

This Opinion is Not a
Precedent of the TTAB

Mailed: August 9, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Kiko S.p.A.
v.
Dooyeon Corp.

Opposition No. 91217033

Michael J. Leonard and Christopher D. Olszyk, Jr., Fox Rothschild LLP,
for Kiko S.p.A.

Jong Park and Peter K. Hwang, The PL Law Group, PLLC,
for Dooyeon Corp.

Before Cataldo, Wolfson, and Hightower,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:



Dooyeon Corp. (“Applicant”) seeks to register the mark

K I C H O

on the Principal Register for the following goods, in International Class 3:

Eyebrow pencils; Lip liner; Mascara; Make-up foundations;
Hair colorants; Cosmetic preparations for bath and shower;
Body lotions; Bath lotion; Shower gels; Skin lotions;
Eyeliner; Eye cream; Face and body lotions; Perfumes;

Hair gel; Hair spray; Make-up powder; Make-up removing lotions.¹

The description of the mark in the application states: “The mark consists of the word ‘KICHO’ and a stylized form of ‘KICHO’ consisting of a triangle, a vertical line, a chevron, a rectangle divided by a line and a circle with a slanted line.”

Kiko S.p.A. (“Opposer”) opposes registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), asserting a likelihood of confusion with its marks KIKO and

KIKO

MAKE UP MILANO, previously registered for make-up and other goods and retail services, as detailed *infra*.

The proceeding is fully briefed. We sustain the opposition.

I. Record

The record in this case consists of the pleadings and the file of the involved application. Trademark Rule 2.122(b)(1). The parties stipulated to submission of witness testimony in the form of written affidavits, without waiving the right to cross-examination, and introduced all evidence by notice of reliance.²

Opposer made of record the following evidence:

- Certified status and title copies of the following four registrations on the Principal Register:

KIKO

○ MAKE UP MILANO, with “MAKE UP MILANO” disclaimed, for:

¹ Application Serial No. 86053930, filed September 3, 2013 based on Applicant’s allegation of its *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² 11 TTABVUE; *see also* 12 TTABVUE (accepting stipulation).

- “Perfumes, toilet soaps, cosmetics, namely, deodorants for personal use; creams, lotions and oils for the face and body; skin cleansing milks, creams and oils; make-up creams; beauty masks; make-up removers; eye shadows; lipsticks; mascara, rouge; crayons for the eyes and lips; face and body powders; suntanning and after sun exposure creams, oils and lotions; pre- and after-shave lotions; talcum powders, bath salts, bath foam, bath oil; hair shampoo, hair lotions; depilatory preparations; nail enamels and polishes, excluding goods for infants and children up to 11 years old,” in International Class 3, and
 - “Retail department store services, excluding goods for infants and children up to 11 years old; retail store services featuring a wide variety of consumer goods of others, excluding goods for infants and children up to 11 years old; retail variety stores, excluding goods for infants and children up to 11 years old,” in International Class 35.³
- KIKO (in standard characters) for “make-up for women,” in International Class 3.⁴
 - KIKO (in standard characters) for “Perfumes, toilet soaps, cosmetics, namely deodorants for personal use; creams, lotions and oils for the face and body; skin cleansing milks, creams and oils; make-up creams; beauty masks; make-up removers; eye shadows; lipsticks; mascara, rouge; crayons for the eyes and lips; face and body powders; suntanning and after sun exposure creams, oils and lotions; pre and after shave lotions; talcum powders, bath salts, bath foam, bath oil; hair shampoo, hair lotions; depilatory preparations; nail enamels and polishes,” in International Class 3.⁵
 - KIKO (in standard characters) for “Spectacles, cases and chains for spectacles, frames for spectacles, optical lenses,” in International Class 9, and “Jewellery [sic] and costume jewellery, namely rings, bracelets, necklaces, tie-bars, scarf rings, pendants, ear clips, tie

³ Registration No. 4690585, issued February 24, 2015. 14 TTABVUE 6-7.

⁴ Registration No. 3650052, issued July 7, 2009; Section 8 & 15 declaration of use and incontestability accepted and acknowledged July 21, 2015. The registration includes a statement that the name “KIKO” does not identify a living individual. 14 TTABVUE 8-9; Affidavit of Stefano Percassi (“Percassi Aff.”) ¶ 13 & Exhibit D, 14 TTABVUE 33, 100-08.

⁵ Registration No. 3689438, issued September 29, 2009; Section 8 & 15 declaration of use and incontestability accepted and acknowledged August 10, 2015. 14 TTABVUE 10-11; Percassi Aff. ¶ 14 & Exhibit E, 14 TTABVUE 33-34, 109-17.

clips, cufflinks [sic], earrings, key holders made of precious metals, brooches, pins being jewelry; clocks, watches, chronographs for use as watches, chronometers,” in International Class 14.⁶

- Applicant’s answers to certain of Opposer’s interrogatories.⁷
- An affidavit from Opposer’s Managing Director Stefano Percassi, with Exhibits A-H (“Percassi Aff.”).⁸
- Printouts from the Merriam-Webster online dictionary pronunciation guide, including for the letters “ch.”⁹

Applicant introduced the following evidence:

- Opposer’s answers to Applicant’s interrogatories.¹⁰
- An affidavit from Applicant’s Deputy Department Head Charles Kim, with Exhibits A-I (“Kim Aff.”).¹¹
- Internet printouts from the Sephora, Birchbox, and Amazon websites.¹²
- A certified copy of a decision by the Patent and Trademark Office in South Korea.¹³
- An entry from Wikipedia for the digraph “Ch.”¹⁴

⁶ Registration No. 4065381, issued December 6, 2011. The registration includes statements that the wording “KIKO” has no meaning in a foreign language and does not identify a particular living individual. The certified copy states that this registration is owned by Kiko S.r.L., Opposer’s previous name before reorganization as Kiko S.p.A. 14 TTABVUE 12-13; *see also* 13 TTABVUE (Opposer’s motion to substitute). However, Opposer’s managing director testified that the registration is owned by Opposer Kiko S.p.A., and recordation of the entity conversion/change of name with the U.S. Patent and Trademark Office Assignment Recordation Branch at Reel/Frame 5540/0007 is of record. *See* Percassi Aff. ¶¶ 1-3, 15, 14 TTABVUE 30, 34; 13 TTABVUE 3, 44.

⁷ 14 TTABVUE 14-28.

⁸ *Id.* at 29-125.

⁹ *Id.* at 126-34.

¹⁰ 15 TTABVUE 5-30.

¹¹ *Id.* at 31-83.

¹² *Id.* at 84-103 (from Sephora.com/Korean-skin-care, birchbox.com/shop/from-korea-with-love-collection/, and amazon.com/b?node=11585018011).

¹³ *Id.* at 104-08. We have not considered this document because it is written in Korean and an English translation was not submitted. *See* Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 104 (2016) and cases cited at n.2.

¹⁴ *Id.* at 109-17 (from [en.wikipedia.org/wiki/Ch_\(digraph\)#English](http://en.wikipedia.org/wiki/Ch_(digraph)#English)).

II. Opposer's Standing and Priority

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). Opposer's standing to oppose registration of Applicant's mark is established by its pleaded registrations, which the record shows to be valid and subsisting, and owned by Opposer. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Otter Prods. LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254 (TTAB 2012). In addition, because Opposer's pleaded registrations are of record, priority is not an issue with respect to the goods covered by Opposer's pleaded registrations. *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

III. Likelihood of Confusion

Our determination under Trademark Act Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods or services, the first two *du Pont* factors. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The

fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). Opposer bears the burden of proving its claim of likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848.

We address in turn each of the *du Pont* factors for which the parties submitted evidence or argument. To the extent that any other *du Pont* factors for which no evidence was presented may be applicable, we treat them as neutral.

A. Similarity of the Goods and Channels of Trade

The second and third *du Pont* factors assess the similarity or dissimilarity of the parties’ goods and services and their established, likely-to-continue trade channels. In comparing the parties’ goods, “[t]he issue to be determined . . . is not whether the goods of plaintiff and defendant are likely to be confused but rather whether there is a likelihood that purchasers will be misled into the belief that they emanate from a common source.” *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989). The parties’ goods or services need not be similar or competitive to support a finding of likelihood of confusion. It is sufficient that the respective goods or services are related in some manner, or that the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that could, in light of the similarity of the marks, give rise to the mistaken belief that they originate from or are associated with the same source. *See In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993).

In view of Applicant’s arguments, we emphasize that we must focus on the wording of the application and registrations, rather than what the record may reveal regarding the parties’ particular goods and services, because “the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application.” *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quotation omitted). It is sufficient for a finding of likelihood of confusion as to a particular class if confusion is likely with respect to use of Applicant’s mark on any item that comes within the description of goods for that class in the pleaded registrations. *See Bond v. Taylor*, 119 USPQ2d 1049, 1052-53 (TTAB 2016).

The parties’ goods are summarized in the chart below, including only the Class 3 goods identified in Opposer’s registrations for KIKO in standard characters:

Applicant’s Identified Goods	Opposer’s Registered Goods
Eyebrow pencils; Lip liner; Mascara; Make-up foundations ; Hair colorants; Cosmetic preparations for bath and shower; Body lotions ; Bath lotion; Shower gels; Skin lotions ; Eyeliner; Eye cream; Face and body lotions ; Perfumes ; Hair gel; Hair spray; Make-up powder; Make-up removing lotions	Make-up for women (Reg. No. 3650052) Perfumes , toilet soaps, cosmetics, namely deodorants for personal use; creams, lotions and oils for the face and body ; skin cleansing milks, creams and oils; make-up creams ; beauty masks; make-up removers ; eye shadows; lipsticks; mascara , rouge; crayons for the eyes and lips; face and body powders; suntanning and after sun exposure creams, oils and lotions; pre and after shave lotions; talcum powders, bath salts, bath foam, bath oil; hair shampoo, hair lotions; depilatory preparations; nail enamels and polishes (Reg. No. 3689438)

The bolded goods are identical or overlapping. Specifically, both the application and the cited registrations identify mascara, perfumes, and face and body lotions. Applicant also lists particular kinds of Opposer's identified make-up removers (make-up removing lotions) and make-up for women (including at least make-up foundations and make-up powder). We find that the parties' goods are identical in part.

We presume that the goods, which are unrestricted, move in all channels of trade normal for those goods and are available to all potential classes of ordinary consumers. *See Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012). Moreover, because certain of Applicant's goods are identical to those identified in the cited registrations, we must presume that those goods of Applicant and Registrant move in the same channels of trade and are available to the same classes of customers for such goods. *See American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this presumption).

The second and third *du Pont* factors strongly support a finding of likely confusion.

B. Similarity of the Marks

We turn next to the first *du Pont* factor, the similarity of the parties' marks. In a likelihood of confusion analysis, we compare the marks in their entireties for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). "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*, 101 USPQ2d at 1721 (citation omitted). Where, as here, the parties use their marks in connection with goods that are identical in part, the similarity needed to support a determination that confusion is likely declines. *See Bridgestone Ams. Tire Operations LLC v. Federal Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012).

For purposes of our likelihood of confusion analysis, we focus on the pleaded registrations for KIKO in standard characters. We find this mark to be the more relevant of Opposer’s marks for our analysis. Accordingly, if we find a likelihood of confusion as to this pleaded mark, we need not find it as to . On the other hand, if we do not reach that conclusion, we would not find a likelihood of confusion as to the other pleaded registration either. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).



Applicant seeks to register the mark , described (as noted *supra*) as “the word ‘KICHO’ and a stylized form of ‘KICHO’ consisting of a triangle, a vertical line, a chevron, a rectangle divided by a line and a circle with a slanted line.” Given the high degree of stylization of the forms in the upper portion of the mark, we cannot conclude that consumers are likely to view those designs as a rendering of the word KICHO, rather than simply as geometric embellishments. Either way, whether consumers perceive the mark to contain the term once or twice,

the literal portion of Applicant's mark is KICHO. Indeed, if consumers view the design portion of the mark as a stylized depiction of KICHO, the images serve to reinforce the significance of the wording in Applicant's mark.

Although we consider each mark on a case-by-case basis, the wording in composite word and design marks normally is accorded greater weight in the likelihood of confusion analysis because the verbal portion is most likely to indicate the origin of the goods, *In re Viterra*, 101 USPQ2d at 1908, and to be used by purchasers to request the goods, *Skincode AG v. Skin Concept AG*, 109 USPQ2d 1325, 1329 (TTAB 2013); *M.C.I. Foods Inc. v. Bunte*, 96 USPQ2d 1544, 1551 (TTAB 2010). *But cf. In re Covalinski*, 113 USPQ2d 1166, 1169 (TTAB 2014) (finding design features to

dominate overall commercial impression of mark



The only difference between Opposer's mark KIKO and the literal portion of Applicant's mark, KICHO, is the substitution of "ch" for "k." Applicant submitted testimony that although KICHO "has no meaning in the Korean or English language, it was derived as a play on the Korean word for 'basic,'" and that its syllables are pronounced in the Korean spelling like "kee" as in "keep" followed by "cho" as in "macho" and "nacho."¹⁵ We note that it is immaterial that "kicho" may be a play on words in Korean; there is no English language meaning. Applicant also submitted a Wikipedia entry discussing several alternate pronunciations for "ch," stating in part: "In English, *ch* is most commonly pronounced as [tʃ], as in *chalk*, *cherry*, *church*,

¹⁵ Kim Aff. ¶ 7, 15 TTABVUE 33.

much, etc. *Ch* can also be pronounced as [k], as in *ache*, *choir*, and *stomach*.¹⁶ Consistent with Applicant’s evidence, Opposer submitted a dictionary pronunciation guide indicating that “ch” can be pronounced both as \t\ + \sh\ and \k\ as in *ache*.¹⁷

We acknowledge that there is no correct pronunciation of a mark that, like both terms here, is not a recognized word.¹⁸ *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1651 (Fed. Cir. 2014); *In re Viterra*, 101 USPQ2d at 1912. Nonetheless, we find that consumers are likely to vocalize the words either identically, if they pronounce the “ch” in Applicant’s mark as a hard “k” sound, or similarly, if they instead use a soft “ch,” given that the leading “ki” prefix in each mark is identical and each ends in a vocalized “o.”



In addition to this strong aural similarity, we find the marks and KIKO, considered in their entirety, to be somewhat similar in appearance and to convey similar overall commercial impressions. Therefore, the first *du Pont* factor favors a finding that confusion between the marks is likely, particularly in light of the lesser similarity required because the respective goods are identical in part.

¹⁶ Exhibit 7, 15 TTABVUE 111. The Board gives guarded consideration to evidence from Wikipedia, recognizing the limitations inherent in this reference work, where – as here – the non-offering party has an opportunity to rebut the evidence by submitting other evidence that may call its accuracy into question. *See In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1032 (TTAB 2007).

¹⁷ 14 TTABVUE 131-32.

¹⁸ *See Percassi Aff.* ¶ 7 (“There is no intended meaning behind the KIKO Mark, as it is merely an arbitrary term.”), 14 TTABVUE 31.

C. Strength of Opposer's Marks

The fifth *du Pont* factor is the fame of the prior mark, in terms of sales, advertising, and length of use, while the sixth factor is the number and nature of similar marks in use on similar goods.

Applicant contends that its KIKO marks are famous. In the likelihood of confusion context, fame “varies along a spectrum from very strong to very weak.” *Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012) (quoting *Palm Bay*, 73 USPQ2d at 1694); see also *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1507 (TTAB 2005) (stating that “[f]ame is relative . . . not absolute”), *aff'd*, 479 F.3d 825, 81 USPQ2d 1919 (Fed. Cir. 2007). A famous mark is one that has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002).

Fame, if it exists, plays a dominant role in the likelihood of confusion analysis. *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, it is the duty of the party asserting that its mark is famous to clearly prove it. The commercial strength of a mark “may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” *Bose*, 63 USPQ2d at 1305. In addition, some context in which to place raw statistics may be necessary. *Id.* at 1309.

Opposer submitted evidence that the mark KIKO has been continuously used on cosmetics and skin care and other beauty products offered in the United States via the Internet since at least as early as 2010; that Opposer opened its first KIKO-branded store in the United States on March 20, 2014; and that Opposer since has opened 17 additional stores in California, Connecticut, Florida, Maryland, Nevada, New York, New Jersey, Rhode Island, and Virginia.¹⁹ U.S. sales of Opposer's KIKO-branded products exceeded \$2.2 million in 2014.²⁰ Opposer also has more than 470,000 followers on Instagram, and views of its YouTube videos exceeded 9.7 million as of October 2015.²¹

Opposer has been selling its goods in the United States for a relatively short time, and its dollar sales are not particularly high in the fame context. Opposer, moreover, has provided no information permitting evaluation within the U.S. cosmetics market. *Cf., e.g., Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000) (noting that retail sales of products under the famous mark FRITO-LAY exceeded \$6 billion in 1995, for a greater than 50 percent market share in the domestic snack chip industry); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1438 (TTAB 2014) (finding HARRY WINSTON famous in the jewelry field on evidence opposers summarized as “sales in the billions, advertising and marketing expenditures in the millions, and editorial mentions valued in the millions over an

¹⁹ Percassi Aff. ¶ 6, 14 TTABVUE 31.

²⁰ *Id.* ¶ 10, 14 TTABVUE 32.

²¹ *Id.* ¶ 11, 14 TTABVUE 32. There is no evidence as to how many of those followers and viewers are U.S. consumers.

eighty year period”). We find that Opposer has not clearly proven that its mark is famous, and the fifth *du Pont* factor is neutral.

On the other hand, as Opposer notes, there is no record evidence that any similar marks are in use for similar goods, and KIKO is a fanciful, invented term. Therefore, on this record we find Opposer’s marks to be commercially and inherently strong, and the sixth *du Pont* factor weighs in Opposer’s favor.

D. Other *du Pont* Factors Argued by Applicant

Applicant offers arguments concerning three additional *du Pont* factors, which we briefly address.

First, Applicant contends that its products are purchased by “sophisticated customers who make deliberate decisions to seek out Korean beauty products and are willing to pay a premium for beauty products.”²² This argument pertains to the fourth *du Pont* factor, the conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing.

As noted *supra*, Applicant’s identified goods are not restricted to premium or Korean beauty products. Therefore, we must assume that Applicant’s and Opposer’s identifications comprise the full range of the identified goods, whether inexpensive or costly. *See, e.g., In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“[B]ecause neither Applicant nor Registrant has limited its products to any particular style, type of consumer, or price point, we must assume that both

²² Applicant’s Brief at 17, 20 TTABVUE 22; Kim Aff. ¶ 12, 15 TTABVUE 34-35.

identifications include ‘residential and commercial furniture’ of all types, styles, and price levels offered to the full range of usual consumers for such goods.”).

Although some of Applicant’s products may be pricier, Opposer has offered its overlapping goods for as little as \$4-\$6.²³ We do not find the purchase of everyday goods such as mascara, face and body lotion, and make-up remover to be limited to careful, sophisticated purchasers. This *du Pont* factor is neutral.

Next, Applicant argues that the market interface between the parties, which are both located outside the United States and apparently compete in foreign countries, lessens the likelihood of confusion. Both parties have registered their marks in South Korea, Hong Kong, the Philippines, and Russia.²⁴ Applicant contends: “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.”²⁵

This argument misconstrues the tenth *du Pont* factor, the market interface between an applicant and the owner of a prior mark, characterized in *du Pont* as:

- (a) a mere “consent” to register or use.
- (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.

²³ See, e.g., Applicant’s response to Opposer’s Interrogatory No. 24, listing prices of its goods ranging from \$4 to \$138, 14 TTABVUE 23-24; Percassi Aff. ¶ 8 & Exhibit A, printouts from Opposer’s website displaying goods including mascara for \$4.90, make-up removing wipes for \$4, and perfumes for \$5.90, 14 TTABVUE 31-32, 46, 62, 72.

²⁴ Kim Aff. ¶ 17, 15 TTABVUE 36.

²⁵ Applicant’s Brief at 18, 20 TTABVUE 23.

- (c) assignment of mark, application, registration and good will of the related business.
- (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.

177 USPQ at 567. Considerations under the *du Pont* factors relate to the parties' use of their marks within the United States, and foreign trademark registration is irrelevant to the registrability of marks in the United States. *See, e.g., Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612 (TTAB 1991). We find this factor to be neutral, as well.

Finally, we address Applicant's argument that there is no evidence of actual confusion between its mark and Opposer's marks. This assertion relates to the eighth *du Pont* factor, assessing the length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

Proof of actual confusion is not necessary to show a likelihood of confusion. *See Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1843 (Fed. Cir. 1990). In this case, Applicant, which filed its application on an intent-to-use basis, submitted no evidence that it has used its mark in the United States. Therefore, there is no evidence of concurrent use in the United States that would result in a meaningful opportunity for actual confusion to occur, and we find *du Pont* factor eight to be neutral.

IV. Conclusion

In sum, we have found that the parties' goods are identical in part, moving in the same channels of trade to the same customers; the marks in their entireties are similar; and there is no record evidence of third-party use of similar marks for similar

goods. The first, second, third, and sixth *du Pont* factors weigh in favor of a likelihood of confusion, while the remaining factors are neutral.

Considering the record as a whole, we find that Opposer has carried its burden to establish by a preponderance of the evidence that Applicant's mark is likely to cause confusion with Opposer's mark KIKO.

Decision: The opposition is sustained pursuant to Trademark Act Section 2(d).