

ESTTA Tracking number: **ESTTA225410**

Filing date: **07/21/2008**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Farouk Systems, Inc.
Granted to Date of previous extension	07/19/2008
Address	250 Pennbright, Suite 150 Houston, TX 77002 UNITED STATES

Attorney information	Ben D. Tobor Greenberg Traurig LLP 1000 Louisiana, Suite 1700 Houston, TX 77002 UNITED STATES toborb@gtlaw.com Phone:713-374-3568
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**Applicant Information**

Application No	77369976	Publication date	05/20/2008
Opposition Filing Date	07/21/2008	Opposition Period Ends	07/19/2008
Applicant	FHI Heat, Inc. Suite B 14500 Industrial Avenue North Maple Heights, OH 44137 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 003. First Use: 2005/12/31 First Use In Commerce: 2005/12/31 All goods and services in the class are opposed, namely: Hair care preparations; Hair conditioners; Hair shampoo; Hair straightening preparations
Class 009. First Use: 2003/09/30 First Use In Commerce: 2003/09/30 All goods and services in the class are opposed, namely: Electric irons for styling hair
Class 011. First Use: 2006/09/30 First Use In Commerce: 2006/09/30 All goods and services in the class are opposed, namely: Hand-held electric hair dryers

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2660257	Application Date	06/19/2000
Registration Date	12/10/2002	Foreign Priority	NONE

		Date	
Word Mark	CHI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2001/01/18 First Use In Commerce: 2001/01/18 ELECTRIC HAIR CURLING IRONS		

U.S. Registration No.	3426769	Application Date	11/30/2004
Registration Date	05/13/2008	Foreign Priority Date	NONE
Word Mark	CHI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2004/11/29 First Use In Commerce: 2004/11/29 Hair coloring preparations, namely, hair color lighteners, color lock treatments, color developers, and colors		

U.S. Registration No.	3387588	Application Date	12/01/2006
Registration Date	02/26/2008	Foreign Priority Date	NONE
Word Mark	CHI NANO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2006/12/01 First Use In Commerce: 2006/12/01 Electric hair curling irons, electric hair styling irons, electric hair straightening irons, electric hair flat irons Class 011. First use: First Use: 2006/12/01 First Use In Commerce: 2006/12/01 Hair dryers		

U.S. Registration No.	2660257	Application Date	06/19/2000
Registration Date	12/10/2002	Foreign Priority Date	NONE
Word Mark	CHI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2001/01/18 First Use In Commerce: 2001/01/18 ELECTRIC HAIR CURLING IRONS		

U.S. Registration No.	3341114	Application Date	04/26/2005
Registration Date	11/20/2007	Foreign Priority Date	NONE
Word Mark	ULTRA CHI		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2007/07/06 First Use In Commerce: 2007/07/06 Electric hair curling irons, electric hair flat irons, and electric hair straightening irons

U.S. Registration No.	3107769	Application Date	05/07/2004
Registration Date	06/20/2006	Foreign Priority Date	NONE
Word Mark	CHI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 2005/12/01 First Use In Commerce: 2005/12/01 electric hand-held hair dryers		

U.S. Registration No.	3331008	Application Date	05/04/2005
Registration Date	11/06/2007	Foreign Priority Date	NONE
Word Mark	ULTRA CHI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 2007/08/24 First Use In Commerce: 2007/08/24 Electric hand-held hair dryers and hair dryers for household and professional salon purposes		

U.S. Registration No.	3054490	Application Date	01/27/2005
Registration Date	01/31/2006	Foreign Priority Date	NONE
Word Mark	CHI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2004/12/31 First Use In Commerce: 2004/12/31 Magazines in the field of haircare, beauty, and fashion		

U.S. Application No.	76512597	Application Date	05/08/2003
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CHI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2002/11/23 First Use In Commerce: 2002/12/11		

	Hair care products, namely, shampoo, thermal hair protective treatment, hair strengthening treatment, hair conditioner; hair care preparations, namely, solutions which bond to the hair to strengthen the hair, and solutions to transform frizzy, curly, or damaged hair
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U.S. Application No.	78782679	Application Date	12/29/2005
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CHI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: Air purifiers and ionizers		

U.S. Application No.	78795135	Application Date	01/19/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CHI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: Fragrances, namely, women's perfume and cologne, and men's cologne		

U.S. Application No.	77457984	Application Date	04/25/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CHI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 008. First use: First Use: 2006/12/31 First Use In Commerce: 2006/12/31 Hair clippers, hair shears and scissors, hair trimmers, razors, and blades for hair clippers, hair trimmers, and razors		

Related Proceedings	Civil Action No. H-07-2333, US District Court for the Southern District of Texas, Farouk Systems, Inc. v. FHI Heat, Inc.
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Attachments	78524660#TMSN.jpeg ( 1 page )( bytes ) 77055581#TMSN.jpeg ( 1 page )( bytes ) 78617337#TMSN.jpeg ( 1 page )( bytes ) 78414762#TMSN.jpeg ( 1 page )( bytes ) 78622448#TMSN.jpeg ( 1 page )( bytes ) 78555431#TMSN.jpeg ( 1 page )( bytes ) 76512597#TMSN.gif ( 1 page )( bytes ) 78782679#TMSN.jpeg ( 1 page )( bytes ) 78795135#TMSN.jpeg ( 1 page )( bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/bendtobor/
Name	Ben D. Tobor
Date	07/21/2008



but not limited to the marks CHI NANO and ULTRA CHI (collectively, the CHI Mark and the CHI Formative Marks are sometimes referred to herein as the "Opposer Marks").

4. Opposer is the owner of several federal registrations for the Opposer Marks, including U.S. Registration Nos. 3,426,769, 2,660,257, 3,107,769, and 3,054,490, for the mark CHI®; U.S. Registration No. 3,387,588, for the mark CHI NANO®; and U.S. Registration Nos. 3,341,114, and 3,331,008 for the mark ULTRA CHI®. The CHI registrations cover goods in International Classes 3, 9, 11, and 16.

5. Opposer is also the owner of a number of pending applications to expand its federal protection of the Opposer Marks, including application Serial Nos. 76/512,597; 78/782,679; 78/795,135; and 77/457,984 for the CHI Mark in International Classes 3, 8, and 11.

6. As a result of Opposer's substantially exclusive and continuous use of the CHI Mark in connection with the Opposer Goods, the CHI mark has developed substantial goodwill and a positive reputation among the industry, the trade, and consumers, and has become a very valuable asset of Opposer.

7. As a result of Opposer's substantially exclusive and continuous use of the CHI Formative Marks in connection with the Opposer Goods, the CHI Formative Marks have developed substantial goodwill and a positive reputation among the industry, the trade, and consumers, and have become a very valuable asset of Opposer.

8. On information and belief, Applicant is a corporation organized under the laws of the State of Ohio with a principal place of business at 14,500 Industrial Avenue North, Suite B, Maple Heights, Ohio 44137.

9. On or about January 11, 2008, Applicant filed the Opposed Application, covering hair care preparations, hair conditioners, hair shampoos, hair straightening preparations in International Class 3; electric irons for styling hair in International Class 9; and hand-held electric hair dryers in International Class 11.

10. The Opposed Application was filed without Opposer's authorization or consent.

11. The CHI Mark, including Opposer's common law rights and U.S. Registration Nos. 3,426,769; 2,660,257; 3,107,769; and 3,054,490, substantially predate the Opposed Application. Some of the CHI applications also predate the Opposed Application. Opposer therefore has rights that are senior to any rights that may be claimed by Applicant.

12. The Applicant's Mark is confusingly similar with the Opposer Marks. Opposer has attached a copy of a web page of Applicant's website, wherein the substantial similarity between

the Opposer Marks and the Applicant's Mark is seen, where the Applicant's Mark appears at the top left-hand portion of the webpage, as well as is illustrated appearing on an iron in the photograph appearing on the right side of the web page. In addition to Applicant's Mark including the last two letters of Opposer's Marks, the letter F of Applicant's Mark is visually similar to the letter C in the Opposer Marks, and in particular, is further confusingly similar as used by Applicant as shown in the attached webpage. As seen, the lower portion of the letter F of Applicant's Mark is cut off, or truncated, to deliberately, on information and belief, make the letter F appear more confusingly similar as a letter C.

13. The goods with which Applicant uses its mark are virtually identical to the goods with which Opposer uses its marks.

14. On information and belief, Applicant was clearly exposed to, and aware of, Opposer and the Opposer Marks before filing the Opposed Application. Applicant's selection of a mark that is confusingly similar to CHI®, and in particular as it is used in commerce, was no coincidence, and was intended to trade off the reputation and goodwill of the Opposer Marks.

15. As a result of confusing similarity between Applicant's Mark and the Opposer Marks, the registration of Applicant's Mark is likely to cause confusion, mistake and/or deception of purchasers as to the source of the parties' respective goods.

16. As a result of the confusing similarity between Applicant's Mark and the Opposer Marks, registration of Applicant's Mark is likely to cause confusion, mistake, and/or deception as to (a) the affiliation, connection, or association between Opposer and Applicant, and (b) the origin, sponsorship, or approval of Applicant's Goods by Opposer.

17. Civil Action No. H-07-2333, captioned *Farouk Systems, Inc. v. FHI Heat, Inc.*, is pending in the United States District Court for the Southern District of Texas, Houston Division, and alleges causes of action against Applicant for trademark infringement and unfair competition, among other causes of action.

WHEREFORE, Opposer Farouk Systems, Inc. respectfully requests that the Opposed Application, Serial No. 77/369,976, be rejected, that registration for Applicant's Mark be refused, and that this Opposition be sustained.

Dated this 21<sup>st</sup> Day of July, 2008.

Respectfully submitted,

FAROUK SYSTEMS, INC.

By  \_\_\_\_\_

Ben D. Tobor  
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Attorney for Opposer,  
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# FHI HEAT°

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Platform Dorned Styling Iron

Platform 4/10"

Platform 7/10"

Platform 1"

Platform 1" Special Edition

Platform 1 1/4"

Platform 1 3/4"

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CERTIFICATE OF SERVICE

I, Ben D. Tobor, counsel for Farouk Systems, Inc., in the above-captioned action, hereby certify that, on the 21<sup>st</sup> day of July, 2008, I served a copy of the foregoing Notice of Opposition, via First Class Mail, postage prepaid, upon the following entity, identified in the Opposed Application as the correspondence address for Applicant's Attorney of Record.

John J. Cunniff  
Hahn Loesner & Parks LLP  
1 GOJO Plaza, Suite 300  
Akron, Ohio 44311-1076

A handwritten signature in black ink, appearing to read "Ben D. Tobor", written over a horizontal line.

Ben D. Tobor