

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB      SEPT. 30,99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Nu Skin International, Inc.

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Serial No. 75/293,155

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W. Norman Roth of Roth & Goldman for Nu Skin International,  
Inc.

Jeffrey Dalton Martin, Trademark Examining Attorney, Law  
Office 112 (Janice O'Lear, Managing Attorney)

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Before Sams, Wendel and Bottorff, Administrative Trademark  
Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant has filed a use-based application<sup>1</sup> to  
register on the Principal Register the mark HAIRFITNESS for  
goods identified, as amended, as "hair care and styling  
preparations, namely hair shampoos, hair and scalp

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<sup>1</sup> Serial No. 75/293,155, filed May 16, 1997. April 1995 is  
alleged as the date of first use of the mark anywhere and first  
use of the mark in commerce. In the application, applicant  
claims ownership, by assignment, of Registration No. 1,944,458,  
which is of the mark HAIR FITNESS (HAIR disclaimed) for goods

conditioners, hair detangling preparations, styling gels, holding sprays, and 3 in 1 shampoo, conditioner and protectant hair care preparations."

The Trademark Examining Attorney has refused registration on the ground that applicant's mark, as applied to applicant's goods, so resembles the registered mark HAIR FITNESS and design (HAIR disclaimed), depicted below,

for "vitamin and nutritional supplements for the hair,"<sup>2</sup> as to be likely to cause confusion, to cause mistake, or to deceive. See Trademark Act Section 2(d), 15 U.S.C. §1052(d).<sup>3</sup>

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identified as "non-medicated hair care preparations, namely shampoos and conditioners."

<sup>2</sup> Reg. No. 1,668,204, issued December 17, 1991; Section 8 and 15 affidavit accepted. September 25, 1990 is alleged in the registration as the date of first use of the mark anywhere, and October 1, 1990 is alleged as the date of first use in commerce.

<sup>3</sup> Initially, the Trademark Examining Attorney had refused registration under Section 2(d) based on a second registration owned by the same registrant, i.e., Registration No. 1,658,635 of the mark HAIR FITNESS (HAIR disclaimed) for "hair vitamin and nutritional supplement." However, that registration has now been cancelled under Section 8, as acknowledged by the Trademark Examining Attorney in his brief. Accordingly, we deem the Section 2(d) refusal to be moot as to that registration.

When the refusal was made final, applicant filed this appeal. Applicant and the Trademark Examining Attorney have filed briefs. No oral hearing was requested. We affirm the refusal to register.

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. See *In re E.I. du Pont de Nemours and 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 and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Applicant's mark is so similar to the cited registered mark that confusion is likely to result from contemporaneous use of the marks on related products. The marks are phonetically identical and share the same connotation, notwithstanding that applicant's mark is presented as one word and registrant's mark is presented as two words. The presence of the design feature in registrant's mark does not distinguish the two marks. Notwithstanding applicant's contention to the contrary, we find that the word portion of registrant's mark, not the

design portion, is the dominant feature of that mark's commercial impression. See, e.g., *In re Appetito Provisions Co.*, 2 USPQ2d 1553, 1554 (TTAB 1987). Furthermore, the design feature itself, depicting a physically fit woman with long, flowing hair, reinforces rather than detracts from the connotation of the registered mark, a connotation shared by applicant's mark. In short, when viewed in their entireties, the marks are similar in terms of their overall commercial impressions. Applicant's arguments to the contrary are not persuasive.

Nor are we persuaded by applicant's contention that the words HAIR FITNESS are weak as applied to the goods involved in this case and that registrant's mark thus is entitled to a narrow scope of protection. Applicant has presented no evidence of third-party use of marks which include the term FITNESS in connection with the types of goods involved in this case, nor is there any other evidence in the record which would warrant or require that we accord registrant's mark a narrow scope of protection.

Applicant's goods are sufficiently related to the goods identified in the registration that confusion is likely to result from the use of the similar marks involved in this case. It is well settled that goods need not be identical or even competitive in order to support a finding

of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods or services. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

The commercial relationship between applicant's goods and the goods identified in the registration is evidenced by applicant's own statements in the record. Applicant admits that it previously has marketed a "kit" product that included both hair care products, such as shampoo and conditioner, and nutritional supplements. (November 25, 1997 response to first Office action, at page 2.) Thus, it is clear that the applicant's type of products and the registrant's type of products can be and are marketed together as complementary products. The relationship between these goods is further established by the fact that Registration No. 1,944,958 of the mark HAIR FITNESS for "non-medicated hair care preparations, namely shampoos and

conditioners," now owned by applicant, was originally registered and owned by the owner of the registration cited against applicant in this case, which is of the mark HAIR FITNESS and design for "vitamin and nutritional supplements for the hair." Thus, a single entity, registrant, has owned contemporaneous registrations of the mark HAIR FITNESS for both hair care products and hair vitamins and nutritional supplements. This is probative evidence to the extent that it suggests that the respective goods emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988).

Applicant argues that the trade channels in which its goods are marketed are different from the trade channels in which the registrant's goods are marketed. This argument is unavailing, because neither the application nor the registration includes any restriction or limitation as to the trade channels or classes of customers for the identified goods. Accordingly, we must presume that applicant's goods and registrant's goods move in all normal trade channels for such goods and that they are marketed to all normal classes of customers for such goods. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). As noted above in connection with applicant's own past practice, hair care

products and nutritional supplements may be marketed together in the same trade channels.

One other *du Pont* evidentiary factor requires discussion in this case. Applicant has claimed ownership of Registration No. 1,944,958, which is of the mark HAIR FITNESS for "non-medicated hair care preparations, namely shampoos and conditioners." As discussed above, it appears from the Office's assignment records that Jeannie Maxon, the owner of the registration cited against applicant in this case (Registration No. 1,668,204), also was the original owner of Registration No. 1,944,958. She assigned Registration No. 1,944,958 to applicant by assignment executed on November 10, 1996 and recorded on March 13, 1997, prior to applicant's filing of the present application.<sup>4</sup>

Applicant argues that Ms. Maxon's prior assignment of Registration No. 1,944,958 to applicant should be deemed to be Ms. Maxon's "consent by assignment" to applicant's registration of the present mark, and that such consent by the owner of the registration cited as a Section 2(d) should be given substantial weight in our likelihood of confusion analysis.

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<sup>4</sup> The mesne assignments are recorded at Reel 1561, Frames 0006 and 0035.

We agree that Ms. Maxon's previous assignment of Registration No. 1,944,958 to applicant is probative evidence on the question of likelihood of confusion, under the tenth *du Pont* factor, and we have considered it as such. However, we find that the assignment is entitled to relatively little weight in our likelihood of confusion analysis, and that it certainly is insufficient to outweigh the evidence under the other *du Pont* factors, i.e., the similarity of the marks, the relatedness of the goods, and the identity of the trade channels and customers for the goods, all of which clearly and strongly supports a finding of likelihood of confusion.

Applicant has not submitted, or even alleged the existence of, a proper consent agreement between itself and Ms. Maxon from which we might determine that the parties have expressly agreed that confusion is unlikely and that they have agreed that they will take steps necessary to avoid confusion. This case thus is distinguishable on its facts from *In re du Pont, supra*, in which the assignment from the registrant to the applicant was made pursuant to and was accompanied by a detailed consent agreement between the registrant and applicant. See 177 USPQ at 566.

In the absence of an appropriately-detailed consent agreement between applicant and Ms. Maxon, from which we



might conclude that the parties indeed believe that no confusion is likely and that they have agreed to take necessary steps to avoid confusion, Ms. Maxon's previous assignment of Registration No. 1,944,958 to applicant is entitled to no more probative evidentiary weight than if it had been a mere "naked" consent to register. That is, it is entitled to very little probative weight. See *In re du Pont*, *supra*, 177 USPQ at 568. Thus, although the assignment is some evidence in support of applicant's position, it does not alter our conclusion, based on the other *du Pont* evidentiary factors, that confusion is likely.<sup>5</sup>

In summary, our consideration of the evidence of record with respect to the relevant *du Pont* evidentiary factors leads us to conclude that a likelihood of confusion

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<sup>5</sup> Applicant also suggests that it would serve no purpose to deny registration to applicant in the present application when applicant already owns the above-referenced registration. However, contrary to applicant's contention and apparent belief, applicant would not be entitled to amend its Registration No. 1,944,458 to add to the identification of goods therein the goods which are identified in the present application but which are not included in the registration's current identification of goods. See Trademark Rule 2.173(b). Therefore, applicant's ownership of that registration does not, in itself, warrant issuance of a new registration, covering additional goods, to be issued to registrant.

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exists in this case.

Decision: The refusal to register is affirmed.

J. D. Sams

H. R. Wendel

C. M. Bottorff

Administrative Trademark Judges  
Trademark Trial and Appeal Board