

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed:  
May 6, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*Abercrombie & Fitch Trading Co.*

*v.*

*Artemides Holdings Pty. Ltd.*

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Opposition No. 91193275

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Susan M. Kayser of Jones Day for Abercrombie & Fitch Trading Co.

J. Joe Sadler of Warner Norcross & Judd LLP for Artemides Holdings Pty. Ltd.

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Before Quinn, Mermelstein and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Artemides Holdings Pty. Ltd. (“applicant”) filed an application to register the  
mark shown below



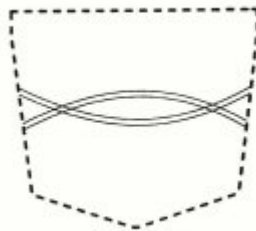
for the goods set forth below:

Clothing, namely, dresses, skirts, jackets, vests, coats, blazers, jumpers, sweaters, caftans, ponchos, shirts, blouses, knit shirts, T-shirts, sweatshirts, tops, polo shirts, trousers, pants, overalls, jeans, and denim trousers, shorts, camisoles, lingerie, sleepwear, women's underwear, swimwear, gloves, ties, scarves, headscarves, shawls, leather belts, fabric belt, socks, hosiery, in Class 25.<sup>1</sup>

In its application, applicant described its mark as follows: “The mark consists of two semi-circles that intersect to form an oval in the center.”

Abercrombie & Fitch Trading Co. (“opposer”) opposed the above-noted application on the ground of likelihood confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and dilution under Sections 13 and 43(c) of the Trademark Act, 15 U.S.C. §§ 1063 and 1125(c). Opposer pleaded ownership of the registrations listed below:

1. Registration No. 2626917 for the mark shown below for “clothing, namely, denim jeans sold in specialty retail clothing stores and Internet website,” in Class 25.<sup>2</sup>



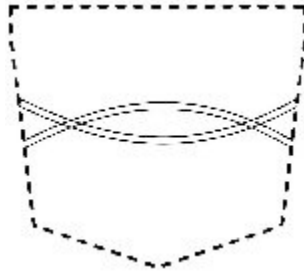
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<sup>1</sup> Serial No. 79064732, filed December 8, 2008. The filing basis for this application is a request for an extension of protection filed under Section 66(a) of the Trademark Act of 1946, 15 U.S.C. § 1141f, based on International Registration No. 0991757, registered on December 8, 2008.

<sup>2</sup> Registered on September 24, 2002 on the Supplemental Register; renewed.

In the registration, opposer described the mark as consisting “of a pair of double-lined stitches, extending continuously across the rear pocket of the goods. The stitches are curved, intersecting twice, forming an oval shape in the center of the pocket. The dotted lines are used to indicate the positioning of the mark on the goods and are not a feature of the mark.

2. Registration No. 3135750 for the mark shown below for “jeans, skirts, shorts, pants,” in Class 25.<sup>3</sup>



In the registration, opposer describes the mark as consisting “of a pair of double-lined stitches, extending continuously across the pocket of the goods. The stitches are curved, intersecting twice, forming an eye shape in the center of the pocket. The broken lines outlining the pockets are used to indicate the positioning of the mark on the goods and are not a feature of the mark.”

3. Registration No. 3951879 for the mark shown below for “denim bottoms, namely, jeans, skirts, shorts, pants; denim jackets; pants,” in Class 25.<sup>4</sup>

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<sup>3</sup> Registered on August 29, 2006 under the provisions of Section 2(f) of the Trademark Act; Sections 8 and 15 affidavits accepted and acknowledged.

<sup>4</sup> Registered on April 26, 2011. The mark was registered on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act.



In the registration, opposer describes the mark as consisting “of two curved double lines, intersecting twice, forming an eye shape in the center.”

In the Board’s September 6, 2013 Order denying applicant’s motion for summary judgment on the issue of likelihood of confusion, the Board suggested that the parties consider employing the Board’s Accelerated Case Resolution option.<sup>5</sup> The parties stipulated to a modified Accelerated Case Resolution option.<sup>6</sup> The parties agreed that “the briefs and submissions” filed in support and in opposition to the motion for summary judgment “shall be treated as the final records and briefs in the case,” and that the Board may resolve any disputed issues of fact, the parties may submit supplemental briefs and “any additional evidence ... may be filed via declaration or affidavit,” and the parties will submit a stipulation of facts.

#### The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), applicant’s application file. As indicated above, the

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<sup>5</sup> TTABVue 39.

<sup>6</sup> TTABVue 40. Because applicant filed its motion for summary judgment only on the issue of likelihood of confusion, and the parties stipulated to accelerated case resolution on the issue of likelihood of confusion, we find that the parties stipulated to the withdrawal of the dilution claim.

parties filed a stipulation of facts.<sup>7</sup> In addition, the parties introduced the testimony and evidence listed below.

A. Opposer's testimony and evidence.

1. Declaration of Susan M. Kayser, counsel for opposer, with attached exhibits,<sup>8</sup> including copies of opposer's pleaded registrations printed from the electronic database of the USPTO showing the current status of and title to the registrations,<sup>9</sup> applicant's responses to opposer's interrogatories,<sup>10</sup> and applicant's responses to opposer's request for admissions;<sup>11</sup> and

2. Declaration of Reid M. Wilson, Vice President and Associate General Counsel – Intellectual Property for opposer, with attached exhibits.<sup>12</sup>

B. Applicant's testimony and evidence.

1. Copies of third-party registrations for marks comprising back pocket stitching;<sup>13</sup>

2. A copy of opposer's application file for Serial No. 76258313 (Registration No. 2626917);<sup>14</sup>

3. Opposer's third supplemental responses to applicant's interrogatories;<sup>15</sup> and

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<sup>7</sup> TTABVue 42 and 43. TTABVue 43 is designated as confidential.

<sup>8</sup> TTABVue 37, p. 28.

<sup>9</sup> TTABVue 37, pp. 30-59.

<sup>10</sup> TTABVue 37, pp. 60-75.

<sup>11</sup> TTABVue 37, pp. 77-84.

<sup>12</sup> TTABVue 37, p. 85. See TTABVue 38 for information designated as confidential.

<sup>13</sup> TTABVue 32, pp. 15-30.

<sup>14</sup> TTABVue 32, pp. 32-59.

4. Declaration of C. Ryan Grondzik, an associate attorney with applicant's counsel, with attached exhibits.<sup>16</sup>

#### Standing

As indicated above, opposer has introduced its pleaded registrations into evidence. In addition, the parties stipulated to the current status and title to the registrations.<sup>17</sup> Because opposer has properly made of record its pleaded registrations, 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 has properly made of record its pleaded registrations, Section 2(d) priority is not an issue in this case as to the marks and the goods covered by the pleaded registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

#### Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key

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<sup>15</sup> TTABVue 32, pp. 61-86.

<sup>16</sup> TTABVue 44, pp. 15-25.

<sup>17</sup> TTABVue 42, pp. 2-3.

considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors and the other relevant *du Pont* factors are discussed below.

A. The similarity or dissimilarity and nature of the goods.

Applicant's description of goods and opposer's description of goods include jeans, skirts, shorts, pants, and jackets. Accordingly, the goods are in part identical. In analyzing the relationship of the goods, we need not find similarity as to each and every product listed in the Class 25 description of goods. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the description of goods in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

B. Established likely-to-continue channels of trade and classes of consumers.

Because the goods are in part identical and the parties' application and registrations contain no significant limitations as to the channels of trade and classes of purchasers,<sup>18</sup> we must presume that the channels of trade and classes of purchasers are the same. *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022,

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<sup>18</sup> We recognize that the description of goods in Registration No. 2626917 contains the language "sold in specialty retail clothing stores and Internet website." While this is a limitation, it does not affect our decision.

1028 (TTAB 2011). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). As such, the third *du Pont* factor – the similarity or dissimilarity of established, likely to continue trade channels – favors a finding of likelihood of confusion.

C. The fame of opposer’s mark.

This *du Pont* factor requires us to consider the fame of opposer’s mark. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments, and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses may have



sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Opposer introduced the evidence set forth below to demonstrate the fame of its mark. Much of opposer's evidence was designated as confidential and filed under seal and, therefore, we refer to such evidence only in general terms.

1. Opposer has used its mark in commerce since at least as early as February 2001;<sup>19</sup>

2. From 2004-2012, opposer's sales of clothing bearing the mark in its pleaded registrations has been substantial by any standard in terms of both units and dollars;<sup>20</sup>

3. Since 2001, the amounts spent for marketing and promotion of opposer's clothing products, which include the mark in opposer's pleaded registrations, has been substantial by any standard;<sup>21</sup>

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<sup>19</sup> TTABVue 42, p. 4.

<sup>20</sup> TTABVue 43, p. 4. Opposer did not introduce any testimony or evidence regarding its market share.

4. Opposer promotes its mark on its websites at Abercrombie.com and Abercrombiekids.com, on in-store photographs, hangtags, and through promotional emails;<sup>22</sup>

5. Opposer's websites receive several million hits per month;<sup>23</sup>

6. Opposer sells clothing bearing the mark in its pleaded registrations through its 410 retail stores located throughout the United States;<sup>24</sup>

7. From 2001-2007, opposer distributed over 16.6 million catalogs displaying and offering for sale clothing bearing the mark in opposer's pleaded registration;<sup>25</sup>

8. "Available at the websites victoriabeckham-jenna.blogspot.com, denimology.com, and denimblog.com are third-party photographs showing the following celebrities, Victoria Beckham, Gabrielle Anwar, Cameron Diaz, Lindsey Lohan, Ciara, and Nicollette Sheridan, wearing jeans or shorts bearing [opposer's] mark.";<sup>26</sup> and

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<sup>21</sup> TTABVue 43, p. 4. Opposer did not introduce any testimony or evidence regarding how the extent of its advertising compares to advertising of its competitors so that we could get an idea of the number of impressions received by consumers of opposer's mark vis-à-vis competing marks.

<sup>22</sup> TTABVue 42, p. 4.

<sup>23</sup> TTABVue 42, p. 4.

<sup>24</sup> TTABVue 42, p. 5. There is no testimony or evidence comparing the number of retail stores owned by opposer with its competitors (*e.g.*, more, less, comparable). Accordingly, we have no context in which to compare opposer's distribution with that of its competitors.

<sup>25</sup> TTABVue 42, p. 5.

<sup>26</sup> TTABVue 42, p. 5. Opposer did not introduce any testimony or evidence regarding how many people read these websites and, therefore, there is no way for us to judge the extent of that exposure.

9. Opposer has enforced its rights in the mark shown in its pleaded registrations against numerous third parties “resulting in these companies agreeing to cease use of similar marks and also abandoning applications for similar marks where filed.”<sup>27</sup>

In this case, the sales and advertising numbers for opposer’s products considered in light of opposer’s advertising and sales material featuring the house mark ABERCROMBIE & FITCH in conjunction with the mark in opposer’s pleaded registrations are not sufficiently independent from opposer’s ABERCROMBIE & FITCH mark that we may find the mark in opposer’s pleaded registrations is famous. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1308 (“we think those who claim fame for product marks that are used in tandem with a famous house mark can properly be put to tests to assure their entitlement to the benefit of fame for the product marks” because “[i]f a product mark used in tandem with a famous house mark ... has independent trademark significance, it should not be a great burden to substantiate the point.”). *See also Bridgestone Americas Tire Operations LLC v. Federal Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012) (the extensive advertising, media publicity, and critical acclaim for POTENZA and TURANZA brand tires established the independent strength of these tire marks, undiminished by the identification of Bridgestone as the manufacturer). In

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<sup>27</sup> TTABVue 43, p. 5. This evidence is not probative of the fame of opposer’s mark. Many of the third parties agreed to stop using their pants pocket stitching “without admitting any liability, expressly denying the same, solely to avoid the expense and distraction of protracted litigation, and wishing to settle its dispute with [opposer] amicably.” TTABVue 37, p. 225. *See also* TTABVue 38, pp. 39, 59, and 84.

other words, based on the evidence of record, we cannot independently assess the impact of the mark in opposer's registration on consumer perception. Nevertheless, we do find that the mark has a strong marketplace presence

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

This *du Pont* factor requires us to consider evidence pertaining to the number and nature of similar marks in use on similar goods. "The purpose of a defendant introducing third-party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different such marks on the bases of minute distinctions." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

Applicant contends that "back pocket jeans designs are widely prevalent in the designer jeans market, and [opposer's] mark is not unique."<sup>28</sup> To support this contention, applicant references the seven third-party registrations (three of which were canceled) for marks comprising stitching on pants pockets it introduced with its motion for summary judgment.<sup>29</sup>

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<sup>28</sup> Applicant's Supplemental Brief in Support of Motion for Summary Judgment, p. 5 (TTABVue 44, p. 6).

<sup>29</sup> Applicant's Motion for Summary Judgment, Exhibit A (TTABVue 32, pp. 15-30). Also, applicant proffered 11 third-party registrations for marks comprising stitching on pants pockets through the declaration of C. Ryan Grondzik, an associate in law firm representing applicant. (TTABVue 44, pp. 15-17). Applicant did not include copies of the registrations; applicant listed the registrations in Mr. Grondzik's declaration and embedded the marks in its supplemental brief. Opposer objected to the third-party registrations on the ground that they were not properly made of record because copies of the registrations were not placed into evidence. Opposer's Supplemental Trial Brief, pp. 5-6 (TTABVue 46, pp. 10-11). "A party that wishes to make such a third-party registration of record in a Board inter partes proceeding may do so by filing, during its testimony period, a plain copy of the registration

Applicant also introduced copies of the specimens from 11 third-party registration files.<sup>30</sup>

The third-party registrations and copies of the specimens of pocket stitching marks prove that such marks have been adopted and registered by others. However, the registrations and specimens are not evidence of the extent of any use or the market impact any of the specific designs may have made. Absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has

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or a printout of the registration from the Office's electronic database records." TBMP § 704.03(b)(1)(B) (June 2013). *See also Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 14894 (TTAB 2007) ("Submitting lists of third-party registrations ... is not an acceptable way to make such registrations ... of record."); *Racciopi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998) (incomplete excerpts of registrations held to be insufficient because "[o]nly soft copies of the registrations, or the complete electronic equivalents thereof obtained from the Office automated systems, are sufficient for purposes of making third-party registrations of record."). "[A] party may not make a third-party registration of record simply by introducing a list of third-party registrations that includes it ... or by referring to the registration in its brief or pleading." TMBP § 704.03(b)(1)(B). *See also Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007) ("Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial," therefore, because respondent failed to properly introduce any third-party registrations, respondent's reference to them in its brief did not suffice to make them of record). In view of the foregoing, opposer's objection to third-party registrations referenced in respondent's supplemental brief and the Grondzik declaration is sustained and those third-party registrations have not been considered.

<sup>30</sup> Grondzik Declaration ¶8 (TTABVue 44, p. 16). Opposer objected to copies of the specimens from the third-party registrations on the ground that applicant merely cut and pasted the specimens into the record rather than making the relevant portion of the registration files of record. Opposer's Supplemental Trial Brief, pp. 5-6 (TTABVue 46, pp. 10-11). "The file history of a third-party registration (), or a portion thereof, may be made of record by: (1) filing, during the offering party's testimony period, a copy of the file history, or the portion it wishes to introduce ...; or (2) appropriate identification and introduction of a copy of the file history, or portion thereof, during the taking of testimony; or (3) stipulation of the parties, accompanied by a copy of the file history or portion thereof." TBMP § 704.03(b)(1)(B). Opposer's objection is overruled. Mr. Grondzik's declaration is sufficient to authenticate the copies of the specimens and we will give them the probative value they merit.

become familiar with them. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office); *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011). *See also In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983).

[I]t would be sheer speculation to draw any inferences about which, if any of the marks subject of the third party (sic) registrations are still in use. Because of this doubt, third party (sic) registration evidence proves nothing about the impact of the third-party marks on purchasers in terms of dilution of the mark in question or conditioning of the purchasers as to their weakness in distinguishing source.

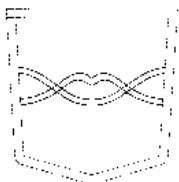
*In re Hub Distributing, Inc.*, 218 USPQ at 286. *See also Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (“As to strength of a mark, however, registration evidence may not be given any weight”).

The same analysis applies for the probative value of the copies of the specimens.

Finally, we note that the mark in the third-party registration that is closest to opposer’s mark has been cancelled.<sup>31</sup> A cancelled registration has no evidentiary value as to the scope of protection afforded to the mark in opposer’s pleaded registrations. *See Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d

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<sup>31</sup> Registration No. 2481854 for the mark shown below was cancelled March 30, 2012.



1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“a cancelled registration does not provide constructive notice of anything.”).

Applicant points out that the mark in Registration No. 2481854 was cited as a bar to opposer’s application to register its mark [Registration No. 2626917].

[Opposer] has previously argued that its mark () is not confusingly similar to the Hot Kiss mark (). Regardless of the merits or that argument, [opposer] cannot credibly contend that its mark is distinct from Hot Kiss’, while at the same time contending that its own mark is confusingly similar to [applicant’s]. If [opposer] and Hot Kiss can exist in the marketplace together, there is certainly ample room for [applicant’s] mark, which looks nothing like either of them.<sup>32</sup>

In its application for registration, opposer was seeking to register its pleaded mark for “clothing, namely, denim jeans sold in specialty retail clothing stores and Internet website.” In seeking to overcome the likelihood of confusion refusal with the mark in Registration No. 2481854 for “clothing, namely, jeans,” opposer argued that the marks “are conceptually different, and create distinctly overall [sic] commercial impressions,”<sup>33</sup> in part because the marketing conditions under which the marks will be encountered are different.<sup>34</sup>

[Opposer], therefore, respectfully submits that no other products, other than [opposer’s] products, are sold in [opposer’s] retail stores, catalogs, and websites, including [opposer’s] goods bearing its Stitching Design mark. Thus, the referenced mark is not sold and would not be

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<sup>32</sup> Applicant’s Motion for Summary Judgment, p. 9 (TTABVue 32, p. 10). *See also* Applicant’s Supplemental Brief in Support of Motion for Summary Judgment, p. 7 (TTABVue 44, p. 8).

<sup>33</sup> TTABVue 32, p. 40.

<sup>34</sup> *Id.* at 41.

expected by a purchaser or a prospective purchaser to be sold in [opposer's] stores, catalogs, and/or website.<sup>35</sup>

There was a restriction in the marketing channels in opposer's application that we are not dealing with in this case because the description of goods in opposer's Registration Nos. 3135750 and 3951879 are not restricted or limited in any way.

Opposer's previous statements in a prior application to overcome a likelihood of confusion rejection have limited probative value because it is this panel that must decide whether the marks at issue are likely to cause confusion based on the evidence of record. This duty may not be delegated by adopting the arguments of opposer in attempting to overcome a likelihood of confusion refusal in an application for registration.

That a party earlier indicated a contrary opinion respecting the conclusion in a similar proceeding involving similar marks and goods is a fact, and that fact may be received in evidence as merely illuminative of shade and tone in the total picture confronting the decision maker. To that limited extent, a party's earlier contrary opinion may be considered relevant and competent. Under no circumstances, may a party's opinion, earlier or current, relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record.

*Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978).

Also, what opposer argued to the USPTO to overcome the refusal to register based on the mark in Registration No. 2481854 is of little value because the issue before us is the likelihood of confusion between opposer's mark and applicant's

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<sup>35</sup> *Id.*



mark, not the third-party mark. *See Stock Pot Restaurant, Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665, 669 (Fed. Cir. 1984), quoting *Krug Vins Fins de Champagne v. Rutman Wine Co.*, 197 USPQ 572, 574-75 (TTAB 1977) (“The conflict here is between petitioner [appellee] and respondent [appellant] and not between petitioner and the world.”); *Maytag Co. v. Luskin’s, Inc.*, 228 USPQ 747, 750 (TTAB 1986) (“another's prior use of a confusing similar mark for the same goods or services, may not be relied upon as a defense in opposition and cancellation proceedings.”). Opposer is entitled to oppose applicant’s application if it can show that it has superior rights.

In view of the foregoing, the number and nature of similar marks in use on similar goods does not affect the strength of the mark in opposer’s pleaded registrations. This factor is neutral.

E. The similarity of dissimilarity of the marks in their entirety in terms of appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that where, as here, the goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach*

*Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Further, “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721. *See also San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Since the goods at issue are clothing, the likelihood of confusion involves ordinary consumers.

The marks at issue are displayed below:

Applicant’s Mark

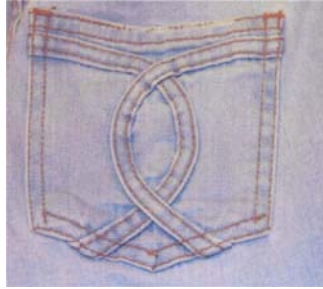


Opposer’s Mark



The marks applied to jeans are shown below:

Applicant's Mark<sup>36</sup>



Opposer's Mark<sup>37</sup>



Applicant asserts that “the marks at issue here simply do not look alike.”<sup>38</sup> Applicant asserts that its “mark is clearly oriented on a vertical axis and its lines originate from the corners of the pocket, which is a striking contrast from [opposer’s] and most every other jean manufacturer on the market. The ‘legs’ of the mark, which extend past the intersection point of the lines, are likewise notable and different from [opposer’s] marks. [Applicant’s] mark is evocative of an Egyptian hieroglyph and, at the same time, could suggest to viewers the intersection of two chain-links. [Opposer’s] is a standard back-pocket design that does not evoke similar connotations.”<sup>39</sup>

With regard to applicant’s argument, where the question of likelihood of confusion involves design marks which are not capable of being spoken, the

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<sup>36</sup> TTABVue 44, p. 19.

<sup>37</sup> TTABVue 37, p. 98.

<sup>38</sup> Applicant’s Supplemental Brief in Support of Motion for Summary Judgment, p. 2 (TTABVue 44, p. 3).


<sup>39</sup> *Id.* Although two of opposer’s registrations show the mark on a pocket (in dotted lines), Registration No. 3951879 does not indicate its placement on a pocket, so it could be used anywhere on the goods.


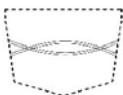
question of the similarity of the marks must be determined on the basis of their visual similarity. Undoubtedly, if the marks were placed side by side for comparison, specific differences in them could be detected and those differences might well be enough to distinguish one from the other. *See In re Vienna Sausage Mfg. Co.*, 16 USPQ2d 2044, 2047 (TTAB 1990); *Matsushita Electric Industrial Co., Ltd. v. Sanders Associates, Inc.*, 177 USPQ 720, 726 (TTAB 1973). However, that is not the appropriate test. It is highly unlikely that the marks of these parties would be viewed together. When such marks are seen at different times on identical goods, the recollection of the first viewed mark will be a general impression most likely devoid of the details noted by applicant. The focus must be on the “general recollection” reasonably produced by a purchaser's encounter with opposer's mark and a mental comparison of applicant's mark therewith. *See Johann Maria Farina Gegenuber Dem Julichs-Platz v. Chesebrough-Pond, Inc.*, 470 F.2d 1385, 176 USPQ 199, 200 (CCPA, 1972). Consideration must also be given to the fact that a purchaser's recollection of design marks is often of a general and hazy nature. So considered, it is the intersecting arcs of the marks that impresses or provides the initial impact when viewing both marks. The overall similarity of the marks is such that there is reasonable likelihood of purchasers attributing identical products sold thereunder to a single source.

E. Balancing the factors.

Taking into account the strength of opposer's mark, because the marks are similar, the goods are in part identical and the presumption that the goods move in

the same channels of trade and are sold to the same classes of consumers, we find

that applicant's mark  for "clothing, namely, dresses, skirts, jackets, vests, coats, blazers, jumpers, sweaters, caftans, ponchos, shirts, blouses, knit shirts, T-shirts, sweatshirts, tops, polo shirts, trousers, pants, overalls, jeans, and denim trousers, shorts, camisoles, lingerie, sleepwear, women's underwear, swimwear, gloves, ties, scarves, headscarves, shawls, leather belts, fabric belt, socks, hosiery" is

likely to cause confusion with opposer's marks  and  for "denim bottoms, namely, jeans, skirts, shorts, pants; denim jackets; pants."

**Decision:** The opposition is sustained and registration to applicant is refused.