

**This Opinion is Not a
Precedent of the TTAB**

Hearing: September 16, 2015

Mailed: October 6, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Fashion Box S.P.A.
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Serial No. 86051465
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Keith A. Weltsch of Scully, Scott, Murphy & Presser, P.C.,
for Fashion Box S.P.A.

Greta Yao, Trademark Examining Attorney, Law Office 118,
Thomas Howell, Managing Attorney.

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Before Seeherman, Mermelstein and Bergsman,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Fashion Box S.P.A. (“Applicant”) seeks registration on the Principal Register of the mark RS RED SEAL and design, shown below, for “men's clothing, namely, denim pants, denim shirts, denim jackets, jeans, trousers, jackets, sweaters, shorts, polo-shirts, T-shirts, sweatshirts, coats, belts, hats, bucket caps, caps with visor, sports caps, skull caps, knot caps, swim caps,” in International Class 25.¹

¹ Application Serial No. 86051465 was filed on August 29, 2013, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.



Applicant described its mark as follows:

The mark consists of a circular design in red with the words "RED SEAL" in large black stylized letters on the top edge of the circle, and the words "THE ORIGIN" in smaller black letters on the bottom edge of the circle, all of which surround a smaller black circle drawn in the middle of the design, inside of which contain the letters "RS" in large black stylized characters.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the previously registered mark RED SEAL (standard character format) for "carry-all bags, leather pouches, rucksacks, duffle bags, travel bags, tool bags sold empty, backpacks, purses, trunks, suitcases, garment bags for travel, billfolds, wallets, harnesses, leather bags, leather bag laces, valises," in Class 18, as to be likely to cause confusion.²

After the Examining Attorney made the refusal final, Applicant appealed to this Board. 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 issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177

² Registration No. 3978673; issued June 14, 2011.

USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. The similarity of dissimilarity and nature of the goods.

To prove that the goods in the application and the cited registration are related, the Trademark Examining Attorney submitted third-party trademark registrations and excerpts from third-party websites showing the same mark used to identify the goods listed in the application and the cited registration.

1. Third-party registrations

The Trademark Examining Attorney submitted 25 copies of use-based, third-party registrations for goods listed in both the application and the cited registration.³ Third-party registrations which individually cover a number of different goods that are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods are of a type which

³ We did not consider Registration No. 3467807 for the mark PUNKYSISTERS or Registration No. 4404888 for the mark MONCRIEF because they were filed under Section 44 and they were not based on use.

We did not consider Registration No. 3060358 for the mark HARVEYS because the clothing products set forth in Class 25 goods were cancelled.

Finally, we note that Eddie Bauer, Swissbrands, and Pink Dolphin Clothing each owned two of the registrations submitted by the Trademark Examining Attorney.

may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). The registrations listed in the table below are representative.⁴ We point out that the majority of the registrations are for “ordinary,” as opposed to “designer” marks.⁵ We recognize that designer name marks may be licensed for a broader range of unrelated goods and services, and therefore that registrations for such marks may be of less probative value to show that goods and services are related. *See Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989) (“In considering this [third-party registrations and exhibits], we have kept in mind defendant's observation that the link between personal care products and wearing apparel is generally apparent in the category of so-called designer or high-fashion marks, and usually involves the names of well-known designers.”).

MARK	REG. NO.	GOODS
WARMBLOOD	3617554	Carryall bags, duffel bags, travel bags, backpacks, purses, suitcases, garment bags, rucksacks, wallets, leather bags Jeans, jackets, sweaters, shorts, t-shirts, sweatshirts, belts, hats, caps,

⁴ Only the goods that appear in both Applicant’s application and Registrant’s registration are listed in the table.

⁵ Applicant contends that “the Examining Attorney included evidence from well-known clothing companies which allegedly establish that certain types of men’s wear covered by Applicant’s pending application would be related to different types of Class 18 goods included in the cited registration” as it applies to the third-party registrations. 4 TTABVUE 12. To the extent that Applicant argues that these registrations are not probative, we disagree. The fact that a well-known clothing company uses its marks for both clothing and Class 18 goods does not affect the probative value of such registrations.

MARK	REG. NO.	GOODS
HALV	4183962	Carryall bags, duffel bags, travelling bags, backpacks, leather pouches, purses, trunks, suitcases, wallets, harnesses, leather bags Denim jackets, jackets, trousers, shorts, polo shirts, t-shirts, sweatshirts, coats, belts, hats, caps, swim caps
AEROMOZA BY PASSION GITANA	4230703	All purpose carrying bags, namely duffel bags, backpacks, trunks, travelling bags, wallets, and purses T-shirts, jackets, coats, sweaters, shorts, jeans, belts, hats and caps
ANNELORE	4136923	Trunks, suitcases, travelling bags, garment bags, backpacks, purses, wallets Polo shirts, trousers, jeans, denim jeans, sweatshirts, sweaters, jackets, coats, hats, shorts
	4098799	Trunks, garment bags, duffel bags, carryall bags, backpacks, purses, wallets, rucksacks Jeans, t-shirts, sweatshirts, shorts, jackets, sweaters, hats, caps, belts

2. Third-party websites

The Trademark Examining Attorney submitted excerpts from six third-party websites to show that entities have adopted the same mark for the clothing listed in the application and the various types of luggage, wallets, etc. listed in the cited registration. A close inspection of this evidence reveals, however, that three of the websites are designer labels. As noted above, such marks may be licensed for a

broader range of goods and services which are otherwise unrelated, and therefore they may be of less probative value to show that goods and services are related. *Cf. In re Donnay International Societe Anonyme*, 31 USPQ2d 1953, 1954 n.3 (TTAB 1994);); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d at 1470 n.6 (discounting the evidentiary value of third-party registrations from an amusement park and a department store where a wide variety of goods and services are sold).

The remaining three third-party websites are listed below:

- a. J. Crew website (jcrew.com) advertising the sale of wallets and purses and sweaters, t-shirts, denim pants, and shorts;⁶
- b. Coach website (coach.com) advertising the sale of purses, wallets, coats and jackets;⁷
- c. Bonobos website (bonobos.com) advertising the sale of, *inter alia*, duffel bags, backpacks, pants, and shirts.⁸

We distinguish the J. CREW and COACH house marks from designer labels. As noted above, designer labels may be used on a wide variety of unrelated products sold through diverse channels of trade. However, websites for house marks are probative that the products advertised on a particular website can be found in one place and that consumers could purchase the goods there.

Applicant argued that the website evidence does not show the relatedness of men's clothing and bags because the websites feature only women's clothing.⁹

⁶ October 11, 2013 Office Action.

⁷ *Id.*

⁸ March 24, 2014 Office Action.

However, the above-noted websites advertise the sale of pants, suits, shirts, travel bags, duffel bags, carryall bags, backpacks, and wallets to both men and women.

While Applicant acknowledges that “there might be a slight relationship between the goods covered by the registered mark in the abstract and clothing in the abstract,” it argues that the evidence is not sufficient to prove that the relevant public would encounter both marks under circumstances likely to give rise to the mistaken belief that the goods emanate from a single source. In other words, Applicant contends that the Examining Attorney has not established that the same consumers would encounter both marks.¹⁰ We disagree. While we acknowledge that the evidence of three websites alone might not be sufficient to show that men’s clothing and various types of luggage, wallets, etc. are related, they add support to the evidence of the third-party registrations, and the evidence in its totality is sufficient for us to find that the goods are related.

B. The similarity or dissimilarity of the marks in their entirety in terms of appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, “two marks may be found to be confusingly similar if there are sufficient similarities in terms of sound *or* visual appearance *or* connotation.” *Kabushiki Kaisha Hattori Seiko v. Satellite Int’l, Ltd.*, 29 USPQ2d

⁹ 7 TTABVUE 10.

¹⁰ 4 TTABVUE 12-13.

1317, 1318 (TTAB 1991), *aff'd mem.*, 979 F.2d 216 (Fed. Cir. 1992) (citation omitted). *See also Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1519 (TTAB 2009).

In comparing the marks, we are mindful that “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). *See also San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Since the goods at issue are clothing and various types of luggage, wallets, etc., the average customer is an ordinary consumer.

As indicated above, Applicant is seeking to register the mark RS RED SEAL and design, shown below, and the registered mark is RED SEAL in standard characters.



The marks are similar because they both include the arbitrary term “Red Seal” and different because Applicant’s mark includes the initials RS, a circular design which engenders the commercial impression of a red seal as evidenced by the concentric rings, and the term “The Origin.”

With respect to the letters RS, we note that they appear in the center of the red seal design and in the largest font. On one hand, because the letters RS are visually prominent, they might be considered the dominant feature of Applicant’s mark. On the other hand, however, the letters “RS” are likely to be viewed as an abbreviation for the term RED SEAL appearing directly above the letters RS. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (“ML is likely to be perceived as a shortened version of ML MARK LEES when used on the same or closely related skin care products.”); *In re TSI Brands Inc.*, 67 USPQ2d 1657, 1661-62 (TTAB 2002) (customers will perceive the letters AK in applicant’s mark AK AMERICAN KHAKIS and design as standing for the term “American Khakis” which is substantially different from the cited AK and design marks which are highly stylized and “have nothing in common with applicant’s mark.”). Thus, the letters RS do not distinguish Applicant’s mark from the cited mark, since because they appear in a red seal they reinforce the commercial impression of a red seal.

With respect to the pronunciation of the mark, we cannot say with certainty whether consumers will refer to the mark as RS or as RED SEAL. Certainly either pronunciation is reasonable, and therefore we must assume that at least some consumers will pronounce the mark identically to the cited mark.

As for connotation and commercial impression, “[i]t has frequently been held that a picture and the word that describes the picture have the same effect and must be treated as legal equivalents in proceedings such as this.” *In re Duofold*, 184 USPQ 638, 640 (TTAB 1974) (the representation of a golden eagle is similar to EAGLE). Thus, we find that Applicant’s pictorial representation of a red seal and the registered mark RED SEAL conjure up the same mental image, meaning and commercial impression. In other words, Applicant’s red seal design reinforces the commercial impression engendered by the term RED SEAL. *See In re Wilson*, 57 USPQ2d 1863, 1865 (TTAB 2001) (PINE CONE BRAND and the design of pine cones and fruit is similar to PINE CONE in part because “the illustration of the pine cones merely reinforces the dominance of the arbitrary designation PINE CONE.”); *In re Shipp*, 4 USPQ2d 1174, 1175 (TTAB 1987) (PURITAN and the design of a woman in a Puritan costume is similar to PURITAN); *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984) (BOOMERANG is similar to BOOMERANG and a swirl-like design); *Arrow-Hart, Inc. v Yazaki Corp*, 169 USPQ 249, 250 (TTAB 1971) (ARROW and arrow design is similar to ARROW).

We acknowledge that Applicant’s mark also includes the term “The Origin.” Applicant concedes that “The Origin” is less prominent than the letters RS and less

likely to resonate with consumers.¹¹ Because of the manner in which it appears, on the lower part of the outer circle, it conveys the impression of being informational or a motto, and rather than distinguishing the marks, merely reinforces the significance of the mark as a red seal.

Applicant argues that the Trademark Examining Attorney has improperly dissected the mark by placing too much emphasis on the term RED SEAL.¹²

In the present case, the registered mark is only comprised of the wording RED SEAL. By comparison, a consumer looking at Applicant's mark will notice not just the RED SEAL wording, but also, the red color contained in the stylized mark, as well as the RS lettering and the phrase "the origin". The fact that Applicant's mark contains all of these additional elements makes it highly unlikely that a typical consumer would look at Applicant's mark, and solely remember the RED SEAL element contained therein when making a comparison to the registered mark, which would tend to make confusion between the marks highly unlikely. Further to this point, a consumer asking for clothing sold under Applicant's brand is just as likely to ask for RS jeans as s/he theoretically might be inclined to ask for RED SEAL jeans.¹³

We disagree. As noted above, the red seal design and the letters RS reinforce the term RED SEAL. Rather than distinguishing the marks, the additional elements in Applicant's mark merge to form a single composite mark which consumers will remember as the red seal. Regardless of the differences which might be apparent in a side-by-side comparison, both marks engender the commercial impression of a red seal. The fact that Applicant's mark may not be identical to the registered mark in

¹¹ 4 TTABVUE 10.

¹² 4 TTABVUE 8-9.

¹³ 4 TTABVUE 9.

all details is less important to our analysis than the basic similarity arising from the fact that both marks engender the same meaning and commercial impression.

At oral argument and in support of its position that the marks are not similar, Applicant referenced *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014), which was decided after the close of briefing. In *Covalinski*, the applicant sought to register the mark REDNECK RACEGIRL and design, shown below, for “athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms.”



The Trademark Examining Attorney refused registration on the ground of likelihood of confusion with RACEGIRL (in standard characters) for clothing, including shirts, jackets, caps and hats. The Board found that the marks were not similar because (i) the display of the letters RR “draw attention to the letters apart from the wording,” (ii) the display of the mark makes the word “Racegirl” hard to notice and (iii) the visual impression is the most important feature of the mark. *Id.* at 1168. In view thereof, the Board found that “the overall commercial impression of Applicant's mark is dominated by its design features, particularly the large double-letter RR configuration.” *Id.* at 1169.

In the case before us, the display of the letters RS does not draw the viewer’s attention to the letters apart from any other element of the mark. In that respect,

the term “Red Seal” is clearly visible and constitutes an important feature of the mark. Unlike in *Covalinski*, where the letters RR dominated the commercial impression of the mark, in this case, the letters RS and the seal-like design reinforce the term “Red Seal.”

Applicant also cited *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 16 USPQ2d 1239 (Fed. Cir. 1990) for the proposition that that “there is no general rule as whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue.” 16 USPQ2d at 1240.¹⁴ In *Electrolyte Labs*, the applicant sought to register the mark K+ and design for a dietary potassium supplement. The Trademark Examining Attorney cited the registered mark K+EFF for the same goods as a bar to registration, and the Board affirmed the refusal. The court held that the Board erred in focusing on K+ as the dominant element of both marks because the design elements in the applicant’s mark comprised a significant feature of the mark and the letters EFF in the registered mark were also significant. Accordingly, the court held that “[a]lthough the symbols and abbreviations can be pronounced, they are not identical, and the design of the marks is substantially different.” *Id.*

As indicated above, in the case before us, the main features of Applicant’s mark reinforce the term “Red Seal.” In view of the foregoing, we find that marks are similar in appearance, sound, connotation and commercial impression.

¹⁴ 4 TTABVUE 8.

C. “The wording RED SEAL is very commonly used for a variety of products.”¹⁵

Applicant argues that “the wording RED SEAL has been used by a multitude of different entities in a variety of fields,” citing third-party registrations Applicant submitted with its March 10, 2014 Response to an Office Action.

Of note are the registrations for HONG BAU (which when translated means RED SEAL) for use with wine and liquor in Class 33 (Reg. No. 3,027,759), RED SEAL for use with paint in Class 2 (Reg. No. 2,601,840), RUEDRICH'S RED SEAL ALE HAND MADE SINCE 1987 MENDOCINO COUNTY NORTH COAST BREWING COMPANY for use with beer in Class 32 (Reg. No. 2,009,351), a separate registration for RED SEAL in Class 34 for snuff (Reg. No. 527,124), in addition to all of the other RED SEAL registrations attached to Applicant's response to the first non-final Office Action.¹⁶

Extensive evidence of third-party use may be probative in showing that a term is weak and that customers have been educated to distinguish between different marks on the basis of small distinctions. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, ___F.3d___, ___USPQ2d___, No. 14-1789 (Fed. Cir. Aug. 19, 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671 (Fed. Cir. 2015). In this case, Applicant has not provided any evidence of third-party use. The third-party registrations are not evidence of use of the marks. *See also Olde Tyme Foods Inc. v.*

¹⁵ 4 TTABVUE 10. The relevant *du Pont* factor is “the number and nature of similar marks in use on similar goods.” 77 USPQ at 567. However, third-party registrations unsupported by evidence of use have little probative value in proving that a mark is weak and, therefore, entitled to only a narrow scope of protection or exclusivity of use. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (“As to strength of a mark, however, registration evidence may not be given *any* weight”); *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (C.C.P.A. 1967).

¹⁶ 4 TTABVUE 10-11.

Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (“As to strength of a mark, however, registration evidence may not be given *any* weight.”); *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office). However, third-party registrations may be used in the manner of dictionary definitions, to show that a term has been adopted by various registrants because it has a suggestive significance. *The Institut National des Appellations D’Origine v. Vintners International Co. Inc.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 153 (CCPA 1978). In the present case, the third-party registrations have little probative value because none is for the goods in either the application or the cited registration. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (the third-party registrations are of limited probative value because the goods identified in the registrations appear to be in fields which are far removed from the goods at issue). *See also Key Chemicals, Inc. v. Kelite Chemicals Corp.*, 464 F.2d 1040, 175 USPQ 99, 101 (CCPA 1972) (“Nor is our conclusion altered by the presence in the record of about 40 third-party registrations which embody the word “KEY”. The great majority of those registered marks are for goods unrelated to those in issue, and there is no evidence that they are in continued use. We, therefore, can give them but little weight in the circumstances present here”); *In re Melville Corp.*, 18 USPQ2d 1386, 1388-89 (TTAB 1991) (“Registrations for goods unrelated to the clothing field are irrelevant to our

discussion.”); *Sheller-Globe Corporation v. Scott Paper Company*, 204 USPQ 329, 336 (TTAB 1979) (“we need not comment on the third-party registrations placed in the record by applicant save to note that they pertain to completely unrelated goods and are therefore irrelevant.”). We certainly cannot conclude from the four third-party registrations made of record by Applicant, for goods in such removed fields as tobacco products, alcoholic beverages and paint, that RED SEAL has a readily understood meaning in connection with luggage and the other products listed in the cited registration, and men’s clothing, such that consumers would look to other elements of Applicant’s mark to distinguish it from the Registrant’s.

D. Balancing the factors.

Because the marks are similar and the goods are related, we find that

Applicant’s mark  for “men's clothing, namely, denim pants, denim shirts, denim jackets, jeans, trousers, jackets, sweaters, shorts, polo-shirts, T-shirts, sweatshirts, coats, belts, hats, bucket caps, caps with visor, sports caps, skull caps, knot caps, swim caps” is likely to cause confusion with the registered mark RED SEAL for “carry-all bags, leather pouches, rucksacks, duffle bags, travel bags, tool bags sold empty, backpacks, purses, trunks, suitcases, garment bags for travel, billfolds, wallets, harnesses, leather bags, leather bag laces, valises.”

While this conclusion is not without doubt, any doubt must be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d

1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565,
223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register Applicant's mark is affirmed.