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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Precision Cuts, Inc.

Serial No. 76342048

Lisa M. Caldwell of Klarquist Sparkman, LLP for Precision Cuts, Inc.

Steven Foster, Trademark Examining Attorney, Law Office 106 (Mary Sparrow, Managing Attorney).

Before Simms, Hanak and Chapman, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Precision Cuts, Inc. (applicant), an Oregon corporation, has appealed from the final requirement of the Trademark Examining Attorney for a disclaimer of the words "PRECISION CUTS" in the mark shown below, for the amended description "barbershop and tanning salon services," in Class 42.¹

¹Application Serial No. 76342048, filed November 27, 2001, asserting use since January 1, 1985, and use in commerce since

PRECISION CUTS

In the original application, applicant asserted that its mark has become distinctive of its services through substantially exclusive and continuous use in commerce for at least five years. In an amendment, applicant claimed that its mark had acquired distinctiveness as the result of substantially exclusive and continuous use for 15 years.

The Examining Attorney contends that the words "PRECISION CUTS" are generic with respect to barbershop services and must be disclaimed pursuant to Section 6 of the Trademark Act, 15 USC §1056.

Applicant and the Examining Attorney have submitted briefs, but no oral hearing was requested.

It is the Examining Attorney's position that dictionary definitions of record² as well as numerous excerpts from stories retrieved from the Nexis database show that these words are generic for a type or style of haircut and are therefore generic with respect to

December 10, 1985. Applicant submitted a disclaimer of the word "CUTS" apart from the mark as shown.

²One definition of record of the word "cut" is "a haircut, often with a styling." *Random House Unabridged Dictionary*, Second Edition (date indecipherable).

haircutting or barbershop services. Because terms are generic for services if they are generic for a key characteristic of those services, the words "precision cuts" should be disclaimed in applicant's mark despite any claim of acquired distinctiveness for the mark as a whole, the Examining Attorney contends. Some of the excerpted stories, all from U.S. publications, are set forth below:

HEADLINE: SNIP, SNIP--CHULUOTA SALON CUTS AWAY AT HAREBRAINED RULES

...a Chuluota Beauty Shop where the air smells like ginger conditioner, and the conventional rules of the modern hair-care establishment aren't just meant to be broken, but tackled, wrassled to the ground, hogtied, and given a precision cut and color rinse.

Orlando Sentinel, February 24, 2003

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She attended cosmetology school at Scottsdale Cole Academy and was previously employed at the Jon English Salon in Minneapolis. She specializes in precision cuts and dimensional block coloring techniques.

Bismarck Tribune, February 9, 2003

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CMB Salon has recently opened in Cape Coral. The staff specializes in precision cuts, color, highlights and perms.

The News-Press, November 25, 2002

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Her approach to dressing the male anchor: The power look. That means dark colors. Blue is business. Her advice to the female anchor: Hair is crucial. Go with a precision cut as opposed to something that's wash-and-wear casual.

The Virginian-Pilot, November 18, 2002

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Offering precision cuts, permanent waves, hair coloring, blow dries and sets, New York Hair has 14 chairs and 12 stylists.

Sarasota Herald-Tribune, November 14, 2002

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Q: What do you specialize in?

A: My most important job is to educate the client on keeping their hair healthy; beyond that, I really like doing precision cuts. I also love doing makeovers and wedding styles.

Hattiesburg American, August 23, 2002

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HEADLINE: Long Island brothers run barbershop for the new generation

The specialty here is precision-cut beards and haircuts using straight-edged razors.

Sometimes 30 or more people wait for marine cuts, flat tops...

Long Island Business News, July 26, 2002

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..."We're a full service hair salon," she said. "We offer precision cuts, weaves, up-dos - anything you can imagine."

The Pantagraph, November 4, 2000

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HEADLINE: Short style -- Summer cuts feature bold, colorful looks

"They want to wear their hair more natural, so they want a precision cut," said Cool C.

The Advocate, June 28, 2000

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HEADLINE: Female barber's business on cutting edge

Stacy's Barbershop is located at 83 Mechanic Street, minutes from Leominster's downtown. It offers what Farrow described as quality, precision cuts at friendly prices.

Telegram & Gazette, September 6, 1998

* * * * *

After working for others, she opened Meenu's Cutting Edge two weeks ago. She offers "barber" and "stylist" precision cuts for men, women and children, as well as threading and henna.

The Tampa Tribune, August 17, 1997

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HEADLINE: MANE POINTS; IN MEN'S HAIR STYLES, VERSATILITY AND CONTROL - NOT LENGTH - ARE WHAT COUNT

"They want something that's easy to maintain, but versatile enough to change to fit whatever they have to do. The key, of course, is a good, precision cut."

The Columbus Dispatch, August 8, 1995

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HEADLINE: Black women find short is simply chic

Sophisticated women who want that nearly down-to-the-scalp precision cut often head for the barber's chair.

The Dallas Morning News, March 15, 1995

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Hold the Shave: Some busy - and adventurous - businesswomen are skipping the salon these days and running off to the barbershop for quickie haircuts. They're trading frills, fuss and gossip for in-and-out precision cuts.

Los Angeles Times, July 28, 1994

* * * * *

Shop owner Bob Williams says he offers "good prices, precision cuts, pretty quick service most days, and a laugh or two."

The Washington Post, July 25, 1987

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She also worked for eight years at a precision cut/Vidal Sassoon style salon and attended advanced training at Arther Academy.

Pensacola News Journal, September 22, 2002

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Instead, what's hip on heads are wash-blow-and-go natural looks, which have their roots in Vidal Sassoon precision cuts of decades past and are today most famously linked with hairstylist-to-the-stars Frederic Fekkai.

Fort Worth Star Telegram, March 29, 2002

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"It is said in the world of beauty that you go to a British cutter for a precision cut, to an Italian cutter for a beautiful cut and to a French cutter for an image cut," said Paddy Calistro, a Santa Monica, Calif.-based beauty expert.

Saint Paul Pioneer Press, January 3, 2000

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HEADLINE: THE TIMES THEY WERE A-CHANGIN'

...Vidal Sassoon introduces precision cut, wash-and-wear hair.

The San Francisco Chronicle, December 30, 1999

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Some stylists in Boston's Newbury Street area, where more than 80 salons have congregated in recent years, are making more than \$100,000 a year thanks to people like Halton, who will pay \$150 or more to get a precision cut.

Boston Business Journal, May 29, 1998

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A full-service salon, Mixed Media offers precision cuts and hair styling, permanents, hair relaxing, coloring and highlights, specialized manicures and pedicures, hair remover, facials and nail wraps.

The San Francisco Examiner, December 5, 1997

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Mr. Mascolo does more than teach his 500 Dallas employees how to precision-cut hair or politely answer phones...

The Dallas Morning News, February 16, 1997

* * * * *

-Carolyn Mosley announces the opening of her new business, N-Trigue, "a salon," at 808 W. Brevard St. Mosley specializes in hair weaving, sculptured designs and precision cuts.

Tallahassee Democrat, July 10, 1996

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Although the new mod bob is different from the stiff, five-point precision cut popularized by Vidal Sassoon back in 1964, "today's style is much shinier and more touchable with lots of movement and ...

The Baltimore Sun, October 12, 1995

It is applicant's position that the Examining Attorney has not submitted a *prima facie* case of genericness by submitting clear or substantial evidence that these words are or will be recognized by at least a majority of the relevant purchasing public, that is, barbershop customers, to primarily signify the name of applicant's services.

First, applicant observes that no dictionary definition of record defines the term "precision cut(s)." According to applicant, the Nexis evidence shows that only a very small portion of the relevant public has used these words to refer to a way of cutting hair. Applicant contends that only a very small number of news articles (about 60) have been made of record which use the term "precision cut" in relation to barbershop services, out of millions of articles covered in the database.³ Therefore, while applicant acknowledges that the stories show use by hair care professionals to describe a way of cutting hair, applicant's attorney argues that the Examining Attorney has offered no evidence that any consumers have actually been exposed to these articles or that most of the relevant public (barbershop customers) in fact use these words generically. Accordingly, applicant maintains that no inferences can be drawn from the evidence that most of the relevant public regards the term PRECISION CUTS as generic. Applicant has also made of record a number of third-party registrations which include the word "CUTS" in combination

³In his appeal brief, p.6, applicant's attorney describes a search which he conducted in the Nexis database. Because the search results were not made of record before the appeal was filed, we can give no consideration to this search. Moreover, the fact that the term "haircut" may appear in many more articles than the expression "precision cut(s)" is not particularly relevant to the issue before us.

with other descriptive or laudatory terms, such as "GREAT" or "SUPER," and argues that its similar mark should also be registered. Finally, applicant asks us to resolve any doubt as to whether the words "PRECISION CUTS" are generic in applicant's favor by finding that they are, at most, descriptive words which have acquired distinctiveness, so that the consuming public has come to view applicant's mark as denoting a particular source.

In response to applicant's arguments about the failure to prove that *most* of the relevant public view the words "precision cuts" as generic, the Examining Attorney argues that the Nexis evidence of record shows that providers of haircutting and barbershop services have referred to their services as including the offering of "precision cuts," and that the purchasing public has been exposed to this generic usage in these stories, appearing not in trade journals, but in general-circulation publications such as newspapers. Further, the Examining Attorney explains:

Given the limited resources of this Office, it would be extremely difficult for the Office to directly prove in any given case what the majority of possibly (in some cases) millions of consumers actually believe when seeing or hearing a term or phrase. The Office does not conduct polls or surveys of ordinary consumers in individual cases, and, as illustrated by the Nexis evidence herein, very few ordinary citizens get quoted in newspapers commenting about the services offered to them by others.

However, this does not mean that these consumers would not recognize terms as being generic when they see or hear them used in relation to the provision of specific goods or services.

See Examining Attorney's appeal brief, unnumbered pages 4-5. The Examining Attorney also notes that applicant offered nothing other than the declaration in support of the claim of acquired distinctiveness.⁴ That is, no evidence such as the amount of sales under the mark, advertising expenditures under the mark, extent of use of the mark, or direct evidence of the public perception of the asserted mark tending to show that the relevant public would attribute trademark significance to the words in the mark as indicating origin in applicant, have been submitted.

With respect to generic terms, Section 14(3) of the Act, 15 USC §1064(3), provides that "The primary

⁴ In a footnote in his brief, the Examining Attorney states that, had applicant sought registration of the words PRECISION CUTS alone, or had applicant claimed acquired distinctiveness of just the phrase PRECISION CUTS (rather than the mark as a whole), he would have argued that, even if the phrase were not generic, applicant's evidence of acquired distinctiveness was insufficient to permit registration of these words. However, he acknowledges that because applicant's claim of acquired distinctiveness was with respect to the mark as a whole, including the design elements, then the claim of acquired distinctiveness appears to preclude this argument. See *In re Creative Goldsmiths of Washington, Inc.*, 229 USPQ 766, 769 n.6 (TTAB 1986), wherein the Board indicated that, where the Section 2(f) claim pertained to more than the subject matter of the disclaimer requirement, any alleged insufficiency of the showing as it pertained to the subject matter of the disclaimer was not well taken.

significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used." This language is equally applicable to the determination of genericness prior to registration. That is to say, the statutory test of the primary significance of the mark to the relevant public is also the test for determining whether an applied-for mark is or is not generic. If the term PRECISION CUTS is generic, and thus constitutes unregistrable matter, then the words must be disclaimed even though applicant is seeking registration of the entire mark under the provisions of Section 2(f). *In re Creative Goldsmiths of Washington, Inc., supra*, at 768, and cases cited therein; and TMEP §1213.03(b) (2nd ed. Rev. 1 March 2004).

In determining whether the primary significance of a term is generic, our primary reviewing court has stated:

...[D]etermining whether a mark is generic ... involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?

H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed.

Cir. 1986). See also *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999). The critical issue in genericness cases is, therefore, whether members of the relevant public primarily use or understand the term sought to be registered to refer to the genus or category of goods or services in question. *In re Montrachet S.A.*, 878 F.2d 375, 11 USPQ2d 1393, 1394 (Fed. Cir. 1989); *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); *Dan Robbins & Assocs., Inc. v. Questor Corp.*, 599 F.2d 1009, 202 USPQ 100, 105 (CCPA 1979); *Zimmerman V. National Assn. of Realtors, Inc.*, 70 USPQ2d 1425 (TTAB 2004); and *In re Recorded Books, Inc.*, 42 USPQ2d 1275 (TTAB 1997). Evidence of the public's understanding of a particular term may be obtained from any competent source, including direct testimony of consumers, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, *supra*; *In re Northland Aluminum Products, Inc.*, 777 F.2d 1566, 227 USPQ 961 (Fed. Cir. 1985); and *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443, 1449 (TTAB 1994). Finally, we note that in the context of this *ex parte* proceeding, it is the burden

of the Examining Attorney to prove the genericness of the words in the mark sought to be registered by clear evidence. *In re Merrill Lynch, Pierce, Fenner & Smith Inc., supra.*

The genus, category or class of services is determined on the basis of the services identified in the application. *See, e.g., Magic Wand, Inc. v. RDB, Inc., supra.* As set forth in this application, the category or class of applicant's services is barbershop services. (The Examining Attorney does not argue that the words PRECISION CUTS are generic with respect to tanning salon services.)

With respect to the issue of whether the term sought to be registered is understood by the relevant public (the general purchasing public in this case) primarily to refer to that class or category of services, we must look to the evidence of record. In this case, there is clear evidence that the term "precision cut(s)" has been used to identify a type or style of haircut. For example, "Offering precision cuts, permanent waves, hair coloring, blow dries and sets, New York Hair has 14 chairs and 12 stylists." Thus, the public would primarily understand the term "precision cut(s)" to have this significance as a result of exposure to the uses of this term in the excerpts from newspapers and magazines distributed to the general public.

Inasmuch as the term "precision cuts" is generic for a type or style of haircut, which is a key characteristic of applicant's barbershop services, these words are generic for those services. See *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987) ("La Lingerie" held generic for services that involve the selling of lingerie); and *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985) ("Wickerware" held generic for mail order and distributorship services in the field of wicker furniture).

The Examining Attorney having presented a *prima facie* case of genericness of these words, it was incumbent on applicant to attempt to rebut this showing by, for example, demonstrating that these words have also been used in a significant manner as a service mark to indicate source or origin in applicant for its barbershop services. This applicant has not done. Rather, applicant has merely relied upon its earlier-filed declaration that its mark has been used substantially exclusively and continuously for over 15 years. As the Examining Attorney has stated, applicant did not otherwise attempt to show that its mark was the subject of substantial sales or advertising, or otherwise used in such a significant manner that it was exposed to the relevant purchasing public. Such evidence may tend to show that the primary significance of the mark

Ser. No. 76342048

is not to indicate a type or style of haircut. In conclusion, we believe that the Examining Attorney has shown by clear evidence that these words are generic for applicant's services, and should therefore be disclaimed.

Decision: The requirement under Section 6 of the Act for a disclaimer of the words "PRECISION CUTS" apart from the mark as a whole and the refusal to register the mark in the absence of this disclaimer is affirmed. However, the refusal of registration will be set aside and the mark published for opposition if applicant, no later than 30 days from the mailing hereof, submits an appropriate disclaimer. See Trademark Rule 2.142(g).