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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

Zervas

Mailed: August 25, 2004

Cancellation No. 92042416

Lancetti Cosmetics d/b/a  
Prestige Cosmetics

v.

Renee Beauty Salons, Inc.

Before Quinn, Walters and Drost, Administrative Trademark  
Judges.

By the Board.

Lancetti Cosmetics d/b/a Prestige Cosmetics  
("petitioner") has petitioned to cancel Registration No.  
1,918,555 for the mark BEAUTY BAR for "beauty salon and  
cosmetology services"<sup>1</sup> owned by Renee Beauty Salons, Inc.  
("respondent"). Petitioner claims in its petition to cancel  
that it filed a trademark application for BEAUTY BAR for  
"color cosmetics, namely color kits consisting primarily of  
articles of manufacture for home self-application of color  
to face, eyes and lips"; that its application has been

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<sup>1</sup> Registration No. 1,918,555 issued on September 12, 1995 and  
claims first use and first use in commerce on November 15, 1993.  
A filing under Section 8 of the Trademark Act was accepted on  
December 6, 2001.

**Cancellation No. 92042416**

refused registration "as likely to cause confusion, or to cause mistake, or to deceive, in view of Registration No. 1,918,555"; and that "registrant has abandoned [its] mark by discontinuing use of [its] mark with no intent to resume ... use."

On October 27, 2003, respondent filed an answer to the petition to cancel which denies the salient allegations of the petition to cancel.

This case now comes up on respondent's motion for summary judgment (also filed October 27, 2003) on the question of abandonment. Respondent's motion has been fully briefed by the parties.

Respondent maintains that its mark is currently in use and has been continuously used since 1993. As support for its contention that it has been using the mark, it has offered the declaration of Daniel Coniglio, Executive Vice President of respondent, who states in paragraph 3 that the mark BEAUTY BAR "has been in use in connection with 'beauty salon and cosmetology services' since at least as early as November 1993, and continues to be in use in interstate commerce"; and that the photographs attached to his declaration depict use of the mark. Respondent also enclosed a copy of a report by Seymour Adler, a private investigator hired by petitioner to investigate respondent's use of its mark, which *petitioner* filed in connection with

**Cancellation No. 92042416**

the prosecution of *petitioner's* application. The report, dated "Sept. 17 to Sept. 24, 2002," states as follows:

Instructions were received from the client to conduct an investigation pertaining to use of Beauty Bar, by Renee Beauty Salons, Inc., Pottsville, PA., tel. 570-429-1684. Contacting the above firm, I was able to speak with Claire, who said that this was a beauty salon, that is part of a thirty six chain. They have been in business for about six years, and are a full service salon.

Beauty Bar is only used as the name of the salon.

They do not have any products bearing the name Beauty Bar.

According to respondent, "there is no evidence of abandonment, nor can Petitioner assert or even suggest, that Respondent's mark BEAUTY BAR has been abandoned and/or is not in use"; and the cancellation should be dismissed.

Petitioner, in a two-page response, maintains as follows:

[The] report of an industrial investigator hired by petitioner ... makes two statements:

First: Beauty Bar is only used as the name of the salon; and

Second: They (Respondent's salons) do not have any products bearing the name Beauty Bar.

Respondent argues that the First statement is service mark use and Petitioner argues that it unambiguously describes a trade name use.

As an exhibit hereto is the examining attorney's basis for refusal of Petitioner's application which provides a synergistic reading of said First and Second statements based on what is know from common experience in the trade, that "... it is in the normal course of business, that an

**Cancellation No. 92042416**

organization that provides beauty salon services would also provide cosmetic items under the same name."

Petitioner concludes that "[o]n the record Respondent, which may have used Beauty Bar as a service mark, is not doing so currently, as reported by the industrial investigator, but is using this designation only as a trade name."<sup>2</sup>

In reply, respondent maintains that petitioner's contention that BEAUTY BAR "is only being used as a trade name is simply wrong"; and that respondent "is using its mark BEAUTY BAR to identify its beauty salon and cosmetology services by displaying the mark in promotional materials and on the premises where such services are rendered."

Respondent also contends that "it is not relevant in a petition to cancel Respondent's registration for services, on grounds of non-use, whether or not Respondent is also using the mark for related cosmetic products."

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The purpose of summary judgment is to avoid an unnecessary trial where additional evidence would not reasonably be expected to

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<sup>2</sup> Petitioner has not provided any evidence supported by an affidavit or declaration. See TBMP § 528.05 (2d ed. rev. 2004).

**Cancellation No. 92042416**

change the outcome. See *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984).

Respondent, as the party moving for summary judgment, has the burden of demonstrating the absence of any genuine issue of material fact and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

After carefully considering the evidence of record and the arguments of the parties, we find that respondent is entitled to summary judgment in this case.

We first note that "[i]t is well established ... that the name of a company or a salient feature of a trade name may function both as a trade name and as a service mark." *In re Amex Holding Corp.*, 163 USPQ 558 (TTAB 1969). The determination of whether a term is used as a trade name and a service mark must be made on the basis of the use of the term on the evidence offered in support of service mark use and the commercial impact of such use upon purchasers and

**Cancellation No. 92042416**

prospective customers as they encounter the services bearing the term. If a company name, or a portion of that name, is used in connection with the sale or advertising of services so as to create a commercial impression separate from the name, then this is evidence of probable service mark usage. *Ex Parte Little Studio, Inc.*, 111 USPQ 224 (Comm'r Pat. 1956).

We next turn to respondent's contention that it has not abandoned the mark. Pursuant to Section 45 of the Trademark Act, a mark is considered abandoned when its use has been discontinued with an intent not to resume such use. In this case, respondent has provided evidence of continuous use of its mark in connection with "beauty salon and cosmetology services" since November 1993. See Coniglio declaration, paragraph 3. Respondent has also enclosed photographs depicting the "present and open use" of BEAUTY BAR. The photographs show use of BEAUTY BAR on a large sign above a store entrance or on the store floor. Styling chairs, make-up chairs, mirrors, styling products and "trappings that are wholly consistent with beauty salon and cosmetology services" are visible inside the store. One photograph shows a store with a BEAUTY BAR sign that further states "Your Complete Beauty Store and Full Service Salon." Additionally, respondent has provided a copy of two pages of

**Cancellation No. 92042416**

its web site.<sup>3</sup> Under the caption "About Beauty Bar" on one web page is the following wording:

Beauty Bar salons are contemporary salons offering a wide range of services including the latest cuts, color, perms, texturizing, styling and many more. ... In addition, we offer COMPLIMENTARY consultations for all of our clients. (Emphasis in the original.)

From the evidence presented to us, we find that respondent's use of BEAUTY BAR creates the unambiguous commercial impression that BEAUTY BAR is used as a service mark; that this is or would be the general and likely impact of such use upon the average person encountering the web site and the stores depicted in the photographs under normal circumstances and conditions; and that respondent has been continuously using BEAUTY BAR in the sale and advertising of respondent's "beauty salon and cosmetology services."

Petitioner has argued that respondent does not use BEAUTY BAR as a service mark because respondent does "not have any products bearing the name Beauty Bar." As support, petitioner cites to one phrase in an Office Action issued in the prosecution of *petitioner's* trademark application, providing that "... it is in the normal course of business, that an organization that provides beauty salon services would also provide cosmetic items under the same name."

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<sup>3</sup> The web page is not accompanied by a declaration or affidavit of a person who can attest to its authenticity. See TBMP § 528.05(e) (2d ed. rev. 2004) and cases cited therein. However,

**Cancellation No. 92042416**

Petitioner's argument regarding trade name use is rejected. Service mark rights are not premised on use of a term also as a trademark; and "beauty salon and cosmetology services" are not premised on concurrent sale of goods, e.g., "cosmetic items." Additionally, petitioner's reliance on the examining attorney's statement is misplaced; the sentence was made in the context of a likelihood of confusion refusal and pertains to the possible relationship between applicant's goods and the services in the cited registration.<sup>4</sup>

In view of the foregoing, we conclude that respondent has met its burden of establishing that there are no genuine issues of material fact as to respondent's continuous use since registration until the present of BEAUTY BAR as a service mark for "beauty salon and cosmetology services," and that summary judgment is warranted in respondent's favor. Thus, respondent's motion for summary judgment is granted, and the petition to cancel is denied with prejudice.

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because petitioner has not raised an objection, we have considered the web page.

<sup>4</sup> Furthermore, it does not appear that the examining attorney was requiring beauty salon services to include the sale of cosmetics under the same name. Instead, the examining attorney was simply noting that this was a common feature of beauty salon services.