

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Paper No. 20
TJQ
Mailed:3/25/04

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Clairol Incorporated and Proctor and Gamble Hair Care LLC,
joined as party plaintiff
v.
Lavar Hair Designs LLC

Opposition No. 91124310
to application Serial No. 76134717
filed on September 25, 2000

Lynda E. Roesch and J. Michael Hurst of Dinsmore & Shohl for
Clairol Incorporated and Proctor and Gamble Hair Care LLC.

Angelo Notaro of Notaro & Michalos for Lavar Hair Designs
LLC.

Before Hanak, Quinn and Hairston, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Lavar Hair Designs LLC to
register the mark L-TRESS for "shampoo and hair
conditioners" (in International Class 3) and "hair
extension[s]" (in International Class 26).¹

Clairol Incorporated, Proctor and Gamble Hair Care

¹ Application Serial No. 76134717, filed September 25, 2000,
alleging a bona fide intention to use the mark in commerce.

Opposition No. 91124310

LLC's predecessor, opposed registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, if applied to applicant's goods, would so resemble opposer's previously used and registered mark ULTRESS for "hair tinting, dyeing and coloring preparations"² as to be likely to cause confusion.

Applicant, in its answer, denied the salient allegations of the notice of opposition.

The record consists of the pleadings; the file of the involved application; and trial testimony, with related exhibits, taken by opposer. Applicant neither took testimony nor introduced any other evidence. Opposer filed a brief on the case, but applicant did not. An oral hearing was not requested.

Melissa Lush, brand manager of opposer's ULTRESS line of hair products, testified that the brand was launched in 1985. Ms. Lush stated that ULTRESS is a premium at-home permanent hair coloring product. The product is sold through food and drug stores, and mass merchandisers; these retail outlets include Wal-Mart, Wegman's, Target, CVS and Walgreens. In the last two years, products have also been sold on the internet. Figures for the period 1992-2001 show sales in excess of \$500 million, and the market share of

² Registration No. 1,282,034, issued June 19, 1984; combined Sections 8 and 15 affidavit filed.

Opposition No. 91124310

ULTRESS products is more than 6%. In 2001, advertising expenditures for ULTRESS products was around \$5 million. Advertising has appeared on television (during programs such as Oprah, ER and Friends), in printed publications (such as Cosmopolitan, Glamour and Allure), and in newspaper inserts and trade magazines. Celebrities such as Linda Evans and Jerry Hall have appeared in the advertising. The products sold under the mark ULTRESS have garnered awards, and have been the subjects of unsolicited articles in printed publications. Studies have shown that the brand awareness of ULTRESS is high, ranging 60%-76% (which represents over 39 million women).

Because opposer has made of record a certified copy showing status and title of its pleaded registration, and because its likelihood of confusion claim is not without merit, we find that opposer has established its standing to oppose registration of applicant's mark.³ See: Lipton Industries, Inc. v. Ralston Purina Company, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Further, because opposer has made its pleaded registration of record, priority is not an issue in this case with respect to the mark and goods identified

³ The certified copy indicates that the registration is owned by Procter and Gamble Hair Care LLC. Vanessa Nichols, trademark counsel for Procter and Gamble Company's beauty care trademark portfolio, testified that it is her understanding that assignment documents have been filed to have the registration assigned to Procter and Gamble Company.

Opposition No. 91124310

therein. See: King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Accordingly, the only issue to be decided is whether opposer has established that a likelihood of confusion exists.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Insofar as the marks are concerned, 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 overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. Further, the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

In the present case, the marks ULTRESS and L-TRESS are nearly identical in terms of sound; there is very little

Opposition No. 91124310

difference between the "UL" sound and the "L" sound in the respective two syllable marks. Any very slight difference in the sounds of the first part of the marks undoubtedly would be missed when the marks are spoken.

The marks are also similar in appearance. Both marks include the letter "L" followed by "TRESS." The only differences are the letter "U" in registrant's mark and the hyphen in applicant's mark. When comparing the marks, we find that the similarities in appearance outweigh the differences.

We also find that the marks are similar in meaning. We take judicial notice of the meaning of the term "tress" which is defined as "a long lock of hair, esp. the long unbound hair of a woman." Webster's Third New International Dictionary (unabridged ed. 1993). Both marks suggest that the products are used with tresses.

In sum, the marks are similar in sound, appearance, meaning and overall commercial impression.

With respect to the goods, it is well established that the goods of the parties need not be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such

Opposition No. 91124310

that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

Applicant's and registrant's goods are commercially related hair products. See: *La Maur, Inc. v. Alberto Culver Co.*, 179 USPQ 607 (D. Minn. 1973), *aff'd*, 496 F.2d 618, 182 USPQ 10 (8th Cir. 1974) [hair bleach is so related to hair spray, shampoo, cream rinse, conditioner and setting solutions that it is reasonable to conclude that they come from the same source if they bear similar marks]. The products would be sold in the same channels of trade; Ms. Lush even testified that applicant's and registrant's types of goods are sold in the same aisles of the same stores. Further, the products would be sold to the same classes of purchasers, namely ordinary consumers.

Hair care products of the types involved herein are relatively inexpensive and, therefore, would be the subjects of impulse purchase. This factor also favors the finding of likelihood of confusion.

Opposition No. 91124310

The other du Pont factor mentioned by opposer is fame. Although opposer states that its mark is "famous," we find that the record falls short of establishing this. Clearly, the ULTRESS product line has been very successful and is a well known brand, but the facts do not establish fame as that legal term is contemplated.

We conclude that consumers familiar with opposer's hair tinting, dyeing and coloring preparations sold under opposer's mark ULTRESS would be likely to believe, upon encountering applicant's mark L-TRESS for shampoo, hair conditioners and hair extensions, that the goods originated with or are somehow associated with or sponsored by the same entity.

Decision: The opposition is sustained, and registration to applicant is refused.