

Hearing:
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Paper No. 36
JQ

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB NOV. 3, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Alberto-Culver Company
v.
Han Beauty, Inc. and Trevive, Inc.

Opposition No. 99,090
to application Serial No. 74/519,598
filed on May 3, 1994

Raymond I. Geraldson, Jr., Douglas N. Masters and Bradley L. Cohn of Pattishall, McAuliffe, Newbury, Hilliard & Geraldson for Alberto-Culver Company.

Charles T.J. Weigell and Lori N. Boatright of Blakely, Sokoloff, Taylor & Zafman for Han Beauty, Inc. and Trevive, Inc.

Before Cissel, Quinn and Bucher, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Trevive, Inc. to register the mark shown below

for "hair care products, namely, hair shampoo, hair conditioner, hair gel, and hair spray."¹

Registration has been opposed by Alberto-Culver Company under Section 2(d) of the Trademark Act on the basis of likelihood of confusion. As grounds for opposition, opposer asserts that applicant's mark, when used in connection with applicant's goods, so resembles opposer's previously used and registered TRES- prefix marks, including TRESEMME, for a variety of hair care products as to be likely to cause confusion.²

Applicant, in its answer, denied the salient allegations of the notice of opposition.

The record consists of the pleadings; the file of the involved application; status and title copies of opposer's pleaded registrations; and stipulated trial testimony by declarations, with related exhibits, submitted by the parties on May 11, 1998. Opposer and applicant filed briefs on the case, and both were represented by counsel at an oral hearing held before the Board.

¹ Application Serial No. 74/519,598, filed May 3, 1994, alleging dates of first use of February 1, 1994. The words "Nutrients" and "Hair" are disclaimed. The application also includes the following statement: "The French wording 'tres vive' means 'full of life.'" The application originally was filed by Han Beauty, Inc. Pursuant to an assignment of the application, Trevive, Inc. was joined as a party defendant. The joined defendants will be referred to herein as "applicant."

² Opposer added, by way of an amended notice of opposition, a claim of abandonment. In a summary judgment decision dated July 21, 1997, the Board granted summary judgment on this ground in favor of applicant.

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Opposer is engaged in the manufacture and sale of a wide variety of health and beauty aids, including hair care products. Opposer markets a range of hair care products under its mark TRESEMME. Through the years, opposer has expanded its product line and, in connection therewith, has used several other TRES- prefix marks. Opposer's products are sold by distributors to retail outlets for direct sales to consumers and to beauty salons for use in the salons and resale to salon customers. The products have been promoted through advertisements in publications such as *Vogue*, *Elle*, *People* and *Modern Salon*, and through commercials on television and radio. Opposer also promotes its products at trade shows. Since 1977, sales of opposer's products under its TRES- prefix marks have exceeded \$450 million. Advertising expenditures, since 1984, have totaled more than \$20 million.

Applicant's hair care products are sold primarily to hair salons for resale to customers. The products have been promoted through trade shows, and in advertisements in trade publications, including *Modern Salon* and *American Salon*.

With respect to priority of use, there is no issue. Opposer has made of record status and title copies of the following pleaded registrations: TRESEMME for hair spray, permanent wave, hair conditioners, hair thickeners, wig sprays, crème lotion developer, wig cleaners and hair

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shampoos; TRESPAC for protein hair conditioning treatment; TRESSPRAY for hair styling spray and sculpting spritz; TRESGELEE (stylized) for hair styling gel; TRESWAVE for hair permanent wave preparation; TRESSHINE for hair conditioning mist for treating frizzy hair; and TRESHOLD (stylized) for hair spray.³ In view of opposer's ownership of these valid and subsisting registrations for its marks, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In *re E. I du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between

³ Although the record includes a status and title copy of Registration No. 1,684,978 for the mark TRESGLAZE for hair styling and sculpting liquid, the Board's check of Office records shows that this registration has since been canceled. Moreover, we note the statement of Lucia Esposito, opposer's product manager, professional division, that opposer has discontinued sales under the mark. (declaration, no. 12) When a federal registration owned by a party has been properly made of record in an inter partes proceeding, and there are changes in the status of the registration between the time it was made of record and the time the case is decided, the Board, in deciding the case, will take judicial notice of, and rely upon, the current status of the registration, as shown by the Office records. *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144 (TTAB 1979); and *TBMP* §703.02(a). Accordingly,

the goods. We will first focus on these factors, and then will consider the remaining relevant du Pont factors.

Insofar as the goods are concerned, the parties stipulated that "[t]he applied for goods of applicant and opposer's goods are related for purposes of determining whether a likelihood of confusion exists." Indeed, both parties' marks are used in connection with identical hair care products, namely hair shampoo, hair conditioner, hair gel and hair spray. The goods, as identified in opposer's registrations and applicant's application, move through the same channels of trade to the same classes of purchasers. *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). Further, these hair care products appear to be relatively inexpensive and they likely would be purchased on impulse.

We next turn to consider the marks. Given the identity in part between the parties' goods, we note, at the outset, that when marks are applied to identical goods, "the degree of similarity [between 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). We also note that the

Registration No. 1,684,978 has not been considered in reaching our decision.

parties have stipulated to the fact that opposer has created a family of TRES- prefix marks.

In comparing the marks, we recognize that the "Nutrients for the Life of Your Hair" ("Nutrients" and "Hair" disclaimed) portion of applicant's mark cannot be ignored. *Giant Food, Inc. v. National Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Although the marks must be compared in their entireties, which include this phrase in applicant's mark, there is nothing improper in giving more weight, for rational reasons, to a particular portion of a mark. In *re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this case, we have given more weight to the TREVIVE portion of applicant's mark because of the subordinate nature of the phrase cited above. This is so because the phrase is suggestive and appears in much smaller type than does the TREVIVE portion.

The dominant TREVIVE portion of applicant's mark sounds similar to the members of opposer's TRES- prefix family of marks. The record includes the declaration of Peter V. Conroy, Jr., a professor of French at the University of Illinois, Chicago. Professor Conroy states, in relevant part, the following:

Based upon its construction and appearance, I believe the term "Tre Vive" will be perceived as a French word or phrase meaning very lively or very alive, and pronounced TRAY-VIVE. TRE would be understood or heard as

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phonetically equivalent to the French adverb TRES, meaning very; vive is an adjective meaning lively.

TRESemme´ and the other terms beginning with TRES also are French in sound and appearance and would be perceived as French or French-derived terms. As noted above, TRES is an adverb meaning very, and it is usually without an accent when written in capital letters. The use of an accent over the final "e" in Tresemme´ gives the term a French appearance. "Gelee" and "mousse" are French words and would be perceived as such.

Since the "s" in Tres is silent, TRES and TRE are phonetically equivalent. TRES is pronounced as TRAY.

Although prior caselaw instructs that there is no correct pronunciation of a trademark, our own sense is that Professor Conroy's views are correct in that opposer's marks and the TREVIVE portion of applicant's mark sound like and look like French terms or French-derived terms. Opposer has stated that although opposer's first mark TRESEMME was derived from the term "tress" (a tress of hair) and the surname (Emme) of an employee who worked for the prior owner of the mark, opposer's later marks "exploit the popularity of European hair styling products by employing the formative TRES meaning 'very' in French, and using that formative to create French sounding marks." (opposer's response, interrogatory no. 1)⁴ Opposer has used, on at least one

⁴ We also note Ms. Esposito's statement that opposer's second mark is pronounced as "TRESS-PAC."

occasion, various TRES- slogans to promote its products. The record includes an advertisement for opposer's TRESEMME brand product which is promoted as "Tres Professional Tres European Tres Chic." Ms. Esposito also stated that opposer sells its products in black containers with the word "European" on labels so as to enhance the "European" image of opposer's products.

In this connection, we also note the testimony of Sal Romeo, national sales director for the products sold under applicant's mark, regarding the selection of the mark:

I just think [Trevive] had almost a continental French flare to it which I think is nice, plays very nice in the American market right now and I think it is good and then, you know, as we got into it, you know, the word "vive" is life and life is important to hair.

If there is no life to hair, it dies. Full of life. So it was a lot of things but I think that the word "vive," I think everybody would remember the word vive. Whether you speak French or not, people remember that word vive even though it may not mean life but in people's minds that is what it means. So I just liked the way it sounded.

Also of record is evidence of applicant's use of the marks TREVOR SORBIE PROFESSIONAL and design, and TRESSA and design, and copies of printouts from three Internet websites showing different third-party uses of PRO-TRESS, VITATRESS and TRESSA in connection with hair care products. This

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evidence does not compel a different result in this case. We acknowledge the suggestiveness of the term "tress" (meaning a long lock of hair) as applied to hair care products. Nonetheless, there is no evidence regarding the extent of use of these marks by applicant or by any of the three third parties. In sum, the evidence is of limited probative value to support applicant's position. *Roffler Industries, Inc. v. KMS Research Laboratories, Inc.*, 213 USPQ 258, 262 (TTAB 1982).

We find that applicant's mark, when considered in its entirety, is sufficiently similar to opposer's family of TRES- prefix marks in terms of sound and overall commercial impression that, when applied to identical, relatively inexpensive hair care products, confusion is likely to occur in the marketplace. In making our determination, we have kept in mind the normal fallibility of human memory over time and that the average consumer normally retains a general, rather than a specific, impression of trademarks encountered in the marketplace.

One last point merits mention. Opposer asserts in its brief that applicant adopted its mark in bad faith. According to opposer, "[i]t is reasonable to infer that [applicant's] selection of such a similar mark in the face of applicant's own experience as a merchant of opposer's products can only be attributed to a desire to exploit the

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goodwill associated with opposer's TRES- family of marks." Contrary to opposer's contention, we agree with applicant (brief, pp. 17-18) that the record does not support such a finding.

To the extent that any of the points raised by applicant raise a doubt on the issue of likelihood of confusion, such doubt must be resolved in favor of the prior registrant. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 2 (CCPA 1977).

Decision: The opposition is sustained and registration to applicant is refused.

R. F. Cissel

T. J. Quinn

D. E. Bucher
Administrative Trademark
Judges, Trademark Trial
and Appeal Board