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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Emilio Pucci Int. B.V.

v.

El Corte Ingles, S.A.

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Opposition No. 91169638

Opposition No. 91177724

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Linda K. McLeod and Naresh Kilaru of Finnegan, Henderson,  
Farabow, Garrett & Dunner, LLP, for opposer.

Michael J. Striker, Esq. for applicant.

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**Before Holtzman, Walsh, and Mermelstein, Administrative  
Trademark Judges.**

**Opinion by Mermelstein, Administrative Trademark Judge:**

This consolidated proceeding concerns two applications  
to register stylized marks comprising the words EMIDIO  
TUCCI.

- Application No. 76624740<sup>1</sup> for the following mark:



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<sup>1</sup> Filed December 15, 2004, pursuant to Trademark Act § 44(e),  
based on Spanish Reg. Nos. 1908876, 1908876, and 0855782, and  
alleging a *bona fide* intent to use the mark in commerce. Both

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for "perfumery, namely, perfume, toilet water, scented water, cologne, essential oils for personal use; cosmetics, namely, body, face and skin moisturizing creams and skin lotions," in International Class 3; and "clothing, namely, hats, belts, stockings, socks and shoes," in International Class 25.

- Application No. 76624741<sup>2</sup> for the following mark:

*Emidio Tucci*

for "leather handbags, imitation leather sold in bulk; trunks for traveling; suitcases, billfolds, wallets, briefcases, umbrellas, parasols, walking sticks, whips and harness," in International Class 18.

Opposer, Emilio Pucci Int. B.V., filed an opposition to registration alleging (1) priority and a likelihood of confusion with opposer's previously used and registered marks, pursuant to Trademark Act § 2(d); 15 U.S.C. § 1052(d); and (2) dilution pursuant to Trademark Act § 43(c); 15 U.S.C. § 1125(c).

By its answer, applicant denied the salient allegations of the notices of opposition, and asserted as affirmative defenses that its applications would be registrable if

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subject applications include a statement that EMIDIO TUCCI "is the name of a deceased individual."

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limited "to those products intended to be used by men only," Answer ¶ 16, and that the oppositions are barred by laches and estoppel.<sup>3</sup>


We sustain the opposition.

**I. Record**

**A. Evidence**

Opposer proffered the following evidence during its assigned trial periods:

- Testimony of Timothy S. Crout, Retail Director, Emilio Pucci, Ltd., and accompanying exhibits;
- Opposer's First Notice of Reliance on the following four trademark registrations:

Mark	Goods	Reg. No.	Filing Date
EMILIO PUCCI	• Ladies' tailored apparel; namely, dresses, scarves, lingerie, hats, bathing suits, skirts, blouses, slacks. IC 25	1687909	10/26/1977
EMILIO PUCCI	• Leather goods; namely, ladies' handbags, tote bags, wallets. IC 18	1689743	10/26/1977
	• Footwear. IC 25	3029721	01/07/2003
EMILIO PUCCI	• Perfumes and lotions. IC 3 • Eyeglasses and eyeglass cases. IC 9 • Jewelry and items made of precious metal, namely, necklaces, bracelets. IC 14	3382298	01/07/2003

- Opposer's Second Notice of Reliance on applicant's responses to certain interrogatories;
- Opposer's Third Notice of Reliance on sample advertisements featuring the EMILIO PUCCI mark;

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<sup>2</sup> Filed December 15, 2004, pursuant to Trademark Act § 44(e), based on Spanish Reg. No. 2027132, and alleging a *bona fide* intent to use the mark in commerce.

<sup>3</sup> The defenses of laches and estoppel were neither tried nor briefed, and we therefore consider them to be waived. See *Liberty & Co., Ltd. v. Liberty Trouser Co., Inc.*, 216 USPQ 66, n.9 (TTAB 1982).

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- Opposer's Fourth Notice of Reliance on printed publications;
- Opposer's Fifth Notice of Reliance on excerpts from a book titled Emilio Pucci; and
- Opposer's Rebuttal Notice of Reliance on applicant's response to one interrogatory.

During its assigned trial period, applicant proffered the following evidence:

- Testimony of Deanna Littell, and accompanying exhibits;
- Testimony of Olga Fuchs, and accompanying exhibits;
- Applicant's First Notice of Reliance on a *New York Post* article;
- Applicant's Second Notice of Reliance on a page of Google search results; and
- Applicant's Third Notice of Reliance on a Wikipedia entry for the term "El Corte Ingles."

#### **B. Evidentiary Objections**

Opposer raised numerous objections during the testimony of applicant's witnesses, Ms. Fuchs and Ms. Littell.

Following the introduction of the transcripts, opposer filed motions to strike the testimony of both witnesses. Ruling on the motions was deferred until final decision. In addition to its motion to strike, opposer objected in its brief and moved to strike all three of applicant's notices of reliance.

#### **1. Applicant's Testimony**

Applicant's witness, Olga Fuchs, identified herself as

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an office manager in the law firm of applicant's counsel. Fuchs Test. at 16. In connection with this proceeding, she visited three stores selling goods branded with opposer's EMILIO PUCCI marks, two stores run by opposer, and a Bergdorf Goodman department store. *Id.* at 4. Ms. Fuchs testified that goods branded with opposer's marks were "very expensive," *id.* at 9, 13, that opposer's stores were in the same general area as other "high-end stores," *id.* at 5, and that the only men's items she found in the stores were neckties, *id.* at 6, 10.

Opposer objects to all of Ms. Fuchs' testimony as irrelevant under Fed. R. Evid. 402. Applicant argues that the testimony is relevant as it "relates to the type of product sold by the Opposer; where the products are sold, and the prices of the products offered for sale." App. Br. at 8. We largely agree with opposer.

In considering whether confusion is likely between the mark in an application and that in a prior registration, it is well-settled that we are limited to consideration of the marks vis-à-vis the goods and services set out in the application and registration, without importing any extraneous limitations:

[W]here the goods in a cited registration are broadly described and there are no limitations in the identification of goods as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration

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encompasses all goods of the nature and type described, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers.

*In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139 (CCPA 1958).

Here, the goods in opposer's registrations are not limited to expensive items or to goods sold only in "high-end" stores or to wealthy customers. Moreover (with the exception of the goods in opposer's 1687909 Registration, and "ladies' handbags" in the 1689743 Registration), the goods in opposer's registrations are not limited to those intended only for women. On the contrary, we must consider the goods covered by opposer's registrations to include both expensive and inexpensive goods, sold in all channels of trade customary for such items, and - unless otherwise limited - sold for use by both men and women. Ms. Fuchs' testimony (and that of Ms. Littell) alleging that that the goods covered by opposer's registrations are more limited in reality cannot alter the required construction of the scope of opposer's registrations, and is indeed irrelevant.

Nonetheless, we note that opposer presented evidence of use of its marks on several goods not covered by its registrations. See *infra*. The authorities cited above requiring broad construction of goods or services recited in a registration do not apply to common-law rights which are

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alleged to bar registration. Instead, we consider what goods opposer actually uses its marks on, and the associated channels of trade and classes of consumers. See, e.g., *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1023 (TTAB 2009) (where petitioner did not own a registration, he "must show that he made common-law use of his ... mark in connection with his alleged services"). To the extent Ms. Fuchs' (and Ms. Littell's) testimony sheds light on any of opposer's goods, channels of trade, and classes of consumers not covered by opposer's registrations, it is not irrelevant, and we will consider it accordingly.

Through Ms. Fuchs' testimony, applicant also identified and introduced applicant's exhibits 4 and 5, pages from the EMIDIO TUCCI and El Corte Ingles websites, respectively. Opposer moved to strike the latter exhibit as irrelevant, because applicant's goods are not sold in the United States. See Opp. Rebuttal Not. of Reliance (applicant's objection to opposer's interrogatory regarding use on the ground that "Applicant does not currently sell its products in the United States."). Applicant does not respond to opposer's motion to strike this exhibit or otherwise explain the relevance of it. As opposer notes, this Spanish-language web page does not reflect use of applicant's mark in the United States. But more importantly, just as the goods in opposer's registrations must be considered based on the

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broad identification, the same is true of the goods identified in the subject applications. *E.g.*, *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1646 (TTAB 2008). To the extent that applicant seeks by this evidence to narrow our consideration of its identified goods to those sold at particular price points, in particular channels of trade or to particular consumers, we cannot consider it for that purpose. Because this evidence was properly introduced, we deny opposer's motion to strike, although we find that the evidence is entitled to little or no weight.

It appears that applicant's other witness, Deanna Littell, was presented as both an expert witness and as a fact witness. Like Ms. Fuchs, Ms. Littell visited two of opposer's stores in New York City, and Barney's New York, which sells opposer's goods. Like Ms. Fuchs, Ms. Littell testified as to what she saw as the high price of opposer's branded products she found. *E.g.* Littell Test. at 25. Applicant also offered Ms. Littell's testimony as an expert on the nature of opposer's goods (particularly the distinctive patterns often used on opposer's clothing), *id.* at 33-35, and on the purported absence of any confusion between opposer's marks and a third party's GUCCI marks which are alleged to be used in the same market, *id.* at 35-36. Ms. Littell also testified that EMILIO PUCCI is "very" well-known and a "famous" brand. *Id.* at 75. Opposer moves



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to strike Ms. Littell's testimony, arguing that she does not qualify as an expert, and that her testimony is irrelevant.

In response, applicant argues that Ms. Littell's qualifications "are imposing and surely qualify her as an expert in the field of fashion." App. Br. at 5

Ms. Littell testified that she is an expert in consumer behavior. Littell Test. at 45. We agree with opposer, however, that Ms. Littell's testimony did not establish that she is an expert in that field. She testified that she does not have an educational background in consumer behavior, *id.* at 54-55, that she does not read scholarly journals in the field, *id.* at 49, or attend conferences with academics in the field, *id.* at 50. Her *curriculum vitae* does not indicate that she has published any books or articles in the field of consumer behavior (or on any other topic), or presented lectures in the field. Littell Test. exh. 3.

To be sure, consumer behavior is certainly part of the fashion world in which Ms. Littell has spent a long and impressive career. But qualifying as an expert in consumer behavior requires more than the inference of general knowledge by long practice in the related fields of apparel design and retail sales. A witness presented as an expert must demonstrate on the record that she is qualified to offer opinion testimony "by knowledge, skill, experience, training, or education...." Fed. R. Evid. 702. Here, the

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record indicates that Ms. Littell has no specific training or education in the field of consumer behavior. While she has spent many years in the apparel industry, that experience and training appears to have been focused on apparel design and prediction of fashion trends, rather than the observation and analysis of consumer behavior. Finally, she has exhibited no professional skill in the field, having no publications or presentations on the subject to her credit, nor has she been qualified to testify as an expert in other cases.

On the other hand, the record does detail Ms. Littell's work in the fashion industry spanning more than forty years at a number of firms on two continents. She appears to be well-aware of the various design houses in the apparel market, and knowledgeable as to their impact in that market. Thus, while she does not qualify as an expert in consumer behavior, we cannot so easily dismiss her testimony as to opposer's reputation in the industry. As noted above, she testified that EMILIO PUCCI is "a very famous brand." Littell Test. at 43, 75. At least to that extent, her testimony appears to be both reliable and directly relevant to the question of likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (Fed. Cir. 1973) (fame of prior mark). Although it does not appear that Ms. Littell has any scientific foundation for

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her testimony (e.g., a trademark survey), we will consider her testimony as that of an experienced individual in the field of apparel, and accord it appropriate probative value.

In any event, whether Ms. Littell is qualified as an expert or not, we find most of her testimony to be of little relevance. Applicant largely introduces Ms. Littell's testimony in an attempt to narrow our consideration of opposer's goods to expensive items, sold in exclusive stores, to discriminating clientele. At least to the extent it relates to the goods in opposer's registrations, it is irrelevant for the reasons discussed in connection with Ms. Fuchs' testimony. Likewise, Ms. Littell's testimony regarding the "distinctive" fabric designs actually used on opposer's goods appears to have little or no relevance. Opposer's registrations are not limited to goods featuring any particular print, and must be construed to include those bearing any fabric design or no design at all.<sup>4</sup>

Lastly, Ms. Littell was asked on direct examination:

Q. In your career including to date, have you ever heard of any instance of any confusion between the trademarks Gucci and Pucci?

A. Never.

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<sup>4</sup> We therefore find it unnecessary to determine whether Ms. Littell is qualified as an expert in the design of prints. See Littell Test. at 44.

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Littell Test. at 36. Opposer objected on the basis of relevance and lack of foundation, and renews those objections in its motion to strike.

We again agree with opposer that this testimony has very limited, if any, relevance, and no foundation. The central issue in this case is whether there is a likelihood of confusion between the marks in the subject applications and opposer's registered and previously used marks, not whether there is actual confusion between opposer's marks and those of a third party. *Cf. AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403; 177 USPQ 268, 269 (CCPA 1973) (even the registration of other, arguably confusing marks does not give applicant the right to register another confusing mark). While "[t]he number and nature of similar marks in use on similar goods" is a factor to be considered, *see du Pont*, 177 USPQ at 567, there is absolutely no evidence in this record as to what GUCCI marks are in use, for what goods, or the length and extent of any such use. Moreover, the testimony quoted has little relevance because Ms. Littell was asked about confusion between "Gucci" and "Pucci." The marks asserted by opposer comprise the wording EMILIO PUCCI, not "Pucci." In short, even if we considered this testimony at face value, the absence of any actual confusion between GUCCI and PUCCI sheds no light on whether

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there is a likelihood of confusion between EMILIO PUCCI and EMIDIO TUCCI.

Accordingly, while we deny opposer's motion to strike Ms. Littell's testimony in its entirety, we give most of it little or no weight.

## **2. Applicant's Notices of Reliance**

Opposer further moves to strike all three of applicant's notices of reliance. Opp. Br. at 4-7. In its brief, "Applicant concedes that [its second and third notices of reliance] should not be considered." App. Br. at 4. We accordingly grant opposer's motion to strike them.

By its first notice of reliance, applicant seeks to introduce an article from the New York Post newspaper. According to applicant, "[t]he article is relevant because it represents a [sic] instance of a major publication in which Pucci is referred to among a group of high end expensive products which are generally purchased by the very wealthy for purposes including snob appeal." App. First Not. of Rel. For the reasons discussed above, this article cannot be used to narrow the scope of the goods, potential purchasers, or channels of trade in opposer's registrations. Nonetheless, similar to the publications introduced with opposer's fourth notice of reliance, the New York Post article does demonstrate wide exposure of the public to

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opposer's brand.<sup>5</sup> Because it is not irrelevant, we will consider this evidence to the extent indicated.

**C. Opposer's Registrations**

As noted, opposer introduced evidence of four registrations under a notice of reliance. Three of the registrations were pleaded in the notice of opposition. The fourth registration, No. 1689743, was not pleaded as a basis for the opposition. None of the registrations was evidenced by "a copy ... of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration." Trademark Rule 2.122(d)(2). We further note that this proceeding commenced prior to August 31, 2007, the effective date of the amendment to Trademark Rule 2.122 permitting introduction of such evidence by way of printouts from the USPTO's public electronic databases. *See generally, Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009).

However, applicant raised no objection to the admission

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<sup>5</sup> As alluded to by applicant, the author of the article appears to take a somewhat dim view of opposer's customers. But as applicant recognizes, App. Br. at 9, the article is not admissible for the truth of the matters asserted therein. *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.2 (TTAB 2007). Regardless of the author's opinion, evidence of the renown of the prior user's mark is relevant because the more well-known the mark, the more likely it is that consumers will be confused by similar marks used in connection with related goods. *See* discussion of fame *infra*. The salient issue is how well-known

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of opposer's registrations to "show ... that opposer ... owns valid and subsisting prior registrations for the ... marks, which are confusingly similar to the EMIDIO TUCCI mark in the opposed application, and which cover goods that are identical and closely related to the goods identified in the opposed application." Opp. First Not. of Rel. at 2. The registrations were also discussed in opposer's opening brief without comment by applicant. We accordingly find that the issue of likelihood of confusion with respect to the '743 Registration was tried by implied consent, and that any objection to the admissibility of opposer's evidence of all four registrations under a notice of reliance was waived. Fed. R. Civ. P. 15(b)(2); *Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650, 1653 n.2 (TTAB 2002).

## **II. Discussion**

### **A. Standing and Priority**

"Applicant concedes that Opposer has priority of use and that it is the owner of the pleaded registrations." App. Br. at 3. Opposer's registrations clearly establish opposer's standing to oppose registration of applicant's marks. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

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the prior mark is, not whether opinions of the product, its source, or its consumers are favorable or unfavorable.

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Moreover, because opposer's pleaded registrations are of record, priority is not an issue with respect to the goods set out therein. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition to its pleaded registrations, opposer also submitted evidence of its prior use of the EMILIO PUCCI mark on goods not covered by its registrations, including aftershave, men's and women's hats, stockings, satchels and mail bags for men, travel bags, briefcases, and umbrellas. *See generally*, Crout Test. at 17-50, exh. 3-4, 6-9; *see Otto Roth & Co. v. Univ. Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). We further find opposer's common-law marks to be distinctive. *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1830 (TTAB 2010), *appeal docketed*, No. 09-10488 (S.D.N.Y. Dec. 28, 2009) (unregistered personal name mark pleaded by opposer deemed inherently distinctive).

Accordingly, we find that opposer has priority with respect to the goods recited in its registrations of record and various other goods on which it uses its mark.

**B. Likelihood of Confusion**

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See du Pont*, 177 USPQ 563; *see also Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En*



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1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 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); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

**1. The Fame of the Prior Mark - Sales, Advertising, Length of Use**

We begin our likelihood of confusion analysis with the fifth *du Pont* factor, which requires us to consider evidence of the fame of opposer's marks. Fame, when established, is entitled to great weight in a likelihood of confusion analysis. See *Bose Corp. v. QSC Audio Prod. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the DuPont factors," *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1456, and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more

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likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.*

*Bose Corp.*, 63 USPQ2d at 1305.

Mr. Crout testified that opposer's business was founded by Emilio Pucci in Italy in 1947, and that it has been using the EMILIO PUCCI trademarks since at least the 1950's.

Crout Test. at 90-91. Opposer's marks were used in the United States as early as 1962, see Opp. Third Not. of Rel., *Charleston Sunday Gazette-Mail* (Jul. 8, 1962), and it

appears clear that at least by the late 1960's, EMILIO PUCCI was a well-established brand in this country. Celebrities who were known to wear EMILIO PUCCI apparel include Marilyn Monroe, Jackie Kennedy, Isabella Rossellini, Madonna, Nicole Kidman, Jennifer Lopez, Kylie Minogue, and Elizabeth Hurley.

*Id.* at 89. Mr. Pucci was also known for having designed uniforms for Braniff Airlines, the mission patch for NASA's Apollo 15 mission to the moon, the interior of the Lincoln Continental automobile, and some furniture. *Id.* at 91-92.

EMILIO PUCCI branded products are currently sold in the United States through several channels: directly to the public in company-owned retail stores, via wholesale sales by opposer to department stores such as Neiman Marcus, Saks,

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Bergdorf Goodman, and Barneys New York, sales directly to the public by licensees, *id.* at 11-17, and direct sales via the Internet, *id.* at 53-54.

The record further evidences opposer's promotional efforts in the United States spanning the past 48 years, including a number of representative print advertisements in publications of general circulation, Opp. Third Not. of Rel., catalogues, Crout Test. exh. 15-16 direct mail, *id.* at 61, 75, 79, exh. 16, and shopping center guides, *id.* at 61. Opposer also conducts "events," such as large shows, dinners and brunches to promote its products and brand. *Id.* at 68, 83. Opposer also submitted extensive evidence of its unsolicited mention in U.S. publications. Opp. Fourth Not. of Rel. Such publications include newspapers and magazines of general circulation, as well as fashion-oriented periodicals, such as *Women's Wear Daily*.

Opposer submitted evidence<sup>6</sup> of its retail and wholesale sales under the mark for calendar years 2003 - 2007 (YTD). Crout Test. exh. 3, 8. While opposer's sales figures are not as large as some we have found to be famous, they are nonetheless quite substantial, indicating significant sales in the United States. Similarly, opposer itself spends a significant amount on advertising in the United States,

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<sup>6</sup> Because evidence of opposer's sales and advertising expenditures were submitted under seal, we refer to them only in general terms.

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independent of any promotional efforts by its department store customers and licensees.

Finally, as discussed above, applicant's own witness testified on the basis of her many years in the apparel industry that opposer's EMILIO PUCCI brand is "very" well-known and is "famous." While Ms. Littell's opinion on opposer's fame is not necessarily dispositive,<sup>7</sup> we give it significant weight, particularly in light of the other evidence of the renown of opposer's marks.

Applicant, noting the "expensive" items its witnesses found in opposer's stores, argues that "the alleged fame of the Emilio Pucci product is directed to a small group of upper crust super rich people (generally sophisticated purchasers). There is no testimony that would support any knowledge of the Emilio Pucci product by the average Joe on the Street." App. Br. at 14. We disagree.

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<sup>7</sup> Although it is not entirely clear, applicant may have elicited this testimony in the belief that opposer's fame is a factor which diminishes any likelihood of confusion (*i.e.*, because opposer's brand is so well-known that purchasers would easily distinguish it from others). This argument has been squarely rejected by the Court of Appeals for the Federal Circuit:

While scholars might debate as a factual proposition whether fame heightens or dulls the public's awareness of variances in marks, the legal proposition is beyond debate. The driving designs and origins of the Lanham Act demand the standard consistently applied by this court - namely, more protection against confusion for famous marks.

*Kenner Parker Toys*, 22 USPQ2d at 1456. In other words, as a matter of law, no mark is too famous to be confused. To the contrary, the more well-known the prior user's mark, the easier it will be to find a likelihood of confusion in the balancing of the *du Pont* factors.

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Contrary to applicant's argument, opposer's evidence of long use, advertising, and extensive mention in the general press makes it clear that "the average Joe on the street" has indeed been exposed to opposer's brand. Moreover, applicant's premise, that the cost of opposer's goods limits its fame to those who can afford them, App. Br. at 13, is faulty. By way of analogy, it could hardly be denied that ROLLS-ROYCE is a very well-known brand of automobile, although only a small fraction of the population can actually afford to purchase one. Likewise, even if it were shown that the cost of opposer's goods places them out of the reach of the ordinary consumer, that fact alone does not mean that opposer's marks can not enjoy significant fame or renown for trademark purposes. In reality, a brand's renown may easily exceed the group of consumers who are immediately able and willing to purchase the goods. The Trademark Act protects marks even in this larger group because both consumer confusion and harm to business reputation can result from the sale of cheaper goods under a similar mark, and because socioeconomic classes are not static.

Based on the record in this proceeding (including the testimony of applicant's witness), we conclude that opposer's mark enjoys (at least) substantial renown with respect to apparel and accessories. And although applicant

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argues that such fame is limited to "upper crust super rich people," opposer's evidence of mainstream advertising and unsolicited mainstream media attention clearly demonstrates otherwise.

This factor favors a finding of likelihood of confusion.

## 2. The Similarity or Dissimilarity and Nature of the Goods

As argued by opposer, Opp. Br. at 30-31, many of the parties' goods are identical or very closely related. A comparison of applicant's identified goods with opposer's most similar goods in tabular form is useful:<sup>8</sup>

App. No.	Applicant's Goods	Opposer's Goods	Reg. No. / Testimony
76624740	Perfumery, namely, perfume, toilet water, scented water, cologne	Perfumes	3382298
76624740	Essential oils for personal use; cosmetics, namely, body, face and skin moisturizing creams and skin lotions	Lotions <i>Aftershave</i>	3382298 <i>Crout Test. at 31</i>
76624740	Clothing, namely, hats	Ladies' tailored apparel; namely ... hats. <i>Hats (men's and women's)</i>	1687909 <i>Crout Test. at 21-22, exh. 3</i>
76624740	Belts	<i>Belts</i>	<i>Crout Test. at 23-24</i>
76624740	Stockings, socks	Ladies' tailored apparel; namely ... lingerie <i>Stockings</i>	1687909 <i>Crout Test. at 22-23</i>
76624740	Shoes	Footwear	3029721
76624741	Leather handbags	Ladies' handbags <i>Satchels, mail bags for men</i>	1689743 <i>Crout Test. at 24-25, exh. 3</i>
76624741	Imitation leather sold in bulk	---	---

<sup>8</sup> Opposer's evidence indicates use of its mark on a number of goods, many of which are also covered by its registrations. Where evidence indicates that particular goods are covered by both use and a registration, for the sake of brevity, only the registration has been noted. (Goods in use are noted in *italics*; goods in opposer's registrations are in Roman type.)

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App. No.	Applicant's Goods	Opposer's Goods	Reg. No. / Testimony
76624741	Trunks for traveling; suitcases	Travel bags ("either rolling or duffel-size")	Crout Test. at 29
76624741	Billfolds, wallets	Wallets	1689743
76624741	Briefcases	Briefcases	Crout Test. at 28-29, exh. 3
76624741	Umbrellas, parasols	Umbrellas	Crout Test. at 23, exh. 3
76624741	Walking sticks, whips and harness	---	---

Although applicant contends that "any overlap in goods is extremely limited to hats and shoes," App. Br. at 10, it is quite clear that in fact most of applicant's goods are identical to goods covered by opposer's registrations or use under the mark. Indeed, only applicant's identified "essential oils for personal use," "imitation leather sold in bulk," and "walking sticks, whips, and harness[es]" are not matched by a legally identical or very closely related item of opposer's. And as to those items, the fact that some of the goods may not be related is irrelevant. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application).

We find that applicant's goods are largely identical or very closely related to opposer's. This factor favors a finding of a likelihood of confusion.

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**3. Trade Channels and Classes of Consumers;  
Sophistication of Consumers**

[W]here the goods in a cited registration are broadly described and there are no limitations in the identification of goods as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers.

*In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139 (CCPA 1958).

Further, to the extent that opposer's goods are legally identical to those in the subject application, we must likewise assume that the purchasers and channels of trade are also identical for such goods. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

Applicant suggests that opposers' customers "are sophisticated purchasers who will exercise a high degree of care in any purchase." App. Br. at 10. Applicant's argument appears to be based largely on its contention that opposer's goods are extremely expensive. But as noted above, the goods in opposer's registrations are ordinary items of apparel and accessories, and are not limited -



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either explicitly or by their nature - to particularly expensive items. We must therefore construe them to include all such items, sold to all of the usual purchasers for them, regardless of the actual retail price of opposer's goods.

In the case of apparel and related accessories, the class of potential consumers is particularly large, essentially including all adults. There is no evidence in this record to suggest that this group is particularly sophisticated or that they exercise unusual care in decisions to purchase the type of goods at issue here.<sup>9</sup>

Moreover, to the extent that the price of opposer's goods is cognizable (*i.e.*, as to goods not covered by opposer's registrations), the mere fact that goods are expensive does not mean that their purchasers are sophisticated or immune from source confusion. See *In re Wilson*, 57 USPQ2d 1863, 1865-66 (TTAB 2001) (where marks are very similar and goods related, confusion may be likely even among sophisticated purchasers); *In re Decombe*, 9 USPQ2d 1812, 1814-1815 (TTAB 1988) ("Being knowledgeable and/or

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<sup>9</sup> The cases cited by applicant for the contrary proposition, *Sally Gee, Inc. v. Myra Hogan, Inc.*, 699 F.2d 621, 217 USPQ 658 (2d Cir. 1983); *A&H Sportswear Co. v. Victoria's Secret Stores, Inc.*, 57 F. Supp. 2d 155; 52 USPQ2d 1143 (E.D. Pa. 1999); *Jordache Enter. Inc. v. Hogg Wyld, Ltd.*, 625 F. Supp. 48, 227 USPQ 794 (D.N.M. 1985), are inapposite. All three are infringement cases, not cases involving the construction of goods in a registration and application for purposes of determining registrability.

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sophisticated in a particular field does not necessarily endow one with knowledge and sophistication in connection with the use of trademarks." ). But even if it is assumed that customers for some of opposer's goods exercise care in making purchasing decisions, such care "does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods." *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986).

We find that the parties' potential customers and channels of trade are largely identical, and that this factor favors a finding of a likelihood of confusion. Further, we find that the potential purchasers of opposer's and applicant's goods are generally not sophisticated, and exercise no more than ordinary care in purchasing decisions.

**4. The Similarity or Dissimilarity of the Marks in their Entireties**

In a likelihood of confusion analysis, we compare the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. "[T]he 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 terms of their overall commercial impression so that confusion as to the source of the goods offered under the

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respective marks is likely to result." *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1727 (TTAB 2008). In comparing the marks, we keep in mind that "[w]hen marks would appear on virtually identical goods..., as is the case here, the degree of similarity necessary to support a conclusion of likely confusion declines." *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010), citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applicant seeks to register two stylized versions of the words EMIDIO TUCCI. Opposer has introduced evidence of its registration and use of both stylized and standard character versions of the wording EMILIO PUCCI. Opposer argues that the marks are "strikingly similar," Opp. Br. at 28-30, while applicant argues that the marks "sound completely differently [sic] and look different to the eye," App. Br. at 15. We find the marks at issue to share significant similarities.

Opposer aptly sums up the similarities in the structure of the marks, pointing out that they

are identical except for two letters (i.e., EMILIO PUCCI versus EMIDIO TUCCI) located in the identical positions within the marks (i.e. the fourth letter of the first word and the first letter of the second word). The marks have the identical number of letters and syllables and a similar structure consisting of a four-syllable word followed by a two-syllable word.

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Opp. Br. at 28.<sup>10</sup> In addition, the marks sound similar and rhyme. *Id.* at 29.

The marks also have a similar connotation. Both are Italian-sounding personal names and the stylized versions of both appear to be signatures. The overall impression of the marks is that the goods sold under each of them were designed by, or received the personal approval of the person named in the mark.

We also consider the marks to be similar in appearance. Although applicant seeks registration of its marks in stylized form, three of opposer's registrations (the '909, '743, and '298 Registrations) are registered in standard characters. With respect to the goods in those registrations, we must consider that opposer's mark could be used in any stylization, including one similar to that used by applicant. *Phillips Petroleum Co. v. C.J. Webb, Inc.* 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) (a mark registered in standard character or typed form is not limited to being depicted in any particular manner of display).

Applicant argues that consumers can distinguish the marks by the different letters used. See App. Br. at 15.

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<sup>10</sup> While our ultimate focus remains on the marks in their entirety, it is not inappropriate to consider and analyze the components of them. "[I]t is these individual aspects that collectively create a difference in the overall impressions made by the marks." *Odom's Tenn. Pride Sausage, Inc. v. FF Acquisition, LLC*, No. 09-1473, \_\_\_ F.2d \_\_\_, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010).

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We acknowledge, of course, that the marks are not identical, and that they can be distinguished when critically viewed or carefully pronounced together. However, we cannot assume that potential purchasers will be able to make an unhurried, side-by-side comparison of the marks. See *Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). Rather, "the emphasis must be 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, 108 (TTAB 1975).

We conclude that, considering the marks in their entirety, applicant's marks bear strong similarities to opposer's pleaded marks. While there are differences in the marks, the similarities clearly outweigh those differences, particularly in light of their use on identical and closely related goods, and in light of the renown of opposer's marks. See *Kenner Parker Toys*, 22 USPQ2d at 1456 ("A strong mark ... casts a long shadow which competitors must avoid.").

This factor weighs in favor of a finding of a likelihood of confusion.

#### **6. Balancing the Factors**

We have carefully considered all of the parties' evidence and argument, including that which we have not

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specifically discussed. We find that opposer enjoys significant renown in its pleaded marks, that most of the parties' respective goods are identical or closely related, and that the channels of trade and classes of consumer are largely identical. We further find that the parties' marks share significant similarities. We therefore conclude that applicant's registration of its EMIDIO TUCCI marks for the identified goods is likely cause confusion with opposer's registered and previously used EMILIO PUCCI marks.

**7. Defense - Restriction to Men's Goods**

As an affirmative defense, applicant pleaded in its answer "that it proposes to amend the Listing of Goods in [the subject application] to those products intended to be used by men only."<sup>11</sup> Answer ¶ 16. Applicant's brief makes scant mention of its defense - the only substantive argument is as follows:

Opposer now argues that with respect to clothing, a differentiation between use by men or women is not meaningful.

However, most of Applicant's goods are not items of clothing. It is believed that no such amendment should be required in order to obtain registration. Nevertheless, it is an option for the Board should it decide to do so.

App. Br. at 16.

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<sup>11</sup> Opposer sought to strike this defense as improper, incomplete and indefinite, and as insufficient to avoid a likelihood of confusion. By order dated August 22, 2006, the Board denied opposer's motion to strike.

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We construe applicant's defense as an argument in the alternative that - in the event the Board finds a likelihood of confusion with respect to the goods in the applications as published - applicant is nonetheless entitled to registration with the proffered restriction. See Trademark Act § 18, 15 U.S.C. 1068; Trademark Rule 2.133(b); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 311.02(b), 514.03 (2d ed. rev. 2004). As an affirmative defense, applicant bears the burden of proving that its restrictive amendment would avoid any confusion which would otherwise be likely.

As set out above, it is clear that opposer's registrations and common-law use of its mark cover a number of goods which are legally identical or very closely related to the goods in the subject applications. With the exception of the goods in opposer's '909 Registration and "ladies' handbags" in its '743 Registration, the goods in opposer's registrations are not limited to those for use only by women. In other words, they must be construed to include such goods for use by men. Moreover, opposer's witness, Timothy Crout, testified that opposer uses its mark on items such as aftershave for men, men's hats, satchels and mail bags for men, as well as briefcases and umbrellas, suitable for use by both sexes. While most of opposer's goods are manufactured and sold for women, Mr. Crout

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testified that a substantial percentage of opposer's total sales were attributable to the sale of men's items. Crout Test. at 34.

The fact that applicant's witnesses testified that they saw few of opposer's products for men in the stores that they visited, is of little significance with respect to the goods not covered by opposer's registrations.<sup>12</sup> As Mr. Crout testified, opposer sells products in its own stores, through department stores, and through licensees. Crout Test. at 11-17. Applicant's witnesses visited only a limited number of outlets; opposer's two New York City stores plus one department store each (Barneys New York and Bergdorf Goodman) at about the same time. It is not clear whether all of opposer's retail outlets and department stores carry the same merchandise, and whether all merchandise is carried throughout the year. Further, applicant's witnesses did not offer any testimony as to EMILIO PUCCI goods offered through opposer's licensees or over the Internet. Finally, opposer offered specific and

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<sup>12</sup> It is of no significance at all with respect to the goods which are covered by opposer's registrations. If applicant believed that opposer's registrations were broader than opposer is entitled to, its remedy was to counterclaim for partial cancellation under Trademark Act § 18. See Trademark Rule 2.106(b)(2)(ii) ("An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration."). Absent such a counterclaim, we must consider opposer's registrations to be valid and to include all of the goods listed therein. See Trademark Act § 7(b); 15 U.S.C. § 1057.



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convincing testimony and evidence of its substantial sales of men's items. *See generally*, Crout Test. at 17-50, exh. 3-4, 6-9. Applicant's contrary testimony based on a limited investigation is insufficient to rebut opposer's evidence on this point.

In sum, applicant's proposed amendment does nothing to limit the goods set out in either opposer's registrations or the other goods on which opposer has established prior use of its mark, both of which categories include items for use by men.<sup>13</sup> Accordingly, we find that applicant has not met its burden to demonstrate that its proposed restriction would avoid any likelihood of confusion.

#### **E. Dilution**

In light of our finding on the issue of likelihood of confusion, we find it unnecessary to reach the issue of dilution. *See Miss Universe L.P. v. Cmty. Mktg. Inc.*, 82 USPQ2d 1562, 1572 (TTAB 2007).

### **III. Conclusion**

In sum, we find that registration of applicant's EMIDIO TUCCI marks for the identified goods is likely to cause confusion with opposer's pleaded EMILIO PUCCI marks pursuant

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<sup>13</sup> We also note opposer's arguments that men's articles may be substantially related to those for women, and that women frequently buy men's articles as gifts, and vice versa, suggesting a finding that such goods are either related or that their purchasers and channels of trade overlap. Because we find an actual overlap in the goods themselves (even when limited to men's articles) we need not discuss these points in detail.

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to Trademark Act § 2(d). Moreover, because we find that opposer's proffered amendment would not alleviate such confusion, we decline to accept it. Lastly, we add that, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290-91 (Fed. Cir. 1984).

**Decision:** Both oppositions are SUSTAINED and registration to applicant is refused in Application Nos. 76624740 and 76624741.