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GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hyatt

Serial No. 76386380

Lenworth Alexander Hyatt, *pro se*.

Shaunia P. Wallace, Trademark Examining Attorney, Law Office 110  
(Chris A.F. Pedersen, Managing Attorney).

Before Simms, Hohein and Holtzman, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Lenworth Alexander Hyatt, a citizen of Jamaica, has filed an application to register the mark "BEAUTIQUE" for "retail store services featuring beauty care products; [and] merchandizing beauty supplies, designer fashions, fashion accessories, jewelry, and footwear" in International Class 35 and "beauty salons" in International Class 44.<sup>1</sup>

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to his services, so resembles the

<sup>1</sup> Ser. No. 76386380, filed on March 22, 2002, which is based on an allegation of a bona fide intention to use the mark in commerce.

mark "BEAUTIQUE," which is registered for "eyeliner pencil and crayons and lipliner pencil and crayons" in International Class 3 and "combs and brushes for hair" in International Class 21,<sup>2</sup> as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods and/or services at issue and the similarity or dissimilarity of the respective marks in their

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<sup>2</sup> Reg. No. 2,114,289, issued on November 18, 1997, which sets forth a date of first use anywhere and in commerce of February 1993 for the goods in International Class 3 and a date of first use anywhere and in commerce of November 1993 for the goods in International Class 21; combined affidavit §§8 and 15. In addition, inasmuch as the same registrant was also the owner of a registration for the mark "BEAUTIQUE" for "permanent hair waving lotion," namely, Reg. No. 1,265,483, which issued on January 31, 1984 and sets forth a date of first use anywhere of January 14, 1982 and a date of first use in commerce of January 15, 1982, registration was finally refused on the basis thereof. However, because an application for the renewal of such registration has not been filed within the grace period allowed by Section 9(a) of the Trademark Act, 15 U.S.C. §1059(a), and the registration has therefore expired, no further consideration will be given thereto as a bar under Section 2(d) of the statute.

entireties.<sup>3</sup> Here, inasmuch as the mark sought to be registered and the registered mark are identical in all respects,<sup>4</sup> the focus of our inquiry is accordingly on the similarity or dissimilarity of the respective services and goods.

Turning, then, to such issue, applicant argues in his brief that because the "goods and services [are] in different classes," his mark "is therefore entitled to be approved for publication, and [to] be published for opposition." However, as the Examining Attorney correctly points out in her brief, the purpose of the United States Patent and Trademark Office in using the classification system is for administrative convenience rather than as an indication of whether goods and/or services are related or not. See, e.g., *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 1171, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990); and *In re Leon Shaffer Golnick Advertising, Inc.*, 185 USPQ

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<sup>3</sup> The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and/or services] and differences in the marks." 192 USPQ at 29.

<sup>4</sup> Applicant urges that his "BEAUTIQUE" mark "is used in conjunction with other marks" which he owns, including the mark "CRUMMY" and design, which is the subject of Reg. No. 2,588,737, issued on July 2, 2002 for a variety of goods, including "cosmetics, namely, cologne, blushes, lipsticks, loose powder, eye makeup, eye pencils, face makeup, perfume, [and] shadows." However, because the issue of likelihood of confusion must be decided on the basis of the mark which applicant seeks to register and the mark shown in the cited registration, the fact that applicant allegedly uses his "BEAUTIQUE" mark in conjunction with other marks simply is legally irrelevant and immaterial to a determination of the issue of likelihood of confusion. See, e.g., *Sealy, Inc. v. Simmons Co.*, 265 F.2d 934, 121 USPQ 456, 459 (CCPA 1959); *Burton-Dixie Corp. v. Restonic Corp.*, 234 F.2d 668, 110 USPQ 272, 273-74 (CCPA 1956); *Hat Corp. of America v. John B. Stetson Co.*, 223 F.2d 485, 106 USPQ 200, 203 (CCPA 1955); and *ITT Canteen Corp. v. Haven Homes Inc.*, 174 USPQ 539, 540 (TTAB 1972).

242, 242 n.2 (TTAB 1974). The fact, therefore, that applicant's services and registrant's goods are classified in different classes is not an indication that the respective services and goods are unrelated; instead, such fact is simply immaterial in determining the issue of likelihood of confusion. See, e.g., In re Clay, 154 USPQ 620, 621 (TTAB 1967) and cases cited therein.

Applicant also argues that, purportedly, because the "BEAUTIQUE" mark in the cited registration issued over a registration for another "BEAUTIQUE" mark (which, subsequently, was canceled),<sup>5</sup> his mark should likewise be registered over the mark in the cited registration.<sup>6</sup> Although implicit in such an argument is an assertion that applicant's services are no more related to registrant's goods than registrant's goods were to those in the earlier issued registration, applicant "questions why there were no problems with the registration of the marks cited" and, in view of the pattern or "rule" established by the issuance of the previous registrations, asks whether "the rule [has] been suddenly changed based on the Racial Profiling of the

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<sup>5</sup> Specifically, Reg. No. 1,422,617, which issued on December 30, 1986 and was canceled six years later for failure to file the affidavit required by Section 8 of the Trademark Act, 15 U.S.C. §1058, listed the following goods: "eyeglass cases" in International Class 9; "dental kits" in International Class 10; "luggage and luggage accessories," including "cosmetic and toiletry cases sold empty," in International Class 18; "cosmetic brush kits and containers sold empty ... to receive pocket or purse-size tissue packages" in International Class 21; "shower caps" in International Class 26; and "cigarette cases" in International Class 34.

<sup>6</sup> In a similar vein, applicant accurately points out that now expired Reg. No. 1,265,483, which as previously indicated in footnote 2 issued on January 31, 1984 for the mark "BEAUTIQUE" for "permanent hair waving lotion," registered over then subsisting Reg. No. 1,233,210, which issued on April 5, 1983 until canceled six years later for failure to file the affidavit required by Section 8 of the statute.

Applicant (Individual Jamaican)." Suffice it to say, however, that at the time that the cited registration issued, the earlier registration noted by applicant was no longer in force and thus could not be a possible bar under Section 2(d) of the statute to issuance of the cited registration.<sup>7</sup>

Additionally, because the cited registration clearly specifies "eyeliner pencil and crayons, lipliner pencil and crayons, [and] combs and brushes for hair" as the registrant's goods, while applicant's application pertains to "a Service Mark for a business," applicant asks the question: "How come the Examining Attorney cannot distinguish the difference?" However, as the Examining Attorney correctly notes, the issue herein is "not likelihood of confusion between particular goods [and services *per se*], but likelihood of confusion as to the source of those goods [and services from contemporaneous use of the same mark]," citing *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984) and cases cited therein. Furthermore, as the Examining Attorney accurately observes, it is well established that:

[C]onsumers are likely [to] be confused by the use of [the same or] similar marks on or in connection with goods and with services featuring or related to those goods. See *In*

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<sup>7</sup> Additionally, as mentioned earlier in footnote 2, Reg. No. 1,265,483 was not a possible bar to issuance of the cited registration because registrant was the owner thereof. Moreover, while Reg. No. 1,265,483 did, as noted previously, issue over another subsisting registration for a "BEAUTIQUE" mark, each case is decided, as the Examining Attorney properly points out, on its own merits. See, *e.g.*, *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the ... allowance of such prior registrations does not bind the Board or this court"]; *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 (TTAB 2001); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1758 (TTAB 1991).

*re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (BIGG's for retail ... general merchandise store services held confusingly similar to BIGGS for furniture); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for retail women's clothing store services ... held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) (21 CLUB for various items of men's, boys', girls', and women's clothing held likely to be confused with THE 21 CLUB (stylized) for restaurant services ...); *Steelcase Inc. v. Steelcare Inc.*, 229 USPQ 433 (TTAB 1983) (STEELCARE INC. for refinishing of furniture, office furniture, and machinery held likely to be confused with STEELCASE for office furniture and accessories); [and] *Mack Trucks, Inc. v. Huskie Freightways, Inc.*, 177 USPQ 32 (TTAB 1972) (use of similar marks for trucking services and on motor trucks and busses is likely to cause confusion).

Lastly, applicant insists that his services are not related to registrant's goods because applicant uses his mark "as [a] business model encompassing multi-services at a single location." However, as identified in his application, applicant's services are not so limited, nor are there any restrictions as to the channels of trade with respect to the goods, as identified, in the cited registration. Applicant's assertion, therefore, is legally irrelevant inasmuch as it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods and services as they are set forth in the involved application and the cited registration, and not in light of what such goods and/or services are asserted to actually be. See, e.g., *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo*

Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Moreover, as the Examining Attorney properly notes, it is well established that the goods and services at issue need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods and services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In support of her contention that applicant's services are indeed related to registrant's goods, the Examining Attorney has made of record copies of two use-based third-party registrations in which the same mark is registered for, *inter alia*, either "retail personal care product ... store services" or "retail store outlet services featuring ... cosmetics," on the one hand, and respectively, either "personal care products, namely, ... mascara, ... eye shadow, lip stick, [and] lip gloss" or "cosmetics, namely, eyeliner, eye shadow, mascara, eyebrow

pencils, eyebrow liner, ... lip liner, lipstick, [and] lip gloss," on the other hand.<sup>8</sup> It is settled, in this regard, that while use-based third-party registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, such registrations may nevertheless have some probative value to the extent that they serve to suggest that the services and goods listed therein are of the kinds which may emanate from a single source. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988), *aff'd as not citable precedent*, No. 88-1444 (Fed. Cir. November 14, 1988). Here, the two registrations noted above and made of record by the Examining Attorney serve to confirm the obvious, namely, that both beauty salons and retail store services featuring beauty care products would offer for sale and sell such cosmetic or beauty care products as eye and lip makeup, including various forms (e.g., pencils and crayons) of eyeliners and lip sticks. The respective services and goods at issue herein are thus, in relevant part, sufficiently related that, when sold or offered under the identical mark "BEAUTIQUE," confusion as to the source or sponsorship thereof would be likely to occur.<sup>9</sup> In particular, customers familiar with applicant's

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<sup>8</sup> Reg. Nos. 2,525,978, issued on January 1, 2002, and 2,372,704, issued on August 1, 2000.

<sup>9</sup> It is well established that a refusal under Section 2(d) is proper if there is a likelihood of confusion involving any of the services set forth in an application and any of the goods listed in a cited registration; furthermore, where a likelihood of confusion is so found, it is unnecessary to rule with respect to any of the other services and goods listed therein. See, e.g., *Tuxedo Monopoly, Inc.*

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"BEAUTIQUE" beauty salons and store services featuring beauty care products could reasonably believe, upon encountering registrant's "BEAUTIQUE" eyeliner pencil and crayons and lipliner pencil and crayons, that applicant has expanded his services to include the marketing of his own line of beauty care products.

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

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v. General Mills Fun Group, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); and Shunk Mfg. Co. v. Tarrant Mfg. Co., 318 F.2d 328, 137 USPQ 881, 883 (CCPA 1963).