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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of Bespoke Europe Limited	)	Serial No. 79133036
Mark: NAIL HQ	)	
Filed: April 18, 2013	)	

APPLICANT'S APPEAL BRIEF

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Introduction

The Applicant, Bespoke Europe Limited, appeals to the Trademark Trial and Appeal Board from the Examining Attorney's final refusal to register the mark NAIL HQ.

Argument

Applicant has filed Application Serial No. 79133036 for:

Goods in Class 3, namely:

"Cosmetics preparations and personal care preparations, namely, non-medicated skin lotions and creams; non-medicated skincare preparations; false eyelashes; body glue for hair piece bonding; non-medicated toiletries; essential oils; soaps; skin care products, namely, non-medicated skin serum; perfumery; nail varnish removers; hand and nail cream; substances for treating nails, namely, nail creams; cosmetic cotton wool; make-up; lotions; beauty creams; beauty masks; facial masks; aloe vera gel for cosmetic purposes; exfoliant creams and scrubs; artificial nails; artificial nails for cosmetic purposes; false nails; glue for strengthening nails; lotions for strengthening nails; nail art stickers; nail base coat; nail buffing preparations; nail care preparations; nail cream; nail enamel; nail enamel removers; nail enamels; nail gel; nail glitter; nail hardeners; nail hardeners [cosmetics]; nail polish; nail polish base coat; nail polish remover; cosmetic nail tips; preparations for reinforcing the nails; abrasive boards for use on fingernails; fingernail decals; nail overlay material; fingernail sculpturing overlays. ", and

Goods in Class 8, namely:

"Manicure and pedicure instruments, namely nail flies, tweezers, scissors, clippers, razors, knives, rasps, files, pincers, tweezers, nippers, scrapers, cuticle pushers, polishing, abrading, cutting and buffing apparatus and instruments; nail buffers; nail files; fingernail polishers.", and

Services in Class 44, namely:

"Provision of beauty, perfumery, make-up and skin treatment services; beauticians' services; beauty consultation services regarding the selection and use of personal care products, cosmetics, make-up, toiletries, manicure and pedicure products; manicure services; pedicure services; nail treatment services; hygienic and beauty services for human beings."

On March 24, 2014, the Examining Attorney issued an Office Action refusing the registration of Applicant's mark on the grounds of likelihood of confusion with U.S. Trademark Registration No. 4431047 for the mark NAIL HQ for service in Class 35, namely:

"Retail store services, namely, pharmacy, retail drug store and general merchandise store services."

The Examining Attorney has determined that the most relevant *DuPont* factors are 1) similarity of the marks, and 2) similarity of the goods and/or services. Using this two-part test, the Examining Attorney has determined that the marks are identical and the goods and services are related and, therefore, consumers would mistakenly believe that the goods and services come from a common source.

Applicant concedes that the marks are indeed identical. Applicant further concedes that Applicant's services in Class 44 are highly related to Registrant's retail services in Class 35, and that consumers would likely be confused as to the origin of Applicant's services if Applicant's mark is allowed to register in Class 44.

However, Applicant contends that the Examining Attorney has erred in concluding that the goods in Applicant's application are related to the retail services in Registration No. 4431047 for the following reasons.

The nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. *See* TMEP 1207.01(a)(iii); *In re Dakin's Miniatures Inc., 59 USPQ2d 1593 (TTAB 1999)*. Registrant's NAIL HQ mark is for retail store services in Class 35 alone. As a service mark, it can only be registered for activities that constitute services as contemplated by the Trademark Act. *See* TMEP 1301.01. In order for a service to be a service contemplated by the Trademark Act, the service must be performed to the order of, or for the benefit of, someone other than the Registrant. *See* TMEP 1301.01(a)(2). A company that promotes the sale of its own goods does so for its own benefit rather than for the benefit of others. *In re Reichhold Cems., Inc. 167 USPQ 376 (TTAB 1970)*. Therefore, Registrant's NAIL HQ mark is only registered for retail store services that do not include the sale of its own NAIL HQ-branded products.

The Examining Attorney has submitted as evidence a number of third-party registrations that include both goods in Class 3 and/or Class 8 and services in Class 35. The Examining Attorney contends this evidence shows that consumers would likely encounter goods similar to Applicant's sold in Registrant's retail stores and therefore would be confused as to the source of Applicant's goods if encountered outside of Registrant's retail stores. Applicant believes this reasoning is faulty because it errantly assumes that the goods contained in the third-party registrations are sold in the same retail store settings as the Class 35 services in those registrations.

First, nothing in the recitation of goods in these third-party registrations indicates that the goods are sold through the retail services offered under the same mark. If a cited registration contains no limitations as to trade channels, it must be presumed that the goods travel through all ordinary channels of trade. *In re Uncle Sam Chem. Co., 229 USPQ 233 (TTAB 1986)*. Therefore, it must be presumed that the goods in the third-party registrations offered as evidence are sold, and would be encountered by consumers, in retail stores other than those of the owners of the third-party registrations. Second, the nature of the retail store services in the third-party registrations dictate that the protected services *do not* include the sale of the registrants' own goods protected under the same mark. Because the goods contained in the third-party registrations can be sold separately from the retail services in the same registrations, and because the protected retail

services in the third-party registrations do not contemplate the sale of goods under the same mark, Applicant believes that the Examining Attorney's evidence tends to prove the opposite of what it is offered to prove: that consumers will not mistakenly believe Applicant's goods in Classes 3 and 8 emanate from the same source as Registrant's retail store services in Class 35, but will rather assume the sources are different.

Furthermore, while companies may register both goods and retail services under the same mark, Registrant has not. Registrant has sought to protect its mark for retail services only. If the Board affirms the Examining Attorney's refusal, it will unjustly expand Registrant's protections under its NAIL HQ mark to goods, and virtually any class of goods that can be sold in a pharmacy, retail drug, or general merchandise store. It would also create the odd situation where Registrant can prevent others from selling goods under a Nail HQ mark even while its own sale of Nail HQ-branded products is specifically excluded from the protection it receives under its Registration 4431047.

For the foregoing reasons, Applicant respectfully requests that the refusal to register Applicant's mark be reversed as to Classes 3 and 8 and that the Application be approved for publication.

Dated: September 14, 2015

Respectfully submitted,

Jon K. Perala
Attorney for Applicant

TABLE OF AUTHORITES

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In re Dakin's Miniatures Inc., 59 USPQ2d 1593 (TTAB 1999).....3

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First-class mail in an envelope addressed to:

ATTN: Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

On September 14, 2015

Jon K. Perala
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