

**This Opinion is Not a
Precedent of the TTAB**

Mailed: August 7, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

*Victoria's Secret Stores Brand Management, Inc. v. Yael
Mamroud/Cummins*¹

—
Opposition No. 91201001
against Serial No. 85007380
—

Kevin C. Parks and Michelle L. Zimmermann of Leydig Voit & Mayer Ltd.
for Victoria's Secret Stores Brand Management, Inc.

Yael Mamroud, *pro se*.²

—
Before Kuhlke, Lykos and Gorowitz,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On April 6, 2010, Yael Mamroud (“Applicant”) filed an application to register on the Principal Register the stylized mark displayed below

¹ See discussion, *infra*, “Applicant’s Motion to Amend.”

² Applicant was advised to secure the services of legal counsel familiar with Board proceedings but has chosen to appear *pro se* in this matter. Interlocutory Order dated September 28, 2011.



for “Organic hair care and skin care products, namely, shampoo, conditioner, styling creams, hair gels, hair sprays, skin water toners, bath salts, face and body creams, and skin moisturizers” in International Class 3.³

Victoria’s Secret Stores Brand Management, Inc. (“Opposer”) opposed the registration of Applicant’s mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with Opposer’s previously used and registered VS and VSX formative marks.⁴ Opposer pleaded common law use as well as ownership of various registered VS and VSX stylized marks and applications, including the following:

³ Application Serial No. 85007380, filed pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), alleging a bona fide intent to use the mark in commerce.

⁴ Opposer also asserted a claim of dilution under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), in the notice of opposition. However, insofar as Opposer has not argued any dilution claim in its brief we find, in accordance with the Board’s usual practice, that this claim has been waived. *See, e.g., Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005).



for “Personal care products, namely, body lotions; body mist; shower gel; eau de parfum; scented body powder” in International Class 3 and “Clothing, namely, bras; panties; pajamas; lingerie, robes; slippers” in International Class 25.⁵

In her answer, Applicant denied the salient allegations therein.

I. *Applicant’s Motion to Amend*

Before turning to the substance of this appeal, the Board must address Applicant’s oral motion to amend the application to correct a mistake in the name of the applicant which was deferred until final decision. *See* Interlocutory Orders dated July 25, 2012 and August 30, 2012. As originally filed, the owner of the application was identified as “Yael Mamroud/ Cummins,” a Canadian corporation. In addition, in response to the Trademark Examining Attorney’s requirement to sign the application, Applicant completed the application in the following manner:

⁵ Registration No. 4118910, issued March 27, 2012 from an application filed on April 20, 2009, alleging July 2, 2009 as the date of first use anywhere and October 1, 2009 as the date of first use in commerce for the goods identified in International Class 3 and October 1, 2009 as the date of first use anywhere and in commerce for the goods identified in International Class 25. The description of the mark is as follows: “The mark consists of STYLIZED “VS” LOGO.” Color is not claimed as a feature of the mark.

SIGNATURE SECTION	
DECLARATION SIGNATURE	/YaelMamroud/Cummins/1234/
SIGNATORY'S NAME	Yael Mamroud
SIGNATORY'S POSITION	Vice President
DATE SIGNED	01/18/2011
RESPONSE SIGNATURE	/YaelMamroud/Cummins/1234/
SIGNATORY'S NAME	Yael Mamroud
SIGNATORY'S POSITION	Vice President
DATE SIGNED	01/18/2011
AUTHORIZED SIGNATORY	YES

During a telephone conference with the assigned Board Interlocutory Attorney to this case, Applicant moved to amend Applicant’s name to “9226-8754 Quebec Inc. DBA Vitamin & Sea.” Opposer filed a written response in opposition thereto, arguing that an application filed in the name of the wrong party is void and cannot be corrected by amendment. Specifically, Opposer contended that because 9226-8754 Quebec Inc. was formed after the filing date of the involved application, it could not be the owner of the application. This prompted Applicant to withdraw her proposed amendment and instead move to amend the application to clarify that “I,

Yael Mamroud (the applicant) am a legal person and not a corporation.” Applicant’s Reply in Support of Motion to Amend dated September 6, 2012. To obfuscate matters further, Applicant, when filing her main brief, stated that she “owns, operates and holds the title of President of the company Vitamin & Sea, that has been incorporated under the name 9226-8754 Quebec Inc.” Applicant’s Brief, p. 4. However, during discovery Applicant stated that “Applicant is an individual. Vitamin & Sea was incorporated in April 2010 with Yael Mamroud as President and Mark Cummins as the General Manager.” Opposer’s Notice of Reliance, Ex. 14 (Applicant’s Answer to Opposer’s First Set of Interrogatories No. 14).

If the party applying to register the mark is, in fact, the owner of the mark, but there is a mistake in the manner in which the name of the applicant is set out in the application, the mistake may be corrected by amendment. *U.S. Pioneer Elec. Corp. v. Evans Mktg., Inc.*, 183 USPQ 613 (Comm’r Pats. 1974). However, the application may not be amended to designate another entity as the applicant. Trademark Rule 2.71(d). *See also* Trademark Manual of Examining Procedure (“TMEP”) § 803.06 (April 2014). An application filed in the name of the wrong party is void and cannot be corrected by amendment. *Huang v. Tzu Wei Chen Food Co.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988); *Great Seats, Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235, 1244 (TTAB 2007); *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (TTAB 1991). Section 1201.02(c) of the TMEP sets forth examples of correctable errors in identifying an applicant, including the following:

- *Inconsistency in Original Application as to Owner Name or Entity.* If the original application reflects an inconsistency between the owner

name and the entity type, for example, an individual and a corporation are each identified as the owner in different places in the application, the application may be amended to clarify the inconsistency.

This case squarely falls within this category of correctable errors given the multitude of internal inconsistencies in the application regarding the nature of Applicant's entity type, name and title. Further, Applicant's proposed amendment to an individual is supported by her discovery responses. Accordingly, Applicant's motion to amend the owner name to "Yael Mamroud," an individual, is granted **contingent upon Applicant providing her citizenship thirty (30) days from the mailing date of this decision, failing which the motion is denied.**

II. *The Record*

The record includes the pleadings, and pursuant to Trademark Rule 2.122(b), Applicant's application file. Opposer filed a notice of reliance consisting of printouts obtained from the USPTO Trademark Electronic Search System ("TESS") database showing the current status of and title to its pleaded registrations, including Reg. No. 4118910;⁶ copies of Opposer's First Set of Interrogatories and First Set of Requests for Admissions with Applicant's answer thereto;⁷ copies of the amended complaint and consent judgment in federal district court litigation involving

⁶ During the course of this proceeding, Opposer's pleaded Registration No. 2244265 was cancelled pursuant to Section 8 of the Trademark Act.

⁷ Opposer also submitted under notice of reliance documents produced by Applicant in response to Opposer's Request for Production of Documents. To the extent that certain of the produced documents are self-authenticating under Trademark Rule 2.122(e) as printed publications obtained from the Internet they are admissible. Otherwise, the documents are inadmissible as per Trademark Rule 2.120(j)(3)(ii) and have not been considered. For a further explanation, consult the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 704.11 ("Produced Documents") (2014).

Opposer as plaintiff against a third-party; and printed publications, namely, articles obtained from the Westlaw News database discussing Opposer's VS brand name and mark as well as printouts from Opposer's and third-party web sites. Opposer also introduced the testimony depositions of Jeremy Tjhung, Associate Vice President of Brand Creative, Victoria's Secret Stores Brand Management, Inc., with Exhibits 1-6 attached thereto; and Sarah Crispi, Senior Counsel, L Brands, Inc. with Exhibits 7-10 attached thereto.

Applicant filed a voluminous notice of reliance which we will not summarize in this opinion.⁸ Opposer has interposed numerous evidentiary objections to Applicant's notice of reliance relating to admissibility such as hearsay and lack of witness testimony to authenticate documents. We see no need to discuss the objections individually, as none of them is outcome determinative. Opposer is reminded that under *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031 (TTAB 2010), a document obtained from the Internet may be admitted into evidence pursuant to a notice of reliance in the same manner as a printed publication in general circulation, in accordance with Trademark Rule 2.122(d), so long as the date the Internet documents were accessed as well as their source (the Internet address or URL) is provided and the party filing the notice of reliance indicates the general relevance of the documents. Suffice to say, we have considered, where appropriate, the entirety of Applicant's notice of reliance in making our decision, keeping in mind

⁸ By Board order dated March 31, 2014, Applicant's motion to rely on her "declaration" and the "declaration" of Mark Cummins at trial, which were submitted with Applicant's responsive brief to Opposer's motion for summary judgment, was denied under Trademark Rule 2.123(b).

Opposer's various objections, and have accorded whatever probative value the evidence merits.⁹

III. *Designation of Confidential Matter*

Applicant designated the entirety of its appeal brief as confidential pursuant to the Board's standard protective order. This was improper. Only the particular portion of a brief that discloses confidential information should be filed as confidential in ESTTA.¹⁰ If a party submits a brief containing information designated as confidential in ESTTA, the party must also submit for the public record a redacted version of the brief. *See* Trademark Rules 2.27(e) and 2.126(c). In other words, for confidential submissions filed via ESTTA two versions are required – a confidential version as well as a redacted version available for public view.

Accordingly, Applicant is allowed thirty (30) days from the mailing date of this decision to submit a redacted brief in which only information that is truly confidential is deleted, failing which the original brief will become part of the public record. *See, e.g., Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1136 n.9 (TTAB 2009).¹¹

IV. *Standing*

Because Opposer has properly made its pleaded registrations of record for


⁹ That being said, any materials produced during discovery which are inadmissible under notice of reliance have not been considered.

¹⁰ ESTTA is the acronym for Electronic System for Trademark Trials and Appeals, the Board's online electronic filing system. For more information regarding ESTTA, consult TBMP § 110.09 (2014).

¹¹ The Board in its opinion has referenced from Applicant's brief only non-confidential matter.

various VS and VSX formative marks, we find that Opposer has established its standing to oppose registration of Applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

V. Section 2(d) Claim

We will now consider Opposer's Section 2(d) claim, focusing on Opposer's Registration No. 4118910 for the  mark for the goods listed in International Class 3, "[o]rganic hair care and skin care products, namely, shampoo, conditioner, styling creams, hair gels, hair sprays, skin water toners, bath salts, face and body creams, and skin moisturizers." This is because when that mark is considered vis-à-vis the applied-for mark and identified goods, it is that mark that is most likely to support a finding of likelihood of confusion. In other words, if confusion is likely between these marks, there is no need for us to consider the likelihood of confusion with Opposer's other marks, and if there is no likelihood of confusion between Applicant's mark and Opposer's mark, then there would be no likelihood of confusion with Opposer's other pleaded marks. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Priority

Applicant contends that Opposer has failed to demonstrate common law use of its mark prior to the filing date of Applicant's intent-to-use application on April 6, 2010, the earliest date on which Applicant can rely. However, priority is not in issue in view of Opposer's ownership of its valid and subsisting Registration No. 4118910

for the Class 3 goods identified therein. *See King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

B. Likelihood of Confusion

The remaining issue in this case is likelihood of confusion. Opposer, as plaintiff in this proceeding, bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence.

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). “Not all of the *du Pont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). For example, the Board can “focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.” *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citation omitted). These factors and the other relevant *du Pont* factors are discussed below.

First, we turn to a comparison of the parties' respective goods. Applicant argues that the goods are “not legally identical to Opposer's goods as they do not share a common Country of origin or value.” Applicant's Brief, p. 18. Applicant contends that its goods are “unique and unmistakable” in part because Applicant's goods are “made in Canada, vegan, cruelty free, hypoallergenic, fragrance free, free trade....”

Applicant's Brief, p. 12. Applicant's arguments necessarily fail because the distinctions noted by Applicant are not reflected in the involved application or registration. In Board proceedings, we base our evaluation on the goods as they are identified in the application and registration at issue. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *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). Here, the involved application and Opposer's pleaded Registration No. 4118910 involve goods that are legally identical, at least in part. This is because Opposer's broadly worded "skin moisturizers" identified in its pleaded registration necessarily encompass Applicant's more narrowly identified "body lotions." For this same reason, Applicant's contention that its products are unisex whereas Opposer's goods are for women exclusively, is also of no avail. Given that the goods are legally identical, at least in part, the second *du Pont* factor weighs in favor of finding a likelihood of confusion.

Because the goods are legally identical in part, and neither Opposer's Registration No. 4118910 nor the involved application contains any limitations on the channels of trade and classes of purchasers, we must presume that the channels of trade and classes of purchasers are the same. *See Stone Lion*, 110 USPQ2d at 1161; *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, 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 – also favors a finding of likelihood of confusion.

Next we consider the conditions under which the goods are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers. Purchaser sophistication may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005). Applicant argues in her brief that while Opposer’s body lotions are priced competitively with various “drugstore” brands with a median price of seven dollars (\$7), by contrast Applicant’s body lotions, which are sold at high-end salons, spas, and luxury brand retailers, have a median price of forty-five dollars (\$45). Applicant’s Brief, p. 19.

Applicant’s arguments are unconvincing. Because the involved application and registration are unrestricted, we must assume that both Applicant’s and Opposer’s identical goods are sold to the same purchasers under the same conditions. *See, e.g.,*

In re Bercut-Vandervoort & Co., 229 USPQ 763, 764 (TTAB 1986) (where both applicant's and registrant's goods were identified as "wine," applicant not permitted to distinguish its French wine by extrinsic evidence of higher quality and price). While we acknowledge that consumers may exercise a greater degree of care in the purchase of Applicant's body lotions costing \$45, because Applicant's identification is not limited to goods sold at this price point, we must consider all types, including those sold at a lower price point. The same logic applies to Opposer's unrestricted registration. We therefore find that the fourth *du Pont* factor weighs in favor of finding a likelihood of confusion.

We now turn to the *du Pont* likelihood of confusion factor regarding the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay*, 73 USPQ2d at 1691. "The 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*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). Because the goods are legally identical, the degree of similarity between the marks that is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). In addition, the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Jack B.*

Binion, 93 USPQ2d 1531 (TTAB 2009); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Both parties' stylized marks are comprised, either in whole or in part, of the letters "V" and "S" in virtually the same stylized font. As Opposer testified,

From a typography point of view, both marks use almost identical fonts. The font generally refers to the relative height of the letter versus the width of the letter. The difference in the relationship between the thick strokes and thin strokes. ...[I]f you look between the two V's they are practically identical. ...When you talk about the letter S, again both the V and the S from the applicant's mark are very similar to the approved Victorian Roman font that we use....

Tjhung Deposition 83:6-20. We agree with Opposer's assessment of the parties' marks that the similarity in font style is striking.

That being said, our analysis cannot be predicated on dissection of the involved marks. *See Stone Lion*, 110 USPQ2d at 1161. Rather, we are obliged to consider the marks in their entireties. *Id.* *See also, Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). Nonetheless, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1161. We observe that Applicant's mark includes an additional element, namely the inclusion of an ampersand between the letters "V" and "S." Applicant argues that the addition of the ampersand in Applicant's mark changes the sound, appearance, connotation

and overall commercial impression to “vee and ess” so as to avoid a likelihood of confusion. Applicant’s Brief, p. 17. However, given the relatively small size of the ampersand in relation to the letters “V” and “S,” it more likely that prospective consumers encountering Applicant’s stylized mark will overlook the ampersand, and perceive and pronounce the mark as the acronym “VS” as opposed to “V and S.” Indeed, we find persuasive Opposer’s testimony that “[t]he ampersand in the middle looks like an afterthought.” Crispi Deposition 41:18-19. We therefore find that because the individual letters “V” “S” are the dominant feature of Applicant’s mark, the involved marks are far more similar than dissimilar in sound, appearance, connotation and commercial impression.

Applicant also points to her applied-for mark as being derivative of her trade name and registration for the mark VITAMIN & SEA, thereby creating a different connotation and commercial impression. Unless the company name is “sufficiently well known,” the fact that the letters are derived from a company’s trade name does not obviate the likelihood of confusion. *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 533 (TTAB 1986). Rather,

...[c]onfusion is more likely between arbitrarily arranged letters than between other types of marks. ... We think that it is well known that it is more difficult to remember a series of arbitrarily arranged letters than it is to remember figures, syllables, words, or phrases. The difficulty of remembering such lettered marks makes confusion between such marks, when similar, more likely.”

Id. In view of the forgoing, the first *du Pont* factor favors a finding that confusion is likely.

Turning now to the fifth *du Pont* factor, Opposer concentrates on the fame of its VICTORIA'S SECRET trademark in connection with intimate apparel and beauty care products (which Applicant has admitted is famous), and argues that it is likely that consumers will perceive its stylized mark as a "shortened version" of its famous VICTORIA'S SECRET mark. Opposer's Brief, p. 12. However, as Applicant correctly points out, Opposer did not plead ownership of any of its VICTORIA'S SECRET trademarks in the notice of opposition. Thus, Opposer's evidence and arguments regarding the fame of its VICTORIA'S SECRET marks have no bearing here. The fifth *du Pont* factor is therefore neutral.¹²

Next we consider the sixth *du Pont* factor, namely 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*, 73 USPQ2d at 1694. Applicant argues that "the use of the letters V and S together and as a stand alone" constitutes "a common generic abbreviation for the word versus" and for this reason has been used by a variety of well-known companies such as Versace and Vidal Sassoon as their trademark. Applicant's Brief, p. 9.

¹² Applicant also argues that her applied-for mark is famous and that this mitigates any likelihood of confusion. Applicant's argument is misplaced. The fifth *du Pont* factor pertains only to the fame of the *prior* mark.

We simply cannot find that Opposer's mark is weak on this basis. The record is devoid of any evidence regarding the number of similar third-party uses of similar marks for similar goods. Accordingly, we deem this factor to be neutral.

In the present case, each of the *du Pont* factors discussed above either favor a finding of likelihood of confusion or are deemed neutral. Accordingly, we find that Opposer has proved its standing, as well as priority and likelihood of confusion under its Section 2(d) claim by a preponderance of the evidence.

Decision: The opposition is sustained.