

This Opinion is Not a  
Precedent of the TTAB

Mailed: October 8, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*Emminence, LLC*

*v.*

*Lisa Kelly*

Opposition No. 91205286  
against Serial No. 85457226

Werner H. Stemer and Lillian Taylor Štajnbaher of Lerner Greenberg Stemer LLP,  
for Eminence, LLC.

Brian K. Yost, of Decker Jones McMackin, *et al*,  
for Lisa Kelly.

Before Bucher, Taylor and Lykos,  
Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Lisa Kelly (hereinafter “Applicant”) seeks registration on the Principal Register  
of the mark **Simplicity Hair Oil Blend** (*in standard character format*) for “oils for  
hair conditioning” in International Class 3.<sup>1</sup>

<sup>1</sup> Application Serial No. 85457226 was filed on October 26, 2011, based upon applicant’s  
allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the

Emminence, LLC (hereinafter “Opposer”), alleges that Applicant’s mark so resembles Opposer’s previously used and registered mark **SIMPLICITY** for “add-in and add-on hair accessories, namely, artificial hair constructed primarily of human hair” in International Class 26,<sup>2</sup> that when used in connection with Applicant’s identified goods, it is likely to cause confusion, to cause mistake, or to deceive, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

Applicant, in her answer, denied the salient allegations of likelihood of confusion. Only Opposer has submitted evidence for the record and only Opposer has filed a brief in this matter.

Because Opposer has made Registration No. 4206506 properly of record, it has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc., v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Furthermore, because the registration is properly of record, priority is not in issue as to the goods identified therein. *King Candy Co., Inc. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, Applicant does not contest Opposer’s priority.

Our likelihood of confusion determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the well-established likelihood of confusion factors. *See In re E.I. du Pont de Nemours and*

---

Trademark Act. No claim is made to the exclusive right to use the words “Hair Oil Blend” apart from the mark as shown.

<sup>2</sup> Registration No. 4206506 issued to Aderans Co., Ltd., a Japanese corporation, on September 11, 2012, under Section 44(e) of the Trademark Act, based upon Japanese Registration No. 5376599. On December 31, 2012, this registration was assigned to Eminence, LLC, a Limited Liability Company of Florida. Reel 5067/Frames 423-29.

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, 1205 (Fed. Cir. 2003) (“... mistaken belief that [a good or service] is manufactured or sponsored by the same entity ... is precisely the mistake that Section 2(d) of the Lanham Act seeks to prevent”).

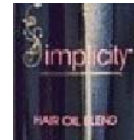
*A. Similarities of the marks*

We turn first to a comparison of Opposer’s and Applicant’s respective marks, keeping in mind that in determining the similarity or dissimilarity thereof, we must consider the marks in their entirety in terms of sound, appearance, meaning and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014).

The marks in this case are Applicant’s **Simplicity Hair Oil Blend** compared with Registrant’s claimed mark, **SIMPLICITY**. While we compare the marks in their entirety, the leading word in Applicant’s mark, “Simplicity,” is identical to the entirety of Opposer’s **SIMPLICITY** mark. That is, Applicant has simply adopted the entirety of Opposer’s mark and added generic and disclaimed wording to it. *See Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660-61 (TTAB 2014)

(“Likelihood of confusion often has been found where the entirety of one mark is incorporated within another.”). *See also The Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (**CALIFORNIA CONCEPT** and surfer design for men’s cologne, hair spray, conditioner and shampoo is likely to cause confusion with the mark **CONCEPT** for cold permanent wave lotion and neutralizer); *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (Applicant’s mark **EBONY DRUM** for hairdressing and conditioner is likely to cause confusion with the mark **EBONY** for cosmetics).

Opposer has also demonstrated with several webpages how Applicant actually uses



this composite mark. As used by Applicant, the term “Simplicity” is clearly highlighted in a prominent manner that overshadows the much smaller lettering of “Hair Oil Blend.” Similarly, Opposer points out that on viewing the trade dress on Applicant’s boxes and labels, one will notice that the placement and size of the term “Hair Oil Blend” creates a *de minimis* impact for these words.

As to Applicant’s repeated allegations in her answer that the designation “Simplicity” is diluted, we note that Applicant then made no evidence of record. Furthermore, Opposer notes in its brief that as used in connection with artificial hair, hair extensions and hair care products generally, Opposer’s search of trademark records at the United States Patent and Trademark Office found only two live registrations fitting this category, and both belong to Opposer. In any case,

given the presumptions under Section 7 of the Act, we must presume that Opposer's mark is a distinctive source indicator.

Based on the above discussion, we find that these marks create similar connotations and commercial impressions, and this critical *du Pont* factor favors a finding of likelihood of confusion.

*B. The Parties' Goods*

Applicant's identification of goods is simply "oils for hair conditioning." The identification of goods in Opposer's Registration No. 4206506 is "add-in and add-on hair accessories, namely, artificial hair constructed primarily of human hair."

Yet in its brief, Opposer claims that it "is the registered owner of rights for use of the **SIMPLICITY** mark in connection with" the following goods:

①hair extension removers;<sup>3</sup> ②Add-in and add-on hair accessories, namely, artificial hair constructed primarily of human hair;<sup>4</sup> ③False hair; wigs; hairpieces; toupees; add-in and add-on hair accessories, namely, artificial hair constructed primarily of synthetic and/or human hair; add-in and add-on hair accessories, namely, plaited hair constructed primarily of synthetic and/or human hair; add-in and add-on hair accessories, namely, tresses of hair constructed primarily of synthetic and/or human hair; false beards; false moustaches; hair accessories, namely, top-knots; hair coloring caps; hair curling pins.<sup>5</sup>

---

<sup>3</sup> Application Serial No. 85729785 for the mark **SIMPLICITY** for "hair extension adhesive removers" in International Class 3. This pending application is suspended awaiting a determination on the application at bar.

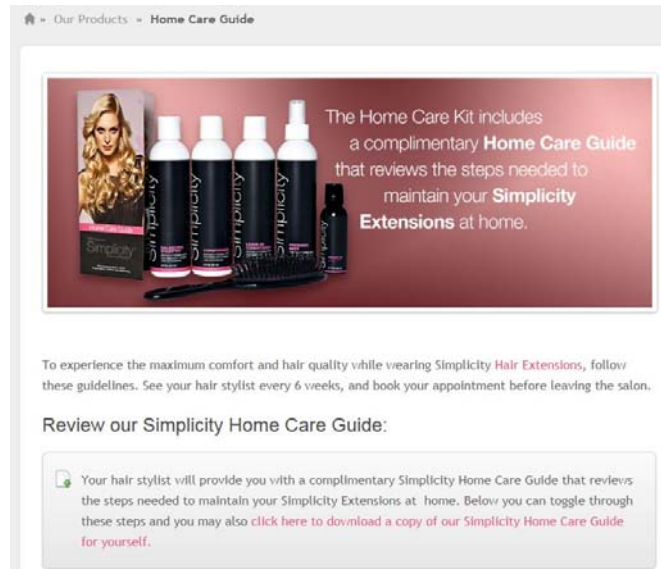
<sup>4</sup> This is the identification of goods as limited with the Statement of Use in Registration No. 4206506 – Opposer's cited registration herein.

<sup>5</sup> This is the identification of goods for Opposer's Registration No. 4129286 for the mark **SIMPLICITY GRAFTS**. The original identification of goods in the ITU Application Serial No. 85078130 (that matured into Opposer's cited '506 registration) contained all the '286 goods plus hair accessories such as "hair ribbons, hair pins, hair bows, hair curlers, hair grips and elastic ribbons."

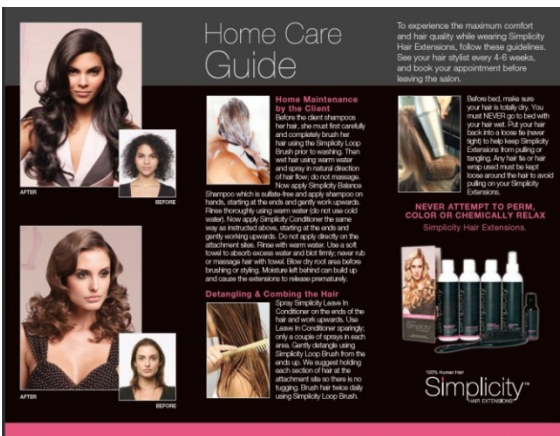
As noted in the respective footnotes, it appears the basis for this broad claim in Opposer's brief is an amalgamation of three different properties owned by Opposer: (1) a pending (but currently suspended) application; (2) the current application's goods as narrowed with the involved Statement of Use; and (3) the identification of goods as listed in another of Opposer's registrations for the mark **SIMPLICITY GRAFTS**. Opposer weaves these various strands together using the concept of its natural zone of expansion and unpleaded common law rights. Opposer points to this broad listing of goods in its brief, as well as goods even more closely related to Applicant's goods that are not listed in any of Opposer's applications or registrations, but on which its mark is allegedly currently being used in commerce, such as shampoo, conditioners, finishing mist, and conditioning oils.

Opposer concludes that Applicant's goods are clearly within Opposer's likely scope of expansion or are nearly identical to goods presently sold by Opposer using its **SIMPLICITY** mark. Using primarily Internet screenshots dating from 2011 through 2014, Opposer argues that, consistent with *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031 (TTAB 2010), it has provided examples of third-party videos of trademark use at tradeshow that are posted online, a certification instruction manual home care guide, offers of sales through third-party online vendors, through brick and mortar salons, and directly from Opposer, all of which are available online.

Opposer also argues that its proffered Internet evidence shows that the parties both market their respective goods and services in a manner that makes it virtually certain that the same persons would encounter such promotions under circumstances that could give rise to consumer confusion. Opposer points to the similarity of the goods, the marks, and trade dress on websites directed to the same end users. Specifically, Applicant markets its Home Care Kits containing shampoo, conditioners, finishing mist, oils and brushes.<sup>6</sup>



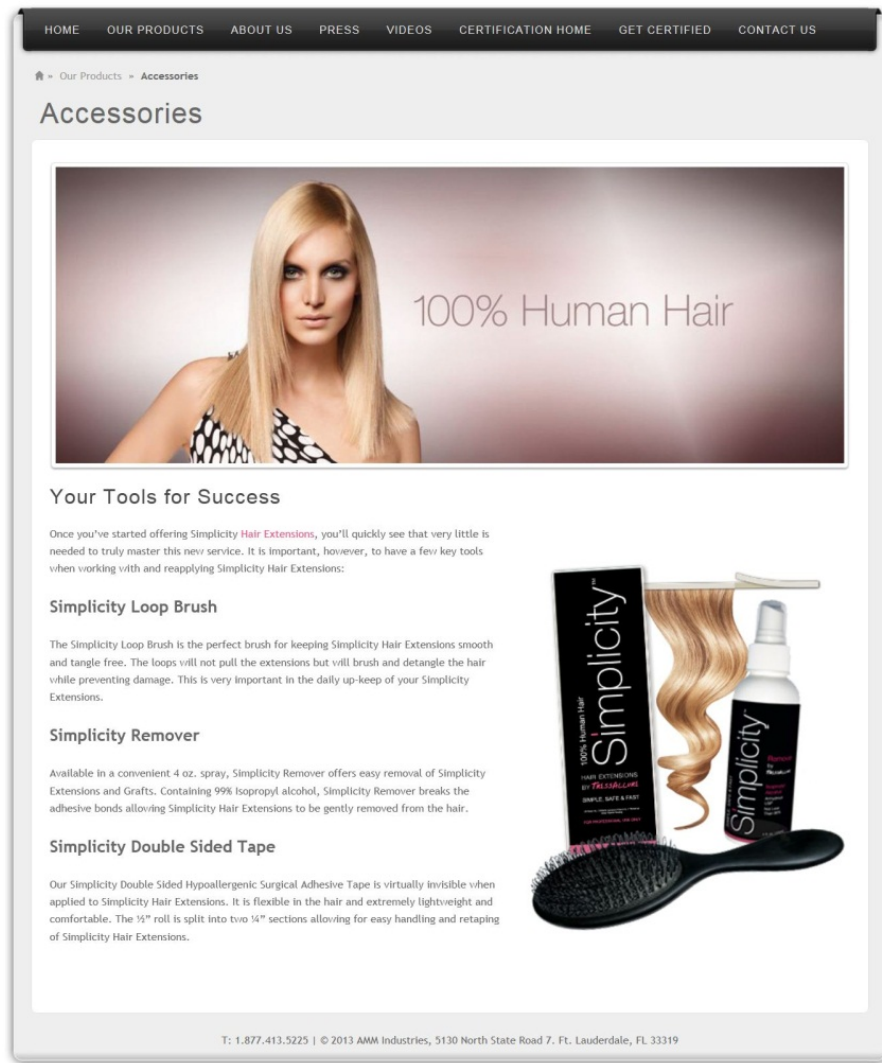
Opposer has also included a copy of its Simplicity Home Care Guide:



<sup>6</sup> Opposer also submitted an excerpt from page 8 of an “Instruction Manual” listing the components of its Home Care Kits. Opposer’s Exhibit #43, 16 TTABVue at 16 of 83. Inasmuch as this is not an Internet document and does not have any testimony or other information about its circulation, etc., it is not admissible under *Safer* and we have given it no consideration. Opposer’s Exhibits ## 34-53, 16 TTABVue at 7-26 of 83.

<sup>7</sup> <http://www.simplicityhair.com/our-products/home-care-guide/>, also Exhibit ## 103, 107, 16 TTABVue at 76, 80-81 of 83.

Among Opposer's screen-prints taken from its own website, we see a variety of goods (e.g., brushes, adhesive removers, and additional double-sided tape) that would be complementary goods to its **SIMPLICITY** hair extensions.



9

Opposer also argues that it would incur special damages to its reputation and business in the event its customers are confused by Applicant's product. Opposer

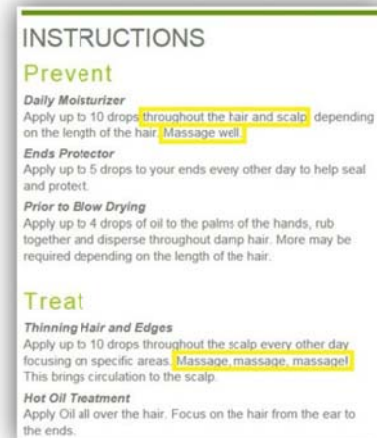
---

<sup>8</sup> <http://www.simplicityhair.com/wp-content/uploads/Simplicity-Home-Care-Guide-v6hi-final.pdf>

<sup>9</sup> <http://www.simplicityhair.com/our-products/accessories/>, also Exhibits ## 100-101, 16 TTABVue at 73-74 of 83.



notes that Applicant's instructions are for the user to apply the oil "... throughout the hair and scalp" and "Massage, massage, massage!" so that the oil may be applied all over the hair for hot oil treatments, and further used as an aid to address dry itchy scalp. By contrast, Opposer's training materials instruct its hair dressers and end users



10

to avoid the application of its conditioners and oil to the scalp area.<sup>11</sup> Opposer notes that applying oil to the adhesive tape critical to keeping Opposer's hair extensions in place would have "a destructive influence."

As support for its allegations of Applicant's bad faith dealings, Opposer also alleges that after it filed the current opposition proceeding on May 23, 2012, Applicant actually altered her packaging in order to have her mark and trade dress more closely resemble Opposer's packaging. Specifically, Opposer points out that Applicant (who had used upper-case letters, "SIMPLICITY," in a horizontal plane on largely white backgrounds) now applies the word "Simplicity" on an ascending vertical plane using lower-case letters against a black background. Moreover, as to the words "Hair Oil Blend," if present at all, they are now *de minimis* by

<sup>10</sup> <http://www.simplicity-oil.com/instructions/>, Opposer's Exhibit #82, 16 TTABVue at 55 of 83.

<sup>11</sup> <http://salonmagazine.ca/whats-new/features/1390-how-to-apply-simplicity-hair-extensions>, Opposer's Exhibits ##84-92, 16 TTABVue at 58-63 of 83. See also "Beauty Launchpad Magazine on the Go." <http://www.prettyladyproducts.com/2011/12/27/all-new-simplicity-hair-extensions-reinvent-the-way-you-practice-your-art/> and <http://www.tressallure.com> <http://www.beautylaunchpad.com>

comparison. Opposer argues that these modifications to Applicant's trade dress simply make confusion unavoidable when consumers acquainted with Opposer's products later encounter such website images.



When focused on this particular *du Pont* factor, it is well-settled that we are charged with determining the relationship between oil for hair conditioning, on the one hand, and hair extensions on the other. One might well speculate about circumstances under which these respective goods may be complementary. Furthermore, it even appears as if Opposer distributes shampoo, conditioners and conditioning oils within its Home Care Kit under its **SIMPLICITY** mark. Finally, as argued by Opposer, it appears as if Applicant's trade dress was changed during the course of this proceeding to reflect more closely the look and feel of Opposer's

<sup>12</sup> "Simplicity Launches New Packaging," <http://www.modernsalon.com/news/Simplicity-Launches-New-Packaging-136334288.html>, as downloaded by Opposer on June 11, 2014, also Exhibit # 107, 16 TTABVue at 82-83 of 83.

<sup>13</sup> SimplicityHairOil on [www.instagram.com](http://www.instagram.com), downloaded by Opposer on June 11, 2014, also Exhibit # 93, 16 TTABVue at 67 of 83.

<sup>14</sup> SimplicityHairOil on [www.instagram.com](http://www.instagram.com), as downloaded by Opposer on June 11, 2014, also Exhibit ## 105, 16 TTABVue at 78 of 83.

trade dress. Hence, we are certainly sympathetic to the position Opposer has taken during the course of this litigation.

However, a review of the Notice of Opposition shows that Opposer is relying solely upon Registration No. 4206506 to establish the priority claim essential to its likelihood of confusion allegations. This narrow pleading, constrained by the scope of this registration's identification of goods as it eventually issued, cannot be construed as including allegations of prior common law usage on a wide range of hair care products (e.g., all kinds of wigs and hair pieces, hair accessories, hair extensions and hair extension removers, shampoos, conditioners and oils, etc.). Hence, Applicant had no notice of such a broad allegation, and despite Applicant's non-participation during the trial of this case, we cannot treat the silence of Applicant *qua* defendant herein the same as finding that the issue was tried by the consent of the parties.

Opposer's position relies heavily upon the doctrine of a zone of natural expansion of trade.<sup>15</sup> Under this doctrine, the first user of a mark in connection with particular goods possesses superior rights in the mark as against subsequent users of the

---

<sup>15</sup> The factors to be considered are 1) whether the second area of business (that is, the subsequent user's area of business, into which the first user has or potentially may expand) is a distinct departure from the first area of business (of the prior user), thereby requiring a new technology or know-how, or whether it is merely an extension of the technology involved in the first area of business, 2) the nature and purpose of the goods or services in each area, 3) whether the channels of trade and classes of customers for the two areas of business are the same, so that the goodwill established by the prior user in its first area of business would carry over into the second area, 4) whether other companies have expanded from one area to the other, and 5) the determination must be made on the basis of the circumstances prevailing at the time when the subsequent user first began to do business under its mark, i.e., what was "natural" in the relevant trade at that time. *See Mason Engineering & Designing Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 962 (TTAB 1985).

same or similar mark for any goods which purchasers might reasonably expect to emanate from it in the normal expansion of its business under the mark.

As noted by Professor McCarthy in his treatise,<sup>16</sup> the doctrine of a zone of natural expansion of trade “appears to be no more than a specific application of the familiar ‘related goods’ test. The ‘natural expansion’ thesis seems to be nothing more than an unnecessarily complicated application of the likelihood of confusion of source or sponsorship test to a particular factual situation. If the ‘intervening’ use was likely to cause confusion, it was an infringement, and the senior user has the right to enjoin such use, whether it had in fact already expanded itself or not.”<sup>17</sup> Conversely, if Opposer has failed to demonstrate a relationship of hair conditioning oils to hair extensions, we should not apply the complexities of the “natural expansion” doctrine as an end-around this critical *du Pont* factor.

The record suggests that there are marketplace realities that might well have supported a broader scope of protection for Opposer’s mark. However, absent an amendment to the Notice of Opposition or clear evidence that this issue was tried by the consent of the parties, the Internet webpages reflecting Opposer’s own use of its mark in connection with a variety of goods are not sufficient to make out a *prima facie* case in favor of Opposer as to this *du Pont* factor. Under the facts of this case as they were litigated during this proceeding, the sum of these observations is not enough to show a relationship between the goods involved herein. In short, we find

---

<sup>16</sup> 3 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:20 (4<sup>th</sup> ed. 2014).

<sup>17</sup> *Id.*

that in addition to an absence of any notice to Applicant that Opposer would be relying upon possible common law usage of the cited mark on disparate goods, there is no factual basis in this record on which to conclude that oils for hair conditioning would be perceived by consumers of hair extensions as falling within the natural zone of expansion of a manufacturer of wigs and hair pieces.

Accordingly, this critical *du Pont* factor fails to support a finding of likelihood of confusion herein.

*C. Determination*

Despite the fact that these marks create quite similar connotations and commercial impressions, we find that Opposer has failed to show a relationship of sufficient nature between Applicant's "oils for hair conditioning" and Opposer's "add-in and add-on hair accessories, namely, artificial hair constructed primarily of human hair" such that consumers will believe that both types of goods emanate from a common source. Accordingly, Opposer has not shown a likelihood of confusion herein.

*Decision:* The opposition is dismissed and the involved application will be issued a Notice of Allowance in due course.