

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Trans Textiles Inc.

Serial No. 76/073,572

Myron Amer, P.C. for Trans Textiles Inc.

Sonya B. Stephens, Trademark Examining Attorney, Law Office  
108 (David Shallant, Managing Attorney).

Before Simms, Hairston and Bucher, Administrative Trademark  
Judges.

Opinion by Simms, Administrative Trademark Judge:

Trans Textiles Inc. (applicant), a New York  
corporation, has appealed from the final refusal of the  
Trademark Examining Attorney to register the mark VALENTINO  
CREATION ("CREATION" disclaimed) for sports shirts, tee  
shirts, sweat shirts, and pants.<sup>1</sup> Applicant and the  
Examining Attorney have filed briefs, but no oral argument  
was requested.

<sup>1</sup> Application Serial No. 76/073,572, filed June 19, 2000, based upon  
applicant's allegation of a bona fide intention to use the mark in  
commerce.

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We affirm.

The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d), on the basis of eight registrations, all now owned by the same entity, for various items of clothing and for related services. These are Registration No. 802,451, issued November 25, 1964 (renewed), for the mark valentino (lower case in script form) for brassieres; Registration No. 910,955, issued April 6, 1971 (renewed), for the mark VALENTINO for dresses, belts, gloves, scarves, swimwear and ties; Registration No. 916,465, issued July 13, 1971 (renewed), for the mark VALENTINO for fashion consultation services, namely, creating clothing, jewelry and accessory designs, and selection of designs, and materials for couture clientele; Registration No. 956,665, issued April 3, 1973 (renewed), for the mark VALENTINO for retail department store services; Registration No. 1,153,226, issued May 5, 1981 (renewed), for the mark VALENTINO for men's clothing, namely, suits, sport jackets, overcoats, shirts, trousers, Bermuda shorts, and bathing suits; Registration No. 1,268,029, issued February 21, 1984 (Sections 8 and 15 affidavit filed), for the mark valentino (lower case) for jumpers, sweaters, dresses, skirts, blouses, suits, jackets, coats, shirts, trousers, vests, jeans, slacks,

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shorts, swimwear, hats, lingerie, ties, belts, scarves, hosiery and gloves; Registration No. 1,268,030, issued February 21, 1984 (Sections 8 and 15 affidavit filed), for the mark valentino (lower case) and "V" design for jumpers, sweaters, dresses, skirts, blouses, suits, jackets, coats, shirts, trousers, vests, jeans, slacks, shorts, swimwear, hats, lingerie, ties, belts, scarves, hosiery and gloves; and Registration No. 1,655,604, issued September 3, 1991 (Sections 8 and 15 affidavit filed), for the mark valentino (lower case) Miss V and V design for clothing, namely, skirts, dresses, suits, evening dresses and suits, jackets, coats, sweaters, slacks and blouses. According to the assignment records of this Office, all of these registrations are now owned by Valentino Globe B.V., a Netherlands corporation.

It is the applicant's position that VALENTINO is a mark in "common use" in the trade and that no one entity has the exclusive right to use this mark. Because of the numerous "uses" of this mark, applicant argues that the public distinguishes the various VALENTINO marks. Applicant has made of record a listing of several third-party registrations which contain the name VALENTINO, such as GIOVANNI VALENTINO, HUGO VALENTINO, VALENTINO GARAVANI V, and MARIO VALENTINO, as well as copies of a number of

third-party applications for various marks which include the name VALENTINO. Considered in its entirety, applicant argues that its mark VALENTINO CREATION differs in sound, meaning and appearance from the cited registered marks.

Applicant also argues that its goods are specifically different from the goods and services listed in the cited registrations. Finally, applicant points to what it contends are the careful, sophisticated purchasers of the respective goods and services.<sup>2</sup>

We agree, however, with the Examining Attorney's position that confusion is likely. In each of the cited registered marks, the name VALENTINO predominates, as it does in applicant's mark VALENTINO CREATION. As the Examining Attorney has pointed out, it is not improper to give less weight in the likelihood-of-confusion analysis to descriptive and disclaimed elements. We note, in this regard, that our principal reviewing court has indicated that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark,

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<sup>2</sup> While applicant argues in its brief that it was deprived of the opportunity to make various third-party registrations of record, applicant could have done so at any time during the prosecution of this appeal including after receipt of the final refusal, by submitting this evidence with a request for reconsideration within six months of the issuance of the final refusal. See Trademark Rule 2.64(b). See also *In re Duofold*, 184 USPQ 638, 641 (TTAB 1984).

provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark ...." 224 USPQ at 751. In this case, the word "CREATION" is descriptive of a characteristic or feature of clothing items and may be given less weight in the analysis.

With respect to applicant's goods and the goods listed in the cited registrations, some are virtually identical (sport shirts vs. shirts, pants vs. trousers) and others are closely related items of apparel. The Examining Attorney has also made of record third-party registrations showing the same mark registered for both items of clothing and retail store services. Applicant's goods are closely related to the fashion consulting and retail department store services listed in the cited registrations. Thus, we also find that applicant's mark for its items of clothing so resembles the registered service marks that confusion is likely.

Furthermore, there is no evidence that purchasers of the respective goods and services are or will be sophisticated. In fact, because neither the identification

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in applicant's application nor in registrant's registrations is limited as to nature of goods/services or class of purchasers, we must construe the goods and services broadly to include all types of such items of clothing and related services, and we must consider that they are being offered or sold in all normal channels of trade to all average purchasers of those goods and services. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

The existence of a few third-party registrations apparently held by different entities containing the name VALENTINO does not justify the registration of a confusingly similar mark. Those registrations are not evidence of use, what happens in the marketplace, or that the public is familiar with them. Suffice it to say that purchasers aware of registrant's VALENTINO clothing and related services who then encounter applicant's VALENTINO CREATION sports shirts, tee shirts, sweat shirts and pants are likely to believe that these goods come from or are sponsored or licensed by the same entity.

Decision: The refusal of registration is affirmed.