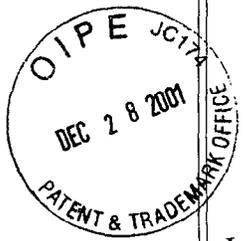


TTAB

TRADEMARK LAW OFFICE 105  
Serial Number: 75/344387  
Mark: CAKE CANDLE

\*\*Please Place on Upper Right Corner\*\*  
\*\*of Response to Office Action ONLY\*\*



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:	)	
	)	
Lumi-Lite Candle Company, Inc.	)	
	)	
Serial No.: 75/344,387	)	Examining Attorney:
	)	Charles L. Jenkins, Jr., Esq.
Filed: August 14, 1997	)	
	)	Law Office 105
Mark: CAKE CANDLE	)	



**BOX TTAB**  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

12-28-2001  
U.S. Patent & TMO/TM Mail Rcpt Dt. #11

**REPLY BRIEF IN SUPPORT OF REGISTRATION**

**I. INTRODUCTION**

In his appeal brief ("Examining Attorney's Brief"), the Examining Attorney asserts that Lumi-Lite Candle Company, Inc.'s ("Applicant") CAKE CANDLE mark ("Applicant's Mark") is generic and incapable of indicating the source of Applicant's frosted pillar candles. In the alternative, the Examining Attorney asserts that Applicant's Mark is descriptive, but that the evidence submitted by Applicant to establish that Applicant's Mark has acquired distinctiveness is insufficient. For the reasons discussed in Applicant's appeal brief ("Applicant's Brief") and this reply brief, Applicant's Mark is not generic for Applicant's product, and Applicant's evidence is more than sufficient to show that Applicant's Mark has acquired distinctiveness. Applicant therefore requests that the Board reverse the Examining Attorney's refusal to register Applicant's Mark.

DOW, LOHNES & ALBERTSON, PLLC  
ATTORNEYS AT LAW  
1200 NEW HAMPSHIRE AVENUE, N.W. • SUITE 800  
WASHINGTON, D.C. 20036-6802  
TELEPHONE 202-776-2000

## II. ARGUMENT

### A. Applicant's Mark is Not Generic as Applied to Applicant's Goods.

The determination of whether a mark is generic is made by applying a two step test: (i) what is the genus of goods at issue, and (2) whether the term sought to be registered is understood by the relevant public *primarily* to refer to that genus of goods. *See H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 U.S.P.Q. 528, 530 (Fed. Cir. 1986) (emphasis supplied). Applicant's goods are decorative, scented standalone candles, weighing several pounds each, that look like small cakes.

The Examining Attorney relies on three types of evidence – dictionary definitions, a letter from an infringer of Applicant's mark and news articles – to attempt to demonstrate that the Applicant's Mark is understood by the relevant public to primarily refer to frosted pillar candles that look like cakes, but a close examination of this evidence shows that Applicant's Mark is not generic.

In his brief, the Examining Attorney cites dictionary definitions of the word "cake" – "a sweet baked mixture of flour, liquid, eggs, and other ingredients shaped into a loaf or rounded layers" – and the word "candle" – "a solid, usu. cylindrical mass of a fatty substance, as tallow or wax, with an axially embedded wick that is burned to provide light."<sup>1</sup> As the Examining Attorney correctly noted, Applicant's product is a "standalone scented candle that **resembles** a cake."<sup>2</sup> Applicant's product, however, is not "a sweet baked mixture of flour, liquid, eggs, and other ingredients shaped into a loaf or rounded layers" – that is, it

---

<sup>1</sup> Examining Attorney's Brief at 3.

<sup>2</sup> *Id.* (emphasis added).

is not a cake. Rather, it is a wax candle made to look like a cake. Thus, while the term “candle” admittedly refers to the genus of Applicant’s goods, the term “cake” does not.

Secondly, the Examining Attorney cited, with little explanation, a quotation from a letter to one of Applicant’s attorneys as evidence that Applicant’s Mark is generic.<sup>3</sup> The letter cited by the Examining Attorney, however, was written in response to a cease-and-desist letter sent by Frank H. Foster, one of Applicant’s attorneys on March 16, 2001. The letter demanded that Lava Enterprises, Inc., publisher of a business-to-business catalog, cease use of the Applicant’s Mark in a descriptive manner to promote the Betty Crocker Bakery Candle Collection.<sup>4</sup> In context, the quoted passage was clearly part of Lava’s counsel’s efforts to mitigate any claim of infringement. Moreover, as noted in Applicant’s Brief, the letter cited by the Examining Attorney ultimately states, “my client will respect your client’s attempt to register its trademark and will refrain from using the cake candle description in the future.”<sup>5</sup> A letter from a infringing user of Applicant’s Mark, particularly an infringer that assented to Applicant’s demand that is cease and desist use of Applicant’s Mark, is not even admissible, much less, persuasive evidence of genericness.

The third type of evidence cited by the Examining Attorney – seven articles from the Lexis/Nexis database – is equally unpersuasive.<sup>6</sup> Of the seven articles<sup>7</sup> cited by the

---

<sup>3</sup> Examining Attorney’s Brief at 3.

<sup>4</sup> See Letter from Frank H. Foster, Attorney for Applicant, to President, Lava Enterprises, Inc (Mar. 16, 2000); Letter from Clinton L. Bain, Attorney for Lava Enterprises, Inc., to Frank H. Foster (Mar. 24, 2000), attached to Applicant’s January 11, 2001, Response to Office Action Dated 11/10/00.

<sup>5</sup> Applicant’s Brief at 9.

<sup>6</sup> Examining Attorney’s Brief at 3-4.

<sup>7</sup> Although the Examining Attorney previously cited 36 additional articles against Applicant, the Board should confine its review to the seven articles cited in the Examining Attorney’s Brief because the Examining Attorney did not state in his Brief that the seven articles are a

Examining Attorney, one [Story 40 of 250] very clearly refers to the aforementioned Betty Crocker line of candles where the unauthorized use of Applicant's mark has since ceased.

It cannot be determined from the face of the remaining six articles cited by the Examiner whether, in fact, they are referring to Applicant's product. Even if this is not the case, particularly where Applicant has made substantially exclusive use of its mark for over twenty years, considerably more than six articles are required before the Board may conclude that Applicant's mark is generic. In most cases where evidence of third party marks or uses were used to support the conclusion that a term or phrase was generic, the number of articles was substantially higher. *See, e.g., Continental Airlines Inc. v. United Air Lines Inc.*, 53 U.S.P.Q.2d 1385 (TTAB 1999) (E-TICKET for computer reservation and ticketing services held generic on summary judgment on the basis of dictionary definitions and *over 110* excerpts from printed publications, use by competitors and the U.S. government); *In re Log Cabin Homes Ltd.*, 52 U.S.P.Q.2d 1206 (TTAB 1999) (LOG CABIN HOMES for building design and retail services held generic on the basis of "*a few hundred*" stories from magazines and newspapers). *See also In re Recorded Books, Inc.*, 42 U.S.P.Q. 1275 (TTAB 1997) (the term RECORDED BOOKS for audio cassettes of literary works held generic in light of inherent meaning of phrase as well as over 70 excerpts from the NEXIS database).

Accordingly, it has been recognized that, to find that uses by third parties overcomes a claim of distinctiveness, those third party uses must be widespread. *See, e.g.,*

---

*...continued*

representative sample. *In re Homes & Land Publishing Corp.*, 24 U.S.P.Q.2d 1717, 1718 (TTAB 1992) ("[W]hen introducing only a portion of the reported articles, the Examining Attorney should indicate whether the ones submitted constitute a representative sample of the whole of the search results.") Even if all the articles initially cited by the Examining Attorney are considered by the Board, they fall well under the threshold for establishing that

*Goodyear Tire and Rubber Co. v. Interco Tire Corp.*, 49 U.S.P.Q.2d 1705, 1719 (TTAB 1998) (in light of many uses by competitors of tire tread designs similar to that of applicant, no substantially exclusive use was shown). The six articles cited by the Trademark Examiner are simply insufficient to show the widespread use of "CAKE CANDLE" by other candle manufacturers.

The Examining Attorney bears the burden to make a substantial showing, through clear evidence, that CAKE CANDLE is generic. See *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1571, 4 U.S.P.Q.2d 1141, 1143 (Fed. Cir. 1987); *In re Leatherman Tool Group, Inc.*, 32 U.S.P.Q.2d 1443 (TTAB 1994). Applicant respectfully submits that the Examining Attorney has not met this burden.

Moreover, should there be any doubt, Applicant has submitted substantial evidence of its efforts to stop unauthorized and/or infringing uses of Applicant's mark and submitted affidavits from three sales representatives who have worked in the candle industry for many years attesting to the fact that both those in the industry and consumers do not view CAKE CANDLE as being a generic term for Applicant's goods and that the mark is exclusively associated with Applicant.<sup>8</sup> Such declarations from third parties should be given great weight. See *In re Ideal Industries, Inc.*, 508 F.2d 1336, 1340, 184 U.S.P.Q. 487 (Cust.& Pat.App. 1975) (letters from electrical contractors who use appellant's WING-NUT wire connectors showed that users recognize WING-NUT as a trademark and mark was not generic and had acquired secondary meaning).

---

...continued

there is a substantial number of unauthorized or infringing uses of "CAKE CANDLE" for marks of the type sold by Applicant.

<sup>8</sup> See Applicant's Brief at 8, 9.

Therefore, even if the Examining Attorney is deemed to have shifted the burden to Applicant to show that Applicant's mark is not generic, Applicant has met its burden. For these reasons, the determination that Applicant's mark is generic should be reversed.

B. Applicant Has Established Acquired Distinctiveness for Its Mark.

Applicant has provided more than sufficient evidence of acquired distinctiveness to support registration of Applicant's Mark on the Principal Register with a disclaimer of the generic term "CANDLE." In addition to the aforementioned declarations from sales representatives and evidence of its program to stop infringing uses of the CAKE CANDLE mark, Applicant has provided evidence of the following:

1. Use by Applicant of the CAKE CANDLE mark in commerce since 1981.
2. Significant and substantial sales of its CAKE CANDLE frosted pillar candles with annual sales from 1993 to 1998 ranging from 200,000 to 3,510,790 units annually at a gross retail price from \$2,000,000.00 to \$35,107,900.00 per year during that period.
3. Expenditure of substantial resources in advertising and promotion of its trademark CAKE CANDLE, including expenditures of approximately \$60,000.00 per year from 1993 to 1997 and promotion of CAKE CANDLE frosted pillar candles through numerous trade publications, as well as through catalogs, flyer sheets and a web site on the Internet and at trade shows nationwide.

See Applicant's Brief at 14-15; *In re Homes & Land Publishing, Corp.* 24 U.S.P.Q.2d 1717, 1719 (TTAB 1992) (the manner of use, the amount of sales and the manner of advertising were considered when determining if a mark had acquired secondary meaning). The Examining Attorney correctly notes that the applicant "has the burden of proof with respect to establishing a prima facie case of acquired distinctiveness." However, five years of substantially exclusive and continuous use is sufficient to establish *prima facie* proof of secondary meaning under Section 2(f) of the Lanham Act. *In re Warren Petroleum Corp.*,

192 U.S.P.Q. 405, 407-08 (TTAB 1976) (holding that the applicant's mark had become distinctive of the applicant's services and was registerable because the applicant had been using the mark continuously for more than five years). The evidence presented by Applicant far exceeds the threshold showing for *prima facie* proof of secondary meaning under Section 2(f).

The Examining Attorney relies on two cases for the proposition that marks that are highly descriptive are either incapable of registration or else demand that the applicant meet a higher burden in showing secondary meaning. Examiner's Brief at 5-6 (citing *In re Leatherman Tool Group Inc.*, 32 U.S.P.Q.2d 1443 (TTAB 1994) and *In re Paint Products*, 8 U.S.P.Q.2d 1863 (TTAB 1988)). Both of these cases are readily distinguishable from the situation presented by Applicant's Mark in that, in both cases, the terms were clearly generic for the types of products offered.

In the *Paint Products* case, the Board affirmed refusal of registration of the mark PAINT PRODUCTS CO. for paint products. In affirming a refusal of registration, despite evidence alleged by the applicant to show secondary meaning, the Board noted that "[e]ach of the words that compose applicant's mark has a clear and unequivocal meaning; when combined those words mean, just as unequivocally, a company specializing in paint products." 8 U.S.P.Q.2d at 1866.<sup>9</sup> Likewise, in the *In re Leatherman* case, the Board affirmed refusal of registration of the mark POCKET SURVIVAL TOOL for a pocket survival tool. The Board cited a number of news articles provided by the Examining

---

<sup>9</sup> The *Paint Products* case is also deserving of little, if any, weight because it followed the now-discredited position that, while not generic, a mark could be so highly descriptive that it is incapable of acting as a trademark. See TMEP § 1209.01(c) at 1200-110 to 1200-111 (2d Ed. 1997 Rev.); *In re Women's Publishing Co.*, 23 U.S.P.Q.2d 1876 (TTAB 1992). Thus, as

Attorney showing generic usage of the applicant's mark and focused in particular on the dictionary meaning of the individual words comprising the applicant's mark, which "when joined to form the phrase "POCKET SURVIVAL TOOL," ... have a meaning identical to the meaning which ordinary usage would ascribe to those terms in combination." 32 U.S.P.Q.2d at 1449. In contrast, the individual words comprising Applicant's CAKE CANDLE mark do not "unequivocally" describe Applicant's goods. Rather, as discussed above, Applicant's goods are wax candles that look like cakes, but, they are not cakes with a wick on top. Thus, *In re Leatherman* and *In re Paint Products* are inapposite.

The instant dispute is much more similar to *In re Women's Publishing Co.*, 23 U.S.P.Q.2d 1876 (TTAB 1992), in which the Board reversed the Examining Attorney's refusal of registration. In that case, the Board rejected the Examining Attorney's argument that DECORATING DIGEST for a magazine about decorating was "so highly descriptive that it is incapable of acting as a trademark." *Id.* at 1877. The Board considered evidence of the applicant's promotion of the magazine, sales of over \$7.5 million, an affidavit from a company officer showing continuous and extensive advertising, and affidavits from individuals who distributed who received the magazine and concluded that the applicant had provided sufficient evidence that the words comprising the applicant's mark had become distinctive of applicant's goods. *Id.* at 1877, 1878.

Applicant has submitted substantial comparable evidence of acquired secondary meaning in its CAKE CANDLE mark – none of which has been challenged by the

---

...continued

the Examining Attorney's argument is based on this now-discredited rule, the argument fails as well.

Examining Attorney. Thus, Board should conclude that Applicant's Mark is entitled to registration on the Principal Register with a disclaimer of the term "CANDLE."<sup>10</sup>

### III. CONCLUSION

For the reasons set forth in this reply brief and Applicant's appeal brief, Applicant respectfully requests that the Board overturn the Examining Attorney's refusal to register the Applicant's Mark and that Applicant's Mark be approved for publication.

Respectfully submitted,

LUMI-LITE CANDLE COMPANY, INC.

By: Mitchell H Stabbe

Mitchell H. Stabbe

Bruce S. Antley

Its Attorneys

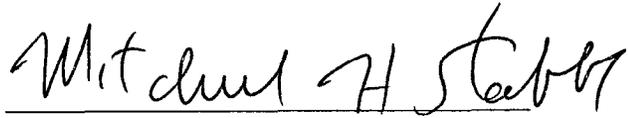
Dow, Lohnes & Albertson, PLLC  
1200 New Hampshire Avenue, N.W.  
Suite 800  
Washington, D.C. 20036  
(202) 776-2812  
December 28, 2001

---

<sup>10</sup> The Board should resolve any reasonable doubt in favor of Applicant. See *In re Women's Publishing Co.*, 23 U.S.P.Q.2d at 1878 (citing *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 U.S.P.Q.2d 1141, 1144 (Fed. Cir. 1987).

**CERTIFICATE OF DELIVERY**

I hereby certify that this correspondence is being deposited via courier for hand delivery in an envelope addressed to: Assistant Commissioner of Trademarks, Box TTAB, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on December 28, 2001.



Mitchell H. Stabbe

DCLIB01:1343761-3|16725.0001