

OFFICE ACTION RESPONSE FOR TROPIC (Serial No. 88/112,528)
(Our Ref. 22749/04006)

I. Amendment of Goods Description:

In the Office Action, the Examining Attorney required the Applicant to further specify the nature of the applied for goods and services. Applicant has agreed to the following potential goods and services descriptions:

Class 3: Cosmetics; Exfoliating scrubs for the feet; Eye liner; Eye makeup remover; Eye pencils; Eye shadow; Eye sticks **in the nature of eye serums**; Eyebrow gel; Eyebrow mascara; Eyebrow pencils; Adhesives for affixing false eyelashes; Facial scrubs; False nails; Foundation makeup; Hair care masks; Hair conditioner; Hair cosmetics; Hand **cosmetic** gels; Hand **moisturizing** milks; Lip balm; **Non-medicated lip** care preparations; **Cosmetic lip** conditioners; Lip gloss; Lip liners; **Cosmetics in the nature of lip** pencils; Lipstick cases; Lipsticks; Liquid foundation; Lotions for beards; Lotions for cellulite reduction; Makeup primer; Mascaras; **Cosmetic** Milks; **skin** moisturisers; Nail buffing preparations; Nail care preparations; Nail cream; Nail gel; Nail strengtheners; Natural oils for perfumes; Night creams; Non-medicated foot soaks; Non-medicated soaps; Perfumed oils for skin care; Room fragrances; Shaving cream; Shaving sets, comprised of shaving cream and aftershave; Shower and bath gel; After-sun creams; After-sun lotions; After-sun oils; Air fragrance preparations; Aloe vera preparations for cosmetic purposes; Anti-aging creams; Anti-aging moisturizers; Antiperspirants for personal use; Anti-wrinkle cream; Aromatic essential oils; Volcanic Ash for cleaning; Balms, other than for medical purposes, **namely, for skin care and body care**; Bath cream; Bath oil; Beauty care cosmetics; Beauty care preparations, **namely, skin care preparations**; Beauty lotions; Beauty masks; Body butter; Body cleansing foams; Body cream; Body glitters; Body lotion; Body Oil to Milks **in the nature of body oil that transforms into milk form**; Body milk; Body scrub; Body wash; Bubble bath **for use on body**; **face** cleansing masks; Concealers **for face and skin**; **Cosmetic** conditioning creams **for face and skin**; Cosmetic creams for the skin; Cosmetic moisturisers; Cosmetic nourishing creams; Cosmetic preparations for eyelashes; cosmetic preparations for skin firming; Cosmetic **products preparations** for the shower; Cosmetics for personal use; ~~Cosmetics for suntanning~~; Creams for cellulite reduction; Exfoliating scrubs for cosmetic purposes; Exfoliating scrubs for the face; ~~Exfoliating scrubs for the feet {duplicate}~~; Exfoliating scrubs for the hands; Eye cream; Eye gels; Face creams; Face and body glitter; Face creams for cosmetic use; Cosmetic preparations for protecting the skin from the sun's rays; Cosmetic preparations for skin care; Cosmetics for protecting the skin from sunburn; Cosmetics for the treatment of dry skin; ~~Creams for tanning the skin~~; Skin cleansers; Skin foundation; Skin moisturizers; Skin toners; Skincare cosmetics; ~~Body cream {duplicate}~~; Body cream for cosmetic use; ~~Body scrub {duplicate}~~; Serums for cosmetic purposes; Makeup foundations; Eye makeup; Facial makeup; Nail cosmetics; Perfume; Aftershave; Shaving balm; Shave creams; Shampoo; Baby bath mousse; Baby lotion; Baby oil; Baby shampoo; Baby powder; **Non-medicated** baby care products, **namely, {specify Class 3 types of goods; "products" could include goods such as "Non-woven textile wipes for cleaning baby bottles and baby feeding equipment" in Class 21; see following example for suggestion} baby skin care preparations.**

Class 24: Blanket throws, bathroom towels, bath linen, cot blankets, cloths for removing makeup, furnishing and upholstery fabrics, towels, wall hangings of textile ~~{non-textile wall hangings are in Class 27}~~, blankets, **namely, {specify type of blanket, e.g. bed blankets; wording is broad enough to encompass "horse blankets" in Class 18 and "yoga blankets" in Class 28}.**

Class 35: Commercial information and advice services for consumers in the choice of products and services; sales promotion services, dissemination of advertising matter; demonstration of goods; distribution of samples; organisation of promotional events for commercial or advertising purposes; organization of fairs and exhibitions for economic and advertising purposes; advertising, advertising consulting, publicity services; marketing services, marketing consulting; commercial and business consulting, business organisation consulting and consulting in the field of sales methods, sales management, and sales improvement; selling assistance, namely, consultation in respect of sales techniques and programs; providing commercial information regarding products from searchable indexes and databases of information; retail store and retail sales services, including those effected in a domestic setting, and online retail store services relating to beauty products, cosmetics, skincare products and cosmetics, Exfoliating scrubs for the feet, Eye liner, Eye makeup remover, Eye pencils, Eye shadow, Eye sticks, Eyebrow gel, Eyebrow mascara, Eyebrow pencils, **Adhesives for affixing false eyelashes**, Facial scrubs, False nails, Foundation makeup, Hair care masks, Hair conditioner, Hair cosmetics, Hand gels, Hand milks, Lip balm, Lip care preparations, Lip conditioners, Lip gloss, Lip liners, Lip pencils, Lipstick cases, Lipsticks, Liquid foundation, Lotions for beards, Lotions for cellulite reduction, Makeup primer, Mascaras, Milks, Moisturisers, Nail buffing preparations, Nail care preparations, Nail cream, Nail gel, Nail strengtheners, Natural oils for perfumes, Night creams, Non-medicated foot soaks, Non-medicated soaps, Perfumed oils for skin care, Room fragrances, Shaving cream, Shaving sets, comprised of shaving cream and aftershave, Shower and bath gel, After-sun creams, After-sun lotions, After-sun oils, Air fragrance preparations, Aloe vera preparations for cosmetic purposes, Anti-aging creams, Anti-aging moisturizers, Antiperspirants for personal use, Anti-wrinkle cream, Aromatic essential oils, volcanic ash for cleaning, Balms, other than for medical purposes, Bath cream, Bath oil, Beauty care cosmetics, Beauty care preparations, Beauty lotions, Beauty masks, Body butter, Body cleansing foams, Body cream, Body glitters, Body lotion, Body Oil to Milks, Body milk, Body scrub, Body wash, Bubble bath, Cleansing masks, Concealers, Conditioning creams, Cosmetic creams for the skin, Cosmetic moisturisers, Cosmetic nourishing creams, Cosmetic preparations for eyelashes, Cosmetic preparations for skin firming, Cosmetic products for the shower, Cosmetics for personal use, ~~Cosmetics for suntanning~~, Creams for cellulite reduction, Exfoliating scrubs for cosmetic purposes, Exfoliating scrubs for the face, Exfoliating scrubs for the feet, Exfoliating scrubs for the hands, Eye cream, Eye gels, Face creams, Face and body glitter, Face creams for cosmetic use, Cosmetic preparations for protecting the skin from the sun's rays, Cosmetic preparations for skin care, Cosmetics for protecting the skin from sunburn, Cosmetics for the treatment of dry skin, ~~Creams for tanning the skin~~, Skin cleansers, Skin foundation, Skin moisturizers, Skin toners, Skincare cosmetics, Body cream, Body cream for cosmetic use, Body scrub, Serums for cosmetic purposes, Makeup foundations, Eye makeup, Facial makeup, Nail cosmetics, Perfume, Aftershave, Shaving balm, Shave creams, Shampoo, Baby bath mousse, Baby lotion, Baby oil, Baby shampoo, Baby powder, non-medicated Baby care products, Candles, Cushions, blankets, photoframes, vases, lamps, lampshades, decorative jars, mirrors, deck chairs, ~~Blanket throws, bathroom towels, bath linen, cot blankets, cloths for removing makeup, furnishing and upholstery fabrics, towels, wall hangings, Clothing, footwear, headgear, scarves, T-shirts, jumpers, beach robes, beach footwear~~; information, advisory and consultancy services relating to the aforementioned services.

Class 41: Training in the field of product presentation; provision of training services, in particular for sales personnel relating to the distribution/sale of goods and products through direct selling channels; ~~training in the field of product presentation {duplicate}~~; information, advisory and consultancy services relating to the aforementioned services.

Class 44: Hygienic and beauty care services; cosmetic treatment services for the body, face and hair; beauty counselling; Beauty cosmetics consultancy services in the selection and use of cosmetics; beauty consultancy services; beauty therapy services, namely beauty salon services, including those effected in a domestic setting; information, advisory and consultancy services relating to the aforementioned services.

By this response, Applicant hereby amends the goods and services descriptions accordingly.

II. Likelihood of Confusion Refusal in View of U.S. Registration Nos. 3,054,168, 4,748,933 and 5,242,493:

The Examining Attorney has refused registration of the current application for the mark TROPIC, U.S. Trademark Application Serial No. 88/112,528 (“the ‘528 Application”) in International Classes 3, 24 and 35 only, under Section 2(d) of the Trademark Act contending that, when used in commerce with the goods identified in the application is likely to be confused with:

- TROPIX, U.S. Registration No. 3,054,168) (“the ‘168 Registration”), which is registered for “beach towels” in Class 24;
- TROPIC, U.S. Registration No. 4,748,933 (“the ‘933 Registration”), which is registered for “fabrics for textile use” in International Class 24; and
- TROPICZ, U.S. Registration No. 5,242,493 (“the ‘493 Registration”), which is registered for “indoor tanning products, namely, non-medicated skin tan darkening lotions and skin moisturizers” in Class 3. (Collectively, the “Cited Registrations”).

For the reasons set forth herein, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) refusal since there is no likelihood of confusion between the ‘528 Application and the Cited Registrations.

The factors that are relevant to an examining attorney’s determination of likelihood of confusion are set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973); TMEP 1207.01. Reserving all rights to make additional arguments in the future, Applicant asserts that the following factor strongly leads to the conclusion that there is no likelihood of confusion between its mark which is the subject of the ‘528 Application and the marks which are the subject of the ‘168, ‘933 and ‘493 Registrations:

- 1.) Applicant’s goods are dissimilar to the goods set forth in the ‘168, ‘933 and the ‘493 Registrations and the goods and services descriptions have been further amended to reflect this.

- 2.) Applicant's mark is dissimilar to the marks set forth in the cited '168 Registration and the '493 Registration.

While Applicant asserts that the DuPont factors set forth above are the most relevant to the present rejection, other DuPont factors may be applicable to distinguish Applicant's mark from the cited registration.

A. Applicant's Goods are Dissimilar to Goods of the Cited Registrations

With respect to a likelihood of confusion analysis, the issue is not whether the goods will be confused with each other, but rather whether the public will be confused about their source. *See, Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). If the goods or services are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.* lamps, tubes) related to the photocopying field).

i. Applicant's Goods Are Dissimilar to the Goods Set Forth in the '168 Registration

Applicant has amended its Application to delete all of the goods in International Class 24. Accordingly, Applicant asserts that an examination of the identification of goods and services at issue suggests that a likelihood of confusion is not present between the marks covered by the '528 Application and the '168 Registration due to the differences in the goods. Applicant's mark no longer covers towels and the remaining goods and services are not sufficiently related to Registrant's goods for confusion to be likely.

ii. Applicant's Goods Are Dissimilar to the Goods Set Forth in the '933 Registration

Applicant has amended its Application to delete all of the goods in International Class 24. Accordingly, Applicant asserts that an examination of the identification of goods and services at issue suggests that a likelihood of confusion is not present between the marks covered by the '528 Application and the '933 Registration due to the differences in the goods. Applicant's mark no longer covers blankets, towels or any fabric related goods and the remaining goods and services are not sufficiently related to Registrant's goods for confusion to be likely.

iii. Applicant's Goods Are Dissimilar to the Goods Set Forth in the '493 Registration

Applicant has amended its Application to delete tanning products in International Class 3 and the retail services related to same in Class 35. Accordingly, Applicant asserts that an examination of the identification of goods and services at issue suggests that a likelihood of confusion is not present between the marks covered by the '528 Application and the '493 Registration. Applicant's mark no longer covers tanning products and the remaining goods and services are not sufficiently related to Registrant's goods for confusion to be likely.

B. Applicant's Mark Is Dissimilar to The Mark Set Forth in the Cited Registrations

When considering the similarity of two marks, the Examining Attorney must consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression. *In re E.I. du Pont*, 476 F.2d at 1361. The marks should not be dissected or split into component parts when evaluating the likelihood of confusion. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974). A disclaimer does not remove the disclaimed matter from the mark. The mark must still be regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In this instance, when viewed as a whole, Applicant's mark is different from the marks of the '168 Registration and '493 Registration for the following reasons.

i. Applicant's Mark is Dissimilar to the Mark of the '168 Registration:

The Applicant's TROPIC mark is different from the mark of the '168 Registration due to spelling of the '168 Registration for TROPIX. The Applicant's mark ends with the letter "C", as opposed to the '168 Registration which ends with the letter "X". This serves to distinguish the marks from the standpoint of appearance, sound, pronunciation, connotation and commercial impression so as to avoid confusion among consumers as to the source of the respective goods.

ii. Applicant's Mark is Dissimilar to the Mark of the '493 Registration:

The Applicant's TROPIC mark is different from the mark of the '493 Registration due to spelling of the '493 Registration for TROPICZ. The Applicant's mark ends with the letter "C", as opposed to the '493 Registration which ends with the letter "CZ". This serves to distinguish the marks from the standpoint of appearance, sound, pronunciation, connotation and commercial impression so as to avoid confusion among consumers as to the source of the respective goods.

The different appearance, meaning, connotation and commercial impression of Applicant's mark and the marks of the Cited '168 and '493 Registrations distinguish the marks so as to avoid confusion among consumers as to the source of the respective goods. These elements must be considered when conducting the likelihood of confusion analysis, as the fundamental rule in that the mark must be considered in their entireties. See *In re Shell Oil Co.*, 992 F.2d 1204,1206 (Fed Cir. 1993).

III. Conclusion:

In conclusion, the different appearance, pronunciation, meaning, connotation and commercial impression of Applicant's mark and the marks of the Cited Registrations distinguish the marks so as to avoid confusion among consumers as to the source of the respective goods. In view of the foregoing Remarks, Applicant respectfully requests reconsideration of the rejection of this application and that the Section 2(d) refusal be withdrawn.