

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Mailed: October 29, 2002
Paper No. 22
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

GA Modefine S.A.
v.
Esportia International Ltd.

Opposition No. 117,002
to application Serial No. 75/746,391
filed on July 1, 1999

Anthony F. Lo Cicero and Denise A. Lindenauer of Amster,
Rothstein & Ebenstein for GA Modefine S.A.

David J. Cartano of Barton, Klugman & Oetting LLP. for
Esportia International Ltd.

Before Seeherman, Hanak and Hairston, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Esportia International Ltd. has filed an application to
register the mark U/X UNDERWEAR EXCHANGE for "men's, women's
and children's underwear, sleepwear and loungewear."¹

Registration has been opposed by GA Modefine S.A. on

¹ Serial No. 75/746,391 filed July 1, 1999, alleging first use
and first use in commerce on May 8, 1998. The word "UNDERWEAR"
has been disclaimed apart from the mark as shown.

Opposition No. 117,002

the ground of likelihood of confusion under Section 2(d) of the Trademark Act. Opposer alleges that since prior to applicant's date of first use, it has used "the marks 'AX ARMANI EXCHANGE' and 'AX' in combination with the word "EXCHANGE" in commerce in the United States on goods in the clothing field;" that it is the owner of Registration No. 1,756,717 for the mark "AX ARMANI EXCHANGE" for the following goods:

handbags, wallets, name card business cases, shoulder bags, fanny packs, backpacks, trunks, for travel, umbrellas and walking sticks in class 18; and work clothing; namely, overalls and coveralls, and clothing; namely, trousers, skirts, coats, overcoats, raincoats, jumpers, jackets, jeans, shorts, short jackets, shirts, sweaters, cardigan jackets, blouses, sport shirts, polo shirts, underwear, track suits, swimming suits, sweat shirts, sweat pants, pullovers, gloves, hosiery, neckties, hats and caps and shoes, sandals, boots and slippers in class 25;²

and that applicant's mark U/X UNDERWEAR EXCHANGE so resembles opposer's marks as to be likely to cause confusion, including causing purchasers to believe that applicant's goods originate with the designer Giorgio Armani.

Applicant, in its answer, denied the salient allegations of the notice of opposition.

² Issued March 9, 1993; affidavits under Sections 8 and 15 accepted and acknowledged, respectively.

Opposition No. 117,002

Before turning to the record and merits of the case, we must first discuss a preliminary matter. We note that opposer submitted under notice of reliance status and title copies of not only its pleaded registration for the mark AX ARMANI EXCHANGE, but several other registrations, including registrations for the marks ARMANI EXCHANGE and AX. However, opposer's testimony and other evidence focuses on opposer's use of the mark A/X ARMANI EXCHANGE (with the diagonal) for apparel and accessories. Moreover, it is this mark that both parties have discussed in their briefs on the case. In view thereof, we deem the notice of opposition amended pursuant to Fed. R. Civ. P. 15(b) to plead ownership of the mark A/X ARMANI EXCHANGE for apparel and accessories and a likelihood of confusion therewith.

The record consists of the pleadings; the file of the involved application; the testimony deposition (with exhibits) of opposer's witness Frank Riniti; and opposer's notice of reliance on status and title copies of its pleaded registration and several other registrations. Applicant did not take testimony or introduce any evidence on its behalf.³

³ We note that applicant attached to its brief on the case an exhibit which consists of magazine and newspaper articles discussing the retail store services and products offered under opposer's marks. Since opposer properly introduced these articles during the testimony of Mr. Riniti, they form part of the record in this case.

Opposition No. 117,002

Both parties filed briefs on the case, but an oral hearing was not requested.⁴

Opposer took the testimony of Frank Riniti, Senior Director of Store Development of Presidio, Inc. d/b/a A/X Armani Exchange (hereinafter A/X Armani Exchange). The record shows that A/X Armani Exchange, opposer's exclusive licensee, first used the mark A/X ARMANI EXCHANGE on T-shirts in 1995. From 1996 to 1997 use of the mark expanded to include polo shirts, crew shirts, v-neck shirts, jackets, jeans, boxer shorts and baseball caps. According to Mr. Riniti, the mark is currently in use on a wide variety of apparel and accessories, which are sold in approximately forty retail and outlet stores located throughout the United States, and through an Internet web site.⁵ Each of the stores bears the mark A/X ARMANI EXCHANGE. Mr. Riniti credited the fashion designer Giorgio Armani with the concept of the A/X ARMANI EXCHANGE retail stores. Mr. Armani has control over the design of the retail stores themselves and the clothing and accessories sold therein.

⁴ We note that applicant filed a "reply" brief on the case and opposer has filed a motion to strike the brief. As correctly pointed out by opposer, there is no provision in the Trademark Rules of Practice for the filing of a reply brief by the party in the position of the defendant in an opposition proceeding. TBMP §801.02(d). In view thereof, opposer's motion to strike the reply brief is granted and we have given it no consideration.

⁵ The sales and advertising figures have been made of record under seal. A review of the documents relative thereto show very large numbers in both categories.

Opposition No. 117,002

The A/X ARMANI EXCHANGE apparel and accessories are advertised by way of print media, mailers, billboards, transit shelters, taxi tops, and magazines, such as Vogue, In Style, Marie Claire, Details, and Interview. In addition, the products are promoted at special events at the A/X ARMANI EXCHANGE retail stores. As evidenced by the magazine and newspaper articles introduced during Mr. Riniti's testimony, the openings of the various store locations and the products sold therein have received much press coverage.

We have little information about applicant inasmuch as applicant failed to take testimony or introduce any other evidence in this case.

Inasmuch as the mark A/X ARMANI EXCHANGE for apparel and accessories is the most pertinent of opposer's marks in this case, and indeed it the mark opposer has focused on, we will determine the issue of likelihood of confusion vis-à-vis this mark and applicant's mark U/X UNDERWEAR EXCHANGE for underwear, sleepwear, and loungewear.

Turning first to the issue of priority, the record shows that opposer's licensee A/X Armani Exchange first used the mark A/X ARMANI EXCHANGE on T-shirts as early as 1995, followed by use on other clothing items, including underwear, in 1996 and 1997. This is prior to applicant's

Opposition No. 117,002

claimed date of first use of May 8, 1998. Thus, priority rests with opposer.

This brings us to the issue of likelihood of confusion. Our determination of likelihood of confusion under Section 2(d) of the Trademark Act must be based on an analysis of all the relevant and probative facts in evidence as they relate to the factors set out in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

We turn first to a consideration of the parties' goods. Applicant argues that there is no likelihood of confusion because the parties "use different marketing strategies," i.e., opposer has nationwide retail outlets whereas applicant sells strictly on a wholesale basis. In addition, applicant argues that opposer "does not focus its sales on one or two items" as does applicant, but instead "sells a wide range of consumer items." (Brief, p. 8).

As often stated, it is not necessary that the goods be similar or competitive, or even that they move in the same channels of trade to support a holding a likelihood of confusion. It is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarities of the marks used therewith, give rise to the mistaken

Opposition No. 117,002

belief that they originate from or are in some way associated with the same producer. See: Hercules Inc. v. National Starch and Chemical Corp., 223 USPQ 1244, 1247 (TTAB 1984).

In this case, we recognize that at present the parties' goods are sold in different channels of trade. The record shows that opposer's licensee sells its goods only at A/X ARMANI EXCHANGE retail and outlet stores and through the A/X ARMANI EXCHANGE web site. Nonetheless, the parties' goods are ultimately sold to the same class of purchasers, namely, the general public. Because consumers normally shop at more than one retail store, they are likely to encounter both parties' goods. Further, consumers may not know that opposer's trade channels are currently limited, and may therefore believe, upon encountering applicant's goods in various retail outlets, that the goods emanate from opposer.

With respect to applicant's contention that opposer's licensee sells a wider range of goods than applicant, this is of no consequence in determining likelihood of confusion in this case. The fact remains that the parties sell clothing items that are identical (underwear) and otherwise closely related.

We turn next to a consideration of the marks. The test for confusingly similarity is not whether the marks can be distinguished when subjected to a side-by-side comparison,

Opposition No. 117,002

but rather whether the marks are sufficiently similar in terms of overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). The marks at issue may not be dissected but rather must be considered in their entireties. However, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, "when marks would appear on virtually identical goods or services, the degree of similarity 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 (Fed. Cir. 1992).

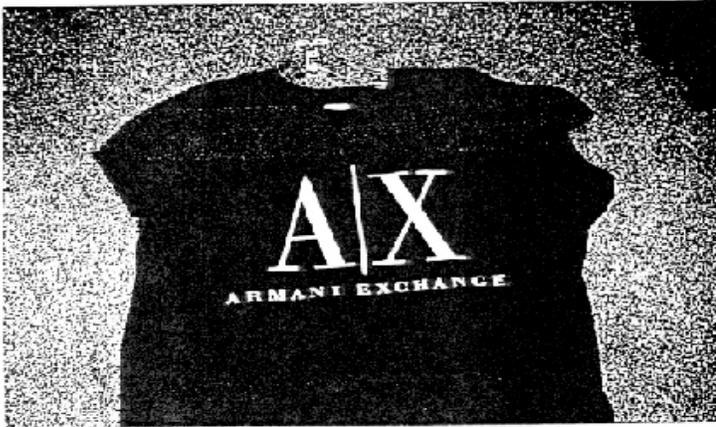
Applying the above principles to the marks at issue, we find that applicant's mark U/X UNDERWEAR EXCHANGE and opposer's mark A/X ARMANI EXCHANGE are substantially similar in commercial impression, sound and connotation. The marks follow the same pattern - a phrase beginning with two letters separated by a "/" and ending in the letter "X";

Opposition No. 117,002

followed by a three syllable word; and ending with the word "EXCHANGE." Further, opposer's A/X ARMANI EXCHANGE mark is inherently distinctive, and the evidence of record indicates that opposer's use and promotion of the mark for apparel has been extensive, with the result that the mark has acquired considerable goodwill and strength. Thus, opposer's mark is entitled to a broad scope of protection. As to applicant's argument in its brief that marks including the word "EXCHANGE" are weak marks, applicant offered no evidence of third-party uses of marks that include the word "EXCHANGE."

Finally, although there is no evidence in the record concerning applicant's intent in adopting its mark, we believe that applicant's choice to depict its mark in a manner and script very similar to that used by opposer's licensee sheds some light on applicant's intentions. See *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984) ["there is ... no excuse for even approaching the well-known trademark of a competitor, but to do so raises 'but one inference-- that of gaining advantage from the wide reputation established by the [the prior user] in the [goods] bearing the mark' ..."]. Reproduced below are examples of opposer's mark as used on the front of a T-shirt and applicant's mark as used on a label.

Opposer's mark



Applicant's mark

U / X
UNDERWEAR EXCHANGE

In view of the foregoing, we conclude that purchasers familiar with opposer's apparel, including underwear, offered under the mark A/X ARMANI EXCHANGE would be likely to believe, upon encountering applicant's mark U/X UNDERWEAR EXCHANGE for underwear, sleepwear and loungewear, that the goods originate with or are somehow associated with or sponsored by the same entity. In particular, purchasers may well believe that opposer has expanded its line of apparel and is now offering underwear, sleepwear and loungewear under the mark U/X UNDERWEAR EXCHANGE.

Opposition No. 117,002

Decision: The opposition is sustained.