

THIS OPINION
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THE T.T.A.B.

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re CHA Direct, Inc.

Serial No. 78664613

James E. Schlesinger of Schlesinger, Arkwright & Garvey,
L.L.P. for CHA Direct, Inc.

Michael Webster, Trademark Examining Attorney, Law Office
102 (Karen, Strzyz, Managing Attorney).

Before Hairston, Holtzman and Bergsman, Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

CHA Direct, Inc. ("applicant") filed an intent-to-use
application on the Principal Register for the mark TRES
JOLIE, in standard character format, for goods ultimately
identified as "ladies clothing, namely, sweaters, blouses,
jackets, pants and skirts," in Class 25. The English
translation of TRES JOLIE is "very pretty."¹

¹ During the prosecution of its application, applicant filed an
amendment to allege use, and amended its application to the
Supplemental Register.

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark is likely to cause confusion with the following marks (owned by the same registrant) both for "eyeglasses, sunglasses and eyeglass frames," in Class 9:

1. TRES JOLI;² and,
2. TRES JOLIE.³

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, 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*

² Registration No. 2239881, issued April 13, 1999 on the Supplemental Register; Section 8 affidavit accepted. The registration includes the statement that TRES JOLI means "very pretty, very pleasing or very neat."

³ Registration No. 3015549, issued November 15, 2005 under the provisions of Section 2(f). The registration includes the statement that TRES JOLIE means "very pretty, very pleasing or very neat."

Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

A. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, *supra*. Applicant's mark TRES JOLIE is identical to the registered mark TRES JOLIE and virtually identical the registered mark TRES JOLI. Moreover, we note that both applicant and the registrant translated TRES JOLIE (and TRES JOLI) to mean very pretty. In view thereof, we find that the identity of the marks weighs strongly in favor of finding that there is a likelihood of confusion.

B. The similarity or dissimilarity and nature of the goods and services.

Applicant is seeking to register its mark for ladies clothing and the registrant's marks are registered for eyeglasses, sunglasses and eyeglass frames.

We begin our consideration of the respective goods with the premise that, because the marks at issue are identical, the extent to which the goods of applicant and registrant must be related to support a finding of likelihood of confusion is lessened. See *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *In re Concordia Int'l Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983). It is only necessary that there be a viable relationship between the two to support a finding of likelihood of confusion. *In re Concordia Int'l Forwarding Corp.*, 222 USPQ at 356. Further, it is a general rule that goods and services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances which could give rise, because of the marks used therewith, 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 each party's goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein; and *Time Warner*

Entertainment Co. v. Jones, 65 USPQ2d 1650, 1661 (TTAB 2002).

The Examining Attorney submitted 32 third-party registrations, based on use in commerce, that include both clothing and eyeglasses or sunglasses.⁴ "Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source." *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). See also *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993).

Also, the Examining Attorney submitted excerpts from numerous websites showing that the women's clothing and eyeglasses and sunglasses were manufactured or branded by a single source. A representative sample of the excerpts include the following:

⁴ Registration No. 3041039 for the mark LUCKY BRAND JEANS is registered for retail store services featuring a wide variety of products including clothing and sunglasses. Thus, while it does not necessarily suggest that clothing and eyeglasses and sunglasses may emanate from a single source, it suggests that those products may be sold by the same retailer.

1. JUST CAVELLI women's clothing and eyewear (couture.zappos.com);
2. MARC by Marc Jacobs women's shoes and eyewear (couture.zappos.com);
3. GIORGIO ARMANI women's apparel and sunglasses (bergdorfgoodman.com);
4. DIOR apparel and sunglasses (bergdorfgoodman.com); and,
5. D&G DOLCE & GABBANA apparel and sunglasses (neimanmarcus.com).

Applicant argues that the third-party registrations should not be given any probative value because many of the registrations are house marks or designer marks that are commonly applied to many different types of goods and services; and therefore, according to applicant, because neither applicant's, nor registrant's marks are designer or house marks, consumers would not be predisposed to encounter the marks on multiple products.⁵ We are not persuaded by applicant's argument. First, not all of the third-party registrations were designer or house marks. Second, as demonstrated by the websites that have been made of record, women's clothing and sunglasses are products that are generally labeled with designer and house marks. The websites submitted by the Examining Attorney show that designer and house marks are commonly placed on sunglasses

⁵ Applicant's Brief, pp. 10-12.

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and women's clothing. In fact, the websites indicate that clothing and sunglasses may be complementary products in that women may purchase sunglasses or eyeglasses as a fashion accessory. Accordingly, consumers would expect that women's clothing and sunglasses identified by the same mark emanate from a single source.

Also, applicant relies on *In re application of Visibilia S.r.l.* (S.N. 74310112) (TTAB Oct. 21, 1994, unpublished) and *Remington Licensing Corp. v. Gregory Dean Shideler* (S.N. 73690909) (TTAB July 7, 1995, unpublished) for the proposition that clothing and eyewear are unrelated products. However, applicant's reliance on these cases is misplaced. First, the issue of likelihood of confusion is determined "from the probative facts in evidence. As so often said, each case must be decided on its own facts." *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567.

To the extent that prior cases have any relevance, the facts in those cases must be similar to the facts in the case before us. *Hyde Park Footwear Company, Inc. v. Hampshire-Designers, Inc.*, 197 USPQ 639, 641 (TTAB 1977) ("It follows that, to the extent that a prior decision relied upon by opposer under the doctrine of stare decisis depended for its conclusion upon particular facts that are not duplicated in the instant proceeding, the prior

decision is irrelevant to the matter in hand"). See also *Playboy of Miami, Inc. v. John B. Stetson Co.*, 426 F.2d 394, 165 USPQ 686, 687 (CCPA 1970) (the Board improperly relied on a line of cases in which the facts differed); *Merritt Foods Company v. Americana Submarine*, 209 USPQ 591 597 (TTAB 1980).

In the *Visibilia* appeal, the Examining Attorney submitted third-party registrations based on Section 44 of the Trademark, not use in commerce. The Board held that the third-party registrations based on Section 44 of the Trademark Act, and not use in commerce, were incompetent to establish that clothing and eyeglasses were associated with a single source. Thus, based on the record, there was no evidence that clothing and eyeglasses were related.

Likewise, in the *Remington* opposition, "[n]o testimony or evidence is cited to support a finding in the present case that these particular goods [opposer's clothing and applicant's umbrellas, eyeglasses and sunglasses] are sufficiently related for purposes of likelihood of confusion." *Remington Licensing Corp. v. Gregory Dean Shideler*, p. 16.

In view of the foregoing, we find that the similarity and nature of the goods weigh in favor of finding that there is a likelihood of confusion.

C. The similarity or dissimilarity of likely-to-continue trade channels and classes of consumers.

Because there are no limitations as to channels of trade or classes of purchasers in either the application or the registrations, it is presumed that the registrations and the application encompass all of the goods of the type described in the description of goods, that the goods so identified move in all channels of trade normal for those goods, and that the products are available to all classes of purchasers for the listed products. *See In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 211 USPQ 639, 640 (TTAB 1981).

The website evidence submitted by the Examining Attorney shows that the same retailers sell both clothing, on the one hand, and eyeglasses and sunglasses, on the other. For example:

1. Bergdorf Goodman advertises GIORGIO ARMANI and DIOR apparel and sunglasses on the same web pages (bergdorfgoodman.com);
2. The DA Designers Apparel website (designersapparel.com) advertises GIORGIO ARMANI sunglasses and apparel on the same web page;
3. Neiman Marcus advertises D&G DOLCE & GABBANA, PRADA, JUICY COUTURE, VALENTINO, VERSACE, YVES SAINT LAURANT and FENDI apparel and sunglasses on different web pages. However, it advertises MISSIONI and ROBERTO CAVALLI apparel and sunglasses on the same webpage (niemanmarcus.com);

4. The GUESS website (shop.guess.com) advertises clothing and sunglasses on different web pages; and,
5. The RALPH LAUREN website (ralphlauren.com) advertises clothing and sunglasses on different web pages.

As indicated above, clothing and eyeglasses and sunglasses may be complementary products that are purchased by the same consumers, as part of a coordinated outfit, in a single shopping trip, from the same retailer. See *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991).

Accordingly, we find that the channels of trade and classes of consumers are factors that weigh in favor of finding a likelihood of confusion.

- D. The conditions under which and buyers to whom sales are made (i.e., impulse vs. careful, sophisticated purchasing).

Applicant contends, without any evidentiary support, that purchasers of clothing and eyeglasses and sunglasses are "sophisticated purchasers," and that they are not inclined to make impulse purchases.

Inherent in the very nature of purchasing clothing, as well as eyewear, is to examine the goods closely and try them on, making sure they fit on one's body and face, respectively. There is no eyewear retailer without a mirror and no clothing retailer without a dressing room.⁶

⁶ Applicant's Brief, p. 13.

Also, applicant asserts that eyeglasses and sunglasses are expensive and essentially custom made or fitted for the purchaser.⁷

As we indicated above, there are no restrictions or limitations in the description of applicant's goods or the goods in the cited registrations. Therefore the description of goods in the application and the registrations are broad enough to encompass inexpensive clothing, eyeglasses and sunglasses which may be sold in discount stores to consumers who may not exercise a high degree of care. Accordingly, the conditions under which sales are made is a likelihood of confusion factor that weighs in favor of finding that there is a likelihood of confusion.

E. The strength of the registered marks.

Applicant contends that the marks TRES JOLIE and TRES JOLI (translated into English as "very pretty") are descriptive or laudatory terms, and therefore they are entitled to a narrow scope of protection or exclusivity of use. In fact, applicant points out that Registration No. 3015549 for the mark TRES JOLIE is registered on the Principal Register under the provisions of Section 2(f) and

⁷ Applicant's Brief, p. 14.

that Registration No. 2239881 for the mark TRES JOLI is registered on the Supplemental Register, and therefore, according to applicant, the registrant has conceded that the marks are descriptive.⁸

TRES JOLI and TRES JOLIE are laudatory terms. The registration of TRES JOLI on the Supplemental Register is an admission that the term is descriptive.⁹ *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972); *In re Consolidated Foods Corp.*, 200 USPQ 477, 478 n.1 (TTAB 1978). On the other hand, the registration of TRES JOLIE on the Principal Register is *prima facie* evidence of the validity, or distinctiveness of

⁸ We note that applicant is not attacking the validity of the registered marks. It is arguing that the registered marks are weak, and therefore entitled to only a narrow scope of protection or exclusivity of use.

⁹ Applicant also contends that the filing of an application under the provisions of Section 2(f) is an admission that the mark is not inherently distinctive. (Applicant's Brief, pp. 4-5). See also *Yamaha International v. Hoshino Gakki*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (when application is initially filed or subsequently amended to Section 2(f), descriptiveness is conceded); *In re Cabot Corp.*, 15 USPQ2d 1224, 1229 (TTAB 1990). However, an applicant may argue the merits of an examining attorney's refusal and, in the alternative, claim that the matter sought to be registered has acquired distinctiveness under §2(f). Unlike the situation in which an applicant initially seeks registration under §2(f) or amends its application without objection, the alternative claim does not constitute a concession that the matter sought to be registered is not inherently distinctive. See *In re E S Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992); *In re Professional Learning Centers, Inc.*, 230 USPQ 70, 71 n.2 (TTAB 1986). Because the prosecution history of the TRES JOLIE registration (Registration No. 3015549) has not been made of record, we cannot draw any inferences from the fact that it was registered under the provisions of Section 2(f).

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the registered mark, and that presumption applies even though the mark is registered under the provisions of Section 2(f). Moreover, so long as the cited registrations are valid, we are obligated to determine the issue of likelihood of confusion by analyzing the *du Pont* factors while keeping in mind that the level of descriptiveness may influence our conclusion as to whether confusion is likely. *See In re Smith and Mehaffey*, 31 USPQ2d 1531, 1533 (TTAB 1994).

In support of its argument that TRES JOLIE is a weak mark that is entitled to a narrow scope of protection, applicant submitted a copy of the following items:

1. Application Serial No. 77369548 for the mark "Tres Jolie" and design for "hair combs," "comb cases," "combs" and "hairbrushes";
2. Registration No. 3352433 for the mark TRÈS JOLIE DAY SPA LLC EXPERIENCE THE DIFFERENCE and design for "health spa services, namely, cosmetic body care services"; and,
3. Application Serial No. 77097615 (now Registration No. 3400809) for the mark TRES JOLIE and design, shown below, owned by applicant, for "ladies jackets, pants, shirts, sweaters, dresses and skirts."



With respect to the third-party application and registration, it is the evidence of third-party use, not registration that is relevant to show that a mark is weak.¹⁰ *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). Applicant has submitted no evidence that either "Tres Jolie" and design for "hair combs," "comb cases," "combs" and "hairbrushes" (Serial No. 77369548) or TRÈS JOLIE DAY SPA LLC EXPERIENCE THE DIFFERENCE and design for "health spa services, namely, cosmetic body care services" (Registration No. 3352433) are actually used by third parties, that they are promoted or that they are recognized by consumers. "[W]here the record includes no evidence about the extent of [third-party] uses . . . [t]he probative value of this evidence is thus minimal." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 73 USPQ2d at 1693, quoting *Han Beauty, Inc. v. Alberto-culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1561 (Fed. Cir. 2001) (emphasis in the original).

With respect to applicant's registration for the mark TRES JOLIE and design set forth above, we readily admit that it is troublesome to refuse registration when

¹⁰ In any event, a pending application is evidence only that the application was filed on a certain date. It is not evidence of use of the mark. See *Nike, Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007).

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applicant already owns a registration for a similar mark for identical goods. However, in Registration No. 3400809, applicant disclaimed the exclusive right to use "Tres Jolie." In view of the disclaimer and applicant's contention that the term "Tres Jolie" is descriptive, the design portion of the mark may be treated as the dominant portion of the mark. *In re National 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 the mark, provided the ultimate conclusion rests on consideration of the marks in their entireties"). Thus, applicant's two TRES JOLIE marks are different.

In any event, each case must be decided on its own merits based on the evidence of record. *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567; *In re Sunmarks Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994).

We obviously are not privy to the record in the files of the registered marks and, in any event, the issuance of a registration(s) by an Examining Attorney cannot control the results of another case.

In re Sunmarks Inc., 32 USPQ2d at 1472. See also *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had

some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court. . . . the Board . . . must assess each mark on the record of public perception submitted with each application").

Because the term TRES JOLIE is a laudatory term, we find that the relative weakness of the mark is a factor that weighs against finding that there is a likelihood of confusion.

F. Balancing the factors.

Even though the registered marks may be weak, they are still entitled to protection against the registration of the same or similar marks for related goods. *King-Kup Candies, Inc. v. King Candy Co.*, 288 F.2d 944, 129 USPQ 272, 273 (CCPA 1961); *Maybelline Company v. Matney*, 194 USPQ 438, 440 (TTAB 1977). Therefore, in view of the identity of the marks, and the similarity of the goods, and the identity of the channels of trade and classes of consumers, we find that applicant's mark TRES JOLIE for "ladies clothing, namely, sweaters, blouses, jackets, pants and skirts" is likely to cause confusion with the marks TRES JOLI and TRES JOLIE both for "eyeglasses, sunglasses and eyeglass frames."

Decision: The refusal to register is affirmed.