

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: June 27, 2017

Mailed: August 30, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Midnight Velvet, Inc.
v.
Sabre Retail Fashion Limited

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Opposition No. 91223400
—

David C. Brezina of Ladas & Parry for Midnight Velvet, Inc.

Caitlin R. Byczko of Barnes & Thornburg LLP for Sabre Retail Fashion Limited.

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Before Shaw, Kuczma, and Coggins, Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Sabre Retail Fashion Limited (“Applicant”), seeks registration of the mark MINT VELVET, in standard characters, on the Principal Register for:

Jewellery; precious stones; watches; costume jewellery, in International Class 14;

Articles of leather and imitations of leather, namely, bags, cases, clutches, straps; trunks and travelling bags; travel cases; luggage; suitcases; holdalls; portmanteaux; valises; bags, namely, tote bags, school bags; handbags; shoulder bags; toilet bags, namely, toiletry bags sold empty; carrier carrying bags, namely, all-purpose carrier bags; rucksacks; backpacks; bum bags; sports bags; casual bags, namely, shoulder bags, duffel bags; briefcases; attaché cases; satchels; beauty cases, namely, cosmetic cases sold empty;

carriers for suits, for shirts and for dresses; tie cases; notecases; document cases; wallets; purses; umbrellas; parasols; walking sticks; shooting sticks, namely, walking sticks which convert to temporary seating; parts and fittings for all the aforesaid goods included in this class, in International Class 18;

Clothing, namely, jackets, jumpers, cardigans, trousers, jeans, shorts, scarves, shawls, wraps, hats, gloves, blazers, blouses, caftans, capes, capri pants, coats, dresses, jump suits, knit bottoms, knit dresses, knit jackets, knit shirts, knit skirts, knit tops, leggings, overcoats, pants, shirts, skirts, sport coats, suits, sweaters, sweatshirts, swimwear; tank-tops, t-shirts, vests; footwear, headgear, namely, hats and caps; belts, in International Class 25; and

The bringing together, for the benefit of others, of a variety of jewellery, precious stones, watches, costume jewellery, articles of leather and imitations of leather, trunks and travelling bags, travel cases, luggage, suitcases, holdalls, portmanteaux, valises, bags, handbags, shoulder bags, toilet bags, carrier bags, rucksacks, backpacks, bum bags, sports bags, casual bags, briefcases, attaché cases, music cases, satchels, beauty cases, carriers for suits, for shirts and for dresses, tie cases, notecases, notebook holders, document cases and holders, wallets, purses, umbrellas, parasols, walking sticks, shooting sticks, belts, clothing, footwear and headgear, enabling customers to conveniently view and purchase those goods from a general merchandise retail store, and from a general merchandise Internet Website, and from a general merchandise catalogue by mail order and or by means of telecommunication systems; advertising services; promotional services, namely, incentive award programs to promote the sale of products and services of others to frequent customer patronage through rewards; information and advisory services all relating to the aforesaid services, namely, commercial information and advice for consumers, in International Class 35.¹

¹ Application Serial No. 79138609, based on International Reg. No. 1125914, issued March 15, 2012. Applicant has disclaimed “VELVET.”

Midnight Velvet, Inc. (“Opposer”) opposes registration of Applicant’s mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C.

§ 1052(d).² Opposer pleaded ownership of the following registered marks:

1. MIDNIGHT VELVET, in typed form, for “Mail order services and catalog services in the field of kitchen items and housewares,” in International Class 42;³
2. MIDNIGHT VELVET, in typed form, for “Mail order services and catalog services in the field of jewelry and related accessories, decorative items, decorative apparel and gift items,” in International Class 42;⁴
3. MIDNIGHT VELVET, in standard characters, for “Dresses; pants; pantsuits; skirt suits; skirts; tops; jackets; robes; sleepwear; loungewear; swimwear; sweaters,” in International Class 25;⁵ and
4. MIDNIGHT VELVET STYLE, in standard characters, for “Electronic catalog services featuring dresses, skirts, pant suits, pants, woven and knit tops, jackets and outerwear, swimwear, sleepwear & lingerie, watches, jewelry, handbags, shoes, accessories, cosmetics & fragrances,” in International Class 35.⁶

In addition, by way of a notice of reliance, Opposer claims ownership of the following registration which issued during the pendency of this proceeding based on an application filed after the notice of opposition was filed:

MIDNIGHT VELVET STYLE, in standard characters, for “Catalogs in the field of clothing, footwear, jewelry, decorative items, decorative apparel, furniture, gift items, fragrances and related accessories,” in International Class 16.⁷

² All other grounds pleaded in the notice of opposition were withdrawn by stipulation of the parties. 12 TTABVUE 6-7.

³ Registration No. 1505336, issued September 20, 1988, Section 8 and 15 affidavits filed and accepted, renewed.

⁴ Registration No. 1930841, issued October 31, 1995, Section 8 and 15 affidavits filed and accepted, renewed.

⁵ Registration No. 3520404, issued October 21, 2008, Section 8 and 15 affidavits filed and accepted.

⁶ Registration No. 3223145, issued March 27, 2007, Section 8 and 15 affidavits filed and accepted, renewed.

⁷ 8 TTABVUE 5-25. Registration No. 4936743, issued April 12, 2016.

I. Evidentiary issues and objections

We begin with Applicant's objection to consideration of Opposer's Registration No. 4936743 which was made of record by way of a notice of reliance.⁸ This registration was not pleaded in Opposer's notice of opposition and Opposer did not amend the pleadings to include either the registration or the underlying application. In cases brought under Trademark Act Section 2(d), "the plaintiff must specifically plead any registrations on which it is relying and may not rely at trial on unpleaded registrations," unless "the plaintiff's pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the matter." TBMP § 309.03(c) (June 2017); *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1424 n.14 (TTAB 2014) (opposer may not rely on registrations that were unpleaded, the underlying applications were unpleaded and opposer did not assert that the pleadings should be amended). Accordingly, we have not considered Reg. No. 4936743.⁹

Applicant also objects to Opposer's reliance on common law rights in the MIDNIGHT VELVET marks, arguing that "Opposer's Notice of Opposition makes no mention of the alleged common law rights upon which Opposer now relies."¹⁰ In response, Opposer argues that its mention, in its Notice of Opposition, of the terms "trade name," "use," and "priority of use" are sufficient to constitute a pleading of common law right in its mark.¹¹ Opposer argues further that its "claim of rights based

⁸ 8 TTABVUE 5-25.

⁹ Although we have not considered Opposer's fifth registration, we hasten to add that, had we considered it, the outcome would not differ inasmuch as the registration adds little to the scope of Opposer's rights in the MIDNIGHT VELVET marks, discussed *infra*.

¹⁰ Applicant's Br., p. 1; 32 TTABVUE 9.

¹¹ Opposer's Reply Br., p. 4, 33 TTABVUE 8.

on ‘use’ is clear, and common law rights are related to and a natural expansion of the goods and services listed in registered trademarks at issue.”¹² We disagree.

“Fairness dictates whether an issue has been tried by consent – there must be an absence of doubt that the nonmoving party is aware that the issue is being tried.” TBMP § 507.03. It is well settled that an opposer, in briefing the case, may not rely on an unpleaded claim, and that to be able to do so the opposer’s pleading must be amended, or deemed amended, pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the claim. *See Odom’s Tennessee Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d 2030, 2031 (Fed. Cir. 2010) (Board need not consider unpleaded common law use); TBMP § 314 (“A plaintiff may not rely on an unpleaded claim.”). Opposer’s mere mention of the terms “trade name,” “use,” and “priority of use” without specifying any goods and services with which the mark is used, is insufficient to plead common law use of its marks. Further, Opposer never formally offered an amendment to its pleadings to assert common law rights.

Nevertheless, the record establishes that Applicant was on notice that Opposer intended to rely on its common law rights. Applicant’s First Set of Interrogatories and Opposer’s responses thereto specifically raised the issue of common law rights:

INTERROGATORY NO. 3

Describe any common law rights upon which Opposer relies in this Opposition.

RESPONSE TO INTERROGATORY NO. 3

Midnight Velvet incorporates by reference its Objections [sic] Nos. 1 – 22 as if fully set forth herein...

Without waiver of the above objections, Midnight Velvet’s common law rights are all trade identity rights that arise from the use of

¹² *Id.*

MDNIGHT [sic] VELVET to identify the source of all goods and services with which the mark is used.

Without waiver of the foregoing, as a response under Rule 33 (d) see the catalogs in Documents No. MV00001 - MV00166.¹³

Accordingly, we have considered Opposer's common law rights in its MIDNIGHT VELVET marks.

Opposer objects to "the bulk" of the deposition by Stuart Grant, Applicant's Chief Operating Officer, on the ground that Applicant's corrections have materially changed the testimony of the witness after the fact, and because the testimony "goes beyond the scope of what is in the Application."¹⁴ Both of these arguments are unpersuasive. In weighing the testimony we employ the standards the Board has noted before:

[T]he Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence, including any inherent limitations. . . . [W]e find no basis on which to strike any testimony or other evidence. As necessary and appropriate, we will point out any limitations in the evidence or otherwise note that the evidence cannot be relied upon in the manner sought. We have considered all of the testimony and evidence introduced into the record. In doing so, we have kept in

¹³ Exh. G, 16 TTABVUE 9.

¹⁴ Opposer's Br., p. 3 and A-2, 30 TTABVUE 10 and 58. Opposer argues that, during his deposition, Grant confused Applicant's and Opposer's marks which establishes that "[t]he marks are so similar that the chief executive of Applicant mistakenly switched them." Applicant's Reply Br., p. 5, 33 TTABVUE 9. Even assuming, arguendo, that the uncorrected transcript is correct, we do not agree with Opposer that this minor misstatement establishes similarity of the marks. The deposition, held by telephone, conducted by multiple parties, between two countries, and lasting for several hours, cannot be considered to replicate the circumstances in which a consumer might experience the marks, and thus it weighs little in establishing whether the parties' marks are confusingly similar. *See Marshall Field & Co. v. Mrs. Field's Cookies*, 25 USPQ2d 1321, 1334 (TTAB 1992); *VMC Corp. v. Distributor's Mktg. Serv.*, 192 USPQ 227, 230 n.4 (TTAB 1976) (witness's inadvertent substitution of one mark for another is not necessarily probative of confusion because "[t]his slip of the tongue under the tension of being subjected to interrogation by opposing counsel is not indicative of a marketing environment.").

mind the various objections raised by the parties and we have accorded whatever probative value the subject testimony and evidence merit.

Luxco, Inc. v. Consejo Regulador del Tequila, A.C., 121 USPQ2d 1477, 1479 (TTAB 2017). In short, “we simply accord the evidence whatever probative value it deserves, if any at all. . . . Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this specific case, including any inherent limitations, and this precludes the need to strike the testimony and evidence.”¹⁵ *Hunt Control Sys. Inc. v. Koninkijke Philips Elec. N.V.*, 98 USPQ2d 1558, 1564 (TTAB 2011).

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the involved application.

Opposer submitted the following evidence:

1. Opposer’s First Notice of Reliance comprising, *inter alia*, screen shots of Opposer’s internet web pages and Facebook page, and screen shots of Applicant’s web page;¹⁶
2. Opposer’s Second Notice of Reliance comprising a copy of Opposer’s 2015 “Holiday Gift Book” catalog;¹⁷

¹⁵ This includes Applicant’s objections to Opposer’s rebuttal evidence filed by notice of reliance. 19 TTABVUE.

¹⁶ 8 TTABVUE.

¹⁷ 9 TTABVUE.

3. Opposer's Third Notice of Reliance comprising printouts from the Trademark Status & Document Retrieval ("TSDR") database of Opposer's four pleaded registrations showing current status and title;¹⁸
4. Opposer's Fourth Notice of Reliance comprising internet evidence to show that "mint green" is a color, including a color for velvet fabric;¹⁹
5. The deposition testimony Opposer's President, Ann Bush ("Bush Testimony"), with exhibits including, *inter alia*, printouts from Opposer's web site, Opposer's mail order catalogs, photographs of Opposer's products, and confidential revenue and expense figures from 2004 to 2014;²⁰ and
6. Opposer's Fifth Notice of Reliance comprising, *inter alia*, internet evidence purporting to rebut portions of Applicant's third-party evidence.²¹

Applicant submitted the following evidence:

1. Applicant's First Notice of Reliance comprising Opposer's responses to written discovery requests, printouts of third-party online clothing store websites, as well as listings for individual clothing products, using the terms "mint," "velvet," "midnight, or "midnight velvet, and third-party registrations incorporating the terms "velvet" or "midnight;"²²

¹⁸ 10 TTABVUE.

¹⁹ 11 TTABVUE.

²⁰ 12-14 TTABVUE.

²¹ 19 TTABVUE.

²² 16 TTABVUE.

2. Applicant's Second Notice of Reliance comprising examples of Applicant's catalogs and website, and internet printouts of third-party use of the terms "midnight velvet" to refer to fabric, clothing articles, and pillows;²³ and
3. The testimony of Applicant's Chief Operating Officer, Stuart Grant ("Grant Testimony"), with exhibits.²⁴

III. 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); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit, has enunciated a liberal threshold for determining standing, namely that a plaintiff must demonstrate that it possesses a "real interest" in a proceeding beyond that of a mere intermeddler, and "a reasonable basis for his belief of damage." *Empresa Cubana Del Tabaco* 111 USPQ2d at 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)).

Opposer has established its standing through its submission of printouts from the USPTO's TSDR database of its four pleaded registrations for MIDNIGHT VELVET marks, which demonstrate that the registrations are valid and subsisting, and owned by Opposer. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d

²³ 17 TTABVUE.

²⁴ 26 TTABVUE.

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1842, 1844 (Fed. Cir. 2000) (party's ownership of pleaded registration establishes standing).

Because Opposer's pleaded registrations are of record, priority is not at issue with respect to the goods and services covered by the registrations vis-à-vis the involved application. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

IV. 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, 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.").

We primarily focus our analysis on Registration Nos. 1930841, 3223145, and 3520404 for the marks MIDNIGHT VELVET and MIDNIGHT VELVET STYLE, in standard characters, because these marks and the goods and services in these registrations are the closest to Applicant's mark and its goods and services. If we do not find a likelihood of confusion with these registered marks and their associated

goods and services, then there would be no likelihood of confusion with the mark in the other pleaded registration. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. *Similarity of the goods and services and channels of trade*

We begin with the *du Pont* factor involving the relatedness of the goods and services and the similarity of established, likely to continue channels of trade. We base our evaluation on the goods and services as they are identified in the application and registrations. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 76 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). In analyzing the similarity of the goods and services, it is sufficient for a refusal based on likelihood of confusion that relatedness is established for any single item encompassed by the description of goods and services in the application. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Applicant's and Opposer's identifications of goods and services are in part identical or legally equivalent. Both parties' identifications include a variety of identical clothing articles in International Class 25, namely, dresses, pants, skirts, tops, jackets, swimwear, and sweaters. In addition, although worded differently, Applicant's services in class 35:

The bringing together, for the benefit of others, of a variety of jewellery, . . . watches, . . . handbags, . . . clothing, footwear and headgear, enabling customers to conveniently view and purchase those goods from a general merchandise retail store, and from a general merchandise Internet Website, and from a general merchandise

catalogue by mail order and or by means of telecommunication systems. . . .

are the legal equivalent of Opposer's services in International Classes 35 and 42 which identify mail order or catalog sale of items such as jewelry, clothing, footwear, and handbags:

Electronic catalog services featuring dresses, skirts, pant suits, pants, woven and knit tops, jackets and outerwear, swimwear, sleepwear & lingerie, watches, jewelry, handbags, shoes, accessories, cosmetics & fragrances

[and]

Mail order services and catalog services in the field of jewelry and related accessories, decorative items, decorative apparel and gift items.

Moreover, Applicant's "Jewellery; precious stones; watches; [and] costume jewellery," in International Class 14, and "Articles of leather and imitations of leather . . ." including "handbags," in International Class 18, are related to Opposer's mail order and catalog services, *supra*, inasmuch as goods and the services of selling those same goods are related for purposes of likelihood of confusion. *See, e.g., In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (holding BIGG'S for retail grocery and general merchandise store services and BIGGS and design for furniture likely to cause confusion); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (holding CAREER IMAGE for retail women's clothing store services and CREST CAREER IMAGES for uniforms likely to cause confusion).

Applicant argues that “there are key distinctions between the goods and services offered by the Parties.”²⁵ In particular, Applicant argues:

Applicant’s products are also higher priced. . . . Applicant’s products are more understated, with a gentle tone. The details of Applicant’s products are subtle and refined, whereas the Midnight Velvet products tend to be more vibrant in color. . . . Further, in situations like this in which the parties are not competitors, the likelihood of confusion is limited.²⁶

None of these arguments distinguishing the parties’ goods and services are persuasive because the registrability of Applicant’s mark must be decided on the basis of the identification of goods and services set forth in the application and cited registrations. *See Octocom*, 16 USPQ2d at 1787 (“The authority is legion that 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 regardless of what the record may reveal as to the particular nature of an applicant’s goods. . . .”). Accordingly, we find Applicant’s goods and services to be identical or closely related to Opposer’s goods and services.

Because the goods and services are legally identical in part, and neither Opposer’s registrations nor the involved application contain any limitations on the channels of trade and classes of purchasers, we must presume that the channels of trade and classes of purchasers are the same for these identical goods and services. *See Stone Lion*, 110 USPQ2d at 1161; *In re Yawata Iron & Steel Co., Ltd.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of

²⁵ Applicant’s Br., p. 32, 32 TTABVUE 40.

²⁶ *Id.*

trade and classes of purchasers are considered to be the same); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011). Further, the record shows that all of the parties' goods are offered primarily, if not exclusively, through their catalog and internet websites.²⁷ Thus, the channels of trade are the same for all of the parties' goods.

The *du Pont* factors relating to similarity and nature of the goods and services and similarity of established, likely to continue channels of trade favor a finding of likelihood of confusion.

B. Conditions of sale

Next we consider the conditions under which the goods and services are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers. Purchaser sophistication or degree of care may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005)).

Applicant argues that “the care taken by fashion-conscious consumers and the price points of the goods and services at issue suggest that consumers would exercise significant care, decreasing any potential likelihood of confusion.”²⁸ However, as noted *supra*, the identifications in the application and Opposer's registrations do not include any limitations regarding marketing and all include goods offered at no

²⁷ See e.g., *Bush Test.*, 12 TTABVUE and *Grant Test.*, 27 TTABVUE.

²⁸ Applicant's Br., p. 27, 32 TTABVUE 35.

specified price point. Although Applicant argues that its catalog “prices reflect the high quality of the products, with most single articles of clothing costing upwards of \$100,”²⁹ many of Applicant’s products, such as sweaters, shorts, shirts, and jewelry, are offered for less than \$100.³⁰ We cannot assume, as Applicant urges, that such price points lead consumers to exercise a greater degree of care in purchasing Applicant’s goods. Rather, we must presume that Applicant’s and Opposer’s goods and services are marketed to all ordinary consumers of clothing, jewelry, and leather goods in the usual marketing channels. Ordinary consumers of these goods are likely to exercise only ordinary care, and given the lack of price restrictions in the identifications, may buy these items on impulse. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) (“When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.”). Accordingly, this factor favors a likelihood of confusion.

C. *Fame of the MIDNIGHT VELVET marks*

In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength.”); *Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72

²⁹ *Id.*

³⁰ See Exh. A to Grant test., 27 TTABVUE 57-78.

(TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); *McCarthy on Trademarks and Unfair Competition* § 11:83 (4th ed. 2017) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899. “[A] mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark. *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002).

We also note that fame is not an all-or-nothing proposition. “Fame for purposes of likelihood of confusion is a matter of degree that ‘varies along a spectrum from very strong to very weak.’” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (quoting *Palm Bay Imps.* 73 USPQ2d at 1694).

Fame may be measured indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments, and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Bose*, 63 USPQ2d at 1309.

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

Opposer introduced the evidence below to demonstrate the fame of its marks. Much of Opposer’s evidence regarding its income, advertising and sales was designated as confidential and filed under seal and, therefore, we refer to such evidence only in general terms.

1. Opposer has used its MIDNIGHT VELVET marks in commerce for mail order and catalog services in the field of jewelry, clothing and accessories, and housewares

since at least as early as 1987.³¹ Opposer owns U.S. registrations for MIDNIGHT VELVET marks dating back to 1988.³²

2. From 2012 to 2014, Opposer's gross sales from MIDNIGHT VELVET catalogs and products in the U.S. have been substantial, on the order of hundreds of millions of dollars.³³

3. Opposer's catalog advertising and promotional expenses for its MIDNIGHT VELVET marks are significant and encompasses a variety of advertising media, such as print catalogs and electronic media, including social media.³⁴

4. Opposer maintains an internet web site located at midnightvelvet.com which offers its goods for sale and which features information about Opposer's MIDNIGHT VELVET products.³⁵

5. Opposer maintains a Facebook page, which promotes the MIDNIGHT VELVET catalog and products.³⁶

While the record shows that Opposer has enjoyed commercial success and that its MIDNIGHT VELVET marks are distinctive and commercially strong, we find that Opposer's commercial success does not make Opposer's MIDNIGHT VELVET marks famous. That is, we cannot on this record find that consumers have been so exposed to the MIDNIGHT VELVET marks, or that they are so aware of them, that they can be considered famous. The overall record simply falls short of a persuasive showing

³¹ Bush Test., 12 TTABVUE 41.

³² 10 TTABVUE.

³³ Exh. 20 to Bush Test., 14 TTABVUE 115-16.

³⁴ *Id.*

³⁵ Bush Test., 12 TTABVUE 9.

³⁶ *Id.*

of fame especially because there is no testimony or evidence regarding the size of the clothing catalog market or the percentage of consumers who purchase clothing and accessories so as to indicate the reach of Opposer's marketing efforts; there is no testimony or evidence regarding whether Opposer's advertising expenditures are large or small vis-à-vis other comparable catalog companies; and there are no examples of unsolicited media referring to the renown of Opposer's MIDNIGHT VELVET products. As indicated above, while Opposer's sales and market share are impressive and are indicative of commercial success, we can only speculate about the actual impact of Opposer's mark on the minds of consumers and, therefore, we find that Opposer has failed to show that its mark is famous.

Nevertheless, based on Opposer's sales figures and its long use of the marks, we find that the MIDNIGHT VELVET marks are commercially strong marks. This *du Pont* factor favors a finding of likelihood of confusion.

D. Number and nature of similar marks in use on similar goods and services

We next consider the strength of the marks under the sixth *du Pont* factor, the number and nature of similar marks in use on similar goods and services. *Du Pont*, 177 USPQ at 567. If the evidence establishes that the consuming public is exposed to third-party use of similar marks used in connection with similar goods and services, it "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay*, 73 USPQ2d at 1693.

The record includes forty third-party registrations, owned by different entities, for marks containing the term VELVET, registered for, *inter alia*, clothing, jewelry, or retail clothing store services.³⁷ The following examples are most relevant.

Reg. No.	Mark	Relevant Goods/Services
2561686	VELVET ROSE	All women's, girl's and children's wearing apparel
2588946	DIAMOND VELVET	Diamond jewelry, namely necklaces, bracelets
2911833	VELVET	Clothing, namely, tops, bottoms, headwear, jackets, coats, and scarves
3101846	VELVET TOUCH	Jewelry consisting of precious metals, precious gemstones, semi-precious stones
3658483	ROYAL VELVET	Bath robes
3735493	VELVET INDUSTRIES	Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms
3850781	BLUE VELVET	Blouses; Dress shirts; Dresses; Hooded sweat shirts; Knit shirts; Skirts; Skirts and dresses
3883933	VELVET LOUNGE	Boots; Footwear for men; Footwear for men and women; Footwear for women; Infants' shoes and boots; Ladies' boots; Shoes; Winter boots; Women's shoes
4276657	CRYSTAL VELVET	Women's special-occasion lingerie and nightwear clothing
4416165	LOVE CRUSHED VELVET	Athletic apparel
4429892	VELVET BY GRAHAM & SPENCER	Retail store services, wholesale distributorship services, on-line retail store services, and telephone order services all in the fields of clothing, footwear, scarves, jewelry, watches, sunglasses, housewares, and leather goods
4486735	DIRTY VELVET	T-shirts, sleeveless T-shirts, long sleeved T-shirts, vests, sweatshirts, hooded sweatshirts, pullovers, hooded pullovers, jumpers, hooded jumpers, zip-up tops, denim jackets, cotton jackets, shorts, combat trousers, casual trousers, denim based trousers, hats, shoes, underwear including socks, sweatbands, belts

³⁷ Exh. H, 16 TTABVUE 78-273.

Reg. No.	Mark	Relevant Goods/Services
4778086	PEACH VELVET	Blouses; Dresses; Jackets; Pants; Shirts; Shorts; Skirts; Suits; Sweaters; Trousers
5140235	PINK VELVET	Gloves; Pants; Shirts; Women’s clothing, namely, shirts, dresses, skirts, blouses; Women’s hats and hoods; Women’s tops, namely, camis; Women’s underwear; Belts; Bottoms; Footwear for women; Men’s and women’s jackets, coats, trousers, vests; Men’s suits, women’s suits; Sarongs; Sweat shirts; T-shirts; Ties; Tops

Applicant made of record a number of excerpts from third-party websites of clothing retailers, including some third-party registrants, *supra*, that use the terms MINT, VELVET, or MIDNIGHT as part of their brand or to refer to clothing articles.³⁸ The following examples are most relevant:

- **RED VELVET**, an online store featuring women’s clothing. (<http://redvelvetvintage.com/collections/clothing>).
- **BLUE VELVET VINTAGE**, an online store featuring vintage women’s clothing. (<http://www.bluevelvetvintage.com/>).
- **THE VELVET BOUTIQUE**, an online boutique featuring women’s clothing. (<http://www.thevelvetboutique.com/>).
- **GREY VELVET**, an online store featuring women’s clothing. (<http://www.greyvelvetstores.com>).
- **VELVET BUTTON BOUTIQUE**, an online boutique featuring women’s clothing. (<http://velvetbuttonboutique.com/shop/>).
- **VELVET ICE COLLECTION**, an online boutique featuring women’s clothing. (<http://velveticecollection.com/collections/fashion>).
- **VELVET HEART**, an online store featuring women’s clothing. (<https://velvetheart.com/>).

³⁸ Exh. I, 16 TTABVUE 33-75.

- **MIDNIGHT RIDER**, an online store featuring women’s clothing. (<http://www.shopmidnightrider.com/collections/dresses>).
- **MIDNIGHT MAGNOLIA BOUTIQUE**, an online store featuring women’s clothing. (<http://themidnightmagnoliaboutique.com/>).
- **WWW.SHOPTHEMINTBOUTIQUE.COM**, an online store featuring women’s clothing. (<http://shopthemintboutique.com/>).
- **“MINT.”**, an online store featuring women’s clothing. (<http://www.mintclothingcompany.com/>).
- **KISS ME MINT**, an online store featuring women’s clothing. (<http://kissmemint.com/>).
- **PINK MINT BOUTIQUE**, an online boutique featuring women’s clothing. (<http://pinkmintboutique.com/>).
- **THE MINT JULEP BOUTIQUE**, an online boutique featuring women’s clothing. (<https://www.shopthemint.com/categories/dresses>).
- **PINK VELVET**, an online store featuring women’s jewelry. (<http://pinkvelvet.storenvy.com/>).
- **VELVET KITTEN**, an online store featuring women’s costumes and lingerie. (<http://www.lingeriediva.com/velvet-kitten>).
- **VELVET BY GRAHAM & SPENCER**, an online store featuring women’s clothing. (Velvet-tees.com).
- **VELVET ANTLER**, an online store featuring women’s clothing accessories. (Velvetantlernyc.com).
- **VELVET-EEZ**, a brand name for shoe and boot innersoles (<http://catalog.bamason.com/>)

Applicant argues that “[i]n this case, the sheer volume of registrations and uses of similar marks provides strong evidence that consumers would be able to distinguish between the distinctive marks at issue.”³⁹

³⁹ Applicant’s Br., p. 21, 32 TTABVUE 29.

For its part, Opposer argues that the “evidence of third party use is weak.”⁴⁰ Opposer first takes issue with some of the evidence because it is from foreign sources, the goods are no longer offered for sale, the uses do not include both MIDNIGHT and VELVET, there is no proof of actual use, or because the third-party usage does not “use the term as a mark.”⁴¹ In addition, Opposer argues that to the extent that third parties use MIDNIGHT or VELVET descriptively, “such uses do not relate to Opposer significantly more than the use of ‘Apple’ by an orchard relates to APPLE computers.” In other words, Opposer is arguing that descriptive use diminishes the probative value of the third-party usage.

Although Applicant’s evidence tells us nothing about the specific extent to which the third-party marks may have been used or the amount of exposure relevant customers may have had to them, the Federal Circuit has held that “even where the specific extent and impact of the usage has not been established,” such evidence of third-party use “can show that customers have been educated to distinguish between different marks on the basis of minute distinctions.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). In the words of the Federal Circuit, evidence of extensive use of a term by others as a mark can be “powerful on its face. . . .” *Jack Wolfskin*, 116 USPQ2d at 1136 (internal quotes omitted). “The weaker an opposer’s mark, the closer an applicant’s mark can come without causing

⁴⁰ Opposer’s Br., p. 44, 30 TTABVUE 51.

⁴¹ *Id.*

a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Juice Generation*, 115 USPQ2d at 1674.

The registrations and website excerpts show that marks with the term VELVET have been adopted and registered in dozens of instances in connection with clothing and accessories, including retail stores selling such goods. Further, many of these marks have similar structures to the parties’ marks wherein the first word modifies VELVET, e.g., CRYSTAL VELVET, DIAMOND VELVET, RED VELVET, PEACH VELVET, ROYAL VELVET, BLUE VELVET, DIRTY VELVET, and GREY VELVET. This evidence of third-party usage establishes that relevant consumers have been exposed to VELVET-formative marks in connection with the parties’ goods and services. *See Rocket Trademarks Pty Ltd., v. Phard S.p.A.*, 98 USPQ2d 1066, 1072 (TTAB 2011). Even if we discount the handful of examples Opposer takes issue with, the remaining evidence of third-party usage of the term VELVET is “powerful on its face” in establishing that Opposer is entitled to a “narrower range of protection” for its MIDNIGHT VELVET marks. *Jack Wolfskin* 116 USPQ2d at 1136.

Accordingly, the weakness of the term VELVET, particularly when used in connection with a term suggesting color for the sale of clothing and accessories, means that Opposer’s MIDNIGHT VELVET marks, despite their commercial strength, cannot bar the registration of every mark comprising VELVET also used in connection with clothing and accessories. Rather, marks comprising VELVET, including Opposer’s MIDNIGHT VELVET marks, will bar the registration of marks “as to which the resemblance to [Opposer’s mark] is striking enough to cause one

seeing it to assume that there is some connection, association or sponsorship between the two.” *Anthony’s Pizza & Pasta Int’l Inc. v. Anthony’s Pizza Holding Co.*, 95 USPQ2d 1271, 1278 (TTAB 2009), *aff’d*, 415 Fed. Appx. 222 (Fed. Cir. 2010) (quoting *Pizza Inn, Inc. v. Russo*, 221 USPQ 281, 283 (TTAB 1983)); *see also In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985) (“the public can be said to rely more on the non-descriptive portion of each mark.”).

This *du Pont* factor favors a finding of no likelihood of confusion.

E. Nature and extent of any actual confusion and length of time and conditions under which there has been concurrent use without evidence of actual confusion

A showing of actual confusion would of course be highly probative, if not conclusive, of a likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight. *See J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965). The issue before us is the *likelihood* of confusion, not actual confusion. *Herbko Int’l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (actual confusion not required). Given Applicant’s recent entry into the U.S. market, we cannot find that the absence of evidence of actual confusion supports a finding that confusion is not likely. This *du Pont* factor is neutral.

F. Similarity of the marks in their entirety as to appearance, sound, connotation and commercial impression

We now turn to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *Du Pont*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan*

Ltd., 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that where, as here, the goods and services are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods and services. *Coach Servs.*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Although marks must be considered in their entirety, it is settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the mark's commercial impression. *In re Nat'l Data Corp.*, 224 USPQ at 751 ("There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable.").

The term STYLE, in Registration No. 3223145 for the MIDNIGHT VELVET STYLE, is less dominant than the terms MIDNIGHT VELVET because the term STYLE is commonly used in the fashion industry and has less source indicating ability. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) ("DELTA," not the term "CAFE," is the dominant portion of the mark THE DELTA CAFE).

Turning to the first terms in the respective marks, MINT and MIDNIGHT, although they look and sound alike in that they include the letters "mi," "n," and "t," the terms are nevertheless different in appearance, meaning, and even sound to the

extent that they differ in the number of syllables. Regarding meaning, Applicant's Chief Operating Officer, Stuart Grant, testified that MINT means "fresh," such as "fresh mint tea."⁴² Opposer's President, Ann Bush, testified that MIDNIGHT means "a time of day," e.g., "midnight" or a color, e.g., "midnight blue."⁴³ These meanings are consistent with the dictionary definitions of the terms. MINT is defined as (1) "any of a family . . . of aromatic plants . . . *especially* : any of a genus . . . that include some used in flavoring and cookery, and (2) a confection flavored with mint."⁴⁴ MIDNIGHT is defined as (1) "the middle of the night; *specifically* : 12 o'clock at night, and (2) "deep or extended darkness or gloom."⁴⁵

With respect to the term VELVET, the record shows that it is conceptually weak; it is widely used in the clothing and fashion fields because it is descriptive of a type of fabric or suggestive of softness or luxury. Applicant disclaimed VELVET at the request of the Examining Attorney⁴⁶ and a number of the third-party registrations disclaim the term as well.⁴⁷

When we look at the marks in their entirety, as we must, in terms of sound, MINT VELVET and MIDNIGHT VELVET or MIDNIGHT VELVET STYLE are similar in that the dominant portions have the same number of words, begin with

⁴² Grant Test., 27 TTABVUE 13 and 36.

⁴³ Bush Test., 12 TTABVUE 71.

⁴⁴ <https://www.merriam-webster.com/dictionary/mint>. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions.

⁴⁵ <https://www.merriam-webster.com/dictionary/midnight>.

⁴⁶ Examiner's Amendment of May 26, 2015.

⁴⁷ Exh. H, 16 TTABVUE 78-273.

words containing the letters “mi,” “n,” and “t,” and end with the identical word VELVET. On the other hand, MINT and MIDNIGHT have a different number of syllables, thus giving the marks a different cadence.

Notwithstanding the slight similarity in sound, here we find critical the obvious distinctions between the marks in connotation and commercial impression. MINT VELVET suggests a fabric of light green color, “mint green,” which is confirmed by internet evidence submitted by Opposer.⁴⁸ Further, Stuart Grant testified that “‘mint’ is a reflection of freshness and newness, and the ‘velvet’ is connected with a luxurious feeling,” and that “‘Mint Velvet’ gives a feeling of freshness and new [sic]”⁴⁹ In contrast, MIDNIGHT VELVET suggests a fabric of dark blue or black color, which is confirmed by Ann Bush’s testimony that MIDNIGHT in MIDNIGHT VELVET suggests a “time of day” or “a color, a midnight blue.”⁵⁰ Thus, the marks have their own unique suggestion of different meanings and distinct commercial impressions—Applicant’s mark suggests lightness and freshness whereas Opposer’s marks suggest darkness and elegance.

Further, although both marks suggest a velvet fabric color, given the number of third party registrations for marks identifying other velvet colors, e.g., RED VELVET, PEACH VELVET, BLUE VELVET, and GREY VELVET, the fact that both marks suggest colored velvet is not sufficient by itself to find that the marks are similar in connotation. As a result, when confronted with the parties’ marks,

⁴⁸ 11 TTABVUE.

⁴⁹ Grant Test., 27 TTABVUE 14 and 37.

⁵⁰ Bush Test., 12 TTABVUE 71.

prospective consumers are unlikely to assume that Applicant's and Registrant's respective goods and services originate from the same source.

We find that when viewed against the background of significant third-party usage and registration of VELVET marks, the differences between the parties' marks in connotation and commercial impression outweigh the similarity in sound. This factor weighs in favor of a finding of no likelihood of confusion.

G. Conclusion

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. On balance, and taking into account the totality of the evidence of record, we find that Opposer has failed to prove by a preponderance of the evidence that the parties' marks so resemble one another as to be likely to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Trademark Act.

Decision: The opposition is dismissed.