

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Global Brand Holdings, LLC

Serial No. 78516081

Alisa Cahan and Louis S. Ederer of Arnold & Porter LLP for
Global Brand Holdings, LLC.

David C. I, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Bucher, Holtzman and Kuhlke, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Global Brand Holdings, LLC seeks registration on the
Principal Register of the mark **XOXO** for goods identified
in the application, as amended and divided, as follows:

"paper goods, namely envelopes, calendars,
gift wrapping paper, postcards, writing
pads, greeting cards and stationery" in
International Class 16.¹

¹ Application Serial No. 78516081 was filed on November 12, 2004 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. Additional goods in International Classes 11, 16, 24 and 27 contained in the application as originally filed have been divided out and placed into Application Serial No. 78977526.

This case is now before the board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). The Trademark Examining Attorney has found that applicant's mark, when used in connection with the identified goods, so resembles the mark

JERRI XOXO² for:

"bridal stationery and printed matter appropriate to bridal showers, the giving of gifts and preparation of weddings, in the nature of post cards, blank forms, thank you cards, invitations, greeting cards, announcement cards, gift cards, address books, address labels, agendas, anniversary books, appointment books, albums, blank note cards, memo pad, note paper, note pads, occasion cards, paper labels, printed invitations, scrapbook albums, scrapbook pages, stationary [sic], stationary [sic] writing paper and envelopes, wedding albums, wedding books, writing pads, writing paper, writing tablets, daily planners, date books, desk pads, desk top planners, diaries, portraits, engagement books, envelopes, stationery and printed poems" also in International Class 16,³

² While the database of the United States Patent and Trademark Office indicates that this is a typed drawing, applicant has correctly shown that registrant's drawing page contained a drawing that did not follow the rule of a typed drawing. However, irrespective of how registrant intended to present the drawing of its mark, this difference is in no way critical to our determination herein.

**Jerri
XOXO**

³ Registration No. 2921955 issued to Jerri & Company on February 1, 2005 based upon an application filed on September 5, 2002 claiming first use anywhere and first use in commerce at least as early as May 31, 2001.

as to be likely to cause confusion, to cause mistake or to deceive.

The Trademark Examining Attorney and applicant have fully briefed the case. We affirm the refusal to register.

In arguing for registrability, applicant contends that applicant's mark and the registered mark create different overall commercial impressions; that applicant's goods are different from registrant's goods; and that the respective goods will flow through different channels of trade.

By contrast, the Trademark Examining Attorney contends that the marks create the same commercial impression; that some of the goods are identical and the balance of the goods are related; and that the goods of applicant and of registrant have no limitations and could well move through the same channels of trade.

Likelihood of Confusion

We turn then to a consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *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 Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the relationship 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).

The goods

Applicant has argued throughout the prosecution of this application that while the International Class 16 products covered by these two marks may fall into the same general field, they are clearly different "product segments." Specifically, applicant points out that registrant has limited its goods to bridal and wedding printed materials whereas applicant is seeking protection for its mark in connection with general paper goods, calendars and the like - goods that, according to applicant, are not in any way related to the bridal industry.

However, while registrant has limited its paper goods and printed materials to bridal stationery, paper products related to bridal showers, weddings and gift giving,

applicant has placed no restrictions on the field of use for its paper goods. As noted by the Trademark Examining Attorney, likelihood of confusion is determined on the basis of the goods as they are identified in the application and in the registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Inasmuch as applicant's identification of goods is unlimited, it is presumed that the application encompasses all goods of the type described, including those enumerated in the registrant's more specific identification, that they move in all normal channels of trade and that they are available to all potential customers. TMEP § 1207.01(a)(iii). Accordingly, we presume that some of applicant's goods are legally identical to those of registrant, and the remaining items are related.

In support of its position that there is no likelihood of confusion, applicant also argues that this "application extends Applicant's **XOXO** mark into the paper goods

category, which is part of the natural expansion of the **XOXO** brand" (Applicant's reply brief, p. 4) from clothing, luggage, eyeglasses, jewelry, bedding and bath accessories. However, the concept of "expansion of trade" is generally addressed in the context of the issue of priority in an *inter partes* proceeding. This doctrine has a more limited application in an *ex parte* proceeding. That is, we look herein at the question of the relatedness of the goods (or services) identified in applicant's application and those in the cited registration based upon whether or not consumers are likely to believe that the goods (or services) emanate from a single source, rather than whether or not one merchant or manufacturer has expanded, or is likely to expand, its particular goods (or services) to include those of another. See *In re 1st USA Realty Professionals, Inc.*, _____USPQ2d_____, Serial No. 78553715 (TTAB August 7, 2007).

Hence, we find that this *du Pont* factor favors a finding of likelihood of confusion.

Channels of trade and standards of care

Applicant argues that according to registrant's website, www.bridalshowergames.net, **JERRI XOXO** bridal products are targeted directly to brides and the women who

host bridal showers. By contrast, applicant argues that its current lines of **XOXO** brand products (e.g., clothing, luggage, eyeglasses, jewelry, bedding, bath accessories, etc.) are sold to young fashion-conscious consumers through upscale retail outlets and department stores such as Bloomingdale's, Macy's and Nordstrom's, and that its line of paper products would be sold to these same consumers as well.

As much as applicant would have us pay heed to "the practicalities of the commercial world," we cannot resort to extrinsic evidence, such as registrant's website, in order to restrict registrant's customers or channels of distribution to registrant's using the Internet to target brides-to-be and the women who host bridal showers. Furthermore, there are no express limitations as to the types of retail outlets or trade channels where applicant's goods will be sold. Hence, we must presume that these legally-identical goods will move in all normal channels of trade, including stationery stores, and that they will both be available to all classes of potential customers, including ordinary consumers. We assume these products are not expensive, and the ordinary consumers making these purchases will not exercise a high degree of care in

selecting these products. Accordingly, these related *du Pont* factors also support the position of the Trademark Examining Attorney herein.

The marks

Applicant argues that the single term **XOXO** is its house mark, while the dominant portion of registrant's **JERRI XOXO** mark is the name **JERRI** - the first word in the mark and registrant's trade name derived from the first name of a principal of registrant's business.

We find that as to connotation and commercial impression, the marks are similar inasmuch as the **XOXO** portion of registrant's mark is quite distinctive. While applicant's mark has some obvious differences from registrant's mark as to appearance and sound, the distinctive term **XOXO** is also a significant point of similarity between the marks in terms of sound and appearance. Furthermore, the term **JERRI** does not provide a distinguishing feature so much as it suggests a variant product line of the **XOXO** brand. To the extent that applicant is the junior user of its mark on International Class 16 goods, but may have a much larger retail presence than registrant, this may indeed be viewed as an example of potential "reverse confusion," as argued by the Trademark

Examining Attorney. That is a relevant factor in this case inasmuch as the involved goods are legally identical, and hence must be considered competitive, and we must also presume that the respective markets are overlapping, and are directed to the same classes of ordinary purchasers. See 3 J.T. McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* (4th Ed.) § 23:10. Accordingly, this *du Pont* factor supports a finding of likelihood of confusion.

Finally, applicant argues that during the prosecution of registrant's application, registrant argued that confusion did not exist between its mark and an **XOXO** mark for paper goods in an earlier-filed application owned by a third party. Nonetheless, we agree with the Trademark Examining Attorney that registrant's earlier arguments on this point are of little probative value in establishing the likelihood of confusion herein. Registrant's having taken this position is "merely illuminative of shade and tone in the total picture" herein. See *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151 (CCPA 1978). Moreover, the involved registration issued only after the cited application had abandoned. And even if it had registered over a potentially blocking registration, we would not be bound by that action.

Although consistency in examination is a goal of the Office, the decisions of previous Trademark Examining Attorneys are not binding on us, and we must decide each case based on the evidence presented in the record before us. *In re Nett Designs Inc.*, 57 USPQ2d 164 (Fed. Cir. 2001).

Conclusion:

In summary, we find that some of applicant's goods are legally identical to those of registrant, and the balance are related; that the respective goods will move in all normal channels of trade and that they will both be available to the same classes of ordinary consumers; and that the marks are similar as to sound, appearance, connotation and commercial impression.

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