

THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.

Oral Hearing:
February 9, 2012

Mailed:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re da Vinci, S.A.

Serial No. 77651154

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for da Vinci, S.A.

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108 (Andrew Lawrence, Managing Attorney).

Before Kuhlke, Mermelstein and Kuczma, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

On January 16, 2009, da Vinci, S.A. applied to register the mark DA VINCI in standard characters on the Principal Register based on a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1052(b), for goods identified as "clothing, namely, t-shirts, sweatshirts, sweatpants, jackets, shorts, tops, shirts, bathing suits, hats, coats, caps, footwear, jerseys, jeans, socks, pants, sleepwear, undergarments" in International Class 25.

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Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used with its identified goods, so resembles the registered marks DON DAVINCI in standard characters for

belts; bermuda shorts; button-front aloha shirts; camp shirts; capri pants; caps; cargo pants; crewneck sweaters; denim jackets; denims; dress shirts; golf shirts; heavy jackets; hoods; jackets; jeans; jerseys; jogging pants; knit shirts; leather belts; leather jackets; leather pants; long jackets; long-sleeved shirts; lounge pants; men and women jackets, coats, trousers, vests; mock turtle-neck sweaters; night shirts; open-necked shirts; pants; polo shirts; rain jackets; rainproof jackets; reversible jackets; shirts; short sets; short trousers; short-sleeved or long-sleeved t-shirts; short-sleeved shirts; shorts; sleep shirts; sport shirts; sports jackets; sports shirts [sic]; sports shirts with short sleeves; stretch pants; stuff [sic] jackets; suede jackets; sweat pants; sweat shirts; sweat shorts; sweaters; t-shirts; ties; turtleneck sweaters; V-neck sweaters; walking shorts; waterproof jackets and pants; wind pants; wind resistant jackets (in International Class 25)

owned by CJK Trading, Inc.¹ and L'IL DAVINCI in typed form for

men's, women's and children's apparel, namely, hats, shirts, pants, shorts, dresses, socks, sweaters, shoes, belts, ties and underwear (in International Class 25)

¹ Registration No. 3551284, issued on December 23, 2008.

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owned by Dynamic Frames, LLC,² as to be likely to cause confusion, mistake or deception.

Applicant has appealed the final refusal and the appeal is fully briefed. We affirm the refusal to register.

When there is a question of likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). 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 (CCPA 1976).

Applicant's shorts, shirts, hats, coats, caps, socks, pants, are identical to the shirts, pants, shorts, hats and socks, in Reg. No. 3660937 and the shirts, pants, shorts, caps and coats in Reg. No. 3551284. It is sufficient for a finding of likelihood of confusion if the relatedness is established for any item encompassed by the identification of goods within a particular class in the application.

² Registration No. 3660937, issued on July 28, 2009.

Tuxedo Monopoly, Inc. v. General Mills Fun Group, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981). However, in addition, the examining attorney has submitted several third-party use-based registrations showing that numerous entities have adopted a single mark for the non-identical goods identified in applicant's application and the non-identical goods in registrants' registrations. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993) (third-party registrations serve to suggest that the goods and/or services listed therein are of a kind that may emanate from a single source). Finally, applicant does not dispute that "there is some overlap between the clothing items." Br. p. 9.

Moreover, in view of the identical the goods and because the application and registrations do not contain any restrictions as to channels of trade or classes of purchasers, we must presume that the identifications encompass all goods of the type described, that they move in all channels of trade normal for these goods, and that they are available to all classes of purchasers for the identified goods. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); ("The

authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed"). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade").

In view of the above, we find that the goods are identical and otherwise related, and the channels of trade and classes of customers overlap.

In determining the similarity between the marks we analyze "the marks in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)

quoting du Pont, 177 USPQ at 567. In making this determination, we are mindful that where, as in the present case, registrants' goods include goods that are identical to applicant's goods, the degree of similarity between the marks which is necessary to support a finding of likelihood of confusion declines. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applicant argues that the marks are sufficiently dissimilar and the word "DAVINCI" so diluted that confusion is not likely. In terms of the similarity of the marks, applicant argues that because there is a space between DA and VINCI in its mark and an absence of a space in the registrants' respective marks, there is a difference in connotation and commercial impression. Specifically, applicant contends that its mark would evoke the well-known historical figure Leonardo da Vinci and the registered marks would not. October 1, 2009 Response p. 16 (Wikipedia entry on Leonardo da Vinci).

Further, applicant argues that the common element DAVINCI in the registered marks is not the dominant element inasmuch as it is preceded in each instance by another element, respectively DON and L'IL. Reply Br. p. 2.

Finally, applicant argues that third-party marks with the historical name REMBRANDT have been registered with "fewer distinguishing characteristics amongst them ... demonstrat[ing] that the Office has a history of registering such well-known names in conjunction with each other." Br. p. 5. Applicant also points to other registrations in the clothing field where the marks share a common surname that coexist. Applicant concludes this demonstrates "that the Office has a history of registering such well-known names in conjunction with each other, with minimally distinguishing characteristics for related goods." Br. p. 5.

We find that all three marks at issue share the connotation and commercial impression of Leonardo da Vinci. All three marks are in standard characters,³ and the rights associated with a mark in standard characters reside in the wording and not in any particular display. In re RSI Systems, LLC, 88 USPQ2d 1445 (TTAB 2008); and In re Pollio Dairy Products Corp., 8 USPQ2d 2012, 2015 (TTAB 1988). Thus, in this case, the absence of a space in registrants' marks cannot serve to distinguish the marks, inasmuch as we must consider the marks "regardless of font style, size, or

³ A typed form mark is subjected to the same analysis of what is now categorized as a standard character mark.

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color.” Citigroup Inc. v. Capital City Bank Group Inc., 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011). For example, in the November 15, 2010 Request for Reconsideration, applicant submitted the following examples of use of the registered marks that display the marks in a manner in which the DAVINCI portion of the marks could be perceived as “Da Vinci.”



As shown above, despite the absence of a space between “a” and “v,” in view of the display of the “a” in both cases, it looks like “Da Vinci.”

Further, we make our determination based on the marks in their entireties and, in so doing, consider whether some aspect of a mark may dominate by presenting a more significant and lasting impression on the consumer. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751. We find that DON and L’IL, respectively, do not dominate over the term DAVINCI in these marks. DON is a title used as a prefix for a Spanish nobleman or gentleman and L’IL is

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the abbreviation for the word little.⁴ These terms simply serve to modify and emphasize the second term DAVINCI which is a well-known historical character. See October 1, 2009 Response. See also *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F. Supp. 329, 331, 165 USPQ 459, 461 (S.D.N.Y. 1970) (holding DA VINCI not primarily merely a surname because it primarily connotes Leonardo Da Vinci). To the extent DON would also be perceived simply as a personal name, it does not detract from the impression of being a Da Vinci.⁵

We recognize that the first word in the literal element of a mark is of "a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." *Presto Products, Inc., v. Nice-Pak Products*

⁴ Applicant's objection to the printout from acronymfinder.com for the word L'IL attached to the examining attorney's brief is sustained. Trademark Rule 2.142(d); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 n.5 (TTAB 2007) (Board would not take judicial notice of online encyclopedia). However, we may take judicial notice of the definition for DON retrieved from the Merriam Webster online dictionary and applicant's objection is overruled as to that submission. *In re Dietrich*, 91 USPQ2d 1622, 1631 n. 15 (TTAB 2009) (judicial notice taken of definition from Merriam-Webster Online Dictionary from www.merriam-webster.com). The Board takes judicial notice of the definition for LIL as meaning "little." Acronyms, Initialisms & Abbreviations Dictionary (33rd ed. 2004).

⁵ We note applicant relies on a Board case that was reversed by the Federal Circuit. See *Nina Ricci S.A.R.L. v. E.T.F. Enterprises, Inc.*, 9 USPQ2d 1062 (TTAB 1988), reversed, 899 F.2d 1079, 12 USPQ2d 1901 (Fed. Cir. 1989).

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Inc., 9 USPQ2d 1895, 1897 (TTAB 1988) (emphasis added). See also *Palm Bay Imports*, 73 USPQ2d at 1692. However, in this case, because the term DAVINCI, with or without the space in the typed and standard character marks in the application and registrations, have the identical strong commercial impression of the well-known historical figure Leonardo da Vinci, and the addition of DON and L'IL do not change this impression, applicant's mark would be perceived as an extension or the core brand of DON or L'IL.

As to the "Rembrandt argument," the evidence of record does not establish such a general policy as posited by applicant. Moreover, in making our determination we look to the law, which states that the Board "must decide each case on its own merits." *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

With regard to the handful of third-party marks that incorporate the term DAVINCI, as noted, prior decisions are not binding on the Board. *Id.* See also *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994). Each case must be decided on its own facts and "we will not compound the problem of the registration of a confusingly similar mark by permitting such a mark to register again." *In re Thomas*, 79 USPQ2d 1021, 1028 (TTAB 2006).

In addition, all four of the third-party DAVINCI marks incorporate other matter that serves to distinguish them from each other, as opposed to applicant's mark which does not, other than a space, which as discussed above does not serve as a distinction.

In view of the above, we find applicant's mark to be substantially similar to each of the marks in the cited registrations.

With regard to the weakness of the term DAVINCI, applicant relies on a total of four third-party registrations, including the two cited in the instant proceeding. First, to the extent applicant presented the third-party registrations in support of the du Pont factor pertaining to third-party use, registrations are not evidence of use of the marks shown therein; thus, they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of the same or similar marks in the marketplace. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); *AMF Inc. v. Am. Leisure Products, Inc.*, 474 F.2d 1407, 177 USPQ 268 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982). However, these registrations, similar to a dictionary definition, may be used to demonstrate that a particular term has some

significance in an industry. This record does not support a finding that DAVINCI has a specific meaning in this field such that consumers would look to other elements to determine source. Although the DAVINCI marks may evoke the historical figure, this is hardly suggestive of clothing goods. In short, these examples do not point to a specific meaning for DAVINCI in the clothing industry such that consumers would look to other elements for source-identifying significance.

We find that, even if these four coexisting registrations serve to support some limitation as to scope when DAVINCI is registered with other distinguishing elements, the scope of protection is still broad enough to prevent the registration of a highly similar mark that contains no distinguishing elements for identical goods. See *In re Farah Mfg. Co., Inc.*, 435 F.2d 594, 168 USPQ 277, 278 (CCPA 1971).

Applicant's reliance on various cases does not persuade us of a different result. In these cases, all of the involved marks contained distinguishing features and presented facts specific to those cases. For example, applicant particularly relies on *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321 (TTAB 1992). In these consolidated opposition and cancellation proceedings, the

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Board held that defendant's mark MRS. FIELDS in stylized form for bakery goods, namely, cookies and brownies was not likely to cause confusion with plaintiff's marks FIELD'S for retail department store services and MARSHALL FIELD'S for baked goods and other foods. In reaching its decision, the Board found, inter alia, that opposer used FIELD'S by itself to reference its mark MARSHALL FIELDS and in combination with other terms that evoked a very different connotation (e.g., FIELD'S AFAR and FIELD GEAR). The Board also held in favor of the defendant's laches defense with regard to the cancellation proceeding.

In conclusion, we find that because the marks are similar, the goods are identical and otherwise closely related, and the channels of trade and purchasers overlap, confusion is likely between applicant's mark for its identified goods and the marks in the cited registrations.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.