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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bon Voyage Inc.¹

Serial No. 78176021

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(Meryl Hershkowitz, Managing Attorney).

Before Chapman, Grendel and Drost, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On October 18, 2002, Bon Voyage Inc. (a New York
corporation) filed an application to register on the
Principal Register the mark DEJA VU in standard character
form for "women's wearing apparel, namely suits, jackets,

¹ Applicant submitted a photocopy of a New York Department of State "Certificate of Amendment of the Certificate of Incorporation of Bon Voyage Inc." changing the corporate name from Bon Voyage Inc. to Zani Group Inc. However, that document has not been recorded with the Assignment Branch of the USPTO. See Section 10 of the Trademark Act, 15 U.S.C. §1060. Accordingly, applicant's name in this application remains "Bon Voyage Inc."

blouses, skirts, trousers, shorts, dresses and women's sportswear namely suits, shirts, blouses, jackets, skirts, trousers, shorts, rompers and jumpsuits." The application includes the following statement: "'Déjà vu' is an expression from the French language and means 'Previously seen' or 'Already seen,'" and the application is based on applicant's claimed date of first use and first use in commerce of October 15, 2002.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its identified goods, so resembles the mark shown below



("creations" disclaimed) for "on-line retail services featuring women's lingerie and undergarments," as to be likely to cause confusion, mistake or deception.²

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant

² Registration No. 2582041, issued June 18, 2002.

to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to a consideration of applicant's goods and registrant's services. It is well settled that goods and/or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and/or services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods and/or services. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB

1991); and In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

Confusion in trade can occur from the use of similar marks for products on the one hand and for services involving those products on the other hand. See In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); Safety-Klean Corporation v. Dresser Industries, Inc., 518 F.2d 1399, 186 USPQ 476 (CCPA 1975); In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467 (TTAB 1988); and Steelcase Inc. v. Steelcare Inc., 219 USPQ 433 (TTAB 1983).

Of course, it has been repeatedly held that in determining the registrability of a mark, this Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration. 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 v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, applicant's goods are identified as "women's wearing apparel, namely suits, jackets, blouses, skirts, trousers, shorts, dresses and women's sportswear namely suits, shirts, blouses, jackets, skirts, trousers,

shorts, rompers and jumpsuits," while registrant's services are identified as "on-line retail services featuring women's lingerie and undergarments."

The use of similar marks on goods and in connection with services featuring those goods will generally result in consumer confusion as to the source or sponsorship of those goods and services. See *In re Hyper Shoppes (Ohio), Inc.*, supra; *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985); and *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986). The fact that applicant's identification of goods does not specifically include the items "lingerie" and "undergarments" which are the featured items in registrant's identified online retail services does not mean that the goods and services are not related. Clearly, lingerie and undergarments are clothing items. Various clothing items have been held to be related in the relevant sense. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992) (Court affirmed Board holding of likelihood of confusion between KangaROOS and a kangaroo design for clothing, namely, athletic shoes, sweatsuits and athletic shirts and KANGOL and a kangaroo design for golf shirts having collars); *General Shoe Corporation v. Hollywood-Maxwell Co.*, 277 F.2d

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169, 125 USPQ 442 (CCPA 1960) (Court affirmed Board holding of likelihood of confusion for the same mark INGENUE used on shoes and hosiery, and brassieres); In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991) (ESSENTIALS in stylized form for women's shoes against ESSENTIALS for women's clothing, namely, pants, blouses, shorts, and jackets); In re Apparel Ventures, Inc., 229 USPQ 225 (TTAB 1986) (SPARKS BY SASSAFRAS in stylized form for women's separates, namely blouses, skirts and sweaters against SPARKS in stylized form for shoes, boots and slippers); In re Pix of America, Inc., 225 USPQ 691 (TTAB 1985)(NEWPORTS for women's shoes against NEWPORT for outer shirts); In re Alfred Dunhill Limited, 224 USPQ 501 (TTAB 1984)(DUNHILL in stylized lettering for various items of men's clothing including belts against DUNHILL for shoes); and In re Kangaroos U.S.A., 223 USPQ 1025 (TTAB 1984) (BOOMERANG for athletic shoes against BOOMERANG and design for men's shirts).

Applicant's goods, women's clothing items, such as suits, jackets, blouses, skirts, and the like, are commercially closely related to the retail service of selling women's clothing items, including lingerie and undergarments, online. Thus, we find that applicant's goods and registrant's services are sufficiently related that their marketing under the same or similar marks would

result in source confusion on the part of the purchasing public. That is, applicant's identified women's clothing items and registrant's online retail services featuring lingerie and undergarments are related within the meaning of the Trademark Act. See *Hewlett-Packard Company v. Packard Press, Inc.*, 281 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").

Applicant's identification of goods is not limited as to trade channels and thus could be sold online which is where registrant's services are offered, as stated in registrant's identification of goods. There is no restriction in either identification as to purchasers. Thus, the respective goods and services, as identified, would be sold in the same or at least overlapping channels of trade to the same or overlapping classes of purchasers.

Applicant's argument pointing out that applicant's goods and registrant's services are classified in different International Classes by the USPTO is unpersuasive. Classification is an administrative matter. See *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, footnote 5 (TTAB 1990).

We turn next to a consideration of applicant's mark and the cited registrant's mark. It is well settled that marks must be considered in their entireties as to the similarities and dissimilarities thereof. However, our primary reviewing Court has held that in articulating reasons for reaching a conclusion on the question 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 or portion of a mark. That is, one feature of a mark may have more significance than another. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); and *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

Applicant's mark is "DEJA VU" and that is the dominant portion of registrant's mark. In registrant's mark, the word "creations," being a descriptive term in relation to women's clothing and the sale thereof, while not ignored in our consideration, is nonetheless of less trademark significance to consumers. The initials DV (in stylized lettering) appearing in registrant's mark may be perceived by consumers as the acronym or initials used to refer to the wording "deja vu," particularly as they are capitalized

and written in the same lettering both as the initials and as the initial capital letters in the words. In addition, the Examining Attorney submitted evidence that clothing designers sometimes include initials in their brands (e.g., "CK by Calvin Klein").

In terms of the similarities of the marks, applicant's arguments regarding each specific difference between the marks are not persuasive. The initials DV and the stylized lettering of the letters and words in registrant's mark, do not offer sufficient differences to create a separate and distinct commercial impression. See *In re Dixie Restaurants Inc.*, supra. It is the dominant word, DEJA VU, not the stylized lettering nor the initials nor the descriptive word "creations" in registrant's mark, that would be used to call for the involved goods and services.

Also, it is true that registrant's mark is in stylized lettering whereas applicant's mark is in standard character (typed) form. However, our primary reviewing Court, the Court of Appeals for the Federal Circuit, has stated that "the argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a *difference* cannot legally be asserted by that party."

Squirtco v. Tomy Corporation, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). (Emphasis in original.)

The connotation of the word "deja vu," which is defined in The American Heritage Dictionary (Fourth Edition 2000) as "n. 1. Psychology The illusion of having already experienced something actually being experienced for the first time. ...," is the same for both marks.³ This could include the connotation suggested by applicant (in relation to registrant's mark) that "deja vu" connotes "vintage clothing."

Moreover, the differences in the marks may not be recalled by purchasers seeing the marks at separate times. The emphasis in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered; that is, the purchaser's fallibility of memory over a period of time must be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23

³ The Board takes judicial notice of this dictionary definition. See *The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §704.12 (2d ed. rev. 2004).

USPQ2d 1735 (TTAB 1991), aff'd unpub'd (Fed. Cir., June 5, 1992).

When considered in their entirety, we find that the respective marks are similar in sound, appearance, connotation and commercial impression. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Applicant argued that other "du Pont factors to consider is [sic] the number and nature of similar marks in use on similar goods and the variety of goods on which a mark is or is not used. There are over 30 distinct uses of the phrase 'déjà vu' in the TARR [USPTO] archives."

(Brief, p. 6.)⁴ Applicant has combined two separate du Pont factors. As to the number and nature of similar marks in use on or in connection with similar goods and/or services, applicant referred only in the very broadest of terms to 30 records in the USPTO's system without providing proper copies thereof. The Board does not take judicial notice of applications (which have virtually no probative value) and/or of registrations (which have limited probative

⁴ See also, applicant's response dated September 16, 2003, unnumbered page 4. The Examining Attorney's "Objection to Applicant's Evidence Not Made of Record" (brief, unnumbered page 2) is overruled.

value). See *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); and *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974).

Most importantly, even if the 30 records are all third-party registrations and if they had been properly introduced into the record, registrations do not establish that the marks shown therein are in use, or that consumers are so familiar with them that they are able to distinguish among such marks. There is no evidence of record of any third-party registration, much less any use by any third party (including the cited registrant)⁵ of any mark including the word DEJA VU for clothing or retail services involving the sale of clothing.

As to the du Pont factor of the variety of goods/services on which a mark is or is not used, it does not relate to the variety of goods/services identified in myriad third-party registrations. Instead, this factor refers to the variety of goods/services on which a party uses its mark (e.g., a "house mark, 'family' mark, product mark"). There is no evidence of record that either applicant or registrant uses their respective marks as house marks/product marks.

⁵ Applicant refers to registrant's website (see e.g., brief, p. 5), but applicant did not submit any evidence thereof.

Applicant acknowledges that there is no evidence of record as to the following du Pont factors: (i) the conditions under which and the buyers to whom sales are made, (ii) fame, (iii) actual confusion, (iv) applicant's right to exclude others, (v) and extent of potential confusion. (Brief, p. 7.)

In view of the similarities of the marks, and the relatedness of the identified goods and services, with the same or overlapping channels of trade and purchasers, we find that applicant's mark for its identified goods is likely to cause confusion with the mark in the cited registration.

Although we have no doubt in this case, any doubt on the question of likelihood of confusion must be resolved against applicant as the newcomer and the newcomer has the opportunity to avoid confusion, and is obligated to do so. See TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and In re Hyper Shoppes (Ohio) Inc., supra.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.