

Exhibit E

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Mailed: May 13, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pure & Natural Company

Serial No. 77433737

A. Kate Huffman of Henkel of America, Inc. for Pure & Natural Company.

Karen P. Severson, Trademark Examining Attorney, Law Office 117 (Brett J. Golden, Managing Attorney).

Before Holtzman, Ritchie, and Shaw, Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Applicant, Pure & Natural Company, filed an application to register on the Principal Register the mark TROPICAL ESCAPE in standard characters and for goods identified as: “Antibacterial soap; Bar soap; Bath soaps; Deodorant soap; Liquid soaps; Body washes,” in International Class 3.¹

The examining attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of a likelihood of confusion with the

¹ Application Serial No. 77433737, filed on March 27, 2008 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on a date of first use of the mark in commerce and anywhere of January 1, 2002. Applicant claims ownership of Registration No. 3686857 for the mark TROPICAL ESCAPE for “Laundry detergents; Laundry soap; Fabric softeners,” in International Class 3.

mark in U.S. Registration No. 3726656 for the mark TROPICAL ESCAPE in standard characters for “Perfuming preparations for the atmosphere, namely, room fragrances; preparations for perfuming or fragrancng the air, namely, room perfume sprays,” in international Class 30 and “Air freshening preparations; air purifying preparations; room air fresheners; household and room deodorants; preparations for neutralizing odors in carpets, textiles and in the air,” in International Class 5.²

After the refusal was made final, applicant appealed. The case is fully briefed. For the reasons discussed below, we reverse the refusal to register.

Objections

The Examining Attorney has objected to applicant’s statement in its brief that the excerpt from the amway.com website made of record by the Examining Attorney “lists not only personal care and household care products but also unrelated products such as batteries, automotive products, light bulbs, health foods, pet foods, etc.”³ The Examining Attorney argues that applicant’s statement should be disregarded inasmuch as the excerpt of record from the amway.com website does not show these goods and applicant did not make of record any additional excerpts. We agree. Applicant’s argument regarding these additional goods has not been considered. 37 C.F.R. § 2.142(d).

The Examining Attorney also has objected to the form of “numerous case citations in Applicant’s brief” because these citations do not include a citation to the

² Issued December 15, 2009.

³ Applicant’s Br. at 20.

United States Patent Quarterly.⁴ When cases are cited in a brief, the case citation should include a citation to the USPQ if the case has appeared in that reporter. TBMP §§ 101.03 and 1203.02(f) (3d ed. 2011). This is, in part, because USPTO employees have limited access to reporters other than the USPQ. The objection is overruled, however, applicant is reminded to cite to the USPQ in any future proceedings before the Board.

Analysis

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence 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 Co., 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 services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). In this case, applicant has also submitted evidence regarding the strength of the marks and the use of similar marks by applicant and third parties, including a prior registration for the same mark owned by applicant.

A. The Similarity or Dissimilarity of the Marks in their Entireties as to Appearance, Sound, Connotation and Commercial Impression

We first consider the similarity of the marks, comparing the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee*

⁴ Examining Attorney's Br. at 3.

En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Applicant's TROPICAL ESCAPE mark in standard characters is identical in all respects to registrant's TROPICAL ESCAPE mark, also in standard characters. This *du Pont* factor heavily favors a finding of likelihood of confusion.

B. The Number and Nature of Similar Marks in Use on Similar Goods.

We next consider the strength of the marks and third-party use of similar marks on similar goods. Evidence of third-party use falls under the sixth *du Pont* factor—the “number and nature of similar marks in use on similar goods.” *Du Pont*, 177 USPQ at 567. If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). Applicant contends that TROPICAL ESCAPE is a very weak mark when considered in the light of the numerous third-party uses of similar marks on similar goods and, therefore, registrant's mark deserves only a limited scope of protection.

Applicant has made of record thirty third-party registrations of marks including the term TROPICAL or ESCAPE and used on personal care products, fragrances, scented sprays, and the like. The following are representative:

- Registration No. 3107574 for TROPICAL FRESH for non-medicated skin care preparations, namely, body wash, in International Class 3;
- Registration No. 3919666 for TROPICAL PARADISE for bath soaps in liquid, solid or gel form; fragrances for personal use; household cleaning preparations; non-medicated skin care preparations; room fragrances, in International Class 3;

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- Registration No. 3919669 for TROPICAL PARADISE for, *inter alia*, fragrant wax for use in potpourri burners, in International Class 4;
- Registration No. 3276615 for TROPICAL FESTIVAL for air fresheners and carpet deodorizers, in International Class 5;
- Registration No. 2743189 for TROPICAL MOMENT for air fresheners, in International Class 5;
- Registration No. 3842824 for CARIBBEAN ESCAPE for, *inter alia*, room fragrances, home fragrance oils, fragrance reeds, fragrant room spray, in International Class 3;
- Registration No. 1222287 for ESCAPE for, *inter alia*, bubble bath, in International Class 3;
- Registration No. 3868204 for ISLAND ESCAPE for, *inter alia*, body scrub; body washes, in International Class 3; and
- Registration No. 3793959 for ISLAND ESCAPE for, *inter alia*, air fresheners, in International Class 5.

Applicant also made of record eleven third-party internet web page printouts showing the use of TROPICAL ESCAPE on a variety air fresheners and scented candles. The following are representative:

- ladysugarsheen.com – a website reviewing candles from Bath & Body Works under the moniker “Tropical Escape Candles;”
- www.thefragrancelamp.com – a website offering “Tropical Escape” diffuser fragrance;
- www.webstore.com – a website offering “Tropical Escape” scented votive candles;
- www.absupermarket.com – a website offering “Tropical Escape” scented Fax brand home air freshener spray;
- www.kohls.com – a website offering Yankee Candle brand citrus passion jar candles described as a “Tropical escape;” and
- www.cosmeticmall.com – a website offering an air freshener product named “Smart Scents Air Freshener Tropical Escape.”

Applicant argues that this evidence shows that “members of the purchasing public are surrounded by a plethora of personal and household care products which are named or described using the terms ‘TROPICAL’, ‘ESCAPE’ or ‘TROPICAL

ESCAPE’, and that, consequently, by any measure of evaluation, the cited mark is a weak mark whose scope has been seriously eroded.”⁵

Absent evidence of actual use, third-party registrations are of limited probative value for the *du Pont* factor showing a crowded field and relative weakness. *Tektronix, Inc. v. Daktronics, Inc.*, 189 USPQ 693, 694 (CCPA 1976) (third-party registrations “are entitled to little weight on the question of likelihood of confusion where there is no evidence of actual use” of the marks therein.). However, third-party registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used.” *Id.*

Applicant, moreover, has supplemented the third-party registrations with internet evidence showing third-party use of TROPICAL ESCAPE for similar goods. We find that the frequent registration of the terms TROPICAL and/or ESCAPE for their suggestive meaning on soaps and detergents as well as on household fragrances and scented sprays together with the evidence of third-party use of TROPICAL ESCAPE on various types of scented products suggests that consumers are able to distinguish the source of these distinctly different scented products bearing similar or even identical names. Based on this finding, we see no need to decide whether the mark TROPICAL ESCAPE, per se, is weak as applied to the relevant goods in this case.

This *du Pont* factor favors applicant.

⁵ Applicant’s Br. at 9.

C. The similarity or dissimilarity and nature of the goods described in the application and registration.

We next turn to the similarity of the goods. It is settled that goods need not be similar or competitive in nature to support a finding of likelihood of confusion. The question is not whether purchasers can differentiate the goods themselves, but rather whether purchasers are likely to confuse the source of the goods. *See Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Further, in an *ex parte* appeal, likelihood of confusion is determined on the basis of the goods and services as they are identified in the application and the cited registration. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976).

Applicant's goods are "Antibacterial soap; Bar soap; Bath soaps; Deodorant soap; Liquid soaps; Body washes." Registrant's goods are "Perfuming preparations for the atmosphere, namely, room fragrances; preparations for perfuming or fragrancng the air, namely, room perfume sprays" and "Air freshening preparations; air purifying preparations; room air fresheners; household and room deodorants; preparations for neutralizing odors in carpets, textiles and in the air."

It is clear that the goods are not the same or even complementary. The Examining Attorney, nevertheless, argues that applicant's and registrant's goods "are related goods that consumers anticipate will emanate from a common source."⁶ In support of the refusal, the Examining Attorney made of record nine third-party registrations, including one owned by the applicant, showing that both applicant's

⁶ Examining Attorney's Br. at 6.

and registrant's types of goods are offered under a single mark by applicant as well as others. The following are representative:

- Registration No. 3168659 for VIE LUXE for, *inter alia*, hand soaps; liquid soap; perfumed soap; room fragrances; soaps for personal use, in International Class 3;
- Registration No. 3187473 for DIAL PROFESSIONAL SERIES and design for, *inter alia*, personal care products, namely, bar soap; liquid soap; body wash, in International Class 3 and air fresheners; air deodorizer; room freshener; aromatic air freshening preparations; perfumed air freshening preparations," in International Class 5;
- Registration No. 3219854 for BLOOMWORKS for, *inter alia*, personal care products, namely, scented and unscented bar soap, bath soap, face soap, hand soap, personal soap, body wash, room fragrances, in International Class 3;
- Registration No. 3299284 for GARDEN COLLECTIONS for, *inter alia*, toilet soap, bath soap, body cleansing scrub, antibacterial skin soaps, anti-bacterial soap; bath and shower gel; room fragrances; fragrance emitting wicks for room fragrance, in International Class 3;
- Registration No. 3336718 for LIQUID LOUNGE for, *inter alia*, personal care products, namely bath foam, bath gel, liquid bath soap, shower gel, room fragrances, laundry soap, fabric softener, body soap, anti bacterial soap, perfumed soaps, in International Class 3;
- Registration No. 3583483 for a Miscellaneous Design for, *inter alia*, detergents for automobiles; germicidal detergents; soap and skin cleansing preparations; non allergic liquid soap; Air fresheners and air freshening preparations, in International Class 5;
- Registration No. 3855040 for YANKEE CANDLE for, *inter alia*, liquid soap, skin cleansing gel, room fragrances, in International Class 3; and
- Registration No. 3968667 for SMILEX for, *inter alia*, deodorant soap; detergents other than for use in manufacturing operations and for medical purposes; soap, namely, bar and liquid soap; air freshening preparations; air purifying preparations, in International Class 5.

Although such third-party registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless may have probative value to the extent they are based on use in commerce and serve to suggest that the goods and services identified therein are of a kind which

may emanate from a single source under a single mark., i.e., that the same entity may provide prepared soaps and body washes and air fresheners and fragrances under the same mark. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); and *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

The Examining Attorney also made of record eight internet web page printouts suggesting that both applicant's and registrant's goods are offered under a single mark by others:

- armandhammer.com – a website showing household deodorizers sold alongside personal care products as well as laundry detergents and fabric softeners, all under the Arm & Hammer brand;
- amway.com – a website showing air fresheners and home fragrances sold alongside personal care products such as body washes;
- dialprofessional.com – a website showing air fresheners and deodorizers sold alongside personal care products such as body washes;
- uncommonscent.com – a website showing room fragrance sprays sold alongside personal care products such as hand wash and liquid soap;
- bathandbodyworks.com – a website showing home fragrances sold alongside personal care products such as body wash;
- thebodyshop-usa.com – a website showing scented room sprays sold alongside personal care products such as bar soap;
- crabtree-evelyn.com – a website showing home fragrance sprays sold alongside personal care products such as bath gel and bar soap;
- moltonbrown.com – a website showing room sprays sold alongside personal care products such as body washes; and
- kaifragrance.com – a website showing home fragrances sold alongside personal care products such as body washes.

As with the third-party registrations, the examining attorney argues that this internet evidence “establishes that the same entity commonly manufactures/produces/provides the relevant goods and markets the goods under

the same mark and that the relevant goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use.”⁷

Applicant argues that even if the goods emanate from a single source, consumer confusion is unlikely because the goods are significantly different in use and function:

The goods in this case are, by all measurements, mutually exclusive; they are used for mutually exclusive purposes. Applicant’s products are for cleaning the skin, whereas the cited Registrant’s products are for fragrancng the air, and would be detrimental if applied to the skin The two products are not functionally related; there is no overlapping in function; they are made from completely different ingredients; they are produced in completely different industries; **they are not competitive**. There is an obvious competitive distance between the goods. The distinction is significantly greater than **minute**. (Emphasis in original).⁸

We note applicant’s arguments that the goods have differing purposes and therefore that the Examining Attorney’s evidence is not persuasive to show a relationship between its goods and those of registrant. However, our case law consistently holds that such evidence is persuasive to support a finding that the goods in an involved application may be related to the goods identified in a cited registration for purposes of a likelihood of confusion determination. As discussed above, the third-party registrations suggest that the identified goods are of a kind that emanate from a common source, and the third-party website evidence is competent to show that such parties use a single mark to identify both applicant’s

⁷ Examining Attorney’s Br. at 16.

⁸ Applicant’s Br. at 10.

and registrant's types of goods. Based upon this evidence and the nature of the goods themselves, we find that registrant's goods are related to those provided by applicant for purposes of our determination herein. As a result, this *du Pont* factor favors a finding of likelihood of confusion.

D. Other Established Fact Probative of the Effect of Use.

The thirteenth and final *du Pont* factor allows for the consideration of any additional probative facts to accommodate the need for flexibility in assessing each unique set of facts. *Du Pont*, 177 USPQ at 567. Such an additional probative fact is present in this case.

Applicant has claimed ownership of Registration No. 3686857 for the mark TROPICAL ESCAPE for "Laundry detergents; Laundry soap; Fabric softeners," in International Class 3. That is, applicant already owns a registration for the exact same mark for laundry soaps and fabric softeners. Thus, we are presented with the unusual situation wherein an applicant's existing registration for the same mark for related goods has coexisted with the cited registration for a number of years.

When we consider this fact under the thirteenth *du Pont* factor, we find in this case that this factor weighs heavily in applicant's favor against a finding of a likelihood of confusion. *See In re Strategic Partners Inc.*, 102 USPQ2d 1397 (TTAB 2012) (finding that applicant's ownership of a prior registration for a substantially similar mark for the same goods which had coexisted with the cited registration for over five years was sufficient to "tip the scale in favor of applicant and a finding of no likelihood of confusion."). This factor favors applicant.

E. Balancing the Factors.

In a particular case, any of the *du Pont* factors may play a dominant role. *Du Pont*, 177 USPQ at 567. In some cases, a single factor may be dispositive. *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). The findings we have made on the record before us, including applicant's previous registration of the mark TROPICAL ESCAPE for laundry soap and fabric softener, the third-party uses of TROPICAL ESCAPE for related goods, the third-party uses of combinations of TROPICAL and ESCAPE, and the difference between applicant's and registrant's goods, all lead us to conclude that, although the marks are identical, there is no likelihood of confusion.

Decision: The refusal to register is reversed.