and the Examining Attorney appeared.

requirement that an application based on Section 44(e) must include a declaration of a bona fide intention to use the mark in commerce even if use in commerce is asserted in the application.

³ Registration No. 1538777, issued May 16, 1989; Section 8 affidavit accepted; Section 15 affidavit acknowledged.

Before we turn to the substantive issue in this appeal, there are some procedural points which we must address. On April 20, 2004, eight days prior to the oral hearing in this appeal, and a little more than two years after filing its notice of appeal, applicant filed a "motion for leave to offer new evidence and to offer a new declaration in support of new evidence," which we deem to be a request for remand. Applicant states that this new evidence came to Applicant's attention "subsequent to the final action." However, the final Office action issued on October 14, 2001. Applicant does not state how long after the final Office action this new evidence came to its attention. The declaration submitted with the motion is by Larry Batchelor, an employee of applicant who had previously been employed by a company which owned the cited registration.⁴ Mr. Batchelor worked at this company from January 1997 until March of 2001; he has been associated with applicant since October 2001. The exhibits Mr. Batchelor seeks to introduce by his registration include documents obtained by him during his employment with AM

⁴ Technically, Mr. Batchelor was employed by Pavion, Ltd., which was purchased by AM Cosmetics, Inc., which had previously purchased Arthur Matney Co., Inc., the owner of the cited registration.

Cosmetics. Another exhibit was received by applicant on November 17, 2003.

Obviously, information from Mr. Batchelor could have been made of record any time after he became associated with applicant in October 2001. Applicant has provided no explanation as to why it waited until April 20, 2004 to do so. Nor has applicant provided any explanation as to why it waited until this date to submit an exhibit that came into applicant's possession on November 17, 2003, one month before the mailing of the Examining Attorney's appeal brief.

A review of the file shows that applicant has submitted or attempted to submit evidence several times after the filing of its notice of appeal. On April 4, 2002, along with its notice of appeal, applicant submitted a "response after final action." The Board remanded the application to the Examining Attorney to consider these remarks, and the request was denied on May 8, 2002. On June 28, 2002, applicant filed a request for an extension of time to file its brief because "applicant has found and collected new evidence." Applicant submitted 16 exhibits, along with a ten-page argument, on September 5, 2002. The Board granted that request for remand on November 19, 2002. The request for reconsideration was subsequently denied by

the Examining Attorney on January 29, 2003. On March 26, 2003, applicant again filed a request for remand in order to submit sixteen additional exhibits, as well as seven pages of argument. The Board granted that request for remand as well, although the Examining Attorney was not persuaded by the submission. Thus, this latest motion for leave to offer new evidence is the fourth submission by applicant after the filing of its notice of appeal.

Section 1207.02 of the TTAB Manual of Procedure discusses requests for remand. Good cause for a remand must be shown, and

the length of the delay in making the request after the reason for the remand becomes known, or the point in the appeal process at which the request for remand is made, will be considered in the determination of whether good cause exists. Generally, the later in the appeal proceeding that the request for remand is filed, the stronger the reason that must be given for good cause to be found.

TBMP §1207.02 (2d ed. rev. 2004). In view of the general history of the prosecution of this application, the absence of any explanation by applicant as to why the evidence could not have been made of record earlier, and the extremely advanced stage of the proceeding at which the request was made (days before the oral hearing),

applicant's motion for leave to offer new evidence/request for remand is denied.

We also point out that, even if applicant's request for remand had been granted, the evidence applicant seeks to make of record would have no effect on our decision herein. Applicant is attempting to provide information about the demographics of the consumers of the products sold under the cited trademark, as well as documents related to pricing, sales tactics and advertising. However, it is well established that in determining the issue of likelihood of confusion, we must consider the goods as identified in the cited registration and the goods as identified in the subject application, not what the evidence shows them to be. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *In re William Hodges & Co., Inc.* 190 USPQ 47 (TTAB 1976). Thus, we must deem the registrant's goods to be sold through all appropriate channels of trade and at all price points for the specific cosmetic items, and we must consider the purchasers to be all customers for goods of this type. See *In re Davis-Cleaver Produce Company*, 197 USPQ 248 (TTAB 1977).⁵

⁵ It is also noted that the record does include website materials and articles purporting to evidence the registrant's

As a final administrative point, we note that during the examination of the application the Examining Attorney stated that certain exhibits to which applicant had referred were not in the record. The Examining Attorney did not mention any missing exhibits in her brief, and we therefore assume that all of them were associated with the file by the time she wrote her brief. In any event, we confirm that all 34 exhibits submitted by applicant are with the file, and that we have considered them in writing this opinion.

This brings us to the substantive issue in this appeal. Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or

target consumer market, such that the additional evidence applicant seeks to submit would appear to be simply cumulative and/or confirmatory. Again, because registrant's identification of goods is not limited as to channels of trade or classes of customers, evidence as to the registrant's actual trade channels or classes of customers cannot aid applicant to show that confusion is not likely.

services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Turning first to the goods, they are not identical. However, it is not necessary for goods to be identical in order to find likelihood of confusion. It is necessary only that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, the Examining Attorney has made of record numerous third-party registrations which show that companies have registered their marks for goods of the type identified in applicant's application and the cited registration. See, for example, Reg. No. 2480095 for, *inter alia*, suntan lotion, sun screen, body lotion, blush powder, bronzer; Reg. No. 2453604 for, *inter alia*, eyeshadow, mascara, eye pencil, eyeliner, eyebrow pencil, blush, lipstick; body lotion, facial moisturizer, lip

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emollient with sun block, hand cream, sun tan lotions; Reg. No. 2432958 for, inter alia, lipstick, lip pencil, eye pencil, eye shadow, blush, mascara, eye liner, skin moisturizer, body moisturizer, self tanner, tanning lotion, tanning gel, tanning oil, and after-tanning moisturizer; and Reg. No. 2437420 for, inter alia, eyeliner, eye shadows, mascara, blush, lipstick, skin lotions, and face and body creams.

Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Further, these goods are of a type that might be used by a consumer as part of a beauty regimen. Thus, for example, one might apply the skin and body creams and lotions identified in applicant's application prior to or after applying the cosmetics identified in the cited registration. Or the consumer might apply sun screening preparations prior to applying cosmetics. Further, a consumer might use sun tanning preparations or sun tan accelerator products as well as cosmetics in order to enhance their appearance.

Applicant has argued that the consumers for its products and those of the registrant are different because the registrant's goods are directed to the African-American and other dark-skinned ethnic market, and such consumers would not have a need for sun tanning or sun tan accelerating products. There are two difficulties with this argument. First, applicant's goods include skin and body creams and skin and body lotions and such products could be used by consumers of any skin coloring. More importantly, the goods as identified in the cited registration are not limited as to their customers. Thus, as we have previously stated, we must assume that these goods are sold to all customers who would use cosmetics, i.e., we must deem the customers for the registrant's products to include women of all ethnicities, including women who would purchase applicant's sun tanning and screening preparations, as well as its skin and body creams and lotions.

As for the channels of trade, because there is no limitation in the identification in either the cited registration or applicant's application, we must deem the goods to be sold in all appropriate channels for such goods. They would include department stores, mass merchandising outlets, spas, salons, discount stores and

drugstores. Even if applicant's goods are sold in "spas, salons and high end specialty cosmetic shops," reply brief, p. 4, the identification does not restrict the goods to sales in such outlets.⁶ In short, we must assume applicant's and the registrant's goods to be sold in the same channels of trade, to the same groups of consumers.

Applicant asserts that presumptions that the goods travel in the same channels of trade and are sold to the same customers may be rebutted with evidence as to actual channels of trade and classes of customers. Although we have addressed this previously, because it is such a major part of applicant's argument, we reiterate that the law is well-settled that "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in an opposer's registration [or, in the case of an ex parte

⁶ We note that in its initial appeal brief applicant states that its goods are sold in "major department store chains," p. 12, but that in its reply brief applicant has said that its goods are "sold at spas, salons and higher priced specialty stores." p. 3. This discrepancy in applicant's statements is of no moment, however, since, as discussed above, we must determine the issue of likelihood of confusion based on the goods as they are identified in applicant's application and in the cited registration, and must assume that they are sold in all channels of trade appropriate for the identified goods.

appeal, the cited registration], rather than what the evidence shows the goods and/or services to be." Canadian Imperial Bank of Commerce v. Well Fargo Bank, N.A., supra at 1 USPQ2d 1814. This is because "although a registrant's current business practices [in connection with which the mark is used] may be quite narrow, they may change at any time." Canadian Imperial Bank of Commerce, quoting CBS, Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

We also note that cosmetics and sun tanning and sun screening preparations, as well as skin and body lotions, can be priced relatively inexpensively. Applicant asserts that registrant's products retail at approximately \$5.00 and less per unit. Supplemental brief filed October 7, 2003, p. 13. Although applicant may, in fact, sell its goods at a somewhat higher price, goods of the type identified in applicant's application may certainly be sold in the same price range as the registrant's cosmetics products. Thus, decisions to purchase, for example, a container of mascara or of sun tan lotion may be made on a casual or even impulse basis, without careful examination of the trademark for the item.

This brings us to a consideration of the marks. Applicant has argued that the only element common to both

marks—TROPEZ—is weak and suggestive, and therefore that it is to the other elements in the marks that consumers will look to distinguish the source of the goods. Thus, applicant asserts that the stylizations of the two marks distinguish them, as well as the design element in applicant's mark and the additional word "ST."

We disagree. The typestyles of the two marks, although somewhat different, are not so unusual that consumers are likely to remember them. Applicant's mark is depicted in plain block letters, while the cited mark is in what would be considered a normal script form. As for the design element, in general, if a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. In *re* *Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). We think that, given the abstract nature of the design in applicant's mark, and the prominent position of the words, that general principle applies to applicant's mark, and it is the literal portion, ST. TROPEZ, that must be considered the dominant element. See *In re* *National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) (although marks must be compared in their entireties, there is nothing improper, for rational reasons, in according certain portions of a mark greater weight).

The cited mark is TROPEZ, rather than ST. TROPEZ. However, again we do not believe that this difference is likely to be noted by consumers. ST. TROPEZ is a famous French Riviera seaside resort town. Applicant has acknowledged that "the word 'TROPEZ,' and all of its derivations, suggests the rich, luxurious lifestyle that is enjoyed by vacationers on the Riviera." Communication filed September 5, 2002, p. 3. See also Brief filed March 26, 2003, p. 5. Not only do the two marks have the same connotation, but consumers are likely to view TROPEZ as the equivalent of ST. TROPEZ.

We recognize that there are distinct differences between the marks which can be detected when they are viewed side by side. However, under actual marketing conditions consumers do not have the luxury to make such a comparison, but must rely on hazy past recollections. *Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980). In this case, because TROPEZ will be viewed as the equivalent of ST. TROPEZ, the marks have the same connotation as well as strong similarities in appearance and pronunciation due to the identical term TROPEZ in each. As a result, the overall commercial impression of the marks is the same.

In its appeal brief filed March 26, 2003, applicant, in addition to arguing that ST. TROPEZ has a geographic meaning and a suggestive significance based on that meaning, has asserted that ST. TROPEZ is the name of a saint, while TROPEZ is a personal name, the modern spelling of Torpes, "one of Nero's centurians [sic] who was beheaded in Pisa for the sake of his religion." p. 9. Applicant has further asserted that the Patent and Trademark Office has a long history of finding no likelihood of confusion between marks which consist, on the one hand, of a personal name, and on the other, of that name preceded by the abbreviation "ST." We are not persuaded by this argument. Applicant has not submitted any evidence that the consumers for its products and those of the registrant would regard TROPEZ as a personal name or would know that ST. TROPEZ is/was a saint. Although there may well have been a Christian martyr named Torpes who was sainted, and although the Riviera town may have been named after this person, there is no indication that the general public will be aware of these meanings, or that "Tropez" is a modern spelling of "Torpes." On the contrary, the Examining Attorney conducted an extensive search of the NEXIS database for the term TROPEZ, and "a cursory review of the numerous articles [16,680 were retrieved] failed to evidence use of the term

TROPEZ as a proper name." Office action mailed July 16, 2003. Accordingly, we do not consider the instant situation to be analogous to the third-party "ST./personal name" registrations.

Applicant has also argued that ST. TROPEZ is a weak mark, relying on what it asserts to be various third-party registrations for that term. In support of this position, applicant has submitted a listing of applications and registrations for ST. TROPEZ/SAINT TROPEZ marks. Such a listing, which includes only the mark, serial number and/or registration number, and indicator that the application/registration is live, would normally be insufficient to make such registrations of record. See *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). However, the Examining Attorney has not objected to the registrations, and has, on the contrary, discussed them. Therefore, we have considered the listing.

The probative value of this list is rather limited. There are eighteen third-party registrations on the list. (The applications are probative only of the fact that they have been filed.) Third-party registrations can be used in the manner of dictionary definitions, to show that a term has a significance in a particular industry. While the list submitted by applicant does not indicate the goods or

services for which the marks have been registered, the Examining Attorney has reviewed them and reports that none of the third-party registrations is for goods or services that are related to the cited registration. Thus, contrary to applicant's contention, TROPEZ is not a weak mark in terms of co-existing on the register with other ST. TROPEZ marks for similar goods.

As we have previously stated, we accept applicant's assertion that ST. TROPEZ is suggestive of "the rich, luxurious lifestyle that is enjoyed by vacationers on the French Riviera, in the seaside resort town of Saint Tropez, a sister city to Beverly Hills." Applicant's brief filed March 26, 2003, p. 5. However, this connotation is the same for applicant's mark and for the cited mark. Although the scope of protection accorded to suggestive marks may be less than that for arbitrary marks, that protection extends in this case to prevent the registration of the similar mark ST. TROPEZ and design for closely related goods.

Simply put, consumers who are familiar with the registrant's TROPEZ mark for cosmetics are likely to assume that sun tanning and sun screening preparations and skin and body creams and lotion sold under the mark ST. TROPEZ and design emanate from the same source.

Finally, applicant argues that its mark and the registrant's have "peacefully" coexisted for ten years without applicant's having received any communication or objection from the registrant. Applicant has argued that this should be viewed as an "implied consent" by the registrant. We disagree. Although an actual consent by the owner of a cited registration can be extremely persuasive in the determination of likelihood of confusion, see *Bongrain International (American) Corp. v. Delice de France Inc.*, 811 F2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987), the lack of an objection cannot be viewed as the equivalent of a consent. Further, the lack of evidence of actual confusion may, in this case, be attributable to differences in the actual customer bases of applicant and the registrant. However, as we have previously discussed, our determination of likelihood of confusion must be based on the premise that applicant's and the registrant's goods may be directed to the same class of consumers.

Decision: The refusal of registration is affirmed.