

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Vanity Fair, Inc.
v.
Kelly C. Hainline

Opposition No. 91163354
to application Serial No. 78315301
filed on October 17, 2003

Opposition No. 91166973
to application Serial No. 78248217
filed on May 11, 2003

Opposition No. 91166975
to application Serial No. 78248218
filed on May 11, 2003

Paul J. Kennedy of Pepper Hamilton LLP for Vanity Fair, Inc.
Kelly C. Hainline, pro se.

Before Walters, Grendel and Walsh, Administrative Trademark
Judges.

Opinion by Grendel, Administrative Trademark Judge:

The three above-captioned opposition proceedings were
consolidated by order of the Board dated April 27, 2006. We

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shall decide all three cases in this single opinion, which shall be entered in each of the opposition proceeding files.

Kelly C. Hainline, applicant herein, is the owner of the three applications involved in these three opposition proceedings. Vanity Fair, Inc., opposer herein, has opposed registration in each case.

In application Serial No. 78315301 (involved in Opposition No. 91163354), applicant seeks registration on the Principal Register of the mark VANITY INSANITY (in standard character form) for goods identified in the application as "clothing and athletic apparel, namely shirts, pants, sweatshirts, shorts, baseball caps, hats, swimwear, beachwear, bottoms, jackets, sweat jackets, pullovers, headwear, jogging suits, lingerie, loungewear, polo shirts, sleepwear, tee shirts, tank tops, underwear, shoes, warm up suits."¹

In application Serial No. 78248217 (involved in Opposition No. 91166973), applicant seeks registration on the Principal Register of the mark VANITY & SANITY (in standard character form) for goods identified in the application as "clothing, athletic apparel, and loungewear, namely shirts, pants, sweatshirts, shorts, baseball caps, hats, swimwear, beach wear, bottoms, jackets, sweat jackets,

¹ This application was filed on October 17, 2003. It is based on applicant's asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

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pullovers, headwear, jogging suits, lingerie, polo shirts, sleepwear, tee shirts, tank tops, underwear, shoes and warm up suits.”²

In application Serial No. 78248218 (involved in Opposition No. 91166975), applicant seeks registration on the Principal Register of the mark VANITY N SANITY (in standard character form) for goods identified in the application as “clothing, athletic apparel, and loungewear, namely shirts, pants, sweatshirts, shorts, baseball caps, hats, swimwear, beach wear, bottoms, jackets, sweat jackets, pullovers, headwear, jogging suits, lingerie, polo shirts, sleepwear, swimwear, tee shirts, tank tops, underwear, shoes and warm up suits.”³

Opposer has opposed registration as to each of the three applications. As its ground of opposition in each case, opposer alleges that each of applicant’s marks so resembles opposer’s mark VANITY FAIR, previously used and registered by opposer in connection with certain clothing items, as to be likely to cause confusion, to cause mistake,

² This application was filed on May 11, 2003. It is based on applicant’s asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

³ This application was filed on May 11, 2003. It is based on applicant’s asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).⁴

In each opposition, applicant filed an answer by which she denied the salient allegations of the notice of opposition.

Both opposer and applicant submitted evidence at trial. The case is fully briefed. After careful consideration of the evidence of record and the parties' arguments, we sustain all three of the oppositions.

The evidence of record consists of the files of applicant's involved applications; the pleadings herein; opposer's notice of reliance on various items; the testimony declaration of opposer's witness Helen Winslow and exhibits thereto; the testimony declaration of opposer's witness Debi Auman and exhibits thereto; applicant's notice of reliance on various items; the testimony declaration of applicant Kelly Hainline and exhibits thereto; the testimony declaration of applicant's witness Armando Hurtado; and the testimony declaration of applicant's witness Shelley Hurtado.⁵

⁴ Opposer also pleaded a dilution claim in each of the three notices of opposition. Because opposer presented no argument in its brief as to this ground, we deem opposer to have waived it, and we shall give it no consideration.

⁵ The parties stipulated in writing that each could present trial testimony by way of declaration. See Trademark Rule 2.123(b), 37 C.F.R. §2.123(b).

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Opposer has made of record status and title copies of its six pleaded registrations, which establish that the registrations are in force and are owned by opposer. These registrations are summarized as follows:

Registration No. 2808866,⁶ of the mark VANITY FAIR (in standard character form) for "foundation garments, lingerie, underwear, bras, slips, loungewear, robes, sleepwear and hosiery";

Registration No. 2185908,⁷ of the mark VANITY FAIR (in stylized lettering) for "pajamas, robes, peignoir sets, bed jackets, scuffs, teddies, nightgowns, thermal underwear, slips, chemises, thong underwear, bustiers, camisoles, bras, panty hose, leggings, socks, body suits, briefs, panties, pant liners, girdles, bodybriefers, and panty-girdles";

Registration No. 0918102,⁸ of the mark VANITY FAIR (in stylized lettering) for "paper slips, petti-slips, and briefs";

Registration No. 0502941,⁹ of the mark VANITY FAIR (in stylized lettering) for "women's and misses' underwear and lingerie, namely, vests, bloomers, panties, briefs, chemises, bandeaux, brassieres, slips, pettiskirts, lounging pajamas, negligees, lounging robes, bed jackets, girdles and pantigirdles; sleeping garments, namely, nightgowns and pajamas";

Registration No. 0305749,¹⁰ of the mark VANITY FAIR (in stylized lettering) for "girdles"; and

⁶ Issued on January 27, 2004.

⁷ Issued on September 1, 1998. Affidavits under Sections 8 and 15 accepted and acknowledged.

⁸ Issued on August 10, 1971. Renewed.

⁹ Issued on October 12, 1948. Renewed.

¹⁰ Issued on August 22, 1933. Renewed.

Registration No. 0116092,¹¹ of the mark VANITY FAIR (in stylized lettering, with cameo design) for "underwear consisting of vests, bloomers, knickerbockers, drawers, combinations, chemise, envelop-chemise, nightgowns, pajamas, made of knitted or textile material, for adults and babies."

Because opposer has properly made its pleaded registrations of record, we find that opposer has established its standing to oppose registration of applicant's marks. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Moreover, because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and goods covered by said registrations. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315

¹¹ Issued on April 3, 1917. Renewed.

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F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We begin with the fifth *du Pont* evidentiary factor, which requires us to consider evidence of the fame of opposer's mark, and to give great weight to such evidence if it exists. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the *DuPont* factors," *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1456 [sic - 1897], and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.*

Bose Corp. v. QSC Audio Products Inc., *supra*, 63 USPQ2d at 1305.

The evidence of record establishes that opposer has used its VANITY FAIR mark nationwide in connection with clothing since 1916. (Auman Decl. at ¶3.) Opposer's sales

and advertising figures have been made of record under seal and we therefore shall not divulge them in this opinion, but we find that they are very substantial and certainly large enough to support a finding of fame. (Auman Decl. at ¶¶6-7 and Exh. B and C.) Based on this evidence, we find that opposer's VANITY FAIR mark has achieved a significant degree of fame, for purposes of the fifth *du Pont* factor.¹² Such fame weighs heavily in favor of a finding of likelihood of confusion.

We next find, under the sixth *du Pont* factor, that the strength of opposer's mark is not mitigated by third-party use of similar marks on similar goods. The third-party VANITY FAIR registrations applicant has made of record (applicant's notice of reliance at Exh. A7-A15) are not evidence of third-party use of such marks for purposes of the sixth *du Pont* factor. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). In any event, those registrations do not cover clothing, and they therefore are of no probative value under the sixth *du Pont* factor. The sixth *du Pont* factor is

¹² With respect to fame, applicant in her brief repeatedly refers to the Board's decision in *The Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164 (TTAB 2001). However, that case dealt with the issue of fame in the context of a dilution claim, not a likelihood of confusion claim. The two concepts are distinct. See *Palm Bay Imports, supra*, 73 USPQ2d at 1694. Dilution is no longer an issue in this case, see *supra* at footnote 4, and the dilution fame principles set out in *Toro* are not apposite here.

neutral in this case; it certainly does not weigh in applicant's favor.

We turn next to the second *du Pont* factor, which requires us to determine the similarity or dissimilarity of the goods as identified in applicant's applications and in opposer's registrations. The identification of goods in each of applicant's applications includes "lingerie," "loungewear," "sleepwear," and "underwear." These items are also included in the identification of goods in opposer's registrations, and applicant's goods are legally identical to opposer's goods to that extent. The second *du Pont* factor accordingly weighs in favor of a finding of likelihood of confusion.¹³

The third *du Pont* factor requires us to determine the similarity or dissimilarity of the trade channels in which applicant's and opposer's goods are or would be marketed. That determination must be based on the goods as they are identified in applicant's applications and in opposer's registrations, respectively, regardless of what the evidence might show to be the actual trade channels in which the

¹³ We need not and do not decide whether any of the rest of applicant's goods are similar or related to opposer's goods. If any of the Class 25 items identified in applicant's applications is similar to opposer's goods, the second *du Pont* factor weighs in opposer's favor as to all of the Class 25 goods identified in applicant's applications. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 209 USPQ 986 (CCPA 1981); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844 (TTAB 2004).

goods are marketed or intended to be marketed. Because there are no restrictions or limitations in applicant's applications or opposer's registrations in terms of trade channels and classes of purchasers, we must presume that the goods are marketed in all normal trade channels and to all normal classes of purchasers for such goods. To the extent that applicant's goods are legally identical to opposer's goods (see discussion *supra*), the trade channels and classes of purchasers for the respective goods likewise must be deemed to be identical. See *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283 (TTAB 2007). We find that the third *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The fourth *du Pont* factor requires us to consider the conditions under which the goods are purchased. We find that applicant's goods and opposer's goods, as identified in the respective identifications of goods, are ordinary consumer items purchased by ordinary consumers. The goods are not inherently expensive, and would be purchased with only a normal degree of care. (Auman Decl. at ¶4.) Applicant's arguments to the contrary are not persuasive. We find that the fourth *du Pont* factor weighs in favor of a finding of likelihood of confusion.

As applicant notes, there is no evidence of actual confusion. However, there also is no evidence that

applicant, whose applications at issue are based on intent-to-use, has made any significant use of her mark. In the absence of any significant opportunity for actual confusion to have occurred, the absence of actual confusion is not probative. *Gillette Canada, Inc. v. Ranir*, 23 USPQ2d 1768 (TTAB 1992). The seventh and eighth *du Pont* factors are neutral in this case.

We turn finally to the first *du Pont* factor, which requires us to determine the similarity or dissimilarity of the marks when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra*. The test, under the first *du Pont* factor, 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 terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in

determining the commercial impression created by the mark. 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applying these principles in the present case, we find as follows. First, we find that the dominant feature in the commercial impressions created by applicant's marks and opposer's mark is the word VANITY. This word is distinctive if not arbitrary as applied to clothing. It appears as the first word in each of the marks, and it therefore is more likely to be perceived and recalled by purchasers as the dominant indication of source. See *Palm Bay Imports v. Veuve Clicquot, supra*; *Cunningham v. Laser Golf, supra*. The other words in the respective marks also contribute to the marks' commercial impressions and we have given them due consideration, but we deem VANITY to be the most prominent feature of the marks and we therefore accord it the most significant weight in our comparison of the marks. *In re Chatam International Inc. supra*; *In re National Data Corp., supra*.

In terms of appearance and sound, we find that the parties' marks are identical to the extent that they both start with the word VANITY. The other words in the respective marks look and sound different. On the whole, however, we find that the similarity in appearance and sound which results from the presence of VANITY in both marks outweighs the differences between the marks which result

from the presence of the different additional wording. Also with respect to the appearance of the marks, applicant's asserted intention to depict her marks in highly stylized lettering is irrelevant because applicant is seeking to register her marks in standard character form, not in stylized form. Her registrations therefore would entitle her to display the marks in any reasonable stylization, including a stylization similar to the manner in which opposer's marks are registered and used. *See Cunningham v. Laser Golf, supra.*

In terms of connotation, we find that the marks are similar to the extent that they both start with the word VANITY, which would mean the same thing in both marks. The marks as a whole have somewhat different connotations, however. Applicant's marks rhyme VANITY with INSANITY or SANITY, which results in an unusual composite. Opposer's mark VANITY FAIR is a unitary term with its own meaning,¹⁴ a meaning which is not presented by applicant's marks. On balance, we find that the marks are somewhat dissimilar in connotation.

¹⁴ "Vanity Fair" is defined as "a place or scene of ostentation or empty, idle amusement and frivolity." The American Heritage Dictionary of the English Language (4th ed. 2000). The Board may take judicial notice of dictionary definitions. *See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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In terms of overall commercial impression, we find that the marks are similar due to the fact that they all begin with the word VANITY. As noted above, VANITY is the dominant feature in opposer's mark and in applicant's marks as well. Upon encountering applicant's marks beginning with the word VANITY, purchasers familiar with opposer's VANITY FAIR mark are likely to be confused as to whether there is a source connection between products bearing the respective marks.

Viewing the marks in their entirety, we find that they are similar, for purposes of the first *du Pont* factor. In making this determination, we keep in mind that where the parties' goods are identical, as they are in this case, the degree of similarity between the marks which is required to support a finding of likelihood of confusion necessarily declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). Moreover, because opposer's mark is famous, it is entitled to a very broad scope of protection. *Bose Corp. v. QSC Audio Products Inc.*, *supra*. Given the long use and fame of opposer's VANITY FAIR mark, potential purchasers are likely to view applicant's marks beginning with the word VANITY as whimsical, contemporary variations on opposer's mark when the marks are used on the identical goods involved here. We conclude that applicant's marks are sufficiently similar to

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opposer's famous mark that source confusion is likely to result if the respective marks are used on the identical goods involved in this case.

Considering all of the evidence of record as it pertains to the *du Pont* factors, we conclude that a likelihood of confusion exists. Opposer's VANITY FAIR mark is famous and entitled to a broad scope of protection. The parties' goods, trade channels and classes of purchasers are legally identical. The goods are inexpensive, ordinary consumer items that would not be purchased with a great degree of care. There is no evidence that opposer's mark is weakened by third-party use of similar marks on similar goods. The absence of evidence of actual confusion is not probative, given the fact that there has been no significant opportunity for actual confusion to have occurred.

Considered together, these facts suffice to establish that a likelihood of confusion exists. To the extent that any doubts might exist as to the correctness of our conclusion, we resolve such doubts against applicant. See *Century 21 Real Estate Corp., supra*; *Ava Enterprises Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783 (TTAB 2006); and *Baseball America Inc. v. Powerplay Sports Ltd., supra*.

In summary, we find that opposer has established its standing and its Section 2(d) ground of opposition in each

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of the three oppositions, and that it therefore is entitled to prevail in each case.

Decision: Opposition Nos. 91163354, 91166973 and 91166975 are sustained.