

This Opinion is not a
Precedent of the TTAB

Mailed: December 12, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hy-Vee Inc.

Serial No. 86749605

Timothy J. Zarley of Zarley Law Firm PLC, for Hy-Vee, Inc.

Jeanine Gagliardi, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

Before Zervas, Wolfson and Heasley,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Hy-Vee, Inc. (“Applicant”) seeks registration on the Principal Register of the standard character mark THE SOAP & WATER COMPANY (“Soap” or “Company” disclaimed)¹ for “retail store service within a section of a retail supermarket featuring bath and body products” in International Class 35.²

¹ The disclaimer statement in the application reads as follows: “No claim is made to the exclusive right to use ‘SOAP’ or ‘COMPANY’ apart from the mark as shown.” While the use of “or” to join terms in a mark that is subject to a disclaimer requirement is permitted, *see* Trademark Manual of Examining Procedure (TMEP) § 1213.08(a)(i) (October 2017), the disclaimer of rights applies to both terms.

² Application Serial No. 86749605, filed on September 8, 2015, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), asserting a *bona fide* intent to use the mark in commerce.

Serial No. 86749605

The Examining Attorney refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on two registrations, owned by the same owner, for the standard character mark SOAP & WATER CLEAN WATER THROUGH SOAP ("Soap" disclaimed). The two registrations on the Principal Register are: Registration No. 4358291 ("the '291 registration") for

soaps for personal use; personal care products, namely, body lotion, bath gels, shower gels, body sprays, bath soaps, body scrubs and cosmetic preparations for cosmetic body wrap applications for general personal care³

and Registration No. 4874946 ("the '946 registration") for

retail store services and online retail store services featuring cosmetics, skin care and personal care products.⁴

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. The case is fully briefed. We affirm the refusal to register.

Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

³ Issued June 25, 2013.

⁴ Issued December 22, 2015.

In considering the evidence of record pertaining to these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see also In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014).

Similarities of the Marks

We turn first to the *DuPont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks “in their entirety as to appearance, sound, connotation, and commercial impression.” *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *DuPont*, 177 USPQ at 567); *see also Palm Bay Imps.*, 73 USPQ2d at 1691. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression “such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015); *In re*

Assoc. of the United States Army, 85 USPQ2d 1264, 1268 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Applicant seeks to register the mark THE SOAP & WATER COMPANY and Registrant's mark is SOAP & WATER CLEAN WATER THROUGH SOAP. Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion"). On the other hand, different features may be analyzed to determine whether the marks are similar. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013) (citing *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955)). In fact, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 224 USPQ at 751.

In analyzing the marks, we have given consideration to the phrase "Soap & Water" as the dominant portion of Applicant's and Registrant's marks. It is the dominant portion of Registrant's mark because it is the leading phrase, the part most likely to

be spoken and remembered by purchasers, especially given their natural tendency to shorten marks. *See Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983); *see also Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered... .”); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1333 (TTAB 1992) (“companies are frequently called by shortened names”). The phrase SOAP & WATER is also the first significant portion of Applicant’s mark. The initial term THE has no source-identifying properties, and the final term COMPANY simply designates Applicant’s status as a corporate entity. The two words together, *i.e.*, “THE ... COMPANY,” emphasize the impression of a particular company that specializes in personal care products, such as are likely to be encountered in Registrant’s retail outlets. *See, e.g., In re Thor Tech*, 90 USPQ2d 1634, 1635 (TTAB 2009) (“Thus, as used in the registered mark THE WAVE, the word ‘The’ simply emphasizes the word ‘Wave.’”; WAVE and THE WAVE likely to cause confusion); *cf. In re Paint Prods. Co.*, 8 USPQ2d 1863 (TTAB 1988) (“CO” held incapable); *In re E.I. Kane, Inc.*, 221 USPQ 1203 (TTAB 1984) (“INC.” held incapable).

Here, the marks are similar in appearance and pronunciation due to the shared phrase SOAP & WATER, which also accounts for their shared connotations, as each calls to mind the popular exhortation to cleanliness: “make sure you use soap and water to wash your hands.”⁵ Applicant argues that because the phrase SOAP &

⁵ This sentence is given as an example of common usage in the Merriam-Webster online dictionary, accessible at <http://www.merriam-webster.com/dictionary/soap>. Attached to

WATER is so commonly used in this fashion, it “resides in the public domain.”⁶ However, Applicant has presented no evidence, such as third-party use of the phrase, to support this assertion. Moreover, contrary to Applicant’s contention, the fact that the Examining Attorney initially cited an additional registration against Applicant’s mark that included the phrase “soap & water” does not show that the cited mark, or the SOAP & WATER component, is weak.⁷

As we have often stated, “the presence of an additional term in the mark does not necessarily eliminate the likelihood of confusion if some terms are identical.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *see China Healthways Inst., Inc. v. Wang*, 491 F.3d 1337, 83 USPQ2d 1123 (Fed. Cir. 2007) (the common word in CHI and CHI PLUS is likely to cause confusion despite differences in the marks’ designs). While the tagline “CLEAN WATER THROUGH SOAP” in the cited mark may evoke the unique idea of funding clean water projects through the sale of soap,⁸ this additional connotation does not avoid a likelihood of confusion. The tagline merely expands upon the meaning of the phrase SOAP & WATER. Further, because Registrant’s mark is presented in standard characters, Registrant is free to use a distinguishing font or colors for the phrase SOAP & WATER that underscores

December 21, 2105 Office Action at 55. All citations to documents contained in the Trademark Document and Status Retrieval (TSDR) database are to the downloadable PDF versions of the documents.

⁶ 7 TTABVUE 2.

⁷ Reg. No. 3962751 for the mark SOAP & WATER EVERYDAY. The refusal to register based on this registration was withdrawn on January 9, 2017.

⁸ Applicant submitted pages from Registrant’s website that indicate this is Registrant’s intended meaning of the phrase. At <http://www.soapandwater.com>, attached to Applicant’s January 9, 2017 Response at 4.

its dominant position in the mark. *See Viterra*, 101 USPQ2d at 1909; *In re Mighty Leaf Tea*, 94 USPQ at 1260 (rejecting an argument that the specific style of a registered mark could serve to distinguish the applicant's mark in standard character form). Pages from Registrant's website suggest that Registrant displays the mark in such stylization:



In view of the foregoing, we find that the marks are similar in appearance, pronunciation, connotation and overall commercial impression due to the shared identical, and dominant phrase "SOAP & WATER." Any distinction in the marks caused by the additional terms is outweighed by the overall similarity resulting from the shared phrase.

Accordingly, the *DuPont* factor regarding the similarity of the marks favors a finding of likelihood of confusion.

⁹ At <http://www.soapandwater.com>, attached to Applicant's January 9, 2017 Response at 4. It is proper to consider Registrant's advertising in deciphering the commercial impression the mark itself is likely to make on the relevant consuming public. *See Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030 (TTAB 2016); *The North Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217 (TTAB 2015); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984); *Northwestern Golf Co. v. Acushnet Co.*, 226 USPQ 240, 244 (TTAB 1985) ("Evidence of the context in which a particular mark is used on labels, packaging, etc., or in advertising is probative of the significance which the mark is likely to project to purchasers."). *Cf. American Rice, Inc. v. H.I.T. Corp.*, 231 USPQ 793, 796 (TTAB 1986) ("we may take into account whether the trade dress of packages or labels in the application file as specimens, or otherwise in evidence, may demonstrate that the trademark projects a confusingly similar commercial impression.").

Relatedness of the Goods and Services/Trade Channels/Classes of Purchasers

We next turn to a comparison of Applicant's services with those goods and services in the cited registrations. In making our determination under the second *DuPont* factor, we look to the goods and services as identified in the involved application and cited registrations. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). For purposes of the *DuPont* factors that are relevant to this appeal we will consider Applicant's involved application for a "retail store service" and Registration No. 4874946 for "retail store services" because these both involve the provision of services rather than the sale of goods, and further, both involve the same type of services. If likelihood of confusion is found as to the '946 registration, it is unnecessary to consider the other cited registration because the services in the '946 registration are more directly related to Applicant's services than are the goods in the '291 registration.¹⁰ Conversely, if likelihood of confusion is not found as to the service mark in the '946 registration, we would not find likelihood of confusion as to the '291 trademark. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

Applicant provides retail store services "featuring bath and body products." Registrant provides retail store services featuring "personal care products."

¹⁰ The marks in the two registrations, of course, are the same.

Applicant's identification also includes the limitation that its retail store services are only available within a section of a retail supermarket. However, the fact that the services are provided within one section of a retail supermarket does not change the nature of the services, which remain the provision of retail store services.¹¹ Applicant's recitation of a "retail store service within a section of a supermarket" essentially identifies retail store services limited to a specific channel of distribution, namely supermarkets. Registrant's trade channels are unlimited, and thus include supermarkets. There is no viable distinction in the context of the second *DuPont* factor between retail store services provided by way of a supermarket and retail store services provided inside a supermarket.

There is also a close relationship between Applicant's and Registrant's retail store services because each provides services featuring the same types of products. While we are specifically addressing the relationship between Registrant's and Applicant's *services*, rather than on or in connection with *goods*, we recognize that personal care products and bath and body products are overlapping categories, in that each includes products designed for washing, caring for, or pampering the body. Indeed, Registrant's registration for goods (Registration No. 4358291) identifies as "personal care products" goods that would also be described as bath or body products: "body lotion, bath gels, shower gels, body sprays, bath soaps, body scrubs and cosmetic

¹¹ We note, however, that as the application is presently based on Applicant's bona fide intent to use the mark, any specimens submitted to show use of the mark in association with the recited services must display the mark as a source-indicator for the retail store services themselves and not merely refer to or identify the goods being sold.

preparations for cosmetic body wrap applications for general personal care.” In addition, the Internet materials submitted into the record demonstrate that “personal care products” such as are provided by Registrant, encompass Applicant’s bath and body products. For example:

- Copies of pages from the Sephora USA, Inc. website show that Sephora offers online ordering of cosmetics, cleansers, body gels and other personal care products;¹²
- Webpages from ULTA Salon, Cosmetics & Fragrance, Inc. advertise personal care bath products such as an exfoliating body scrub under the ULTA brand;¹³ and
- The M•A•C website sells personal care products such as face and body lotion, eye cream and moisture gel online under the M•A•C brand.¹⁴

The record evidence also includes an example of a supermarket that sells bath and body products online on the same webpage as other personal care products.¹⁵

Accordingly, we find Applicant’s and Registrant’s retail store services to be closely related and find that the trade channels as described in the application and registration overlap; that is, Applicant’s recitation includes a limitation to supermarket sections and Registrant’s recitation is broadly worded such that Registrant’s trade channels would encompass the trade channels of retail

¹² At www.sephora.com/sephora-collection, attached to December 21, 2105 Office Action at 17-21.

¹³ At <http://www.ulta.com>, id. at 39.

¹⁴ At <http://www.maccosmetics.com>, id. at 48-51.

¹⁵ See at <https://www.wegmans.com/products/personal-care-and-makeup.html>, attached to January 24, 2017 Final Office Action at 138.

supermarket sections. Because the trade channels overlap, the consumers to whom the services are marketed are the same. Further, although we are comparing services and not goods, we are mindful that the purpose of the services is to sell the goods, and given that personal care products and bath and body products are generally low-cost, every-day consumer items, average purchasers of these goods (utilizing the recited services to access the goods) would exercise no more than ordinary care in their selections of Applicant's and Registrant's services.

The second and third *DuPont* factors strongly favor a finding of likelihood of confusion.

Conclusion

After considering all of the *DuPont* factors for which there has been evidence or argument, including evidence and arguments not specifically mentioned in this decision, we find that Applicant's mark THE SOAP & WATER COMPANY and Registrant's mark SOAP & WATER CLEAN WATER THROUGH SOAP are similar and that the services are closely related and offered to the same classes of consumers through identical trade channels.

Accordingly, we find that the mark THE SOAP & WATER COMPANY for "retail store service within a section of a retail supermarket featuring bath and body products" is likely to cause confusion with the mark SOAP & WATER CLEAN WATER THROUGH SOAP for "retail store services and online retail store services featuring cosmetics, skin care and personal care products" (Reg. No. 4358291). Inasmuch as we have determined a likelihood of confusion exists on this basis, we

Serial No. 86749605

need not consider whether a likelihood of confusion exists between Applicant's mark and Registrant's mark for "soaps for personal use; personal care products, namely, body lotion, bath gels, shower gels, body sprays, bath soaps, body scrubs and cosmetic preparations for cosmetic body wrap applications for general personal care" (Reg. No. 4874946).

Decision: The refusal to register under Section 2(d) is affirmed.