

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed: November 16, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Stript Wax Bar, LLC

Serial No. 77706198

Don Thornburgh of Don Thornburgh Law Corporation for Stript
Wax Bar, LLC.

John Kelly, Trademark Examining Attorney, Law Office 117
(Bret Golden, Managing Attorney).

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

Opinion by Wellington, Administrative Trademark Judge:

Stript Wax Bar, LLC, applicant, has appealed the final
refusal of the trademark examining attorney to register the
mark below for "body waxing services for the human body" in
International Class 44.¹



¹ Application Serial No. 77706198, filed April 3, 2009, based on
Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) (intent-
to-use).

During prosecution, the Examining Attorney required a disclaimer of the term WAX,² but applicant subsequently chose to amend the application to disclaim the compound wording WAX BAR.³

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, if used in connection with the identified services, so resembles the mark THE WAX BAR (in standard character format) for "body waxing services" in International Class 44,⁴ that it is likely to cause confusion or mistake or to deceive.

Our likelihood of confusion determination 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 Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods*,

² Office action issued on July 9, 2009.

³ In Office action issued on March 23, 2011, the Examining Attorney advised applicant that BAR need not be disclaimed and offered applicant the opportunity to withdraw the disclaimer of this term.

⁴ Registration No. 3504950, issued September 23, 2008.

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 turn first to the *du Pont* factor involving the similarity of the services and immediately find the applied-for mark and cited registration cover identical services, *i.e.*, body waxing services. Thus, this factor clearly weighs in favor of finding a likelihood of confusion and we further keep in mind that "[w]hen marks would appear on virtually identical goods or services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

In addition, because the respective services in the application and in the cited registration are identical, we must assume that the purchasers and channels of trade for such services are the same. See *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003); and *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). Accordingly, the *du Pont* factors involving the trade channels and classes of purchasers weigh in favor of finding a likelihood of confusion.

We now consider the similarity and dissimilarity between the marks. 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 Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

Applicant's mark, as shown above, is the combination of the literal terms STRIPT and WAX BAR. The initial term STRIPT figures more prominently inasmuch as it appears first in a larger, saloon-style font with the letter "S" further emphasized and isolated in an oval border.

The registered mark is THE WAX BAR in standard character format.

In comparing the two marks, the obvious similarity is that applicant's proposed mark adopts nearly the entire registered mark. On the other hand, the marks differ visually and phonetically due to the presence of the term STRIPT. To the extent that applicant argues the stylized lettering in STRIPT further distinguishes its mark, we must also consider that the registered mark is in standard character form and thus may be displayed in the same saloon-style font, thereby increasing the visual similarity of the two marks. *See, e.g., Citigroup Inc. v. Capital*

City Bank Group Inc., 637 F.3d 1344, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011).

The scenario of one party seeking to register a mark that incorporates the entirety of a previously-registered mark has been addressed by the Board on numerous occasions. Indeed, there is a line of cases holding that, in situations where a proposed mark incorporates the entirety of another mark, additional matter added to the proposed mark will not necessarily be sufficient to distinguish the marks as a whole. See, generally, *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988) (SUKESHA with a 'zigzag' design and other design element for hair care products confusingly similar to very similar 'zigzag' mark for hair care products); *In re Christian Dior, S.A.*, 225 USPQ 533 (TTAB 1985) (LE CACHET DE DIOR for shirts confusingly similar to CACHET for dresses); and *In re C. F. Hathaway Company*, 190 USPQ 343 (TTAB 1976) (HATHAWAY GOLF CLASSIC for men's shirts confusingly similar to GOLF CLASSIC for the same goods). On the other hand, the addition of a house mark or other matter has been found sufficient to distinguish two marks under circumstances where the registered mark, or appropriated matter, is highly suggestive or merely descriptive or has been frequently used or registered by others in the field for

the same or related goods or services. See, generally, *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066 (TTAB 2011) (ZU ELEMENTS, stylized, not confusingly similar to ELEMENTS despite identical goods); *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005) (ESSENTIALS not confusingly similar to NORTON MCNAUGHTON ESSENTIALS despite identical goods); *In re Merchandising Motivation, Inc.*, 184 USPQ 364 (TTAB 1974) (MEN'S WEAR for a semi-monthly magazine not confusingly similar to MMI MENSWEAR for fashion consulting for men because "MENSWEAR" is merely descriptive of such services). Accordingly, and with respect to this appeal in particular, we look to the nature of the common element, WAX BAR, to help determine the scope of protection to be accorded the registered mark in our likelihood of confusion analysis.

In its brief, applicant contends that the term WAX BAR has significance in relation to body waxing services. Applicant argues that "the only common element between the two marks (namely, "wax bar") is descriptive (or at least, highly suggestive) of the services being provided." Brief, p. 6. As a result, applicant asserts, the "focus of the comparison [of marks] should be upon the elements which the two marks do not share, including the word 'STRIPT,' which is completely absent from the [registered mark]." *Id.* at

p. 7 (emphasis in original). In support, applicant relies on the website printouts it submitted showing third-party use of the terms WAX BAR, BAR, or WAXING BAR, either in whole or in part, in connection with body waxing services. Based thereon, applicant states, "[t]hat so many third parties have adopted marks that include the term 'wax bar' indicates that the term has measurable significance in the field of body waxing services." Id. at p. 8. Applicant also likens the facts of this case to those found in *Knight Textile* and in *Rocket Trademarks*.

Based on the record, we are not persuaded that the wording WAX BAR possesses the degree of suggestiveness or significance in relation to body waxing services such that applicant's addition of the term STRIPT, albeit appearing first and in larger lettering, suffices for purposes of outweighing this similarity and distinguishing the two marks. There is no question that the word WAX alone is descriptive in connection with body waxing services; however, the evidence does not lead us to conclude that BAR or the combined wording WAX BAR is so highly suggestive of body waxing services or has been adopted by so many third-parties such that the registration is entitled to a narrower scope of protection. Contrary to applicant's assertion of use by "numerous third parties," the printouts

merely reflect eleven different websites referencing marks such as ZANELLA'S WAX BAR, LA LOOK WAX BAR, DALLAS WAX BAR, WAX BAR or THE WAX BAR being used in connection with body waxing services. At least three of the eleven websites indicate use of the term THE WAX BAR and the possibility exists that the referenced establishments may all be affiliated with the cited registrant. Accordingly, applicant has not shown that the circumstances of this case are akin to those found in cases such as *Knight Textile* or *Rocket Trademarks*. In those two cases, the Board relied on the defined meanings of the common terms, ELEMENTS and ESSENTIALS, providing some background to the significance of those terms in connection with clothing. In this case, it has not been shown how the defined meaning of "bar" would have any significance with respect to body waxing services. Furthermore, in *Knight Textile*, the Board relied on the existence of twenty-three, third-party registrations for marks containing the term ESSENTIALS for clothing goods; these registrations, like the dictionary definition, supported a finding that the term is highly suggestive for clothing.

With regard to the commercial impression or meaning of the marks, we consider them in their entirety and do not ignore the relevance of the stylized STRIPT element in

applicant's mark. The record does not indicate that this term has any special meaning in connection with body waxing services.⁵ And while STRIPT appears first in applicant's mark and injects a possible different connotation not found in the registered mark, its presence does not, by itself, remove the likelihood of confusion. See, generally, *In re Christian Dior, S.A.*, 225 USPQ 533 (TTAB 1985); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (RICHARD PETTY'S ACCU TUNE for automotive service centers confusingly similar to ACCUTUNE for automotive testing equipment); and *Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 USPQ 168 (TTAB 1982) (MENNEN SKIN SAVERS for hand and body lotion confusingly similar to SKIN SAVERS for face and throat lotion). Rather, consumers already familiar with registrant's mark may interpret the addition of STRIPT as a house mark that simply identifies what had previously been an anonymous source for registrant's services. See *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1367 (TTAB 2007) ("Indeed, a consumer who has been told about the advantages of registrant's MVP casino services is likely to believe that

⁵ The examining attorney argues in his brief that STRIPT is the phonetic equivalent of "stripped" and thus is highly suggestive because body waxing services "involve hair being 'stripped' away from the skin." Brief, p. 7. While this may be true, this is not matter for which the Board can take judicial notice and the evidence does not reflect such meaning.

the CLUB PALMS MVP casino services is simply the now identified source of the previously anonymous MVP casino services.”)

In view of the foregoing, we find that the marks, when considered as a whole, are overall more similar than not and we resolve this *du Pont* factor against applicant.

In sum, and upon weighing all of the evidence and arguments pertaining to the relevant *du Pont* factors, we find that consumers already familiar with registrant’s mark THE WAX BAR are likely to assume, upon encountering applicant’s mark STRIPT WAX BAR, stylized with design, being used in the same trade channels and in connection with the same body waxing services, that said services derive from the same source.

We emphasize that our ultimate conclusion is based mainly on applicant’s incorporation of the term, WAX BAR, which is essentially identical to registrant’s mark, THE WAX BAR. The evidence does not show WAX BAR to be so frequently used or so suggestively weak to permit such an adoption when both marks would be used in connection with the same body waxing services. Under these circumstances, and resolving any doubt as we must in favor of the prior registrant, we find that a likelihood of confusion exists. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d

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1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal of registration is affirmed.