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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Wahl Clipper Corporation

Serial No. 76610840

Harold V. Stotland of Seyfarth Shaw LLP for Wahl Clipper Corporation.

Ronald McMorro, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Grendel, Drost and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

On September 7, 2004, Wahl Clipper Corporation filed an intent to use application for the mark COLORPRO, in standard character form, for "electric hair clippers," in Class 8 (Serial No. 76610840). The Trademark Examining Attorney finally refused registration under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that applicant's mark so resembles the mark COLORPRO, in standard character form, for, *inter alia*, nail files and manicure sticks that function as cuticle removers

and pushers, in Class 8, as to be likely to cause confusion.¹

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

A. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We turn first to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours &*

¹ Registration No. 3086274, issued April 25, 2006.

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Co., supra. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). *See also, In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988). In this case, the marks are identical.

B. The similarity or dissimilarity and nature of the goods.

In an *ex parte* appeal, likelihood of confusion is determined on the basis of the goods as they are identified in the application and the cited registration. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). Moreover, the greater the degree of similarity between the applicant's mark and the mark in the cited registration, the lesser the degree of similarity between the goods in the application and the cited registration is required to support a finding of likelihood of confusion. *In re Opus One, Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

It is well settled that the goods of the applicant and the registrant do not have to be identical or directly

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competitive to support a finding that there is a likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give rise to the mistaken belief that they emanate from or are associated with a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

The goods in the cited registration include, *inter alia*, nail files and manicure sticks that function as cuticle removers and pushers. Applicant's products are identified as "electric hair clippers." With respect to the nature of the goods, we note that applicant has conceded that its electric hair clippers and registrant's products may both be classified as falling "within the general market of personal grooming."²

The Examining Attorney has made of record 17 probative third-party registrations to support his argument that applicant's "electric hair clippers" and the registrant's

² Applicant's Brief, p. 3.

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nail files and instruments for treating cuticles are related.³ See the following registrations:⁴

Mark	Registration No.	Goods
FLEX 360	2973921	Hair clippers; nail files
PUG.LEE	2953582	Nail files; electric hair clippers
DOVO	0892638	Nail files; hair clippers
GIFFON	1084543	Nail files; hair clippers
CC CERENA	1429024	Electric hair clippers; nails files
E ARIUS- EICKERT	1911132 3191014	Nail files; hair clippers
JAGUAR	2145847	Nail files; electric hair clippers
Design mark	2266232	Electric hair clippers; nail files
DENCO	2039786	Nail files; hair shears and hair shapers
LTD	2451924	Nail files; hair cutting scissors

³ The Examining Attorney also submitted copies of eight applications, three registrations originally filed under the provisions of Section 44 of the Trademark Act of 1946, and the cited registration. The third-party applications have no probative value because applications are evidence only that an application has been filed. Likewise, we have not considered the registrations based solely on foreign filings pursuant to Section 44 because such registrations do not require use in commerce, and therefore they have little probative value. *In re Albert Trostel & Sons Co.*, supra at 1785-1786; *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). However, we did consider the two registrations filed under Section 44 with declarations of continued use pursuant to Section 8 of the Act because those registrants have shown use in commerce.

⁴ We have not included the entire description of goods for each of the subject registrations. We have only listed the goods identical or analogous to the goods in the application and cited registration.

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Mark	Registration No.	Goods
MARCUS ANTONI	2807167	Nail files; barber scissors; nose and ear hair trimmers
NAIL WIZARD	2891654	Nail files; barber scissors; nose and ear hair trimmers
TWEEZERMA N MEN	2875643	Nail files; hair cutting scissors
FINISHING TOUCH	2840298	Electric hair trimmers; nail files
MICROTOUCH H	2884308	Electric hair trimmers; nail files
BIKINI TOUCH	2891442	Hair trimmers, scissors; nail files

Third-party registrations based on use in commerce that individually cover a number of items may serve to suggest that that the listed goods are a type that may emanate from a single source. *In re Albert Trostel & Sons Co., supra;* *In re Mucky Duck Mustard Co., Inc., supra.*

Applicant contends that its electric hair clippers and registrant's nail files and manicure sticks are not similar or related products because applicant's electric hair clippers are marketed primarily to men and they are sold with other male related products such as razors and shavers. On the other hand, the registrant's nail files and manicure sticks are marketed primarily to women and are

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sold in the cosmetic section of stores.⁵ Applicant supports its argument with the declaration of Ray Nielsen, applicant's Senior Product Manager. Mr. Nielsen testified that "ninety percent (90%) of the people on whom electric hair clippers COLORPRO are being used are male."⁶ There are two problems with Mr. Nielsen's testimony. First, Mr. Nielsen did not testify about electric hair clippers in general. His testimony was limited to applicant's products. There is no evidence suggesting that electric hair clippers are sold and used only by men. If some electric hair clippers are marketed to and used by women, then women may believe that nail files and electric hair clippers marketed under the same trademarks emanate from the same source. Also, there is no evidence to suggest that men do not buy nail files, and, likewise, men could mistakenly believe that such products marketed under identical marks emanate from a single source. Finally, even if electric hair clippers are used primarily by men, there is nothing that precludes women from purchasing electric hair clippers. A women purchaser may mistakenly believe that a COLORPRO electric hair clipper is somehow

⁵ Applicant's Brief, p. 4.

⁶ Nielsen Declaration ¶3.

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associated with the company that makes COLORPRO nail files and manicure sticks.

The second problem with applicant's evidence is that Mr. Nielsen's testimony that applicant's electric hair clippers are marketed primarily to men is not reflected in the description of goods. As indicate above, we must determine the issue of likelihood of confusion based on the description of goods in the application and cited registration. We cannot read any limitations or restrictions into the description of goods. *Octocom Systems, Inc., v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983). If the application and/or the cited registration describe the goods broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the application and/or the cited registration

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encompass all the goods of the type described, that they move in same channels of trade normal for these goods, and that they are available to all classes of purchasers for the described goods. *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). Because there is no restriction in applicant's description of goods (e.g., "electric hair clippers for men"), we must presume that applicant's electric hair clippers are marketed to and may be purchased and used by both men and women.

In view of the foregoing, we find that the goods at issue are related products.

C. The similarity or dissimilarity of established, likely-to-continue trade channels.

A channel of trade refers to the method of distribution (*i.e.*, how and to whom the products are sold). *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700-1701 (Fed. Cir. 1992). In this regard, applicant has argued that its electric hair clippers and the registrant's nail files and manicure sticks are sold in different sections of stores (*i.e.*, applicant's electric hair clippers are "sold with other male and/or electric products, such as razors, shavers and hair dryers," while registrant's nail files and manicure

sticks are sold in the cosmetics section).⁷ However, in determining the issue of likelihood of confusion, we do not find the fact that the products at issue may be sold in different sections of a store to be significant. First, Ray Nielsen established that electric hair clippers and registrant's nail care products are both sold in the same stores (e.g., Walgreens, K-Mart, Wal-Mart, and CVS).⁸ Second, applicant's reliance on the proximity of the products in the respective stores misses the point. Our concern is whether consumers will believe that products bearing the same mark emanate from the same source, not whether consumers would purchase an electric hair clipper thinking that it was a nail file. Thus, the proximity of the products' display is not an essential factor. *In re Buck-Stop Lure Co., Inc.*, 226 USPQ 190, 192 (TTAB 1985); *Trak Inc. v. Traq Inc.*, 212 USPQ 846, 851 (TTAB 1981). See also *Helen Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 n.30 (TTAB 1989). Based on our finding that the goods at issue are related, if consumers were to encounter different personal grooming products, such as applicant's electric hair clippers and registrant's nail files and manicure sticks, in different sections of the

⁷ Applicant's Brief, p. 4.

⁸ Nielsen Declaration ¶5.

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same store, they would naturally assume that they were manufactured by the same source.

In view of the foregoing, we find that the channels of trade are similar.

D. Balancing the factors.

In view of the identity of the marks and the similarity of the goods and channels of trade, we find that applicant's mark COLORPRO, when used in connection with electric hair clippers, so resembles the mark COLORPRO for, *inter alia*, nail clippers and manicure sticks that function as cuticle removers and pushers, as to be likely to cause confusion.

Decision: The refusal to register is affirmed.