

This Opinion is not a
Precedent of the TTAB

Oral Hearing February 6, 2020

Mailed: March 25, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Tintoria Piana U.S., Inc.
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Serial No. 87776775
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Robert N. Cook of Whitham & Cook PC,
for Tintoria Piana U.S., Inc.

Alexandra Liebl, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

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Before Mermelstein, Goodman and Hudis,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Tintoria Piana U.S., Inc. (“Applicant”) seeks registration on the Principal Register of the mark PIANA HYDRO (in standard characters, PIANA disclaimed) for “Textile fibers, namely, fibers treated with hydrophobic chemicals providing water repellency” in International Class 22.¹

¹ Application Serial No. 87776775 was filed on January 30, 2018, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

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 Applicant's mark, when used with its identified goods, so resembles twelve previously registered LORO PIANA and LORO PIANA-inclusive marks, all owned by Loro Piana S.p.A. ("Registrant"), as to be likely to cause confusion, mistake or deception.²

The registered marks are as follows:

Registration No. 1282535 for the mark LORO PIANA (typed)³ for Class 24: coverlets, gloves, mufflers, plaids, shawls and other woolen goods;

Registration No. 1337982 for the mark LORO PIANA (typed)⁴ for Class 23: Yarns and Threads; Class 24: Bed Covers, Blankets; Class 25: Clothing for Men, Women and Children namely, Jackets, Coats, Skirts, Trousers, Cloaks, Mantles, Overcoats and Knitted Vests; Scarves, Mufflers, Shawls and Gloves;

Registration No. 1846780 for the mark



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for Class 23: yarns and threads; Class 24: fabrics for use in the manufacture of clothing, nightwear and bedding material; namely,

Page references to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board's TTABVUE docket system. Coming before the designation TTABVUE is the docket entry number; and coming after this designation are the page references, if applicable.

² The Examining Attorney originally cited fourteen registrations, but as noted by the Examining Attorney, 10 TTABVUE 3, n.1, one of the registrations, No. 4164958, has since been cancelled. In addition, another cited registration, No. 4292668, was cancelled during the pendency of this appeal.

³ "The name 'Loro Piana' is part of the name of a living individual whose consent is of record."

⁴ "The name 'Loro Piana' is the name of a living individual whose consent is of record."

⁵ "& C" is disclaimed. "The term 'ING' in the mark stands for 'engineer' and the letter 'C' stands for 'company.'" The underlying application for this registration was filed prior to May 13, 2008, so no description of the mark was required.

blankets and coverlets; woven fabrics made of wool, worsted fabric blends of wool and cotton fabric, silk and wool blend fabrics, cotton knit fabrics and wool knit fabrics; Class 25: clothing for men, women and children; namely, jackets, coats, skirts, trousers, cloaks, mantles; overcoats and knitted vests; scarves, mufflers, shawls and gloves;

Registration No. 1937960 for the mark



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for Class 23: yarns and threads; Class 24: fabrics for use in the manufacture of clothing, nightware and bedding material, namely blankets and coverlets; woven fabrics made of wool, worsted fabric blends of wool and cotton fabric, silk and wool blend fabrics, cotton knit fabrics and wool knit fabrics; Class 25: clothing for men, women and children, namely jackets, coats, skirts, trousers, cloaks, mantles; overcoats and knitted vests; scarves, mufflers, shawls and gloves;

Registration No. 3606230 for the mark LORO PIANA “THE WAVE” (standard characters)⁷ for Class 24: Textiles and textile goods, namely, fabrics for the manufacture of clothing, bed covers, namely, blankets, duvet covers, mattress covers, pillow covers, and fabric table covers, namely, table cloths, napkins and placemats; Class 25: Clothing for men, women and children, namely, jackets, coats, skirts, trousers, cloaks, mantles, overcoats, vests, scarves, mufflers, shawls and gloves; footwear; headwear;

Registration No. 3631604 for the mark LORO PIANA “THE WAVE” (standard characters)⁸ for Class 23: Yarns and threads, for textile use;

Registration No. 3882649 for the mark LORO PIANA ZIBELINE (standard characters)⁹ for Class 24: Fabrics for textile use which have undergone a zibeline finishing; fabrics that have undergone a zibeline finishing that may or may not have printed patterns and designs

⁶ “The name ‘LORO PIAN[A]’ in the mark identifies a living individual whose consent is of record.” The underlying application for this registration was filed prior to May 13, 2008, so no description of the mark was required.

⁷ “The name ‘LORO PIANA’ identifies a living individual whose consent is of record.”

⁸ “The name ‘Loro Piana’ identifies a living individual whose consent is of record.”

⁹ “ZIBELINE” is disclaimed. “The name ‘LORO PIANA’ identifies a living individual whose consent is of record.”

thereon for use in textile applications, namely, the manufacture of apparel, upholstery, and textile fabrics for the manufacture of clothing; textile fabrics that have undergone a zibeline finishing for home and commercial interiors; textile fabrics that have undergone a zibeline finishing for use in making clothing and household furnishings; textile fabrics that have undergone a zibeline finishing for use in the manufacture of garments, bags, jackets, gloves, and apparel; bed and table linen which have undergone a zibeline finishing;

Registration No. 4058142 for the mark LORO PIANA LOTUS FLOWER (standard characters)¹⁰ for Class 24: Textiles and textile goods, namely, fabrics for the manufacture of clothing, bed covers, namely, blankets, duvet covers, mattress covers, pillow covers, and fabric table covers, namely, table cloths, napkins and placemats, all of the aforesaid goods made in part of lotus flower fibers; Class 25: Clothing for men, women and children, namely jackets, coats, skirts, trousers, cloaks, mantles; overcoats and knitted vests; scarves, mufflers, shawls and gloves; footwear; headwear;

Registration No. 4161523 for the mark



for Class 23: Textiles and goods made of textile, namely, table covers, bed covers, plaid blankets, textiles for curtains, textiles for moquettes, baby blankets, textiles for clothing and for interior decorations, all of which are made in whole or substantial part of cashmere; Class 25: Footwear; clothing and headgear, namely, coats, jackets, reefers, cover jackets, polo shirts, crew-neck pullovers, v-neck pullovers, pullovers, rollneck pullovers, bomber jackets, cardigans, gilets, scarves, mufflers, shirts, gloves, dressing gown, cabans, cardigans, blouses, stoles,

¹⁰ “LOTUS FLOWER” is disclaimed. “The name(s), portrait(s), and/or signature(s) shown in the mark identifies a living individual, whose consent(s) to register is made of record.”

¹¹ “BABY CASHMERE” is disclaimed. “The mark consists of the words ‘LORO PIANA’ in stylized script above the words ‘BABY CASHMERE’ in capital letters. To the left of the wording is a stylized coat of arms in which the upper left square contains a picture of a tree, the lower right square contains a picture of an eagle, and the other two squares each contain a five-pointed star. The coat of arms is set above a two-branched spray of holly. Color is not claimed as a feature of the mark.” “The name ‘LORO PIANA’ identifies a living individual whose consent is of record.”

ponchos, mantles, slippers, berets, caps, hats, socks, all of which are made in whole or substantial part of cashmere;

Registration No. 4537242 for the mark LORO PIANA (standard characters)¹² for Class 24: Fabrics for use in the manufacture of clothing;

Registration No. 4489975 for the mark LORO PIANA DENIM FLOWER (standard characters)¹³ for Class 24: Textile fabrics for the manufacture of clothing, namely, shirts, trousers, skirts and jackets and bed covers and table covers all of which are made with a denim structure;

Registration No. 4948617 for the mark LORO PIANA ZENIT (standard characters)¹⁴ for Class 24: Textiles and textile goods, namely, table cloths, plaid bed blankets, textiles for use in making curtains, textiles for use in making moquettes, baby blankets, textile fabrics for making clothing and household furnishings; textile fabrics for use in making clothing and home furnishings; woven and knitted fabrics; non-woven fabrics; fabrics for use as a textile in the manufacture of clothing, bedding, namely, blankets being bed blankets, lap blankets, duvet covers, mattress covers, and pillow covers, fabric table cloths, textile napkins and placemats; bed covers; plastic table covers; travelling throws; curtains of textile; curtains of plastic materials; household linen; cushion covers; bedspreads; bed linen; bed sheets; bath linen; bath towels; hand towels; towels for guests; beach towels; table linen; table napkins of textiles; place mats; handkerchiefs of textile; textile labels; boxes of textile; furnishing fabrics; traced cloth for embroidery; fabrics for use in the manufacture of footwear; textile used as linings for clothing; lingerie fabrics; fabrics for furniture, namely, upholstery; wall hangings of textile; tablecloths; table mats; fabrics for textile use; sofa throws.

When the refusals were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for

¹² “The name(s), portrait(s), and/or signature(s) shown in the mark identifies ‘LORO PIANA,’ whose consent(s) to register is made of record.”

¹³ “DENIM FLOWER” is disclaimed. “The name(s), portrait(s), and/or signature(s) shown in the mark identifies ‘LORO PIANA,’ whose consent(s) to register is made of record.”

¹⁴ “The English translation of ‘ZENIT’ in the mark is ‘ZENITH.’” “The name(s), portrait(s), and/or signature(s) shown in the mark identifies Pier Luigi Loro Piana, whose consent(s) to register is made of record.”

reconsideration, the appeal was resumed and Applicant as well as the Examining Attorney filed briefs.¹⁵ An oral hearing was held at which Applicant's counsel and the Examining Attorney appeared.

We reverse the refusal to register.

I. Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Two key factors in every § 2(d) case are the similarity or dissimilarity of the marks, and the goods or services, because 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.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We confine our analysis to the following standard character marks:

Registration No. 1282535 for the mark LORO PIANA (typed) for Class 24: coverlets, gloves, mufflers, plaids, shawls and other woolen goods;

¹⁵ It was unnecessary for Applicant to attach as exhibits to its brief evidence already submitted during prosecution. *In re Allegiance Staffing*, 115 USPQ2d 1319, 1323 (TTAB 2015) (practice of attaching to appeal brief copies of the same exhibits submitted with responses is discouraged); *In re SL&E Training Stable Inc.*, 88 USPQ2d 1216, 1220 n.9 (TTAB 2008) (attaching exhibits to brief of material already of record only adds to the bulk of the file, and requires Board to determine whether attachments had been properly made of record).

Registration No. 1337982 for the mark LORO PIANA (typed) for Class 23: Yarns and Threads; Class 24: Bed Covers, Blankets; Class 25: Clothing for Men, Women and Children namely, Jackets, Coats, Skirts, Trousers, Cloaks, Mantles, Overcoats and Knitted Vests; Scarves, Mufflers, Shawls and Gloves;

Registration No. 4537242 LORO PIANA (standard characters) for Class 24: Fabrics for use in the manufacture of clothing.

If we do not find a likelihood of confusion with these registered marks and their associated goods, then there would be no likelihood of confusion with the marks in the other cited registrations. *See In re Max Capital Grp.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Similarity or dissimilarity of the marks

Under the first *DuPont* factor, we consider “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)). The test, under this *DuPont* factor, 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 terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs., Inc. v.*

Triumph Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

Applicant's mark is PIANA HYDRO and the Registrant's mark is LORO PIANA. Although the marks share the term PIANA they are clearly different by virtue of the additional terms "HYDRO" and "LORO," and by the first versus second position of the term PIANA in each mark, such that the marks, when taken as a whole, convey different overall impressions. We thus find the marks more dissimilar than similar. This *DuPont* factor weighs in Applicant's favor.

B. Similarity or Dissimilarity of the Goods and Trade Channels

The second *DuPont* factor "considers '[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.'" *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). It is not necessary that the goods be identical or even competitive to support a finding of a likelihood of confusion. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). Likelihood of confusion can be found if the respective goods "are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source." *Id.* (quoting *7-Eleven*, 83 USPQ2d at 1724).

Registrant's goods are "coverlets, gloves, mufflers, plaids, shawls and other woolen goods" (Registration No. 1282535); and "Fabrics for use in the manufacture of

clothing” (Registration No. 4537242); and “Yarns and Threads;” (Registration No. 1337982); and “Bed Covers, Blankets; and Clothing for Men, Women and Children namely, Jackets, Coats, Skirts, Trousers, Cloaks, Mantles, Overcoats and Knitted Vests; Scarves, Mufflers, Shawls and Gloves” (Registration No. 1337982). Applicant’s goods are “Textile fibers, namely, fibers treated with hydrophobic chemicals providing water repellency.”

The Examining Attorney submitted evidence of webpages from seven businesses, offering fibers, and/or textiles and/or finished goods.

Jeffcofibres.com offers “the widest range of specialized and technical textile fibers in North America.” Jeffco also offers sleep products and foam and fiber-based mattresses, pillows, toppers and foundations.¹⁶

Paradies.com offers duvets with “microfiber filling,” “fibre filling,” and “textile fibre filling.”¹⁷

Tencel.com offers cellulosic fibers of botanic origin. The webpages discuss Tencel’s properties and advantages, indicating the types of products that use the fiber.¹⁸

Martexfiber.com recycles post-industrial and post-consumer textile waste. Martex offers cuttings, wipers, remnants, thread waste, fiber waste, and textile byproducts. Martex also offers recycled cotton and recycled textiles “whether you are manufacturing paper, insulation, vulcanized fiber or any other cellulosic application.”¹⁹

Leigh fibers.com is a textile recycler and offers reprocessed textile waste and byproducts, including natural fibers, technical fibers, shoddy, recycled carpet and plastics.²⁰

¹⁶ May 17, 2018 Office Action at TSDR 41 and 42.

¹⁷ May 17, 2018 Office action at 45-46.

¹⁸ May 17, 2018 Office action at TSDR 43-44.

¹⁹ December 18, 2018 Office Action at TSDR 2-3.

²⁰ December 18, 2018 Office Action at TSDR 4.

Orangefiber.it produces fabrics from a silk-like cellulose yarn, and citrus textile from citrus juice byproducts. It indicates that Salvatore Ferragamo offers various finished products using its orange fiber textiles.²¹

Schotttextiles.com offers fabrics in their natural finished state, fabrics made of synthetic fibers, fabrics that are dyed, bleached or printed, and customized fabrics developed for the customer.²²

The Examining Attorney asserts in her brief that the website evidence demonstrates that Applicant's goods and the Registrant's goods are provided by the same entity and marketed under the same mark and travel through the same trade channels.²³ The Examining Attorney also asserts that the "goods are related because textile fibers and textile fabrics are goods that are often provided together and marketed under the same mark."²⁴

However, upon review of this evidence, we do not find the website evidence submitted by the Examining Attorney particularly probative. Most of these website webpages are unclear as to the exact nature of the goods offered.

The Schott Textile and Orange Fiber websites relate solely to textile fabrics, and not textile fibers. The Paradies website appears to be offering only bedding products such as duvets with various fiber fillings (a product made up of fibers) and not the raw fiber itself, while the Tencel website appears to be informational, promoting the use of the Tencel fiber in a variety of applications including clothing and bedding

²¹ December 18, 2018 Office Action at TSDR 5-6.

²² *Id.* at 7.

²³ Examining Attorney's Brief, 10 TTABVUE 10.

²⁴ *Id.*

products, but not offering finished products itself. The website does not indicate that Tencel fiber is treated to be hydrophobic. Although the Jeffco Fibers website indicates that it offers textile fibers and fiber based mattresses and sleep products (mattress toppers and foundations) made from a fiber-fill, as well as foam fabrication, these are not goods that Registrant offers. In addition, the Examining Attorney has not shown that chemically treated hydrophobic fibers are used in fiber-based mattresses and sleep products.

Perhaps the most relevant evidence is from the websites of Martex Fiber and Leigh Fibers showing that these companies offer recycled fibers and textiles from the recycled fibers. The Martex Fiber website indicates it offers recycled cotton textiles. The Leigh Fibers website offers recycled carpet and plastics, which are not goods Registrant offers.

Leigh Fibers offers shoddy,²⁵ which is a low quality textile created from recycled fibers, but it is not clear that shoddy is used in connection with clothing goods and bedding products or is a textile of a similar type to those offered by Registrant for various applications. Leigh Fibers also offers “technical fibers” but the nature of these fibers is unclear.

²⁵ Shoddy is defined as b: a fabric often of inferior quality manufactured wholly or partly from reclaimed wool. Merriam-Webster Dictionary, <https://www.merriam-webster.com/dictionary/shoddy> (accessed March 4, 2020). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (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. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

Although the Examining Attorney argues that the evidence shows entities provide textile fibers for a wide variety of purposes and Registrant's yarns and threads could be made up of hydrophobic fibers,²⁶ none of the evidence shows that a company providing fibers also provides yarns and threads, or that they offer fibers with hydrophobic properties. Neither the Martex Fiber website nor the Leigh Fibers website shows that either company specifically offers recycled fibers treated for hydrophobic properties nor finished textiles that are made with recycled fibers chemically treated for hydrophobic properties, and the website pages do not indicate they offer yarns or threads from the recycled fiber.

We therefore are unable to conclude, based on this evidence, that these companies offer the specific products identified by Applicant's application and Registrant's registrations, or that they offer them under a single mark. Therefore, we find that the record does not support that the goods are related, and weighs against a finding of likelihood of confusion under the second *DuPont* factor.

For the reasons discussed, the website evidence also is of limited probative value for purposes of showing that the channels of trade for Applicant's and Registrant's goods are related. The record simply does not support a finding that consumers are accustomed to encountering Applicant's and Registrant's identified goods in the same or overlapping trade channels. Accordingly, the third *DuPont* factor also weighs against a finding of likelihood of confusion.

²⁶ Examining Attorney's brief, 10 TTABVUE 12.

C. Conditions of Sale

Applicant argues that consumers of Applicant's goods are sophisticated purchasers who exercise heightened care in their purchasing decisions which makes confusion unlikely. Applicant's witness testified by way of Declaration that Applicant's goods are "specialized fibers sold only to manufacturers of yarn or non-woven textiles" and professional buyers make these purchases.²⁷ We agree that purchasers of raw material, such as hydrophobic textile fibers, would be sophisticated purchasers and exercise care in their purchase as they must determine whether the fibers purchased are appropriate for the intended application. Accordingly, we conclude that the sophistication of the potential purchasers favors a finding of no likelihood of confusion.

D. Fame

Applicant has argued that Registrant's marks are not famous. However, the purported lack of fame of Registrant's marks, as argued by Applicant, is of little consequence. *See In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006). In an ex parte appeal, the owner of the cited registration is not a party, and the Examining Attorney is under no obligation to demonstrate exposure to or recognition of the cited mark in the marketplace. *In re Integrated Embedded*, 120 USPQ2d 1504, 1512 (TTAB 2016). For that reason, "in an ex parte analysis of the *DuPont* factors for determining likelihood of confusion ..., the 'fame of the mark' [fifth] factor is normally treated as

²⁷ Second Declaration of Sanghoon Lim, Research and Development Director of Tintoria Piana U.S., Inc., June 14, 2019 Request for Reconsideration at TSDR 2-3.

neutral when no evidence as to fame has been provided.” TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1207.01(d)(ix) (Oct. 2018). Thus, because there is no evidence of record regarding the fame of the cited mark, the fifth *DuPont* factor is neutral.

II. Conclusion

Because the first, second, third and fourth *DuPont* factors weigh in Applicant’s favor, we find confusion is unlikely. We find Applicant’s mark and the cited, registered marks are more dissimilar than similar. The respective goods of Applicant and the Registrant are not related, and the channels of trade do not overlap. The potential purchasers of the respective goods are sophisticated, lessening the likelihood of confusion. We treat the other likelihood of confusion factors as neutral.

Decision: The refusal to register Applicant’s mark PIANA HYDRO on grounds of a likelihood of confusion is reversed.