

**This Opinion is Not a
Precedent of the TTAB**

Mailed: March 28, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Bespoke Europe Limited
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Serial No. 79133036
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Jon K. Perala, Esq., of Perala Law Office
for Bespoke Europe Limited.

Paul Moreno, Trademark Examining Attorney, Law Office 103,
Michael Hamilton, Managing Attorney.

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Before Wellington, Kuczma, and Goodman,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Bespoke Europe Limited (“Applicant”) seeks registration on the Principal Register of the mark NAIL HQ, in standard character format, for the following goods and services:

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 for skin; beauty creams; beauty masks; facial masks; aloe vera gel for cosmetic purposes; exfoliant creams and body scrubs; artificial nails; artificial nails for cosmetic purposes; false nails; glue for strengthening nails; lotions for

strengthening nails; nail art stickers; nail polish 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, namely, emery boards; fingernail decals in International Class 3;

Manicure and pedicure instruments, namely, nail files, 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 in International Class 8; and

Provision of beauty, perfumery, make-up and skin treatment services, namely, make-up application and cosmetic body care; 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 in International Class 44.¹

The application contains a disclaimer of the exclusive right to use of the word NAIL.

The Trademark Examining Attorney has refused registration of Applicant's mark on the ground of a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the registered mark NAIL HQ, in standard character format, for "retail store services, namely, pharmacy, retail drug store and general merchandise store services."² The registration contains a disclaimer of the exclusive right to use of the word NAIL.

¹ Application Serial No. 79133036 was filed on April 30, 2013, under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a), based on International Registration No. 1167742 dated April 18, 2013.

² Registration No. 4431047 issued November 12, 2013.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed and briefs have been filed.

For the following reasons, we affirm the likelihood of confusion refusal.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion 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, however, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, 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).

Similarity of the Marks

We begin by comparing the two marks in their entirety and, in doing so, look to their appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In this case, there is little to analyze because the applied-for mark, NAIL HQ, is identical to the cited registered mark. Thus, they are the same in sight and sound. Applicant expressly concedes this much in its brief.³

³ 13 TTABVUE 3 (“Applicant concedes that the marks are indeed identical.”).

The only possible distinguishing point between the marks is that the term NAIL, which has been disclaimed in both marks, takes on a more highly descriptive meaning in the context of Applicant's goods and services. In the context of Applicant's recited goods and services that specifically involve fingernails or toenails, *e.g.*, nail treatments, manicure and pedicure instruments, and nail treatment services, the term NAIL takes on an obvious, highly descriptive meaning. Registrant's services, on the other hand, involve retail store or drugstore services and do not specifically include nail services or products. Thus, in the context of these services, the term "nail" may likely be understood as a reference to the sale of metal fasteners as well products for fingernails or toenails.

Nevertheless, as we have often held, the identity of marks is a *du Pont* factor that "weighs heavily in favor of a finding of likelihood of confusion." *In re i.am.symbolic, LLC*, 116 USPQ2d 1406, 1411 (TTAB 2015). *Accord In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 (TTAB 2013). ("In short, we find that the marks are identical. This finding under the first *du Pont* factor strongly supports a conclusion that a likelihood of confusion exists.").

Accordingly, this *du Pont* factor weighs in favor of finding a likelihood of confusion.

Similarity Between the Goods and Services

We turn now to the *du Pont* factor involving the relatedness of goods and services. It is settled that in making our determination, we must look to the goods as identified in the application vis-à-vis those recited in the cited registration. *See Octocom Sys., Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed.

Cir. 1990); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011). We further note that when the involved marks are identical, as is the case here, “the degree of similarity between the goods [or services] that is required to support a finding of likelihood of confusion declines.” *i.am.symbolic*, 116 USPQ2d at 1402; *see also*, *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688-89 (Fed. Cir. 1993) (“even when the goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source”); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002); and *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001). It is only necessary that there be a “viable relationship between the goods” to support a finding of likelihood of confusion. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009).

1. *Applicant’s Class 44 services and Registrant’s Services*

In its appeal brief, Applicant “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.”⁴ Because Applicant concedes this factor, as well admitting the marks are identical, and ultimately admits that there is a likelihood of confusion with the registered mark, we need not give further attention in this appeal with respect to Applicant’s Class 44 services.

⁴ 13 TTABVUE 3.

2. Applicant's Goods in Classes 3 and 8 vis-a-vis Registrant's Services

Applicant's Class 3 goods are described in general as "cosmetics preparations and personal care preparations," and specifically include "non-medicated skin lotions and creams . . . non-medicated toiletries . . . soaps . . . cosmetic cotton wool . . . make-up . . . lotions for skin . . . artificial nails . . . nail polish . . . abrasive boards for use on fingernails, namely, emery boards." Applicant's Class 8 goods are prefaced as "manicure and pedicure instruments," but specifically include certain household basics such as nail files, tweezers, scissors, clippers, and razors.

In support of the argument that Applicant's Class 3 and 8 goods are related to Registrant's "retail store services, namely, pharmacy, retail drug store and general merchandise store services," the Examining Attorney submitted Internet printouts from the retail stores Target, Macy's, Walmart, and Walgreens.⁵ These printouts show that retail establishments that offer pharmacy services or sell general merchandise may specifically feature the same types or categories of goods listed in Classes 3 and 8 of the application. For example, Walmart's website allows the consumer to shop its "Beauty" and "Makeup" category that includes subcategories

⁵ We note that the Examining Attorney also submitted numerous third-party registrations in support of his argument that Applicant's goods and services are related to Registrant's services. However, we find the registrations submitted have little probative value here and have not been relied upon in making our ultimate conclusion regarding a likelihood of confusion. Specifically, in order for third-party registrations to have some probative value they should be use-based and cover the listed goods and services involved in the proceeding in order to show that these types of goods and services may emanate from the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Here, nearly all of the third-party registrations do not cover pharmacy, retail drug store or general merchandise store services; rather, they involved retail store services featuring specific goods or specific types of goods.

such as “nails . . . face ... body makeup.”⁶ The Walgreens website mentions its “Pharmacy” category of products and, on the same page, identifies many of the same products listed in Classes 3 and 8 of the application under the product category of “facial skin care” and “cleansers” as well as various nail-care instruments and products.⁷ The retailer Target also sells not only a variety of cosmetics and skincare preparations but also some of the same specific instruments listed in Class 8 of the application, including “manicure kits” and “pedicure kits.”⁸ Based on the sheer number and variety of cosmetics, personal care preparations and nail care instruments being offered by these general merchandise retailers, it is evident that general merchandise or pharmacy retailers dedicate significant attention to these categories of goods. Indeed, general merchandise retailers and pharmacies constitute a viable and likely trade channel for the very same type of goods listed in the application.

Accordingly, we find that there is a sufficient relationship between Applicant’s goods, as listed in Classes 3 and 8, with Registrant’s retail pharmacy, drugstore, and store services featuring general merchandise, and this factor weighs in favor of finding a likelihood of confusion.

⁶ Office Action issued on July 6, 2015 at pp. 6-17.

⁷ *Id.* at pp. 25-60.

⁸ *Id.* at pp. 62-83.

Conclusion

Upon review of the entire record, we find that Applicant's applied-for mark NAIL HQ, in all three classes of goods and services, is likely to cause confusion with the mark in the cited registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). In particular, with respect to Applicant's Class 44 services, Applicant admitted that there is a likelihood of confusion. We further find that consumers already familiar with Registrant's NAIL HQ mark for general merchandise store, drugstore and pharmacy services are likely to be confused as to source upon encountering Applicant's Class 3 and 8 goods being sold under the identical mark, NAIL HQ which may be featured in the same type of retail stores.

Decision: The likelihood of confusion refusal to register Applicant's mark is affirmed.