

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
3 July 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sexy Hair Concepts, LLC
v.
Perfect Plus, Inc.

Opposition No. 91170863
to application Serial No. 78573653

Roberta Jacobs-Meadway of Ballard Spahr Andrews & Ingersoll,
LLP for Sexy Hair Concepts, LLC.

Richard H. Zaitlan of Pillsbury Wintrop LLP for Perfect
Plus, Inc.¹

Before Holtzman, Drost, and Mermelstein, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On February 23, 2005, applicant, Perfect Plus, Inc.,
applied to register the mark SEXY 'N SASSY in standard
character form on the Principal Register for "Hair care
products, namely, shampoo, conditioners, hair spray, styling
gels, and mousse" in Class 3. The application is based on
applicant's allegation of a bona fide intention to use the
mark in commerce.

¹ Applicant did not file a brief in this case.

Opposition No. 91170863

On May 12, 2006, 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 the following goods: 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 Class 3. The registration was issued November 14, 2000,² and it contains a disclaimer of the word "Hair."

In its notice of opposition (p. 2), 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),' among others."

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." Notice of Opposition at 3.

Applicant has denied the salient allegations of the notice of opposition.

² Affidavits under Sections 8 and 15 have been accepted and acknowledged.

The Record

The record consists of the pleadings, the file of the involved application; the testimonial deposition of Mark Stiller, opposer's chief operating officer, with exhibits; the testimonial deposition of Jim Morrison, opposer's chief executive officer, with exhibits; the testimonial deposition of John F. Metzger, the senior legal assistant of opposer's law firm, with exhibits; the testimonial deposition of Kenneth Browning, applicant's chief executive officer, with exhibits; opposer's notices of reliance on a status and title copy of its SEXY HAIR registration, applicant's responses to opposer's interrogatories, and excerpts from printed publications. Applicant also submitted a notice of reliance on an Office action in another trademark application.³

Priority

As a result of opposer's submission of status and title copies of its registration (No. 2403396), which also supports a non-frivolous argument of confusion, 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*

³ The notice of reliance also indicated that applicant was relying on the testimonial deposition of Kenneth Browning, which is already of record in its entirety. Objections to applicant's notice of reliance with respect to this deposition will not be separately considered.

King's Kitchen, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Evidentiary Questions

Opposer has raised numerous objections to the testimony of applicant's witness. Opposer objects to Browning Exhibits 106-118 and the related testimony because this testimony and the related exhibits concern internet searches that the witness did not perform. See, e.g., Browning dep. at 53:

Q. Moving on, let's just take a look at Exhibit 108. How many pages did you print out?

A. For Exhibit 108?

Q. Right. Did you do these searches?

A. No. I did not.

Q. Who did the searches?

A. Counsel.

Q. Did you review the searches?

A. Yes.

We sustain opposer's objections to these exhibits. See *Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741, 1748 (TTAB 2006):

Starbucks has objected to several printouts of excerpts apparently taken from Internet websites that Ruben sought to introduce during his testimony deposition. These excerpts contain criticisms of Starbucks and/or the price of goods sold by Starbucks. During Ruben's deposition, Starbucks' counsel objected to this evidence as inadmissible hearsay that was not properly authenticated by the person with first-hand knowledge who searched for and downloaded the information. In

fact, on cross examination, Mr. Ruben admitted that these particular searches were conducted, and the search results printed out, by someone in his counsel's office. While he allegedly conducted a similar search himself, he was not aware of the parameters of the search associated with the web pages submitted during his testimony, and was not able to name the individual who conducted the Internet search. Accordingly, this evidence has not been properly authenticated, and we have given it no consideration.

Opposer also objects to Browning Exhibits 119 and 120 and the related testimony. Opposer points out that applicant is "improperly attempt[ing] to make of record third-party registrations through search reports ... Only legible soft copies of registrations or the electronic equivalent qualify as evidence of the third party registrations." Brief at 3. We agree. See *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006) ("The trademark search report is not credible evidence of the third-party uses or registrations listed in the report. Accordingly, the listings therein are not entitled to any probative value") (citations omitted). Exhibit 119 is a USPTO printout that is a list showing the registration and serial number along with the mark and the Live/Dead status of the registration. We do not consider lists of registrations. See *Plus Products v. Pharmavite Pharmaceutical Corp.*, 221 USPQ 256, 260 (TTAB 1984) ("Applicant has attempted to show that opposer's mark is weak by filing a notice of reliance on a long list of third party registrations and applications for registration which

incorporate the term 'PLUS' as part of the mark. The lists of registrations submitted by applicant are unsupported by any copies of the registrations, which are not matters for judicial notice. As such, they are not properly of record and cannot be considered").

We overrule opposer's relevancy objections to exhibit 121 and related testimony. While evidence of use of a term on different goods is not highly relevant, it is not necessarily irrelevant either. Opposer also objects to exhibits 105, 121, and 122 and related testimony on the ground that opposer requested the information and applicant "failed or refused to produce" the information during discovery. Brief at 4. We do not understand that applicant failed or refused to produce the information. Applicant's responses were not a denial that documents existed or a simple refusal to answer the interrogatories on the ground that the information was irrelevant. See, for example:

Interrogatory No. 1:
Identify all products with which Applicant uses Applicant's Mark.

Subject to and without waiving its objections, Applicant responds as follows: "Applicant uses Applicant's Mark in connection with the SEXY HAIR⁴ hair care products sold on QVC.com."

Interrogatory No. 15:
Identify all uses by any entity other than Opposer and Applicant of the term SEXY as a name or mark, or component of a name or mark for any hair care products.

⁴ Interestingly, applicant's mark is SEXY 'N SASSY not SEXY HAIR.

Applicant hereby incorporates by reference and explicitly reasserts the General Objections in this response. Applicant further objects to this interrogatory because it purports to seek information that is not within Applicant's knowledge. Applicant further objects to this interrogatory because it is vague and ambiguous, overbroad, unduly burdensome, harassing, and purports to seek information that is neither relevant to, nor likely to lead to the discovery of admissible evidence.

Unlike opposer's cited case of *Weiner King, Inc. v. The Wiener King Corp.*, 615 USPQ 512, 204 USPQ 820 (CCPA 1980), applicant's answers did not amount to a statement "that all of the information concerning the issues ... that [applicant] would rely on with respect to those issues" was somehow already of record. *Id.* at 828. This case is more similar to *Linville v. Rivard*, 41 USPQ2d 1731 (TTAB 1996), *aff'd on other grounds*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998). In that case the party "objected to both the interrogatory and the production request as 'vague and ambiguous, and overly burdensome.' These objections were not of a nature which would have led petitioner to believe that no such documents existed." *Id.* at 1733. We therefore overrule opposer's objection to these documents.⁵

We also overrule opposer's objections to the magazine covers in Exhibit 105. These are portions of printed publications and they are the proper subject of a notice of reliance and not irrelevant. 37 CFR § 2.122(e).

⁵ Petitioner did not file a motion to compel.

Likelihood of Confusion

Next, we address the issue of likelihood of confusion under Section 2(d). Here, applicant's mark is SEXY 'N SASSY and opposer's mark is SEXY HAIR. In these cases, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

We begin by comparing the parties' goods. Applicant's goods are hair care products, namely, shampoo, conditioners, hair spray, styling gels, and mousse and opposer's goods are 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. Applicant's goods are either identical or virtually identical to opposer's goods, i.e., shampoo, conditioners, hair spray, styling or hair gel, and mousse. Applicant's goods are included within opposer's identification of goods and there is no legal difference between the goods.

We also must consider the goods as they are identified in the identification of goods in the application and registration. *Octocom Systems, Inc. v. Houston Computers*

Opposition No. 91170863

Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). Therefore, despite any actual differences in type or quality of the parties' goods, we must assume that they are identical.

The fact that the goods are identical also means that we must assume that purchasers and channels of trade are also identical. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the

same channels of trade, and be sold to the same class of purchasers").

Another important point that we must consider is that when goods are identical, marks do not have to be as similar before there is confusion. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) ("When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines").

The next "DuPont factor requires examination of 'the similarity or dissimilarity of the marks in their entirety as to 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, 1691 (Fed. Cir. 2005) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973)). We must compare the marks in their entirety, and not simply the individual features of the marks. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). Applicant's mark is SEXY 'N SASSY while opposer's mark is SEXY HAIR. Both marks are shown in typed or standard character form and that means that there is no viable difference in the marks based on their stylization. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939

Opposition No. 91170863

(Fed. Cir. 1983). In effect, we must assume that the marks are or can be displayed in the same stylization. *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1639 (TTAB 2007) (“[B]ecause applicant's mark ARDENBEAUTY is presented in typed or standard character form, the wording could reasonably be displayed in the same block letter form as ARDEN B, thereby increasing the visual similarity of the two marks”} and *In re Hester Industries, Inc.*, 231 USPQ 881, 882 n.6 (TTAB 1986) (“Inasmuch as the drawing of applicant's mark is in typed form, applicant is not limited to any particular form of display, and might use its mark in the same form as registrant”).

Next, we look at the similarities between the words in the marks SEXY 'N SASSY and SEXY HAIR. They are similar inasmuch as they both begin with the same word SEXY, which is a factor that supports a conclusion that confusion is likely here. *Palm Bay Imports*, 73 USPQ2d at 1692 (“To be sure, CLICQUOT is an important term in the mark, but VEUVE nevertheless remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label. Not only is VEUVE prominent in the commercial impression created by VCP's marks, it also constitutes ‘the dominant feature’ in the commercial impression created by Palm Bay's mark”). See also *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1845.

The only other word in opposer's mark is the word "hair," which opposer has disclaimed. "Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'" *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846, quoting, *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985). The Federal Circuit has noted that "a disclaimed term... may be given little weight, but it may not be ignored." *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1948-49 (Fed. Cir. 2006). In this case, we find that the term "Hair" is particularly entitled to little weight inasmuch as both applicant's and opposer's goods are identified as "hair care products." Because both parties' products are products for a person's hair, it is unlikely that purchasers will rely on the term "hair" to distinguish one party's hair care products from those of others.

However, applicant's next term ('N SASSY) is different from any word in opposer's mark. This is a fact in favor of applicant. However, we do not find that its presence results in dissimilar marks. Customers familiar with opposer's mark SEXY HAIR for hair care products are likely to assume that applicant's SEXY 'N SASSY mark for the same products are in some way related or associated with opposer.

Opposition No. 91170863

The term "'N SASSY" builds on the SEXY HAIR meaning of opposer's mark and adds an additional element "Sassy." Customers are likely to believe that applicant's shampoo is a refinement of opposer's SEXY HAIR shampoo.

We add that opposer uses its SEXY HAIR marks with additional words such as: STRAIGHT SEXY HAIR, SHORT SEXY HAIR, BIG SEXY HAIR, CURLY SEXY HAIR, HOT SEXY HAIR, WILD SEXY HAIR, and SILKY SEXY HAIR. Stiller dep. at 11-12, Exhibit 1. We do not reach the issue of whether this is a family of marks, but the evidence does show that consumers are accustomed to numerous products with a variation of opposer's SEXY HAIR mark originating from opposer. This fact favors opposer's argument that the marks are similar. *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1700 (TTAB 1987) ("The fact that Humana has itself used variations of its house mark by adding matter to it, e.g., HUMANA CARE and HUMANA CARE PLUS, increases the likelihood that HUMANOMICS would be perceived as another variation. We do not consider the above to be a "family of marks" result...").

We also have taken into consideration the fact that the term "Sexy" is hardly an arbitrary term for the parties' goods. However, opposer is relying on a mark that is registered on the Principal Register and applicant has not petitioned to cancel the registration. Therefore, we must

assume that the mark is inherently distinctive. 15 U.S.C. § 1057(b).

The starting point in this case is that opposer's registrations are valid and enjoy the benefits of section 7(b). The next point is that this is an opposition only and in an opposition, this court has always held, the validity of the opposer's registrations are not open to attack. As long as a registration relied on by an opposer remains uncanceled, we treat it as valid, entitled to the section 7(b) presumptions, and take it at face value.

Contour Chair-Lounge Co., Inc. v. The Englander Co., Inc., 324 F.2d 186, 139 USPQ 285, 287 (CCPA 1963) (citations omitted).

We note that applicant has submitted evidence apparently to show that the term "Sexy" is commonly used to refer to a variety of products, including some hair care products. Browning Ex. 104 - *Allure* - "Sexy, Speedy Hairstyles"; *Allure* - "Fresh Sexy Hair"; *Mademoiselle* - "Sexy Hair & Makeup for a melt-proof summer"; *Mademoiselle* - "22 Sexy New Looks"; *Glamour* - 578 Love, Sex, Hair & Style Dos"; *Glamour* - Happy, Sexy, Healthy"; and *Glamour* - Sexy Hair You'll Love").

Opposer, on the other hand, has shown that its mark has acquired some renown. It has been featured on television and in magazines and internet advertising. See, e.g., *Mobile Register (Alabama)*, January 3, 2006 ("If you're desperate for housewife hair you can have that, too.

Longoria says she keeps up her coif with Big Sexy Hair Spray

Opposition No. 91170863

and Play Hairspray"); *Cleveland Plain Dealer*, April 21, 2004 ("On the product front, he praises the Sexy Hair Concepts lines, which includes Big Sexy Hair Root Plum Plus (great for curly or straight hair), Big Sexy Hair Big Shine Shine Spray (It doesn't weigh hair down at all) and Big Sexy Hair Flip It Over Full & Wild Spray"); *Chicago Tribune*, March 12, 2003 (At Sexy Hair Concepts, a new product called Wild Sexy Hair was being promoted while hair aficionados grooved to vinyl records spun by a disc jockey"); and *Los Angeles Daily News*, June 28, 2003 ("The trendy edge led JC Penney to stock his wares, adding the Big, Short and Healthy Sexy Hair lines"). Opposer's SEXY HAIR products have been featured on *The Today Show*, *Entertainment Tonight*, and HBO's *Entourage*, CBS's *How I Met Your Mother*, ABC's *The View*, and on the show *Ugly Betty*. Morrison dep. at 16-17; Stiller dep. Exhibits 34 and 35. Sales of its SEXY HAIR products have risen substantially over the last several years from about \$4 million in 1999 to more than \$51 million in 2006. Stiller dep. at 14 and Exhibit 1.⁶ Opposer has increased its selling and marketing expenses from \$4.2 million in 2003 to more than \$6.2 million in 2006. Stiller dep. at 77. While opposer's mark may be highly suggestive, opposer's evidence

⁶ Opposer's witness estimated that these wholesale figures would be more than triple at retail.

Opposition No. 91170863

shows that the mark is not so weak that it is entitled to only a very narrow scope of protection.

We add that the fact that a mark is not unique does not mean that it is entitled to a very narrow scope of protection. *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1198 (TTAB 2007) (“[W]hile star designs in and of themselves may be weak, there is no evidence which would effectively diminish the scope of protection to be accorded opposer's S and star design mark as a whole”). See also *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978) (ERASE is confusingly similar to STAIN ERASER on the Supplemental Register both for stain removers).

While we can examine the individual elements of the marks, ultimately, we must compare the marks in their entireties and determine if they are similar or dissimilar. *National Data*, 224 USPQ at 751 (“[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable”). We “note that similarity is not a binary factor but is a matter of degree.” *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003). In this case, it is clear to us that the marks are

more similar than they are dissimilar and this factor supports a conclusion that confusion is likely.

Another factor that we consider is the fact that opposer is the prior registrant. To the extent that we have doubts about whether there is a likelihood of confusion, we resolve them, as we must, against the applicant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) and *In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes*, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973). See also *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1948 (Fed. Cir. 2004) quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002) ("Like the Board, this court 'resolves doubts about the likelihood of confusion against the newcomer because the newcomer has the opportunity and obligation to avoid confusion with existing marks'").

When we consider that the goods in this case are legally identical and that the channels of trade and purchasers are also identical, when the marks SEXY HAIR and SEXY 'N SASSY are used on these products, a non-de minimis number of consumers are likely to believe that the sources of the products sold under these marks are in some way related or associated.

Opposition No. 91170863

Decision: The opposition to the registration of application No. 78573653 is sustained.