

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: September 20, 2010

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Chanel, Inc.  
v.  
Frank Mauriello

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Opposition No. 91168097  
to application Serial No. 76604356  
filed on July 26, 2004

Opposition No. 91172654  
to application Serial Nos.  
76650737 filed on November 22, 2005  
76651132 filed on November 30, 2005  
76652820 filed on December 27, 2005  
76653044 filed on January 6, 2006  
76654037 filed on January 24, 2006  
76654830 filed on February 9, 2006  
76657982 filed on April 7, 2006  
76657983 filed on April 7, 2006

Cancellation No. 92046246

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Barbara A. Solomon and Michael Chiappetta of Fross Zelnick  
Lehrman & Zissu, P.C. for Chanel, Inc.

Brian R. Gibbons for Frank Mauriello.

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Before Quinn, Kuhlke and Taylor, Administrative Trademark  
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Frank Mauriello (hereinafter defendant) owns a registration on the Principal Register and several applications,<sup>1</sup> by which he seeks registration on the Principal Register, for the marks set forth below:

ENELLE (typed form) - Registration No. 2748181, filed on July 2, 2001, issued on August 5, 2003, for "umbrellas, wallets, purses, handbags, travel bags, business card cases, passport cases, clutch bags, key cases, attaché cases, duffel bags and tote bags" in International Class 18;



- Application No. 76604356, filed on July 26, 2004, for "umbrellas, wallets, purses, handbags, travel bags, business card cases, passport cases, clutch bags, key cases, attaché cases, duffel bags and tote bags" in International class 18;



- Application Serial No. 76650737, filed on November 22, 2005, for "umbrellas, wallets, purses, handbags, business card cases, clutch bags, key cases, and tote bags" in International Class 18;



- Application Serial No. 76651132, filed on November 30, 2005, for "authentic and imitation jewelry" in International Class 18;



- Application Serial No. 76652820, filed on December 27, 2005, for "sunglasses" in International Class 9;

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<sup>1</sup> The applications are all based on an allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b).

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- Application Serial No. 76653044, filed on January 6, 2006, for "umbrellas, wallets, purses, handbags, business card cases, clutch bags, key cases, and tote bags" in International Class 18;

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- Application Serial No. 76654037, filed on January 24, 2006, for "umbrellas, wallets, purses, handbags, business card cases, clutch bags, key cases, and tote bags" in International Class 18;



**ênêllê** - Application Serial No. 76654830, filed on February 9, 2006, for "umbrellas, wallets, purses, handbags, business card cases, clutch bags, key cases, and tote bags" in International Class 18;



- Application Serial No. 76657982, filed on April 7, 2006, for "jeans, pants, shorts, skirts, dresses, blouses, shirts, t-shirts, sweaters, sweatshirts, tank tops, swimwear, swimsuits, hosiery, socks, pantyhose, hats, headwear, panties, stockings, jackets, coats, robes, belts, footwear, shoes, scarves, gloves, and suits" in International Class 25; and

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- Application Serial No. 76657983, filed on April 7, 2006, for "t-shirts, sweatshirts, and tank tops" in International Class 25.

Chanel, Inc. (hereinafter plaintiff) brought these consolidated proceedings on the grounds that, as applied to defendant's goods, the marks so resemble plaintiff's previously used and registered famous CHANEL and CC logo

marks used on identical or closely related goods, as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d). In addition, plaintiff alleges that defendant's marks dilute and/or are likely to dilute the distinctive quality of plaintiff's marks under Trademark Act Section 43(c), 15 U.S.C. §1125. Finally, in Cancellation No. 92046246, plaintiff also alleges partial abandonment with regard to "business card cases, passport cases, key cases, attaché cases and duffel bags" under Trademark Act Section 18, 15 U.S.C. §1068.

By its answers defendant denies the salient allegations.<sup>2</sup>

#### **EVIDENTIARY ISSUES**

As a preliminary matter, we address plaintiff's motion (filed August 5, 2009) to strike (1) defendant's first notice of reliance on third-party registrations and file histories on the ground that defendant did not sufficiently

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<sup>2</sup> The equitable defenses of waiver, laches, estoppel, acquiescence, fair use, fraud, misuse, mistake, prior registration and unclean hands were not adequately pleaded and, moreover, defendant did not submit evidence or argument on these defenses. In view thereof, we have not considered them. Defendant's assertion "that it may be entitled to registration within a certain geographic region" may only be raised in the context of a concurrent use proceeding. Similarly, defendant's assertion that it may be entitled to registration for "certain channels of trade," is unavailing absent counterclaims to restrict plaintiff's registrations which cover all ordinary trade channels.

specify the relevance of the material being offered, and (2) exhibits B1-B45 attached to Mr. Gibbons' (defendant's outside counsel) testimonial declaration<sup>3</sup> on the ground that the website pages are not properly authenticated or identified. In view of the marks and claims in issue, defendant's reference to "its reliance on the following third-party registrations" and the listing of those marks, is sufficient to meet the requirement under Trademark Rule 2.122(e). *Mack Trucks, Inc. v. California Business News, Inc.*, 223 USPQ 164, 165 n. 5 (TTAB 1984) ("[T]he identification of the records as 'bulldog trademarks' is sufficient to meet that requirement since, as applicant has indicated, the relevance of the proffered registration records is largely self-evident from that fact"). To the extent it is not sufficient, defendant, in its response, has clarified the relevance of these third-party registrations. *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (failure to explain relevance of material is a curable defect). With regard to the website pages submitted under Mr. Gibbons' testimonial declaration, they have been properly identified and authenticated. We further note, that the Board now accepts printouts of website pages submitted under notice of reliance as printed publications

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<sup>3</sup> The parties stipulated to submission of testimony by declaration. Trademark Rule 2.123(b).

when the printout includes the date of publication or date that it was accessed and printed, and its source (e.g., the URL), which is the case here. *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). In view of the above, plaintiff's motion to strike is denied.

On November 24, 2009, plaintiff also moved to reopen testimony to submit an article published after the close of plaintiff's rebuttal testimony period. Plaintiff states that it "offers the Article to supplement its evidence already submitted concerning the fame of the CHANEL mark, particularly in relation to other well-established brands." Br. p. 2. To reopen testimony under these circumstances, "[t]he moving party must show not only that the evidence is newly discovered, but also that the evidence could not have been discovered earlier through the exercise of reasonable diligence." *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1790 (TTAB 1998), citing, *Canadian Tire Corp. v. Cooper Tire & Rubber Co.*, 40 USPQ2d 1537, 1539 (Comm'r 1996). The determination is committed to the discretion of the Board and in deciding a motion, the Board will consider, among other things: (1) the nature and purpose of the evidence sought to be added, (2) the stage of the proceeding, (3) the adverse party's right to a speedy and inexpensive determination of the proceeding, and (4) the need for closure once the trial period has been completed. *Id.*

While it is true that the evidence only became available after the close of trial, the new evidence does not warrant reopening this proceeding. It is similar to other evidence already submitted in support of plaintiff's assertion of fame and is, therefore, cumulative and redundant and is not likely to cause a different result or affect the outcome of the case. In addition, further delay would be prejudicial to defendant's right to a speedy and inexpensive determination of the proceeding. *Id.* In view thereof, plaintiff's motion to reopen to submit new evidence is denied.

**EVIDENCE OF RECORD**

The evidence of record consists of the pleadings herein and the files of the subject registration and applications. In addition, the record includes the following:

- (1) Plaintiff's notices of reliance on its status and title copies of its various CHANEL and CC logo registrations, printed publications, defendant's discovery responses, and excerpts from defendant's discovery deposition;
- (2) Plaintiff's testimony declarations with exhibits of Dr. Gerald L. Ford, partner in the marketing research and consulting firm of Ford Bubala & Associates, Barbara Cirkva, plaintiff's Division President of Fashion, Watches & Fine Jewelry, Veronica L. Hrady, plaintiff's Vice President General Counsel, Mario Ortiz, paralegal with plaintiff's outside counsel, and cross examination of defendant Frank Mauriello;
- (3) Defendant's notices of reliance on third-party registrations, plaintiff's discovery responses, and printed publications; and

(4) Defendant's testimony declarations, with exhibits, of Frank Mauriello, defendant, and Brian R. Gibbons, defendant's outside counsel.

**PRIORITY/STANDING**

Plaintiff made of record its pleaded registrations, all of which are in full force and effect and owned by plaintiff.<sup>4</sup> The most relevant registrations are summarized as follows:

**CHANEL** - Registration No. 612169 for "necklaces" in US Class 28,<sup>5</sup> filed on November 24, 1954, issued on September 13, 1955, Section 8 accepted, Section 15 acknowledged, renewed;

**CHANEL** - Registration No. 626035 for "women's handbags" in US Class 3, filed on December 16, 1954, issued on May 1, 1956, Section 8 accepted, Section 15 acknowledged, renewed;

CHANEL (in typed form) - Registration No. 902190 for "bracelets, pins, and earrings" in International Class 28, filed on May 28, 1969, issued on November 10, 1970, Section 8 accepted, Section 15 acknowledged, renewed;

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<sup>4</sup> Plaintiff also made of record several unpleaded registrations. Inasmuch as applicant addressed plaintiff's marks in a general inclusive manner and made no objection to the unpleaded registrations, we consider the unpleaded registrations to have been tried by implied consent pursuant to Fed. R. Civ. P. 15(b), and that the notices of opposition and petition to cancel are deemed amended to conform to the evidence.

<sup>5</sup> The prior United States classification continues to govern for all statutory purposes for trademark applications filed on or before August 31, 1973, and all registrations issued on the basis of an application filed on or before August 31, 1973, unless the owner of the registration amends the registration to adopt international classification. Trademark Rule §2.85(b); Trademark Manual of Examining Procedure (TMEP) §1401.02 (6<sup>th</sup> ed. 2<sup>nd</sup> rev. 2010).



- Registration 1241264 for "suits, jackets, skirts, dresses, pants, blouses, tunics, sweaters, cardigans, tee-shirts, coats, raincoats, shawls, scarves, shoes and boots" in International Class 25, filed on April 14, 1982, issued on June 7, 1983, Section 8 accepted, Section 15 acknowledged, renewed;

CHANEL (typed form) - Registration No. 1241265 for "suits, jackets, skirts, dresses, pants, blouses, tunics, sweaters, cardigans, tee-shirts, raincoats, scarves, shoes and boots" in International Class 25, filed on April 14, 1982, issued on June 7, 1983, Section 8 accepted, Section 15 acknowledged, renewed;



- Registration No. 1271876 for "clothing - namely, coats, dresses, blouses, raincoats, suits, skirts, cardigans, sweaters, pants, jackets, blazers, and shoes" in International Class 25, filed on November 21, 1979, issued on March 27, 1984, Section 8 accepted, Section 15 acknowledged, renewed;



- Registration No. 1293398 for "retail store services in the field of ready-to wear clothing and shoes" in International Class 42, filed on April 14, 1982, issued on September 4, 1984, Section 8 accepted, Section 15 acknowledged, renewed;



- Registration No. 1314511 for "leather goods, namely, handbags" in International Class 18, filed on March 26, 1982, issued on January 15, 1985, Section 8 accepted, Section 15 acknowledged, renewed;

## CHANEL



- Registration No. 1329750 for "blouses, skirts, sweaters, cardigans, dresses" in International Class 25, filed on June 25, 1984, issued on April 9, 1985, Section 8 accepted, Section 15 acknowledged, renewed;

CHANEL (typed form) - Registration No. 1347677 for "leather goods - namely, handbags" in International Class 18, filed on March 26, 1982, issued on July 9, 1985, Section 8 accepted, Section 15 acknowledged, renewed;



- Registration No. 1501898 for, inter alia, "blouses, shoes, belts, scarves, jackets, men's ties" in International Class 25, filed on February 9, 1987, issued on August 30, 1988, Section 8 accepted, Section 15 acknowledged, renewed;



- Registration No. 1654252 for "sunglasses" in International Class 9, filed on September 17, 1990, registered on August 20, 1991, renewed;

CHANEL (in typed form) - Registration No. 1733051 for "leather goods; namely, handbags, wallets, travel bags, luggage, business and credit card cases, change purses, tote bags, cosmetic bags sold empty, and garment bags for travel" in International Class 18, filed on January 31, 1992, issued on November 17, 1992, Section 8 accepted, Section 15 acknowledged, renewed;



Registration No. 1734822 for "leather goods; namely, handbags, wallets, travel bags, luggage, business card cases, change purses, tote bags, and cosmetic bags sold empty" in International Class 18, filed on January 31, 1992, issued on November 24, 1992, Section 8 accepted, Section 15 acknowledged, renewed;



- Registration No. 3022708 for, inter alia, "ski goggles, sunglasses" in International Class 9, "luggage, handbags, totes, backpacks, travel bags, all-purpose carrying bags, umbrellas" in International Class 18, "boots, coats, jackets, gloves, hats, pants, sandals, scarves, shirts, shoes, ski boots, sun visors, suspenders, sweatbands, swimwear" in International Class 25, filed on October 8, 2004, issued on December 6, 2005;



- Registration No. 3025934 for "handbags" in International Class 18, filed on October 8, 2004, issued on December 13, 2005; and



- Registration No. 3025936 for, inter alia, "mobile phone straps, eyeglass frames, sunglasses" in International Class 9 and "gloves, swimwear" in International Class 25, filed on October 8, 2004, issued on December 13, 2005.

Because plaintiff has made its registrations of record and has shown that the registrations are valid and subsisting and owned by plaintiff, plaintiff has established its standing to oppose and petition to cancel registration of defendant's marks. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

As to priority, defendant relies on the filing dates of its registration and applications for its prior use date. *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 36 USPQ2d 1328, 1332 (TTAB 1998), quoting, *Alliance Manufacturing Co., Inc. v. ABH Diversified Products, Inc.*, 226 USPQ 348, 351

(TTAB 1985); and Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542 (TTAB 1991).

With regard to the opposition proceedings, plaintiff's priority is not in issue as to the marks and goods covered by plaintiff's registrations made of record. See King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, through the declaration testimony of Barbara Cirkva plaintiff has shown, at a minimum, use analogous to trademark use, sufficient to establish its priority of use of the mark CHANEL in connection with sunglasses. Cirkva Test. ¶15, Exhs. K and L (internet and print advertising).<sup>6</sup> Herbko International Inc. v. Kappa Books Inc., 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002); National Cable Television Ass'n, Inc. v. American Cinema Editors, Inc., 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991); and Stickley, Inc. v. Ronald C. Cosser, 81 USPQ2d 1956 (TTAB 2004).

With regard to the cancellation proceeding, plaintiff's filing dates of the most relevant registrations are earlier than the filing date of defendant's registration. Because defendant relies on its filing date as the constructive date of first use, plaintiff has also established priority with

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<sup>6</sup> While it is possible the mark CHANEL is embossed on the inside of the sunglasses, it is not possible to discern this from the exhibits of record. See, e.g., Cirkva Test. Exh. H.

respect to defendant's registration. *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998).

Accordingly, we turn to the question of likelihood of confusion.

#### LIKELIHOOD OF CONFUSION

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

Plaintiff has presented argument and evidence on the du Pont factor as to the fame of its marks, and we begin with this factor because fame "plays a 'dominant' role in the process of balancing the du Pont factors." *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). "[T]he fame 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 Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). However, "[b]ecause 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." *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901 (TTAB 2007).

The CHANEL and CC logo marks have been used in the United States for nearly ninety years and are displayed prominently on the product packaging as well as the products themselves, and in some cases, as in sunglasses and jewelry, the CC logo marks are the focal point of the product. *Cirkva Test.* ¶¶11-13. Plaintiff has used and registered its marks in connection with a wide variety of goods, including perfume, cosmetics, handbags, jewelry, sunglasses and a wide variety of clothing. *Id.* ¶¶13-14; NOR (plaintiff's registrations). As shown through the testimony and other evidence, plaintiff has had and continues to have extensive sales under and advertising expenditures in connection with its CHANEL and CC logo marks.<sup>7</sup> *Id.* ¶¶16, 28. Moreover, plaintiff's advertising and sales statistics are presented in the context of a broad, organized and aggressive marketing strategy that places its marks in front of consumers in a variety of ways (e.g., national magazines and newspapers with wide circulation, television and feature films, celebrity endorsements, celebrity photographs in

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<sup>7</sup> The exact figures were submitted under seal.

magazines, on the Internet and outdoor media). Id. ¶¶28-34. In addition, plaintiff's marks are the subject of significant unsolicited media coverage "addressing everything from the history of the brand, recent fashion collections for the brand, reaching tens, likely hundreds of millions of readers annually." Br. p. 24; Cirkva Test. ¶¶36-40; NOR Exh. 7. The record also includes brand surveys conducted by and published in "Women's Wear Daily" (WWD), the fashion industry trade magazine, and one commissioned by plaintiff as part of its regular course of business. The WWD surveys have ranked the CHANEL brand among the top 50 most recognized brands for each of the last five years.<sup>8</sup> Cirkva Test. Exh. Q.

Defendant does not dispute or rebut plaintiff's evidence of fame.

On this record, we find that plaintiff has more than fulfilled its duty to establish that its CHANEL marks and all of the variations of the CC logo design marks are extremely famous and have been a fashion fixture for nearly a century in the United States. Based on this finding, we accord the CHANEL and CC logo marks a very wide scope of protection.

We turn then, to consider the du Pont factors of the relatedness of the goods, channels of trade and classes of

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<sup>8</sup> The results of plaintiff's survey were submitted under seal.

purchasers. We must make our determinations under these factors based on the goods as they are identified in the respective registrations and applications. See *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("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, the particular channels of trade or the class of purchasers to which sales of the goods are directed.")

Each of defendant's applications and his registration contain goods that are identical to plaintiff's goods listed in its corresponding registrations and its established common law use. See *supra*. To establish this du Pont factor, i.e., that the goods are related, it is sufficient that any item encompassed by the identifications of goods is identical or related. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981).

Further, inasmuch as the identifications of goods are identical in part, we must presume, for purposes of the likelihood of confusion analysis, that the trade channels and classes of purchasers are identical. *Hewlett-Packard*

Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and Octocom, 16 USPQ2d 1783.

Moreover, inasmuch as the registrations and applications do not limit their goods to the high end of the market, purchasers would include ordinary members of the general public. The applicable standard of care is that of the least sophisticated purchaser of the goods. *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020 (TTAB 2009); *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301 (TTAB 2004). Thus, the conditions of sale include less sophisticated consumers exercising a lower level of care. These factors all favor plaintiff.

Against this backdrop, the extreme fame of plaintiff's marks and the identical nature of defendant's goods, we consider the similarities and dissimilarities of the marks. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) ("A strong mark ... casts a long shadow which competitors must avoid. ... Thus, the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark's fame increases, the Act's tolerance for similarities in competing marks falls."); *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989), quoting, *Planter's Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ

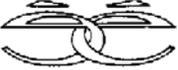
504, 511 (CCPA 1962) (“... there is ‘no excuse for even approaching the well-known trademark of a competitor’”). See also *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (“When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.”)

It is the defendant’s contention that the marks are not similar and their dissimilarities outweigh all other factors, in particular, when consideration is given to the marketplace in which their respective marks appear.

We examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under the respective marks is likely to result. In making our determination, we must keep in mind the fallibility of human memory. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks.

Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

As shown above, defendant's filings began with the word mark ENELLE, progressed to the back-to-back interlocking letter logo design and then evolved into various composite marks of the logo design with the word ENELLE.

We first compare defendant's logo marks  and  in, respectively, Application Serial No. 76604356 for, inter alia, handbags, and Application Serial No. 76657982 for, inter alia, blouses, shoes and scarves.

Plaintiff's closest marks are its logo marks  for handbags in Registration No. 1314511 and  for, inter alia, blouses, shoes and scarves in Registration No. 1501898. The parties' marks are identical in nature in that they both comprise back-to-back, mirror image, interlocking letters of semi-circular shape. Defendant points to the differences in the marks, specifically that its mark "is composed of two thin lowercase E's, each in a compressed letterform in which the letters are markedly wider than they are tall [and a]n accent mark appears above each E, and the backs of the E's are close together, with only a very small

amount of white space surrounded by the intersection of the letters. ... [and are different i]n letter choice, font, proportionality, accents and spacing of the mark's elements." Br. pp. 21-22.

On balance, and viewing the marks in their entireties, we find the overall commercial impression of the marks to be very similar and it outweighs any perceived differences in appearance or connotation. In particular, the line of the E is so thin and placed so high that it is easily missed. We further observe that given the manner of display of these logo marks directly on the goods which is common in the fashion industry, it makes them more susceptible to confusion. Such a display can mask differences and we note in one example, as displayed on handbags, plaintiff's logo mark is intersected by the bag closure which creates a line that bisects the interlocking CC's as shown below.



We next compare defendant's marks that combine the EE logo with the word ENELLE shown below:



for, inter alia, handbags in  
Application Serial No. 76650737;



ênelle, for, inter alia, handbags in  
Application Serial No. 76654830;



, for inter  
alia, handbags in Application Serial No. 76654037;  
and



for t-shirts,  
sweatshirts, tank tops in Application Serial No.  
76657983.

The interlocking letter design is very prominent in all of the marks and dominates the first two. Given the similarity of the logo design, the overall commercial impression is confusingly similar. This similarity is exacerbated by the additional word ENELLE which is similar in sound to CHANEL and in the last two marks listed above where the back-to-back EE logo could be mistaken for a back-to-back CC logo, the likelihood of confusion is heightened. Thus, we find these marks to be similar to plaintiff's CC logo marks. See *Envirotech Corp. v. Nat'l Serv. Indust., Inc.*, 197 USPQ 292, 296 (TTAB 1977) ("[T]he addition by applicant of the mark 'LITHONIA' to applicant's sun design is not in our opinion sufficient to preclude likelihood of confusion between applicant's resulting mark and opposer's sun design mark"). Further, plaintiff also has registrations for its CHANEL and CC logo marks combined for

various clothing items, leather goods and retail store services featuring these goods:

**CHANEL**

BOUTIQUE



Registration No. 1420554 for retail store services for clothing and handbags;

**CHANEL**

IDENTIFICATION

Registration No. 2579752 for handbags and clothing items; and

**CHANEL**



Registration No. 1329750 for clothing items.

In addition, the record contains many examples of plaintiff's use of its composite marks in its advertising for various fashion products. We find defendant's composite marks also to be very similar to plaintiff's composite marks.

This leaves the marks **ênelle** in Application Serial Nos. 76651132 for jewelry, 76652820 for sunglasses and 76653044 for, inter alia, handbags, and ENELLE (in typed form) in Registration No. 2748181 for, inter alia, handbags. Defendant's argument that the marks "differ markedly in pronunciation and aural impression" because the "accent marks over each 'e' in Mauriello's mark make it clear that each vowel should be stressed," is misplaced. Br. p. 20. It is well established that there is no correct

pronunciation of a trademark and defendant admits that some people pronounce ENELLE in a manner that rhymes with plaintiff's CHANEL marks. Pl. NOR. Exh. 2, Discovery Dep. of Defendant pp. 84-85. See *Centraz Industries Inc. v. Spartan Chemical Co. Inc.*, 77 USPQ2d 1698, 1701 (TTAB 2006). Thus, both marks can be pronounced as two syllables. Based on the rhyming and structure of two syllables, CHANEL and ENELLE have a similar feel and cadence. Moreover, both marks evoke the impression of a French connection, CHANEL through its French founder and defendant's mark through the use of the French suffix "ELLE," as was defendant's intention. *Mauriello Test.* p. 1 ("This trademark was selected due to its pleasant sound, and as a composition of the prefix 'en-' and the word '-elle', which is both a common French word for girl as well as a part of my surname.") While plaintiff's CHANEL marks are distinct from defendant's mark because they begin with the "sha" sound, given the fame of plaintiff's marks and defendant's use and intent to use its marks on identical goods, the differences in sound and appearance are not sufficient to overcome the similarities in the marks, in particular, the similarity in overall commercial impression. *Kenner Parker Toys*, 22 USPQ2d at 1458 ("Despite the dangers that consumers may receive the same commercial impression from both marks, the Board incorrectly discounted the evidence of similarity due

to the fame of PLAY-DOH.") Finally, with regard to the mark ENELLE in the registration, it is in typed form and therefore, we must consider all reasonable displays, including plaintiff's font. In re RSI Systems, LLC, 88 USPQ2d 1445 (TTAB 2008).

In view of the above, the du Pont factor of the similarity of the marks weighs in favor of plaintiff with respect to the marks in defendant's registration and each of his applications.

Defendant states that plaintiff "would have the Board believe that its marks are so famous that anyone seeing any other mark composed of intersecting circular letters or ending in '-nel' would confuse that mark with [plaintiff's] own." Br. p. 28. Clearly, as discussed above, the points of similarity are greater than defendant's assertion, and the goods upon which the marks appear are identical. Moreover, as noted above, famous marks are "entitled to a broader scope of protection than one which is relatively unknown ... because the issue in a trademark registration conflict such as this is the likelihood that, because of the marks used on the involved goods, there will be confusion, mistake or deception as to the source of those goods and confusion is more likely to occur where a mark is very well known or even famous because there is a propensity of consumers to associate a little-known mark with one which is

familiar to them." *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1900 (TTAB 1989).

Finally, defendant's attempt to narrow the protection of plaintiff's mark based on the du Pont factor of "the number and nature of similar marks in use on similar goods" is not persuasive. Defendant relies heavily on its argument that "the field of relevant third-party marks is crowded." Defendant asserts that it "has provided evidence of over twenty marks ending in 'nel' or 'nelle' being used in the relevant field." Br. p. 28. In addition, defendant asserts that it "has provided evidence of fourteen CC marks being used on or in connection with the relevant field of products. ... eight marks comprised of intersecting lowercase e's ... [and] nineteen marks which include or are composed of intersecting circular letters." Br. p. 29.

It cannot be disputed that it is common practice for designers to use initials as trademarks, and defendant's evidence corroborates this marketplace reality. However, defendant's evidence is not sufficient to diminish, in any way, the broad scope of protection to be given the CHANEL and CC logo marks based on their longstanding fame. The vast majority of third-party examples cannot be considered within the scope of similarity to defendant's logo mark. Most of the examples have distinguishing features not present in defendant's marks. For example, one of

defendant's proffered third-party interlocking letter marks

is  registered by the Washington Nationals Baseball Club, LLC for, inter alia, caps, hats, visors, shirts, shorts, baseball uniforms, jogging suits, ties and socks; and one of its "nelle" marks is JOURNELLE registered by Quotidienne, LLC for use in connection with lingerie and undergarments. As to the handful of examples that arguably fall more within the scope, there is little to no evidence of their use and no evidence from which to find broad consumer exposure to these other marks.

To the extent defendant is attempting to imply that because plaintiff has not attempted to stop use or registration of these marks, it should not be allowed to object to defendant's registration of its marks, as noted above, almost all of the third-party marks presented by defendant are not close to plaintiff's marks, and in the closest example, plaintiff, in fact, has objected to that mark. Hrdy Test. Exh. Z. Moreover, a party is not obligated to search and destroy every use, application or registration of a trademark that could conceivably be likely to confuse consumers. However, over the years plaintiff has, in fact, engaged actively in policing use and registration of confusingly similar marks and routinely files against counterfeit and other confusingly similar marks. Plaintiff has been recognized by the press as one of

the top-ten filers of trademark lawsuits. Hrды Test. Exh. Y "The New York Times." It is clear from the record that many seek to ride on the coattails of plaintiff's fame.

As to the factor of actual confusion, defendant asserts that plaintiff is unaware of any incident of actual confusion between its marks and the list of third-party marks presented by defendant. In applying the du Pont factor of "the nature and extent of any actual confusion," we look to the marks in issue, i.e., any actual confusion between plaintiff's marks and defendant's marks, and not between plaintiff's marks and the world, including the third-party marks cited by defendant. Inasmuch as the record shows that there has not been a meaningful opportunity for such confusion to have occurred between plaintiff's and defendant's marks, we consider this factor to be neutral.

Finally, in support of its case, plaintiff also submitted a likelihood of confusion survey conducted for the EE logo for use in connection with umbrellas, wallets, purses, handbags, travel bags, business card cases, passport cases, clutch bags, key cases, attaché cases, duffel bags and tote bags. While the survey has probative weight as to likely confusion with regard to that specific mark and goods, we reject plaintiff's attempt to extend the relevance of that survey to plaintiff's other marks and goods.

Turning then to the survey, plaintiff asserts that it strongly supports a finding of likelihood of confusion. We accept, and defendant has not disputed, the competence of plaintiff's survey expert, Mr. Ford. According to Mr. Ford, the survey indicates that "approximately fourteen percent ... of the relevant universe of potential purchasers of one or more of [defendant's] intended products expressed the belief that [defendant's] products bearing the stylized "ee" logo mark are either put out by [plaintiff], are put out with the authorization/approval of [plaintiff], or that the company that puts out the products has a business affiliation/connection with [plaintiff]." Ford Test. ¶10.

In understanding the relevance of a particular percentage, courts and the Board find likelihood of confusion when a "substantial" or "appreciable" number of consumers are likely to be confused. In analyzing percentage numbers then, courts will extrapolate a percentage to the actual number of potentially confused consumers. Thus, in our case, fourteen percent, represents quite an appreciable number of potential consumers, based on the class of consumers being those members of the public interested in purchasing handbags, etc., or even, based on plaintiff's annual sales. *James Burrough, Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 192 USPQ 555, 565 (7<sup>th</sup> Cir. 1976) ("We cannot agree that 15% is 'small.' Though the

percentage of likely confusion required may vary from case to case, we cannot consider 15 percent, in the context of this case, involving the entire restaurant-going community, to be de minimis.") See also *Humble Oil & Refining Co. v American Oil Co.*, 405 F.2d 803, 160 USPQ 289, 299 (8<sup>th</sup> Cir. 1969), cert. denied, 395 US 905 (1969) ("Despite all this, the surveys, singly and as a group, do not dispel the existence of a percentage of confusion which we may not dismiss as de minimis. The percentage figure varies from 11% to as high as 49%. The lower figure itself is not an insignificant percentage. The record discloses that the number of motorists in the Midwest is in the millions. Eleven percent of a figure in the millions is a large number.")

Mr. Ford further explains the significance of the survey results when compared to the results of the control group:

Specifically, the survey results make clear that the causal nexus for likelihood of confusion is the appearance of the stylized "ee" logo mark and is not due to any other alternative explanation. Because the control cell, using the dissimilar yet interlocking fictitious stylized "mm" logo mark, also employed the same list of products and asked the same survey questions, and resulted in less than one percent likelihood of confusion with Chanel, it is certain that the measured likelihood of confusion is attributable solely to the presence of the stylized "ee" logo mark. Conversely, the survey results also make clear that the use of a dissimilar mark in conjunction with the list of Applicant's intended products is not likely to cause confusion.

Ford Test. pp. 5-6.

Defendant attacks the probative value of the survey, by contending that the survey questions were biased. We find no such deficiency. The survey was conducted well within the parameters of the likelihood of confusion survey formats accepted by the Board. See, e.g., Starbucks U.S. Brands LLC v. Ruben, 78 USPQ2d 1741 (TTAB 2006), Carl Karcher Enterprises Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125, 1132 (TTAB 1995). Thus, we find that it is reliable and has probative value on the issue of likelihood of confusion as to the EE logo used in connection with the Class 18 goods. Starbucks, at 1753.<sup>9</sup>

Defendant also takes issue with plaintiff's classification of certain responses as belonging in the category of those indicating a connection to Chanel. While we do not agree with defendant's characterization, even if we were to subscribe to defendant's calculations which reduces the survey result to 9% being confused, this percentage has been recognized by courts as supporting a

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<sup>9</sup> Defendant's reference to the non-precedential opinion in Hormel Foods Corp. v. Spam Arrest, LLC, Slip Op. Cancellation No. 92042134 (November 21, 2007), is misplaced. The stated purpose of the survey in that case was to assess whether the name SPAM ARREST had attained secondary meaning and whether it diluted the distinctiveness of Hormel's SPAM trademark. The deficiencies in that survey flowed from the starting gate inasmuch as the claim in that case was likelihood of confusion, which sparks a different line of inquiry and requires a completely different analysis.

finding of likelihood of confusion. Grotian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons, 365 F. Supp. 707, 180 USPQ 506, 513 (S.D.N.Y. 1973), modified, 523 F.2d 1331, 186 USPQ 436 (2d Cir. 1975) (8.5% sufficient to show likely confusion between the marks STEINWAY and STEINWEG for piano consumers). Defendant further argues that several respondents indicated the EE logo was connected to another brand, specifically, Coach; however, this does not diminish the findings as to Chanel, and, in fact, reinforces the argument that the EE's look like CC's. We also note a review of the survey responses reveals that some potential consumers perceive defendant's EE logo as C's rather than E's. See Ford Test. Exh. A ("Looks like backward c's." "Because of the c's." "They look like two cc's." "Because of the two c's that connect." etc.) At a minimum, this certainly undermines defendant's argument that the difference in the letters serves to distinguish the marks.

Finally, we note that the survey merely serves to corroborate what the other evidence of record already demonstrates. Thus, although we find the survey proper and probative, it is not necessary to our determination.

As to the factor of intent, plaintiff argues that defendant's:

... attempt to break into the fashion and accessory business bears out his intent. After selecting the ENELLE mark, he set out to add a logo. Mauriello considered a logo consisting of a

single letter "e." Yet, he did not use that.

Instead, he adopted . The selection of this logo, like the selection of the ENELLE mark, was done with constructive knowledge of Chanel's marks, and with actual notice of the CHANEL and  marks.

Br. p. 37 (citations to record omitted).

In response, defendant argues that his:

...selection of the ENELLE mark was based upon using part of his name as his mark, as well as a common French word. Likewise, the EE logo was based on his ENELLE trademark, and selected based upon the widespread use of intersecting initials in the field of clothing, handbags and other leather goods. As is shown by the crowded field of similar marks, these beliefs were reasonable and well-founded.

Br. p. 34.

Bad faith, or intent to confuse, falls under the thirteenth du Pont factor "any other established fact probative of the effect of use." *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2008). "[W]hen there is evidence of an applicant's intent to adopt a mark that suggests to purchasers a successful mark already in use by another, the Board may, and ought to, take into account that intent when resolving the issue of likelihood of confusion when that issue is not free from doubt." *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1633 (TTAB 1988). See also *Roger & Gallet S.A. v. Benice Trading Co. Inc.*, 1 USPQ2d 1829, 1832 (TTAB 1987). However, "an inference of 'bad faith' requires something

more than mere knowledge of a prior similar mark." Sweats Fashions, Inc. v. Pannill Knitting Co., Inc., 833 F.2d 1560, 1565, 4 USPQ2d 1793 (Fed. Cir. 1987). See also TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); Action Temporary Services Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ2d 1307, 1310 (Fed. Cir. 1989); and Ava Enterprises Inc. v. Audio Boss USA Inc., 77 USPQ2d 1783, 1787 (TTAB 2006).

This record does not establish that defendant intended to adopt his marks in bad faith. We recognize that defendant was aware of plaintiff's marks when defendant adopted his marks and over time defendant's marks progressed from the word mark ENELLE that is similar in sound and cadence to CHANEL to the back-to-back interlocking logo design that is strikingly similar in appearance and commercial impression to plaintiff's marks. However, while this may be enough to "raise and eyebrow," it is not sufficient to prove an *intent* to confuse. Ava Enterprises, 77 USPQ2d at 1789.

In any event, it is well established that as a newcomer defendant has both the opportunity and the obligation to avoid confusion and one who adopts a mark similar to the mark of another for the same or closely related goods does so at his own peril. W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc., 190 USPQ 308 (TTAB 1976).

On balance, the relevant du Pont factors weigh in favor of a likelihood of confusion. In view of the fame of plaintiff's marks, the identical nature of the goods, channels of trade and classes of customers, and the similarity of the marks, we conclude that there is a likelihood of confusion between defendant's marks in its registration and each of its applications and plaintiff's CHANEL and CC logo marks. To the extent there is any doubt with regard to the question of likelihood of confusion, such doubt must be resolved in favor of plaintiff, the prior user and registrant. *Hewlett-Packard*, 281 USPQ2d at 1003 ("This court resolves doubts about the likelihood of confusion against the newcomer because the newcomer has the opportunity and obligation to avoid confusion with existing marks"); *Nina Ricci*, 12 USPQ2d at 1904 ("...all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous...").

Accordingly, plaintiff has proven its claims of likelihood of confusion under Section 2(d) of the Trademark Act as to these marks.

In view of our decision on likelihood of confusion, we do not reach the dilution claims brought under Section 43(c) and the claim of partial abandonment brought under Section 18.

Opposition Nos. 91168097 and 91172654; Cancellation No. 92046246

**Decision:** The oppositions are sustained and the petition to cancel is granted. Registration No. 2748181 will be cancelled in due course.