

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
August 7, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Coach Services, Inc.

v.

E&D Trading, Inc.

Opposition No. 91203818

Jean Clemente, Esq. for Coach Services, Inc.

Helen B. Jiang of Law Office of Helen B. Jiang for E&D Trading, Inc.

Before Holtzman, Cataldo, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

E&D Trading, Inc. (“applicant”) filed an application to register the trademark shown below:

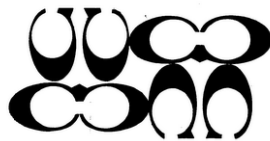


for the following goods:

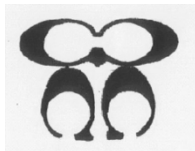
Cases for eyeglasses and sunglasses; Cases for spectacles and sunglasses; Chains for spectacles and for sunglasses; Eyewear, namely, sunglasses, eyeglasses and ophthalmic

frames and cases therefor; Eyewear, namely, sunglasses, optical frames, reading glasses; Frames for spectacles and sunglasses; Lenses for sunglasses; Nose guards which can be worn by attachment to eyewear such as sunglasses and ski goggles; Spectacles and sunglasses; Sunglass chains and cords; Sunglass lenses; Sunglasses; Sunglasses and spectacles, in International Class 9.¹

Coach Services, Inc. (“opposer”) opposed registration of the mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant’s mark, as used in connection with applicant’s goods, so resembles opposer’s two previously used and registered marks shown below as to be likely to cause confusion, mistake or deception. Opposer has pleaded ownership of six U.S. registrations of the following mark, as set forth in the margin:²



Opposer has pleaded ownership of one registration of the following mark:³



Applicant’s answer consists of a general denial of the allegations in the notice of opposition.

¹ Application Serial No. 85277491, filed on March 25, 2011 under Trademark Act § 1(a), 15 U.S.C. § 1051(a), claiming January 15, 2011 as the date of first use and February 28, 2011 as the date of first use in commerce.

² Reg. No. 2832589, issued on April 13, 2004; Reg. No. 3695290, issued on October 13, 2009; Reg. No. 2822318, issued on March 16, 2004; Reg. No. 2822629, issued on March 16, 2004; Reg. No. 2592963, issued on July 9, 2002; Reg. No. 2626565, issued on September 24, 2002.

³ Reg. No. 3396554, issued on March 11, 2008.

The parties stipulated that, in lieu of taking trial testimony or discovery, each may rely on affidavits, declarations, any documents annexed thereto, and notices of reliance as evidence in this proceeding.⁴ The parties also agreed to proceed under the “stipulated record and trial briefs” model of Accelerated Case Resolution.⁵ See TBMP § 702.04(d) (3d ed. rev. 2012). In connection with such agreement, the parties stipulated that:

- (a) Opposer has standing to bring this opposition;
- (b) Opposer has priority of use of its pleaded marks;
- (c) The goods of the parties are identical and otherwise similar for purposes of likelihood of confusion.⁶

The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the application file for applicant’s mark. The record also includes the following evidence submitted by opposer:

1. Four notices of reliance upon the following documents:
 - No. 1: Copies of seven certificates of registration of opposer;
 - No. 2: File of opposer’s Application Serial No. 76348453;
 - No. 3: File of opposer’s Application Serial No. 77687107;
 - No. 4: File of applicant’s involved application.

⁴ Stipulation filed October 8, 2012.

⁵ Board order of October 30, 2012 (cited herein as “Stipulation Order”).

⁶ *Id.* The Board commends the parties for their utilization of Accelerated Case Resolution (ACR) and the efficiencies realized thereby.

2. Affidavit of Jean Clemente, counsel to opposer and to Coach, Inc., with attachments thereto:

Attachment I: Website visitor numbers;

Attachment II: (not of record);⁷

Attachment III: Copies of seven registration certificates of opposer (duplicative of notice of reliance No. 1);

Attachment IV: Advertisements for marked goods of opposer;

Attachment V: Sales figures for marked goods of opposer;

Attachment VI: Advertisements for marked eyewear of opposer;

Attachment VII: Sales figures for marked eyewear of opposer.

Opposer has filed its brief. Applicant has filed neither a brief nor any evidence.

Evidentiary Matters

Pleaded Registrations.

Opposer has filed, with its notice of reliance No. 1 and as Attachment III to the Clemente affidavit, copies of its seven pleaded registrations as originally issued. These copies do not set forth the current status or title of the registrations. The parties have stipulated that all documents attached to an affidavit or notice of reliance “will be admissible as evidence and may be relied on by either party.”⁸ However, the documents provided by opposer do not establish opposer’s current ownership or the current status of the registrations. The parties have stipulated to

⁷ Attachment II refers the Board to the <Coach.com> website for a copy of opposer’s 2012 SEC Form 10-K. Such a reference is not sufficient to make this material of record.

⁸ Stipulation Order, item 6.

opposer's "priority of use of its pleaded marks,"⁹ but not to opposer's ownership of registrations. The proper method for establishing the ownership and status of a registration is to file:

(a) a copy of the registration prepared and issued by the Office showing both the current status of and current title to the registration; or (b) a current printout of information from the electronic database records of the Office such as (i) TSDR (Trademark Status and Document Retrieval) showing the current status and title (owner) of the registration and, if the TSDR printout does not reflect the current owner of the registration, a printout from the Office's Assignment database demonstrating an assignment to the current owner of the registration; or (ii) TESS (Trademark Electronic Search System) along with a copy of any records from the Assignment database showing an assignment to the current owner of the registration.

TBMP § 704.03(b)(1)(A); *see also* 37 C.F.R. § 2.122(d)(2); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1654 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011).

The "Status" and "Current Owner(s) Information" sections of the TSDR record contain information regarding the maintenance and renewal of the registration and the current ownership of the registration. Similarly, the TESS record sets forth ownership and maintenance information. To the extent that either of these records is not up-to-date, the rules require additional evidence from the Assignment records of the Office. The documents filed by opposer lack such current information and are not sufficient under 37 C.F.R. § 2.122(d)(2) and TBMP § 704.03(b)(1)(A). Accordingly, although the copies of the original registration

⁹ *Id.*, item 3.

certificates are in evidence, they do not sufficiently establish the current ownership or status of the registrations.

The Clemente Affidavit.

The Clemente affidavit sets forth information relating to use of opposer's pleaded marks not by opposer but by an entity called Coach, Inc. Although the affidavit and opposer's brief appear to assume that there is a relationship between Coach, Inc. and opposer, there is nothing in the record to explain what that relationship may be. If the Clemente affidavit were necessary to establish opposer's priority of use of its marks or the nature of opposer's goods, it would be inadequate to do so. However, these two issues have been addressed by stipulation of the parties. To the extent that the affidavit addresses other matters at issue in this proceeding (and we note that opposer's claim of fame is entirely dependent on the affidavit), it leaves unanswered the question of how activities of Coach, Inc. could inure to the benefit of opposer. In order to ensure that opposer's claims receive a full hearing, we have considered the Clemente affidavit, with the *caveat* that its relevance to opposer is uncertain. We note that, even if we were to interpret the Clemente affidavit as if it related to opposer in all ways, doing so would not alter our ultimate decision in this matter,

Standing and Priority

The parties have stipulated that opposer has standing to bring this opposition; and that opposer has priority of use of its pleaded marks.¹⁰ Accordingly,

¹⁰ *Id.*, items 2 and 3.

we consider opposer's standing and priority to be established without more evidence.

Likelihood of Confusion

We consider next whether applicant's mark is likely to cause confusion with opposer's pleaded marks under Trademark Act § 2(d). As opposer's ownership of its pleaded registrations has not been established, opposer must initially prove that it owns "a mark ... previously used in the United States... and not abandoned..." Trademark Act Section 2(d), 15 U.S.C. § 1052(d). We take the parties' stipulations as establishing that opposer "has priority of use of its pleaded marks" for goods that are "identical or otherwise similar" to those of applicant. The Clemente affidavit corroborates that opposer's rights in its marks extend to the field of eyewear:

10. ... the Signature C Design¹¹ has been used on eyewear since Coach first expanded into the eyewear market. Coach's direct sales in the eyewear market exceed forty-one million dollars (US\$41,000,000).

11. The Signature C design is featured prominently on many models of eyewear, among them "Hayley", "Brand", "Aubree", "Joelle", "Carla", and "Pamela." ...

12. In 2012, the yearly sales of Signature C marked eyewear in the United States was one million eight hundred thousand dollars (US \$ 1,800,000). ...

Although the Clemente affidavit does not address when opposer's marks were first used on eyewear, opposer's priority is established by stipulation.

¹¹ Opposer often refers to its two registered marks in the singular, as if they were two versions of one basic mark (presumably the one shown in Reg. No. 3396554). Opposer's brief refers to this basic mark as the "CC Logo trademark"; the Clemente affidavit refers to it as the "Signature C Design."

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, as set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services at issue. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In the case before us, opposer has also presented evidence and arguments as to the fame of its marks, the parties' customers and the parties' trade channels.

Goods; Trade Channels; Customers.

That the goods of the parties are identical or similar has been established by stipulation. There is also evidence showing that opposer has sold sunglasses under the mark,¹² confirming that the parties' goods are, in fact, identical at least in part. To the extent that the parties' goods are identical, we must presume that they move through the same channels of trade and are offered to the same classes of customers. *See American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994); *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). Accordingly, the three *du Pont* factors relating to the similarity or dissimilarity of the goods, the trade channels, and likely customers favor a finding of likelihood of confusion.

¹² Clemente affidavit ¶ 10-11 and Attachment VI; opposer's notice of reliance No. 3, specimen of use.

The Fame of Opposer's Marks.

Opposer maintains that its marks are famous and argues that “[T]here is no excuse for even approaching the well-known trademark of a competitor ... all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous...” Opposer’s brief at 5, *quoting Nina Ricci S.A.R.L. v. E.T.F. Enters.*, 889 F.2d 1070, 1074, 12 USPQ2d 1901 (Fed. Cir. 1989). Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection. 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). 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’s demonstration of fame rests primarily on evidence of strong sales of its goods and extensive advertising and marketing expenditures, as set forth in the Clemente affidavit.¹³ Ms. Clemente, in her affidavit, testifies that opposer’s

¹³ We reiterate our *caveat* that the relevance of the Clemente affidavit to opposer is questionable; but for purposes of opposer’s argument of fame we read the affidavit as if it applies to opposer. If we did not do so, the relevance of the affidavit to the case before us

“Signature C Design is a world-renowned design, synonymous with quality”; that it was first used in 2000 on handbags and other goods; and that in 2012 opposer expended \$89.2 million on consumer communications relating to the mark, and \$245.2 million on advertising, marketing and design costs.¹⁴ Ms. Clemente states that the Signature C Design “features heavily” on opposer’s internet web site, which received over 45 million visits from persons residing in the United States from July 2011 to May 2012.¹⁵ She states that opposer offers for sale over 200 different products under the mark, which is “arguably my Company’s most famous trademark”;¹⁶ that worldwide sales under the mark exceeded \$4 billion in both 2011 and 2012; and that U.S. sales under the mark in 2012 were \$1.5 billion.¹⁷ Annual sales under the mark in the U.S. in 2008 to 2011 ranged between \$1.1 billion in 2010 and \$1.5 billion in 2008.¹⁸ She states that in 2012, sales of eyewear under the mark were \$1.8 million.¹⁹ Sales of marked eyewear in the U.S. in 2008 through 2011 ranged between \$6.9 million in 2010 to \$2.3 million in 2008.²⁰

A showing of sales and advertising expenditures relating to marked goods over a substantial period of time is a valid way of indirectly demonstrating the

would be so uncertain that we would have to conclude that opposer has made no showing of fame or public recognition.

¹⁴ Clemente affidavit ¶ 6.

¹⁵ *Id.* ¶ 5 and Attachment I.

¹⁶ *Id.* ¶ 8.

¹⁷ *Id.* ¶ 9 and Attachment V.

¹⁸ *Id.*, Attachment V.

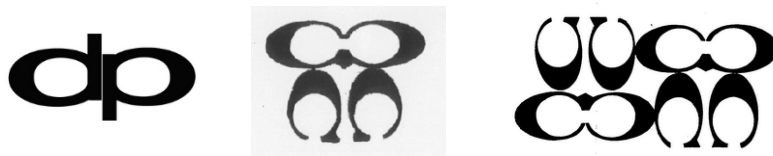
¹⁹ *Id.* ¶ 12 and Attachment VII.

²⁰ *Id.*, Attachment VII.

mark's fame. *Bose*, 63 USPQ2d at 1305-1306 and 1309. However, opposer's showing is somewhat limited in scope. Opposer provides no commercial context for its raw statistics, such as evidence of how opposer's sales and marketing expenditures compare to others in its industry, or evidence of opposer's market share. Opposer also provides no evidence of actual consumer recognition of opposer's marks. We find that opposer's evidence of vigorous promotion of its marks and sales of goods under them weighs in favor of a finding of likelihood of confusion. However, it is insufficient to demonstrate actual fame or an objectively high level of customer recognition.

The Marks.

We turn next to address the similarity or dissimilarity of the parties' marks (shown below) in terms of appearance, sound, meaning, and overall commercial impression.



Applicant's mark consists of the stylized, lower-case letters DP and would likely be perceived as such by typical customers. To the extent that these letters have meaning, that meaning would differ from the meaning of opposer's marks, which consist of the repeated letter C displayed in various orientations. If applicant's mark were pronounced, the most likely pronunciation would be "DP." It is doubtful whether opposer's marks would be pronounced, but if they were they

would most likely be pronounced “C” or “CC” or “CCCC.” Accordingly, to the extent the marks would be pronounced, their pronunciations would differ substantially.

Opposer argues, however, that when the marks are viewed as designs, rather than letters, they are “substantially identical” and “strikingly similar.” Opposer argues that both applicant’s mark and opposer’s marks

use two joined letters to create a circular aesthetic. Further, in Coach’s CC Logo trademark, the sides of the joined C’s are emphasized and are much fuller than the top or bottom of the C’s. The DP Design uses a similar design where the sides of the “d” and “p” are also disproportionally accentuated and the top and bottom are slender.

Opposer’s brief at 7.

Opposer urges us to consider applicant’s mark alongside a cropped version of opposer’s marks that shows only two C’s facing each other in mirror image, thus:



However, the cropped version of the opposer’s marks was not pleaded by opposer and there is no evidence that opposer has ever used its marks in this cropped form. Rather all of the evidence of record indicates that opposer uses its marks in forms in which there are not only four C’s or eight C’s (*i.e.*, the forms of the two pleaded marks), but rather as a repetitive pattern that covers large surfaces of the goods with innumerable iterations of the marks. *See* Clemente affidavit, Attachment IV; and notice of reliance No. 3 (specimen of use). Opposer argues further:

Since the dominant and the most significant identifying part of these two marks is the circular formation created

by the joined letters, the difference of the small stems coming off the lowercase “d” and “p” are minor, particularly when the stems of the “d” and the “p” disappear into the overall design, and the consumer is left with the impression of two circles. Consequently, the difference between the marks in overall appearance is negligible. Likelihood of confusion could be even further compounded if E&D used its DP Design in repeat on a product or packaging. ... A customer could easily be confused by seeing the DP design used in repeat in such a manner.

Opposer’s brief at 7-8.

While we perceive some similarity in the oval shapes of which the marks of applicant and opposer are formed, we are not persuaded that the marks are highly similar in appearance. Opposer’s two pleaded marks consist, respectively, of four and eight oval shapes, some oriented vertically and some oriented horizontally. Applicant’s mark consists only of two horizontally oriented ovals. Moreover, applicant’s mark clearly appears to consist of the lower-case letters DP, and the two letters are separated from each other rather than conjoined; by contrast, in opposer’s marks the unusual orientations and reversals of the letter C transform the marks into something that is visually distinct from a mere repetition of the letter C. Thus, while applicant’s mark has the character of a combination of letters, opposer’s marks have the character of abstract designs, albeit composed of iterations of the letter C in various orientations and reversals. While opposer might, in another context, have occasion to object to any use by applicant of its mark as a repeating pattern, that issue is not before us because applicant does not seek to register a repeating pattern mark. Moreover, there is no evidence that applicant has ever used its mark as a repeating pattern. *See* opposer’s notice of

reliance No. 4, showing a sample of applicant's goods with the mark displayed in large format on the temple of a pair of eyeglasses. Overall, we find applicant's mark to be dissimilar in appearance, meaning, sound, and overall commercial impression from opposer's pleaded marks.

Balancing the Factors

Having considered the evidence of record and all relevant *du Pont* factors, including those not specifically discussed herein, we find the dissimilarity of the marks to be dispositive of this case. *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive.") We find that applicant's mark, as applied to applicant's goods, is not likely to give rise to confusion, mistake or deception as to the source of applicant's goods.

Decision: The opposition is dismissed.