

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: August 13, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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S&G Hampton Sun, LLC

v.

Hamptons Glow, LLC

—
Opposition No. 91222391

Cancellation No. 92062549

—
Robert L. Powley, Keith E. Sharkin and David A. Jones of Powley & Gibson PC,
for S&G Hampton Sun, LLC.

Rachel Thompson, pro se, for Hamptons Glow, LLC.

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Before Thurmon, Deputy Chief Administrative Trademark Judge, Ritchie and
Pologeorgis, Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Hamptons Glow, LLC (“Defendant”) filed an intent-to-use application to register
the following composite mark on the Principal Register:



for “Aromatherapy fragrance candles; Candles; Candles and wicks for candles for lighting; Perfumed candles; Scented candles; Scented wax for use in candle warmers; Votive candles” in International Class 4.¹

Defendant is also the owner of a registration on the Principal Register for the same composite mark that is the subject of its involved application, but for the following goods in International Class 3:

Aromatic body care products, namely, body lotion, shower gel, cuticle cream, shampoo, conditioner, non-medicated lip balm, soap, body polish, body and foot scrub and non-medicated foot cream; Beauty creams for body care; Body and beauty care cosmetics; Cosmetic creams for skin care; Cosmetic preparations for body care; Cosmetic preparations for protecting the skin from the sun's rays; Cosmetic preparations for skin care; Cosmetic preparations for skin renewal; Cosmetic products in the form of aerosols for skin care; Exfoliants for face and body; Fragranced body care preparations, namely, exfoliants, lotions, cellulite and skin firming, sunscreen and sunblock and self tanners; Fragranced face care preparations, namely, face washes, moisturizers, skin renewal; Fragranced skin care preparations,

¹ Application Serial No. 86402060, filed on September 22, 2014, based on an allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The application includes the following description of the mark:

The mark consists of A tan girl with black hair wearing a blue bikini, black sunglasses and a blue and light blue hat. The color tan is reflected in the color of her skin. The girl design element sits above a wavy blue line. Just below the wavy blue line design element is the wording HAMPTONS GLOW. The word HAMPTONS text is represented in the color black and the word GLOW text is represented in the color gold. The word HAMPTONS appears in black text just above the word GLOW which appears in gold text. The blue wavy line design element sits between the girl design element and the words HAMPTONS GLOW.

The colors blue, light blue, black, tan and gold are claimed as a feature of the mark. The color white is only represented as a background color. The term “HAMPTONS” has been disclaimed.

namely, exfoliants, moisturizers, bronzers; Lotions for face and body care.”²

I. The Pleadings

S&G Hampton Sun, LLC (“Plaintiff”) filed a notice of opposition to Defendant’s application and petitioned to cancel Defendant’s registration.³ As the sole ground for opposition and cancellation, Plaintiff alleged, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), that Defendant’s marks are likely to cause confusion with Plaintiff’s word mark HAMPTON SUN, which it has used at common law on various skin care products, tanning and sunscreen preparations, bathing products and room fragrances since May 1, 2005, and is registered on the Principal Register in standard characters (the “704 registration.”) for, among other things, various skin and sun care products.⁴ In further support of its Section 2(d) claim asserted in the opposition proceeding, Plaintiff also pleaded ownership of a pending intent-to-use application on

² Reg. No. 4740353, issued on May 19, 2015, claiming April 1, 2014 as the date of first use and June 23, 2014 as the date of first use in commerce. We note that the description of the mark subject to this registration is slightly different than the description of the mark of Defendant’s involved application. The differences, which are minor and nonsubstantive, are not consequential to our decision, as they simply include slightly different wording to describe the same composite mark. Notwithstanding the foregoing, Defendant’s registration also includes a disclaimer of the term HAMPTONS, as well as the following color statement: The colors blue, light blue, black, tan and gold are claimed as a feature of the mark.

³ The opposition and cancellation proceedings were consolidated in an order designating the opposition as the “parent case.” *See* 11 TTABVUE (in Opposition No. 91222391) and 5 TTABVUE (in Cancellation No. 92062549). All references in this decision are to the TTABVUE record in Opposition No. 91222391 unless otherwise indicated.

⁴ Notice of Opposition ¶¶ 10-16, 1 TTABVUE 7-8 in Opposition No. 91222391; Petition to Cancel ¶¶ 11-14, 1 TTABVUE 5-6 in Cancellation No. 92062549.

the Principal Register, also for the mark HAMPTON SUN in standard characters for, among other things, “Candles; scented candles” in International Class 4.⁵

In its answers, Defendant denied the salient allegations asserted in Plaintiff’s notice of opposition and petition to cancel except Defendant admitted that, according to USPTO records, Plaintiff is the current owner of its pleaded registration and that Plaintiff is the owner of its pleaded pending intent-to-use application but only for the goods identified in International Classes 3 and 4, and not for the services identified in International Class 42.⁶ Defendant also asserted various putative “affirmative defenses.” We construe Defendant’s “affirmative defenses” as mere amplifications of the denials in its answers. *See Order of Songs of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995).

Additionally, Defendant asserted in its trial brief for the first time that Plaintiff engaged in a pattern of unfair litigation and tactics.⁷ This argument is based, in part,

⁵ Notice of Opposition ¶¶ 4-5, 1 TTABVUE 5-6 in Opposition No. 91222391. As noted below, Plaintiff submitted a status and title copy of its pleaded pending application Serial No. 86386811 with its notice of reliance. *See* Exh. 40, 43 TTABVUE. The record demonstrates that Plaintiff’s pleading pending intent-to-use application was filed on September 5, 2014, a filing date that precedes the filing date of Defendant’s subject application in the opposition proceeding.

⁶ Defendant’s Answers, 4 TTABVUE in both Opposition No. 91222391 and Cancellation No. 92062549.

⁷ 53 TTABVUE 18-19. Pursuant to its “Third Affirmative Defense” in its answer to the Notice of Opposition, Defendant alleges that it “has continuously used its mark HAMPTONS GLOW and tanning girl design on goods in International Class 3, as set forth in Registration No. 4,740,353, without any opposition or objection by Opposer and without any known occurrence of any purchaser confusion.” 4 TTABVUE 5-6. These allegations are insufficient to raise a laches or acquiescence defense in that pleading. Moreover, to the extent Defendant is attempting to assert a prior registration or *Morehouse* defense, such a defense is unavailable inasmuch as the goods identified in Defendant’s involved application differ from those identified in its subject registration in the cancellation proceeding. *See Morehouse Mfg. Corp.*

on a June 2014 letter in which Plaintiff's counsel demanded that Defendant withdraw its trademark application or face an opposition from Plaintiff. Defendant notes that no opposition to its underlying application of its subject registration in the cancellation proceeding was filed and that Plaintiff did not petition to cancel until November 2, 2015. Plaintiff responded by arguing that its actions were proper.⁸ We construe these allegations by Defendant as an unpleaded affirmative defense of laches or acquiescence. Plaintiff did not object to the presentation of this defense, but responded to it on the merits. For these reasons, we consider this unpleaded affirmative defense of laches or acquiescence to be tried by implied consent of the parties and the pleadings amended to conform to the evidence. Fed. R. Civ. P. 15(b); *UMG Recordings Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1872 n.3 (TTAB 2011) (implied consent found where nonoffering party raises no objection to introduction of evidence on the issue and was fairly apprised that the evidence was being offered in support of the issue); *Citigroup Inc.* 94 USPQ2d at 1655-56 (Board deemed unpleaded affirmative defense of tacking by prior use of an unpleaded mark to have been tried by implied consent pursuant to Fed. R. Civ. P. 15(b)), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011).

v. J. Strickland & Co., 407 F.2d 881, 160 USPQ 715 (CCPA 1969); *see also Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1651 (TTAB 2010), *aff'd*, *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) ("This defense applies where an applicant owns a prior registration for essentially the same mark **identifying essentially the same goods or services** that are subject of the proposed application.") (emphasis added).

⁸ 54 TTABVUE 12-13.

II. The Record

The record consists of the pleadings, the files of Defendant's subject application and registration, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), and the following evidence submitted by the parties:

A. Plaintiff's Evidence:

- Testimony Declaration of Mr. Grant Wilfley, Plaintiff's Vice President, and accompanying exhibits;⁹
- Notices of Reliance on selected discovery responses of Defendant;¹⁰
- Notice of Reliance on excerpts from the discovery deposition of Ms. Rachel Thompson, Defendant's founder;¹¹
- Notice of Reliance on screenshots from various websites downloaded from the Internet that purportedly offer for sale Plaintiff's sun and skin care goods;¹²
- Notice of Reliance on status and title copies of Plaintiff's pleaded registration and pleaded pending intent-to-use application;¹³ and
- A rebuttal Notice of Reliance on screenshots from various websites downloaded from the Internet purporting to show both parties' sun and skin care goods being sold on the same website.¹⁴

⁹ 30 TTABVUE 2-8, Exhs. 17-20, 22-29; 31-37 TTABVUE Exhs. 21-1 to 21-7.

¹⁰ 38 TTABVUE Exhs. 30 (Defendant's Responses to Interrogatories in the Opposition), 31 (Defendant's Responses to Interrogatories in the Cancellation), 32 (Defendant's Responses to Requests for Admission); 39 TTABVUE Exhs. 33-35 (written responses and documents produced by Defendant in response to Interrogatories). Some of the documents submitted with Exhibits 33-35 are marked confidential. We do not find the details of these documents relevant to these proceedings, and no confidential information from these exhibits is included in this decision.

¹¹ 40-41 TTABVUE (presented as Exh. 36). Ms. Thompson's entire discovery deposition transcript is marked confidential. To the extent we rely on this testimony, we do so only in general terms.

¹² 42 TTABVUE Exhs. 37 (Plaintiff's website), 38 (www.jet.com), 39 (www.amazon.com).

¹³ 43 TTABVUE Exhs. 40 (registration), 41 (application).

¹⁴ 46 TTABVUE (identifying the evidence); 48 TTABVUE Exhs. 42 (ebay), 43 (Wish).

B. Defendant's Evidence

- Testimony declaration of Ms. Rachel Thompson, Defendant's founder,¹⁵ and the following accompanying exhibits:
 - (1) media mentions, marketing, and sales websites for Defendant's sun and skin care products and various USPTO records relating to Defendant's registration and application;¹⁶
 - (2) a purported cease and desist letter from Plaintiff's counsel to Defendant dated June 11, 2014;¹⁷ and
 - (3) a commercial trademark search report.¹⁸

We note that some of the evidence proffered by Plaintiff has been designated confidential and filed under seal. We have discussed only in general terms the relevant evidence submitted under seal, if necessary and appropriate. However, to the extent Plaintiff has improperly designated testimony and evidence as confidential, the Board has disregarded the confidential designation when appropriate. Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g) (“[t]he Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.”); *see also Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014).

We additionally note that the parties have submitted printouts from various websites downloaded from the Internet. Although admissible for what they show on their face, *see* Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2), this evidence also contains hearsay that may not be relied upon for the truth of the matters asserted

¹⁵ 45 TTABVUE 2-12.

¹⁶ *Id.* at Exhs. 1-6, 8-10.

¹⁷ *Id.* at Exh. 7.

¹⁸ *Id.* at Exh. 11.

unless supported by testimony or other evidence. Fed. R. Evid. 801(c); *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1038 (TTAB 2018); *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1039-40 (TTAB 2010); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 704.08(b) (2019) (“The probative value of Internet documents is limited. They can be used to demonstrate what the documents show on their face. However, documents obtained through the Internet may not be used to demonstrate the truth of what has been printed.”).

III. Standing

Standing is a threshold issue that must be proven by the plaintiff in every inter partes case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). Our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit, has enunciated a liberal threshold for determining standing, namely that a plaintiff must demonstrate that it possesses a “real interest” in a proceeding beyond that of a mere intermeddler, and “a reasonable basis for his belief of damage.” *Empresa Cubana Del Tabaco* 111 USPQ2d at 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie*, 50 USPQ2d at 1026.

Plaintiff has demonstrated through the USPTO electronic database printout made of record that it is the owner of its pleaded registration and that the registration is valid and subsisting. Because Plaintiff’s registration is of record and since Defendant

did not assert a counterclaim to cancel the registration, Plaintiff has established its standing in both the opposition and cancellation proceedings. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Otter Prods. LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254 (TTAB 2012). Moreover, in the context of the opposition proceeding, Plaintiff has made of record a status and title copy of its pleaded and earlier-filed intent-to-use application. The arguable similarities of Plaintiff's and Defendant's marks and the identical nature of the goods in part which are evident from the face of the status and title copy of Plaintiff's application suffice to show that Plaintiff possesses a real interest in the opposition proceeding beyond that of a mere intermeddler and a reasonable basis for its belief of damage. *See, e.g., Spirits Int'l B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Statik Kooperatifleri Birliđi*, 99 USPQ2d 1545, 1548 (TTAB 2011). Accordingly, Plaintiff's intent-to-use application, which is of record, further supports its standing in the opposition proceeding of this consolidated case.

IV. Section 2(d) Claim

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). To prevail on its Section 2(d) claim, Plaintiff must prove, by a preponderance of the evidence, that it has priority in the use of its pleaded HAMPTON SUN mark and that use of Defendant's HAMPTONS GLOW and design

mark is likely to cause confusion, mistake, or deception as to the source or sponsorship of Defendant's goods, *Cunningham*, 55 USPQ2d at 1848, even in the absence of contrary evidence or argument. *Threshold TV, Inc. v. Metronome Enters., Inc.*, 96 USPQ2d 1031, 1040 (TTAB 2010).

With regard to the opposition proceeding, we will focus our analysis primarily on Plaintiff's pleaded intent-to-use application for the mark HAMPTON SUN in standard characters. If we find confusion likely between that mark and the goods identified in Plaintiff's application with Defendant's mark and the goods identified in Defendant's subject application, we need not consider the likelihood of confusion between Defendant's mark and Plaintiff's pleaded registered mark. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Priority

With regard to the opposition proceeding, Plaintiff may rely on the filing date of its intent-to-use application to establish constructive use of its mark on that date under the provisions set forth in Section 7(c) of the Trademark Act. *See Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840, 1845 n.7 (TTAB 1995); *see also Spirits Int'l B.V.*, 99 USPQ2d at 1548. As the electronic printout from the USPTO database of Plaintiff's pleaded application shows, its filing date of September 5, 2014 precedes the September 22, 2014 filing date of Defendant's involved application.

A caveat to this principle is that any judgment entered in favor of Plaintiff based on such constructive use is contingent upon the ultimate issuance of a registration. *Larami Corp.*, 36 USPQ2d at 1845 n.7 ("Section 7(c) provides that any judgment

entered in favor of a party relying on constructive use -- whether that party is in the position of plaintiff or defendant in a Board proceeding -- is contingent upon the ultimate issuance of a registration to that party.”); *see also Spirits Int’l B.V.*, 99 USPQ2d at 1548. Thus, even if Plaintiff can demonstrate a likelihood of confusion in the opposition proceeding based on its pleaded application, it cannot prevent the issuance of a registration to Defendant on this ground until it submits evidence that its own application is registered, thereby perfecting its priority.¹⁹

In a cancellation proceeding in which both plaintiff and defendant own registrations, as is the case here, priority is at issue and Plaintiff has the burden of proving its priority. *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281 (TTAB 1998). A plaintiff in a cancellation proceeding may rely on the filing date of the underlying application of its pleaded registration for priority, or introduce evidence of its actual date of first use in commerce. *Media Online Inc. v. El Classifcado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008); *Brewski Beer*, 47 USPQ2d at 84. Here, the filing date of the underlying application of Plaintiff’s pleaded registration, i.e., January 30, 2004, precedes the February 14, 2014 filing date of the underlying application of Defendant’s subsection registration. Defendant has not submitted any evidence demonstrating use of its mark prior to January 30, 2004.

¹⁹ Notwithstanding, we note that because Plaintiff’s pleaded registration is of record, priority is not an issue in the opposition proceeding with respect to the goods identified in Plaintiff’s registration. *See Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy, Inc. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)). However, since our likelihood of confusion analysis in the opposition proceeding is based on Plaintiff’s application, Plaintiff may only establish its constructive use priority when, and if, its application matures into a registration.

Accordingly, Petitioner has established its priority in the cancellation proceeding of this consolidated case.

B. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). For example, the Board can “focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (quoting *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001)). The fame of the prior mark can also be critical. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). These factors, and the other relevant *DuPont* factors are discussed below.

1. Similarity of the Goods

We first address the second *DuPont* likelihood of confusion factor focusing on the comparison of the goods at issue. “In the context of likelihood of confusion, it is sufficient to find likelihood of confusion as to the entire class if likelihood of confusion is found with respect to use of the mark on any item in a class that comes within the description of goods.” *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 U.S.P.Q.2D 1734, 1745 (TTAB 2014) (citing *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d

1335, 209 USPQ 986, 988 (CCPA 1981) and *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007)).

Turning first turn to the opposition proceeding, we compare the goods identified in Defendant’s involved application vis-à-vis the goods identified in Plaintiff’s pleaded application. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. 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). Plaintiff’s application includes the following goods: “candles; scented candles.”²⁰ Defendant’s involved application identifies the goods as “Candles; Perfumed candles; Scented candles.” Both of the parties’ identifications include the identical goods, namely, candles and scented candles. As such, the goods are legally identical in part.

Turning next to the cancellation proceeding, we similarly focus on the goods as identified in each party’s respective registration. We note the following overlapping goods between the parties’ respective registrations:

Plaintiff’s Plead Registration	Defendant’s Subject Registration
Tanning and sunscreen preparations; sunblock; sun care lotion; sun cream; sun tan gel; sun tan lotion; suntan oil	sunscreen and sunblock and self tanners
cosmetic preparations for body care; facial cream; facial lotion	Cosmetic preparations for body care; Beauty creams for body care; Cosmetic creams for skin care
face and body moisturizers, skin lotion	Lotions for face and body care

²⁰ Plaintiff’s application also identifies goods and services in International Classes 3 and 42. These goods and services, however, are not relevant to our analysis.

The examples provided above show that the parties' respective goods in the cancellation proceeding are identical or legally identical in part.

The second *DuPont* factor, therefore, strongly favors a finding of likelihood of confusion in both the opposition and cancellation proceedings.

2. Similarity of Trade Channels and Classes of Purchasers

Next we consider established, likely-to-continue channels of trade, the third *DuPont* factor. We initially note that there are no restrictions as to trade channels or classes of purchasers set forth in the identification of goods of Plaintiff's application or pleaded registration or Defendant's involved application and subject registration. In view thereof and because there are identical goods at issue in both the opposition and the cancellation, we presume the channels of trade and classes of purchasers are the same for these identical goods. *See In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018) ("Because the services described in the application and the cited registration are identical, we presume that the channels of trade and classes of purchasers are the same."); *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Glob. Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

The evidence of record further supports this conclusion in the cancellation proceeding, as it shows that both parties' sun and skin care goods are sold via the Internet, including at some of the same online retailers, such as www.amazon.com and www.jet.com.²¹ The evidence also shows that marketing of these goods includes advertising and extensive media mentions, such as in articles about skin care and sun protection.²² Accordingly, the third *DuPont* factor also weighs in favor of finding a likelihood of confusion in both the opposition and cancellation proceedings.

3. Strength of Plaintiff's HAMPTON SUN mark

The fifth *DuPont* factor, the fame of the prior mark, and the sixth *DuPont* factor, the number and nature of similar marks in use for similar goods, *DuPont*, 177 USPQ at 567, may be considered in tandem to determine the strength of Plaintiff's mark and the scope of protection to which it is entitled. *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017).²³ "In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition." *Bell's Brewery*, 125 USPQ2d at 1345 (citing *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014)); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681,

²¹ 30 TTABVUE Exhs. 18, 22; 42 TTABVUE Exhs. 37, 38, 39; 45 TTABVUE 5 ¶ 11.

²² 31-37 TTABVUE (Plaintiff's advertising and media mentions for sun and skin care goods); 45 TTABVUE Exh. 4 (similar materials for Defendant's sun and skin care goods).

²³ The Federal Circuit has reiterated that "[w]hile dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion fame varies along a spectrum from very strong to very weak." *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694 (internal quotation omitted)).

1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”).

We initially determine the alleged fame of Plaintiff’s HAMPTON SUN mark under the fifth *DuPont* factor. In determining the commercial strength of Plaintiff’s HAMPTON SUN mark under this factor, such strength “may be measured indirectly by the volume of sales and advertising expenditures in connection with the [goods] sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the [goods] identified by the mark []; and the general reputation of the [goods].” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017).

To demonstrate the commercial strength of its HAMPTON SUN mark in connection with the goods identified in its ‘704 registration, Plaintiff submitted a variety of evidence. The evidence of record shows that (1) Plaintiff has used its HAMPTON SUN mark in connection with its skin and sun care products continuously in U.S. commerce since 2005;²⁴ (2) since 2005, Plaintiff’s sales under the HAMPTON SUN mark in the United States have totaled more than \$12 million;²⁵ (3) its total sales in 2013, the year proceeding Defendant’s asserted first use of its mark, was \$1.4 million and in 2016 totaled \$1.9 million;²⁶ (4) Plaintiff’s goods under the

²⁴ Wilfley Decl. ¶ 8, 30 TTABVUE 3.

²⁵ *Id.* at ¶ 15, 30 TTABVUE 4.

²⁶ *Id.*

HAMPTON SUN mark are generally sold at retail for between \$10.00 and \$70.00;²⁷ (5) since 2005, Plaintiff has expended more than \$750,000 in advertising and promotion of its skin and sun care products under its HAMPTON SUN mark;²⁸ (6) Plaintiff has advertised its goods in several national and regional publications, including InStyle, Cosmopolitan, Womens' Health, O The Oprah Magazine, US Weekly, Harper's Bazaar, Vogue, People, WWD Beauty Biz, Town & Country, Travel + Leisure, and Coastal Living;²⁹ (7) Plaintiff's HAMPTON SUN skin and sun care products are advertised and sold through its website www.hamptonsuncare.com and that since December 2015, when Plaintiff first began tracking statistics regarding its website, the website has generated more than 1.3 million impressions and over 8,500 "clicks";³⁰ (8) Plaintiff has also sold its HAMPTON SUN skin and sun care products in specialty store, resorts, and spas such as Ritz Carlton, and large retail chains such as Victoria's Secret, Nieman Marcus, Blue Mercury, Bergdorf Goodman and SpaceNK in Bloomingdales, as well as major online retailers such as Sephora, Jet and Amazon;³¹ (9) Plaintiff has maintained a presence on social media platforms such as Facebook (9,000 followers), Twitter (approximately 3,500 followers) and Instagram (approximately 5,000 followers);³² (10) Plaintiff's HAMPTON SUN skin and sun care

²⁷ *Id.* at ¶ 14, 30 TTABVUE 4.

²⁸ *Id.* at ¶ 17, 30 TTABVUE 4.

²⁹ *Id.* at ¶ 16 and accompanying Exh. 21, 30 TTABVUE 4 and 31-37 TTABVUE.

³⁰ *Id.* at ¶ 18 and accompanying Exh. 22, 30 TTABVUE 4 and 172-294.

³¹ *Id.* at ¶ 12 and accompanying Exh. 20, 30 TTABVUE 3 and 121-171.

³² *Id.* at ¶ 19 and accompanying Exh. 23, 30 TTABVUE 4 and 295-299.

products have received unsolicited media coverage throughout the United States, including The New York Times Magazine;³³ (11) Plaintiff has received several awards including: Shape Magazine beauty awards in 2014 for “Best for Babies” and 2015 for Best Self-Tanner,” along with a 2016 “Best Sun Product” award from Star Magazine;³⁴ and (12) Plaintiff’s skin and sun care products under its HAMPTON SUN mark have been recommended by dermatologists.³⁵

“In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, we think that it is the duty of a plaintiff asserting that its mark is famous to clearly prove it.” *Blue Man Prods. Inc. v. Tarmann*, 75 USPQ2d 1811, 1819 (TTAB 2005).

When viewing Plaintiff’s “fame” evidence in its totality, we find that the evidence is insufficient to demonstrate that Plaintiff’s HAMPTON SUN mark falls on the very strong end of the fame spectrum for likelihood of confusion purposes. We initially note that the length of time Plaintiff has used its HAMPTON SUN mark in commerce, standing alone, is not sufficient to establish that its mark has achieved such commercial renown that it may be considered a very strong mark. Moreover, while Plaintiff’s dollar amount of sales based on the price point of its products and advertising figures do not constitute a trivial amount of expenditures and sales,

³³ *Id.* at ¶ 21 and accompanying Exh. 25, 30 TTABVUE 5 and 326-331.

³⁴ *Id.* at ¶ 22 and accompanying Exh. 26, 30 TTABVUE 5 and 332-398.

³⁵ *Id.* at ¶ 23 and accompanying Exh. 27, 30 TTABVUE 5 and 399-406.

Plaintiff has failed to submit any evidence to demonstrate (1) how its sales and advertising figures compare to its competitors in the industry, (2) how many times consumers encounter its HAMPTON SUN mark for skin and sun care products, or (3) any context for its achievements in the skin and sun care product industry, e.g., market share. Without comparative numbers or market share percentages, it is difficult to place the apparent success or renown of Plaintiff's HAMPTON SUN mark into context. *Bose Corp.*, 63 USPQ2d at 1309. In other words, it is impossible to ascertain from this record the extent to which consumers have been exposed to Plaintiff's skin and sun care products under its HAMPTON SUN mark vis-à-vis its competitors, and, thus, whether Plaintiff's evidence of sales, advertising and media exposure translates into a mark that falls on the very strong end of the fame spectrum.

With regard to Plaintiff's advertising, although the record demonstrates that Plaintiff's HAMPTON SUN skin and sun care products have been advertised in a number of national and regional publications, it is unclear how often these advertisements have been placed in such publications since it began using its mark in 2005 so as to demonstrate widespread consumer recognition of Plaintiff's mark.

As to the number of followers of Plaintiff's social media platforms, i.e., Facebook, Twitter and Instagram, such evidence falls short of demonstrating the extent to which the number of followers translates into widespread recognition of Plaintiff's HAMPTON SUN marks among the relevant consuming public, and also lacks context. We are simply without enough information to determine the degree to which

Plaintiff's social media followers are significant. The same rationale holds true regarding the number of "impressions" and "clicks" on Plaintiff's website www.hamptonsuncare.com.

Finally, the amount of unsolicited media attention and awards and accolades received by Plaintiff, including product recommendation by dermatologists, is not so extensive so as to demonstrate widespread recognition of Plaintiff's HAMPTON SUN mark used in connection with skin and sun care products.

Notwithstanding, based on the totality of the evidence submitted by Plaintiff which the Board may consider, including the evidence submitted under seal, we find that Plaintiff has demonstrated that its HAMPTON SUN mark has achieved somewhat appreciable commercial success and renown when used in association with skin and sun care products but only to the extent that it has achieved a marginal degree of fame for purposes of likelihood of confusion. Thus the fifth *DuPont* factor only slightly favors Plaintiff in the cancellation proceeding.³⁶

We next address the sixth *DuPont* factor, the number and nature of similar marks in use on similar goods. *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1033 (TTAB 2016). Defendant contends that Plaintiff's HAMPTON SUN mark is comprised of such weak, commonly used elements that consumers will look to the other features in Defendant's mark to differentiate the

³⁶ There is no evidence of fame or market strength for Plaintiff's HAMPTON SUN mark used in association with the International Class 4 goods identified in its application in the opposition. This factor is therefore neutral in the context of the opposition proceeding.

marks in appearance, sound, meaning and commercial impression.³⁷ Specifically, Defendant maintains that the designation HAMPTON or HAMPTONS is weak or diluted when used in association with the goods under Plaintiff's HAMPTON SUN mark.³⁸ To demonstrate this alleged weakness, Defendant submitted a commercial trademark search report from 2014 created by a third-party. This document contains listings of federal and state trademark registrations and information from a variety of sources. Trademark search reports from a third party have limited probative value. However, even if we were to consider the search report, we would not be persuaded that third parties are using the designation HAMPTON or HAMPTONS or that Plaintiff's HAMPTON SUN mark is weak. Specifically, the federal and state registrations in the search report do not establish use of a trademark and therefore have limited probative value. *Faultless Starch Co. v. Sales Producers Assoc., Inc.*, 530 F.2d 1400, 189 USPQ 141 (CCPA 1976); *Centraz Indus., Inc. v. Spartan Chemical Co., Inc.*, 77 USPQ2d 1689, 1701 (TTAB 2006) (trademark search report is not credible evidence of the third-party uses or registrations listed in the report); *see also* 2 J. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:59 (5th ed. 2019) ("A trademark search report, in addition to being hearsay evidence, has been held incompetent to prove either registration or use of third party marks."). Indeed, mere mention of third-party registrations and use in a search report does not make such registrations and use of record. *See* TBMP 704.03(b)(1)(B) ("[A] party may not

³⁷ Defendant's Trial Brief, p. 21, 53 TTABVUE 22.

³⁸ *Id.*

make a third-party registration of record simply by introducing a list of third-party registrations that includes it; or by filing a trademark search report in which the registration is mentioned;”); *see also In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998) (“Applicant submitted the approximately 45 listings from a commercial trademark search report. These types of search reports are not credible evidence of the existence of the applications and/or registrations listed in such reports.) and *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994) (“[T]he Board will not consider copies of a search report or information taken from a private company's data base as credible evidence of the existence of the registrations listed therein.”) (citing *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983)).

We similarly find that the listings of marks and business names, alone, do not demonstrate use of the marks in commerce. Particularly, they do not reveal the extent of the use made by the listed third-party businesses; some of the businesses may never have gotten off the ground, or may have gone out of business; and some of the businesses may be small enterprises, in remote locations, that have affected only a minuscule portion of the general purchasing public for the goods involved in this consolidated proceeding. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559 (TTAB 1996); *Carl Karcher Enterprises Inc. v. Stars Rest. Corp.*, 35 USPQ2d 1125 (TTAB 1995). With regards to the remaining information in the search report such as the Internet addresses and webpages, they too have limited probative value because

there is no evidence that the websites are still active or the extent consumers have viewed the websites.

With regard to the conceptual strength of Plaintiff's HAMPTON SUN mark, we note that the term HAMPTON has a geographically suggestive connotation (and we further note that Defendant has disclaimed "HAMPTONS" in its subject registration and pending application). The villages and associated beaches on the southeastern shores of Long Island, New York are known collectively as "the Hamptons."³⁹ Indeed, Plaintiff concedes that its HAMPTON SUN mark "was selected to evoke the image of a luxury product line made for the sophisticated lifestyle, such as that of the beautiful beaches of eastern Long Island, New York, in the minds of consumers."⁴⁰

Based on the foregoing, we find that Plaintiff's HAMPTON SUN mark possesses a degree of conceptual weakness due to its geographically suggestive connotation. As a result, the scope of protection accorded to Plaintiff's HAMPTON SUN mark is not as wide as that of an arbitrary or coined mark. That being said, even conceptually weak marks are entitled to protection, and likely confusion may still be found where the marks are very similar and the goods are identical in part. *See In re FabFitFun*,

³⁹ "Hamptons" is defined as "a string of fashionable resort communities on the south fork of eastern Long Island. The Hamptons include Westhampton, Hampton Bays, Southampton, Bridgehampton, and East Hampton." www.thefreedictionary.com based on American Heritage Dictionary of the English Language (accessed on August 2, 2019). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010).

⁴⁰ Wilfley Dec. ¶ 7, 30 TTABVUE 3.

Inc., 127 USPQ2d 1670, 1676 (TTAB 2018) (citing *China Healthways Inst., Inc. v. Wang*, 491 F.3d 1337, 83 USPQ2d 1123, 1125 (Fed. Cir. 2007)).

In light of the lack of any evidence of record demonstrating third-party use or third party registrations that employ the term HAMPTON in connection with skin and sun care products registrations, we find that the sixth *DuPont* factor regarding the number and nature of similar marks in use for similar goods to be neutral in both the opposition and cancellation proceedings, notwithstanding our finding that Plaintiff's HAMPTON SUN mark is somewhat conceptually weak.

4. Similarity of the Marks

We now consider the first *DuPont* likelihood of confusion factor, which involves an analysis of the similarity or dissimilarity of the marks “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014); accord *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968).

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 so that confusion as to the source of the goods and services offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA

1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

These consolidated proceedings involve identical goods, so less similarity of the marks is necessary to find a likelihood of confusion. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Prod. Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Plaintiff's mark in both its '704 registration and in its pleaded application is HAMPTON SUN in standard characters. Defendant's mark at issue in both



proceedings is . We find that the marks are similar in appearance in that both Plaintiff's mark and the literal portion of Defendant's mark consist of two words both of which begin with the identical singular or plural form of the word "Hampton."⁴¹ Consumers are generally inclined to focus on the first word of a mark.

⁴¹ Marks "consisting of the singular and plural forms of the same term are essentially the same mark." *Weider Publ'ns, LLC v. D & D Beauty Care Co., LLC*, 109 U.SPQ2d 1347, 1356 (TTAB 2014) (finding no material difference between the singular and plural forms of ZOMBIE such that the marks were considered the same mark); *In re Pix of Am., Inc.*, 225 USPQ 691, 692 (TTAB 1985) (noting that the pluralization of NEWPORT is "almost totally insignificant" in terms of likelihood of confusion among purchasers).

See Palm Bay Imports, 73 USPQ2d at 1692. Moreover, while we acknowledge that Defendant's mark includes a design element that is displayed more prominently than the wording HAMTPONS GLOW, when considering a composite mark containing both words and a design, as is the case with Defendant's mark, the word portion is more likely to indicate the origin of the goods or services because it is that portion of the mark that consumers use when referring to or requesting the goods or services. *See In re Viterra, Inc.*, 101 USPQ2d at 1908; *Bond v. Taylor*, 119 USPQ2d 1049, 1055 (TTAB 2016). Further, because Plaintiff's mark is in standard characters, it may be displayed in the same font or stylization as the wording in Defendant's mark. *In re Viterra, Inc.*, 101 USPQ2d at 1909. Moreover, the fact that Plaintiff's mark does not include a design element does not necessarily mean that Plaintiff's standard character mark could not be displayed with a design element similar to that of Defendant. *See In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1195 (TTAB 2018) (Ritchie concurring). On balance, we find that the marks have similar attributes in appearance.

As to sound, the marks are similar solely to the extent that the first word in each mark would be pronounced similarly by relevant consumers.

We also find that the marks are similar in connotation. The term "HAMPTONS" has been disclaimed by Defendant in that the term is geographically descriptive of Defendant's goods. The term "HAMPTON" has geographic significance with regard to Plaintiff's mark as well. As noted above, Plaintiff selected its HAMPTON SUN mark to evoke the sophisticated lifestyle of the beautiful beaches of eastern Long

Island, New York, known as the Hamptons. Moreover, many of the early media materials for Plaintiff's HAMPTON SUN product were from publications circulated in the Hamptons area in Long Island, New York.⁴² Accordingly, the term HAMPTON or HAMPTONS has at least similar geographic significance for both parties.

Plaintiff argues that because its registration has become incontestable the term HAMPTON does not serve as a geographic element in relation to its HAMPTON SUN mark.⁴³ Plaintiff's argument is unavailing.

Statutory presumptions do not affect the likelihood of confusion analysis. *Byk-Gulden, Inc. v. Trimen Laboratories, Inc.*, 211 USPQ 364, 368 (TTAB 1981) (quoting *Hyde Park Footwear Co., Inc. v. Hampshire-Designers, Inc.*, 197 USPQ 639, 641 (TTAB 1977)):

The statutory presumptions, however, do not answer the question of whether applicant's mark, for the goods identified in the application, so resemble either of opposer's marks as to be likely to cause confusion, mistake or deception. The registrations alone are incompetent to establish any facts with regard to the nature or extent of opposer's use and advertising of its trademarks or any reputation they enjoy or what purchasers' reactions to them may be.

See also Martha White, Inc. v. American Bakeries Co., 157 USPQ 215, 217 (TTAB 1968) (opposer's registration is not evidence of the nature and extent of opposer's use and advertising of its mark and, thus, is not probative of consumer reaction to the mark, no matter how long it has been registered).

⁴² 31 TTABVUE Exh. 21-1.

⁴³ Plaintiff's Reply Brief p. 5, 54 TTABVUE 9.

Here, we are considering the manner in which relevant consumers would understand portions of the parties' respective marks, not whether Plaintiff's mark, as a whole, is distinctive. Words that are understood to be geographically descriptive are less likely to cause confusion. Thus, the fact that Plaintiff's federally-registered trademark has achieved incontestable status means that it is conclusively considered to be valid, but it does not dictate that the mark lacks any geographically descriptive or suggestive connotation for purposes of determining likelihood of confusion. *See Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1036 (TTAB 2010) *cited in In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1518 n. 25 (TTAB 2016).

We further find that the second term in each mark, i.e., SUN and GLOW, convey similar connotations. The definitions of the term "glow" is "to shine with or as if with an intense heat."⁴⁴ This definition is evocative of the sun. Also, Plaintiff has made of record various media materials that demonstrate that the term "glowing" is often a term used to describe those who have been in the sun or who use a sunless tanning product.⁴⁵ Furthermore, the design element of Defendant's mark also suggests sun exposure and perhaps a "glowing" tan. These facts, when taken with the common use of the word "Hampton" or its plural form, demonstrate that the marks have a similar meaning to relevant consumers. The commercial impression of each mark is also similar to the extent that they both conjure up images of the glowing Hampton's sun.

⁴⁴ www.merrian-webster.com (accessed on August 2, 2019).

⁴⁵ Wilfley Decl., Exhs. 21-1, 21-3, and 21-7, 31 TTABVUE 10, 33 TTABVUE 14, 37 TTABVUE 7, respectively.

On balance and considering each party's mark in its entirety, as we must, we find that the overall similarities of the marks outweigh their differences, and therefore the *DuPont* factor of the similarity or dissimilarity of the marks weighs in favor of a finding of likelihood of confusion. This especially holds true since the parties' respective goods are identical in part.

5. Actual Confusion and Opportunity for Actual Confusion

Lastly, we turn to the seventh *du Pont* factor (nature and extent of any actual confusion) and the related eighth *du Pont* factor (extent of the opportunity for actual confusion).

No evidence of actual confusion was submitted.⁴⁶ The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Defendant of its mark for a significant period of time in the same markets as those served by Plaintiff under its mark. *Citigroup Inc.*, 94 USPQ2d at 1660; *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. North American Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) ("the absence of actual

⁴⁶ 52 TTABVUE 35.

confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring”).

The parties’ sun and skin care products coexisted in similar market channels for about three years before trial briefs were submitted.⁴⁷ The evidence shows that Defendant’s sales have been limited, which reduces the chances of finding actual confusion.⁴⁸ On the other hand, as Plaintiff points out, Defendant’s sun and skin care goods are sold on the Internet, both on Defendant’s own website and on prominent online retailers like amazon.com and jet.com, which also offer Plaintiff’s sun and skin care products.⁴⁹ The evidence also shows media coverage of both parties’ goods in some of the same magazines.⁵⁰ Defendant’s sales may be somewhat limited, but it appears Defendant’s mark has been presented to consumers on a number of magazines and websites.

We find this issue close in connection with the cancellation, which involves the parties’ sun and skin care goods. A three-year coexistence period with so much overlap in trade channels may in some situations be sufficient. With so many forms

⁴⁷ 53 TTABVUE 5-6 (referring to February 25, 2015 statement of use filed for use of HAMPTONS GLOW design mark on Defendant’s sun and skin care goods). There is evidence that Defendant used the mark HAMPTONS TANNING as early as 2010, but that mark was used with services and we do not find such use relevant to the period of coexistence between the marks at issue in this case. *See* Thompson Decl. p. 3, 53 TTABVUE 4.

⁴⁸ 52 TTABVUE 35 (citing evidence that Defendant’s first two years of sales totaled about \$37,000).

⁴⁹ 52 TTABVUE 31-32.

⁵⁰ 31-37 TTABVUE Exhs. 21-1 to 21-7 (showing magazines featuring Plaintiff’s sun and skin care goods); 45 TTABVUE Exhs. 4, 6 (showing similar magazines and other marketing).

of consumer input and feedback on goods sold via the Internet (e.g., consumer ratings/comments on amazon.com is one example), one would expect that at least a few instances of actual confusion would have arisen if confusion really were likely. Defendant, however, has been a relatively small player in this market, a point it concedes in its brief.⁵¹ On balance, we find the seventh and eighth *du Pont* factors to be neutral or slightly favoring Defendant in the cancellation proceeding.⁵²

6. Balancing the Factors

We have carefully considered all evidence of record and the parties' arguments, even if not specifically discussed herein, as they pertain to the relevant *DuPont* factors. We treat as neutral any *DuPont* factors for which there is no evidence or argument of record.

We conclude that although Plaintiff has not established that its HAMPTON SUN mark is very strong on the fame spectrum for likelihood of confusion purposes, the record nonetheless demonstrates that Plaintiff's mark has achieved some commercial success and renown in connection with the sale of skin and sun care products, notwithstanding the fact that the mark is somewhat conceptually weak. Moreover, the goods involved are identical in part and are therefore presumed to travel through the same trade channels and be purchased by the same classes of consumers, ordinary consumers. When considered in their entirety, the marks HAMPTON SUN and

⁵¹ 53 TTABVue 18 (identifying Defendant as a "small business").

⁵² The seventh and eighth *DuPont* factors are neutral with regard to the opposition proceeding because the evidence of record does not indicate that Defendant has commenced use of its mark in connection with the goods identified in its involved application. As such, there has been no opportunity for actual confusion to have occurred.



are similar in appearance, sound, meaning and commercial impression.

Although Defendant has demonstrated a degree of time during which the marks in the cancellation proceeding have coexisted without evidence of actual confusion, this is not sufficient to balance out the likelihood of confusion due to the overlap in the goods and the similarity of the marks.

Accordingly, we find that Plaintiff has proved a likelihood of confusion under Section 2(d) of the Trademark Act by a preponderance of the evidence in both the opposition and cancellation proceedings.

V. The Laches/Acquiescence Defense

We finally turn to Defendant's affirmative defenses of laches and acquiescence which, as noted above, have been tried by implied consent.

"The defense of laches in a trademark proceeding recognized under 15 U.S.C. § 1069 requires a showing of undue delay in asserting rights against a claimant to a conflicting mark and prejudice resulting therefrom." *Nat'l Cable TV Ass'n v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991). An acquiescence defense requires a showing that plaintiff "expressly or by clear implication, assents to, encourages, or furthers the activity on the part of the defendant, which is now objected to." *Hitachi Metals Int'l, Ltd. v. Yamakyu Chain Kabushiki Kaisha*, 209 USPQ 1057, 1067 (TTAB 1981).

We initially note that the affirmative defenses of laches and acquiescence are generally unavailable in opposition proceedings, and Defendant has not shown how

they would be applicable here. *Barbara's Bakery*, 82 USPQ2d at 1292 n.14; *see also Nat'l Cable*, 19 USPQ2d at 1432. In view thereof, Defendant's affirmative defenses of laches and acquiescence, as they pertain to the opposition proceeding, fail and are therefore dismissed.

We now turn to these affirmative defenses as they pertain to the cancellation proceeding. When a laches defense is presented in a cancellation proceeding, the period of delay is measured from the date the application for registration is published for opposition. *Nat'l Cable*, 19 USPQ2d at 1432. Laches defenses are rarely successful unless there has been a delay of at least a few years. *See e.g., Teledyne Techs., Inc. v. Western Skyways, Inc.*, 78 USPQ2D 1203, 1211 (TTAB 2006) (delay of over three and one-half years sufficient); *Murphy's Ltd. v. Murphy's Brewery Ir. Ltd.*, 25 F. App'x 987 (Fed. Cir. 2001) (delay of over three years); *Hitachi Metals*, 209 USPQ at 1068 (over five years delay). A laches defense also typically requires prejudice beyond merely continuing to use the mark. *Ralston Purina Co. v. Midwest Cordage Co.*, 373 F.2d 1015, 1019, 153 USPQ 73, 76 (CCPA 1967) (no laches where evidence of promotional expenditure was not submitted and sales data did not show any substantial growth of trade during the period at issue); *Meyers v. Asics Corp.*, 974 F.2d 1304, 1308, 24 USPQ2D 1036, 1038 (Fed. Cir. 1992) (laches requires detriment caused by the delay); *A.C. Aukerman Co. v. R.L. Chaides Constr. Co.*, 960 F.2d 1020, 1033, 22 USPQ2D 1321, 1329 (Fed. Cir. 1992) (in banc) ("The courts must look for a change in the economic position of the alleged infringer during the period of delay.").

The trademark registration Plaintiff petitioned to cancel resulted from an application that was published for opposition on October 28, 2014. The petition to cancel was filed on November 2, 2015, showing a delay of just over one year.⁵³ The only arguable prejudice Defendant has shown is the ordering of a trademark search report and the continued use of its mark. We find the evidence in this case falls far short of supporting a laches defense with respect to the cancellation petition. The delay was not long (about one year) and there is no evidence of material prejudice resulting from the delay. For these reasons, we dismiss Defendant's laches defense in the cancellation proceeding.

Turning to the affirmative defense of acquiescence as it pertains to the cancellation proceeding, we note that "[a]cquiescence is a type of estoppel that is based on the plaintiff's conduct that expressly or by clear implication consents to, encourages, or furthers the activities of the defendant." *Nashin v. Prod. Source Int'l LLC*, 107 USPQ2d 1257, 1263 (TTAB 2013) (quoting *Panda Travel, Inc. v. Resort Option Enter., Inc.*, 94 USPQ2d 1789 n.21 (TTAB 2009)); see also *Christian Broadcasting Network Inc. v. ABS-CBN Int'l*, 84 USPQ2d 1560, 1573 (TTAB 2007). Defendant has failed to submit any testimony or evidence that would demonstrate that Plaintiff expressly or by clear implication consented to, encouraged, or furthered

⁵³ There is evidence that Plaintiff had actual knowledge of Defendant's pending trademark application by June 11, 2014, but Plaintiff could not have taken any action against the application at the USPTO until it was published for opposition. 45 TTABVUE Exh. 7 (June 11, 2014 letter from Plaintiff's counsel demanding that Defendant withdraw its trademark application). If Plaintiff's delay were measured from the June, 2014 letter, the period of delay would be about one year and five months. We find such a period of delay, when taken with the very limited evidence of prejudice, is also insufficient to support a laches defense.

Defendant's belief that Plaintiff consented to Defendant's use and registration of the HAMPTONS GLOW trademark in connection with the goods identified in the registration. As such, Defendant's affirmative defense of acquiescence, as it pertains to the cancellation proceeding, is also dismissed.

Decision: The opposition is sustained, contingent upon the issuance of registration of Plaintiff's application, i.e., Application Serial No. 86386811, so as to establish constructive use of its HAMPTON SUN mark in connection with the goods identified in its application. We observe that the status of Plaintiff's application changed from a pending application into a registration.⁵⁴ Accordingly, Plaintiff is allowed until **20 days** from the mailing date of this decision to submit to the Board (and serve upon Defendant) a status and title copy of its issued registration.⁵⁵

The petition to cancel Defendant's HAMPTONS GLOW and design mark registration under Section 2(d) of the Trademark Act is granted.

⁵⁴ Our observation of the status change of Plaintiff's application should not be construed as the Board taking judicial notice of Plaintiff's resulting registration.

⁵⁵ We find that the submission of Plaintiff's registration is clearly of import since Plaintiff "cannot prevail without establishing constructive use pursuant to Trademark Act § 7(c), 15 U.S.C. § 1057 (c)." TBMP § 901.02(b). To do otherwise would deprive Plaintiff of the benefit of the constructive use provision of the Trademark Act. The Board explained in *Larami*, supra, why this approach is necessary to implement the intent of Congress behind the Section 7(c) filing date constructive use provision. 36 USPQ2d at 1844 ("To require registration of an applicant's mark prior to realization of its rights under Section 7(c) would defeat the purpose of filing applications based on intent-to-use.").

Moreover, allowing Plaintiff to submit its resultant registration causes no prejudice to Defendant who has been on notice of Plaintiff's pending application since the inception of the opposition. Defendant did not oppose that application and has presented no objection to it during this proceeding. Moreover, if we refused to consider Plaintiff's recently-issued registration, and Defendant's application matures into a registration, Plaintiff could then petition to cancel that registration and rely on its Section 7(c) constructive use priority date in that proceeding. This plausible scenario confirms that allowing Plaintiff to submit its registration causes no prejudice to Defendant herein.

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The time of filing an appeal or for commencing a civil action or for requesting reconsideration will run from the date of the present decision. *See* Trademark Act Section 21(a)(2), 15 U.S.C. § 1071(a)(2); Trademark Act Section 21(b)(1); 15 U.S.C. § 1071(b)(1); Trademark Rules 2.129 and 2.145; 37 C.F.R. §§ 2.129 and 2.145.