

**THIS OPINION IS NOT A
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Mailed: December 23, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sexy Hair Concepts, LLC
v.
Dean V. Christal

Opposition No. 91177752

Roberta Jacobs-Meadway, Jay K. Meadway, and Sean P. McConnell of Eckert Seamans Cherin & Mellot, LLC, for Sexy Hair Concepts, LLC.

Dean V. Christal, pro se.

Before Walters, Wellington, and Ritchie, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

On September 28, 2006, applicant, Dean V. Christal, applied to register the mark THE SEXY SIDE OF SCIENCE in standard character form on the Principal Register for "Hair care preparations, color treatment products, namely shampoos, conditioners, hair gels, hair creams and lotions, hair sprays, hair mousses, hair tonics, non-medicated skin care preparations, namely, skin cleanser, skin moisturizer, skin cream, skin lotion, cosmetics, namely, facial make-up, foundation make-up, eye make-up, eye cream, eye shadow,

cheek blush, make-up remover, lipstick, lip gloss, lip balm, body lotion, bath soap, bath oils, essential oils for personal use, massage oils, aromatherapy oils, perfume, cologne, toilet water, incense, liquid soaps for hands, face and body," in International Class 3.¹ The application is based on applicant's allegation of a bona fide intention to use the mark in commerce.

On June 11, 2007, opposer, Sexy Hair Concepts, LLC, opposed the registration of applicant's mark on the ground that applicant's mark is likely to cause confusion with opposer's marks. Opposer asserts that it owns Registration No. 2403396 for the mark SEXY HAIR in typed or standard character form for "Hair care products for men, women and children, namely, hair shampoos, hair conditioners, hair lotions, hair cremes, hair gels, hair sprays, hair color, hair dyes, hair rinses, and hair mousse," in International Class 3.² The registration was issued November 14, 2000, and it contains a disclaimer of the word "Hair."

In its notice of opposition, opposer also alleges that it "has taken steps to develop a family of 'SEXY' marks for hair care preparations, including: 'SEXY HAIR CONCEPTS,' 'HEALTHY SEXY HAIR,' 'BIG SEXY HAIR,' 'CURLY SEXY HAIR,' 'SHORT SEXY HAIR,' and 'SEXY HAIR (Design),'

¹ Serial No. 77010028.

² Sections 8 and 15 affidavits accepted and acknowledged.

among others." (Notice of Opposition at 2).

Opposer maintains that applicant's "mark for hair care products is confusingly similar to Opposer's registered 'SEXY HAIR' trademarks and also to the family of 'SEXY' marks established by Opposer." (*Id.* at 3).

Applicant denied the salient allegations of the notice of opposition. Only opposer filed a brief in the case.

The Record

The record consists of the pleadings; the file of the involved application; the testimonial deposition of James Morrison, opposer's chief executive officer, with exhibits; the testimonial deposition of John F. Metzger, a litigation paralegal at opposer's law firm, with exhibits; and opposer's four notices of reliance on a status and title copy of its SEXY HAIR and other trademark registrations (specifically, HOT SEXY HIGHLIGHTS, SEXSYMBOL, WILD SEXY HAIR, SEXY HAIR CONCEPTS (and design), SEXYBATH&BODY, HEALTHY SEXY, SHORT SEXY, AND STRONGSEXYHAIR), applicant's responses to opposer's interrogatories and requests for admissions, and excerpts from printed publications.³

³ Although Registration Nos. 2553996 (HOT SEXY HIGHLIGHTS), 2636664 (SEXSYMBOL), 2707751 (WILD SEXY HAIR) and 2823999 (SEXYBATH&BODY) were not pled in the notice of opposition, we have considered them because applicant has not objected to the unpled registrations. Therefore, the notice of opposition is deemed amended to conform to the evidence under FRCP 15(b).

Applicant did not submit any testimony or evidence.

Priority and Standing

As a result of opposer's submission of status and title copies of its SEXY HAIR registration (No. 2403396), among others, opposer has established its priority as well as its standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) and *King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). As dicussed further below, opposer also has a family of SEXY marks that was created before applicant's filing date; thus opposer has priority as to this family of marks vis-à-vis the involved application.

Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the relevant, probative evidence in the record. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The Goods and Channels of Trade

A number of goods listed in the identification of goods covered by opposer's SEXY HAIR registration are also listed in the identification of goods covered by the application. These include "shampoos," "conditioners," "hair lotions" "hair creams" "hair gels" "hair sprays" "color" and "hair mousse." Indeed virtually every product listed in opposer's SEXY HAIR identification of goods is also listed in the application. Accordingly we find substantial overlap between opposer's and applicant's identified goods.

Both opposer's and applicant's identifications of goods are broadly worded, without any limitations as to channels of trade or classes of purchasers. We must presume, then, that the hair care products of applicant and opposer are (or will be, in the case of the intent-to-use application) sold in all normal channels of trade to all usual purchasers for goods of the type identified. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In other words, we conclude that the channels of trade and classes of purchasers of the parties' goods are the same. These *du Pont* factors heavily favor finding a likelihood of consumer confusion.

The Marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their

entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Preliminarily, we note that the more similar the goods at issue, the less similar the marks need to be for the Board to find a likelihood of confusion. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). In comparing the marks, we are mindful that 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 offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Opposer claims a family of marks based on the common

term SEXY.⁴ (Opposer's Brief at 1). A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin. *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). Recognition of a family of marks is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. *Id.* In the present case, the evidence clearly establishes that opposer promotes a group of marks for which the common characteristic is the term "sexy." (Morrison depo. at 27:7-10 and exhibits). Except for the mark SEXY HAIR, opposer's family of marks is characterized by the term

⁴ Although opposer pleaded likelihood of confusion with respect to several of its individual marks as well as its family, its brief discusses likelihood of confusion only with respect to its family of marks, and we will therefore do the same.

SEXY, generally preceded by a word that suggests an intended result of the product, and generally followed by a generic noun in the hair care field (e.g., SEXY HAIR, BIG SEXY HAIR, STRAIGHT SEXY HAIR, SHORT SEXY HAIR, HEALTHY SEXY HAIR, HOT SEXY HAIR, WILD SEXY HAIR, HOT SEXY HIGHLIGHTS). Opposer has also submitted evidence of its registrations for marks not including or referencing the word "hair," such as SEXSYMBOL, SHORT SEXY, and HOT SEXY).

We must consider whether "sexy" is sufficiently distinctive to function as the common element of a family of marks. We take judicial notice of the definition in *Merriam-Webster's Collegiate Dictionary* (11th ed. 2003) of "sexy" as "1. sexually suggestive or stimulating: erotic. 2. generally attractive or interesting: appealing." "Sexy" is, at most, suggestive of an amorphous, yet desirable, quality of hair or hair care products. The advertising and articles of record clearly imply that a purchaser or reader should desire "sexy hair"; but it is not clear that "sexy hair" is a specific quality that means the same thing to all people. Particularly with respect to opposer's products, "sexy hair" could be straight, or curly or wild; or it could pertain to hair length, color or texture. The record does not establish a direct connection between the term "sexy" and a specific quality, characteristic, function, ingredient, attribute or feature of the identified hair care products or

of hair after the use of these products.

The evidence establishes that consumers are likely to view marks following this pattern as having a common origin. Opposer advertises and promotes together its marks containing the word SEXY, and has done so since at least 2002. (Morrison depo. at 27:7-10 and exhibits). For example, the different "SEXY" brands and their respective products are shown together on television, at trade shows, demonstrations, and seminars, and in promotional brochures for professional clients (*Id.* at 27:25, 28:9-18, and exhibits). The SEXY element is emphasized by the use of different fonts and colors for the SEXY portion of opposer's marks on packaging and in promotional materials. (*Id.* at 18:15-20 and exhibits). In addition to using the particular SEXY brand on products in promotional materials and advertising, opposer uses SEXY HAIR CONCEPTS or SEXY HAIR CONCEPTS and star design (with SEXY appearing larger and in a different font than other wording) on most packaging and promotional materials across all SEXY brands, thereby reinforcing opposer's portrayal, and the likely perception by consumers, of SEXY as a common element among numerous hair care products from the same source. (*Id.* at 19:1-2 and exhibits). Opposer's significant advertising in this manner has resulted in periodicals discussing several of the SEXY brands together in articles about hair care and referring to

the various brands as the SEXY HAIR or SEXY HAIR CONCEPTS "collection" or "line" of products since at least 2002, well before applicant's filing date (*Id.* at 26:24-29:25, and exhibits; Notice of Reliance). We are persuaded that opposer has established a family of marks based on the common element SEXY, and that the priority date for opposer's SEXY family of marks precedes applicant's earliest priority date for THE SEXY SIDE OF SCIENCE.

We consider, next, the market strength of opposer's family of marks. The record includes articles in consumer and professional magazines that use the word "sexy" to discuss various types of haircuts, hair styles and products unrelated to opposer. In particular, opposer submitted a notice of reliance with excerpts of printed publications. Some of these excerpts use the word "sexy" in a non-trademark manner unrelated to opposer, while others include both trademark and non-trademark uses of "sexy." The following are examples:

"Since then, Sexy Hair slowly has turned the image of a sexy, fun niche brand into one that is more elegant and mature." *Women's Wear Daily*, September 7, 2007.

"There is nothing subtle in O'Rourke's life, as one might expect from someone who runs a company that has both Sexy and Hair in the name." *LA Daily News*, March 10, 2006.

"Four steps to sexy, messy tresses" *Boston Herald*, 10/21/04.

"Sexy Hair Concepts Wants Americans to Show Off Their Sexiest Hair in a Reality Contest" *Household & Personal Products Industry*, April 1, 2006.

"Sexy Hair Concepts launched the Disruptive Texture Collection of haircuts. . . John Paul Mitchell Systems features sexy looks this spring such as Tousled Texture." *Household and Personal Products Industry*, May 1, 2003.

"The booth of Italian company Dawa was doing a brisk business in flat irons with interchangeable patterned inserts, including some with the word 'sexy,' and had none left by the end of the show's second day." . . . "At Sexy Hair Concepts, a new product line called Wild Sexy Hair was being promoted. . . " *Chicago Tribune*, March 12, 2003.

"This month Sebastian launched three new Raw hair products under the Xtah line. . . Xtah Loose Locks separates the hair with a flexible, sexy and 'undone' look. . . Sexy Hair Concepts. . . introduced its new Healthy Sexy Hair Moisture Collection." *Household and Personal Products Industry*, December 1, 2002.

"L'Oreal turned to its consulting hairstylist Oribe, who works with celebrities including Jennifer Lopez, Sharon Stone and Gwyneth Paltrow, according to the company, in developing its latest styling products. 'The tousled, sexy look is really popular with women today,' Oribe observed." *Household and Personal Products Industry*, May 1, 2001.

However, regarding third-party use or registration and limiting ourselves to the field of hair care, the record contains few, if any, third party trademarks that include the term "sexy" for hair care products, other than opposer's family of marks and applicant's proposed mark. Further, the use of the term "sexy" as part of a mark, does not defeat or limit opposer's family of marks characterized by the term SEXY preceded by a word that suggests an intended result of the product and followed by a generic noun in the hair care

field. Opposer's CEO has also testified that he is unaware of any unpoliced use by any third party of the word SEXY in its mark. (Morrison depo. at 36:21-37:4).

Moreover, opposer has testified as to significant advertising and marketing of its family of SEXY marks. In particular opposer has testified to having over 100 products (Morrison depo. at 22:1), with advertising expenses of almost \$1.5 million in 2007, with significant annual growth. (*Id.* at 28:9-18 and exhibits). Opposer has also noted a "very high level of success" in getting its SEXY products placed on major, national television shows, such as the Today Show, the Jay Leno Show, The View, and Oprah, among others. (*Id.* at 29:10-25 and exhibits). Through its public relations firm, opposer has also gotten write-ups in major magazines such as Allure, Vogue, Cosmo, Teen Vogue, Essence, and Harper's Bazaar. (*Id.* at 31:14-16).

Overall, opposer is one of the top 10 or 11 largest hair care manufacturing companies, out of "hundreds." (*Id.* at 31:10-16). Opposer's CEO testified that in his estimate the SEXY products are sold in one quarter of all hair salons in North America. (*Id.* at 32:8-13). This resulted in \$62 million in sales volume to opposer in 2007, with about \$250 million in retail sales. (*Id.* at 34:14-35:4 and exhibits). While this evidence does not establish opposer's SEXY marks as famous, it does establish some renown for opposer's

family of SEXY marks. Thus, opposer's family of marks is entitled to the scope of protection normally accorded a family of marks for whom the common element is a suggestive, rather than an arbitrary, term, i.e., a more limited scope of protection than for an arbitrary mark, but still inherently distinctive. *See Motorola, Inc. v. Griffiths Electronics, Inc.*, 317 F.2d 397, 137 USPQ 551, 553 (CCPA 1963) ("As a matter of logic it would seem to us that if opposer has a family of six marks all starting with the [same] word . . ., it still has that family notwithstanding there may be some others using the same word").

Finally, we consider whether the marks in their entirety are so dissimilar as to make it "unlikely that confusion would result from the simultaneous use of the marks." *Kellogg Co. v. Pack'Em Enterprises Inc.*, 21 USPQ2d 1141, 1145 (Fed. Cir. 1991). Clearly, the dominant element in opposer's family of marks is SEXY. Applicant's mark is THE SEXY SIDE OF SCIENCE. The word "sexy" is not clearly dominant in applicant's mark. Rather, it appears to balance and modify the word "science," thereby showcasing a particular link between "sexy" and "science." Nevertheless, opposer has shown that it is not unusual for hair care products to be designed and marketed as scientific. (Morrison deposition at 10:18-21; noting that opposer's products have "proprietary ingredients, exclusive formulas,

exclusive and unique compounds, and different scientific combinations of ingredients that are unique to Sexy Hair.”). Indeed, each of opposer’s products has a special scientific formula designed for a particular type of hair. (*Id.* at 11:2-3; explaining that for each SEXY HAIR product, “each one is a specific answer or remedy to a hair need.”). This is evident in opposer’s various marks, many of which indicate the desired result of the product on the consumer’s hair (i.e., CURLY, STRAIGHT, WILD), based on opposer’s use of tailored, scientific formulas for each product. *Id.* As a result, consumers may also mistakenly believe that applicant’s mark is another one of opposer’s SEXY family-branded products with a reference to the “scientific” ingredients thereof. We therefore find that this *du Pont* factor favors finding a likelihood of consumer confusion.

Balancing the Factors

Considering all of the evidence of record as it pertains to the *du Pont* factors, we conclude that the goods substantially overlap and are likely to be marketed through the same channels of trade; opposer’s mark SEXY HAIR and family of SEXY marks have a degree of renown such that the marks are strong despite the suggestive nature of SEXY; and the marks are similar. Resolving doubt in favor of opposer as the prior registrant, which we must, we find a likelihood of consumer confusion between opposer’s mark SEXY HAIR and

Opposition No. 91177752

its family of SEXY marks and applicant's mark, THE SEXY SIDE OF SCIENCE. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *Miss Universe L.P. v. Community Marketing Inc.*, 82 USPQ2d 1562, 1572 (TTAB 2007).

DECISION: The opposition is sustained.