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Paper No. 29

EWH/AKP

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Nexxus Products Company

v.

Tocco Magico S.P.A.

Opposition No. 86,022
to application Serial No. 74/123,691
filed on December 11, 1990

John R. Rydell II of Griffith & Thornburgh for Nexxus
Products Company

Lawrence E. Abelman for Tocco Magico S.P.A.

Before Seeherman, Hanak and Quinn, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Tocco Magico S.P.A. (applicant) seeks to register
NEXTIME in typed capital letters for: hair shampoos, hair
tonics, hair setting lotions, hair lacquers, hair
conditioners, permanent hair waving preparations. The
intent-to-use application was filed on December 11, 1990.

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Nexxus Products Company (opposer) filed a notice of opposition alleging that long prior to December 1990, opposer both used and registered the trademark NEXXUS for various hair care products, and further alleging that the contemporaneous use of NEXTIME by applicant and NEXXUS by opposer is likely to cause confusion. Opposer attached to its notice of opposition a copy of its Registration No. 1,376,635 for the mark NEXXUS in the form shown below. This registration issued on December 31, 1985 with a claimed first use date of December 1979. The goods of this registration are as follows: "hair shampoo, hair conditioners, hair sprays, hair dye solutions and neutralizing preparations for use in permanent hair waving, skin cleaning preparations, and skin conditioners." In its notice of opposition, opposer did not claim ownership of any other marks, nor did opposer claim that it used or registered its NEXXUS mark on any other products.

The image shows the word "NEXXUS" in a bold, black, sans-serif font. The letters are thick and blocky. The 'X' is particularly prominent, with a large, white, stylized 'X' shape overlaid on it, creating a double-X effect. The overall appearance is that of a registered trademark logo.

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Applicant filed an answer which denied the key allegations of the notice of opposition. Both parties filed briefs. Neither party requested a hearing.

The record in this case consists of the depositions (with exhibits) of Stephen J. Redding (opposer's president) and Stefano Sarra (applicant's managing director).

Before discussing the merits of this case, one preliminary matter must be dealt with. During the deposition of opposer's president, opposer's counsel attempted to introduce into evidence not only the aforementioned Registration No. 1,376,635, but also two additional federal registrations for NEXXUS, as well as one California state registration for the mark ACCU-TIME. (Registration Nos. 1,558,098 and 1,551,053; California trademark Registration No. 77,628). The goods of opposer's two other federal registrations are various clothing items. The goods of opposer's California trademark registration are described as a "permanent wave product." During the deposition of opposer's president, applicant's counsel stated that he had "a continuing objection to the introduction of any other registrations or trademark applications other than with respect to Registration No. 1,376,635." (Redding deposition page 12). In addition, applicant's counsel objected to opposer's reliance on any trademarks which opposer did not plead in its notice of opposition. (Redding deposition pages 7 and 8). Moreover, in footnote 1 of its brief, applicant requested that all

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references to Registration Nos. 1,558,098 and 1,551,053 for NEXXUS for clothing as well as California state Registration No. 77,628 for ACCU-TIME for a permanent wave "product should be stricken from the record."

We find applicant's request to be well taken. At no time did opposer move to amend its notice of opposition to claim ownership of additional marks or to claim that it used or registered NEXXUS for products other than those set forth in opposer's pleaded Registration No. 1,376,635. As a practical matter, our ruling is of little consequence because in its brief, opposer has never discussed its other marks, nor has opposer discussed its use or registration of NEXXUS on clothing products or on any other products besides those set forth in Registration No. 1,376,635.

As the parties agree, there is only one issue in this case, namely, whether the use of NEXTIME by applicant for hair care products and of NEXXUS by opposer for hair care products is likely to result in confusion. (Opposer's brief page 4; applicant's brief page 3). By making of record its Registration No. 1,376,635, opposer has established its priority.

In any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by section 2(d) goes to

the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.")

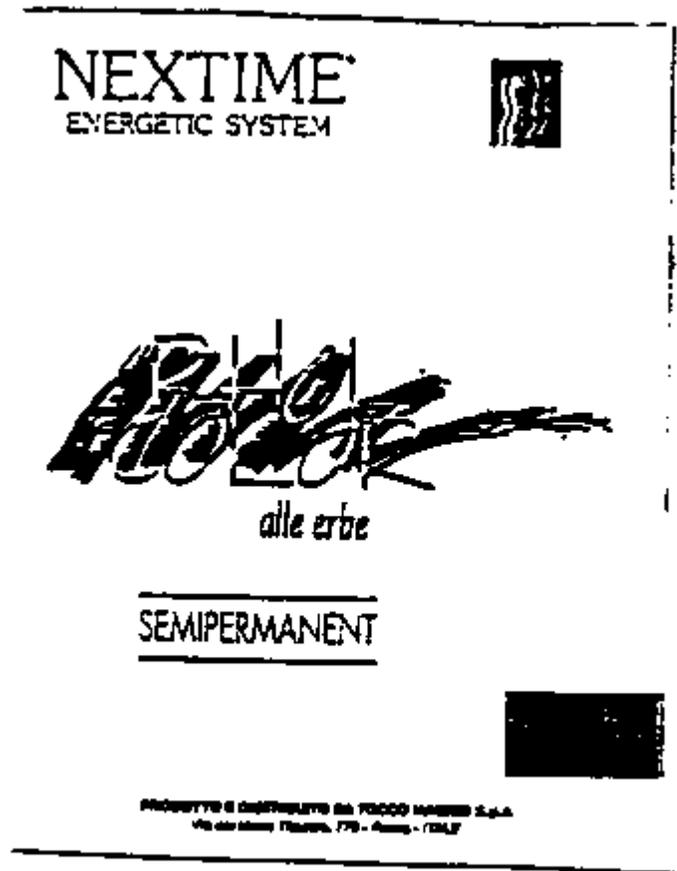
In this case, the goods of the application and opposer's Registration No. 1,376,635 are, in part, either identical (hair shampoos and hair conditioners) or very closely related.

Turning to a consideration of the marks, we note at the outset that "when marks would appear on virtually identical goods or services [as is the case here], the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). However, having said the foregoing, we find that the marks are dissimilar enough such that their use on identical, relatively inexpensive consumer products is not likely to result in confusion.

Marks are usually compared in terms of three factors: (1) visual appearance/sight; (2) pronunciation/sound; (3) meaning/connotation. See 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 23:21 at page 23-47 (4th ed. 1996).

In terms of visual appearance, while both marks begin with the letters NEX, they are otherwise quite dissimilar. This is particularly true when one compares applicant's mark NEXTIME with the manner in which the opposer has registered and almost always uses NEXXUS for hair care products, namely, with one X stacked on top of another X. As

opposer's president testified, he prefers that opposer's NEXXUS mark be depicted with "stacked" double Xs. (Redding deposition page 21). In addition, while applicant filed in 1990 an intent-to-use application, applicant in actuality has made continuous use of its mark NEXTIME in the United States since 1991. Reproduced below is the packaging for applicant's product as it is sold in the United States. (Of course, applicant should not have utilized the letter "R" within a circle next to its mark NEXTIME.).



As can be seen from above, applicant's mark is visually quite distinct from opposer's mark, especially when one considers opposer's mark as it is registered and as it is typically used (see below).



Comparing the two marks in terms of pronunciation, we believe that applicant's mark, while it is depicted as one word with one T, would nevertheless be pronounced as "next time." In terms of pronunciation, applicant's mark NEXTIME and opposer's mark NEXXUS are once again dissimilar.

Finally, in terms of meaning or connotation, applicant's mark NEXTIME has the meaning of the very common expression "next time." On the other hand, opposer's mark NEXXUS would, according to opposer's president, be perceived either as opposer's trademark (i.e. as an arbitrary term), or as the word "nexus" meaning "coming together or joining together ... a connection ... a link." (Redding deposition page 18). Obviously, the meanings of the words "next time" and "nexus" are distinctly different, and in no way can the

two words be used interchangeably. (Redding deposition page 21).

In summary, given the dissimilarities in applicant's mark and opposer's mark, we find that the contemporaneous of these two marks on identical goods is not likely to result in confusion.

One final comment is in order. While opposer never contended that its NEXXUS mark is famous, opposer did argue that its mark is "well known." (Opposer's brief page 5). However, opposer has provided no evidence as to the extent of sales of its NEXXUS products in terms of either dollar amounts or unit amounts. While opposer has demonstrated that "in 1991-1992, alone, TV advertisement expenditures by [opposer for its NEXXUS hair care products] amounted to approximately \$10 million," we find that the advertising expenditures are simply not great enough to have caused opposer's NEXXUS trademark to achieve the status of a famous mark. (Opposer's brief page 5).

Decision: The opposition is dismissed.

E. J. Seeherman

E. W. Hanak

T. J. Quinn

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Administrative Trademark
Judges, Trademark Trial
and Appeal Board