

ESTTA Tracking number: **ESTTA745324**

Filing date: **05/09/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91217033
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Date	05/09/2016
Attachments	20160509_T08313DS_TU_RebuttalBrief.pdf(175007 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

KIKO S.r.L.)
)
)
 Opposer,)
) Opposition No. 91217033
 v.)
)
 DOOYEON CORP.)
)
)
 Applicant.)
 _____)

APPLICANT DOOYEON CORP.'S TRIAL BRIEF

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I. TABLE OF CONTENTS

	Page
I. TABLE OF CONTENTS.....	i
II. INDEX OF CASES.....	ii
III. INTRODUCTION	1
IV. DESCRIPTION OF THE RECORD	3
V. STATEMENT OF THE ISSUES.....	5
VI. RECITATION OF THE FACTS	6
VII. ARGUMENT	9
VIII. CONCLUSION.....	19
IX. APPENDIX.....	21

II. INDEX OF CASES

	Page(s)
Cases	
<i>Application of Burndy Corp.</i> , 300 F.2d 938, 133 U.S.P.Q. 196, 197 (C.C.P.A. 1962).....	13
<i>Century 21 Real Estate Corp. v. Century Life of America</i> , 970 F.2d 874, 23 U.S.P.Q.2d 1698 (Fed. Cir. 1992)	14
<i>Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce</i> , 228 U.S.P.Q. 689, 1986 WL 83634 (T.T.A.B. 1986).....	14
<i>In re E.I. DuPont DeNemours & Co.</i> , 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).....	9, 10
<i>In re Electrolyte Laboratories, Inc.</i> , 929 F.2d 645, 16 U.S.P.Q.2d 1239 (Fed. Cir. 1990)	13
<i>Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.</i> , 954 F.2d 713, 21 U.S.P.Q.2D 1388 (Fed. Cir. 1992)	9, 10
<i>Franklin Mint Corp. v. Master Mfg. Co.</i> , 667 F.2d 1005, 212 U.S.P.Q. 233 (C.C.P.A. 1981).....	10
<i>Georgia-Pacific Corp. v. Great Plains Bag Co.</i> , 614 F.2d 757, 204 U.S.P.Q. 697, 699 (C.C.P.A. 1980).....	13
<i>In re Homeland Vinyl Prod., Inc.</i> , 81 U.S.P.Q.2d 1378, 2006 WL 2794003 (T.T.A.B. 2006).....	9
<i>HRL Assoc., Inc. v. Weiss Assoc., Inc.</i> , 12 U.S.P.Q.2d 1819, 1989 WL 274391 (T.T.A.B. 1989).....	15
<i>Interlego AG v. Abrams/Gentile Entertainment, Inc.</i> , 63 U.S.P.Q. 1862, 2002 WL 31039614 (T.T.A.B. 2002).....	11, 12, 13, 15
<i>Kenner Parker Toys Inc. v. Rose Art Indus., Inc.</i> , 963 F.2d 350, 22 U.S.P.Q.2d 1453 (Fed. Cir. 1992)	15
<i>Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC</i> , 82 U.S.P.Q.2d 1901, 2007 WL 749713 (T.T.A.B. 2007).....	16

<i>Lebanon Seaboard Corp. v. R&R Turf Supply Inc.</i> , 101 U.S.P.Q.2d 1826, 2012 WL 953406 (T.T.A.B. 2012)	16
<i>Olay Co., Inc. v. Avon Prod., Inc.</i> , 178 U.S.P.Q. 502, 1973 WL 19958 (T.T.A.B. 1973)	14
<i>Presto Prod., Inc. v. Nice-Pak Prod. Inc.</i> , 9 U.S.P.Q.2d 1895, 1988 WL 252340 (T.T.A.B. 1998)	14
<i>Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., Inc.</i> , 703 F.2d 1372, 217 U.S.P.Q. 505 (Fed. Cir. 1983)	16
<i>In re Vittera, Inc.</i> , 671 F.3d 1358, 101 U.S.P.Q.2d 1905 (Fed. Cir. 2012)	11, 12
<i>Witco Chem. Co. v. Whitfield Chem. Co.</i> , 418 F.2d 1403, 164 U.S.P.Q. 43 (C.C.P.A. 1969)	10
<i>Yamaha Int’l Corp. v. Hoshino Gakki Co., Ltd.</i> , 840 F.2d 1572, 6 U.S.P.Q.2d 1001 (Fed. Cir. 1988)	9
<i>In Re ZOLO Tech., Inc.</i> , 2002 WL 1844232 (T.T.A.B. 2002)	12

Statutes

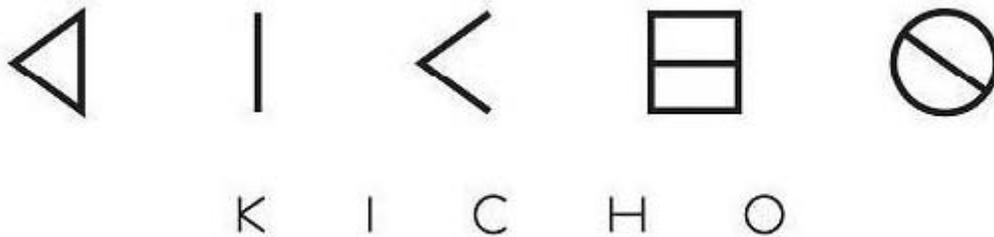
15 U.S.C. § 1052(d)	5, 19
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Other Authorities

37 C.F.R. §2.123(b)	3
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III. INTRODUCTION

Applicant Dooyeon Corp. (“Applicant”) is a company based in South Korea that sells specific cosmetic products commonly known as “Korean Beauty” or “K-Beauty” products. The terms “Korean Beauty” or “K-Beauty” are not only used in Korea, but also by large cosmetic retailers in the United States such as Sephora, Birchbox, and Amazon, which target consumers who are sophisticated and pay a premium as they specifically seek out Korean cosmetic products that will help produce the “look” for which Koreans are known in other Asian countries and in the United States. It is in this context that Applicant seeks to register the following mark:



(“Applicant’s Mark”).

Opposer Kiko, S.p.a. (“Opposer”), by its own description, is an “Italian-based company” that sells “affordable European-designed and produced products.” Opposer has registered the word marks “KIKO MAKE UP MILANO” and “KIKO” (collectively, “Opposer’s Marks”).

In its trial brief, Opposer only establishes, at best, a possibility of confusion between Opposer’s Marks and Applicant’s Mark. As established below, however, that is not enough. Indeed, Opposer has the burden to prove that there is a sufficient likelihood and/or probability of confusion between Applicant’s Mark and Opposer’s Marks. Opposer, however, fails to satisfy its burden. Indeed, as specified below, most, if not all, of the *DuPont* factors weigh in favor of

the Applicant. Accordingly, the Trial and Trademark Appeal Board (the “Board”) should dismiss Opposer’s Opposition and permit the registration of Applicant’s Mark.

IV. DESCRIPTION OF THE RECORD

In its trial brief, Applicant relies upon the following materials:

- A. Applicant's Notice of Reliance, dated December 27, 2015, and all attachments thereto.
1. Opposer's Answers to Applicant's Interrogatories
 2. Affidavit of Applicant's Deputy Department Head, Charles Kim, dated December 27, 2015, and Exhibits A – I attached thereto, submitted per the stipulation of the parties and the Board's September 29, 2015 Order permitting such testimony by affidavit per Trademark Rule 37 CFR § 2.123(b).
 3. Internet publication from Sephora, available at <http://www.sephora.com/korean-skin-care>, last accessed on December 22, 2015 (relating to, among other things, commercial impression of marks, dissimilarity of goods and the conditions under which and buyers to whom sales are made).
 4. Internet publication from Birchbox, available at <https://www.birchbox.com/shop/from-korea-with-love-collection>, last accessed on December 22, 2015 (relating to, among other things, commercial impression of marks, dissimilarity of goods and the conditions under which and buyers to whom sales are made).
 5. Internet publication from Amazon, available at <http://www.amazon.com/b?node=11585018011>, last accessed on December 22, 2015 (relating to, among other things, commercial

impression of marks, dissimilarity of goods and the conditions under which and buyers to whom sales are made).

6. Certified copy of a decision entered by the Patent and Trademark Office in South Korea, transmitted on April 7, 2014 in Application No. 40-2013-0009027, Objection No. 40-2013-0001739 in opposition proceeding initiated by Opposer against Applicant.
 7. Wikipedia digraph entry for “ch,” (noting that “*ch* is most commonly pronounced as [\[tʃ\]](#), as in *chalk*, *cherry*, *church*, *much*, etc.”), available at https://en.wikipedia.org/wiki/Ch_%28digraph%29, last accessed on December 26, 2015.
- B. Opposer’s Notice of Reliance, dated October 28, 2015, and all attachments thereto.

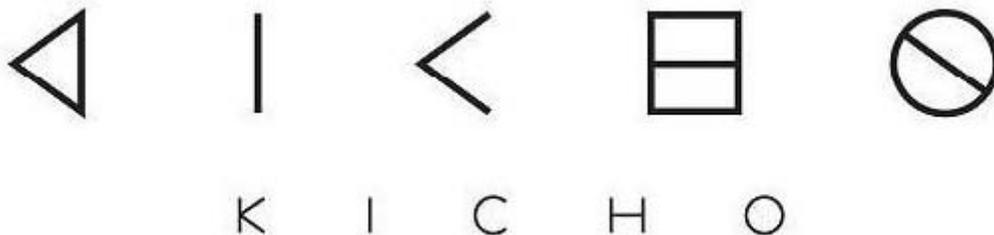
V. STATEMENT OF THE ISSUES

The primary issue before the Board is whether there is a *sufficient* likelihood – rather than a mere possibility - of confusion, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), between Applicant's Mark and the Opposer's mark so as to sustain the Opposer's opposition and preclude the registration of the Applicant's Mark.

VI. RECITATION OF THE FACTS

Applicant Dooyeon Corp. (“Applicant”) is a South Korean company that was founded in 2012, specializing in the manufacturing and exportation of a wide array of Korean cosmetic products. Ex. 2 of Applicant’s Notice of Reliance, Affidavit of Charles Kim (“Kim Aff.”), at ¶ 5. Opposer Kiko, S.P.A. (“Opposer”) is an Italian company that advertises, markets and sells KIKO-branded products as “affordable European-designed and produced products. . .” Ex. 3 of Opposer’s Notice of Reliance, Affidavit of Stefano Percassi (“Percassi Aff.”), at ¶ 9; *see also id.* at ¶ 5. Indeed, one of Opposer’s Marks is KIKO MAKE UP MILANO, indicating its place of origin. *See* Ex. 1 of Opposer’s Notice of Reliance.

Applicant filed this instant application (Application Serial No. 86/053,930) on September 3, 2013 for the registration of the following mark:



(“Applicant’s Mark.”). Kim Aff. at ¶ 15. Although “KICHO,” spelled in Korean as “키초” has no meaning in the Korean or English language, it was derived as a play on the Korean word for “basic,” spelled in Korean as “기초.” *Id.* at ¶ 7. The syllable “키” in the Korean spelling of KICHO is pronounced like the first three letters in the English word “keep,” and the syllable “기” in the Korean word for “basic” is pronounced like the first three letters in the English word “geese” (“kee” v. “gee”). *Id.* Both KICHO and the Korean word for “basic” share the same

second syllable, “초,” which is pronounced as the “cho” is pronounced in the words “macho” and “nacho.” *Id.*

This play on the Korean word for “basic” was intentional, as “basic” serves as the first out of five core principles upon which the KICHO brand adheres. *Id.* at ¶ 8; *see also* Ex. A to the Kim Aff. The design portion of the proposed mark was designed to serve as an infographic. Kim Aff. at ¶ 9; *see also* Ex. B to the Kim Aff.

Applicant developed various products that adhered to its five core principles. Kim Aff. at ¶ 10; *see also* Ex. C to the Kim Aff. Applicant’s products are featured as products that provide benefits from the use of various natural extracts. Kim Aff. at ¶ 10. It is this use of various natural extracts that helps produce the “look” for which Koreans are known in other Asian countries and in the United States. *Id.* at ¶ 11. Indeed, the terms “Korean Beauty” or “K-Beauty” are currently used by cosmetic retailers in the United States such as Sephora, Birchbox, and Amazon. *Id.*; *see also* Exs. D-F to the Kim Aff.; Exs. 3 – 5 of Applicant’s Notice of Reliance.

Applicant promotes and advertises its products and its brand through various print advertisements, including in publications such as Allure and International bntWorld, and websites, including Facebook (<https://www.facebook.com/kichoworldwide/>) and Instagram (https://www.instagram.com/kicho_cosmetics/), all of which promote the products in the context of the “Korean Beauty/K-Beauty” concept. Kim Aff. at ¶ 14; *see also* Exs. G, H to the Kim Aff. Applicant’s products are currently sold at its flagship store in Seoul, South Korea, in third-party stores in Singapore, Malaysia, Vietnam, China and Taiwan, and through its website. Kim Aff. at ¶ 13. Purchasers of Applicant’s products know about and seek out Korean beauty products. *Id.* at ¶ 12. Such purchasers are sophisticated customers who make deliberate decisions to seek out

Korean beauty products and are willing to pay a premium for beauty products. *Id.* Indeed, the cost of Applicant's products are significantly higher than other brands of cosmetic products, including Opposer's products, which, as noted above, are marketed as "affordable European-designed and produced products." *Id.*; *see also* Percassi Aff. at ¶ 9; *compare* Ex. C to the Kim Aff. *with* Ex. A to the Percassi Aff.

Applicant has not received any reports of, and is not aware of, any instances of actual confusion between Dooyeon's Mark and those that are the subject of the opposition by Opposer. Kim Aff. at ¶ 16. Indeed, other foreign agencies have also recognized that there is no, and/or insufficient, likelihood of confusion between the KICHO and Kiko marks so as to preclude the registration of the KICHO mark. *Id.* at ¶ 17. The Patent and Trademark Office in South Korea denied Opposer's opposition to Applicant's application for registration, ruling that Applicant's Mark and the Opposer's Marks are not similar in appearance or sound, among other things. *Id.* Additionally, Applicant's Mark has been registered/allowed in Hong Kong (Application/Registration No. 303138183), the Philippines (Application No. 4/2015/00006225), and Russia (2014731500/50) despite the registration of the Opposer's mark in those countries. *Id.*

VII. ARGUMENT

Simply stated, there is an insufficient probability of confusion between Applicant's Mark and Opposer's Marks so as to sustain Opposer's opposition and preclude registration of Applicant's Mark. The Board's determination "is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue." *In re Homeland Vinyl Prod., Inc.*, 81 U.S.P.Q.2d 1378, 2006 WL 2794003, at *1 (T.T.A.B. 2006).

Factors that the Board must consider include:

- (1) the fame of the prior mark;
- (2) the similarity of the marks;
- (3) the similarity of established, likely-to-continue trade channels;
- (4) the similarity and nature of the goods and services;
- (5) the conditions under which and buyers to whom sales are made;
- (6) evidence of actual confusion;
- (7) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
- (8) the market interface between applicant and the owner of a prior mark; and
- (9) the extent of potential confusion.

In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

The Opposer alleging a sufficient likelihood of confusion "has the burden of proof to establish that applicant does not have the right to register its mark." *Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 1579, 6 U.S.P.Q.2d 1001 (Fed. Cir. 1988).

Importantly, Opposer must establish a sufficient *probability* of confusion, not a mere *possibility*. *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 719, 21

U.S.P.Q.2D 1388 (Fed. Cir. 1992). Indeed, it is well established that the Board is “not concerned with mere theoretical possibilities of confusion, deception, or mistake . . . but with the practicalities of the commercial world, with which the trademark laws deal.” *Id.* at 717 (citing *Witco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d 1403, 1405, 164 U.S.P.Q. 43 (C.C.P.A. 1969)).

As noted above, the Opposer fails to satisfy its burden to establish that there is more than a mere possibility of confusion. The marks at issue are not sufficiently similar. Additionally, Opposer fails to sufficiently establish fame of its mark(s). While the goods sold by Applicant and Opposer may overlap to a certain extent and share certain trade channels, the conditions under which, and buyers to whom, sales are made sufficiently differentiate Applicant’s and Opposer’s goods and marks. Indeed, there is no evidence of actual confusion, and the market interface between the Applicant and the Opposer as they concurrently use their marks establish the lack of any potential confusion.

A. The Marks at Issue Are Not Sufficiently Similar

When considering the similarity or dissimilarity of the marks at issue, the Board considers the marks “in their entirety as to appearance, sound, connotation and commercial appearance.” *DuPont*, 476 F.2d at 1361. Indeed, “[i]t 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.” *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007, 212 U.S.P.Q. 233 (C.C.P.A. 1981).

In its trial brief, Opposer submits that the Applicant’s Mark and Opposer’s Marks are similar in both sound and appearance. Applicant addresses each of these points in turn.

1. Applicant's Mark and Opposer's Marks Sound Different

As noted above, although the word portion of Applicant's Mark ("KICHO"), spelled in Korean as "키초," has no meaning in the Korean or English language, it was derived as a play on the Korean word for "basic," spelled in Korean as "기초." Kim Aff. at ¶ 7. The syllable "키" in the Korean spelling of KICHO is pronounced like the first three letters in the English word "keep," and the syllable "기" in the Korean word for "basic" is pronounced like the first three letters in the English word "geese" ("kee" v. "gee"). *Id.* Both KICHO and the Korean word for "basic" share the same second syllable, "초," which is pronounced as the "cho" is pronounced in the words "macho" and "nacho." *Id.* This play on the Korean word for "basic" was intentional, as "basic" serves as the first out of five core principles upon which the KICHO brand adheres. *Id.* at ¶ 8.

Notwithstanding that the word portion of Applicant's mark and KIKO¹ are, in fact, pronounced differently, Opposer submits that there is a sufficient likelihood that the "CH" in KICHO may be pronounced like the "K" in KIKO. In support of this contention, Opposer relies on *In re Vittera, Inc.*, 671 F.3d 1358, 101 U.S.P.Q.2d 1905 (Fed. Cir. 2012) and *Interlego AG v. Abrams/Gentile Entertainment, Inc.*, 63 U.S.P.Q. 1862, 2002 WL 31039614 (T.T.A.B. 2002).

Opposer's reliance on those two cases, however, is misplaced, and the two cases are clearly distinguishable from this case. As Opposer notes in its brief, the court in *In re Vittera, Inc.* held that "XCEED" and "X-Seed" were sufficiently similar in sound. 671 F.3d at 1367. In that case, the applicant contended that the two marks sounded sufficiently different because the

¹ It should be noted that one of Opposer's Marks is not merely "KIKO," but "KIKO MAKE UP MILANO"

applicant intended “XCEED” to be pronounced with an emphasis on the second syllable while “X-Seed” was pronounced with an emphasis on the first syllable. *Id.*

Here, however, the issue as to sound is not whether people will know to emphasize a particular syllable as intended, but, rather, whether there is a sufficient likelihood – and, indeed, more than a mere possibility – that people will pronounce KICHO like KIKO. While Opposer submits that people may possibly pronounce the characters “CH” as “K” in certain limited circumstances, it fails to establish that it is likely people will do so. Indeed, to the contrary, it is well established that “CH,” in English, “is most commonly pronounced as [tʃ], as in *chalk*, *cherry*, *church*, *much*, etc.” Ex. 7 to Applicant’s Notice of Reliance, at 2. Importantly, for the marks at issue in *In re Vittera, Inc.*, the “C” in “XCEED” and the “S” in “X-Seed” are interchangeable. In other words, the character “C” may often be pronounced as “S,” and “S” may also often be pronounced as “C.” Here, while there are limited circumstances in which “CH” may be pronounced as “K,” the Opposer fails to establish any possibility that “K” may at times be pronounced as “CH.” Indeed, this Board has cited to this lack of interchangeability as a reason to hold that two marks do not sound the same. *See In Re ZOLO Tech., Inc.*, 2002 WL 1844232, at *3 (T.T.A.B. 2002) (holding that “ZOLO” and “SOLO” do not sound sufficiently similar to establish a likelihood of confusion, because, in part, the “Z” in “ZOLO” and the “S” in “SOLO” do not have interchangeable pronunciations).

Similarly, *Interlego* is also distinguishable from this case. In that case, the Board held that “LEGO” and “MEGO” sounded sufficiently similar so as to cause a likelihood of confusion. *Interlego*, 63 U.S.P.Q. 1862, 2002 WL 31039614, at *2. As the Board stated, however, the Board’s holding in that case was made “given the great fame of opposers’ LEGO mark.” *Id.* In addition to the fact that this case involves a comparison between a five-letter word and a four-

letter word, unlike the comparison in *Interlego*, KIKO simply does not have the same “fame” as the LEGO brand does so as to warrant a finding that people may likely confuse Applicant’s and Opposer’s Marks, in large part, because of the strength of Opposer’s brand recognition. Indeed, as discussed below, Opposer fails to satisfy its burden in establishing fame.

Accordingly, because Opposer failed to establish a sufficient likelihood and/or probability – and more than a mere possibility – that people will pronounce KICHO and KIKO similarly, this factor strongly favors the Applicant.

2. Applicant’s Mark and Opposer’s Appear Different

Simply stated, Applicant’s Mark contains a separate design element that goes beyond a mere stylization of letters often found in marks, which markedly differentiates Applicant’s Mark from Opposer’s Marks. As noted above, the design portion of Applicant’s Mark serves as an infographic conveying a narrative that explains Applicant’s principles.

Contrary to what Opposer may suggest, there “is no general rule as to whether letters or design will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue.” *In re Electrolyte Laboratories, Inc.*, 929 F.2d 645, 647, 16 U.S.P.Q.2d 1239 (Fed. Cir. 1990). Indeed, “[n]o element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *Id.* Rather, marks may “partake of both visual and oral indicia, and both must be weighed in the context in which they occur.” *Id.* (citing *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 614 F.2d 757, 760, 204 U.S.P.Q. 697, 699 (C.C.P.A. 1980)). After all, designs “are not word marks and are not capable of being spoken[.]” and “dissimilarities between them which can be fully appreciated only from seeing them.” *Application of Burndy Corp.*, 300 F.2d 938, 940, 133 U.S.P.Q. 196, 197 (C.C.P.A. 1962). Accordingly, whether marks appear similar “must always be resolved on the basis of the marks

as a whole.” *Olay Co., Inc. v. Avon Prod., Inc.*, 178 U.S.P.Q. 502, 1973 WL 19958, at *3 (T.T.A.B. 1973).

Here, the separate design element of Applicant’s Mark clearly and sufficiently differentiates it from Opposer’s Marks. Even if the separate design element of Applicant’s Mark were not considered, the word portion of Applicant’s Mark itself appears sufficiently different than Opposer’s Marks.² Indeed, even if the design element were ignored or given less weight, “the fact that two marks have common initial letters does not necessarily mean that the marks as a whole project the same commercial image or impression.” *Olay*, 178 U.S.P.Q. 502, 1973 WL 19958, at *3.

The cases to which Opposer refers in its brief in support of its contention that its marks and the word portion of Applicant’s Mark, apart from its design element, appear similar are all distinguishable. In *Presto Prod., Inc. v. Nice-Pak Prod. Inc.*, the Board held that marks appeared confusingly similar, because the marks both started with the same word “KID.” 9 U.S.P.Q.2d 1895, 1988 WL 252340, at *3 (T.T.A.B. 1998). It was the connotation of the prefix “KID” that led the Board to its conclusion that the marks appeared similar. *Id.* Similarly in *Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*,³ the Board held that marks were confusingly similar, because they both shared the same prefix, “COMM,” and the same suffix, “CASH,” both of which had known connotations. 228 U.S.P.Q. 689, 1986 WL 83634, at *2 (T.T.A.B. 1986). Similarly again, in *Century 21 Real Estate Corp. v. Century Life of America*, the court held that two marks were confusingly similar, because they both started with the word “CENTURY.” 970 F.2d 874, 876, 23 U.S.P.Q.2d 1698 (Fed. Cir. 1992). Here, Applicant’s Mark and Opposer’s

² This is even more the case with Opposer’s mark “KIKO MAKE UP MILANO.”

³ In its Brief, Opposer cites to the appeal affirming the Board’s decision in that matter, rather than the underlying Board decision.

mark only share certain common letters that, in of themselves, do not have any shared connotations, unlike “KID,” “COMM,” “CASH,” and “CENTURY.”

In *Interlego*, the Board held that “LEGO” and “MEGO” were sufficiently similar so as to cause a likelihood of confusion, but stated that it’s holding in that case was made “given the great fame of opposers’ LEGO mark.” 63 U.S.P.Q. 1862, 2002 WL 31039614, at *2. As noted above, in addition to the fact that this case involves a comparison between a five-letter word and a four-letter word, unlike the comparison in *Interlego*, KIKO simply does not have the same “fame” as the LEGO brand does so as to warrant a finding that people may likely confuse Applicant’s and Opposer’s Marks, in large part, because of the strength of Opposer’s brand recognition. Indeed, as discussed below, Opposer fails to satisfy its burden in establishing fame.

In *HRL Assoc., Inc. v. Weiss Assoc., Inc.*,⁴ the Board held that the “letter marks ‘TMS’ and ‘TMM’ [were] similar.” 12 U.S.P.Q.2d 1819, 1989 WL 274391, at *2 (T.T.A.B. 1989) (emphasis added). In so holding, however, the Board stated that “[c]onfusion [was] more likely between letter marks than between other types of marks.” *Id.* Here, as noted above, Applicant’s Mark is not solely a letter mark. Rather, it includes a separate and distinguishable design element that clearly distinguishes Applicant’s Mark from Opposer’s Marks.

As such, based upon a comparison of the marks in their entirety, this factor weighs in favor of the Applicant.

B. Opposer Fails to Sufficiently Establish Fame of Its Mark(s)

A famous or strong mark is one “with extensive public recognition and renown.” *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353, 22 U.S.P.Q.2d 1453 (Fed. Cir. 1992). Fame “is insufficient in itself to establish [a] likelihood of confusion under § 2(d).”

⁴ In its Brief, Opposer cites to the appeal affirming the Board’s decision in that matter, rather than the underlying Board decision.

Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., Inc., 703 F.2d 1372, 1374, 217 U.S.P.Q. 505 (Fed. Cir. 1983). Rather, it “must also be established that there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark.” *Id.* If an opposer asserts fame, it “is the duty of [that] party . . . to clearly prove it.” *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 U.S.P.Q.2d 1901, 2007 WL 749713, at *5 (T.T.A.B. 2007).

In its brief, Opposer submits that its marks are famous, because of the number of stores it has across the world, revenues it has earned, units it has sold, and advertisement efforts it has made. As an initial matter, a vast majority of the stores to which Opposer refers are not in the United States. Opposer did not open its first store in the United States until March 2014, only approximately three months before it filed its Opposition in this matter, and, as of April 13, 2015, only had stores in Connecticut, Florida, New Jersey and New York. Ex. 1 to Applicant’s Notice of Reliance at 22; *see also* Opposer’s Brief at 5. This is insufficient to establish fame.

As to the other support it provides, Opposer is correct that fame may be measured indirectly by the volume of sales and advertising efforts. It is equally axiomatic, however, that Opposer must also provide “context for opposer’s advertising and sales figures, such as how the figures for the [Opposer’s product] compare with that for other brands of [that product.]” *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 U.S.P.Q.2d 1826, 2012 WL 953406, at *5 (T.T.A.B. 2012). Here, Opposer provided no such context, and, without such context, it is impossible to determine whether Opposer’s Marks are famous. Accordingly, Opposer failed to “clearly prove” fame.

C. Notwithstanding Any Overlap in Goods Sold and Trade Channels, the Conditions Under Which, and Buyers to Whom, Sales Are Made Sufficiently Differentiate Applicant's and Opposer's Goods and Marks

Applicant's products are used and bought by sophisticated purchasers. As noted above, Applicant developed various products that adhered to its five core principles. Kim Aff. at ¶ 10; *see also* Ex. C to the Kim Aff. Applicant's products are featured as products that provide benefits from the use of various natural extracts. Kim Aff. at ¶¶ 10. It is this use of various natural extracts that helps produce the "look" for which Koreans are known in other Asian countries and in the United States. *Id.* at ¶ 11. Indeed, the terms "Korean Beauty" or "K-Beauty" are currently used by cosmetic retailers in the United States such as Sephora, Birchbox, and Amazon. *Id.*; *see also* Exs. D-F to the Kim Aff.; Exs. 3 – 5 of Applicant's Notice of Reliance.

Applicant promotes and advertises its products and its brand through various print advertisements, including in publications such as Allure and International bntWorld, and websites, including Facebook (<https://www.facebook.com/kichoworldwide/>) and Instagram (https://www.instagram.com/kicho_cosmetics/), all of which promote the products in the context of the "Korean Beauty/K-Beauty" concept. Kim Aff. at ¶ 14; *see also* Exs. G, H to the Kim Aff. Purchasers of Applicant's products know about and seek out Korean beauty products. Kim Aff. at ¶ 12. In light of the marketing by cosmetic retailers, such purchasers are sophisticated customers who make deliberate decisions to seek out Korean beauty products⁵ and are willing to pay a premium for beauty products. *Id.* Indeed, the cost of Applicant's products are significantly higher than other brands of cosmetic products, including Opposer's products, which, as noted above, are marketed as "affordable European-designed and produced products."

⁵ This is unlike Opposer's product, which, when bearing the mark "KIKO MAKE UP MILANO," clearly indicates that it is an Italian product.

Id.; *see also* Percassi Aff. at ¶ 9; *compare* Ex. C to the Kim Aff. *with* Ex. A to the Percassi Aff. Accordingly, while the goods sold by Applicant and Opposer may overlap to a certain extent and share certain trade channels, the conditions under which, and buyers to whom, sales are made sufficiently differentiate Applicant's and Opposer's goods and marks.

D. There Is No Evidence of Actual Confusion

Opposer concedes there is no evidence of actual confusion despite the fact that both Applicant and Opposer offers products through the internet. Accordingly, this factor weighs in favor of the Applicant.

E. The Market Interface Between the Applicant and the Opposer as They Concurrently Use Their Marks Establish the Lack of Any Potential Confusion

Both Applicant and Opposer have registered their marks and sold goods across the world outside of the United States. Other foreign agencies have recognized that there is no, and/or insufficient, likelihood of confusion between the KICHO and Kiko marks so as to preclude the registration of the KICHO mark. Kim Aff. at ¶ 17. The Patent and Trademark Office in South Korea denied Opposer's opposition to Applicant's application for registration, ruling that Applicant's Mark and the Opposer's Marks are not similar in appearance or sound, among other things. *Id.* Additionally, Applicant's Mark has been registered/allowed in Hong Kong (Application/Registration No. 303138183), the Philippines (Application No. 4/2015/00006225), and Russia (2014731500/50) despite the registration of the Opposer's mark in those countries. *Id.* While this all occurred outside of the United States, the interface between the Applicant and Opposer throughout different countries, dealing with various ethnicities and languages, establishes the lack of any potential confusion outside of Italy and Korea where Opposer and Applicant respectively are based.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a copy of the foregoing was served via electronic mail and first-class mail, postage prepaid, this 9th day of May 2016, on:

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Jong Park

APPENDIX

2002 WL 1844232 (Trademark Tr. & App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

IN RE ZOLO TECHNOLOGIES, INC.

Serial Nos. 76/035,119; 76/035,120; 76/035,301

August 13, 2002

*1 [Thomas D. Bratschun](#) of Swanson & Bratschun, L.L.C. for Zolo Technologies, Inc.

[Kelly A. Choe](#), Trademark Examining Attorney

Law Office 113

([Odette Bonnet](#), Managing Attorney)

Before Simms, Cissel and [Seeherman](#)

Administrative Trademark Judges

Opinion by Cissel

Administrative Trademark Judge:

This is an appeal from the final refusals to register the marks in the above-identified three applications. Because the issues are closely related in each appeal, these cases have been consolidated. The marks, procedural histories and records are only slightly different. All three applications were filed on April 26, 2000. The basis for filing each application is applicant's assertion that it possesses a bona fide intention to use the mark in commerce in connection with the goods set forth in the application.

The marks applicant seeks to register are "ZOLO," "ZOLO TECH," and "ZOLO TECHNOLOGIES." The descriptive word "TECHNOLOGIES" has been disclaimed in the application to register the latter mark.

The goods in each application, as amended, are as follows: "fiber optic communications components, namely, optical multiplexers, optical de-multiplexers, optical spectrum analyzers, reconfigurable add/drop multiplexers, electro optic solid state switches and external cavity semiconductor lasers, and multiplexed optical signal attenuators," in Class 9.

The Examining Attorney has refused registration of each of applicant's marks under Section 2(d) of the Lanham Act, [15 U.S.C. Section 1052\(d\)](#), on the ground that applicant's marks so resemble the mark "SOLO," which is registered¹ for "optical fiber cable," that if applicant were to use these marks in connection with the fiber optic communications components specified in the applications, confusion would be likely.

Applicant's marks either consist of the term "ZOLO" or combine it with the descriptive or suggestive terms "TECHNOLOGY" or "TECH." "ZOLO" is clearly the dominant portion of the two marks in which it is combined with these terms. The Examining Attorney reasons that confusion is likely because "ZOLO" is similar to "SOLO." He argues that because the letters "S" and "Z" can be pronounced the same way, "ZOLO" and "SOLO" are "essentially phonetic equivalents," (brief, p.7)², and the marks, when considered in their entirety, are similar because they create similar commercial impressions. Further, he takes the position that the goods with which applicant intends to use its marks are closely related to the goods set forth in the cited registration, so that if applicant were to use the marks it seeks to register in connection with the goods listed in the application, confusion with the cited registered mark would be likely.

*2 Applicant disputes the Examining Attorney's assertions, arguing that the marks are not similar and that the goods are not so closely related that the use of the marks in question on them would be likely to cause confusion.

Both applicant and the Examining Attorney submitted briefs, but applicant did not request an oral hearing before the Board.

In support of the refusals to register, the Examining Attorney made of record the following: (1) An excerpt from Funk & Wagnalls New Encyclopedia (2000 edition) wherein it is noted that the letter "S" is "pronounced either voiceless, as the hissing sound in sun and nurse, or as a z, the voiced counterpart of s, in such words as prose and tease"; (2) A collection of excerpts from published articles in which words like "hospitalize" and "editorialize" are spelled with the letter "s" in place of the letter "z"; (3) Definitions of the words "multiplexer" and "attenuator" from Harcourt's Academic Press Dictionary of Science and Technology. The former is listed as "a device that allows the transmission of two or more signals on a single line or in a single frequency channel"; the latter as "a resistive or capacitative circuit designed to lower a signal amplitude to some desired value without distorting the signal waveform"; and (4) Copies of a number of third-party trademark registrations wherein the goods listed include switches, multiplexers, and/or attenuators, in addition to fiber optic cables.³

Applicant made of record three pages from the website of the owner of the cited registration and the declaration of Michael Wearsch, Vice President of Business Development/Marketing for applicant, who explains how the fiber optic market is divided, and that the website information indicates that "SOLO" fiber optic cable is sold to the "outside engineers" at "service providers," whereas applicant's fiber optic components are sold to "facility engineers" at "system providers."

In the case of E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the predecessor to our primary reviewing court set out the factors to be considered in determining whether confusion is likely. Chief among these factors are the similarity of the marks as to appearance, pronunciation, meaning and commercial impression, and the similarity of the goods set forth in the application and registration, respectively.

In the case at hand, the record establishes that the goods listed in the application are related to the product identified in the cited registration. The people who make the decisions to purchase these products can be the same individuals within a given business organization, but these people are sophisticated and knowledgeable with regard to these products. Accordingly, they expend time and exercise care when purchasing these goods, and they would be likely to notice the differences between the marks.

*3 Given this fact and the differences in the marks discussed below, we hold that confusion would not be likely.

Applicant and the Examining Attorney argue at length about the similarities and differences among the marks. The Examining Attorney argues that because one of the marks applicant seeks to register is "ZOLO" and "ZOLO" is the dominant portion of the other two marks applicant seeks to register, the issue boils down to whether "ZOLO" is similar to "SOLO." We cannot adopt his conclusion that these terms are "highly similar" because they both "contain the identical 'OLO' preceded by the phonetic equivalent letters, 'S' and 'Z.'" While it is true that in some instances these two letters can be pronounced in the same way and may be used interchangeably, these facts do not prove the Examining Attorney's contention that "[r]egistrant's mark, SOLO, may be pronounced as SOLO or ZOLO, and since applicant's mark, ZOLO, may be pronounced as ZOLO or SOLO; therefore, the marks are essentially phonetic equivalents." (brief, p. 7).

Rather, we agree with applicant that when these marks are considered in their entirety, applicant's marks are sufficiently different from the registered mark to avoid a likelihood of confusion. "ZOLO" and "SOLO" do share three letters, but the fact that one begins with the letter "Z" and the other begins with "S" results in significant differences in the way these marks look, the way they are likely to be pronounced, and their connotations, or lack thereof.

The Examining Attorney's argument that these terms are phonetic equivalents is not well taken. Clearly, the mark "SOLO," which is a common English word, would only be pronounced with an "S" sound. As for the mark "ZOLO," we are not persuaded that consumers would pronounce this invented term with an "S" rather than a "Z" sound. The examples provided by the

Examining Attorney show only that “S” may be pronounced as “Z,” not the reverse. The examples provided by the Examining Attorney which show the letter “S” actually used in place of the letter “Z” are all specifically designated as typical British spellings, rather than the preferred spelling in this country. Even in the cases where “S” is pronounced as “Z,” the examples demonstrate this equivalency in pronunciation only when the letter “S” appears at the end of the word. No example provided by the Examining Attorney is analogous to the present case, i.e., we are provided with no examples where the letters “S” and “Z” are used interchangeably at the beginning of a word. As applicant points out, when these letters are substituted for each other at the beginnings of ordinary words, it is clear that they are not interchangeable. As examples, applicant suggests comparing “singer” to “zinger”; “zip” to “sip”; or “zag” to “sag.”

Moreover, the dissimilarities between “ZOLO” and “SOLO” are not limited to differences in appearance and pronunciation. These two terms do not create similar commercial impressions because “SOLO” is a real word with a known meaning, whereas “ZOLO” is not. “SOLO” is understood as a reference to being alone, unaccompanied. In contrast, “ZOLO” is a fanciful term with no ascertainable meaning. We have previously found that the comparison of a known term with an unfamiliar one results in the conclusion that the marks are sufficiently distinguishable to avoid a likelihood of confusion. It is a well-settled principle that the familiar is readily distinguishable from the unfamiliar, and there is a line of decisions recognizing the distinction between the two. See: *Laboratoires du Dr. N. G. Payot v. Southwestern Classics Collection, Ltd.*, 3 USPQ2d 1601, at 1606, (TTAB 1987), and cases cited therein.

*4 In the case before us, we hold that if applicant were to use the marks it seeks to register in connection with the goods listed in these applications, confusion with the cited registered mark would not be likely because the marks, in their entireties, are not similar in appearance, pronunciation or connotation, and they create different commercial impressions.

DECISION: The refusals to register under Section 2 (d) the Lanham Act are reversed.

Footnotes

- 1 Reg. No. 2,150,858, issued on the Principal Register on April 14, 1998 to Siecor Corporation.
- 2 In this opinion, references will be to the record in application S.N. 76/035,119 unless otherwise indicated.
- 3 Additional materials submitted with the appeal brief of the Examining Attorney have not been considered. [Trademark Rule 2.142\(d\)](#). In any event, they appear to relate to the relationship between the goods listed in the application and the goods specified in the registration, and the record establishes this relationship without the evidence untimely submitted with the brief.

2002 WL 1844232 (Trademark Tr. & App. Bd.)