

This Opinion is not a  
Precedent of the TTAB

Mailed: February 22, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Restoque Int'l LLC*  
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Serial No. 86548859  
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W. Scott Petty, King & Spalding,  
for Restoque International LLC.

Alice Benmaman, Trademark Examining Attorney, Law Office 116,  
Christine Cooper, Managing Attorney.

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Before Kuhlke, Hightower, and Larkin,  
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Restoque International LLC (“Applicant”) seeks registration on the Principal Register of the mark shown below for “swimsuits; belts; bermuda shorts; shorts; pants; coats; dresses; shoes; gloves; formalwear, namely, dresses, gowns, tuxedos, dinner jackets, trousers and footwear; headgear, namely, hats and caps; jackets; scarves; neckerchiefs; trousers; rainwear; shirts; footwear; skirts; socks; sweaters;

beachwear; t-shirts; ties; tops; blouses; tank-tops; cardigans; vests; bikinis; jumpsuits; boots; jeans; slippers,” in International Class 25.<sup>1</sup>



The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the standard character marks MADE IN HEAVEN for clothing, namely, tank tops, T-shirts, tunics, shirts, dresses, pants, capri pants, skirts, jackets, cardigans, shawls, and scarves, shown in Registration No. 3076501;<sup>2</sup> MADE IN HEAVEN INTIMATES (“INTIMATES” disclaimed) for lingerie, robes, and slippers, shown in Registration No. 4068446;<sup>3</sup> and MADE IN HEAVEN INTIMATES (“INTIMATES” disclaimed) for bathing suits; beach cover-ups; belts; blouses; bras; camisoles; capri pants; caps; cardigans; coats; denim jackets; denims; dresses; garter belts; hats; jackets; jeans; lingerie; nighties; nightwear; pajamas; panties; shorts and briefs; pants; pantyhose; robes; scarves; shawls; shirts; shoes; shorts; skirts; slacks;

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<sup>1</sup> Application Serial No. 86548859 was filed on February 27, 2015 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), on the basis of Applicant’s allegation of a *bona fide* intention to use the mark in commerce. The mark is described in the application as follows: “The mark consists of the wording ‘JOHN JOHN’ in an arch shape, below it are two concentric and fanciful X’es with the ends of the X’es forming ornate scroll or finials, and below the X’es design is the wording ‘MADE IN HEAVEN’ in a reverse arch shape.” Applicant claims ownership of Registration No. 4049787.

<sup>2</sup> Registration No. 3076501 issued on April 4, 2006 and was renewed on June 24, 2016.

<sup>3</sup> Registration No. 4068446 issued on December 6, 2011.

slips; socks; stockings; sweat jackets; sweat pants; sweat shirts; sweat shorts; sweat suits; sweaters; T-shirts; tank tops; tunics; and underwear; shown in Registration No. 4119382,<sup>4</sup> all owned by the same registrant, as to be likely, when used in connection with Applicant's goods, to cause confusion, mistake, or deception.

After the Examining Attorney made the refusal final, Applicant timely appealed and requested reconsideration, which was denied. Applicant and the Examining Attorney have filed briefs. We affirm the refusal to register.

### **I. Prosecution History and Record on Appeal**

The Examining Attorney issued a first Office Action on June 5, 2015 in which she refused registration on the basis of the three cited registrations and raised informalities regarding the identification and classification of certain goods. Applicant responded on December 7, 2015, briefly traversed the refusal to register on the merits, and stated that it was in the process of seeking a co-existence agreement with the owner of the cited registrations and would respond to the informalities issues if a co-existence agreement was reached.

The Examining Attorney issued a second Office Action on January 7, 2016 making final the refusal to register under Section 2(d). The Examining Attorney made of record Internet evidence regarding the relatedness of Applicant's goods and the goods in the cited registrations.

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<sup>4</sup> Registration No. 4119382 issued on March 27, 2012.

Applicant filed an appeal on July 7, 2016 and simultaneously requested reconsideration.<sup>5</sup> In the Request for Reconsideration, Applicant amended its original goods identification by deleting four types of clothing (loungewear, handkerchiefs, sleepwear, and underwear), narrowed the goods identified as tanks to tank-tops, and made of record a printout from the Patent and Trademark Office's TESS system of Registration No. 4049787 of the mark JOHN, JOHN THE BEST COOL JEANS and design, as well as screenshots from Applicant's website.

The Examining Attorney denied Applicant's Request for Reconsideration on July 27, 2016, 5 TTABVUE 1-2, and the appeal was resumed. 6 TTABVUE.

## II. Likelihood of Confusion Analysis

Section 2(d) of the Trademark Act prohibits the registration of a mark that so resembles a registered mark as to be likely, when used in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under § 2(d) is based upon an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). We consider each *du Pont* factor that is relevant and for which there is record evidence. *See, e.g., M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015). In every case under Section

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<sup>5</sup> The Board instituted the appeal and suspended it pending the Examining Attorney's disposition of the Request for Reconsideration. 2 TTABVUE 2.

2(d), of course, two key considerations are the similarities between the marks and the similarities between the goods or 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”). We turn first to the similarity of the goods, and the related factors regarding their trade channels and classes of customers.

#### **A. Similarity of the Goods, Trade Channels, and Classes of Customers**

Our determination of the similarity of the goods is based upon the identifications of goods in the application and in the cited registrations. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The goods do not have to be identical or even competitive for confusion to be likely. “[L]ikelihood of confusion can be found ‘if the respective goods are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

The identifications of goods in the application and in the cited registration of MADE IN HEAVEN both include the following goods: tank tops, pants, t-shirts,

shirts, dresses, skirts, jackets, cardigans, and scarves.<sup>6</sup> The goods are thus identical in part. “Likelihood of confusion must be found if there is likelihood of confusion involving *any item* that comes within the identification of goods in the involved application.” *In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *Tuxedo Monopoly, Inc. v. General Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)); *see also In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (“[I]n view of our findings with respect to Applicant’s fresh processed fish and frozen fish and Registrant’s non-live fish and frozen fish, we need not make a determination as to Applicant’s remaining goods as it is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application.”). This *du Pont* factor supports a finding of a likelihood of confusion.

“Where, as here, Applicant’s and Registrant’s goods are in part . . . identical, we must presume that the channels of trade and classes of purchasers for those goods are the same.” *Aquamar*, 115 USPQ2d at 1126 (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)). The third and fourth *du Pont* factors also support a finding of a likelihood of confusion.

### **B. Similarity of the Marks**

We turn now to the *du Pont* factor regarding similarity of the marks. This factor focuses on “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v.*

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<sup>6</sup> As discussed below, we focus our analysis on this registration.

*Veuve Cliquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “The 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*, 101 USPQ2d at 1721 (quotation omitted).

Clothing such as pants, t-shirts, shirts, dresses, skirts, and jackets are offered to members of the general public. “Although marks must be compared in their entirety, where they are used on goods and services offered to the general public, emphasis must also be placed on the recollection of the average purchaser, who normally retains a general rather than a specific impression of them.” *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987). The identity of the goods in part also reduces the degree of similarity between the marks necessary for confusion to be likely. *See, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016).

We will focus our analysis on a comparison of Applicant’s mark to the standard character mark MADE IN HEAVEN shown in Registration No. 3076501,<sup>7</sup> which we find to be the most relevant of the three cited marks. If we find a likelihood of confusion as to this cited mark, we need not find it as to the others; conversely, if we

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<sup>7</sup> A standard character registration covers all “depictions of the standard character mark regardless of font style, size, or color.” *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011).

do not find a likelihood of confusion as to this cited mark, we would not find it as to the others. *See Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 USPQ2d 1913, 1917 (TTAB 2015); *In re Max Capital Grp., Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

For ease of reference in following our analysis, we again depict Applicant's mark below:



The Examining Attorney argues that the Registrant's mark MADE IN HEAVEN is included in Applicant's mark, "modified by the addition of its house mark and a design element." 9 TTABVUE 7. She contends that "[a]dding a house mark to an otherwise confusingly similar mark will not obviate a likelihood of confusion under Section 2(d)." 9 TTABVUE 6.

Applicant argues that JOHN JOHN is the dominant portion of its mark, 7 TTABVUE 9, that the words MADE IN HEAVEN in both marks are "weak and suggestive," 7 TTABVUE 9, and that the "addition of the very unique wording 'JOHN JOHN' on top of a distinctive design and the words 'Made in Heaven,' in a distinctive design layout, conveys a wholly different meaning than that of the Cited Marks." 7 TTABVUE 9.

Applicant's mark is a composite word-and-design mark. "In the case of a composite mark containing both words and a design, 'the verbal portion of the mark is the one



most likely to indicate the origin of the goods to which it is affixed.” *Viterra*, 101 USPQ2d at 1908 (quoting *CBS Inc. v. Morrow*, 708 F.2d 1579, 218, USPQ 198, 200 (Fed. Cir. 1983)). “[T]he literal component of brand names likely will appear alone when used in text and will be spoken when requested by consumers.” *Id.* at 1911. *See also In re Chica Inc.*, 84 USPQ2d 1845, 1849 (TTAB 2007). This principle is illustrated by the uses of the words “John John” alone in text on the pages of Applicant’s website in the record.

Even if Applicant’s self-styled “house mark” JOHN JOHN, 7 TTABVUE 11, is the dominant portion of its mark, the marks must be considered in their entirety, and Applicant’s mark contains the entire cited mark MADE IN HEAVEN. We thus must decide whether the addition of JOHN JOHN and the design element to the cited mark makes Applicant’s mark sufficiently dissimilar from the cited mark to make confusion as to the source or sponsorship of Applicant’s goods unlikely. We conclude, on the record here, that it does not.

There have been numerous cases over the years that have reached different conclusions on whether the addition of a house mark avoids confusion. It has long been held that the addition of a trade name or house mark to a registered mark does not generally avoid confusion. . . . “However, there is no arbitrary rule of law that if two product marks are confusingly similar, likelihood of confusion is not removed by use of a company or housemark in association with the product mark.” In these cases, we must, of course, consider the entire marks, including the presence of the house mark in applicant’s mark in light of the evidence of record.

*In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1364 (TTAB 2007) (quotations and citations omitted).

In *Fiesta Palms*, the Board considered the registrability of the mark CLUB PALMS MVP for casino services over the mark MVP for identical services. In rejecting the applicant's claim that the presence of its house mark CLUB PALMS in its mark was sufficient to differentiate its mark from the cited mark, the Board discussed its previous decision in *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005), in which it had found that NORTON MCNAUGHTON ESSENTIALS for clothing was registrable over ESSENTIALS for identical goods. The Board noted that in *Knight Textiles*, the record had included a dictionary definition of "essential" and 23 third-party registrations of "ESSENTIAL"-formative marks for clothing, and that this evidence had caused the Board to find "[i]n terms of overall commercial impression, . . . that although the word ESSENTIALS is the entirety of the commercial impression created by opposer's mark, in applicant's mark it contributes relatively less to the mark's commercial impression than does the house mark NORTON MCNAUGHTON." This was because the evidence showed that "the word ESSENTIALS is highly suggestive as applied to the parties' clothing items and as it appears in both parties' marks, especially in applicant's mark." *Fiesta Palms*, 85 USPQ2d at 1364-65 (quoting *Knight Textile*, 75 USPQ2d at 1315).

The Board then contrasted the record before it in *Fiesta Palms* with the record in *Knight Textile*:

Unlike the party in *Knight Textile*, applicant has not submitted evidence that the term MVP is so highly suggestive that the inclusion of its house mark would create significant differences in the marks' appearance, pronunciation, meaning, and commercial impression. In addition, applicant has not submitted any evidence that

the term MVP is used by others in the casino field or that it has any specific meaning in that field other than the general dictionary meaning of a “most valuable player,” which is often used in the field of sports. . . . Because applicant has not demonstrated that MVP is a highly suggestive term for casino services, the addition of the house mark CLUB PALMS is not sufficient to distinguish these otherwise identical marks, and the marks CLUB PALMS MVP and MVP are similar in sound, appearance, meaning, and connotation.

85 USPQ2d at 1366.

Here, as in *Fiesta Palms*, Applicant “has not submitted evidence that the term [MADE IN HEAVEN] is so highly suggestive that the inclusion of its house mark would create significant differences in the marks’ appearance, pronunciation, meaning, and commercial impression.” *Id.* The record is devoid of evidence that MADE IN HEAVEN is “weak and suggestive” for clothing, as Applicant claims, 7 TTABVUE 9, as there is no evidence that it has a recognized meaning in the American vernacular and is thus inherently weak, or that it has been weakened by third-party uses or registrations of MADE IN HEAVEN for clothing. The record is similarly devoid of evidence that Applicant’s claimed house mark JOHN JOHN “is a well-known international brand that has been used in the United States for at least the last seven years,” 7 TTABVUE 11,<sup>8</sup> such that the house mark gives Applicant’s mark

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<sup>8</sup> As noted above, Applicant made of record a TESS page for Registration No. 4049787 of the mark JOHN, JOHN THE BEST COOL JEANS and design. 4 TTABVUE 5. Under Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c), a registrant can rely, for priority purposes, on the filing date of the application that matured into its registration as its constructive date of first use of the registered mark, but Applicant’s registration *per se* is not proof that its claimed house mark is well-known in the United States. *Cf.* Trademark Rule 2.122(b)(2), 37 C.F.R. § 2.122(b)(2) (in an *inter partes* proceeding, an allegation of a date of use in an application or registration in the record “is not evidence on behalf of the applicant or registrant; a date of

a “wholly different meaning” from the cited mark. 7 TTABVUE 9.<sup>9</sup> We find, on this record, that because “the common part of the marks is identical, purchasers familiar with the registrant’s mark are likely to assume that the house mark simply identifies what had previously been an anonymous source,” *Fiesta Palms*, 85 USPQ2d at 1364, or that Applicant’s mark represents a variation or brand extension of the cited mark. *See also, e.g., In re Toshiba Medical Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (addition of “product mark” VANTAGE to applicant’s TITAN mark insufficient to make VANTAGE TITAN and TITAN dissimilar as applied to medical devices, notwithstanding Board’s conclusion that the term TITAN was slightly laudatory); *In re Riddle*, 225 USPQ 630, 632 (TTAB 1985) (finding RICHARD PETTY’S ACCU TUNE and design for automotive service centers likely to cause confusion with

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use of a mark must be established by competent evidence.”). Applicant did not make of record its Application Serial No. 86548854 to which it also refers. 7 TTABVUE 10.

<sup>9</sup> The cases cited by Applicant on the differences between the marks, 7 TTABVUE 8-9, do not aid Applicant on the record here. In *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 USPQ 529, 530 (CCPA 1970), the court found that PEAK and PEAK PERIOD were dissimilar, but the goods were “different and noncompetitive in that their application and utility serve different objectives.” In *Electronic Realty Assocs., Inc. v. Kayser-Roth Corp.*, 216 USPQ 61, 63 (TTAB 1982), the Board found that GOLDEN ERA and ERA for clothing were dissimilar, but the ERA mark was “in essence a monogram mark for the name ‘Electronic Realty Associates’” and “clients and consumers would view it, think of it, pronounce it and call for it as such . . .” In *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 153-54 (CCPA 1978), the court found that RED ZINGER for herbal tea and ZINGERS for cakes were dissimilar, but the record included third-party registrations of “ZING-”formative marks and evidence that the opposer had argued that the formative was weak, and entitled only to a narrow scope of protection, to obtain its registration over a citation of a previously-registered ZING-formative mark. In *Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co.*, 781 F.2d 884, 228 USPQ 364, 366-67 (Fed. Cir. 1986), the court found that ROMANBUGER for carryout sandwiches and ROMAN MEAL for food products were dissimilar, but the goods and channels of trade were different and the court saw “no reason to believe, and there is no evidence on the point, that consumers are likely to extract ‘Roman’ from ‘Romanburger’ and rely on ‘Roman’ per se as an indication of source.”

ACCU-TUNE for automotive testing equipment). This *du Pont* factor supports a finding of a likelihood of confusion.

### C. Purchase Conditions

Applicant argues that “the consumers of Applicant’s goods are very sophisticated and savvy” and that the “goods offered by Applicant are expensive, with prices ranging from close to \$100 an item to close to \$1000 an item and are not likely to be purchased on impulse without a great deal of research and care.” 7 TTABVUE 11. As noted above, Applicant made of record pages from its website (reproduced below), which it claimed showed the sophistication of the purchasers of its goods:

7/7/2016 PREVIEW VERÃO 17 - FEMININO JOHN JOHN DENIM | SHOP ONLINE | Compre a nova coleção pelo site oficial.

JOHN JOHN FEMININO MASCULINO KIDS LIFESTYLE SALE 00

HOME

FEMININO TAMANHO

PÁGINA: 1 2 PRÓXIMO PRODUTOS POR PÁGINA: 13 ORDENAR POR: RELEVÂNCIA

SAIA CAMILA II TRICOT R\$368,00

CALÇA BOYFRIEND MANCHESTER JEANS R\$398,00

<http://www.johnjohndenim.com/catalog/category/view/s/preview-verao-17/id/343/> 1/3

7/7/2016

PREVIEW VERÃO 17 - FEMININO JOHN JOHN DENIM | SHOP ONLINE | Compre a nova coleção pelo site oficial.



FEMININO MASCULINO KIDS LIFESTYLE SALE

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SCARPIN METALLIC R\$458,00

SANDÁLIA FLAT SPIN METALLIC R\$398,00

BOTA LIA METALLIC R\$698,00

COLAR JANAINA R\$258,00



COLAR JANAINA GRAFITE R\$258,00

COLAR JESSICA OURO R\$238,00

BOLSA CROSSBODY MINI PAMELA BLACK R\$298,00

VESTIDO SOFIA TRICOT R\$568,00

PÁGINA: 1 2 PRÓXIMO

PRODUTOS POR PÁGINA: 13

ORDENAR POR: RELEVÂNCIA

http://www.johnjohndenim.com/catalog/category/view/s/preview-verao-17/id/343/

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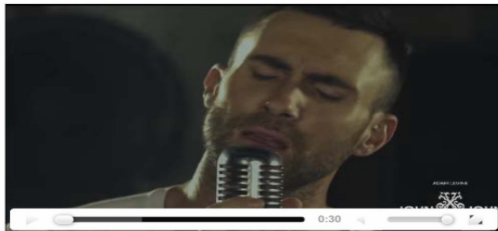
7/7/2016

PREVIEW VERÃO 17 - FEMININO JOHN JOHN DENIM | SHOP ONLINE | Compre a nova coleção pelo site oficial.



FEMININO MASCULINO KIDS LIFESTYLE SALE

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NOSSAS LOJAS

ACHE A LOJA MAIS PRÓXIMA

CONTATO

ASSESSORIA DE IMPRENSA

TRABALHE CONOSCO

FALE CONOSCO

SAC 0300 770 5500

INFORMAÇÕES

TROCA E DEVOLUÇÃO PERGUNTAS FREQUENTES

PAGAMENTO



SEGURANÇA



RESTOQUE COMÉRCIO E CONFEÇÕES DE ROUPAS S.A. - RUA OTHÃO, 405 - VILA LEOPOLDINA - SÃO PAULO - SP - 05313-020 - CNPJ: 49.669.856/0088-02

http://www.johnjohndenim.com/catalog/category/view/s/preview-verao-17/id/343/

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Applicant's website does not support Applicant's claim,<sup>10</sup> but it is irrelevant to our analysis in any event. Neither the application nor cited Registration No. 3076501 contains any restrictions or limitations on the price of the identified clothing items. We thus must presume that the tank tops, pants, t-shirts, shirts, dresses, skirts, jackets, cardigans, and scarves that are common to the application and the cited registration encompass low-priced goods that would be purchased with ordinary or even minimal care. *See, e.g., In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1649 (TTAB 2008) (where identification of "jewelry" in application was not limited by price, Board was required to "assume that the jewelry includes inexpensive items that consumers would purchase with nothing more than ordinary care."). In any event, we must base our decision on the least sophisticated potential purchasers. *Stone Lion*, 110 USPQ2d at 1163. This *du Pont* factor is neutral in our analysis.

### **Conclusion**

All of the *du Pont* factors for which there is record evidence support a finding of a likelihood of confusion with respect to Registration No. 3076501, as the goods, channels of trade, and classes of customers are identical in part, and the marks are similar. We find that confusion as to the source or sponsorship of Applicant's goods is likely.

**Decision:** The refusal to register is affirmed.

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<sup>10</sup> These pages are almost entirely in Portuguese and one of them (4 TTABVUE 8) provides contact information in Sao Paulo, Brazil. Applicant made of record no evidence regarding the exposure of its website to consumers in the United States. The prices of the goods on Applicant's website are stated in Brazilian currency.