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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lumi-Lite Candle Company, Inc.

Serial No. 75/344,387

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for Lumi-Lite Candle Company, Inc.

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Before Hanak, Wendel and Drost, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Lumi-Lite Candle Company, Inc. has filed an
application to register the proposed mark CAKE CANDLE for
"frosted pillar candles."¹

¹ Serial No. 75/344,387, filed August 14, 1997, claiming a first
use and first use in commerce date of at least as early as 1981.
A disclaimer has been made of the word CANDLE.

Registration has been finally refused under Section 2(e)(1) on the grounds that the proposed mark is generic and, if not generic, that the evidence of acquired distinctiveness is insufficient for registration under Section 2(f).

Applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The issues before us are whether the term CAKE CANDLE, when used for frosted pillar candles, is generic, or, if not generic, whether the phrase has acquired distinctiveness as would permit registration under Section 2(f). If generic, the designation is by definition incapable of indicating source. See *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). If not generic, since applicant has amended the application to one seeking registration under Section 2(f), the phrase has been conceded to be merely descriptive and the only question is whether it is registrable on the basis of acquired distinctiveness. See *In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443 (TTAB 1994).

We turn first to the issue of genericness. The burden of proof is on the Office to show by "clear evidence" that CAKE CANDLE is a generic designation for the goods of

applicant. See *In re Merrill Lynch*, 4 USPQ2d at 1143. Evidence of whether the relevant public's perception of the designation is as a generic reference or as an indication of source may be obtained from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications. See *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985); *In re Leatherman Tool Group, Inc.*, *supra*.

Before considering the arguments on the issue, we must first clarify the nature of the goods with which applicant uses the designation CAKE CANDLE. As identified, the goods are "frosted pillar candles." By the declaration of Pete Pappas, an officer of applicant, applicant has stated that these candles are "decorated, scented, standalone candles and are not candles placed on top of birthday or other cakes." (Pappas declaration 1). Although clearly not limited to the two and five pound sizes sold by applicant, we are convinced that candles described as being "frosted pillar" in design do not encompass the small type of candles used in the decoration of birthday or other cakes. The Examining Attorney is in agreement with this interpretation of applicant's goods. Thus, our analysis will go forward on this basis.

The Examining Attorney states that the wording "cake candle" is commonly used to designate candles that have a cake scent or have the shape of a cake. He maintains that since such candles are similar in size and characteristic to applicant's candles, the designation CAKE CANDLE is generic as applied to applicant's goods.

To support his position on the generic nature of the term "cake candle," the Examining Attorney has turned to three sources. First, he relies upon dictionary definitions of the words "cake" and "candle" as being sufficient in themselves to render the composite term "cake candle" generic for a candle that "resembles a cake." Second, he points to the letter from the attorney of an alleged infringer to applicant's counsel in which the following statement is found:

Please keep in mind these catalogs are distributed to retailers, many of which are familiar with the candle industry, and it is likely these retailers are probably not at all confused by the cake candle description as they probably have numerous suppliers attempting to sell them "cake candles."

This is relied upon by the Examining Attorney as evidence that other suppliers use the designation "cake candle" as a generic term for their respective brands of frosted pillar candles.

Finally, the Examining Attorney has introduced several excerpts of articles retrieved from the Nexis database, as well as three Web pages from the Internet, in which the designation "cake candle" appears. Of the total of forty-three of such references, the following are representative:

Gayfers department stores sell pillar-shaped candles with pine scents and imbedded flowers and fir branches, and cake candles with a coating that looks like frosting and scents of vanilla pound cake, butter rum cake and cranberries.

The Florida Times-Union (Feb. 28, 1998);

Candles come in many sizes from the best selling little votive candle to pillar candles, decorative beeswax and twisted candles, jar candles and a cake candle with a whipped wax that resembles frosting on a cake.

Charlestown Daily Mail (Dec. 15, 1997);

General Mills and Lava Enterprises are bringing out the Betty Crocker Bakery Candle Collection. There are 4-by-4-inch cake candles that look like a frosted minicake in spiced plum, pistachio green, carrot cake, peaches 'n' cream, blueberry supreme and cherry chip scents.

Knoxville News Sentinel (Feb. 16, 2000);

The shop carries candles that promise much; Millennium Money candles, with money inside; cake candles that look and smell like cake (but don't deliver the calories);

St-Louis Post-Dispatch (Nov. 18, 1999);

"We had to turn away a lot of work because we couldn't produce it fast enough," said Steve. So far the best sellers at the shop are jar candles, which go for \$12.49 each, and cake candles, which also sell for \$12.49 apiece.

The Virginian-Pilot (April 25, 1999);

Country Accents, in Towson Town Center, has cake candles (\$12), which are so popular the store sells out of them constantly. The candles have a warm fragrance like when someone's baking, with flavors like applesauce cake, cinnamon spice, vanilla pound cake and cranberry cake.

The Sun (Baltimore) (Nov. 26, 1995);

...store, which recently celebrated its 10th anniversary, offers products that are 100 percent made in the U.S.A., with a concentration on crafts. Most of the items are handmade. Customers can buy anything from pottery produced by an Ohio artist to unique cake candles.

Chicago Daily Herald (Dec. 21, 1998).

The Web pages from the Internet include a reference to a "Good Fortune Wedding Cake Candle," an order form for various "cake candles" and an article on making "cake candles" which describes the use of the term "cake candle" to refer to "a candle that has a frosted appearance."

Applicant maintains that the Examining Attorney has not met the burden of showing through clear evidence that CAKE CANDLE is generic. Applicant challenges each of the sources relied upon by the Examining Attorney. In the first place, applicant argues, insofar as dictionary definitions are concerned, its product is not a "cake" by definition, but rather a candle that resembles a cake. As for the letter cited by the Examining Attorney, which was written in response to a cease-and-desist letter sent out by one of applicant's counsel, applicant urges that the

quoted passage is nothing more than efforts of the alleged infringer to mitigate any claim of infringement.

Finally, applicant takes issue with the Nexis and Internet material relied upon by the Examining Attorney. Of these forty-three articles, applicant argues that three refer specifically to applicant's products, six refer to birthday cake candles and thus are not applicable, and seven use the term "cake candle" in a catalog reference to a Betty Crocker line of candles, and in connection with which the catalog publisher has agreed to stop using the term. Thus, according to applicant, only twenty-seven articles remain for a period of time beginning in 1995. Applicant strongly contends that more than this number of articles over this period of time, is required to conclude that CAKE CANDLE is generic for applicant's goods; that in most cases where evidence of third-party uses were used to support a conclusion of genericness, the number of articles were substantially higher than twenty-seven.

Applicant points to evidence which it has submitted in its behalf in the form of declarations of three sales representatives who have worked in the candle industry for years to the effect that other manufacturers, retailers and consumers have come to exclusively associate CAKE CANDLE with candles manufactured by applicant. In addition,

applicant notes the evidence of the active policing of its mark, as described in the Pappas' declarations, resulting in the cessation of use of the designation by several recipients of applicant's cease-and-desist letters and the entry of consent orders against three other businesses, enjoining them from any further use of CAKE CANDLE or any similar mark. Applicant argues that while it has taken action against infringers, it is "neither practical nor realistic" to expect applicant to take similar actions against journalists and their use of the designation, as represented by the relatively few and isolated articles cited by the Examining Attorney.

The critical issue in determining genericness is whether members of the relevant public primarily use or understand the designation sought to be registered as a reference to the genus or category of goods in question. See *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). In making our determination, we follow the two-step inquiry set forth in *Marvin Ginn* and reaffirmed by the Court in *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), namely:

- (1) What is the genus or category of goods at issue?, and

- (2) Is the designation sought to be registered understood by the relevant public primarily to refer to that genus or category of goods?

Here the category of goods is frosted pillar candles, which encompasses, by applicant's own description of its products, "decorative, scented standalone candles, weighing several pounds each, that look like small cakes." (Reply Brief, p. 2). The question is whether the designation "cake candle" would be understood by the general consuming public primarily to refer to candles falling within this category.

We find the Examining Attorney's reliance upon the separate dictionary definitions for the words "cake" and "candle" to be misplaced for two reasons. First, as applicant has argued, these are not "cakes" in the dictionary sense of a cake as a bakery item and thus the literal meaning of the word "cake" is not applicable to the goods. But even more significant, our principal reviewing court has made it clear in *In re American Fertility Society, supra*, that only when a compound word is involved may evidence be relied upon that each constituent word is generic and that the compound term formed by joining the words has a meaning identical to the meaning which would be ascribed to those words as a compound. See also *In re*

Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987). As stated by the Court, "the Board cannot simply cite definitions and generic uses of the constituent terms of a mark ...in lieu of conducting an inquiry into the meaning of the disputed phrase as a whole to hold a mark ... generic." In re American Fertility Society, 51 USPQ2d at 1836. The designation CAKE CANDLE is not a compound word, and thus any reliance upon dictionary definitions of the constituent terms of the designation is misguided. We must look to evidence of usage of the designation as a whole.

Furthermore, we place little probative weight in the letter from the attorney of an alleged infringer in which reference is made to the use by "numerous suppliers" of the designation "cake candle" for their products. Such a self-serving statement falls short of direct evidence of generic usage of the term by others.

It is when we turn to the Nexis and Internet evidence made of record by the Examining Attorney that we find clear and convincing evidence of the use of the designation "cake candle" in a generic sense in connection with candles that either have the scent of a cake or the shape of a cake, or both. In reviewing the number and content of the excerpts of articles before us, we have taken into consideration

that these candles are a novelty type of item and would most probably only be available in specialty retail outlets, such as gift shops or perhaps candle or gift departments of a larger store. The excerpts in fact show generic use of the term "cake candle" in connection with products being offered by several shops of this genre.

Thus, we are dealing with a narrow market and a very specialized type of product. This is a far cry from the situation in *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385 (TTAB 1999) in the air transportation industry was involved, the generic term was being used for large scale computerized reservation and ticketing services, and "over 110" references were relied upon to show generic usage of the term E-TICKET. Keeping in mind the specialized nature of the particular type of candle involved here, and the limited exposure of the public in general to such a product, we find the amount of evidence produced by the Examining Attorney of generic usage of the term "cake candle" sufficient to meet the clear evidence burden of proof.

While applicant in rebuttal has introduced the declarations of three sales representatives which claim exclusive association of CAKE CANDLES with candles originating from applicant, we find these declarations

outweighed by the evidence of generic usage of the designation by others, as produced by the Examining Attorney. Although applicant has also introduced evidence that applicant has been extremely active in its attempts to police the CAKE CANDLE mark, it would appear that these efforts have been overwhelmed by the adoption by competitors and by the public in general of this term in a generic sense.

Accordingly, we find that it has been established by the evidence of record that the designation sought to be registered, namely, CAKE CANDLE, would be understood by the relevant public primarily to refer to a category of frosted pillar candles which included candles which have the scent of cake or the shape of cake, or both, and, thus, is generic for goods of this category.

Having been found to be generic, the designation CAKE CANDLE is by definition incapable of identifying and distinguishing applicant's goods from those of others and thus incapable of registration under the provisions of Section 2(f), regardless of the evidence submitted thereunder.

In the interests of completeness, however, we have also considered the evidence introduced by applicant in support of its claim of acquired distinctiveness under

Section 2(f). For purposes of this review, we assume that CAKE CANDLE is merely descriptive, rather than generic, when used with applicant's frosted pillar candles.

Nonetheless, the designation is still considered to be highly descriptive, and thus the burden on applicant to establish distinctiveness is proportionally greater. See *Yahama International Corp. v. Hoshimo Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988).

In the supplemental declaration of Pete Pappas submitted on June 18, 1999, applicant has provided sales figures showing the rise in sales for the candles from 200,000 units or \$2 million in 1993 to 3,510,790 units or over \$35 million in 1998. In an earlier declaration Pappas stated that applicant has continuously used its CANDLE CAKE mark since at least 1981; that applicant expends approximately \$60,000 per year to promote the sales of CAKE CANDLE candles; and, that applicant's candles are promoted through trade publications, catalogs, flyer sheets, a Web site and at trade shows in various parts of the country. In further arguing the acquired distinctiveness of its mark, applicant again points to the declarations from sales representatives which it has made of record as well as the evidence of its efforts in policing its mark and stopping infringing uses thereof.

The Examining Attorney has basically taken the position that the designation CAKE CANDLE is so highly descriptive that it is incapable of being distinctive, no matter what degree of evidence has been produced. This is not a position which we can support; we require only that the level of acquired distinctiveness which must be established be commensurate with the degree of descriptiveness, as previously stated. Although applicant may be facing a high burden of proof, the establishment of acquired distinctiveness is not unattainable.

The major deficiency in applicant's claim of distinctiveness lies in the absence of any evidence of public recognition of the mark CAKE CANDLE as an indicator of a single source for goods of the type applicant produces, rather than as a general designation for a candle which either has the scent of a cake or looks like a cake, or both.

It is true that applicant has submitted proof not only of a long period of use of its mark, but also of a substantial rise in sales over recent years and considerable advertising and promotional expenditures. This type of evidence, however, is not sufficient in itself to prove acquired distinctiveness. An increase in sales figures may at best demonstrate the popularity or

commercial success of applicant's product, rather than any acquired distinctiveness of the mark under which the goods are being sold. See *In re Leatherman Tool Group Inc.*, *supra*. Furthermore, regardless of the years of use or of the amount of advertising expenditures or promotional endeavors, applicant remains under the burden of showing that the mark has acquired distinctiveness in the eyes of the public, i.e., that its advertising and promotional efforts have resulted in recognition of CAKE CANDLE as the particular source of these goods, rather than as a descriptor of the nature of the product. See *In re Audio Book Club, Inc.*, 52 USPQ2d 1042 (TTAB 1999)(inadequate evidence to establish that advertising and promotional efforts resulted in recognition of AUDIO BOOK CLUB as an indicator of the source of the services, rather than as the name of a new category of "book club" services.)

Here there is no direct evidence whatsoever of actual recognition by the purchasing public of the designation CAKE CANDLE, as used by applicant, as an indication of origin. Cf. *In re Women's Publishing Co., Inc.*, 23 USPQ2d 1876 (TTAB 1992)(reliance by the Board on the affidavits of individuals who state that they recognize applicant's mark as identifying and distinguishing applicant's magazines from those of others). Although applicant has made of

record declarations of three sales representative, that is, persons who are well aware of the source of the candles, these cannot serve to establish that the ultimate purchasers would recognize the designation as an indication that the candles originate from applicant. See In re Pingel Enterprise Inc., 46 USPQ2d 1811 (TTAB 1998); In re Semel, 189 USPQ 285 (TTAB 1975).

Accordingly, we find that, even if the designation CAKE CANDLE were found to be merely descriptive, rather than generic, the evidence submitted by applicant is insufficient to demonstrate acquired distinctiveness under Section 2(f).

Decision: The refusal to register CAKE CANDLE on the ground that the proposed mark is generic is affirmed. In the alternative, if the designation is not found to be generic, the refusal to register on the ground that applicant's evidence of acquired distinctiveness is insufficient for registration under Section 2(f) is also affirmed.

Ser No. 75/344,387