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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

EuRex International, Inc.
v.
Pepin Manufacturing, Inc.

Opposition No. 91116333
to Application Serial No. 75691243

William E. Johnson, Jr. of The Matthews Firm for EuRex
International, Inc.

Christopher A. Mitchell of Young & Basile P.C. for Pepin
Manufacturing, Inc.

Before Hairston, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Pepin Manufacturing, Inc. seeks to register the mark
HAIR BUSTER on the Principal Register for "adhesive rollers
for removing lint, hair, and other foreign particles from
clothing, furniture, and upholstery" in International Class
21.¹

¹ Application Serial No. 75691243 was filed on April 26, 1999
by Pepin Manufacturing, Inc., based upon applicant's allegation
of a *bona fide* intention to use the mark in commerce. Applicant
has disclaimed the word "Hair" apart from the mark as shown.

EuRex International, Inc. has opposed the registration of applicant's mark. In its notice of opposition, opposer alleges that it has used the mark HAIRBUSTER in conjunction with a "pet shedding comb and grooming device" since February 1999. It also claims that it will be irreparably damaged if applicant should be issued a registration given the likelihood of confusion between these substantially identical marks when used on these related goods. (Notice of Opposition at pp. 1 - 2) Applicant denied the salient allegations of the notice of opposition.

The record consists of the following items: the file of the involved application; the trial testimony deposition of opposer's president and CEO, Haraldur Karlsson, with accompanying exhibits; and applicant's Notice of Reliance upon opposer's responses to certain of applicant's interrogatories. Both parties have filed briefs, but an oral hearing was not requested.

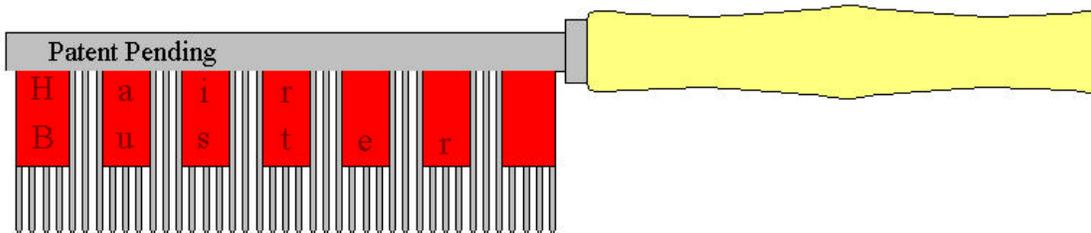
Opposer does not allege ownership of a registration, but relies upon its common law rights in the mark "HairBuster" for a pet shedding comb and grooming device. Hence, "the decision as to priority is made in accordance with the preponderance of the evidence." Hydro-Dynamics Inc. v. George Putnam & Company Inc., 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987).

Based upon Mr. Karlsson's testimony, the record shows that opposer entered into a "Confidentiality Agreement" with a Chinese manufacturer, SinoPro International, on January 17, 1999. (Karlsson dep. at pp. 15 - 16; Karlsson exhibit #6) This executed document refers to HairBuster as opposer's trademark for these goods. While this document makes it clear that opposer had adopted its trademark sometime before January 1999, we agree with applicant that this document does not constitute technical trademark use. Moreover, the use of the term HairBuster in this document with a potential future supplier of the goods certainly does not qualify as use analogous to trademark use. See T.A.B. Systems v. PacTel Teletrac, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996); Dyneer Corporation v. Automotive Products, plc, 37 USPQ2d 1251 (TTAB 1995); and Era Corp. v. Electronic Realty Associates, Inc., 211 USPQ 734, 745 (TTAB 1981).

During February 1999, opposer designed a two-page flyer about its HairBuster product, although the flyer does not identify opposer and contains no information about purchasing the product (Karlsson exhibit #5). In fact, it is clear that the product was not yet available at this juncture. (Karlsson dep. at p. 61) Additionally, Mr. Karlsson was unsure of how many of these flyers were

distributed. (Karlsson dep. at pp. 14, 61) Again, we find that this effort has not been shown to have been of a sufficient nature and extent as to create a public identification of the term with opposer's goods, and hence does not qualify, for priority purposes, as use analogous to technical trademark use. T.A.B. Systems, *supra*.

On February 22, 1999, the Chinese manufacturer issued an invoice for the first fifty of the HairBuster combs and shipped them to opposer in Kingwood, TX soon thereafter.² (Karlsson dep. at pp. 19, 22, 59, 63; Karlsson exhibit #20) This first shipment of products had no packaging, but opposer did have his trademark in slightly-raised letters on the red rubber sleeve intertwined through the tines of the comb (although it is nearly impossible to even find these slightly-raised, red-on-red letters):



While receipt of the manufactured goods is a necessary predicate for later sales, the ordering of these goods by

² The most significant entry on this invoice was the billing for the injection molding tooling needed to manufacture the rubber sleeves.

Mr. Karlsson, the shipment of these combs from SinoPro International and the receipt of the goods by EuRex International clearly does not involve use of the mark with customers.

From opposer's standpoint, the critical period for establishing its first use is March and April of 1999 - a period during which the record shows that the first sales of these combs took place. On March 15, 1999, opposer sold fifteen of these combs to Dieter Schaefer, described by opposer as his "distributor" in Germany. (Karlsson dep. at pp. 16 - 17, 57 - 59; Karlsson exhibit #7) Then on March 29, 1999, opposer sold ten combs to an acquaintance from his hometown of Kingwood, Texas, who Mr. Karlsson had bumped into at a social event. On April 2, 1999, Mr. Karlsson sold three more combs to another acquaintance who dropped by Mr. Karlsson's house - a neighbor from several doors down the street who had maintained Karlsson's home air conditioning system. (Karlsson dep. at pp. 21 - 23, 65 - 70; Karlsson exhibits ## 9 and 10) These three separate sales of unpackaged combs constitute the only documented sales of the product prior to applicant's filing date.³

³ The record demonstrates sufficient public use of the mark from July 1999 to the present. Specifically, according to Mr. Karlsson, opposer's marketing program for the HairBuster product was "kicked off" at the Astro World Series of Dog Shows in July 1999. (Karlsson dep. at pp. 28 - 30; Karlsson Exhibit #15) The

As for the sale to Mr. Schaefer in Bad Munder, Germany, applicant charges that this foreign trademark usage is ineffectual to create trademark rights in the United States, citing to La Societe Anonyme des Parfums Le Galion v. Jean Patou, Inc., 495 F.2d 1265, 181 USPQ 545, 547, n.1 (2nd Cir. 1974); and Fuji Photo Film Company, Inc. v. Shinohara Shoji Kabushiki Kaisha et al., 754 F.2d 591, 225 USPQ 540 (5th Cir. 1985). Moreover, applicant argues that when the serendipitous manner in which opposer made two token sales to opposer's personal acquaintances in Kingwood is combined with a total absence of any verifiable advertising, these sales do not constitute *bona fide* events in the ordinary course of trade, and that they consequently failed to make use of opposer's alleged mark "in a way sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public mind as those of the adopter of the mark." Lucent Information Management, Inc. v. Lucent Technologies, Inc., 986 F.Supp. 253, 45 USPQ2d 1019 (D. Del. 1997), aff'd 186 F.3d 311, 51 USPQ2d 1545 (3rd Cir. 1999); Natural Footwear Limited v. Hart, Schaffner & Marx et al., 760 F.2d 1383, 225 USPQ 1104

first commercial promotion of the HairBuster product (e.g., in newspapers, periodicals and electronic media) was initiated in June and July of 1999 - all subsequent to applicant's filing date. (Opposer's answers to applicant's interrogatories ## 15 & 16)

(3rd Cir. 1985); ZazZu Designs v. L'Oreal, S.A., 979 F.2d 499, 24 USPQ2d 1828 (7th Cir. 1992); and Allard Enterprises Inc. v. Advanced Programming Resources Inc., 146 F.3d 350, 46 USPQ2d 1865 (6th Cir. 1998).

Given how critical these sales are to establishing opposer's priority, we must examine them in greater detail.

We recognize that it would be a stretch to characterize Mr. Karlsson's sales to acquaintances in Kingwood as intentional steps toward marketing a new product under a well-considered business plan. If one measures this use under the four-factor test of Natural Footwear Ltd. v. Hart, Schaffner & Marx, 760 F.2d 1383, 225 USPQ 1104 (3rd Cir. 1985), as urged by applicant, these sales to prior acquaintances do appear to be *de minimis*. While these two sales are indeed minimal, we recognize that opposer is not a large, established, national company. Rather, Mr. Karlsson was operating out of his home a small, start-up business having a pending patent application, a Chinese manufacturer, and a German distributor. Between March 15 and April 2, 1999, Mr. Karlsson sold through arms-length transactions more than half of his first shipment of fifty combs. We find that none of opposer's activities during this period have been shown to be merely for the purpose of reserving rights in a trademark. Having

established these transactions by a preponderance of the evidence, our precedent does not require that opposer meet the test enunciated in Natural Footwear Ltd., *supra*.

In determining the requisite quantum of use opposer must demonstrate, the second part of the test set out by our principal reviewing Court is whether these initial sales were followed by activities proving a continuous effort or intent to use the mark. See Avakoff v. Southern Pacific Co., 765 F.2d 1097, 226 USPQ 435 (Fed. Cir. 1985) (citing to Professor McCarthy's treatise, now at 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §19:114 n3 (4th ed. 2001)). Here again, the record demonstrates that soon thereafter, opposer made continuous commercial utilization that was sufficiently public to identify and distinguish the marked goods in an appropriate segment of the public mind as those of the adopter of the mark. See Blue Bell, Inc. v. Farah Mfg. Co., Inc., 508 F.2d 1260, 185 USPQ 1 (5th Cir. 1975). We find that opposer has established that these shipments constituted *bona fide* commercial transactions when combined with the evidence in the record of subsequent events. See Fort Howard Paper Co. v. Kimberly-Clark Corp., 390 F.2d 1015, 1017, 157 USPQ 55, 56 (CCPA), cert. denied, 393 U.S.

831, 159 USPQ 799 (1968); and Seiberling Rubber Co. v. Dayton Rubber Co., 110 USPQ 556, 559 (Comm'r. Pats. 1956).

Accordingly, we find that opposer has demonstrated by a preponderance of the evidence use of the mark HAIRBUSTER as of March 29, 1999⁴ - a date prior to applicant's filing date of April 26, 1999.

We turn then to the question of likelihood of confusion. Our determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. 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 the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

⁴ It is clear from this record that the March 1999 shipment of the involved goods to opposer's German distributor was not a sham transaction, but rather comprised a *bona fide* shipment in foreign commerce. Moreover, the shipment of these combs directly to a customer in Germany constitutes a type of commerce that Congress has the Constitutional authority to regulate, and hence such a transaction would support a hypothetical application for registration filed by opposer. However, in light of our findings above as to opposer's priority established by the two sales in Kingwood, we need not reach the question of whether this shipment to Germany, by itself, would support opposer's priority under Section 2(d) of the Lanham Act.

Opposer's entire argument as to likelihood of confusion is contained in a single paragraph toward the end of its appeal brief:

The HAIRBUSTER trademark adopted by the plaintiff, and used in commerce before the filing date of the defendant's Intent-To-Use trademark application is spelled the same, is pronounced the same and is the same. The products manufactured and sold by the plaintiff under the HAIRBUSTER trademark, are for essentially the identical market served by the defendant. This is a market created by people having problems with pet hair. The plaintiff's product is used to comb a dog's hair and get rid of excess hair. The defendant's product is in the form of a handheld roll which can be rolled on furniture or clothes to get rid of dog hair. This creates an obvious, tremendous potential for confusion in the minds of the purchasing public.

We agree with opposer that for our purposes, these marks are substantially identical. Even more than would be apparent from comparing the marks shown in all upper case letters (e.g., applicant's HAIR BUSTER versus opposer's HAIRBUSTER), opposer actually uses the mark with upper-case letters "H" and "B" (i.e., HairBuster), creating the feel of two distinct (albeit run together) words. As applied to the respective goods, the connotations are also identical (i.e., items for dealing with unwanted hair).

However, as to the relationship of the goods, we agree with applicant that opposer has failed to place any

evidence into the record as to the relationship of the parties' respective goods. Opposer simply argues in a conclusory manner that the parties' respective goods would be used by someone "having problems with pet hair." Even if true, this fact is insufficient to establish that the goods are related. There is no evidence of record supporting a conclusion that there is a commercial relationship between a dog comb and a lint roller, or that they generally emanate from the same source. Hence, we find that opposer, as plaintiff in this action, has not shown by a preponderance of the evidence that there is a likelihood of confusion herein.

Decision: The opposition is dismissed and the application will be forwarded for the issuance of a notice of allowance.