

**THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.**

Hearing: February 14, 2012

Mailed: July 18, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Valentino S.p.A.

v.

Matsuda & Co.

Opposition Nos. 91174169, 91174171, 91174183,
91174195, 91174315, and 91179386
To applications Serial Nos. 78651057, 78651257,
78651011, 78651198, 78651123, and 78651156

G. Franklin Rothwell, Anne M. Sterba, and Jenny L. Workman
of Rothwell, Figg, Ernst & Manbeck P.C. for Valentino S.p.A.

Anne Haring Hocking of Haring + Smith, LLP for Matsuda & Co.

Before Bucher, Wolfson and Lykos, Administrative Trademark
Judges.

Opinion by Wolfson, Administrative Trademark Judge:

On June 15, 2005, Matsuda & Co. ("applicant") filed six
applications for the mark shown below for goods in
International Classes 9, 14, 18, 24, 25, and 28.¹

¹ Serial No. 78651057 was filed for "watches"; Serial No.
78651257 for "sporting equipment, namely, golf clubs, golf irons,
golf bags"; Serial No. 78651011 for "spectacles"; Serial No.
78651198 for "clothing, namely, clothing tops, blouses, shirts,
sweaters, cardigans, blazers, coats, suits, tuxedos, vests, suit
coats, sport coats, top coats, jackets, parkas, jeans, slacks,

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

Valentino Rudy

The applications were filed under Section 44(e) of the Trademark Act of 1946, 15 U.S.C. § 1126(e), on the basis of applicant's Japanese registrations for the marks. The applications include various "Name Portrait Consent" statements stating that "VALENTINO RUDY" identifies a particular individual who is deceased.

Valentino S.p.A. ("opposer") opposes the registration of applicant's marks on the grounds of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Specifically, opposer alleges that it is the owner of the previously used and registered

dungarees, pants, trousers, shorts, skirts, culottes, jumpsuits, dresses, evening gowns, kimonos, stoles, shawls, fur coats and jackets, leather and wind resistant jackets, gowns, tunics, t-shirts, polo shirts, sweatshirts, sweatpants, sweat suits, warm-up suits, bathrobes, jogging suits, socks, pocket squares, gloves, mittens, hosiery, stockings, tights, leggings, leotards, belts, headwear, neckwear, sleepwear, underwear, loungewear, beachwear, swim wear, rainwear, tennis wear and footwear, all for men, women and children"; Serial No. 78651123 for "umbrellas, walking sticks and accessories, namely, replacement handles for walking sticks"; and Serial No. 78651156 for "clothing fabric, synthetic and non-synthetic fabric except tatami hem, synthetic and non-synthetic fabric for use as tatami hem, knitted fabrics, felt and unwoven fabric for textile use, oil cloth, rubber water-proof cloth for textile use, vinyl cloth for textile use, rubber cloth for textile use, fabric goods, namely, kitchen towel, mosquito-net, bed sheets, comforter, duvet, fabric for bedding cover, pillow case, bed blanket, fabric tapestry, curtain, table cloth, thick curtain, shower curtain, black and white curtain, red and white curtain, fabric labels, cloth Nobori flags, namely flags for parades, sports, music and all kinds of events; filter cloth for use in filtering water in cooking and other purposes, cloth flags."

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

marks VALENTINO, VERY VALENTINO, VALENTINO and "V" design, and VALENTINO GARAVANI and "V" design for clothing and related accessories,² and that applicant's marks so resemble

² Opposer's pleaded registrations are:

Reg. No. 0901896 for the mark VALENTINO for "eau de cologne"; registered November 3, 1970; renewed.

Reg. No. 0910955 for the mark VALENTINO for "articles of clothing and accessories-namely, dresses, belts, gloves, scarves, swimwear, and ties"; registered April 6, 1971; renewed.

Reg. No. 0916465 for the mark VALENTINO for "fashion consultation services-namely, creating clothing, jewelry, and accessory designs and selection of designs and materials for couture clientele"; registered July 13, 1971; renewed.

Reg. No. 0956665 for the mark VALENTINO for "retail department store services"; registered April 3, 1973; renewed.

Reg. No. 1140394 for the mark VALENTINO for "umbrellas and parasols"; registered October 14, 1980; renewed.

Reg. No. 1268029 for the mark VALENTINO for "articles of clothing and accessories-namely, jumpers, sweaters, dresses, skirts, blouses, suits, jackets, coats, shirts, trousers, vests, jeans, slacks, shorts, swimwear, hats, lingerie, ties, belts, scarves, hosiery and gloves"; registered February 21, 1984; renewed.

Reg. No. 1418315 for the mark VALENTINO GARAVANI V and design, as shown at right, for "costume jewelry"; registered November 25, 1986; renewed.

Reg. No. 1419190 for the mark VALENTINO GARAVANI V and design, as shown at right, for "valises, garment bags for travel, handbags, shoulder bags, clutch bags, brief cases, attaché cases, umbrellas, and small leather -- namely, passport cases, wallets, key cases, billfolds, vanity cases sold empty and credit card holders"; registered December 2, 1986; renewed.

Reg. No. 1422015 for the mark VALENTINO GARAVANI V and design, as shown above, for "articles of clothing -- namely, belts, scarves, gloves, boots, shoes and slippers"; registered December 23, 1986; renewed.

Reg. No. 2312756 for the mark VALENTINO for "spectacle frames and sunglasses"; registered February 1, 2000; renewed.

Reg. No. 2286240 for the mark VERY VALENTINO for "perfume, eau de parfum, eau de toilette, body lotion, deodorant and bath and shower gel"; registered October 12, 1999; renewed.

Reg. No. 2755270 for the mark V VALENTINO GARAVANI and design for "retail store services featuring clothing, eye glasses and sunglasses, watches leather or imitation leather articles such as bags, purses, briefcases, address books, journals, and shoes"; registered August 26, 2003; Section 8 (6-year) accepted & Section



Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

opposer's registered marks as to be likely to cause confusion, mistake, or deception among purchasers.³ Opposer has withdrawn its originally pleaded dilution claims.

Applicant has denied the salient allegations in the notices of opposition. The cases were consolidated on April 3, 2008, and have been presented on the same record and briefs.

The Record

By rule, the record includes applicant's application files and the pleadings. Trademark Rule 2.122(b), 37 CFR § 2.122(b).

The parties stipulated that they "may introduce testimony by written declaration, if so desired."⁴ Pursuant

15 acknowledged.

Reg. No. 2880581 for the mark V VALENTINO GARAVANI for "handbags, shoulder bags, clutch bags, wallets; articles of clothing, namely, belts, scarves, gloves, boots, shoes"; registered September 7, 2004; partial Sections 8 (6-year) and 15 combined declaration accepted and acknowledged.

Reg. No. 2826869 for the mark VALENTINO GARAVANI for "spectacle frames and sunglasses; men's and women's watches"; registered March 30, 2004; partial Sections 8 (6-year) and 15 combined declaration accepted & acknowledged.

Reg. No. 1153226 for the mark VALENTINO for "men's clothing-namely, suits, sport jackets, overcoats, shirts, trousers, bermuda shorts, and bathing suits"; registered May 5, 1981; renewed.

Reg. No. 1268030 for the mark V VALENTINO and design as shown at right for "articles of clothing and accessories-namely,

jumpers, sweaters, dresses, skirts, blouses, suits, jackets, coats, shirts, trousers, vests, jeans, slacks, shorts, swimwear, hats, lingerie, ties, belts, scarves, hosiery and gloves"; registered February 21, 1984; renewed.



³ In the notices of opposition, opposer alleges prior use of the mark R.E.D. VALENTINO, but inasmuch as opposer did not rely on

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

to the above-noted stipulation, each party introduced testimonial declarations into evidence during its respective testimony period, and opposer introduced a testimonial declaration during its rebuttal period.

Opposer's Record

Opposer's record consists of the testimonial deposition of Carmine Pappagallo, opposer's chief financial officer, with accompanying exhibits; the declaration testimony of Stephen Dougherty, an employee in opposer's counsel's office, with accompanying exhibits; notices of reliance on third-party registrations; and applicant's answers to selected discovery requests. During its rebuttal period, opposer filed the cross-examination testimony deposition of Ellen Bass, an associate of counsel at applicant's counsel's firm, with accompanying exhibits; the cross-examination declaration testimony of Eri Matsumura, applicant's Manager, with an exhibit; and notices of reliance on official documents and additional responses to discovery requests.

Applicant's Record

Applicant's record consists of the declaration testimony of Ellen Bass with accompanying exhibits;⁵ the

the mark at trial or mention it in its briefs, we have not included it in our discussion under Section 2(d), *infra*.

⁴ *Joint Stipulation for Declaration Testimony*, p. 1.

⁵ Exhibits L-T of Ms. Bass's declaration have not been considered. See Board order dated September 27, 2010.

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

declaration testimony of Eri Matsumura with accompanying exhibits; and the declaration testimony of applicant's counsel with accompanying exhibits. Applicant also filed notices of reliance on official documents and printed publications.⁶

Evidentiary Objections

Objections by Opposer

In an appendix to its brief on the case, opposer objected to the admission of certain declaration testimony and documentary evidence proffered by applicant. Specifically, opposer objects to the introduction of Exhibit B from Ms. Matsumura's declaration as hearsay being proffered for the truth of the matter asserted, and exhibits I and J to the declaration on the basis that they are irrelevant.

With respect to exhibit B, an article about Valentino Rudy, inasmuch as it has been properly made of record by way of Ms. Matsumura's declaration, it is at least admissible for what it shows on its face and that the public has been exposed to the article and may be aware of the information contained therein. Turning to exhibits I and J (a list of registrations in China and Vietnam that have apparently expired, copies of what appears to be foreign registration

⁶ Applicant's notice of reliance No. 9 is in the record; Nos. 1-8 have been stricken. See Board order dated September 27, 2010.

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

certificates, and decisions from foreign trademark offices), while properly admitted under notice of reliance as relevant to the issues herein, they are of no real probative value, and have been given no weight. *See, e.g., In re Bayer Aktiengesellschaft*, 82 USPQ2d 1828 (Fed. Cir. 2007) (evidence of registration of ASPIRINA in another country is of little value to our analysis of its entitlement to protection in the United States).⁷

Opposer further objects to the entirety of Ms. Hocking's declaration, including exhibits 1-8, as being irrelevant. The declaration was utilized by applicant to introduce copies of TARR printouts of several trademark applications. To the extent that these are of applications involved in this proceeding, such was unnecessary; the file histories of applicant's involved applications are already of record. *See Trademark Rule 2.122(b)(1)*. As to the remainder, they have been considered, but only as showing that the applications were filed. *See Glamorene Products Corp. v. Earl Grissmer Co., Inc*, 203 USPQ 1090, 1092, n.5 (TTAB 1979) ("copies of ... applications or the publication thereof in the Official Gazette is evidence only of the filing of the applications and nothing else.").

⁷ We have also given no weight to opposer's exhibits H-1 to H-8, which are copies of foreign court decisions allegedly involving the parties' marks.

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

Finally, opposer's objection to Ms. Bass's declaration exhibits C-F, I, and K on the ground that they were not produced during discovery is overruled. During discovery, opposer sought information about "any and all" third-party uses of the term VALENTINO "ever known." Applicant replied that it was unable to identify all third-party uses "ever known," but did identify those of which it was "currently aware ... that use the term VALENTINO for clothing and related products," adding, "There may be other uses of the common Italian name 'Valentino' for other purposes." While we do not condone applicant's failure to timely supplement its discovery responses, we do not believe that applicant's delay unduly prejudiced opposer. *See Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1071-72 (TTAB 2011) (objection to evidence of third-party use overruled; any prejudice can be eliminated or minimized during rebuttal testimony period). Accordingly, we have considered these exhibits and the testimony pertaining thereto.

We further note that in its rebuttal brief, opposer objects to two exhibits (exhibit B, a copy of an Office action from the file history of Serial No. 76184572 for the mark VALENTINO and "V" design; and pages 2, 4 and 6 of exhibit C, copies of mock-ups of opposer's products affixed with applicant's mark) that were introduced for the first time as attachments to applicant's trial brief. Insofar as

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

the materials contained therein were not properly introduced at trial, we have not considered them. *See, e.g., Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1116 (TTAB 2009); TBMP § 704.05(b) (3d ed. rev. 2012) ("Exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony.").

Objections by Applicant

Applicant objects to the introduction of opposer's exhibit C, pages 1-1239 (printed publications), exhibits D1-D29 (third-party registrations), and exhibits E2-E7 of Mr. Pappagallo's testimony to the extent they may be relied upon for the truth of the matters asserted therein. The exhibits were properly submitted under notice of reliance or during Mr. Pappagallo's deposition and are thus admissible for what they show on their face and for the effect they would have on the relevant public. They have not been considered for the truth of any matter asserted therein.

Applicant states a further objection to the introduction of portions of exhibits E1 and E12 of Mr. Pappagallo's testimony on the grounds of lack of personal knowledge under Fed. R. Evid. 602 and lack of proper foundation and authentication under Fed. R. Evid. 901. *See Applicant's Appendix A, Obj. 6-7.* However, based on

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

applicant's arguments, it is apparent that applicant's objection relates to exhibits E2-E7 and not exhibits E1 and E12. Accordingly, we treat this objection as one going to exhibits E2-E7. With respect to those exhibits, Mr. Pappagallo testified to the authenticity of the copies and that the originals of these exhibits were either lost or misplaced.⁸ Accordingly, we will accept the copies as evidence. We also have considered applicant's objection grounded on lack of personal knowledge, and, when appropriate, have weighed the evidence in light of the objection.

Suffice it to say that we have considered the entire record with an eye on the parties' objections, and accorded the evidence whatever probative weight it merits.

Standing

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the

⁸ Pappagallo Dep., p. 146.

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

marks and the goods covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Moreover, the evidence of record shows that opposer has used the mark VALENTINO since at least 1992,⁹ well before the June 15, 2005, filing date of applicant's application, which is the earliest date on which applicant can rely.¹⁰

Likelihood of Confusion

We now turn to the issue of likelihood of confusion with respect to opposer's marks VALENTINO, VERY VALENTINO, VALENTINO and "V" design, and VALENTINO GARAVANI and "V" design. We have focused our likelihood of confusion analysis in this decision on the registered mark VALENTINO, which forms the dominant word portion of each of opposer's other marks. If applicant's mark VALENTINO RUDY so resembles opposer's word mark VALENTINO that confusion as to source would be likely, we need not address whether there is a likelihood of confusion between applicant's mark and opposer's other pleaded marks, although where relevant, we have addressed the other marks. Conversely, if there is no

⁹ Mr. Pappagallo testified that opposer first used the mark VALENTINO in the 1960's, Dep., p. 14, but the earliest records show advertising and sales in 1992. See Pappagallo Dep., p. 27, Exhibit E4.

¹⁰ See applicant's response to request for admissions No. 1: "Admit that June 15, 2005 is the earliest date for which Matsuda can rely, for priority purposes, in this opposition proceeding. Response: Admit."

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

likelihood of confusion when the marks VALENTINO and VALENTINO RUDY are compared, there will be no likelihood of confusion when comparing applicant's mark to opposer's other pleaded marks.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

Similarity of Goods; Trade Channels; Purchasers

We first turn our attention to a comparison of the similarity or dissimilarity and nature of the goods described in the applications and registrations.

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

We base our evaluation on the goods as they are identified in the registration and application. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). It is settled that it is not necessary that the respective goods be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). The goods need only be sufficiently related that consumers would be likely to assume, upon encountering the goods under similar marks, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

The goods identified in application Serial Nos. 78651011, 78651123, and 78651198 are identical to those of Reg. Nos. 2312756, 1140394, 0910955 and 1268029, all for the mark VALENTINO, as follows:

Serial No. 78651011 covers "spectacles" and Reg. No. 2312756 covers "spectacle frames and sunglasses."

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

Serial No. 78651123 covers "umbrellas, walking sticks and accessories, namely, replacement handles for walking sticks" and Reg. No. 1140394 covers "umbrellas and parasols."

Serial No. 78651198 covers:

clothing, namely, clothing tops, blouses, shirts, sweaters, cardigans, blazers, coats, suits, tuxedos, vests, suit coats, sport coats, top coats, jackets, parkas, jeans, slacks, dungarees, pants, trousers, shorts, skirts, culottes, jumpsuits, dresses, evening gowns, kimonos, stoles, shawls, fur coats and jackets, leather and wind resistant jackets, gowns, tunics, t-shirts, polo shirts, sweatshirts, sweatpants, sweat suits, warm-up suits, bathrobes, jogging suits, socks, pocket squares, gloves, mittens, hosiery, stockings, tights, leggings, leotards, belts, headwear, neckwear, sleepwear, underwear, loungewear, beachwear, swim wear, rainwear, tennis wear and footwear, all for men, women and children

and Reg. Nos. 0910955, 1268029 and 1153226 cover, respectively, "articles of clothing and accessories-namely, dresses, belts, gloves, scarves, swimwear, and ties"; "articles of clothing and accessories-namely, jumpers, sweaters, dresses, skirts, blouses, suits, jackets, coats, shirts, trousers, vests, jeans, slacks, shorts, swimwear, hats, lingerie, ties, belts, scarves, hosiery and gloves"; and "men's clothing-namely, suits, sport jackets, overcoats, shirts, trousers, bermuda shorts, and bathing suits."

Clearly, identical goods are related for purposes of finding a likelihood of confusion. Moreover, "[l]ikelihood of confusion may be found based on any item that comes

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

within the identification of goods in the involved application and registration." *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008).

In addition, the goods in Serial No. 78651057, "watches," are identical to those in opposer's registration No. 2826869 for the mark VALENTINO GARAVANI and "V" design for "men's and women's watches." Moreover, Mr. Pappagallo testified that in 2004, "Valentino USA was also distributing accessories" and he specifically mentions "fragrances, watches, sunglasses."¹¹

Turning to Serial No. 78651156, the goods include several different types of fabric, such as "clothing fabric" and "knitted fabric," as well as "kitchen towel," "bed sheets, comforter, duvet, fabric for bedding cover, pillow case, bed blanket," and "curtain, table cloth, thick curtain, shower curtain, black and white curtain, red and white curtain." These goods are identical to those in opposer's registration No. 2826869 for the mark VALENTINO GARVANI and "V" design, which covers, *inter alia*, "textile fabrics for use in the manufacture of clothing, bed linen, bed blankets, curtain, and kitchen towels." While Mr. Pappagallo testified that opposer never sold fabric goods,¹² in comparing the goods identified in the application and in

¹¹ Pappagallo Dep., p. 63.

¹² Pappagallo Dep., pp. 117-119.

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

the cited registration, " ... it is the identification of goods that controls, not what extrinsic evidence may show about the specific nature of the goods." *Peregrina*, 86 USPQ2d at 1646.

Next, we consider Serial No. 78651257, which covers "sporting equipment, namely, golf clubs, golf irons, golf bags." Opposer does not use the VALENTINO mark on golf clubs, golf irons, or golf bags,¹³ and none of the registrations cover these goods. To show that the goods on which opposer uses its VALENTINO mark are related to applicant's sporting equipment, opposer introduced copies of third-party registrations based on use, for marks owned by a single entity that cover both clothing items of the type sold by opposer and sporting equipment of the type sold by applicant. Copies of use-based, third-party registrations may serve to suggest that the goods are of a type which may emanate from a single source. *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd*, 864 F.2d 149 (Fed. Cir. 1988). *See also In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993).

The vast majority of third-party registrations submitted by opposer were based on Trademark Act § 66(a) and do not recite any dates of use of the involved marks. Such

¹³ Pappagallo Dep., p. 120.

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

registrations cannot serve to show that the purchasing public is aware of these marks. See *Calypto Tech., Inc. v. Calypso Capital Mgmt., LP*, 100 USPQ2d 1213, 1221 (TTAB 2011); *In re Princeton Tectonics, Inc.*, 95 USPQ2d 1509, 1511 (TTAB 2010); and *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) (third-party registrations not based on use in commerce have no probative value in showing the relatedness of the goods and/or services).

Of the remaining registrations, the following groups of registrations are relevant:

1. The mark CALLAWAY and design has been registered for "spin golf balls" (Reg. No. 2697487); CALLAWAY (stylized) has been registered for "golf clubs" (Reg. No. 1768763) and CALLAWAY GOLF has been registered for "clothing and headgear" and "golf equipment" (Reg. No. 2622352);
2. The mark PING has been registered for "golf clubs" (Reg. No. 704552) and for "clothing, namely, shirts, caps, sweaters, and sun visors" (Reg. No. 1637647);
3. ADIDAS has been registered for "sport shoes and sportswear" (Reg. No. 891222) and "balls of every kind" (Reg. No. 1050759); and
4. NIKE and design has been registered for various items of clothing (Reg. No. 2180866) and for "athletic and casual clothing for men, women and

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

children" (Reg. No. 1237469); NIKE SPHERE has been registered for "clothing and sports clothing apparel and outerwear" (Reg. No. 2804865); and NIKE GOLF has been registered for "all purpose sports bags, footwear and clothing" (Reg. No. 1944436).

The first two groups of marks (for CALLAWAY and PING) show that two companies have registered clothing and golfing equipment under a single mark, or in the case of the CALLAWAY marks, marks that bear the same common element. The ADIDAS and NIKE registrations are far less probative; although "balls of every kind" could include golf balls, and "all purpose sports bags" could conceivably include golf bags, there is no evidence of this in the record. Thus, this evidence is only minimally probative to show relatedness of the goods.

On the other hand, opposer has supplemented this showing with online evidence of third-party uses of clothing and golf equipment offered under a single mark:¹⁴

1. At www.overstock.com, the mark NIKE appears in connection with NIKE SLINGSHOT OSS LH IRON SET golf clubs and the NIKE XTREME SPORT CARRY II golf bag. The mark NIKE is also shown in connection with the advertisement, at <http://store.nike.com>, of a NIKE NO-SEW NOVELTY WOMEN'S GOLF POLO shirt.

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

2. At www.burberryusaonline.com, golf clothing and golf accessories (gloves, accessory bag, and clip on pouch) are advertised under the BURBERRY mark.

3. At www.ladygolfcourture.com, golf bags are advertised under the brand name ESCADA EURO and clothing is advertised under the brand name ESCADA SPORT.

4. At www.asos.com, a "golf carry bag" and "golf belt" are advertised on the same page as "golf" clothing under the mark BOSS. A BOSS "green golf long sleeve zip polo" and BOSS "green golf glove" are advertised at different pages on the website. Golf shoes are advertised under the BOSS mark at www.zappos.com.

5. At <http://shop.adidasgolf.com>, several different types of shirts are offered under the mark ADIDAS as well as the ADIDAS ASCEN 90 STAND BAG golf bag.

6. At www.lizclaiborne.com, under the mark LIZ CLAIBORNE, golf shirts, skirts, sweaters and slacks are offered as well as knitted covers for golf clubs and visors.

Taken as a whole, the evidence shows that consumers have been exposed to companies that sell clothing and, at the least, golf bags, balls, clubs and shoes under a single mark. This evidence supports opposer's position that the

¹⁴ Dougherty Declaration; exhibits F1-F6.

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

goods in applicant's Class 28 application are related to opposer's clothing.

For these reasons, we find that the parties' goods are identical in part and related in part. Where the parties' goods are identical or closely related, and in the absence of any limitation as to channels of trade in the identification of goods of any of the marks, we must presume that the parties' goods would be sold in the same channels of trade to the same classes of consumers. See *Hewlett-Packard*, 62 USPQ2d at 1005; *Octocom Systems*, 16 USPQ2d at 1788 ("an application with an identification of goods having no restriction on trade channels obviously is not narrowed by testimony that the applicant's use is, in fact, restricted to a particular class of purchasers."). See also, *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade."). Moreover, Mr. Pappagallo testified that opposer sells its product to "directly-operated boutiques, high-end department stores and outlets,

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

as well as specialty stores.”¹⁵ Applicant also sells its products “in established channels of trade such as upscale department stores” and in “major department stores,” and that “most department stores that carry our merchandise do so in dedicated in-store boutiques.”¹⁶

As to the conditions of sale, Mr. Pappagallo testified that opposer’s customers are “usually very high-end and sophisticated” but “we also have, what we call, the aspirational consumer that shop some pieces of our ready-to-wear, but a lot of accessories.”¹⁷ Ms. Matsumura stated in her declaration that applicant’s goods are “not luxury or couture products.” We conclude that customers of both parties include those that would exercise no more than ordinary care. In any event, even sophisticated or careful purchasers are not immune from source confusion. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) *citing Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) (“Human memories even of discriminating purchasers...are not infallible.”).

Accordingly, these *du Pont* factors weigh in favor of a finding of likelihood of confusion.

¹⁵ Pappagallo Dep., p. 16.

¹⁶ Matsumura Declaration, p. 3.

¹⁷ Pappagallo Dep., p. 20.

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

Comparison of the Marks

In comparing the marks, we must consider the marks in their entireties as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay*, 73 USPQ2d at 1692. 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 services 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).

In cases such as this case, where the applicant's goods are legally identical in part to the registrant's goods, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). *See also, In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed.

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

Cir. 2010); *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997).

Applicant's mark VALENTINO RUDY incorporates opposer's entire mark VALENTINO. They are similar in appearance and pronunciation. Likelihood of confusion has frequently been found where one mark incorporates the entirety of another mark. *Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL for gin and BENGAL LANCER for nonalcoholic club soda, quinine water and ginger ale); *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); and *In re South Bend Toy Manufacturing Company, Inc.*, 218 USPQ 479, 480 (TTAB 1983) (LIL' LADY BUG for toy doll carriages and LITTLE LADY for doll clothing).

Moreover, the general commercial impression of both marks, VALENTINO and VALENTINO RUDY, is that of a person's name. It is highly likely that consumers will believe that both marks identify a real person and that applicant's mark is merely the complete, full name of the individual whose first name is Valentino. Even those consumers who are familiar with the mark VALENTINO GARAVANI and "V" design may only remember it as "Valentino," and when confronted with applicant's mark, mistakenly believe that "Rudy" is the

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

actual surname or possibly an alternate middle name of the person who is otherwise known as Valentino. As VALENTINO is the first term in applicant's mark and the first literal term in opposer's VALENTINO GARAVANI mark, it is the part of the mark that is likely to be impressed upon the mind of a purchaser and remembered. *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (" ... it is often the first part of a mark which is likely to be impressed upon the mind of a purchaser and remembered"). See *Palm Bay*, 73 USPQ2d at 1692. Further, the words in opposer's mark are more likely to be remembered than the "V" design. When a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). As to the mark VERY VALENTINO, the adjective "very" merely serves to emphasize the impression of the dominant portion of the mark, i.e., VALENTINO.

Accordingly, we find the marks to be highly similar.

Strength of Opposer's Mark

Opposer contends that its VALENTINO mark enjoys "enormous recognition" and is entitled to a "broad enough scope of protection to prevent registration of [applicant's]

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

marks.”¹⁸ Applicant has criticized opposer’s evidence, contending that the record does not establish that the mark is strong. Opposer has not claimed that its mark is “famous,” however, and we find that the fame factor is neutral in this case. We also find, however, given opposer’s established long and continuous use of its VALENTINO mark, coupled with the arbitrary nature of the mark, that opposer’s mark is commercially strong.

Third-party Uses

The sixth *du Pont* factor requires consideration of any evidence pertaining to “the number and nature of similar marks in use on similar goods.” In an attempt to show that opposer’s mark lacks distinctiveness and is entitled to a narrow scope of protection, applicant has introduced copies of web pages advertising various products sold under the following marks: MARIO VALENTINO (perfume, neckties, shoes and sunglasses), FORTUNA VALENTINO (zip bag), SV BY SERENDIPITY VALENTINO (handbags and wallet), RODOLFO VALENTINO (shoes), HUGO VALENTINO (pajama pants), GEORGIO VALENTINO (sport coat and perfume), MARCO VALENTINO (belts), SERGIO VALENTINO (blazer), and VALENTINO ORLANDI (tote bag). In addition, Ms. Bass testified that she purchased each of the items (except GIORGIO VALENTINO brand perfume) and submitted receipts and copies of the actual products to show

¹⁸ Opposer’s Brief, p. 25.

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

that the marks are still in use in connection with these goods. Ms. Bass also testified to telephone calls she placed to "Valentino Tailor," a tailoring shop in New York, and "Valentino Shoe Repair," a shoe repair shop also located in New York. Mr. Pappagallo testified that he was aware of the brand GIOVANNI VALENTINO in connection with "accessories, small leather goods"¹⁹ and of the actor, RUDOLFO VALENTINO.²⁰

Although there are a sizeable number of third-party uses of "Valentino," all but the mark VALENTINO ORLANDI include the word "Valentino" in the second, less dominant, position. Moreover, opposer and "Mario Valentino S.N.C. Mario Valentino" entered into an agreement with respect to use of the MARIO VALENTINO brand.²¹ However, based on the evidence overall, we draw an inference that consumers have come to recognize that several other entities use the term VALENTINO as part of their mark in connection with products that may be used to accessorize clothing items. This factor favors applicant.

Lack of Actual Confusion

Applicant argues that the parties' marks have co-existed "in large parts of the world for nearly thirty

¹⁹ Pappagallo Dep., p. 130.

²⁰ Pappagallo Dep., p. 131.

²¹ Pappagallo Dep., p. 134-137.

Opposition Nos. 91174169, 91174171, 91174183, 91174195, 91174315, and 91179386

years.”²² While lack of actual confusion for a long period of time may be considered as evidence tending to show that confusion is unlikely, here whatever presupposition we could make regarding any lack of confusion depends upon circumstances entirely outside the United States. Moreover, actual confusion is not necessary to show a likelihood of confusion. See *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983). Accordingly, we conclude that the actual-confusion factor is neutral in this case.

Balancing the factors.

In view of the facts that opposer's mark VALENTINO is commercially strong, the marks are similar, and the goods related, we find that applicant's registration of the mark VALENTINO RUDY is likely to cause confusion with opposer's mark VALENTINO. These factors, going in opposer's favor, outweigh that which goes in applicant's favor, namely the existence of third-party uses of similar marks. While the third-party uses show that the VALENTINO mark exists in a somewhat crowded field, the existence of the third-party uses has not rendered opposer's mark weak.

Decision: The oppositions are sustained under Trademark Act Section 2(d).

²² Matsumura Declaration, p. 4.