

THIS OPINION
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Alianza Enterprises Inc.

Serial No. 78513502

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105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Holtzman and Zervas, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Alianza Enterprises Inc. has appealed from the final
refusal of the trademark examining attorney to register

The logo for "Just-a-Cut" is displayed in a large, blue, rounded, sans-serif font. The letters are thick and have a slightly irregular, hand-drawn appearance. The text is centered on the page.

as a trademark for the following services, as amended:

"Hair salon that provides haircutting services to adults

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and children," in International Class 44.¹ Applicant has entered into the record a statement providing that the entire mark appears in the color blue and a claim that the color blue is a feature of the mark.

The examining attorney has refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the previously registered mark JUST A CUT (in typed form) for "hairdressing salon services" in International Class 42,² as to be likely to cause confusion or mistake or to deceive.

After the refusal was made final, applicant appealed. Applicant and the examining attorney have both filed briefs. Upon careful consideration of the arguments advanced by applicant and the examining attorney and the evidence of record, we conclude that confusion is likely.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic*

¹ Application Serial No. 78513502, filed on November 8, 2004, asserting a date of first use anywhere on March 15, 1989 and a date of first use in commerce on April 15, 1989.

² Registration No. 1688518, issued May 19, 1992, renewed.

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Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first consider the similarities or dissimilarities of the marks in their entireties. Our focus is on whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We do not consider whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar that confusion as to the source of the services offered under the respective marks is likely to result. 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 (TTAB 1975).

The marks are identical in sound and meaning because both marks share the same wording, i.e., JUST A CUT, and

neither mark has any additional wording.³ As for the appearance of the marks, while applicant limits its mark to the color blue and a particular letter stylization, registrant's mark is a typed mark and hence may be depicted in any color and in any letter stylization, including the same shade of blue and the same letter stylization as depicted in applicant's mark. Applicant's argument that its mark is different in appearance because it is depicted in the color blue is therefore of no avail. As for the dots between the words in applicant's mark, they are not articulated when referring to applicant's services, but are a minor component of applicant's mark that merely serve to separate the wording in the mark; hence, they do not assist in distinguishing the marks. Although the marks must be considered in their entirety, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Therefore, we find that, in appearance, the marks

³ Applicant argues at p. 7 of its brief that Registration No. 1688518 is owned by a Luxembourg entity; and that "because of the difference in languages [in Luxembourg and the United States] the conflicting marks may not sound similar as there may be a different [sic] pronunciation between both marks." We are concerned here with consumers in the United States, not with foreign consumers who are not in the United States. The pronunciation of registrant's mark by persons in Luxembourg is totally irrelevant.

are highly similar. Further, because of the identity of the wording in the marks, we find that the commercial impression of the marks is the same. Thus, we find that the first *du Pont* factor weighs heavily against applicant.

We next consider the second and third *du Pont* factors, i.e., the similarities between registrant's and applicant's services and the similarities between registrant's and applicant's trade channels and classes of purchasers of those services. Applicant and registrant's services are legally identical. In this situation, because there are no limitations in the identification, we must presume that the services recited in the application and the registration include all normal types of such services offered in all normal trade channels for such services and to all normal classes of purchasers for such services.⁴ See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Because the services are described broadly in the identifications of services, and there are no trade channel limitations included in the identifications of services, we must assume that the trade channels overlap.

⁴ We presume, therefore, that both parties provide the "specific and generic hairstyles offered at the registrant's and applicant's hair salon[s]," mentioned at p. 9 of applicant's brief.

Applicant has made several arguments in favor of registration based on a "Translation Statement" that appears in the record for the cited registration, which states:⁵

It is a gray salon, a new concept which follows a format "an excellent styling and nothing more." No color or perms, robes and towels are disposable, pace is rapid and prices are inexpensive, it's a totally new space for trying other JEAN LOUIS DAVID styles.

Applicant argues that applicant's and registrant's services differ because registrant "offers 'JEAN LOUIS DAVID' hairstyles and the applicant does not"; and that a "purchaser of the registrant's services would have an expectation of entering a 'gray salon' ... that specifically provides 'JEAN LOUIS DAVID' hairstyle services." In contrast, "a purchaser of applicant's hair salon services would have an expectation of a hair cut by any stylist available at the time the purchaser enters the applicant's hair salon." Brief at p. 4.

Applicant's arguments are not well taken because they relate to the "Translation Statement" and not to what is stated within the identification of services. The Board determines likelihood of confusion based on the services as

⁵ Because registrant's mark is entirely in English, it appears that the "Translation Statement" pertains to foreign wording in the specimen of use, which the Office inadvertently included in the registration record.

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they are recited in the application and registration, and does not read limitations into those services. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987); *In re Elbaum*, *supra*. Here, the cited registration describes registrant's services broadly, and there is no limitation as to the nature or type of services, the channels of trade or the class of purchasers. Thus, even if registrant has "gray salons" (which presumably are limited in the nature of the services offered), registrant may change the nature of its salons so that they offer additional services such as hair coloring or permanents. As for applicant's arguments regarding "'JEAN LOUIS DAVID' hairstyles," applicant misreads the "Translation Statement" in suggesting that registrant offers only a certain type of hairstyle. It is obvious that registrant's statements refer to the fact that the JEAN LOUIS DAVID salons offer various hairstyles. Thus, the hairdressing salon services identified in the registrant's registration would encompass the haircutting services identified in applicant's application.

Applicant has also argued that confusion is not likely because "the registrant and applicant are located in remote

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geographic areas of the world," with applicant located in Texas and registrant located in Luxembourg. Brief at pp. 8, 10. However, registrant is the owner of a registration for its mark in the United States. A United States registration is accorded the presumptions of validity set forth in Section 7 of the Trademark Act, which includes the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate. Thus, that registrant is a Luxembourg entity is irrelevant to the issues before us - what is important is that it owns a geographically unrestricted United States registration, and our determination of likelihood of confusion must be based on registrant's presumed use of the mark in the United States.⁶

Additionally, at p. 11 of its brief, applicant maintains that "it does not appear that the registrant has [an] intent to use the mark in the applicant's geographical area and/or market." It is immaterial to the issues at hand whether registrant has an intent to use its mark in a particular geographic area in the United States. Registrant, even if a foreign entity, has a geographically

⁶ If applicant believes that registrant does not use its mark in the United States, the appropriate procedure would have been for applicant to have filed a petition to cancel the registration.

unrestricted registration that provides it with rights in all areas of the United States, regardless of whether it has used its mark in all areas of the United States.

Moreover, applicant is seeking a geographically unrestricted registration for its mark, such that applicant's rights would not be limited to a specific geographical area.

In view of the foregoing, we resolve the second and third *du Pont* factors against applicant.

Under the fourth *du Pont* factor involving the conditions under which and buyers to whom sales are made, we find that applicant's and registrant's services are common consumer services that are obtained on a more or less regular basis by the general public. Applicant has provided no evidence to show that these services would be purchased with a great deal of thought or care and, while some people may be careful about the hair salon services they choose, given the near identity of the marks and the services, even careful consumers are likely to be confused. This factor therefore either weighs in favor of a finding of likelihood of confusion or is at best neutral.

Turning now to the seventh *du Pont* factor regarding actual confusion, applicant has argued that "there is a time span of more than sixteen years where both applicant

and registrant have used the marks and ... confusion has not occurred" Brief at p. 8. Applicant's contention is of little weight in this ex parte proceeding, where there is no opportunity for registrant to participate or state whether it is aware of any instances of actual confusion. The Federal Circuit in *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) addressed the question of the weight to be given to an assertion of no actual confusion by an applicant in an ex parte proceeding:

With regard to the seventh *DuPont* factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. See *In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, [citation omitted], especially in an ex parte context.

Accordingly, while examples of actual confusion may point toward a finding of a likelihood of confusion, an absence of such evidence is not as compelling in support of a finding of no likelihood of confusion. Thus, we cannot conclude from the lack of instances of actual confusion

that confusion is not likely to occur. Also, the lack of alleged actual confusion could well be due to a geographical separation between where applicant and registrant render their services, which was argued by applicant in contending that confusion is not likely.

Applicant has made another argument that is not relevant to this proceeding. At page 11 of its brief, applicant argues that "applicant can be considered the senior user since it first used the mark on March 15, 1989, prior to the registrant's first use on June 9, 1990." Suffice it to say, that in an ex parte proceeding such as this, applicant may not attack the validity of the cited registration by arguing that it used its mark prior to the time that the cited mark was used. *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (CCPA 1971). Accordingly, even assuming purely for the sake of argument that applicant did indeed use its mark from a point in time predating the first use of the cited mark, this is legally irrelevant in an ex parte proceeding.⁷

In view of the foregoing, we find that there is a likelihood of confusion between applicant's mark for a

⁷ It is noted that the cited registration issued in 1992, and therefore it cannot be attacked in a cancellation proceeding on the ground of priority and likelihood of confusion. See Section 14 of the Trademark Act, 15 U.S.C. §1064.

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"Hair salon that provides haircutting services to adults and children," and registrant's mark for "hairdressing salon services."

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.