

Mailed 1/14/2005

THIS OPINION IS NOT CITABLE
AS PRECEDENT OF
THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Co-Star Beauty Supply, Inc.

Serial No. 76453448

Jason D. Firth of Quirk & Tratos for Co-Star Beauty Supply, Inc.

Karen K. Bush, Trademark Examining Attorney, Law Office 105
(Chris Doninger, Managing Attorney).

Before Hanak, Chapman and Bottorff, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Co-Star Beauty Supply, Inc. (applicant) seeks to register STARDUST SALON SYSTEMS and design in the form shown below for "wholesale distributorship of beauty salon equipment, product displays, fixtures, cosmetics, hair accessories and hair care products, hair appliances, salon garments, cotton, towels, and skin care products." The application was filed on September 25, 2002 with a claimed first use date of July 15, 2001. As a point of

clarification, as shown in applicant's drawing (below) there are two "plus signs" separating the three words in applicant's mark. However, in the cover letter attaching its application as well as in all of its subsequent papers applicant never referred to the word portion of its mark as STARDUST+SALON+SYSTEMS. Moreover, the Examining Attorney never in any of her papers depicted applicant's mark with "plus signs." Because both the applicant and the Examining Attorney have consistently depicted the word portion of applicant's mark as STARDUST SALON SYSTEMS, we will do likewise.



The Examining Attorney has refused registration on two grounds. First, citing Section 2(d) of the Trademark Act, the Examining Attorney refused registration on the basis that applicant's mark, as applied to applicant's services, is likely to cause confusion with the mark STARDUST, previously registered in typed drawing form for

"fragrances; namely, perfumes, colognes and eau de toilettes; body powders, body creams, skin and hair lotions, personal deodorants and antiperspirants, bath gels and bath soaps, lipsticks, powder blushes, facial powders, lip glosses, lip balms, after shave balms, after shave lotions, body mousses, skin cleansers, skin toners and moisturizers, and gift kits of the aforesaid goods for the promotion of products." Registration No. 1,998,503.

Second, while acknowledging that applicant has disclaimed the exclusive right to use SALON, the Examining Attorney has refused registration because applicant did not disclaim what she contends is the "descriptive wording" SALON SYSTEMS in its entirety. (Examining Attorney's brief page 6).

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

We will consider first the refusal based upon the fact that applicant has refused to disclaim the word SYSTEMS in its mark. As just noted, the Examining Attorney contends that the term SALON SYSTEMS in applicant's mark is merely descriptive of applicant's services, and that therefore a disclaimer of simply the word SALON (which applicant has

submitted) is insufficient. In order to be held merely descriptive, a word or term must forthwith convey information regarding at least one significant quality or characteristic of the relevant goods or services with a "degree of particularity." In re TMS Corporation of the Americas, 200 USPQ 57, 58 (TTAB 1978); In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990) aff'd unpublished Fed. Cir. February 13, 1991.

In support of her contention that the word SYSTEMS is merely descriptive of applicant's services, the Examining Attorney merely relies upon a dictionary definition of the word "system" first brought to the Examining Attorney's attention by the applicant. That definition is as follows: "An assemblage or combination of things or parts forming a complex or unitary whole." Random House Webster's Unabridged Dictionary (2001). The Examining Attorney has offered no other evidence showing how the word SYSTEMS is merely descriptive of applicant's services.

It need hardly be said that the burden of showing that a word or term is merely descriptive, and thus must be disclaimed, rests with the Examining Attorney. Based upon this record, we find that the Examining Attorney has simply not met this burden. The Examining Attorney has failed to show how the word SYSTEMS identifies any significant

quality or characteristic of applicant's services with the required "degree of particularity." Accordingly, the refusal to register based upon applicant's refusal to disclaim the word SYSTEMS is hereby reversed. Obviously, our reversal does not affect applicant's disclaimer of the descriptive word SALON. This disclaimer remains in effect.

Turning to the refusal pursuant to Section 2(d) of the Trademark Act, we note that in any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods or services. 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 [or services] and differences in the marks.").

Considering first the marks, we note that there is no dispute that the word STARDUST is entirely arbitrary as applied to either applicant's services or the goods of the cited registration. Applicant has never contended that the word STARDUST has any meaning or even any connotative properties as applied to its services or the goods of the cited registration. In addition, applicant has not offered any proof showing that third parties have used the word

STARDUST as a mark or part of a mark for any types of goods or services, much less goods or services that are related to registrant's goods or applicant's services. Under such circumstances the arbitrary mark STARDUST which, based on this record has been shown to be used only by applicant and registrant, is considered a strong mark entitled to "a wide scope of protection." 1 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 11:14 at page 11-18 (4th ed. 2003).

In essence, applicant has taken the strong, arbitrary mark STARDUST and merely added to it the words SALON SYSTEMS and a design. Obviously, in comparing applicant's mark and registrant's mark we are obligated to compare the marks "in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985). However, in comparing the marks in their entireties, it is completely appropriate to give less weight to a portion of a mark that is merely descriptive of the relevant goods or services. National Data, 224 USPQ at 751 ("That a particular feature is descriptive ... with respect to the relevant goods or services is one commonly accepted rationale for giving less weight to a portion of the mark."). Thus, in comparing registrant's mark STARDUST with applicant's mark STARDUST SALON SYSTEMS and design, we

have accorded very little weight to the descriptive word SALON. Moreover, while we have found that the word SYSTEMS is not descriptive of applicant's services, by the same token, it is a weak source identifier and accordingly, we have given less weight to the word SYSTEMS in our likelihood of confusion analysis. Finally, with regard to the design component of applicant's mark, we note that said design component is not spoken.

In sum, in terms of pronunciation, we find that the two marks are quite similar. Obviously, applicant's mark would not be pronounced as "STARDUST SALON SYSTEMS and design." Rather, applicant's mark would be pronounced simply as STARDUST SALON SYSTEMS. When so pronounced, applicant's mark and registrant's marks are very similar. They both begin with the same strong, arbitrary word STARDUST. Applicant's mark then concludes with the weak source identifying term SALON SYSTEMS.

Moreover, in terms of connotation or meaning, the marks are quite similar. They both bring to mind "stardust."

Finally, in terms of visual appearance, we recognize that the design in applicant's mark causes it to be dissimilar from the registered mark. Nevertheless, this dissimilarity in visual appearance is outweighed by the

fact that the marks are quite similar in terms of pronunciation and connotation.

Turning to a consideration of applicant's services and registrant's goods, we note that applicant's wholesale distribution services feature, among other products, cosmetics, hair accessories and hair care products. Likewise, registrant's goods feature, among other goods, various cosmetics as well as specifically "hair lotions." In other words, certain of the goods which applicant distributes are legally identical to certain of registrant's goods. For example, there can be no dispute that hair lotions (one of registrant's goods) is encompassed by the broader term "hair care products" found in applicant's description of the products which it distributes.

Given the fact that applicant's mark is quite similar to registrant's mark in terms of pronunciation and connotation, and given the additional fact that certain of the products which applicant distributes are legally identical to certain of registrant's products, we find that there exists a likelihood of confusion resulting from the contemporaneous use of both marks for their respective goods and services. Moreover, it must be remembered that to the extent that there are doubts on the issue of

Ser. No. 76453448

likelihood of confusion, we are obligated to resolve such doubts in favor of the registrant. In re Hyper Shoppes Inc., 837 F.2d 463, 6 USPQ2d 1025, 1027 (Fed. Cir. 1988).

Decision: The refusal to register based on the requirement for a further disclaimer of the word "systems" is reversed. The refusal to register based on Section 2(d) of the Trademark Act is affirmed.