

This Opinion is not a
Precedent of the TTAB

Mailed: November 2, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Forever 21, Inc.
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Serial No. 86678161
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Gene Bolmarcich of Law Offices of Gene Bolmarcich,
for Forever 21, Inc.

Andrea D. Saunders, Trademark Examining Attorney, Law Office 117,
Hellen Bryan-Johnson, Managing Attorney.

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Before Zervas, Wellington, and Adlin,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Forever 21, Inc. (“Applicant”) seeks registration on the Principal Register of the standard character mark **THE BEVERLY** for “denims; jeans; pants” in International Class 25.¹

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that

¹ Application Serial No. 86678161 was filed on June 29, 2015, based upon Applicant’s 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).

Applicant's mark, when used on the identified goods, so resembles the registered mark, shown below, for "pants; shirts; tops; bottoms" that it is likely to cause confusion:



When the refusal was made final, Applicant appealed and Applicant and the Examining Attorney filed briefs.

Likelihood of Confusion

Our likelihood of confusion determination is based on facts related to the relevant factors set out in *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., 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. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Similarity of the Goods/ Channels of Trade/ Consumers

With regard to the goods, channels of trade and classes of consumers, we must make our determinations under these factors based on the goods as they are identified in the cited registration and application. *See In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also Stone Lion Capital*

² Reg. No. 3539743 issued on December 2, 2008, Section 8 and 15 affidavits accepted. The word JEANS is disclaimed.

Partners, LP v. Lion Capital LLP, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Here, the goods in the application and those in the registration are identical (*i.e.*, “pants”), or legally identical because they encompass one another (*i.e.*, Applicant’s “denims” and “jeans” fall within the scope of Registrant’s “pants” and “bottoms”). When an applicant’s goods are identical to the registrant’s, we must presume that the channels of trade and classes of purchasers for those goods are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same). Both Applicant’s and the registrant’s goods will be therefore be sold to the general public, and will travel in the same trade channels, including retail apparel outlets and apparel websites.

In view of the above, these *du Pont* factors weigh heavily in favor of finding likelihood of confusion.

Similarity of the Marks

We now consider whether Applicant’s proposed mark, THE BEVERLY, is similar to the registered mark, BEVERLY JEANS, stylized with a design. We compare them

“in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). In making our determination we focus on the recollection of the average purchaser, who normally retains a general rather than specific impression of the trademarks. *In re Cynosure, Inc.*, 90 USPQ2d 1644, 1645 (TTAB 2009); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). *See also Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 73 USPQ2d at 1695 (“[G]eneral consumers, not just connoisseurs, occasionally purchase champagne or sparkling wines on celebratory occasions, with little care or prior knowledge”). We are also mindful that where, as here, the goods are identical, the degree of similarity between the marks necessary to find a likelihood of confusion need not be as great as where there are recognizable differences between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

We find the marks are confusingly similar as a result of the common element, BEVERLY, which dominates both marks. The additional elements in the registered mark have little to no source-identifying significance. Specifically, the additional word JEANS is generic and has been disclaimed, and the design element is essentially a rectangular border created by the repetition of the term BEVERLY, reinforcing the shared term’s significance.

Applicant argues that the marks are distinguishable because its mark will be perceived as a “style name” and that “no consumer of jeans would be confused as between ‘Beverly Jeans’ (brand) and ‘The Beverly’ (style name for Forever 21 Jeans).”³ To support this argument, Applicant submitted printouts from its own website and from third-party websites in order to show how Applicant’s mark is “actually used” and that it is “in conformance with marketplace convention for style names.”⁴ Applicant asserts that the evidence shows that “style names are commonly used in the jeans market” and “such style names commonly begin with the word ‘The.’”⁵

Applicant’s argument is not well taken because, regardless of whether Applicant only uses its mark to identify a style of jeans, there is no stopping Applicant from using the proposed mark as a source-identifier for pants, denims and jeans in general, and not merely as a *style name*. Furthermore, the argument implies that Applicant’s trade name or house mark, “Forever 21,” appears nearby. Again, there are no restrictions on Applicant’s use of its mark nor any guarantee that “Forever 21” will appear in proximity therewith. *See Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1914-15 (TTAB 2000) (use of parties’ house marks in close proximity to trademarks at issue irrelevant). Thus, we must consider Applicant’s mark will be the sole source-identifier of the goods.

³ 7 TTABVUE 3.

⁴ 4 TTABVUE 4. Printouts attached to Applicant’s response filed on February 1, 2016.

⁵ *Id.*

We have reviewed Applicant's evidence showing third-party use of the term "The" preceding another term (often a proper name), to identify a "style name" of clothing. However, we do not believe that Applicant's use of "The" before "Beverly" defuses the likelihood of confusion. Even if consumers perceive Applicant's mark as identifying a style name, as Applicant suggests, there is still a likelihood of confusion. Should consumers who are already familiar with Registrant's jeans sold under the mark BEVERLY JEANS stylized with a design encounter Applicant's mark THE BEVERLY on jeans, they are likely to be confused as to the source of the goods and may mistakenly believe that Applicant's mark is merely a reference to Registrant's style of jeans. Indeed, this would be consistent with Applicant's evidence showing third-party usage of "The" as a prefix in a second-reference to the same goods. For example:

Becca Bootcut Womens Jean - Description: **The Becca** is our modern bootcut fit.

Fayza Boyfriend Jeans 08851 Style: Cool blue stretch boyfriend jeans from Diesel in a medium wash with a slightly worn effect. **The Fayza** boyfriend jeans has a loose fit with a low waist.

Karlie Low Rise Bell Bottom (Short Inseam) Womens Jean – Description: Introducing **the Karlie**, our widest leg bell bottom.

Austyn Relaxed Straight in Los Angeles Dark – Description: **The Austyn** is a relaxed straight leg that is roomy through the hip and thigh."

Halle Super Skinny Distressed Womens Jean – Description: **The Halle** is our signature super skinny fit for women.

Ada Boyfriend In Bleached Destructed Vintage...Introducing our newest boyfriend jean. **The Ada** has a slouchier fit and higher rise than our other boyfriend, Emma...

Mavi Jeans Cora – Deep Black Paris Denim - Details: **The Cora** by Mavi Jeans is a flare jean with a low rise and slim fit...

Avedon Ultra Skinny in Ozone Blue – Details: **The Avedon** is an essential skinny jean with an ultra slim fit from hip to ankle.

[Emphasis in **bold** added].

In the event that consumers do not perceive a “style name” significance from Applicant’s addition of the “The” prefix, the marks are confusingly similar nonetheless. For these consumers, the addition of “The” will be perceived as having no source-indicating significance or as simply directing focus back to the common term, BEVERLY, which dominates both marks. *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (“The addition of the word ‘The’ at the beginning of the registered mark does not have any trademark significance. ‘The’ is a definite article. When used before a noun, it denotes a particular person or thing.”) (citing *inter alia Conde Nast Pubs. Inc. v. Redbook Pub. Co.*, 217 USPQ 356, 357 (TTAB 1983)).

The similarity of the marks is enhanced by the fact that BEVERLY has no demonstrated significance in connection with the involved goods and appears to be an arbitrary use of what is otherwise a proper name. Furthermore, it has not been shown that any other entities use this term and Applicant makes no argument that BEVERLY is a weak or diluted term for apparel.

Viewed in their entirety, Applicant’s THE BEVERLY mark is very similar to the registered mark BEVERLY JEANS, stylized with a design. This *du Pont* factor therefore also weighs in favor of finding a likelihood of confusion.

Conclusion

Based on our findings that the goods and their trade channels are identical, and the marks are overall very similar, we find that Applicant's proposed mark THE BEVERLY, if used on pants, jeans and denims, is likely to cause confusion with the registered mark BEVERLY JEANS, stylized with a design, on pants and bottoms.

Decision: The refusal to register under Section 2(d) is affirmed.