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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91252482
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Attachments	NON-CONFIDENTIAL _PUBLIC_ MAIN BRIEF OF OPPOSER _AXIO_.pdf(531984 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Serial No.: 88/289,218
Mark: AXIO and Design
Published in the Official Gazette on May 28, 2019

Giorgio Armani S.p.A.		
	Opposer,	
v.		Opposition No. 91252482
SEH International, Ltd.		
	Applicant.	

Honorable Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

TRIAL BRIEF FOR OPPOSER GIORGIO ARMANI S.P.A.

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TABLE OF CONTENTS

Page

Table of Contents (continued)

Page

TABLE OF AUTHORITIES

Page(s)

Cases

Statutes

Other Authorities

Regulations

STATEMENT OF THE CASE

Opposer, Giorgio Armani S.p.A. (hereinafter "Opposer" or "Armani") submits this brief in support of its opposition to SEH International, Ltd.'s application to register the mark AXIO and Design in Appl. SN 88289218. This opposition is limited to Applicant's products listed in International Class 25, that is, sports equipment, namely, soccer uniforms, namely, shirts and shorts; jackets, pants and sweatshirts, belts for clothing, and socks.

Likelihood of confusion exists between Armani's famous AX trademark and Applicant's AXIO and Design Mark when used in connection with the parties' respective goods. Moreover, Applicant's AXIO and Design Mark is likely to dilute by blurring the distinctiveness of Armani's famous AX® Mark. Therefore, the Board should sustain this opposition to Appl. SN 88289218, under Lanham Act §§ 2(d) and 43(c).

Opposer is an international fashion house founded in 1975 by famed Italian designer Giorgio Armani. Armani creates, distributes and retails a wide variety of clothing and related fashion accessories including haute couture, ready-to-wear, leather goods, shoes, watches, jewelry, eyewear and cosmetics. From the early days of its foundation in Italy, Armani has - throughout the years - expanded its presence globally beyond the design and supply of clothing and fashion accessories. It has become a life-style syndicate and, as such, it is active internationally including in the United States in areas ranging from sports sponsorship and uniforms design, to provision of restaurant services, food, edible creations, home furnishing, home décor and hotel services, just to name a few. Not all of Armani's products are sold as luxury goods and aimed at high end consumers. In fact, Armani sells and markets worldwide certain products that specifically target a younger audience and as such encompass sport-featuring clothing

and accessories. Among Armani's most important and valuable trademarks are the ARMANI EXCHANGE and the AX trademarks. Through extensive use, advertising, promotion, and commercial success, the AX name and mark have achieved widespread name recognition among consumers, and become among the most famous and valuable brands in the fashion industry.

In particular, Armani has used the AX® Mark in U.S. interstate commerce for many decades, and in connection with a variety of goods and services including clothing in Class 25. Opposer's trademark use began well prior to Applicant's filing date of February 5, 2019, or alleged first date of use of November 30, 2017 for the opposed mark AXIO and Design. As illustrated below in details, the parties' respective marks are confusingly similar. They are used in connection with goods that are identical or otherwise **admittedly** related, and commonly originate from the same source. Armani AX® Mark is distinctive when used in connection with its goods. It is also famous both domestically and internationally, and it was so well before Applicant filed its application for federal registration and began using its mark. AXIO and Design Mark is therefore also likely to dilute Armani's famous AX® Mark by blurring its distinctiveness.

As the newcomer, Applicant SEH International has a responsibility to select a mark that would avoid likelihood of confusion with, and dilution of, Armani's famous senior mark. Applicant failed to meet its responsibility.

THE RECORD

I. OPPOSER'S RECORD

Opposer's record in this case consists of the following:

A. Notice of Opposition:

1. With its Notice of Opposition filed on November 22, 2019 (1

TTABVUE) Armani included as Exhibit a printout from TSDR showing the current status and title of Reg. No. 4239644 for the trademark AX, as well as a copy of the Certificate of Registration for the same reference.

B. Opposer's Notices of Reliance:

1. Opposer's **First Notice of Reliance** (9 TTABVUE) submitting for the record Opposer's Registration No. 4239644 for the trademark AX, and USPTO documents attesting to its current status.

2. Opposer's **Second Notice of Reliance** (10 TTABVUE) submitting for the record copies and excerpts of various public advertising campaigns featuring celebrities and aimed at a young audience interested in streetwear and sportswear, all to promote and advertise the type of products/services listed in its registration for Armani's AX® Mark;

3. Opposer's **Third Notice of Reliance** (11 TTABVUE) submitting for the record evidence of Applicant's use of the mark AX in connection with certain downloadable computer apps for mobile devices, used in connection with sports-related activities, including smart watches and monitoring devices used by athletes and, generally, individuals who intend to monitor their fitness, health, and sports-related parameters;

4. Opposer's **Fourth Notice of Reliance** (12 TTABVUE; 13 TTABVUE) submitting for the record copies of Applicant's Answers To Opposer's First Set of Interrogatories and Applicant's Responses To Opposer's Requests For Admissions;

5. Opposer's **Fifth Notice of Reliance** (14 TTABVUE) submitting for the record evidence of Opposer's uses the AX® Mark in connection with a variety of

products including sportswear, sports clothing, footwear and others and in a number of iterations and stylized versions;

6. Opposer's **Sixth Notice of Reliance** (15 TTABVUE) submitting for the record printouts of Applicant's website at https://axiosoccer.com;

7. Opposer's **Seventh Notice of Reliance** (16 TTABVUE) submitting for the record evidence in the form, *inter alia*, of public advertising, website printouts and other publications showing that Opposer's name and trademarks relied herein are widely endorsed by top athletes in numerous sport.

8. Opposer's **First Rebuttal Notice of Reliance** (32 TTABVUE) submitting in rebuttal for the record evidence of certain enforcement, protection and monitoring action undertaken in connection with Opposer's AX® Mark.

C. Opposer's testimony:

1. Testimony Declaration of Armani's global Intellectual Property Manager Mr. Antonio Croce, as well as all exhibits annexed thereto. (17 TTABVUE, 18 TTABVUE; "Croce Decl.");

2. Rebuttal Testimony Declaration of Armani's global Intellectual Property Manager Mr. Antonio Croce, as well as all exhibits annexed thereto. (31 TTABVUE; "Croce Reb. Decl.").

II. APPLICANT'S RECORD

A. Applicant's Notices of Reliance:

1. Applicant's First Notice of Reliance (20 TTABVUE);

2. Applicant's Second Notice of Reliance (27 TTABVUE);

3. Applicant's Third Notice of Reliance (21 TTABVUE; 22 TTABVUE);

4. Applicant's Fourth Notice of Reliance (24 TTABVUE);

5. Applicant's Fourth Notice of Reliance (28 TTABVUE).

B. Applicant's testimony:

1. Declaration of Duncan Hall (23 TTABVUE);

2. Declarations of Marriam Lin (25 TTABVUE; 26 TTABVUE).

STATEMENT OF ISSUES

1. Under Section 2(d) of the Trademark Act, whether Applicant's Mark so resembles Opposer's AX® Mark that confusion, mistake or deception is likely as to the source of the parties' respective goods, including confusion about sponsorship, affiliation, endorsement or connection between the sources.[1] The issue is NOT whether the goods themselves are likely to be confused.[2]

2. Under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), whether Applicant's AXIO and Design mark is likely to cause dilution by blurring of the distinctive quality of the prior registered AX® Mark, which became famous long before the February 5, 2019 filing date of Applicant's Application or Applicant' claimed first date of use of November 30, 2017.

[1]The test of "likelihood of confusion" encompasses any type of confusion, including: confusion of source; confusion of sponsorship; confusion of affiliation; or confusion of connection. *See e.g. 4 McCarthy on Trademarks and Unfair Competition* § 24:6 (5th ed., June 2021 Update); *In re Save Venice New York, Inc*., 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) (The test measures whether a "consumer would believe that noncompetitive but related goods sold under similar marks derive from the same source, or are affiliated with, connected with, or sponsored by the same trademark owner.")

2The issue is not whether the respective marks themselves, or the goods or services offered under the marks, are likely to be confused but, rather, whether there is a likelihood of confusion as to the source or sponsorship of the goods or services because of the marks used thereon. (Emphasis added) *See Paula Payne Prods. Co. v. Johnson's Publ'g Co*., 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973).

STATEMENT OF FACTS

I. OPPOSER'S BUSINESS

Opposer Armani is an international fashion house founded in 1975 by famous Italian designer Giorgio Armani. Armani creates, distributes and retails a wide variety of clothing and related fashion accessories including haute couture, ready-to-wear, leather goods, shoes, watches, jewelry, eyewear and cosmetics. (See Croce Decl. Page 3 at 17 TTABVUE 7). Throughout the years, Armani has expanded its presence globally beyond the design and supply of clothing and fashion accessories, and has become a life-style syndicate, as such, active internationally including in the United States, in areas ranging from the provision of restaurant services, food, edible creations, to home furnishing, home décor and hotel services, just to name a few. *Id.* Not all of Armani's products are sold as luxury goods and aimed at high end consumers. In fact, Armani sells and markets worldwide certain products that specifically target a younger audience and as such encompass sport-featuring clothing and accessories. *Id.*

Armani is very much involved in the world of sport and has various dedicated "sporty" collections of clothing. (See Croce Decl. Page 4 at 17 TTABVUE 8). From 2012, Armani has sponsored the Italian Olympic team. Armani has also historically been a sponsor of the international Milan marathon, which takes place each year in Milan. *Id.* The event is advertised on a number of important marathon and long-distance running websites targeted to the public at large, not just Italian consumers, and it attracts runners from many countries including the United States.

Armani also has a number of important and well-known brand ambassadors from the world of sport, such as: – Ricardo Kaka (football) – Rafael Nadal (tennis) – Federica Pellegrini (swimming) – Danilo Gallinari (basketball) – Fabio Fognini (tennis) – Filippo

Volandri (tennis) – Charles Leclerc (Formula 1 racing) 15. Armani officially sponsors Milan's OLIMPIA basketball team under its AX® Mark. *Id.*

Armani's AX® Mark features on the team's uniform, and at events. The OLIMPIA basketball team, known as AX Armani EXCHANGE MILAN, is currently third in the Euroleague, the top-tier professional basketball club competition in Europe. Armani AX basketball team has travelled to the United States for sports exhibition and it can claim followers internationally, including from the United States. *Id.*

II. OPPOSER'S TRADEMARK

Opposer is the owner of various federal trademark registrations for the AX® Mark, including the following:

Mark	Reg. No.:	Goods/Services
AX (word mark)	4,239,644	Various goods and services in International Classes 9, 12, 14, 16, 18, 24, 25, 26, 28, 35, including but not limited to the following goods in International Class 25: "Clothing, namely, pullovers, cardigans, sweaters, trousers, skirts, jackets, blouses, shirts, jeans, sweat-pants, shorts, sweatshirts, suits, dresses, overcoats, coats, raincoats, belts, jerseys, neckwear, socks and stockings, tights, vests, waistcoats, jumpers, tracksuits, blousons, gym suits, knickers, T-shirts, anoraks, suspenders, loungewear, un-derwear, beachwear, sleepwear, overalls, gloves and scarves; headgear, namely, hats and caps; shoes, sandals, boots and slippers; and others.

Reg. No.: 4,239,644 was filed on March 23, 2007 and registered on November 13, 2012, further strengthening Opposer's claim of priority. Said registration is valid and subsisting, as evidenced by true copies of the USPTO records, showing the current status

and title to the registrations is also now incontestable under Section 15 of the Trademark Act (Notice of Opposition, Ex. A; 1 TTABVUE 14-27; Opposer's First N.O.R. 9 TTABVUE). Therefore, priority is not at issue and Opposer has superior rights in its AX® Mark.

Together with the ARMANI EXCHANGE trademark, the pleaded AX® Mark is one of Armani's most important and valuable trademarks. (See Croce Decl. Page 3 at 17 TTABVUE 7). Armani actively takes steps to protect these trademarks, including obtaining trademark registrations and enforcing the trademarks against third parties. *Id.*

Applicant's ARMANI EXCHANGE line of products is commonly sold and promoted under the mark AX, appealing, with its provocative advertising campaigns, to Armani's younger audience that seeks streetwear and sportier clothing. *Id.*

Opposer's AX-branded products would not be regarded by consumers as a luxury clothing line. Unlike Armani's other brands. AX-branded products are more affordable and accessible to US consumers whilst simultaneously reflecting Armani's style, design and quality. (See Croce Decl. Page 4 at 17 TTABVUE 8).

Commercial Strength of the AX® Mark

Armani estimates conservatively that it has sold hundreds of thousand units of products bearing AX on the product itself in every state of the United States from 1991 to the present. (See Croce Decl. Page 5 at 17 TTABVUE 9). Use of the AX® Mark, sales of products bearing AX®, and recognition of AX® has continued to increase over the years. For an example of sales volumes for the past years, between 2015 and 2019 alone, Armani has derived revenues in excess of one billion U.S. dollars from the sale of products bearing the mark AX in the United States. *Id.*

[redacted]

U.S. advertising campaigns and promotional events for Opposer's AX-branded

products, have been widespread and continuous throughout the years 2000-2020. (See e.g. Croce Decl. Pages 11-16 at 17 TTABVUE 15-20; 74-1087; OPP_00059- OPP_01068 ; OPP_00063-OPP_00065). For example, and without limitation, the record shows promotional events focusing on the AX® Mark such as event named: "TIESTO DJ SET" occurred in Miami, FL on March 24, 2011; the event named: "MARTIN GARRIX DJ SET" occurred in New York City, NY on November 11, 2017; the event named: "MARTIN GARRIX DJ SET" occurred in Miami, FL on November March 3, 2018; other promotional events attended by celebrities such Paris Hilton and Cara Delevingne. (See e.g. Croce Decl. Page 15 at 17 TTABVUE 19; 17 TTABVUE 1084-1087; OPP_00063-OPP_00065).

In particular, Armani routinely engages international celebrities to act as testimonials for Armani's AX line of products. For example, Patricia Arquette and Matthew Modine were testimonials for the 1993 AX ad campaign. More recently, actor Gregg Sulkin, social media influencer Jay Alvarrez, English musician Eliot Sumner, Israeli model Shlomit Malka acted as testimonials for the 2016 AX ad campaign; famed model, actress, and singer Cara Delevigne acted as testimonial for the 2017 and 2018 AX ad campaigns; record producers and international DJ superstar Martin Garrix for the 2017, 2018, 2019 ad campaigns; American fashion model and singer Selah Marley for the 2018 and 2019 AX ad campaigns; London-based Pop duo Bloom Twins and musician and model Dylan Jagger Lee for the 2020 AX ad campaign; American actor William Peltz for the 2020 AX ad campaign; American fashion model and actress Pyper America and American fashion model Lucky Blue Smith for the 2019 AX ad campaign; American model and musician Cailin Russo for the 2020 AX ad campaign. *Id*. and also Croce Decl. Page 15 at 17 TTABVUE 19; 17 TTABVUE 1089-1090; OPP_00066-OPP_00067.

Armani's Products and Services with which Opposer Uses the AX® Mark

Armani's use of the AX® Mark permeates many aspects of its business. Armani's products bearing the AX include many different type of apparel such as pullovers, cardigans, sweaters, trousers, skirts, jackets, blouses, shirts, jeans, sweatpants, shorts, sweatshirts, suits, dresses, overcoats, coats, raincoats, belts, jerseys, neckwear, socks and stockings, tights, vests, waistcoats, jumpers, tracksuits, blousons, gym suits, knickers, T-shirts, anoraks, suspenders, loungewear, underwear, beachwear, sleepwear, overalls, gloves and scarves; headgear, namely, hats and caps; shoes, sandals, boots and slippers, all currently listed in the pleaded registration for AX 4,239,644. (See Croce Decl. Pages 6-7 at 17 TTABVUE 10-11); (Notice of Opposition, Ex. A; 1 TTABVUE 14-27; Opposer's First N.O.R. 9 TTABVUE).

Other products that Armani sells in the U.S. commerce under the AX® Mark range from watches, chronometric instruments, leather goods, sport clothing, fashion accessories, and numerous type of garments. (See Croce Decl. Page 7 at 17 TTABVUE 11). Armani also uses AX extensively in its retail stores, on its website, in connection with athletic events it sponsors, and via social media. Armani endeavors to make sure that its use and promotion of AX remain current with new types of uses and media, such as on software applications and through digital media. *Id.*

In connection with this additional products, to the extent that they are not listed in Reg. No.: AX 4,239,644, Armani acquired rights under common law as evidenced in the large amount of evidence that Applicant introduced via Notices of Reliance.

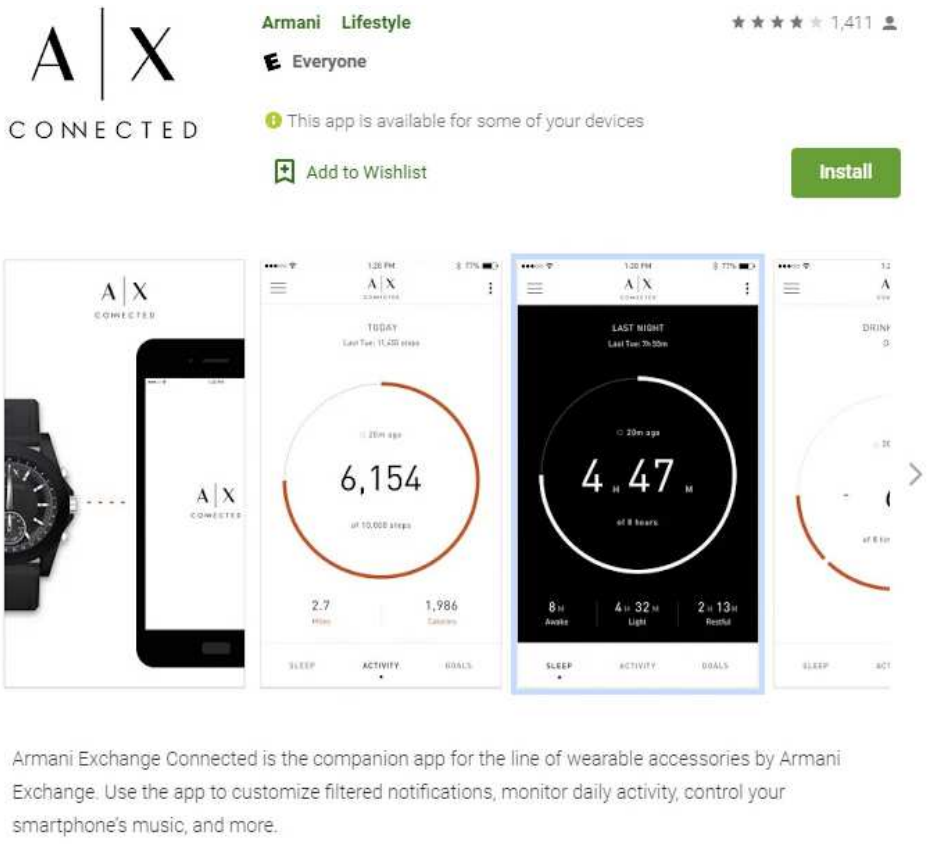
Furthermore, Armani's advertisements and promotional materials for the Armani's Mark AX include print advertising and billboards, sponsored and unsponsored

celebrity endorsement, targeted ads in department store and merchandising, extensive social media campaigns, sponsored product placement. *Id.* Over the course of the last twenty years, as new forms of media have been developed, such as digital platforms, including social media, Armani has expanded its use of AX to keep pace with the times. To that end, Armani uses AX on digital media, including its Facebook, Twitter, and Instagram pages, its website, and mobile applications, not only to promote its products, but to connect with consumers and to motivate consumers to live healthier lives and achieve their goals. *Id.*

Armani uses at least the following social media platforms to advertise its products and services under the trademark AX: Facebook, Instagram, Twitter, YouTube, Pinterest and Tik Tok. (See Croce Decl. Page 8 at 17 TTABVUE 12).

For example, as of July 2020, the Facebook account dedicated to products and services provided under the AX trademark has 2 million followers, and the Instagram account also has 2 million followers. *Id.*

Armani also uses AX in connection with its mobile apps. For example, AX CONNECTED mobile app allows users to track their health and sports goals and send their daily activity data to their favorite health platforms. Below are examples of uses of the mark AX, in one of its stylized configurations, in connection with the AX CONNECTED app. *Id. See also* Opposer's Third N.O.R. 11 TTABVUE 3-11; OPP_01147-OPP_01152.



Armani's use of the AX® Mark in connection with sports and athletic apparel, footwear is apparent throughout the record. A few examples of AX® Mark used in connection with sports and athletic apparel, footwear is shown below.

See Croce Decl., Page 10; 17 TTABVUE 33; 28-75; OPP_00004-OPP_00049.

These items were and/or are available for sale to U.S. consumers, among other outlets, on Armani's website, https://www.armaniexchange.com/us. *Id.*

Intended Consuming Public for Opposer's AX-branded products

In addition to Armani's traditional customers, which orbit around the allure of luxury fashion brands, a significant portion of consumers of Armani's AX-branded products and thus also one of the primary targets of AX advertising campaigns are members of a young demographic segment, ranging from teenagers to individual in their late twenties. The line of products sold under the AX® Mark encompasses products targeting both genders, looking for causal, sport casual and street apparel. As such, Armani's products sold the under mark AX includes a variety of sport products, shoes, tracksuits and a variety of sport clothing and fashion apparel that consumers of Armani's AX-branded products – due to their nature - notoriously pair with merchandise from their favorite soccer / basketball players. See Croce Decl., Page 9; 17 TTABVUE 13; 28-75; OPP_00004- OPP_00049.

Enforcement of Armani's AX® Mark

Armani has enforced its rights in the AX® Mark in numerous disputes. For example and without limitation, enforcement actions revolving around other party's use of marks alleged to be confusingly similar to Armani's AX® Mark, for the years 2014 to date, approximate or slightly exceeds 300 cases, of which between 15 and 20 matters relates to enforcement efforts in the United States, all of the foregoing to include including formal oppositions, demand letters, enforcement-aimed investigations and general trademark disputes. (See Croce Decl. Page 5 at 17 TTABVUE 9).

Considering the fame, notoriety, and substantial goodwill in the AX® Mark, Opposer is aware that there have been attempts by others to use or register AX or variations thereof, such as AXBLACK, AXWEAR, XA AX , XAX, etc.

For example, and without limitation, Armani has successfully opposed or petitioned to cancel at least the following trademark applications and registrations for marks using the A or a variation thereof, resulting in judgments in Armani's favor:

- U.S. Ser. No.: 88/508,730 for the mark AXBLACK proposed for registration by Xingxing LEI (TTAB Opp. No.: 91254472).
- U.S. Ser. No.: 88/538,208 for the mark AXWEAR proposed for registration by Xiamen Youjing E-commerce Co., Ltd. (TTAB Opp. No.: 91255257).
- U.S. Ser. No.: 87/842,632 for the mark XAX proposed for registration by Chen Yuting (TTAB Opp. No.: 91248171)
- U.S. Ser. No.: 87/104,046 for the mark JAX proposed for registration by Kellwood Apparel, LLC (TTAB Opp. No.: 91242746).
- U.S. Ser. No.: 86/779,389 for the mark XA AX proposed for registration by Elohim Music, LLC (TTAB Opp. No.: 91233383).

(*Also see* Croce Decl. Page 5 at 17 TTABVUE 9-22; 32 TTABVUE 1-34).

III. APPLICANTS' BUSINESS

Applicant SEH International, Ltd. is a limited liability company of Delaware with an address of record at Suite 201, 850 New Burton Road, Dover, DE. Applicant owns and operates, *inter alia*, an online retail store featuring clothing, sporting apparel, and accessories, associated with the internet domain address of axiosoccer.com. See opposed application, automatically of record under 37 CFR § 2.122(b)(1); see also Applicant's Response to Opposer Request for Admission at 12-13 TTABVUE 34, OPP_01179; Opposer's Sixth N.O.R., 15 TTABVUE.

IV. APPLICANT'S TRADEMARKS

Applicant's trademark application opposed herein is for the mark AXIO and Design and bears U.S. Appl. SN. 88/289,218 (sometimes the " '218 application ").

The '218 application lists *inter alia* "sports equipment, namely, soccer uniforms, namely, shirts and shorts; jackets, pants and sweatshirts, belts for clothing, and socks" in International Class 25.

The trademark drawing of record with the opposed application is displayed below:

The application describes the applied-for mark as consisting of the word "AXIO" with a stylized "X. See opposed application, automatically of record under 37 CFR § 2.122(b)(1).

V. SIMILARITIES OF THE TRADEMARKS

Opposer's trademark is:

AX

(Opposer's relied upon registration contains a standard characters claim)

Applicant's trademark is:

AXIO and Design, i.e. 

The literal element of the applied-for mark incorporates in its entirety Applicant's mark AX. Further, the initial portions of the parties' marks are effectively identical. It is Opposer's position that the design in the opposed mark, as shown below, places significant emphasis on the letters AX. These letters form the initial portion of Applicant's mark, and thus they become immediately distinguishable to the U.S. consuming public. (See Croce Decl. Page 19 at 17 TTABVUE 23).

Opposer maintains as self-evident that, due to the particular stylization of the opposed mark, it is possible that the relevant consuming public would read the letter "IO" as the number "10", thus potentially suggesting that the AXIO and Design is rather an iterative version (AX No. 10) of an AX-branded product. *Id.*

Because the particular stylization of the opposed mark emphasizes the initial portion AX, and divides it from the subsequent stylized number "10", the relevant consuming public is hinted to pronounce the mark appearing as "AX 10", thus reinforcing the perception that Applicant's mark is an iteration of Opposer's Mark. *Id.*

VI. RELEVANT PRIORITY DATES

Priority is not at issue in this matter. Applicant admits that it did begin use of the applied-for mark prior to April 30, 2017. Furthermore, Applicant's filing date is February 5, 2019. *See* Applicant's Response to Opposer's Requests for Admission No. 26-28; at 12-13 TTABVUE 38; OPP_01181.

In contrast, Opposer has shown use of the mark for many decades, and certainly

prior to Applicant's filing date of Feb. 05, 2019. Regardless, by virtue of filing its registration for the mark AX under Section 66(a) of the Trademark Act from International Registration 0926043 and with a priority claim based on the earlier basic application, Opposer is entitled to a statutory priority of Feb. 22, 2007. *See* Opposer's First N.O.R. at 9 TTABVUE 13; OPP_01074; 9 TTABVUE 79-

Furthermore, Opposer is entitled to additional priority under common law date back as far as 1991, and has provided actual sample use of the mark AX in connection with fashion products and related advertising campaigns since the early 2000's. (*See* Croce Decl., Page 5 at 17 TTABVUE 9; Page 11 at 17 TTABVUE 15; 17 TTABVUE 75-78; OPP_00060-OPP_00062; 17 TTABVUE 79-1082; OPP_00068-OPP_01067.

VII. THE PARTIES' RESPECTIVE GOODS AND SERVICES ARE IDENTICAL, SIMILAR AND RELATED

It is uncontroverted that the parties' respective products and services are identical, otherwise similar or related. Applicant admits so.

From Applicant's Response to Opposer's Requests for Admission No. 14:

> "14. Admit that the goods described in United States Trademark Application Serial No.: 88/289,218 for International Class 25 are related to the goods provided under Opposer's Mark as described in the Notice of Opposition.
>
> **Response**: Admit."

See Applicant's Response to Opposer's Requests for Admission at 12-13 TTABVUE 34-39; OPP_01179- OPP_01184.

This is also apparent otherwise from the record.

Opposer's registration for the AX® Mark in U.S. Reg. No.: 4,239,644 lists the following goods International Class 25: "clothing, namely, pullovers, cardigans, sweaters, trousers, skirts, jackets, blouses, shirts, jeans, sweat-pants, shorts, sweatshirts, suits, dresses, overcoats, coats, raincoats, belts, jerseys, neckwear, socks and stockings, tights, vests, waistcoats, jumpers, tracksuits, blousons, gym suits, knickers, T-shirts, anoraks, suspenders, loungewear, underwear, beachwear, sleepwear, overalls, gloves and scarves; headgear, namely, hats and caps; shoes, sandals, boots and slippers; and others."

Opposer also uses the AX® Mark on a variety of sport products, shoes, tracksuits and a variety of sport clothing and fashion apparel that consumers of Armani's AX-branded products – due to their nature - notoriously pair with merchandise from their favorite soccer / basketball players. See Croce Decl., Page 9; 17 TTABVUE 13; 28-75; OPP_00004- OPP_00049.

Armani also uses AX in connection with its mobile apps. For example, AX CONNECTED mobile app allows users to track their health and sports goals and send their daily activity data to their favorite health platforms. Below are examples of uses of the mark AX, in one of its stylized configurations, in connection with the AX CONNECTED app. *(See* Croce Decl. Page 8 at 17 TTABVUE 12; also *see* Opposer's Third N.O.R. at 11 TTABVUE 3-11; OPP_01147- OPP_01152.)

The opposed '218 application lists the following products: "sports equipment, namely, soccer uniforms, namely, shirts and shorts; jackets, pants and sweatshirts, belts for clothing, and socks" in International Class 25.

Applicant's record also shows that Applicant sells additional products under the opposed mark such as neck t-shirt, jersey, jackets, backpacks, polo shirts, etc. See

Applicant's Answer to Opposer's Interrogatories at Pages 5-6, 12-13 TTABVUE 11-12; OPP_01157- OPP_01158; 12-13 TTABVUE 28-30; OPP_01173-OPP_01175.

The parties' products are therefore indisputably identical or legally related to each other.

Intended Consumers, Trade Channels, Price Points and Commercial Strategies

The intended consuming public is effectively identical for the products sold under Opposer's Mark and those sold under Applicant's mark.

While denying, inexplicably, that the goods associated with the opposed mark AXIO and Design are sold to the same class of purchasers, Applicant admits at the same time that its own identification of products in the '218 application contains no limitation as to the class of intended purchasers. *See* Applicant's Response to Opposer's Requests for Admission at 12-13 TTABVUE 36; OPP_01181. That the opposed application contains no limitation as to intended consumers and trade channels is also apparent from a cursory review of the identification of goods listed in the '218 Application, automatically of record under 37 CFR § 2.122(b)(1).

Applicant also admits that the identification of goods in Trademark Application Serial No.: 88/289,218, does not contain any limitation as to the intended trade channels. For example, From Applicant's Response to Opposer's Requests for Admission No. 19:

> "19. Admit that the identification of goods in Trademark Application Serial No.: 88/289,218, does not contain any limitation as to the intended trade channels.
>
> **Response**: Admit"

See Applicant's Response to Opposer's Requests for Admission at 12-13 TTABVUE 37;

OPP_01182.

Opposer has clarified that Armani's AX products appeal often to a young clientele and to a sports-oriented community and are sold through a multitude of channels. They are sold at least in department stores, outlets, proprietary or third-party retail stores, whether online or offline, and through direct sale to consumer via internet websites. Products bearing the AX® Mark are also made available to sports teams directly such as Olimpia Milano Basketball Team. Opposer's primary website targeting U.S. consumers is https://www.armaniexchange.com/us. *See e.g.* Croce Decl., Page 20; 17 TTABVUE 24.

Opposer also testified about its knowledge that sports companies do often feature in the fashion media. Many of Armani's products, such as shoes and shirts are also often used in connection with Armani's sponsored sports and entertainment initiatives. As such, consumers viewing Applicant's AXIO mark may well believe that Applicant's goods are endorsed, sponsored by, or originate with Armani. *Id.*

In addition to their respective websites, for Opposer at https://www.armaniexchange.com/us (see Croce Decl., Page 10; 17 TTABVUE 33; 28-75; OPP_00004-OPP_00049) and for Applicant at axiosoccer.com (see Applicant's Response to Opposer Request for Admission at 12-13 TTABVUE 34, OPP_01179; Opposer's Sixth N.O.R., 15 TTABVUE), the parties also use identical third-party social media outlets to advertise their products, such as for example Instagram and Facebook. (See Croce Decl. Page 7 at 17 TTABVUE 11; and 12-13 TTABVUE 14).

It follows that the parties intended consuming public, trade channels, commercial and marketing strategies contain no limitation, and that in fact they overlap.

Miscellaneous Factors

Albeit Applicant denies having prior knowledge of Opposer's AX® Mark, Applicant

admits that he was aware of Opposer and its company when it filed the application for the opposed AXIO and Design mark. *See* 12-13 TTABVUE 34, OPP_01179.

Based on the widespread use of the AX® Mark in connection with U.S. sales, advertising, promotional campaigns and events for many decades, Applicant's failure to identify Opposer's mark points to its negligence in performing even the most basic clearance searches, if not an intentional disregard for third-party rights.

ARGUMENT

I. THE OPPOSED APPLICATION SHOULD BE DENIED BECAUSE APPLICANT'S MARK CREATES LIKELIHOOD OF CONFUSION WITH OPPOSER'S MARK

A. Opposer's Standing and Priority

There is no dispute about Opposer's standing to oppose registration of Applicant's Marks since standing is established by the pleaded Registration No. 4239644. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (party's ownership of pleaded registration establishes standing).

Applicant also admits not having priority. In its own answer to Opposer's discovery requests, Applicant admits that it did not start using its mark prior to its alleged date of first use of April 30, 2017 nor prior to Opposer's federal statutory priority dating as far back as February 22, 2007.

It is therefore undisputed that Opposer's Mark enjoys long priority over Applicant's Mark. Opposer's registration is valid, subsisting, and incontestable. Therefore, Opposer has the right to exclude others, such as Applicant, from registering confusingly similar marks, particularly where those marks are applied for and used on the same, similar goods, or in connection with products that are legally related to Opposer's Products. Further, Opposer has acquired additional common law rights

through the long use in U.S. commerce of its Marks since 1991, in conjunction with a variety of additional fashion products, sporting goods and accessories, and associate services. Their nature is even broader than the nature of the items listed in Opposer's registration, thus showing priority on an even broader range of goods.

Thus, priority is not at issue.

B. Applicant's Marks and Opposer's Marks are Confusingly Similar

Applicant's Mark so resembles Opposer's Mark "as to be likely, when used on or in connection with the goods of the Applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). Whether a likelihood of confusion exists is a question of law based on underlying factual determinations. *Id.* at 1843-44.

The Board determines the likelihood of confusion on a case-by-case basis, applying the factors set out in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A.1973).

The factors identified in *In re E.I. DuPont*, are: (1) the similarity of the marks in appearance, sound, connotation and commercial impression; (2) the similarity in nature of the goods as described in an application; (3) the similarity of established and likely to continue trade channels; (4) the conditions under which the goods are purchased and to whom sales are made; (5) the fame of the prior mark; (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used; (10) the market interface between application and the owner of the prior mark; (11) the extent to which an applicant has the right to exclude others from use of its mark on its goods; (12) the

extent of potential confusion; and (13) any other established fact probative of likelihood of confusion.

Although the likelihood of confusion analysis considers all *DuPont* factors for which there is evidence of record, the relevance and weight to be given to various factors may differ from case to case. *Id.*

It is also well settled that if the issue of likelihood of confusion is in doubt, the question should be resolved in favor of the senior user. *Nina Ricci, S.A.R.L. v. E.T.F. Enters.*, 889 F.2d 1070, 1074, 12 USPQ2d 1901 (Fed. Cir. 1989). In the present case, as discussed in more detail below, a finding of likelihood of confusion is inescapable.

Opposer's Mark is one of the main source identifiers in the United States for Opposer products and services, particularly for those targeting a young, sport-focused clientele. The mark is well-known in the fashion, sport and entertainment industry and by the relevant public. As such, they are entitled to a wide degree of protection. The goods (and associate retail services) being provided in connection with the respective parties' marks are identical and otherwise related.

The trade channels and consumers are also, admittedly, identical, including potentially the same distributors, and retail points of sale, whereas neither Opposer's pled registration nor the opposed application contain any limitation thereto.

The marks are also similar in appearance and commercial impression. The actual manner of trademark use shows products advertised and travelling through the same trade channels (e.g. online retail websites, social media, and physical stores), using confusingly similar marks.

This undermines Opposer's substantial advertising, widespread commercial and

marketing investments. It causes risk of confusion, mistake or deception as to the source or sponsorship of the parties' goods and services.

1. Opposer's Mark and Applicant's Mark Are Nearly Identical In Appearance, Sound, Connotation and Commercial Impression

When performing a likelihood of confusion analysis, the Board considers the similarities and dissimilarities of the trademarks at issue, in terms of their appearance, sound, connotation and overall commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En* 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005), quoting *Du Pont*, 177 USPQ at 567.

Similarity in anyone of the traditional elements -- overall appearance, sound and connotation (*In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)) -- can be sufficient to support a finding of likely confusion. *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1914 (TTAB 2000). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980).

A decision of confusingly similarity must be based on the entire marks, not just part of the marks[3]. At the same time, the respective dominant features should be analyzed to determine whether the marks are similar. *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (C.C.P.A. 1955).

It is however expected that more or less weight be given to a particular feature of a mark. *Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Finally, when some of the goods identified are commercially identical, "the degree of similarity

[3]*See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981)

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, 1701 (Fed. Cir. 1992).

i. Similarity in Appearance

A comparison of the marks at issue demonstrates that the marks are almost identical in concept and style. They are similar in appearance, sound and meaning, and convey a similar overall commercial impression.

Opposer's mark is registered in standard characters so that Plaintiff is not limited in the manner in which it may display its AX® Mark. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983); *In re RSI Sys., LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1998).

Accordingly, the Board must assume that Opposer could display its mark in a stylization similar to Defendant's stylized mark. *In re Aquitaine Wine*, 126 USPQ2d 1181, 1186 (TTAB 2018) ("Since Registrant's mark is a standard character mark, we must consider that the literal elements of the mark (the words and the letters) may be presented in any font style, size or color, including the same font, size and color as the literal portions of Applicant's mark. This is because the rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color.") (*citing Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011)).

In this sense, when performing a likelihood of confusion analysis under Section 2(d) of the Trademark Act, one should presume that Opposer's Mark could be displayed in the exact font-type as Applicant or in a markedly similar fashion.

Regardless, both Opposer and Applicant's mark comprise the letters AX, whereas

Applicant also adds the letters “IO”.

In this regard, it is all but certain that prospective consumers encountering Applicant's mark will focus primarily on the first portion of its mark which is identical to Opposer. As to the additional design element in the opposed ‘218 application, it does nothing to mitigate the identical sound and identical appearance of the expression “AX” in the involved marks.

In this regards, Applicant should be reminded of the well-known principle that when a mark consists of a literal portion and a design portion, the literal portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods and/or services; therefore, the literal portion is normally accorded greater weight in determining whether marks are confusingly similar. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999). *See also CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011). Furthermore, Applicant's mark could be perceived as a variation of the AX® Mark, relating to a particular plan or strategy to be employed, or Registrant's mark could be perceived as a variation of Applicant's mark.

This is not to say that design elements in Applicant’s mark should be ignored.

In re RSI Sys., supra at 1885. Taking those light design features into consideration, it becomes even more evident that the dominant element in Applicant’s mark is identical to Opposer’s mark. That is, due to the particular stylization of the opposed mark, it is possible that the relevant consuming public would read the letter “IO” as the number “10”, thus potentially suggesting that the AXIO and Design is rather an iterative version (AX No. 10) of an AX-branded product.

As shown below, it is immediately apparent that the letter "X" in Applicant's Mark is displayed in a size which is noticeably larger than the other letters. It creates a subtle yet lasting impression in the mind of the readers that the AX portion precedes and is conceptually separable from the letters "IO". Further, the stylization of the letters "IO" using a sans-serif font type shows that consumers might easily read those letters as the number "10", since the sans serif letters "I" and "O" would lack any differentiating element with the numbers "1" and "0".

Thus, viewing the marks in their entireties, they are very similar in appearance and connotation.

ii. Similarity in Sound

In the course of discovery, Applicant seemed to favor the idea that the letters A and X in the AX® Mark would be pronounced as "ā eks". *See e.g.* Applicant's Request at 36 TTABVUE 39-40.

Opposer does not object to the assertion that the pronunciation of the words AX in Opposer's mark is "ā eks" (or | ə eks |), however Opposer notes that at least some consumers presented with the words AX might pronounce it as "ăks".

Regardless, as explained above, the design in Applicant's mark places significant emphasis on the letter "X", thus encouraging consumers (or at least a relevant segment thereto) to pronounce the applied-for mark as | ā eks ˈaɪəʊ | or, even more likely as | ā eks ten |.

Thus, the pronunciation of the parties' marks is effectively identical, or at least it

is identical in one likely variation.

Furthermore, because the dominant portion of the parties' marks is spelled identically, whether the marks are pronounced "correctly" or not, they would be pronounced similarly, as they consist of the same letters in the same order.

Any doubt, again, should be resolved in favor of the senior user. *See Nina Ricci, supra.*

iii. Meaning

Opposer's Mark has no meaning, albeit it originally started as an abbreviation of the expression ARMANI EXCHANGE. Importantly, the large evidence of record shows that Opposer - dependably and habitually - uses the mark AX by itself without any hint of its origin from ARMANI EXCHANGE.

Applicant's mark also has no recognized meaning.

Furthermore, the dominant portion of the parties mark "AX" is identical, and the additional elements of Applicant's Mark add little, especially in light of the stylized elements that separate conceptually the letters AX from "IO" (or rather "10).

Thus, the parties' mark would both likely convey either no meaning or the same or similar meaning.

iv. Similarity in Overall Commercial Impression

Because the parties' marks are so similar in appearance, sound, and meaning (or lack thereof), they create highly similar commercial impressions. *See e.g., Inter Ikea Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1741 (TTAB 2014) (finding IKEA and AKEA confusingly similar, stating "[w]here, as here, both marks are coined terms that look alike and sound alike and there are no known differences in the meaning to distinguish them, the marks engender a similar commercial impression") (citing cases); *Atlas Supply Co. v.*

The Dayton Rubber Co., 125 USPQ 529, 530 (TTAB 1960) ("The marks 'PLYCRON' and 'NYCRON' are similar in composition, they bear a marked resemblance in sound, and they are both coined terms having no apparent meaning other than as trademarks. In view thereof, it is believed that purchasers of tires might reasonably attribute a common origin to 'PLYCRON' tires and 'NYCRON' cord for making tires ….").

It should also be noted that "the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark's fame increases, the Act's tolerance for similarities in competing marks falls." *See Kenner Parker Toys*, 22 USPQ2d at 1456. Thus, this factor also weighs heavily in support of finding a likelihood of confusion.

2. Priority is not at Issue

Priority is not at issue. Applicant has effectively admitted that Opposer has priority in the mark AX.

In particular, Applicant admitted that it did not begin use of the applied-for mark prior to April 30, 2017. Furthermore, Applicant's filing date is February 5, 2019. In contrast, Opposer filed its application to register the AX® Mark, under Section 66(a) of the Trademark Act stemming from International Registration 0926043. Opposer's registration also includes a claim of priority based on the earlier basic application. Thus, Opposer is entitled to a statutory priority date of February 22, 2007.

Opposer has also shown priority under common law an provided significant testimony and documentary evidence under which Opposer's use of the AX® Mark in U.S. commerce started as far back as 1991.

3. Strength/Fame of Opposer's Trademarks

Not all trademarks are equal. Unlike "weaker" marks, "strong" marks are given

"strong" protection, over a wide range of related products and services and variations on visual and aural format. *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1360, 56 USPQ2d 1351 (Fed. Cir. 2000).

Trademark strength is expression of conceptual strength and commercial strength, and should be determined by weighing both aspects:

> Conceptual Strength: the placement of the mark on the spectrum of marks; and
>
> Commercial Strength: the marketplace recognition value of the mark.

See In re Chippendales USA, Inc., 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength … and its marketplace strength ….").

a. Conceptual Strength of Opposer's Mark

In the spectrum of trademark conceptual strength, fanciful and arbitrary marks are the strongest types. Fanciful and arbitrary marks are regarded as being "inherently distinctive."[4]

Particularly, an arbitrary mark consists of a word or symbol that might be in common usage in a language, but is arbitrarily applied to the goods or services in question. *See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition*, § 11:1 (5th ed., June 2021 Update).

[4]*Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 120 L. Ed. 2d 615, 112 S. Ct. 2753, 23 USPQ2d 1081, 1084 (1992); *Lahoti v. Vericheck, Inc.*, 636 F.3d 501, 505–506, 97 USPQ2d 1878 (9th Cir. 2011).

The literal element of Opposer's Marks do not have any meaning or significance as applied to the relevant goods and services. Furthermore, even though it is at times used together with the expression ARMANI EXCHANGE (an expression which is conceptually strong on its own), the AX® Mark is very often applied in isolation to its respective goods. Importantly, ARMANI EXCHANGE is not a defined expression, that the mark is inherently distinctive. See In re Chippendales USA Inc., *supra* at 1684 (Fed. Cir. 2010) ("Word marks that are arbitrary, fanciful, or suggestive are inherently distinctive.").

In other words, when used on clothing, sporting apparel and accessories, and related services, Opposer's Mark is conceptually strong. Opposer's Mark is therefore inherently distinctive and appears on the strongest side of the spectrum for trademark conceptual strength. *Id.* The pleaded registration for Opposer's Mark has also obtained incontestability status under Section 15 of the Trademark Act, with respect to the goods and services listed therein.

b. Commercial Strength of Opposer's Mark

With regard to Opposer's commercial strength, Opposer recognizes that the commercial strength of a mark can range from "very strong to very weak." *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (*quoting In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)). *See also, Joseph Phelps Vineyards, LLC v. Fairmont Holdings*, LLC, 857 F.3d 1323, 122 USPQ2d 1733, 1734-35 (Fed. Cir. 2017).

The record in this case fully supports Opposer's contention that its mark is not only very strong, but famous, for likelihood of confusion purposes.

Courts have stated that the "fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Id*. Other relevant factors include "length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark." *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012).

By each of these measures, Opposer's AX® Mark is famous.

The mark has been in the public consciousness for three decades, since the year of Opposer's adoption, that is in 1991. Opposer has also shown for the record advertising expenditure amounting to millions of dollars, has produced hundreds of pages displaying uninterrupted U.S. media campaigns, and sponsored events with celebrities throughout the past decades, together with high consumer following and engagement on third-party social media platforms.

Where fame exists, as here, it "plays a 'dominant role in the process of balancing the DuPont factors,' … and '[f]amous marks thus enjoy a wide latitude of legal protection.'" *In re Bose Corp.,* 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)), at 1305 (quoting *Recot, Inc. v. Benton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)). A strong mark such as Opposer's "casts a long shadow which competitors must avoid." *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Thus, this factor weighs heavily in favor of finding a likelihood of confusion.

4. Applicant's Goods Are Identical in Nature and Otherwise Related to Opposer's Goods and Services

Applicant has **admitted** that the parties' respective products are related. This is also apparent elsewhere from the record.

At the outset, while considering goods, it is not necessary that they be identical (or even competitive) in order to find a likelihood of confusion. Rather, the question is whether the goods are marketed in a manner that "could give rise to the mistaken belief that [the] goods emanate from the same source." *Coach Services*, 101 USPQ2d at 1722 (*quoting 7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 227 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ("Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services."); *Recot, Inc. v. Benton, 214* F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000)) ("even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods"); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1109 (2007).

Here, both parties use their respective marks in connection with clothing, sporting apparel and accessories. Opposer's registration for the AX® Mark lists, *inter alia*, numerous clothing items in Class 25, and so does the opposed application.

The opposed application lists "sports equipment, namely, soccer uniforms, namely, shirts and shorts; jackets, pants and sweatshirts, belts for clothing, and socks". In sum, the similarity and/or relatedness of the parties' respective goods traded under the respective marks is uncontroverted, inasmuch as Applicant admitted thereto and the

record confirms it.

This factor heavily weigh in favor of a finding of likelihood of confusion.

5. Opposer and Applicant Sell Products Through the Same Channels of Trade

There are no trade channel restrictions in Opposer's registration and Applicant's application.

Inasmuch as the parties' respective marks are legally identical or otherwise related, the Board should presume that there is overlap in trade channels and classes of consumers. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *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).

The likelihood of confusion is greater where, as here, the goods bearing or sold in connection with the respective marks will travel through the same or related trade channels. *In re E.I. DuPont*, *supra* at 563.

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

6. Proof of Actual Confusion is Not Necessary

At the time of the filing of this opposition, Applicant's goods have been sold under the proposed marks for approximately three years, while Opposer testified selling its products in U.S. interstate commerce under the AX® Mark since at least 1991.

In other words, there might have been no meaningful opportunity for actual confusion to have occurred. *Double Coin Holdings*, 2019 USPQ2d 377409, at *9 (TTAB

2019) ("The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by [Tru] … of its mark for a significant period of time in the same markets as those served by [Double Coin] … under its mark[].") (quoting *Citigroup v. Capital City Bank Grp.*, 94 USPQ2d 1645, 1660 (TTAB 2010), aff'd, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011)).

Additionally, proof of actual confusion is not necessary to establish a likelihood of confusion. *See, e.g., In re Detroit Athletic Co.*, 128 USPQ2d at 1053; *Weiss Assocs. Inc. v. HRL Assocs. Inc.* 902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990); *Double Coin Holdings*, 2019 USPQ2d 377409, at *8.

7. The Number and Nature of Similar Marks in Use on Similar Goods

Applicant submitted evidence of third party trademark registrations, conceivably, in an attempt to limit the scope of protection for Opposer's Marks.

Close examination of the submitted records demonstrates that the list includes registrations for marks differ so significantly in appearance, sound, connotation and commercial impression from Opposer's Mark to not affect their scope of protection for clothing, fashion and apparel products, or related services. For example, Applicant's record refers, *inter alia*, to the following registrations:

- RN 6158439 for the mark AXIAL and Design September 22, 2020 and claiming first use in commerce of August 3, 2020.
- RN 6111102 for the mark AXXIOM registered on July 28, 2020
- RN 5703025 for the mark AXCENT and Design registered on March 19, 2019 and claiming date of first use in commerce of August 1, 2018.
- RN 5611178 for the mark AXION and Design registered on November 20, 2018 and claiming date of first use in commerce of October 1, 2017.
- RN 5366268 for the mark AX ALETTERHIN and Design ()

and claiming a date of first use in commerce of November 8, 2016.

- RN 5053860 for the mark AXESEA registered on October 4, 2016 and claiming a date of first use of January 1, 2016.

Importantly, not only are there strong elements of differentiation between Opposer's Mark and the marks in the other registrations cited by Applicant, but also, Applicant did not submit any meaningful evidence that the listed third party marks are currently in use in the United States or that these marks are recognized by consumers. "The probative value of third-party trademarks depends entirely upon their usage." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369 (Fed. Cir. 2005); see, e.g., *Scarves by Vera, Inc. v. Todo Imports*, Ltd., 544 F.2d 1167, 1173 (2d Cir. 1976) ("The significance of third-party trademarks depends wholly upon their usage. Defendant introduced no evidence that these trademarks were actually used by third parties, that they were well promoted or that they were recognized by consumers."). Where the "record includes no evidence about the extent of [third-party] uses ... the probative value" of third party trademark registrations is minimal. Palm *Bay Imports, Inc., Id.* (citing *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1338 (Fed. Cir. 2001). As such, Opposer's Marks are entitled to a wide scope of protection and this factor weighs in favor of Opposer, or is otherwise neutral.

8. Any Doubt Should Be Resolved in Favor of Opposer

Any doubt as to likelihood of confusion should be resolved against Applicant. *In re Hyper Shoppes, Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988). The newcomer "has the opportunity of avoiding confusion, and is charged with the obligation

to do so," *In re Shell Oil Co.*, 992 F.2d at 1209, 26 USPQ2d at 1691 (Fed. Cir. 1993). The trademark AX has been used in U.S. commerce since at least as early as 1991. While surprisingly denying its knowledge of the AX® Mark, Applicant admitted to its knowledge of Opposer and its business.

Opposer's prior use is many years before Applicant adopt a strikingly similar trademark, and filed a federal application listing goods that legally identical, and admittedly related to those for which Opposer is widely known.

Any doubt as to whether a likelihood of confusion exists between the parties' designation and logos must be resolved against Applicant.

II. APPLICANT'S REGISTRATION OF AXIO AND DESIGN SHOULD BE DENIED BECAUSE IT IS LIKELY TO DILUTE THE FAMOUS AX® MARK BY BLURRING

To establish grounds for opposition based on dilution by blurring, Armani must prove that its AX® Mark was famous prior to the date of Applicant's application to register Applicant's AXIO and Design Mark, and that Applicant's AXIO and Design mark is likely to blur the distinctiveness of the AX® Mark. *See UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1886 (TTAB 2011).

The Court of Appeals for the Federal Circuit set forth the following four elements a plaintiff must prove in a Board proceeding in order to prevail on a claim of dilution by blurring: (1) the plaintiff "owns a famous mark that is distinctive; (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff's famous mark; (3) the defendant's use of its mark began after the plaintiff's mark became famous; and (4) the defendant's use of its mark is likely to cause dilution by blurring or by tarnishment." *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1372, 101 USPQ2d 1713,

1723- 24 (Fed. Cir. 2012).

A. Opposer Owns A Famous Mark That Is Distinctive

To establish fame for dilution purposes, a party must show that its mark "is widely recognized by the general consuming public in the United States." 15 U.S.C. § 1125(c)(2)(A). The Lanham Act sets forth four factors for determining whether a mark has acquired "fame" under the Act: (1) the "duration, extent, and geographic reach of advertising and publicity of the mark"; (2) the "amount, volume, and geographic extent of sales of goods or services under the mark"; (3) the "extent of actual recognition of the mark"; and (4) whether "the mark was registered." *Id.*

1. Duration, Extent, Geographic Reach Of Advertising And Publicity Of The Mark

Opposer has shown widespread U.S. use and advertising of AX-branded products for several decades, dating back from 1991.

Opposer has also shown that the mark has been used not only domestically but also internationally. It has acquired global reach and world-wide recognition.

This factor favors a finding of fame and dilution.

2. The Amount, Volume, And Geographic Extent of Sales of Goods or Services Offered Under The Mark

The record is copious with respect to Opposer's advertising and publicity of the AX® Mark goods, and it clearly indicates that AX products are sold throughout the United States. Opposer has shown advertising expenditures specifically related to AX-branded products for the years 2015-2019 of almost 17 million dollars. Opposer has shown revenues from sales of AX-branded products well in excess for the year 2015-2019 well in excess of one billion dollar. Opposer also submitted copies of print advertising from 2000-2020. In addition, Opposer regularly sponsors promotional events focusing on

the AX® Mark, to name a few: "TIESTO DJ SET" occurred in Miami, FL on March 24, 2011; the event named: "MARTIN GARRIX DJ SET" occurred in New York City, NY on November 11, 2017; the event named: "MARTIN GARRIX DJ SET" occurred in Miami, FL on November March 3, 2018; other promotional events attended by celebrities such Paris Hilton and Cara Delevingne. Opposer has shown millions of followers for its AX-branded social media accounts.

Armani also has a number of important and well-known brand ambassadors from the world of sports, to name a few: – Ricardo Kaka (football) – Rafael Nadal (tennis) – Federica Pellegrini (swimming) – Danilo Gallinari (basketball) – Fabio Fognini (tennis) – Filippo Volandri (tennis) – Charles Leclerc (Formula 1 racing). Armani officially sponsors Milan's OLIMPIA basketball team under its AX® Mark.

This factor also favors a finding of fame and dilution.

3. The Extent of Actual Recognition of Opposer's Mark.

As indicated above, the mark has acquired significant recognition in the United States and elsewhere. Millions of social media users have become followers of various accounts featuring the AX® Mark and associated products. Opposer has provided for the record thousands of pages of magazine covers and excerpts and other publications, all featuring the AX® Mark. Celebrities and famous stars have become brand ambassador and actively host events intended to consolidate the widespread reputation of the AX® Mark.

Thus, the evidence shows that the AX® Mark has been referenced in major media outlets, and celebrities, for many decades, and well before Applicant applied-for registration of its AXIO and Design Trademark.

"Perhaps the most significant of the four elements set forth in the Act to determine fame is the extent of actual public recognition of the mark as a source-indicator for the goods or services in connection with which it is used." *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1024 (TTAB 2011).

This factor also favors a finding of fame and dilution.

4. Whether The Mark Was Registered on The Principal Register.

Opposer owns various registrations, including the pleaded registration for the standard character mark AX in RN 4,239,644 that issued in 2012.

Opposer's mark is registered on the Principal Register as an inherently distinctive mark without resorting to Section 2(f) or subject to a disclaimer. Moreover, since it over five years old, it is not subject to challenge under Trademark Act § 2(e). Trademark Act § 14(3), 15 U.S.C. § 1064(3).

Accordingly, this factor also favors a finding of fame and dilution.

B. Applicant Is Using And Is Attempting To Register A Mark That Dilutes Opposer's Famous Mark

In analyzing whether Applicant's marks dilute Opposer's AX® Mark by blurring, the marks should be compared for their similarities; the marks do not have to be identical or nearly identical. *Nike*, *supra* at 1030 ("The harm dilution does to the selling power of a mark is not only caused by a third-party use or registration of an identical mark. It may be caused by a "look-alike" mark, one that is close enough to the famous mark that consumers will recall the famous mark and be reminded of it….").

The similarities of the respective marks has been discussed earlier. Courts typically employ the same in the context of dilution by blurring as they do in the context of a likelihood of confusion analysis. At the same time, in the dilution context, "the

similarity between the famous mark and the allegedly blurring mark **need not be substantial** in order for the dilution by blurring claim to succeed." Emphasis added. *Nike v. Maher*, 100 USPQ2d at 1029 (citing *Tiffany (NJ) Inc. v. eBay, Inc.*, 600 F.3d 93, 111 n. 18, 94 USPQ2d 1188, 1201 n. 18 (2d Cir. 2010)).

What's more, Applicant's mark incorporates in its entirety Opposer's Mark. Marks have frequently been found to be similar where one mark incorporates the entirety of another mark, as is the case here. *Coca-Cola Bottling Co. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL is similar to BENGAL LANCER); *Johnson Publ'g Co. v. Int'l Dev. Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY is similar to EBONY DRUM); *In re S. Bend Toy Mfg. Co.*, 218 USPQ 479, 480 (TTAB 1983) (LIL' LADY BUG is similar to LITTLE LADY).

As indicated earlier, it is also not improper to give more weight to the shared dominant feature AX in determining the commercial impression created by the mark. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.").

All other Factors Also Favor a Finding of Dilution by Blurring

Opposer has provided an ample record showing that it engages in substantially exclusive use of the AX® Mark with respect to competitive, as well as non-competitive goods and services.

While Applicant submitted certain third-party registrations partly comprising or containing the letters AX, any such evidence is self-serving and unpersuasive. Opposer's record shows that Opposer has successfully taken action against other AX-containing

marks. Inasmuch as Opposer has elected to take no action against the remaining third-party registrations, it is because none of those remaining marks come nearly as close to the AX® Mark as Applicant's AXIO and Design, and the associated goods and services. That is, those other marks do not create a commercial impression similar to the AX® Mark. They might, for example, combine the word AX with a suffix or a letter that changes the commercial impression of the mark. Significantly, Applicant did not submit adequate evidence that such third-party marks are in use, and/or about the extent of such alleged concurrent use.

As explained earlier, third-party registrations are not evidence that the marks shown therein are in use, nor that the public is familiar with them. *Conde Naste Publ'ns, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 USPQ 422, 424-25 (CCPA 1975); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007). Thus, to the extent that Applicant might attempt to show that Opposer's use of its AX® Mark is not substantially exclusive, these registrations are not probative and this dilution factor favors Opposer.

With regard to the degree of recognition of Armani's famous AX® Mark, Opposer has submitted relevant evidence of advertising, press coverage, public recognition, celebrities' events, and social media following, that spans two decades or more. That it, the AX® Mark "is now primarily associated with the owner of the mark even when it is considered outside of the context of the owner's goods and services." *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180-81 (TTAB 2001)). Accordingly, the factor concerning the degree of recognition of the famous mark also favors a finding of dilution by blurring.

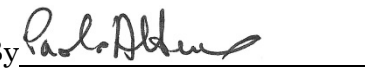
It follows that, as a whole, Applicant's AXIO and Design trademark is likely to dilute the distinctive quality of Opposer's famous AX® Mark.

CONCLUSION

For the foregoing reasons, the Opposition should be sustained on both grounds of likelihood of confusion and dilution by blurring. Accordingly, Opposer respectfully requests that the Board deny registration of Applicant's Mark in International Class 25.

Respectfully Submitted

Dated: September 14, 2021

By 

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CERTIFICATE OF SERVICE AND FILING

I hereby certify that a true and complete copy of the foregoing TRIAL BRIEF FOR OPPOSER, including any exhibits thereof, has been served on Applicant, via email at Applicant's counsel email address of record on September 14, 2021, as shown below:

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The undersigned further certifies that this document and its exhibits are being transmitted electronically to the Commissioner for Trademarks on September 14, 2021, by filing the same electronically at http://estta.uspto.gov/filing-type.jsp

By 

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