

TTAB

AKIN GUMP
STRAUSS HAUER & FELD LLP

Attorneys at Law

JOHN M. CONE
214-969-4214/Fax: (214) 969-4343
jccone@akingump.com

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VIA EXPRESS MAIL

Assistant Commissioner for Trademarks
BOX TTAB – NO FEE
2900 Crystal Drive
Arlington, VA 22202-3513



08-08-2005

U.S. Patent & TMO/TM Mail Rcpt Dt: #11

Re: *The Wet Seal, Inc. v. FD Management, Inc.*; Opposition No. 91157022
Re U.S. Trademark Application No. 76/372,550 ARDENBEAUTY
Our Reference No.: 031458.0026

Dear Sirs:

Enclosed for filing in triplicate is Opposer's Trial Brief.

Regards,

John M. Cone

Enclosure

cc: Joseph Dreitler

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application No. 76/372,550 ARDENBEAUTY.

THE WET SEAL, INC.,

Opposer,

v.

FD MANAGEMENT, INC.,

Applicant

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Opposition No. 91157022



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OPPOSER'S TRIAL BRIEF

John M. Cone
Cara Foos Pierce
AKIN GUMP STRAUSS HAUER & FELD LLP
1700 Pacific Avenue, Suite 4100
Dallas, Texas 75201-4675
Telephone: (214) 969-4214
Facsimile: (214) 969-4343
trademarkdallas@akingump.com

ATTORNEYS FOR OPPOSER
THE WET SEAL, INC.

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Opposition No. 91157022

OPPOSER'S TRIAL BRIEF

TO THE HONORABLE UNITED STATES TRADEMARK TRIAL AND APPEAL BOARD:

Opposer, The Wet Seal, Inc., d/b/a Arden B ("Arden B" or "Opposer"), in support of its Opposition No. 91157022 to U.S. Trademark Application No. 76/372,550 (the "Application") of FD Management, Inc. ("FD" or "Applicant") for the mark ARDENBEAUTY, would respectfully show the Board as follows.

I. RECORD EVIDENCE

The evidence of record consists of:

- (1) U.S. Application No. 76/372,550 ARDENBEAUTY (the "Application").
- (2) Trial testimony of Laura Nicholas on behalf of Arden B ("Nicholas Dep.").
- (3) Trial testimony of James Perry on behalf of FD ("Perry Dep.").
- (4) Trial testimony of Ronald Rolleston on behalf of FD ("Rolleston Dep.").
- (5) Arden B's Notice of Reliance Pursuant to 37 C.F.R. § 2.122(e) dated February 24, 2005, which includes the Declaration of Vicki Martin and attachments, and the Declaration of Patrick Dredden and attached business records produced in this action ("2/24/05 Notice").

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- (6) Arden B's Notice of Reliance Under Rule 2.122(e) and attachments dated June 9, 2005 ("6/9/05 Notice").
- (7) FD's Notice of Reliance Under 2.122(d) and attachments dated 3/30/05 ("3/30/05 Notice").
- (8) FD's Notice of Reliance Under Rule 2.122(e) dated 4/8/05 and attachments ("4/8/05 Notice").

II. STATEMENT OF THE ISSUES

1. Whether Arden B's extensive use of the ARDEN B trademark and trade name since 1997 established common law rights in the ARDEN B mark prior to the application date of the ARDENBEAUTY Application, and if so, whether use of ARDENBEAUTY for the goods of the Application is likely to cause confusion, or to cause mistake, or to deceive.

2. Whether Applicant's admitted lack of intention to use the mark applied for on some of the goods of the Application renders the Application void *ab initio*.

III. SUMMARY OF ARGUMENTS

Opposer established common law rights in ARDEN B, an inherently distinctive term, by using it as a trade name and service mark for its retail stores and as a trademark for women's clothes and accessories sold in those stores. These rights were established before Applicant filed the opposed intent-to-use application for ARDENBEAUTY for, *inter alia*, cosmetics. The purchasing public for Applicant's ARDENBEAUTY goods are the same people who shop at Opposer's ARDEN B stores and buy ARDEN B clothes and accessories. Those customers are aware that many brand owners use the same mark for both clothing and cosmetics. The two marks ARDEN B and ARDENBEAUTY are substantially identical and, given the nature of the goods and services for which they are used, create the same commercial impression as to source. "BEAUTY" has little or no distinctive character when used in relation to cosmetics, so the dominant portion of both marks is "ARDEN." The word "beauty," moreover, is likely to be

considered by those customers as an expansion of the letter B, adapting the brand ARDEN B for use on beauty products, but still indicating the same source. Use of ARDENBEAUTY for the goods of the opposed Application is likely to cause confusion or to cause mistake or to deceive. Therefore, the application should be denied under Section 2(d) of the Lanham Act. 15 U.S.C. § 1052(d).

In addition, Applicant admitted during its trial testimony that at the time it filed the Application it had no intention of using the mark ARDENBEAUTY on at least some of the goods for which it sought registration of the mark. Registration of the mark should therefore also be denied under Section 1(b) of the Lanham Act. 15 U.S.C. § 1051(b).

IV. OPPOSITION BASED ON SECTION 2(d)

To prevail on this ground, Opposer must establish two things. Because Arden B relies on common law rights, it must first show that it acquired rights in the trade name and trademark ARDEN B prior to the application date of the ARDENBEAUTY Application. In addition, Arden B must show that the proposed use of ARDENBEAUTY is likely to cause confusion. *Clifton v. Plough, Inc.*, 341 F.2d 934, 144 U.S.P.Q. (BNA) 599, 600 (C.C.P.A. 1965) (to prevail in an opposition, establishing a likelihood of confusion is sufficient.).

A. Establishment Of Rights In Arden B.

ARDEN B, when used in relation to women's clothing and accessories and retail store services featuring women's clothing and accessories, is an inherently distinctive mark. It does not describe the goods or services for which it is used, and it is not barred from registration under Sections 2(a), (b), (c) or (e) of the Lanham Act. 15 U.S.C. §§ 1052(a), (b), (c) or (e). Indeed, the

mark has been accepted for registration several times without a requirement that secondary meaning be proven under Section 2(f).¹ 15 U.S.C. § 1052(f).

The evidence clearly establishes that prior to February 5, 2002, Arden B had made extensive use in commerce of ARDEN B, starting as early as 1997. (Nicholas Dep. at 14:16-19.) In September 1997, Arden B purchased labels bearing the ARDEN B mark, and clothes bearing these labels were sold as part of Opposer's Fall 1997 clothing line. (Nicholas Dep. at 15:7-25, 16:1-4.) Clothing bearing the ARDEN B mark was initially sold through several retail store chains owned by the Opposer. (Nicholas Dep. at 17:22-25.) In November 1999, Opposer opened its first ARDEN B store. (Nicholas Dep. at 23:6-16.) Subsequently, it opened additional ARDEN B stores. By February 2002, it operated eighty-four ARDEN B stores in numerous cities around the country ranging from San Francisco to New York to Miami. (Nicholas Dep. Ex. 16; *see also* Nicholas Dep. at 23:17-25.) The ARDEN B mark was prominently displayed in the stores. It was and is visible throughout the stores, both inside and out. On the exterior of the ARDEN B stores, the ARDEN B logo was and is found above the entrance door as well as on the store windows. (Nicholas Dep. at 46:8-9, Nicholas Dep. Ex. 23.) Throughout the stores' interiors, the ARDEN B mark could be found behind the wrap desk, throughout the floor fixtures, as well as on the stores' wooden hangers, shopping bags, tissue paper, stickers, and gift boxes. (Nicholas Dep. at 46:10-14; Nicholas Dep. Ex. 23.)

Since their inception, the ARDEN B stores have sold women's clothing and accessories. Most of these goods contain labels with the ARDEN B mark. These labels are used on, for example, tops, bottoms, outerwear, suits, dresses, shoes and accessories, including jewelry,

¹ *See, e.g.*, U.S. Registration No. 2,795,689 ARDEN B for "Retail apparel stores featuring women's clothing, footwear, hats and clothing accessories." (2/24/05 Notice at 1(c) WS000908-912.)

handbags, belts and hats. (Nicholas Dep. at 24:18-25, 31:8-9.) Sales figures for the ARDEN B stores from 1999 through February of 2001, showing sales for each individual store, broken down by type of product from September 2000 through January 2005, are collected in Arden B's business records at Exhibits 13 and 15 to the 2/24/05 Notice.

The ARDEN B mark has been advertised widely. Arden B featured the name and mark ARDEN B extensively in consumer publications, and the brand has been recognized and identified in editorial stories in the consumer press well before February 5, 2002, the filing date of the Application. (Nicholas Dep. at 41:22-25, 42:1-11, 43:12-25, 44:1.)

Initially, the ARDEN B mark was used in a stylized script form as follows:

A stylized script logo for "Arden B". The word "Arden" is written in a cursive, flowing script, and the letter "B" is written in a similar but more upright and bold script.

Starting in the middle of 2001, the appearance of the mark was changed to:

A block letter logo for "ARDEN B". The letters are bold, uppercase, and have a slightly spaced-out, geometric appearance.

(Nicholas Dep. at 46:19-25, 47:1-11.)

Both stylized forms are clearly recognizable as ARDEN B. The change in font did not affect the impression that the mark creates in the mind of the purchasing public. "It is settled that a person may change the display of a mark at any time because whatever rights he may possess in the mark reside in the term itself rather than in any particular form or arrangement thereof." *Humble Oil & Refining Co. v. Sekisui Chem. Co.*, 165 U.S.P.Q. (BNA) 597, 603-04 (T.T.A.B. 1970); *see also Ilco Corp. v. Ideal Security Hardware Corp.*, 527 F.2d 1221, 1224, 188 U.S.P.Q. (BNA) 485 (C.C.P.A. 1976) ("The law permits a user who changes the form of its mark to retain the benefit of its use of earlier form, without abandonment, if the new and old forms create the

same, continuing commercial impression.”). In this instance, the commercial impression that the purchasing public has and always has had of the mark is of the two words, ARDEN B, not of a particular graphic representation of the words. In any event, Opposer started using the second version of ARDEN B months before the filing of the Application.

By virtue of Opposer’s considerable advertising and use, Arden B acquired nationwide common law, use-based rights in the trade name ARDEN B and in the mark ARDEN B used for women’s clothing, accessories and retail store services featuring women’s clothing and accessories, before the filing of the Application on February 5, 2002.

B. Use Of ARDENBEAUTY For The Goods Of Application No. 76/372,550 Is Likely To Cause Confusion.

FD has applied to register ARDENBEAUTY for the following goods: fragrance products for personal use, namely, perfume, cologne, toilet water, scented body lotion and moisturizing cream, body oil, body powder, scented skin soap; cosmetics and skin care preparations, namely, foundation make-up, face powder, blusher, compacts, eye pencils, lip pencils, lipstick, lip gloss, non-medicated lip balm, mascara, eye make-up, eyeliners, skin moisturizer and skin toner; hair care products, namely, shampoo, hair conditioners, hair gel and hair spray; nail care preparations, namely, nail polish, nail strengtheners, and nail polish remover; shaving cream, shaving gel, after-shave lotion; skin soap; shower gel; deodorant; antiperspirant; potpourri; sachets; suntanning preparations; sun screen and sun block preparations.

To succeed in the opposition, Arden B is not required to show a likelihood of confusion with respect to each of the individual goods listed in the Application. Rather, the opposition will be sustained if Arden B establishes that the use of ARDENBEAUTY on any of the goods listed in the Application is likely to cause confusion. *Shunk Mfg. Co. v. Tarrant Mfg. Co.*, 318 F.2d 328, 330, 137 U.S.P.Q. (BNA) 881 (C.C.P.A. 1963) (noting “where there is any likelihood of

confusion as to any of the goods listed in the application, it is not necessary to rule on other goods listed therein”).

In addition, it is not necessary that Arden B establish that its goods are identical to, or even competitive with, Applicant’s goods to support a finding of likelihood of confusion. It is settled law that it is enough that the goods at issue “are related in some manner or that the conditions surrounding the marketing of the goods or the offering of the services are such that they would be likely to be encountered by the same persons under circumstances which would give rise, because of the marks used, to the mistaken belief that they originate from or are in some way associated with the same source.” *Super Valu Stores, Inc. v. Exxon Corp.*, 11 U.S.P.Q.2d (BNA) 1539 (T.T.A.B. 1989). The evidence establishes that potential customers of the products sold under both marks are the same, namely women, and that the products are sold and marketed through similar trade channels, namely retail stores primarily in shopping malls. (Nicholas Dep. at 24:1-22; Rolleston Dep. at 11:7-13, 81:11-22.)

In the present case, it would be improper to limit the nature or quality of the ARDENBEAUTY goods, or the channels of their distribution because there are no such limitations in the goods of the Application. The Board should presume that goods bearing the ARDENBEAUTY mark are distributed through all the customary trade channels for those goods and that they are sold to all the customary purchasers for those types of goods. *The All England Lawn Tennis Club (Wimbledon) Ltd. v. Creations Aromatiques, Inc.*, 220 U.S.P.Q. (BNA) 1069 (T.T.A.B. 1983) (when goods in application are not restricted as to trade channels, they must be presumed to travel through the normal channels of trade associated with such goods); *Olde Tyme Foods, Inc. v. Roundy’s Inc.*, 961 F.2d 200, 22 U.S.P.Q. (BNA) 1542, 1544 (Fed. Cir. 1992) (when the registrations do not place restrictions on trade channels and classes of purchasers, the

Board presumes that the goods reach all classes of purchasers through all customary trade channels).

The Board must compare ARDENBEAUTY and ARDEN B assuming that ARDENBEAUTY goods will be sold to the same customers through the same trade channels as ARDEN B goods and services, without limitations or distinctions based on the way in which the Applicant may have used ARDENBEAUTY. Thus, it would be proper for the purposes of the Section 2(d) (15 U.S.C. § 1052(d)) comparison to consider ARDENBEAUTY used in all lower case font, for all usual qualities and price ranges of the goods in the Application. In addition, the Board should consider that those goods would be sold through all the normal trade channels, that is to say, through retail stores in shopping malls, including many of the same malls in which the ARDEN B stores are located.

It is also proper to consider the mark ARDENBEAUTY as used in all different scripts or fonts because the mark is shown in the Application in block capital letters and with a typed drawing. *Fossil, Inc. v. The Fossil Group*, 49 U.S.P.Q.2d (BNA) 1451 (T.T.A.B. 1994) (noting that because the mark as depicted on the opposer's registration is in typed drawing form, the mark itself is not limited to the mark depicted in any special form, and in the likelihood of confusion analysis the Board should consider all reasonable manners in which the mark could be depicted); *see also Phillips Petroleum Co. v. C.J. Webb, Inc.*, 442 F.2d 1376, 1378, 170 U.S.P.Q. (BNA) 35 (C.C.P.A. 1971).

Additionally, the fact that Applicant may use the opposed mark in association with a house mark, for example ELIZABETH ARDEN, is not relevant to the issues in this Opposition. *The State Historical Society of Wis. v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc.*, 190 U.S.P.Q. (BNA) 25, n.3 (T.T.A.B. 1976) (the fact that applicant uses applied-for mark

CIRCUS WORLD with the house mark RINGLING BROS.-BARNUM & BAILEY is immaterial to the issue of whether a mark should be registered because only the mark applied for is relevant); *Interstate Brands Corp. & Interstate Brands West Corp. v. McKee Foods Corp.*, 53 U.S.P.Q.2d (BNA) 1910 (T.T.A.B. 2000) (fact that applicant's YO-YO snack cakes may be used with LITTLE DEBBIE house mark is not relevant to the determination of likelihood of confusion, rather the "determination of likelihood of confusion must be based on the specific marks at issue").

Likelihood of confusion is determined using the *du Pont* test,² and the Board's precedents teach that each element of that test should be considered if there is evidence as to that element in the record. If the record is devoid of evidence, the Board cannot, of course, use that element in its evaluation. The elements of the *du Pont* test are:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, *i.e.* "impulse" vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

² *In the Matter of E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. (BNA) 563 (C.C.P.A. 1973).

- (9) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark:
 - (a) a mere “consent” to register or use.
 - (b) agreement provisions designed to preclude confusion, *i.e.* limitations on continued use of the marks by each party.
 - (c) assignment of mark, application, registration and good will of the related business.
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, *i.e.*, whether *de minimis* or substantial.
- (13) Any other established fact probative of the effect of use.

Id. at 1361.

Turning now to the individual elements of the *du Pont* test:

1. **The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.**

ARDEN B and ARDENBEAUTY are very similar in their appearance, sound, connotation and commercial impression, all of which support a finding of a likelihood of confusion between the marks. In order for likelihood of confusion to be found, the marks need not be similar in all three respects. Rather, a mark will be refused registration “if the similarity in form, spelling, or sound alone is likely to cause confusion.” *E. I. du Pont de Nemours & Co. v. Sunlyra Int’l, Inc.*, 35 U.S.P.Q.2d (BNA) 1787 (T.T.A.B. 1995) (citing *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 U.S.P.Q. (BNA) 523, 526 (C.C.P.A. 1968)). In this case, the marks at issue are similar in all three respects. First, the two marks are extremely similar in appearance. Both marks contain the same first six letters, namely A-R-D-E-N and B. In

Applicant's mark "B" becomes "BEAUTY." The marks are also very similar in sound. The first part of both marks, "ARDEN," is pronounced the same way. Finally, since the ARDENBEAUTY mark is not shown in any particular form in the Application, it should be compared as if it is used in the same font as the ARDEN B mark. Therefore, the two marks are similar in spelling, sound and form.

When comparing marks, although the final analysis must consider marks in their entirety, "it is entirely proper to note that one word or feature or a mark may be the dominant or more prominent feature in the mark or may be given greater weight in determining likelihood of confusion." *Super Valu Stores, Inc.*, 11 U.S.P.Q.2d (BNA) 1539 (when comparing the two marks, TIGER MART and TIGER DISCOUNTER, Board found that where other feature word is descriptive, it is clear that TIGER is prominent word, and that the words "MART" and "DISCOUNTER" did not distinguish the two marks when compared in their entirety); *Giant Foods, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 U.S.P.Q. (BNA) 390 (Fed. Cir. 1983). In this case, ARDEN is the dominant feature of both marks.

The Federal Circuit recently addressed the issue of dominant features of marks in *In re Chatam Int'l, Inc.*, 380 F.3d 1340, 71 U.S.P.Q. (BNA) 1994 (Fed. Cir. 2004). In *Chatam*, the Federal Circuit upheld the Board's decision refusing to register the mark JOSE GASPAR'S GOLD for tequila because of a likelihood of confusion with the existing mark GASPAR'S ALE for beer and ale. *Id.* at 1345. The court agreed with the Board's finding that although the marks are not identical, the name GASPAR is the dominant element of both marks, and the non-dominant features of the marks should be discounted. *Id.* The Federal Circuit ultimately concluded that the marks were nearly identical. *Id.* at 1343; *see also Fossil, Inc.*, 49 U.S.P.Q.2d (BNA) 1451 (when comparing the two marks FOSSIL to FOSSILSCAPES THE FOSSIL

GROUP STONESCAPES, the Board found that because of the way the mark appeared on the logo the dominant portion of the mark was “THE FOSSIL GROUP,” and because “THE” has little source identifying significance and “GROUP” has somewhat limited source identifying significance, there was a likelihood of confusion between the marks).

In this instance, the dominant portion of each mark is the word “ARDEN,” and the non-dominant features “BEAUTY” and “B” should be discounted when comparing the similarity of the two marks. In Applicant’s mark, the word “BEAUTY” has only limited source identifying significance because over 700 registered marks used for beauty products also contain “BEAUTY.” (Nicholas Dep. at 93:9-18; 4/8/05 Notice at Ex. A and Attachments 1-197.) In terms of marks in the cosmetics industry, “BEAUTY” has little source identifying significance because of its repeated use, much like “GOLD” in the *Chatam* case and “GROUP” in the *Fossil* case. Therefore, viewed in their entirety, with the non-dominant features appropriately discounted, ARDEN B and ARDENBEAUTY become identical because the dominant feature of both marks is “ARDEN.” The commercial impression of both marks is the same: namely, that the marks identify goods from the same source, namely “ARDEN.” Finally, the public could think that the “B” in Opposer’s mark is short for “BEAUTY,” or that the mark ARDEN B has been expanded to ARDENBEAUTY for use on “beauty” products, i.e. cosmetics, fragrances and body lotion.

Because the dominant portion of each mark is “ARDEN,” which is identical in sound, spelling, connotation and commercial impression, the marks are extremely similar. Therefore, this *du Pont* factor supports a finding of a likelihood of confusion between ARDEN B and ARDENBEAUTY.

2. **The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.**

The goods described in Opposer and Applicant's trademark registrations, namely women's clothing and accessories and beauty products respectively, are strongly related. The Board has repeatedly recognized the similarities between cosmetics and clothing. *The All England Lawn Tennis Club (Wimbledon) Ltd.*, 220 U.S.P.Q. at 1071 (in a case finding a likelihood of confusion between a very similar marks for cosmetics and clothing, the Board stated that "[n]umerous cases have held confusion to be likely when the same or similar marks were used in connection with cologne or other cosmetics on one hand and clothing on the other."); *In re Arthur Holland, Inc.*, 192 U.S.P.Q. (BNA) 494, 496 (T.T.A.B. 1976) (noting that the use of the same trademarks for clothing and cosmetics is likely to cause confusion, deception or mistake).

Along with Board precedent, the evidence in this case indicates that clothing and cosmetics are very similar. For example, it is very common in the marketplace for the same marks to be used on both cosmetics and women's clothing to indicate a common source. This is the case for several clothing store chains including BCBG, Anthropology, Forever XXI and Banana Republic, all of which sell both women's clothing and fragrances and body care products bearing the same or substantially similar marks. (Nicholas Dep. at 47:19-25-51:17; Nicholas Dep. Exs. 26-30.) Each of their representative sample beauty products bears a mark that is either identical to or a close derivative of the store name and clothing mark, namely: BCBG's product is BCBGIRL'S perfumed bath and shower scrub; Banana Republic's perfume is sold under the BANANA REPUBLIC W mark; Anthropology's soap bears the ANTHROPOLOGY mark, and Forever XXI's lip gloss and nail polish bear the FOREVER XXI mark. *Id.* Additional evidence of use of the same mark to indicate the same source for clothing and cosmetics is constituted by

the numerous federal trademark registrations made of record in the 6/9/05 Notice. Accordingly, it is very common for women's clothing stores to sell beauty products under similar or identical marks and the relevant purchasing public is well aware of that fact.

This common occurrence increases the likelihood of confusion between ARDEN B and ARDENBEAUTY because it is likely that a consumer will think that ARDENBEAUTY is a derivative mark of ARDEN B clothing stores, because so many other similar clothing stores have their own beauty products lines sold under marks that are derived from and are closely similar to the store name. In addition, it is common for women who purchase ARDEN B merchandise to purchase fragrances, body and hair care products and cosmetics also. (Nicholas Dep. at 25:8-22.)

Because many of the same customers purchase both women's clothing and cosmetics, and many stores sell both under similar marks, the nature of the goods sold under ARDEN B and ARDENBEAUTY are closely related, and lead to a high likelihood of confusion.

3. The similarity or dissimilarity of established, likely-to-continue trade channels.

As discussed above, the Board should assume that both Applicant's and Opposer's products are sold through all customary trade channels for their respective products since the trade channels are not addressed in the Application. Accordingly, the products should be treated as though they are sold in juxtaposition in retail stores, which are primarily located in shopping malls. (Nicholas Dep. at 32:13-25-40; Rolleston Dep. at 81:11-22.) It is very likely that the same customer will see ARDENBEAUTY products as she walks into the mall, only to see the ARDEN B store-front moments later. There is no evidence indicating that either Opposer or Applicant intends to change the trade channels through which it sells its products. In addition, both Applicant and Opposer advertise and promote their products in similar ways, namely

through consumer magazines such as Cosmopolitan, Glamour and InStyle magazine. (Nicholas Dep. at 41:13-25–42:1-11; Rolleston Dep. at 66:8-20.)

Because there is a strong similarity between the established, likely-to-continue trade channels used by both Opposer and Applicant to sell and advertise the products bearing their respective marks, this *du Pont* factor supports a finding of a likelihood of confusion between ARDEN B and ARDENBEAUTY.

4. The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing.

Both ARDEN B and ARDENBEAUTY sell products in a medium to low price point for their respective goods, and both target female customers. (Nicholas Dep. at 74:6-25–75:1-5; Rolleston Dep. at 89:11-25–90:1-8.) While ARDENBEAUTY is primarily sold in department stores, some of its products are sold through mass merchandisers such as Wal-Mart and Target. (Rolleston Dep. at 89:11-25–90:1-8.) Its target market is defined as “women of every age and every style.” (Rolleston Dep. at 26:24-25.) Thus and bearing in mind that there is no limitation in the Application as to the price point of the goods, the ARDENBEAUTY cosmetics and fragrances should be considered sold to the same customers and at similar price points to ARDEN B goods. Most of ARDEN B clothing and accessories are sold at a moderate price point similar to BCBG and Anthropologie stores, rather than a high price point similar to Neiman Marcus stores. (Nicholas Dep. at 74:6-25–75:1-5.) Opposer’s target customer base is women between the ages of 20 and 45. Applicant should be considered to target many of the same women. (Nicholas Dep. at 24:18-22; Rolleston Dep. at 26:24-25.) Therefore, because neither ARDEN B nor ARDENBEAUTY products are expensive or high price point goods, the products both tend toward “impulse” purchases.

The likelihood that Applicant's goods will be purchased on impulse and without careful or prolonged scrutiny supports a likelihood of confusion finding.

5. The fame of the prior mark (sales, advertising, length of use).

Through its extensive advertising and sales around the United States since 1997, the ARDEN B mark has become famous. (Nicholas Dep. Exs. 17-22; Nicholas Dep. at 41:13-25–46:1-2.) Arden B advertised in many national magazines including Glamour, In Style, Cosmopolitan, Jane, Entertainment Weekly, Vogue, Marie Claire and Elle before February 5, 2002, the date of the Application. (Nicholas Dep. Ex. 18; Nicholas Dep. at 41:13-25–42:1-11.) In fact, Arden B spent more than \$1.8 million dollars on advertising in 1999 alone. (Nicholas Dep. Ex. 19; *see also* Nicholas Dep. at 43:2-3.) As discussed previously, Arden B stores are located throughout the country, and eighty four existed before FD filed its Application. (Nicholas Dep. Ex. 16; Nicholas Dep. at 23:17-25.) Since 1997, the sales of clothing and accessories bearing the ARDEN B mark have been considerable. Business records evidencing these sales can be found collected in Exhibits 13 and 15 to Opposer's Notice of Reliance Pursuant to 37 C.F.R. § 2.122(e) dated February 24, 2005. These high, nationwide sales of ARDEN B goods, coupled with the significant advertising for the name and the mark that has occurred since the ARDEN B mark's inception in 1997 prove that the mark is famous.

Accordingly, this *du Pont* factor weighs in favor of finding a likelihood of confusion between ARDEN B and ARDENBEAUTY.

6. The number and nature of similar marks in use on similar goods.

Neither Applicant nor Opposer produced evidence that there are third party marks containing the word "ARDEN" in the marketplace. Although there are over 700 registered marks containing the word "BEAUTY," as discussed above, the "BEAUTY" portion of Applicant's mark has only limited source identifying significance. "ARDEN" is the prominent

portion of both marks. As there is no evidence of any other similar marks to “ARDEN,” other than those used by the parties, this indicates that the public is more likely to believe the two marks, ARDEN B and ARDENBEAUTY, indicate a common source of goods. This factor favors a finding of likelihood of confusion.

7. The nature and extent of any actual confusion.

Although Arden B is not aware of any instances of actual confusion at this point, the Board should not take that to mean that there is not a likelihood of confusion between the marks. As a practical matter, because both ARDEN B and ARDENBEAUTY items are sold through many stores around the country with many different employees, it is possible that instances of actual confusion have occurred, but management was not made unaware of them. In fact, the Board has recognized how difficult it is to learn of instances of actual confusion, “evidence of actual confusion is notoriously difficult to come by and, in any event, such evidence is not required in order to establish likelihood of confusion.” *Time Warner Enter. Co. v. Jones*, 65 U.S.P.Q.2d (BNA) 1650, 1662 (T.T.A.B. 2002) (refusing registration for ROAD RUNNER MAPS based on likelihood of confusion with ROAD RUNNER despite no evidence of actual confusion).

Because evidence of actual confusion is difficult to establish, the Board should give no weight to the absence of actual confusion in this case.

8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

Like factor seven, this *du Pont* factor is not particularly important in this case for two reasons. First, as discussed above, it is notoriously difficult to obtain evidence of actual confusion. Therefore, an absence of proof of confusion during the three years of concurrent use is not significant.

Second, the three years of concurrent use of the marks is not a particularly long time. *Id.* (noting that even though parties used their marks concurrently for over thirteen years and have marketed their products through some of the same trade channels, this concurrent use was not substantial enough to be legally significant in a likelihood of confusion analysis). Therefore, this factor is not particularly useful in determining likelihood of confusion between ARDEN B and ARDENBEAUTY. Applicant has not introduced evidence of an absence of instances of confusion between the marks, nor has it established that if there has been no confusion, it is due a lack of similarity between the two marks, as opposed to source differentiation caused by other factors, such as trade dress, or use by the Applicant of a second distinctive mark on its goods.

This factor should not be given weight in the Board's determination of likelihood of confusion.

9. The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).

ARDEN B is used on a wide variety of clothing items and accessories. As discussed previously, ARDEN B is used on tops, bottoms, outerwear, suits, dresses, shoes and accessories, including jewelry, handbags, belts and hats. (Nicholas Dep. at 24:18-25, 31:8-9.) The use of the mark on this range of products makes it more likely that customers would expect cosmetics, toiletries, etc. sold under a similar mark to come from the same source. Also, similar "house" marks are used on both cosmetic and clothing of Arden B's competitors such as BCBG, Anthropology, Forever XXI and Banana Republic. Thus, it is likely that potential customers will assume that ARDENBEAUTY is a mark of Arden B's for its cosmetic line.

Accordingly, this *du Pont* factor weighs in favor of a likelihood of confusion finding in this Opposition.

10. The market interface between applicant and the owner of a prior mark.

In Opposition No. 112,592 filed January 6, 1999, FD's predecessor opposed Arden B's application to register ARDEN B for women's clothing and related retail store services based on its rights to the mark ELIZABETH ARDEN for cosmetics.³ The fact that FD previously opposed Arden B's application for registration of ARDEN B for women's clothing based on its right in a cosmetics mark indicates its belief that the public would be confused and likely to think that clothing and cosmetics came from the same source when sold under similar marks, that is to say, that the use of similar marks on cosmetics and clothing respectively is likely to cause confusion. In the present opposite case, there is vastly greater similarity between the marks than was the case in Opposition No. 112,592.

a. A mere "consent" to register or use.

No evidence was presented by either party relating to this factor, so the Board should consider it neutral. *In re Wilson*, 57 U.S.P.Q.2d (BNA) 1863, 1868 (T.T.A.B. 2001) (when there is no evidence presented on a *du Pont* factor, the Board gives it neutral treatment).

b. Agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.

In the settlement to Opposition No. 112,592, FD and Arden B reached an agreement regarding Opposer's use of the ARDEN B mark that prevents Opposer from selling cosmetic products in its stores under the mark ARDEN B. Again, this indicates that Applicant was concerned that if Opposer sold cosmetics bearing the ARDEN B mark, the public might think the goods were related to Applicant. It is logical that when FD decides to develop cosmetics under

³ The parties settled the previous opposition and Arden B agreed not to sell cosmetics in its stores under the ARDEN B mark. That agreement is not, of course, known to the purchasing public for the Applicant's goods and is irrelevant to the issues before the Board.

the ARDENBEAUTY mark, which is so very similar to the ARDEN B mark, Arden B would have the same concerns and the same likelihood of confusion would apply.

c. *Assignment of mark, application, registration and good will of the related business.*

Because there is no evidence in the record dealing with this factor, it should not be considered by the Board. *In re Wilson*, 57 U.S.P.Q.2d at 1868.

d. *Laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.*

Similarly, because no evidence was presented regarding this factor, the Board should not consider it in its analysis. *In re Wilson*, 57 U.S.P.Q.2d at 1868.

11. The extent to which applicant has a right to exclude others from use of its mark on its goods.

Arden B owns federally registered trademarks and has used its mark in commerce since 1997. It has a right to exclude others from use of ARDEN B and confusingly similar marks on other goods. (*See, e.g.*, U.S. Registration No. 2,795,689 ARDEN B, 2/24/05 Notice at 1(c) WS000908-912.)

Accordingly, this factor weighs in favor of finding a likelihood of confusion.

12. The extent of potential confusion, i.e., whether *de minimis* or substantial.

There is a substantial likelihood of extensive confusion between ARDEN B and ARDENBEAUTY because the marks are closely similar and are used for relatively low cost goods sold in large quantities to women individual purchasers through similar channels of trade, shopping malls.

Therefore, there is much more than a *de minimis* likelihood of potential confusion and this factor forms a finding of likelihood of confusion.

13. Any other established fact probative of the effect of use.

Opposer is unaware of any other probative facts for the Board to consider relating to the effect of use.

C. Applicant Has Admitted It Had No Intention Of Using The Mark For At Least Some Of The Goods Recited In The Application.

The opposed Application was filed more than three years ago under Section 1(b) (15 U.S.C. § 1051(b)) of the Lanham Act on an “intent to use basis.” In the application, Applicant stated it had a bona fide intent to use the mark on numerous goods, not only cosmetics, body care products and fragrances, but also on potpourri and sun screen. (See U.S. Application No. 76/372,550.) Applicant has used the mark only in connection with perfume, cologne, body lotion and moisturizing cream. It has made no use of the mark with respect to many items listed on its application including: body oil, body powder, scented skin soap; cosmetics and skin care preparations, namely, foundation make-up, face powder, blusher, compacts, eye pencils, lip pencils, lipstick, lip gloss, non-medicated lip balm, mascara, eye make-up, eyeliners, skin moisturizer and skin toner; hair care products, namely, shampoo, hair conditioners, hair gel and hair spray; nail care preparations, namely, nail polish, nail strengtheners, and nail polish remover; shaving cream, shaving gel, after-shave lotion; skin soap; shower gel; deodorant; antiperspirant; potpourri; sachets; suntanning preparations; sun screen and sun block preparations. (Rolleston Dep. at 48:18-22, 76:17-77:2.) More significantly, Applicant’s representative in his trial testimony admitted that it never had any plans to use the mark ARDENBEAUTY on shampoo or candles. (Rolleston Dep. at 85:2-13, 23-25-86:2-3, 87:11-15, 24-88:11.)

Case authority is clear that the Applicant must have a bona fide intention to use the mark in connection with all the goods recited in an intent-to-use Application. Absence of an intention

to use the mark on any of the goods renders the Application void *ab initio*. *Caesars World, Inc. v. Milanian*, 126 Fed. Appx. 775, 777 (9th Cir. 2005) (“Milanian’s intent-to-use applications were not made with a bona fide intent to use, and were therefore void.”). Accordingly, FD’s Application is void because the evidence proves that FD had no intent to use the ARDENBEAUTY mark in connection with at least some of the recited goods at the time it filed the Application.

V. CONCLUSION

The mark applied for, ARDENBEAUTY, creates the same commercial impression as Opposer’s earlier name and mark ARDEN B. The respective goods and services are closely related: they are sold to the same target market through the same trade channels. There are numerous examples of the same mark being used for both clothes and cosmetics to indicate a common source of those goods. The Application should be denied under Section 2(d). 15 U.S.C. § 1052(a).

In addition, the Applicant did not have the requisite bona fide intent to use the mark on all the goods identified in the Application. The Application should also be refused under Section 1(b). 15 U.S.C. § 1051(b).

Arden B has met its burden of demonstrating that registration of ARDENBEAUTY should be refused. Should any doubt as to the outcome remain, the Board should bear in mind that doubt about likelihood of confusion should be resolved against the Applicant because it had a duty to avoid confusion with existing marks when selecting a new mark. *In re Chatum Int’l, Inc.*, 380 F.3d at 1345.

Dated: August 8, 2005

Respectfully submitted,



John M. Cone
Cara Foos Pierce
AKIN GUMP STRAUSS HAUER & FELD LLP
1700 Pacific Avenue, Suite 4100
Dallas, Texas 75201-4675
Telephone: (214) 969-4214
Facsimile: (214) 969-4343
trademarkdallas@akingump.com

ATTORNEYS FOR OPPOSER
THE WET SEAL, INC.

CERTIFICATE OF SERVICE

I hereby certify that on this 8th day of August 2005, a copy of the foregoing document was served upon the following counsel via first class U.S. mail:

Joseph R. Dreitler
Jones Day
P.O. Box 165017
Columbus, Ohio 43216-5017



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Certificate of Mailing Under 37 C.F.R. § 1.8

Date of Deposit: 8-8-05

I hereby certify that the papers enclosed herein are being deposited with the United States Postal Service as first class mail on the date indicated above in an envelope and addressed to: Commissioner for Trademarks, Box TTAB-No Fee, 2900 Crystal Drive, Arlington, VA 22202-3513.

VICKI MARTIN

(Typed or printed name of person mailing paper or fee)

Vicki Martin

(Signature of person mailing paper or fee)