

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Oral Hearing:  
March 9, 2010

Mailed:  
June 25, 2010

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Valentino U.S.A., Inc.  
v.  
Florence Fashions (Jersey) Limited

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Opposition No. 91094961  
to application Serial No. 74188334  
filed on July 25, 1991

Opposition No. 91095203  
to application Serial No. 74188331  
filed on July 25, 1991

Cancellation No. 92029390

Cancellation No. 92029476

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Rothwell, Figg, Ernst & Manbeck P.C. for Valentino U.S.A.,  
Inc.

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Garrett & Dunner, L.L.P. for Florence Fashions (Jersey)  
Limited.

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Before Quinn, Holtzman and Kuhlke, Administrative Trademark  
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

As can be readily ascertained from the case caption, these proceedings have been pending for many years. The opposition proceedings were filed in June of 1994 and the cancellation proceedings were filed in June of 1999. After sixteen years of suspensions and extensions for settlement negotiations and discovery, consolidations of proceedings, a summary judgment motion, and various skirmishes during the trial phase of these consolidated proceedings, they are now ready for final disposition.<sup>1</sup> It is unfortunate that after so many years the parties were unable to apply the surgical precision of negotiation to arrive at an acceptable settlement agreement and have now litigated their dispute on what can best be described as a stale record, in particular on the part of the plaintiff, focusing on activities prior to 1991, nearly twenty years ago.

The marks in Florence Fashion (Jersey) Limited's (hereinafter defendant) applications and registrations at issue in these proceedings are as follows:

GIANNI VALENTINO (in typed form) - Application Serial No. 74188334, filed on July 25, 1991, based on an intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b),

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<sup>1</sup> Over the past few years the Board has instituted procedures to limit the ability of parties to linger in the Board's files. We understand that in some circumstances, similar to those involved in these proceedings, the Board proceedings are merely the tip of the iceberg of a global battle and the settlement negotiations are extremely complicated; but sixteen years of dithering is simply beyond the pale. We hasten to add that we recognize that current counsel was not involved in these proceedings throughout these sixteen years and have proceeded relatively steadily through the trial phase.

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for "bath robes; boots; ski boots; boots for sports; coats; dressing gowns; gloves; hosiery; jackets; jerseys; jumpers; knitted pullovers; knitted cardigans; mittens; leggings, overcoats; pants; pullovers; pajamas; sandals; scarves; mufflers; knitted caps; knitted vests; shawls; shirts; shoes; skirts; slippers; socks; sweaters; swimsuits; trousers; underwear; waistcoats; ties; neckties; bow ties; cravaths [sic]; night gowns; bed jackets; negligees; and headwear" in International Class 25;

GIOVANNI VALENTINO (in typed form) - Application Serial No. 74188331, filed on July 25, 1991, based on an intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b), for "attache cases; bandoliers; brief cases; garment bags for travel; handbags; straps for luggage; thongs; pocket wallets; drawstring pouches; purses; rucksacks; satchels; cosmetic cases sold empty; cases for men's toiletries sold empty; valises; animal hides; trunks for travelling; umbrellas; parasols; walking sticks; whips; harnesses; and saddlery; all made of leather or imitation of leather" in International Class 18 and "shoulder belts; namely, belts which run across the body from front to back and which are attached to belts about the waist" in International Class 25;

GIANNI VALENTINO (in typed form) - Registration No. 2130804, filed on July 25, 1991, issued on January 20, 1998, asserting 1991 as the date of first use, for "attache cases; bandoliers, brief cases; garment bags for travel; handbags; straps for luggage; thongs; music cases, namely, a type of brief case designed to carry musical scores; pocket wallets; drawstring pouches; purses; rucksacks; satchels; school bags; travelling bags; individual pieces of luggage and luggage sets; cosmetic cases sold empty; cases for men's toiletries sold empty; valises; animal hides; trunks for travelling; umbrellas; parasols; walking sticks; whips; harnesses; and saddlery; all made of leather or imitation of leather" in International Class 18; and

GIOVANNI VALENTINO (in typed form) - Registration No. 2103658, filed on July 25, 1991, issued October 7, 1997, asserting 1991 as the date of

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first use, for "bath robes; boots; boots for sports; coats; overcoats; dressing gowns; bed jackets; gloves; hosiery; jackets; knitted pullovers; pullovers, jerseys, sweaters, jumpers, knitted cardigans; leggings, mittens; trousers; pants; pajamas; shoes; sandals; scarves; mufflers; shawls; knitted caps; knitted vests; shirts; skirts; slippers; socks; swimsuits; underwear; waistcoats; ties; neckties; cravats; bowties, night gowns, negligees; and headwear" in International Class 25.

The applications and registrations all include the statement that "GIANNI VALENTINO" or "GIOVANNI VALENTINO" is a "living individual whose consent is of record."

Valentino U.S.A., Inc. (hereinafter plaintiff)<sup>2</sup> brought these proceedings on the ground that, as applied to

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<sup>2</sup> We refer to the Board orders issued on May 19, 2008 and December 15, 2008, clarifying that the plaintiff in these proceedings was Valentino Couture, Inc. We reiterate that in the case of the opposition proceedings, once the thirty-day opposition period closed, any further possible plaintiffs, even related companies, are statutorily barred from joining the proceeding. Trademark Act Section 13, 15 U.S.C. §1063(a) ("Any person who believes that he would be damaged by the registration of a mark upon the principal register...may, upon payment of the prescribed fee, file an opposition...within thirty days after the publication...of the mark sought to be registered."); Trademark Rule §2.101(c), 37 C.F.R. §2.101 ("The opposition must be filed within thirty days after publication of the application being opposed or within an extension of time for filing an opposition"); SDT Inc. v. Patterson Dental Co., 30 USPQ2d 1707 (TTAB 1994); In re Cooper, 209 USPQ 670 (Comm'r. Pat. 1980). Thus, because plaintiff's parent company, Valentino S.p.A., the purported owner of the pleaded registrations, did not file a notice of opposition or a request for an extension of time within which to do so during the statutory period, it is statutorily time-barred from opposing defendant's applications. Reading the pleadings filed back in 1994, it appears that plaintiff intentionally only named the licensee as the opposer and the registrations were informatively listed to allege which marks plaintiff was licensed to use. The only joinder or substitutions that may occur in an opposition are where an individual or entity has succeeded to the interest of a plaintiff's rights which is not the case here. In the case of the cancellation proceedings, by the time plaintiff's parent allegedly moved to be joined in October 2004, it was time-barred as to the Section 2(d) claim

defendant's goods, the marks so resemble plaintiff's previously used marks VALENTINO and VALENTINO GARAVANI for a variety of clothing and accessory items, including coats, dresses, sweaters, hosiery, gloves, handbags, belts and footwear, as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d).<sup>3</sup> The pleading also lists several registrations allegedly owned by plaintiff's parent company. While plaintiff may not rely on the registrations for the presumptions afforded by Section 7(b) of the Trademark Act, plaintiff has alleged that it is authorized as the exclusive licensee in the United States to use the marks appearing in the registrations in connection with the goods listed

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because by that time both registrations were over five years old. Section 14, 15 U.S.C. § 1064. Plaintiff's filing of the petitions for cancellation did not serve to toll the five-year statutory limit for other potential parties, even related companies. As to the Section 2(a) claim the Board determined that plaintiff had delayed too long to be joined for that one claim. In any event, as discussed infra, plaintiff has waived the Section 2(a) claim.

Finally, we note that on April 24, 2009, the proceeding was recaptioned to reflect the merger of Valentino Couture, Inc. into Valentino USA, Inc., which is the successor to plaintiff's rights.

<sup>3</sup> The complaints in all four proceedings include an insufficient pleading for a claim of false suggestion of a connection under Section 2(a) of the Trademark Act. In addition, in the opposition proceedings plaintiff asserted the ground that defendant did not have a bona fide intent to use the marks. In its brief, plaintiff presents argument only as to the claim of priority and likelihood of confusion under Section 2(d) of the Trademark Act. In view thereof, we deem plaintiff to have waived these other claims. *Krause v. Krause Publications Inc.*, 76 USPQ2d 1904, 1906 n.2 (TTAB 2005).

therein. The marks in the registrations are, for the most part, similar to the alleged common law marks VALENTINO and VALENTINO GARAVANI except in three instances the letter V or a V logo is part of the mark. In general, pleadings are to be construed liberally, and we consider the pleadings to have alleged use of all of the various VALENTINO marks; however, our analysis must necessarily be limited to those for which there is evidence of use.<sup>4</sup>

Defendant filed answers by which it denied the salient allegations and in each case asserted the affirmative defense that plaintiff is "estopped from opposing [or cancelling defendant's applications and registrations] herein as the result of a 1979 Agreement limiting [plaintiff's] rights to the pleaded marks, and allowing use of the term 'valentino' in marks for, inter alia, clothing and leather goods. Those limitations are a bar to the opposition filed herein." Opposition No. 91094961, Answer ¶18. To the extent defendant asserted a contractual estoppel defense, defendant has not presented argument on this estoppel defense and we consider it waived.<sup>5</sup>

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<sup>4</sup> Defendant's objection to plaintiff's submission of these registrations under notice of reliance is sustained to the extent that they may only be used to show "what appears on their face, namely, that an application was filed claiming use for the mark shown in the registration for the listed goods and services, and that the registration was granted." Defendant's Appendix of Objections ("Def. App.") p. 2.

<sup>5</sup> As discussed below, defendant is not a party to the 1979 agreement. "The degree to which an admission of no likelihood of

In addition, defendant averred that "Any similarity which may exist between the [marks] would be the result of their respective use of the term 'valentino,' which has been used and registered by numerous third parties in the clothing, clothing-related, and other fields. As a result, [plaintiff] cannot base any similarity between its pleaded marks and the mark of [defendant] on use of the term 'valentino.'" Answer ¶17.

#### THE RECORD

Defendant asserted many objections to the evidence, including that much of plaintiff's testimony is inadmissible based on lack of personal knowledge and hearsay. We address these objections, as necessary, within the decision, and to

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confusion inherent in a consent can be invoked by third parties has yet to be fully defined by the courts." J. T. McCarthy, McCarthy on Trademarks and Unfair Competition, § 32:106 (4<sup>th</sup> ed. 2009). Here, defendant's use of the agreement is more in the nature of an admission against interest, arguing that plaintiff acknowledges other "Valentino" marks can coexist in the marketplace. In a similar manner, defendant relies on statements made in the prosecution of plaintiff's parent corporation's pending applications. We consider this evidence for whatever limited probative value it may have. *Specialty Brands Inc. v. Coffee Beans Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1283 (Fed. Cir. 1984), quoting, *Interstate Brands Corp. v. Celestial Seasonings Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978) ("[T]hat a party earlier indicated a contrary opinion respecting the conclusion in a similar proceeding involving similar marks and goods is a fact, and that fact may be received in evidence as merely illuminative of shade and tone in the total picture confronting the decision maker. To that limited extent, a party's earlier contrary opinion may be considered relevant and competent.") We note, however, that in the case of the agreement, it involves different marks and includes limitations on use, and in the case of the pending applications those statements were not made by plaintiff but rather its parent company.

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the extent we rely on plaintiff's testimony, it will be given the probative value to which it is properly entitled pursuant to the Federal Rules of Evidence. Ballet Tech Foundation, Inc. v. The Joyce Theater Foundation, Inc., 89 USPQ2d 1262, 1265 (TTAB 2008) ("We are not inclined to strike the testimony depositions in toto, nor are we inclined to parse the depositions to separate the admissible testimony from the inadmissible testimony. However, we are aware of the infirmities described in petitioner's objections. To the extent that we rely on any testimony from Ms. Shelton and Mr. Flecher, it will be given the probative value to which it is properly entitled pursuant to the Federal Rules of Evidence.") Plaintiff did not maintain its objections in its main brief on the case; therefore, we deem any objections to have been waived. See Hard Rock Cafe International (USA) Inc. v. Elsea, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000) (objection to exhibit raised during deposition but not maintained in brief is deemed waived). As stated by the Board "[p]laintiff cannot be allowed to wait until its reply brief to maintain any objections; to allow this would effectively foreclose respondent from responding to the objections." Kohler Co. v. Baldwin Hardware Corp., 82 USPQ2d 1100, 1104 (TTAB 2007).

However, before we proceed we must first take up for consideration a remaining evidentiary motion, filed by

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defendant on November 3, 2009. Defendant moves to strike plaintiff's October 20, 2009 notice of reliance on an Italian Supreme Court Decision and English translation. By way of background, on May 19, 2009, defendant filed a notice of reliance on decisions issued by various Italian courts concerning litigation between defendant and plaintiff's parent company. On June 29, 2009, plaintiff moved to strike defendant's notice of reliance. However, on October 20, 2009, plaintiff withdrew its motion to strike and filed the notice of reliance which is the subject of the current motion to strike.

Plaintiff submitted the notice of reliance as rebuttal to defendant's tenth notice of reliance, noting that defendant "neglected to submit the most recent Italian decision and translation, wherein the Italian Supreme Court found a likelihood of confusion between the marks at issue [and] that [defendant] was not a party to the Mario Valentino Agreement of 1979." Plaintiff's Notice of Reliance p. 1. Defendant argues that the documents submitted under plaintiff's notice of reliance lack foundation in that the 8-page English translation of the 81-page Italian Supreme Court decision is incomplete.

First, in the case before us, there is no dispute that defendant is not a party to the 1979 Agreement. Second, the question of likelihood of confusion in another country is

irrelevant to the question of likelihood of confusion among consumers in the United States. Thus, the substance of the Italian Supreme Court decision is of no probative value; however, the existence of the decision does serve to rebut defendant's notice of reliance, to the extent that it corrects any implication that defendant's submission represented the final determinations in the Italian courts. In view thereof, defendant's motion to strike is denied and the documents under this notice of reliance are admitted for the limited purpose noted above.

Thus, the evidence of record consists of the pleadings herein; the files of defendant's subject applications and registrations; the testimony depositions (with exhibits) submitted by plaintiff of Carmine Pappagallo, plaintiff's Chief Financial Officer, Antonella Andrioli, Director of Legal and Corporate Affairs of Valentino Fashion Group, S.p.A., plaintiff's grandparent company,<sup>6</sup> Steven Dougherty, paralegal for plaintiff's outside counsel, and Alan Garten, Assistant General Counsel for the Trump Corporation. Defendant submitted the testimony depositions of James William Norris, defendant's Director, and Larry White, legal assistant for defendant's outside counsel. In addition, both parties submitted several voluminous notices of

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<sup>6</sup> Ms. Andrioli's testimony was taken as a deposition upon written questions, as she resides in Italy.

reliance on various printed publications, official records and discovery responses.<sup>7</sup>

#### THE PARTIES

Plaintiff is a fashion company engaged in the sale of a variety of clothing, handbags, footwear and accessory items. See generally, Pappagallo Test. Plaintiff is the wholly-owned subsidiary of Valentino S.p.A. Pappagallo Test. p. 7. In turn, Valentino S.p.A. is the wholly-owned subsidiary of Valentino Fashion Group S.p.A. Andrioli Test. p. 81.<sup>8</sup> Valentino S.p.A. owns several U.S. trademark registrations for various VALENTINO marks for a variety of clothing, leather goods and accessory items. Andrioli Test. p. 8. Plaintiff is the exclusive user and licensee of the VALENTINO marks in the United States. Andrioli Test. pp. 8-10. Plaintiff's VALENTINO marks are derived from the name of the fashion designer Valentino Garavani. Pappagallo Test. p. 46.

Defendant is a fashion company engaged in the sale of clothing, leather goods and accessory items. Norris Test.

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<sup>7</sup> Certain testimony and exhibits were designated as confidential and we will discuss those portions of the record in general terms. In addition, while we only discuss certain portions of the record in the decision, we have considered the entire record in arriving at our determination.

<sup>8</sup> Defendant only objects to Ms. Andrioli's testimony as to plaintiff's use in commerce in the United States which we address infra. In her position as Director of Legal and Corporate Affairs for Valentino Fashion Group S.p.A., she is competent to testify about the corporate structure of the companies and the ownership of the pleaded registrations.

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pp. 5, 48-49. Defendant's products are designed by Giovanni Valentino. Norris Test. p. 10. Defendant's marks GIOVANNI VALENTINO and GIANNI VALENTINO are the name of the designer, Gianni being the diminutive of Giovanni. Giovanni Valentino comes from a family with a history in the fashion industry, beginning with his grandfather Vincenzo Valentino. Norris Test. p. 11. He specialized in leather goods, including shoes and bags. Norris Test. p. 14. Giovanni Valentino's father, Mario Valentino, carried on the grandfather's business using the marks VALENTINO and MARIO VALENTINO in connection with leather goods and clothing in the United States. Norris Test. pp. 16-17. Giovanni Valentino worked for his father Mario for approximately twelve years and later set up his own business and brand. Norris Test. p. 27.

#### **STANDING**

As discussed below, plaintiff has shown that it uses the marks VALENTINO and VALENTINO GARAVANI in connection with various clothing items, handbags, footwear and accessories and has demonstrated a real interest in preventing and cancelling registration of defendant's marks. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987); *Lipton*

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Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Thus, plaintiff has established its standing.

#### PRIORITY

As noted above, the pleadings reference several VALENTINO marks; however, we confine our analysis to the asserted common law marks VALENTINO and VALENTINO GARAVANI (hereinafter also referred to as the "VALENTINO marks").<sup>9</sup> We begin with the question of priority. Because plaintiff is not the owner of the pleaded registrations, plaintiff must prove its common law rights prior to defendant's priority date. Hydro-Dynamics Inc. v. George Putnum and Company Inc., 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). "Under the rule of Otto Roth, a party opposing [or seeking to cancel] registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he shows by a preponderance of the evidence that his term is distinctive of his goods, whether inherently or through the acquisition of secondary meaning or through 'whatever other type of use may have developed a trade identity.'" Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990), citing, Otto

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<sup>9</sup> We note, that even in displays of the marks with the V logo, VALENTINO and VALENTINO GARAVANI create a separate commercial impression.

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Roth & Co. v. Universal Food Corp., 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981).

Thus, in order to prevail, plaintiff must establish that it acquired trademark rights in the VALENTINO marks, that they are distinctive, either inherently or through acquired distinctiveness, and that its use predates defendant's first actual or constructive use.

The applications, alleging an intention to use the marks in commerce, and the underlying applications for the registrations, alleging 1991 as the date of first use, were all filed on July 25, 1991. During trial, and in its brief, defendant attempts to establish an earlier date of first use, asserting use since 1977. On June 30, 2009, in a prior order, the Board denied defendant's motion to amend its answer to assert an earlier date of first use.<sup>10</sup> In particular, the Board noted that at least as early as May 19, 2008, defendant was on "notice that plaintiff would be required to establish its priority date through evidence of use...and should have moved promptly after that date, if not well beforehand, to amend its answers...even if defendant established that plaintiff does not need discovery regarding the distinctiveness of its own marks, defendant does not and cannot argue that plaintiff should not have discovery on

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<sup>10</sup> By its motion, defendant also sought to amend its answer to assert the defense that plaintiff's mark is primarily merely a surname, which we discuss infra.

defendant's newly-claimed date of first use. Yet defendant seeks leave to plead that plaintiff 'cannot establish that its marks acquired distinctiveness before [defendant's newly-claimed] 1977 date of first use.'"<sup>11</sup> Board Order pp. 5-7. Based on this Board order, defendant may only rely on its filing dates for its priority date.

We add that even if we were to allow defendant to assert this earlier date, defendant has failed to prove it. A party attempting to establish a first use date that is earlier than the date in the application or registration is subject to a higher evidentiary burden. Such facts must be established by clear and convincing evidence, as opposed to the preponderance of the evidence standard imposed on a common law plaintiff. Compare *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000) (plaintiff has burden of proving by a preponderance of the evidence that there was a likelihood of confusion) with *Hydro-Dynamics*, 1 USPQ2d 1772 (to establish an earlier date of use than the date alleged in its application, proof must be clear and convincing and must not be characterized by contradiction, inconsistencies and indefiniteness). See also *Martahus v. Video Duplication Services Inc.*, 3 F.3d

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<sup>11</sup> In fact, the initial complaints in all four proceedings, filed in 1994 and 1999, put defendant on notice that priority was an issue in these proceedings inasmuch as the owner of the

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417, 27 USPQ2d 1846, 1852 n. 7 (Fed. Cir. 1993); and *The B. R. Baker Company v. Lebow Brothers*, 66 USPQ 232, 236 (CCPA 1945) ("It has become well-settled law that one who seeks to prove priority of ownership and use of a trade mark over the application date of a registered mark must do so by a preponderance of the evidence ... however, [where] one has under oath stated his earliest use and then amends his oath and by proof attempts to show an earlier date, he is then under a heavy burden, and his proof must be 'clear and convincing.'")

The evidence presented by defendant to establish 1977 as the first use date, some 14 years prior to the filing date of its intent-to-use applications and date of first use alleged in its registrations, is far from clear and convincing. Defendant's director, James Norris, testified that defendant's predecessor-in-interest, Florence Fashions Trading, first used the mark GIOVANNI VALENTINO in 1977. His testimony is based on a brochure with a copyright date of 1977 displaying purses. He testifies that he bases his testimony of first use on this brochure he found in some litigation files and that he has no knowledge of any sales and no knowledge if that brochure was distributed. An excerpt of his testimony is set forth below:

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registrations was not a party and any confusion in that regard did not occur until 2004.

Q. Okay. And so when you learned of the 1977 date, it was based on this document?

A. Yes.

Q. And when did you discover this document?

A. Only recently, as I said, when we made inquiries as to documents that would support [defendant's predecessor's] history. And we had no reason to delve into them prior to that.<sup>12</sup>

Q. Was this brochure distributed in the United States?

A. Yes.

Q. When was this brochure distributed in the United States:

A. 1977. ...

Q. Do you have personal knowledge as to how this brochure was used by [defendant's predecessor]?

A. No.

Q. Do you have any knowledge that it was actually distributed by [defendant's predecessor]?

A. No.

Norris Test. pp. 37 and 272, Exh. No. 4.

Thus, plaintiff must establish use prior to defendant's constructive use date, July 25, 1991, the filing date of the pending applications and the underlying applications for the registrations.

As noted above, during the trial phase, defendant moved to amend its answer to include as an affirmative defense that the "pleaded common law marks are comprised of or contain the common surname VALENTINO [and t]he pleaded marks are primarily merely a surname and lack distinctiveness." The Board denied this motion but noted "defendant's operative answers already deny the salient allegations in the notices of opposition and petitions for cancellation,

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<sup>12</sup> An inexplicable statement, given SIXTEEN YEARS of litigation.

and defendant itself 'believes that its denial of [plaintiff's] priority and likelihood of confusion claims in the prior Answers filed in these proceedings are sufficient to place the burden on [plaintiff] to establish prior use and ownership of a protectable mark.'" Board Order p. 6, quoting, Defendant's Motion for Leave to Amend at p. 2 n.2.

Indeed, in its original answer defendant denied plaintiff's allegations pertaining to any trademark rights in the asserted VALENTINO marks. Further, because plaintiff is asserting common law rights, plaintiff has the burden to establish those rights, and part of that burden necessarily includes establishing that the asserted mark is distinctive, either inherently or through the acquisition of secondary meaning. This is not an exact science. In some cases, it may simply be obvious that the mark, on its face, is inherently distinctive and the record at trial does not contradict such a finding. On the other hand, it may not be so obvious and the record may bring into question whether the mark is, in fact, inherently distinctive. We observe that plaintiffs relying on common law rights, in general, often overlook this element of proof as they shoulder the burden of going forward.

This case presents a circumstance where the plaintiff may have thought this was an obvious type of situation inasmuch as, at least in its case, the mark is a given name

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and not a surname, and as such was not on notice that such a defense would be attempted at trial. Moreover, the Board order did not disabuse plaintiff of this assumption. In any event, we first find that VALENTINO GARAVANI is obviously not primarily merely a surname, and, as a personal name, is considered to be inherently distinctive in proceedings before the Board. *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823 (TTAB 2009). Second, we find that this record does not establish that VALENTINO is primarily merely a surname. Plaintiff's marks are derived from a designer's *first* name. In addition, the record includes some examples of third-party uses of VALENTINO as a first name (e.g., Valentino Rossi and Valentino Orlandi). This case presents the inverse of *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004), where by virtue of exposure to a public official with the surname Rogan, the Board concluded that while the name may be rare when viewed in terms of frequency of use as a surname in the general population, [it is] not at all rare when viewed as a name repeated in the media and in terms of public perception." Here, by virtue of exposure to a known designer with the first name of VALENTINO, it is, at a minimum, not *primarily merely* a surname.

Finally, even if VALENTINO is primarily merely a surname, this record, discussed *infra*, establishes that the mark VALENTINO acquired distinctiveness in connection with

clothing, handbags, footwear and accessory items prior to defendant's constructive use date in 1991.<sup>13</sup>

Plaintiff currently uses the marks VALENTINO and VALENTINO GARAVANI in the United States on a variety of clothing items, handbags, footwear, accessories and in connection with retail stores for these goods. See, e.g., Pappagallo Test. pp. 16-21. In support of its assertion of priority, plaintiff presented the testimony of two witnesses and submitted a variety of printed publications. Plaintiff has not provided any business records concerning actual sales (e.g., invoices, revenue compilations) or advertising

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<sup>13</sup> Defendant points to a third-party's use of the mark VALENTINO and argues that plaintiff's use has not been substantially exclusive and, therefore, its mark could not have acquired distinctiveness. Defendant references the unpublished case *Gus Sclafani Corp. v. Violet Packing Co.*, Opposition No. 91106710, Slip Op. (TTAB January 17, 2002), where both parties used the name SCLAFANI in connection with food items. There the Board held that "opposer's claim must be dismissed due to opposer's failure to prove an element of its claim, that is, that it has priority of acquired distinctiveness. Further, given applicant's contemporaneous use, opposer's use has not been 'substantially exclusive' such that acquired distinctiveness has been established at any time." The facts concerning the parties' contemporaneous use in that case even included the opposer selling the applicant's "SCLAFANI brand spaghetti sauce in applicant's cans to opposer's institutional customers." The facts in this case are quite different. First, plaintiff's predecessor and Mario Valentino did not market each other's goods. Second, plaintiff's predecessor entered into a settlement agreement with Mario Valentino that delineated the manner of use and channels of trade in order to avoid confusion. Thus, we cannot find that based on the concurrent use of the VALENTINO marks in their specific trade channels and used on their specific goods that plaintiff and its predecessor's use was not substantially exclusive. To find otherwise would certainly discourage parties from entering into settlement agreements.

expenditures.<sup>14</sup> Plaintiff lost all documentary evidence pertaining to prior sales and advertising in the United States in 2002 when the Valentino companies (the grandparent and all issue) were merged into yet another company. Pappagallo Test. p. 12. Thus, we turn to plaintiff's testimony and other evidence of prior use.

Ms. Andrioli testifies that plaintiff and its predecessor were the exclusive licensees of Valentino S.p.A. (and its predecessors), the owner of the registrations, to use the marks in the United States. See, e.g. Andrioli Test. pp. 19-20. Throughout her testimony she testifies that plaintiff's predecessor was the first to use the VALENTINO marks in the United States, beginning in 1960. See, e.g., pp. 18, 30-31. In particular, she testifies that plaintiff's predecessor used the mark VALENTINO in connection with various clothing items in 1960, p. 32, with men's clothing in 1968, p. 34, and with retail store services in 1970, p. 34. She testifies that the mark VALENTINO appeared on tags and labels, p. 35. She also testifies that plaintiff's predecessor first used the mark VALENTINO GARAVANI in connection with handbags, belts and shoes in 1983, p. 40.

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<sup>14</sup> Mr. Pappagallo did not know if the 1989 media plans attached as an exhibit to his testimony had actually been implemented.

The testimony of a single witness may be sufficient to prove priority but should not be "characterized by contradictions, inconsistencies, and indefiniteness but should carry with it conviction of its accuracy and applicability." B. R. Baker, 66 USPQ at 236. See also *Powermatics, Inc. v. Glebe Roofing Products Co.*, 341 F.2d 127, 144 USPQ 430 (CCPA 1965). However, where "the oral testimony of a single witness, testifying long after the events happened, is relied upon to prove priority, such testimony, while entitled to consideration, should be most carefully scrutinized; and if it does not carry conviction of its accuracy and applicability, it should not be permitted to thus successfully attack the presumed validity of a registered trade mark." *Id.*

Ms. Andrioli's testimony is not characterized by "contradictions and inconsistencies." She clearly testifies that the marks VALENTINO and VALENTINO GARAVANI were used in connection with the sale of various clothing items, handbags, footwear and accessory items in the United States and plaintiff's predecessor, Valentino Couture Inc., was the entity that used the marks in connection with the sale of such goods.

Defendant argues that Ms. Andrioli lacks personal knowledge to testify about the use of the VALENTINO marks prior to her employment with plaintiff's grandparent company

in 2006. Defendant asserts that Ms. Andrioli's reference to the parent company's registrations is the sole basis for her testimony regarding plaintiff's use of the trademarks in the United States, which would be hearsay.<sup>15</sup> However, reviewing the testimony she is merely using these registrations to refresh her knowledge derived from her position as Director of Legal and Corporate Affairs in the overarching company. Under Fed. R. Evid. 602 "evidence to prove personal knowledge may, but need not, consist of the witness' own testimony." Thus, while reliance on documents that do not satisfy the business records hearsay exception under Fed. R. Evid. 803(6) is not sufficient, a defendant's own testimony may suffice. As she testified, she is Director of Legal and Corporate Affairs of the grandparent company and as such "is informed about what happens" in legal matters concerning the company. Rebuttal Test. p. 84.

She further testifies as follows:

Question 49. State whether or not you are familiar with how the trademarks pled by Petitioner/Opposer in these proceedings are and have been used in the United States.

Answer. Yes I am.

Question 50. ...state the date on which goods and/or services bearing the marks VALENTINO and valentino were first sold in the United States by the company by which you are employed or any related entity.

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<sup>15</sup> Although the registrations are of record as third-party registrations, the allegations in the registrations, e.g., dates of first use, do not constitute evidence; they must be established by competent evidence at trial. TBMP Section 704.04 (2d ed. rev. 2004).

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Answer. Okay, is 1960.

Question 51. Identify the entity that first used the marks VALENTINO and valentino in the United States.

Answer. It's Valentino Couture, Inc.

Andrioli Test. pp. 30-31

Question No. 86: State whether or not you are familiar with the historic advertising procedures for the goods/services bearing the trademarks pled by Petitioner/Opposer in these proceedings in the United States.

Answer: Yes, I am.

Andrioli Test. p. 50

Cross Examination Question 27. You will agree that the entity that first used the mark VALENTINO in the United states was not Valentino S.p.A. or one of its predecessors in interest, correct?

Answer. It's a little bit complex. What I know is that Valentino Couture, and not Valentino S.p.A., used the mark in the United States.

Andrioli Test. pp. 60-61.

Defendant also objects to much of the testimony regarding the dates of first use on the basis that it is vague inasmuch as some of the questions use the phrasing "by the company by which you are employed or any related entity." While that particular question is indeterminate, when the testimony is read as a whole it is clear by her specific testimony that the first user is plaintiff's predecessor, Valentino Couture, Inc., as noted above, and the testimony that it was the exclusive licensee to use the mark in the United States, also noted above, which effectively eliminates use by another "related entity."

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Further, we must take her testimony within the context of the entire record. In addition to the testimony, the record includes, inter alia, copies of magazine advertising from 1970 (Harper's Bazaar, Exh. No. C181) to 1990 Town & Country Exh. No. F56) and even, in one case, up to 2000 (Town & Country, Exh. No. F55). In addition to the marks VALENTINO and VALENTINO GARAVANI, some of the advertisements include a reference to "Valentino Couture." See Elle Exh. No. F18). The record also contains countless articles from numerous nationally distributed publications (New York Times, Vogue, Vanity Fair, Newsweek, Christian Science Monitor, Detroit Free Press, etc.) dating as far back as 1962 (Exh. No. C256) referencing Valentino and the Valentino fashion collections. In addition, the record contains several books written about the namesake, the designer Valentino Garavani, and testimony regarding awards he received from the fashion industry, including prior to 1991. Pappagallo Test. p. 46. These are from printed publications and are self authenticating, i.e., are properly submitted under a notice of reliance; although, the statements therein are hearsay and they are not evidence that goods were sold under the mark.

Finally, we note that even defendant's witness testifies that plaintiff and its predecessor have sold products in the United States and that plaintiff's

predecessor and a third party, Mario Valentino, have sold and advertised products in the same channels of trade. See, e.g., Norris Test. pp. 21-25. While this testimony is not specific as to the time period of overlapping sales, defendant presented testimony and evidence of Mario Valentino's use of his marks prior to 1991. In addition, defendant relies on the 1979 agreement between Mario Valentino and plaintiff's predecessor, which implies that each party is selling products in the United States under a Valentino mark.

Notwithstanding the limitations of plaintiff's evidence, the inescapable conclusion from the testimony, the magazine advertisements over three decades, and books dedicated to a designer and his fashions, is that plaintiff's predecessor began selling clothing under the VALENTINO mark sometime in the 1960's and later extended its line to bags, footwear and accessory items; it is simply not reasonable to conclude that a company continued to advertise in nationally distributed magazines for decades and entered into a consent to use agreement despite making no sales.

Where a record consists of many different pieces of evidence we must be cognizant of guidance from the Court of Appeals for the Federal Circuit:

[W]hether a particular piece of evidence by itself establishes prior use is not necessarily dispositive as to whether a party has established prior use by a preponderance. Rather, one should

look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use. The TTAB failed to appreciate this. Instead, the TTAB dissected the evidence to the point that it refused to recognize, or at least it overlooked, the clear interrelationships existing between the several pieces of evidence submitted. When each piece of evidence is considered in light of the rest of the evidence, rather than individually, the evidence as a whole establishes by a preponderance that West used the 'FAST EDDIE'S' mark prior to Jet's admitted first use of the mark.

West Florida Seafood Inc. v. Jet Restaurants Inc., 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994).

Thus, keeping in mind both defendant's objections based on hearsay and lack of personal knowledge and our task to view the record as a whole, we find that the record establishes that plaintiff's predecessor-in-interest first sold, under the mark VALENTINO, coats, dresses, gloves, and stockings, at least as early as 1970 (see Exh. Nos. C178-182, C347); knitwear, at least as early as 1983, (see Exh. No. C352, F70); and, under the mark VALENTINO GARAVANI, handbags, shoes and belts, at least as early as 1989 (see Exh. Nos. F36 and F37 advertisements in the September 1989 edition of Miss Vogue showing Valentino Garavani and Made in Valentino and Exh. No. F19 advertisements in a 1990 edition of Elle Magazine showing Valentino Garavani and Made in Valentino with bags). We add that these findings conservatively use the date for which there is an example of advertising which supports the testimony regarding use.

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Therefore, although the testimony may include earlier dates of first use and a broader array of goods, we have confined our findings to dates and goods for which there are examples of advertising in the record. In view thereof, plaintiff has established priority of use as to both marks VALENTINO and VALENTINO GARAVANI.

#### **LIKELIHOOD OF CONFUSION**

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

The parties have presented evidence and argument on the factors of the similarity of the marks, the relatedness of the goods, channels of trade, classes of purchasers, the fame or strength of plaintiff's marks, and actual confusion.

We begin with the factor of fame because fame "plays a 'dominant' role in the process of balancing the du Pont factors." *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). "[T]he fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Bose Corp. v. QSC*

Audio Products, Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002).

In support of its assertion of fame, plaintiff submitted several printed publications showing use of the VALENTINO marks in magazine advertising, mentioned in the press and books about the designer and namesake Valentino Garavani, along with testimony about various awards bestowed on Mr. Garavani. We note that sixteen years have passed since the filing of the first of these consolidated proceedings and nineteen years since the filing date of the involved applications and registrations; yet, plaintiff limited its evidence to the time period preceding 1991. Despite the evidentiary problem that plaintiff faced, i.e., no sales or advertising documents, prior to 2002, plaintiff did not provide evidence of sales or advertising expenditures after that date. Plaintiff explains the reason they did not provide any evidence of the fame of its marks post-1991 was because it believed its "burden is to show that its marks were strong as of [defendant's] priority date." Reply Br. p. 13. Plaintiff relies on *McCormick & Co. v. Summers*, 354 USPQ 668 (CCPA 1966) in support of this position. However, that case concerns the timing for an applicant to establish acquired distinctiveness. The Board generally accepts and considers evidence related to likelihood of confusion for the period up to the time of

trial, and this includes evidence of the fame of a plaintiff's mark. This is distinct from a claim of dilution under Section 43(c) of the Trademark Act where an element of the claim is the acquisition of fame prior to the defendant's first use or application filing date. Thus, while whether, at a time previous to this proceeding, plaintiff's VALENTINO marks were famous is indeed a fact which would be relevant to the issue of likelihood of confusion, plaintiff should nonetheless demonstrate with respect to the asserted fame of its marks that the marks are or continue to be famous as of the closing of the trial phase of this proceeding. Fame comes and goes, we must make a determination as to whether likelihood of confusion exists today, not only sometime in the distant past. In any event, this record does not support a finding of fame even prior to 1991.

Generally, we look to the volume of sales and advertising expenditures over time and within the context of market share and manner of consumer exposure in order to make a determination regarding fame. Here, plaintiff did not provide any sales figures and the testimony and documentary evidence of an advertising plan for one year has very little probative value and is woefully inadequate to find fame. However, plaintiff's marks appear to have some strength in connection with clothing, bags, footwear and

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accessories, based on decades of, at least, magazine advertisements and frequent references in the press, exposing relevant consumers to these marks and in connection with celebrities such as Jackie Kennedy Onassis. In addition, plaintiff's namesake, Valentino Garavani, has received substantial recognition over the years as evidenced by the numerous awards given to him by organizations in the fashion industry and by being the subject of numerous books about his career in and impact on the fashion industry. However, "[b]ecause of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it." *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901 (TTAB 2007). Given the lack of evidence on the extent of sales and advertising to better understand how much plaintiff's marks have penetrated the market, we find that plaintiff has not met its burden to show that it owns a famous mark. In view thereof, the strength of plaintiff's marks do not reach the level of playing "a 'dominant' role in the process of balancing the du Pont factors." *Recot*, 54 USPQ2d at 1897. See also *Packard Press Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56

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USPQ2d 1351, 1356 (Fed. Cir. 2000); and Hard Rock Cafe, 48 USPQ2d at 1409.<sup>16</sup>

This brings us then to our consideration of the similarities between plaintiff's and defendant's goods, channels of trade and classes of purchasers. We must make our determinations under these factors based on the goods as they are recited in defendant's applications and registrations. See *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 set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed."); *In re Elbaum*, 211 USPQ 636 (TTAB 1981).

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<sup>16</sup> Defendant relies in part on the Board's decision in *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811 (TTAB 2005), reversed Civil Action No. 05-2037 (JDB) (D.D.C. 2008). We note that this decision was reversed on appeal upon a motion for default judgment. However, the approach taken with respect to the factor of fame is in line with that enumerated by our primary reviewing court, the Court of Appeals for the Federal Circuit. See *Packard*, 56 USPQ2d 1351, 1356 ("That the fame factor is based on underlying factfinding dictates that relevant evidence must be submitted in support of a request for treatment under the fame factor. This responsibility to create a factual record is heightened under the more deferential standard that this court must apply when reviewing PTO factfinding. See *Zurko*, 527 U.S. at 165, 50 USPQ2d at 1937; *Gartside*, 203 F.3d at 1315, 53 USPQ2d at 1775.")

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As noted above, the record shows that plaintiff uses the mark VALENTINO with coats, dresses, gloves, stockings, and knitwear. Defendant's Application Serial No. 74188334 and Registration No. 2103658 contain "coats," "sweaters," and "hosiery" in the identification of goods; therefore, for purposes of our analysis, the goods in International Class 25 in defendant's Application Serial No. 74188334 and Registration No. 2103658 are, at least in part, identical. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981) (it is sufficient for a determination of likelihood of confusion if the relatedness is established for any item encompassed by the identification of goods in the application). The record also shows that plaintiff uses the mark VALENTINO GARAVANI in connection with shoes, handbags and belts. Defendant's Application Serial No. 74188331 and Registration No. 2130804 include "handbags" and "purses" in the identification of goods, therefore, for purposes of our analysis, the goods in International Class 18 in defendant's Application Serial No. 74188331 and Registration No. 2130804, are, at least in part, identical. *Id.* Further, we find that the "shoulder belts" in Application Serial No. 74188331 are complementary to and, as such, commercially related to, at a minimum, plaintiff's belts.

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With regard to the channels of trade and classes of purchasers, we must consider any ordinary channel of trade and class of purchaser for defendant's goods, in view of the lack of any such limitations in its identifications. Thus, defendant's trade channels include all types of stores, from high-end fashion boutiques and department stores to discount retailers, and defendant's classes of purchaser range from the more discriminating purchaser to the general consumer. With regard to plaintiff, the record shows that plaintiff sells in the high end of the market and specializes in luxury goods. See, e.g., Pappagallo Test. pp. 19-20. Plaintiff also sells in the "luxury wing" of outlet malls. Pappagallo Test. pp. 16, 17, 21, 65 and 66. In addition, Plaintiff describes its consumers as "very high end consumer, sophisticated, with pretty high disposable income [and] aspiration customers, still very sophisticated; they want to buy luxury goods but have less disposable income." Pappagallo Test. p. 23. Thus, the overlap in trade channels and possible customers is limited to the higher end of the market.

In view of the above, we find that, at least some of the goods in each class of defendant's applications and

registrations are identical or otherwise related and the parties' trade channels and customers overlap.<sup>17</sup>

We turn next to consider the marks. At the outset of this consideration, it is noted that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 32 USPQ2d 1698 (Fed. Cir. 1992).

With respect to the involved marks, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under the respective marks is likely to result.

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<sup>17</sup> Defendant's arguments that the parties do not sell their respective goods in the exact same stores is not persuasive, inasmuch as we must consider all ordinary channels in regards to defendant's sales and the fact that they are sold in different high end department stores does not obviate a finding that the channels of trade overlap.

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With regard to plaintiff's mark VALENTINO, defendant's marks GIOVANNI VALENTINO and GIANNI VALENTINO incorporate plaintiff's mark in its entirety. Those consumers not familiar with Valentino Garavani's full name would likely believe Giovanni Valentino is referring to Valentino, not knowing his full name is Valentino Garavani, and thus would be confused as to the source of the goods. We realize that plaintiff has only established use in the high end of the market, from couture to more high end stores such as Saks and Bergdorf Goodman. However, even in this market consumers may not be familiar with Valentino's full name. The record shows that plaintiff has emphasized Valentino over Garavani in its marketing of its goods and the designer himself, plaintiff's namesake, is repeatedly referred to simply as Valentino. Moreover, consumers in the lower end of the clothing market have nonetheless been exposed to plaintiff's mark VALENTINO through magazine advertisements, in the press, and in outlet malls. Because defendant's applications and registrations are not restricted by trade channels, we must consider consumers in the lower end of the market, who are even less likely to know Valentino's full name; and even though the record does not establish an actual overlap in this trade channel, the consumers in this trade channel may likely believe GIOVANNI VALENTINO and

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GIANNI VALENTINO are an extension of the brand into a different market sector for VALENTINO.<sup>18</sup>

With regard to defendant's marks we cannot say that one element dominates over another but rather the full name will be taken as a whole. That being said, defendant's marks are in typed form and we must consider all possible presentations of those marks including uses that would emphasize the VALENTINO portion over the GIOVANNI or GIANNI portion, by, for example, displaying them in drastically different sizes:

giovanni  
**VALENTINO**

One of defendant's tags attached to its products illustrates the danger of emphasizing the VALENTINO portion of the mark in terms of heightening the likelihood of confusion.

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<sup>18</sup> We note that even if we do not consider the lower end of the market, we would arrive at the same final determination.

**GIOVANNI VALENTINO**  
MADE IN ITALY

All over the world the name VALENTINO is synonymous of style and quality, thanks to the geniality and dedication of three generations of the VALENTINO family. The family's success story began when Vincenzo Valentino, Giovanni's grandfather, established the first VALENTINO Design House in the year 1908. The great talent of this Italian designer was soon recognised by the international 'jet set' and his creations fast became the aspiration of a world-wide clientele. Giovanni's father, Mario, eagerly followed in his father's footsteps, designing collections that won the acclaims of the press and public in the fashion shows of Rome, Milan and Paris.

Today, this unique and prestigious heritage is personified in GIOVANNI VALENTINO, a designer who combines the most innovative creativity with the highest standards of skilled workmanship, successfully upholding and indeed enhancing his family's illustrious tradition.

Every GIOVANNI VALENTINO product is an example of exclusive design and fine quality and carries a Certificate of Guarantee to assure its authenticity and your satisfaction.

Norris Test. p. 51 Exh. No. 7.

The text reads, "All over the world the name VALENTINO is synonymous of style and quality, thanks to the geniality and dedication of three generations of the VALENTINO family, etc." We recognize that the tag includes the full name in the same size font, however, when the last name is emphasized through capitalization and bold font, it increases the likelihood of confusion.

Consumers, when presented with identical goods under the respective marks VALENTINO and GIOVANNI VALENTINO or GIANNI VALENTINO, are likely to perceive these two marks as the same name with one being the shortened form of the other. The similarity occasioned by the name VALENTINO occurring in both marks has particular weight in the clothing and accessories industry where it is common for

designers to shorten their name marks.<sup>19</sup> Defendant argues that it is also common for designers with the same surname to coexist in the marketplace and the register (e.g., CALVIN KLEIN and ANNE KLEIN) and consumers are accustomed to distinguishing between designers with identical surnames. However, all of defendant's examples include the entire name of the respective designers and are not as similar to each other as the marks present in this case. Further, as plaintiff notes, defendant "is asking the Board to make a number of assumptions of the facts regarding the named third-party designers. For example, there is no evidence in the record of any of the designers' level of sales or geographic scope, or even if any of the listed third-parties are engaged in any type of negotiations over their respective brands." Rebuttal Br. p. 17.

We conclude that the points of similarities in sound, appearance and connotation outweigh the dissimilarities, and

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<sup>19</sup> Several cases have commented on the propensity in the fashion industry to shorten names. See *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) ("the Board has previously recognized the practice in the fashion industry of referring to surnames alone"); *Marshall Field & Co.* ("companies are frequently called by shortened names, such as Penney's for J.C. Penney's, Sears for Sears and Roebuck..., Ward's for Montgomery Ward's, and Bloomies for Bloomingdale's"); *Big M. Inc. v. United States Shoe Corp.*, 228 USPQ 614, 616 (TTAB 1985) ("[W]e cannot ignore the propensity of consumers to often shorten trademarks and, in the present case, this would be accomplished by dropping the 'T.H.' [in T.H. MANDY] in referring to registrant's stores"); and *Polo Fashions, Inc. v. La Loren, Inc.*, 224 USPQ 509, 512 (TTAB 1984) ("Lauren" is a shorthand term for Ralph Lauren).

the marks VALENTINO and GIOVANNI VALENTINO and GIANNI VALENTINO have the same overall commercial impressions.

With regard to plaintiff's mark VALENTINO GARAVANI we also conclude that the marks are confusingly similar in sound, appearance, connotation and overall commercial impression. Plaintiff emphasizes the VALENTINO portion its mark, and, as noted above, we must consider displays of defendant's marks that emphasize the VALENTINO portion. Further, the second name in each of the marks begins with a G and ends with an I. Thus, despite the difference in the actual name, consumers are likely to focus on the VALENTINO portion of the marks and, again, not remember that it is GARAVANI, not GIOVANNI or GIANNI, when confronted with defendant's marks. Thus, we conclude that the marks VALENTINO GARAVANI and GIOVANNI VALENTINO and GIANNI VALENTINO are similar in terms of sound, appearance, connotation and commercial impression.<sup>20</sup>

The sixth du Pont factor requires consideration of any evidence pertaining to "the number and nature of similar

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<sup>20</sup> Defendant's reliance on an unpublished decision from 1987 is not persuasive of a different result. The decision in *Delta Shoe Corp. v. Braxton Jean, Inc.*, Opp. No. 91069956, slip op. (TTAB Aug. 31, 1987), is not binding on the Board, was based on a different record and presents different facts. For example, as noted by defendant the Board in Delta "noted that there was no evidence that prospective purchasers would overlook" the other components NINO and RUDOLFO in their marks. Def. Br. p. 43. Here, we have evidence of record where plaintiff's and defendant's use emphasizes the VALENTINO portion of the marks. Moreover, the full name marks here, VALENTINO GARAVANI and

marks in use on similar goods." "The probative value of the third-party trademarks evidence depends entirely upon their usage." Palm Bay, 73 USPQ2d at 1673 "As this Court has previously recognized, where the 'record includes no evidence about the extent of [third-party] uses...[t]he probative value of this evidence is thus minimal.'" Id. at 1693 quoting Han Beauty, Inc. v. Alberto-Culver CO., 236 F.3d 1333, 1338 (Fed. Cir. 2001).

Defendant argues that plaintiff's "names and marks have been even further weakened by the widespread use, promotion and sales of the same or similar goods under third-party VALENTINO-formative marks in the marketplace for the same or similar goods." Def. Br. p. 37. In particular, defendant argues that "Mario Valentino's VALENTINO and MARIO VALENTINO name and mark have coexisted with [plaintiff's] VALENTINO and VALENTINO GARAVANI name and mark in the marketplace for 50+ years. During this time, Mario Valentino and [plaintiff] have sold their identical products in the same stores, advertised their products in the same magazines and newspapers, and received unsolicited publicity from the identical media outlets, often in not only the same issue of a publication, but within the same article. Moreover, by way of a coexistence agreement, Mario Valentino and [plaintiff] have expressly approved and consented to each

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GIOVANNI/GIANNI VALENTINO have more points of similarity than

other's respective uses of the VALENTINO, MARIO VALENTINO, and VALENTINO GARAVANI marks, as sufficient to avoid any likelihood of confusion." Def. Br. pp. 37-38. Defendant also points to five other third-party uses of the name Valentino in connection with clothing, handbags and footwear (SERENDIPTIY VALENTINO, F by FORTUNA VALENTINO,<sup>21</sup> CARLO VALENTINO, VALENTINO ORLANDI and VALENTINO ROSSI).

Defendant's evidence of third-party use consists of webpages from a variety of websites where one or more of the third parties offers a product for sale under a VALENTINO-formative mark, including one where VALENTINO GARAVANI also appears for handbags. In addition, defendant points to examples where these third parties are featured in the same publications as plaintiff. Several of these examples are from trade press, e.g., "Women's Wear Daily," and have little probative value as to consumer perception.

Overall, we find that this evidence is not sufficient to establish that consumers "have learned to distinguish between and among designers using the VALENTINO name based on other differences" or that the "PTO's decision to register so many VALENTINO-formative marks for identical or closely related leather goods and clothing likewise shows that the addition of other terms to the common VALENTINO

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NINO VALENTINO and RUDOLFO VALENTINO.

element more than suffices to distinguish the marks and avoid a likelihood of confusion." Def. Br. pp. 38-39. We further note the five VALENTINO registrations include defendant's registrations and Mario Valentino's registration for which a consent agreement was concluded.

Although we have given some weight to the evidence of third-party use, the weight is limited given the absence of any corroborating facts bearing on the extent of such use. There are no specifics regarding the sales or promotional efforts surrounding the third-party marks. Thus, we are unable to conclude that consumers have become conditioned to recognize that several other entities use the mark VALENTINO for clothing or accessory items such that they are conditioned to look for other elements to distinguish the marks. *Carl Karcher Enterprises Inc. v. Stars Restaurant Corp.*, 35 USPQ2d 1125, 1130-31 (TTAB 1995) ("The Board has in the past given weight to evidence of widespread and significant use by third parties of marks containing elements in common with the mark being opposed on grounds of likelihood of confusion to demonstrate that confusion is not, in reality, likely to occur in the marketplace. The justification is, of course, that the presence in marks of common elements extensively used by others unrelated as to

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<sup>21</sup> Fortuna is Mario Valentino's daughter. See *Norris Test*. p. 168. Plaintiff has a pending action against Fortuna Valentino. *Andrioli Test*. p. 107.

source may cause purchasers not to rely upon such elements as source indicators, but to look to other elements as a means of distinguishing the source of the goods/services. By relying on the third-party star marks in the restaurant field, applicant would have us conclude that small variations in the star marks used in the field, including opposer's and applicant's marks, are sufficient to avoid confusion... We have no problem concluding that opposer's marks are strong, even in the face of applicant's evidence. ...We see some other problems which limit the probative value of the evidence of third-party use. Many of the marks being used are less similar to opposer's marks than are applicant's marks. Further, applicant has not furnished any evidence regarding the extent of use of the marks by these third parties...In sum the evidence of third-party use is of limited probative value to support applicant's position." (citations omitted).) See also Kohler, 82 USPQ at 1112.

Similarly, here, some of the third-party marks are not as similar and there is insufficient evidence regarding the extent of the third-party use.

The third-party registrations which include the term VALENTINO are not evidence of what happens in the marketplace or that the purchasing public is familiar with the use of the marks which are the subjects thereof and has therefore learned to distinguish those marks by the

differences therein. See National Aeronautics & Space Administration v. Record Chemical Co., 185 USPQ 563, 567 (TTAB 1975). These registrations do not show that they are being used and provide no information as to the extent of any possible use such that customers have become accustomed to encountering the marks in the marketplace. See AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). See also Olde Tyme Foods, v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992).

Finally, the references in the press to other "Valentino's" are primarily to Mario Valentino, in particular when mention is made of both plaintiff and Mario Valentino. As we know from the record, plaintiff's family of companies has an agreement with the Mario Valentino company which outlines specific ways in which they avoid confusion.

Defendant argues that the relevant consumers in this case are sophisticated purchasers of expensive luxury items. However, there is no evidence of record to support a finding that the more disposable income an individual consumer has the more discerning that person is in their purchasing decision. This is not a situation that involves intricate equipment requiring that a buyer have a specialized knowledge or skill and engage in an involved procurement process. See Electronic Design & Sales Inc. v. Electronic

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Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992) ("The record confirms that opposer's services are expensive and are purchased only by experienced corporate officials after significant study and contractual negotiation. Applicant submitted deposition testimony from three experienced purchases of battery chargers and power supplies in the OEM market which demonstrates that the evaluation process used in selecting applicant's products requires significant knowledge and scrutiny.")

Defendant also argues that "[d]espite decades of concurrent use by the parties, both parties admit that there is no evidence of actual confusion." Def. Br. p. 41. The lack of evidence of actual confusion does not carry much weight based on this record. While there is evidence that defendant has sold products in the United States, at least, under the mark GIOVANNI VALENTINO, the record does not show that these sales have been extensive or in overlapping trade channels such that there has been a meaningful opportunity for confusion to occur. With regard to defendant's reliance on the co-existence and overlapping sales of related goods under the mark MARIO VALENTINO, a third-party's mark, plaintiff and its related companies have a consent arrangement with that particular company, in which the parties have agreed to take steps to avoid confusion. Finally, statements made in the prosecution of trademark

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applications, were not by plaintiff but rather its parent company, and, moreover, it is not unusual for a party to take a different position in a later action. In addition, the marks against which plaintiff's parent was arguing were not as similar as those involved in this case, ANDRE VALENTINO and OSCAR VALENTINO.<sup>22</sup>

Based on this record there have not been meaningful opportunities for confusion to occur between the marks in issue and we find this factor to be neutral in our analysis.

Finally, plaintiff asserts that defendant adopted its marks in bad faith. There is nothing in the record to even infer bad faith, and, in fact, defendant's marks are simply the name of the designer behind the brand. Accordingly, we find no bad faith in defendant's adoption of its marks.

We have carefully considered all of the evidence pertaining to the relevant du Pont factors, as well as the parties' arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion). In balancing the relevant factors, we conclude that because defendant's marks GIOVANNI VALENTINO and GIANNI VALENTINO are similar to plaintiff's marks VALENTINO and VALENTINO GARAVANI, the goods are identical, in part, and otherwise closely related, and there is an overlap in the

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<sup>22</sup> As plaintiff notes, the registrations for these two marks have since been cancelled. Exh. Nos. H3 and H5 (Pl. N.O.R. (August 6, 2009))

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channels of trade and the classes of purchasers, there is a likelihood of confusion. Further, plaintiff has established priority of use. In view thereof, plaintiff has proven its claim under Section 2(d) of the Trademark Act. Finally, to the extent we have any doubt we resolve it, as we must, in favor of the prior user. See *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 USPQ2d 1001, 1003 (Fed. Cir. 2002); *Hard Rock Cafe*, 56 USPQ2d at 1514 and *W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308, 311 (TTAB 1976).

**Decision:** The oppositions are sustained and the petitions to cancel are granted on the respective claims under Section 2(d) of the Trademark Act.