

**This Opinion is Not a
Precedent of the TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re MAC Mode GmbH & Co. KGaA
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Serial Nos. 79099041 and 79101237
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Thilo C. Agthe of Wuersch & Gering LLP for MAC Mode GmbH & Co. KGaA.

Charlotte K. Corwin, Trademark Examining Attorney, Law Office 119, Brett J. Golden, Managing Attorney.

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Before Seeherman, Wellington and Masiello, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

This is a consolidated appeal¹ involving the applications of MAC Mode GmbH & Co. KGaA (“Applicant”) for registration of the marks DREAM JEANS with designs, as shown below, for “clothing, namely, pants, jeans” in International Class 25.



¹ The appeal was consolidated by Board order mailed February 23, 2014, in response to Applicant’s motion to consolidate.

In both applications the word JEANS has been disclaimed and color is not claimed as a feature of the mark. Application Serial No. 79099041, in which the word JEANS is inverted, was filed on May 26, 2011; Application Serial No. 79101237 was filed on June 20, 2011. Both applications are based on Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a) (request for extension of an International Registration).

The Trademark Examining Attorney has refused registration of Applicant's marks pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's marks so resemble the marks DREAM JEANNE'S in standard characters² and DREAM JEANNES and design,³ shown below, both owned by the same entity and registered for "women's apparel, namely, jackets, jeans, skirts and shorts," that if used on Applicant's goods they are likely to cause confusion or mistake or to deceive.



Applicant and the Examining Attorney have filed briefs. We affirm the refusals to register.

² Registration No. 3971764, issued May 31, 2011.

³ Registration No. 3982583, issued June 21, 2011. The mark consists of the stylized wording "DreamJeannes" appearing among clouds and stars.

As a preliminary matter, we note the Examining Attorney's objection to the third-party registrations attached to Applicant's appeal brief. This evidence was not made of record during prosecution of the applications. Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal. Therefore, this evidence is untimely and we will not consider it. We further note that with its requests for reconsideration Applicant submitted a list, taken from the Patent and Trademark Office's TESS database, of registrations of marks in Class 25 that include the word DREAM(S) or JEANS. Such a list does not make the registrations of record, nor was it submitted at a point where, if the Examining Attorney had advised Applicant of the deficiency, Applicant could have cured it. In any event the list of the registrations has little or no probative value.

Turning now to the substantive issue, our determination of the issue of likelihood of confusion 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 & 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). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first consider the *du Pont* factor of the similarity of the goods. Applicant does not contest that this factor favors a finding of likelihood of confusion: “Applicant admits at the outset that the goods named in Applicant’s applications and in the cited registrations are, at the very least, closely related.” Brief, p. 3. In point of fact, the “[women’s] jeans” identified in Applicant’s applications are legally identical to the “jeans” identified in the cited registrations. The Examining Attorney has submitted third-party registration evidence to show the relatedness of the remaining goods, “pants,” in Applicant’s identifications of goods. In view of Applicant’s acknowledgement that “pants” and the goods in the cited registrations are related, there is no need for us to provide details of these registrations; suffice it to say that we agree with Applicant and the Examining Attorney that the identified “pants” are closely related to the clothing items in the registrations.

Since Applicant’s and the Registrant’s goods are in-part identical, they are deemed to be sold in the same channels of trade to the same classes of purchasers. The Examining Attorney has also submitted evidence that pants and, e.g., skirts and shorts, are sold through the same channels of trade, such as the websites for the Nordstrom and Macy’s department stores.⁴ Thus, the *du Pont* factors of the similarity of the goods and channels of trade favor a finding of likelihood of confusion.

⁴ The various items are displayed together on single webpages that were retrieved from a search for the general category of “women’s apparel”; thus, this is not simply a situation where the goods are part of a vast array of items that may be sold through an Internet website, but are items that a shopper could encounter in close proximity in looking for items of apparel.

When marks would appear on virtually identical goods or services, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). With that in mind, we turn to a consideration of the *du Pont* factor of the similarities of the marks.

First, the marks are identical in sound. Although the cited marks use the spelling JEANNE'S and JEANNES, respectively, these words are likely to be pronounced identically to the word JEANS in Applicant's marks. Applicant has argued that the registered marks will remind consumers of the television series "I Dream of Jeannie," and therefore they will pronounce the name as "Jeannie." We are not persuaded. First, it is unclear how many people actually know of and/or would remember this television series, which, according to the evidence submitted by Applicant, ran from 1965 to 1970. Second, the name in the title of the series is "Jeannie," not JEANNE or JEANNES. Even if there may be some people that view and pronounce JEANNE'S or JEANNES as "Jeannie's," it is still reasonable to conclude that a substantial number of consumers will pronounce the name as the phonetic equivalent of "JEANS," especially so given the context of the identified goods. Accordingly, we find that it is likely that the marks will be pronounced identically. Moreover, this similarity in pronunciation is significant because jeans may be recommended orally, with one friend telling another that they got a pair of DREAM JEANNES that they love. If the person then sees Applicant's marks, DREAM JEANS and design, on jeans, they are likely to believe that these are the

recommended jeans. *See Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006) (“inasmuch as the goods may be ... recommended by word of mouth, the similarity in sound is an important factor in comparing the marks, especially where, as here, identical products are involved.”).

As for the meanings of the marks, although JEANNE’S/JEANNES in the cited marks may have the meaning of a woman’s name, the evidence shows that this term has been promoted as also having the meaning of jeans, the garment. For example, the copy for “Quacker Factory ‘DreamJeannes’ Regular 5Pocket Knit Denim Boot Cut Pants” has the title “Not Your Ordinary ‘Jeannes’” and the statement “we’ve put the magic back in Jeannes!” QVC website, www.qvc.com. Office Action mailed May 9, 2013, p. 11-12. To this extent, Applicant’s and the Registrant’s marks have the same connotation. In addition, although normally the word JEANS in Applicant’s marks would be understood as referring to the garment, because “Jean” is a variant spelling of “Jeanne,” consumers familiar with the cited special form mark, which uses the “plural” form of the name JEANNES as a substitute for “jeans,” may view JEANS in Applicant’s marks also as the “plural” form of the name “Jean.”

Applicant argues that Registrant’s mark “clearly evokes the image of an ideal female person, and her goods, and even more likely a subtle reference to ‘I Dream of Jeannie,’” while Applicant’s mark “refers to the goods and a quality of the goods (that they are superior as well as made of denim),” brief, p. 7 and that “DREAM functions as an adjective and modifies the term JEANS, evoking the impression in

the consumer's mind that these jeans are attractive, wonderful, ideal—a dream,” and “creates a commercial impression and meaning in the mind of the consumer of superior clothing.” *Id.* at 8.

As we said above, we are not persuaded that consumers would understand the cited marks to be a reference to the TV series. In saying this, we have taken into account Applicant's argument that because of the cloud design in the cited DREAMJEANNES mark, consumers will be reminded of an illustration for the TV show, in which pink “smoke” appears to be coming out of a bottle. The cloud design in the Registrant's mark is not likely to be regarded as smoke, as there are also stars with the clouds. Instead, the cloud and stars design, when considered with the words, will be understood as a reference to the night sky, reinforcing the meaning of DREAM. Further, DREAM JEANNE'S in standard characters does not include a design, and therefore the meaning of that mark must be assessed without reference to a design element. As for the other meanings that Applicant suggests, we have already discussed that, regardless of whether JEANNE'S/JEANNES in the cited marks is viewed as a woman's name or as wordplay on the generic term for the garment, Applicant's and the cited marks convey similar meanings and similar commercial impressions.

As for the similarity or dissimilarity in appearance of the marks, we recognize that the design elements in Applicant's marks are a prominent part of each mark. However, the words DREAM JEANS in the marks are a noticeable part of the marks as well, and because they are the part of the marks by which consumers will

refer to the goods, the words DREAM JEANS will be noted and remembered. Thus, despite the differences in Applicant's marks and the cited marks resulting from the designs, there are also similarities due to the literal portions. In view of the identity in pronunciation and the similar meanings and commercial impressions, we find that the differences in appearance are not sufficient to distinguish Applicant's marks from the cited marks or, put another way, the similarity in sound, in particular, outweighs any differences in appearance. Given that Applicant's and the Registrant's marks are for legally identical goods, the marks are sufficiently similar for us to find that this *du Pont* factor favors a finding of likelihood of confusion.

Applicant argues that the cited marks are weak, and therefore the registrations should be given a limited scope of protection. However, as previously noted, Applicant has not properly made the proffered third-party registrations of record, nor has Applicant submitted any evidence of third-party use to support this argument.

The foregoing are the only *du Pont* factors discussed by Applicant or the Examining Attorney, and the only factors on which evidence has been submitted. To the extent that any others are relevant, we treat them as neutral.

After considering all of the arguments and evidence, we find that Applicant's marks are likely to cause confusion with the two cited registered marks.

Decision: The refusals to register Applicant's marks are affirmed.