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A PRECEDENT OF
THE TTAB

Hearing: November 2, 2006

Mailed: May 15, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Yves Saint Laurent Fashion B.V. and Luxury
Goods International (LGI) S.A.¹

v.

Goldfinger Hawaii, Inc.

Opposition No. 91118017

Jess M. Collen and Thomas P. Gulick of Collen IP for Yves Saint
Laurent Fashion B.V. and Luxury Goods International (LGI) S.A.

Michael A. Painter of Isaacman, Kaufman & Painter for Goldfinger
Hawaii, Inc.

Before Seeherman, Holtzman and Kuhlke, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Goldfinger, Hawaii, Inc. (applicant) has filed an
application to register the mark shown below for "men's and
women's fine jewelry" in Class 14.²

¹ Luxury Goods International (LGI) S.A. was joined as plaintiff in this proceeding on July 6, 2005 in view of the assignment of opposer's pleaded registrations.

² Application Serial No. 75555847, filed September 21, 1998, based on an allegation of first use and first use in commerce on September 12, 1994. The application includes a claim of ownership of Registration No. 1423791 for the mark SL (in typed form) for "jewelry."



Yves Saint Laurent Fashion B.V. (opposer or Yves Saint Laurent) filed a notice of opposition on the ground of priority and likelihood of confusion.³ Opposer alleges that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered "YSL" marks as to be likely to cause confusion. Opposer identifies these registrations as Registration No. 1712999 for the mark YSL, in typed form, for "jewelry, clocks and watches" in Class 14; and Registration No. 1711127 for the mark shown below for "jewelry, clocks and watches" in class 14.



³ To the extent that opposer intended to assert dilution as a separate ground for opposition, the claim is neither clearly nor sufficiently pleaded. Moreover, opposer has not argued dilution as a separate claim in its brief but only mentions dilution in passing in its discussion of likelihood of confusion. Accordingly, we treat the references to dilution in the pleading and in the brief as part of opposer's likelihood of confusion claim and we consider likelihood of confusion as the sole ground for opposition.

Applicant, in its answer, has admitted that opposer is the owner of the above registrations. Applicant has also admitted paragraph 6 of the notice of opposition which asserts that "there is no issue as to priority" in view of the above registrations. Applicant has denied the remaining salient allegations.

The record includes the pleadings; the file of the involved applications; and opposer's notice of reliance on evidence including applicant's responses to interrogatories along with documents provided as part of those responses.⁴ Opposer also introduced, by stipulation of the parties, testimony in the form of declarations (with exhibits) of Adelio Lardi, opposer's member and secretary of the board of directors; and Stefano Savoldi, opposer's director.⁵

Applicant did not take any testimony or offer any other evidence in its own behalf. Only opposer filed a brief and attended the oral hearing.

Findings of Fact

The designation YSL is a fashion brand associated with the French designer and fashion house, Yves Saint Laurent. The Yves Saint Laurent fashion house was established in 1962. The YVES SAINT LAURENT mark has been used in connection with fashion

⁴ Opposer included with its notice of reliance plain copies of a number of registrations for "YSL" marks. Because, to make registrations of record by notice of reliance, status and title copies must be submitted, we have given no consideration to these plain copies. See Trademark Rule 2.122(d) (2).

⁵ The two witnesses have given essentially the same testimony.

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products in the United States for more than 40 years, and Yves Saint Laurent fashion designs are featured in the Metropolitan Museum of Art in New York.

Opposer began selling apparel under the mark YSL in the United States in 1964, and has continued to do so since that date. Opposer has been selling jewelry and other fashion accessories such as sunglasses, handbags and belts under the YSL mark in the United States since 1968. Opposer's jewelry and other fashion products are sold in retail stores throughout the country, including Bergdorf Goodman, Saks Fifth Avenue and Neiman Marcus; as well as in opposer's own Yves Saint Laurent Boutiques.

The YSL mark is displayed on the products and on packaging for the products. The initials appear prominently on jewelry items such as bracelets, necklaces and watches, in a variety of styles and formats, including the stylized form shown in opposer's registration. There is no specific testimony relating to first use, or the extent of use, of the YSL mark in any particular format.

Opposer has advertised and promoted its apparel and fashion accessories under the YSL mark through catalogs and in a variety of consumer fashion magazines such as W, Vogue, Women's Wear Daily, GQ, and Mirabella. Opposer submitted sales and advertising figures for "YSL" products for the years 2001 to

2004. While the specific figures are confidential, we can say that such figures are substantial.⁶

The YSL mark has received considerable media publicity. For example, an article in Bazaar Magazine (September 1987) entitled "The YSL Revolution" refers to YSL as a "key symbol of New York's headiest time" and it describes the Yves Saint Laurent form of evening dress as "so indelibly stamped with his initials." In 2002, alone, the YSL designation appeared on the covers of 128 magazines as the subject of featured articles in the magazines. The notoriety of the YSL mark is also reflected in widely circulated newspapers such as The New York Times, The Wall Street Journal, The Washington Post, Chicago Tribune and The Miami Herald, containing references to YSL as both the Yves Saint Laurent fashion house and a brand name in fashion. For example, an article in The Wall Street Journal (January 9, 2002) entitled "All About Yves," in discussing Yves Saint Laurent's historical contributions to fashion, notes that in 1966, mass-produced licensed products "using the famous YSL initials began to appear everywhere." An article in The New York Times (March 14, 2004) under the headline "Pops Culture" states "Take Morty Seinfeld as your fashion muse. ... Accessorize with YSL's jumbo, geriatric sunglasses..."

⁶ Although both Mr. Lardi and Mr. Savoldi identified the relevant time period as 1999-2004, it appears from the supporting documents that the actual time period covered is 2001-2004. Whichever time period is considered, however, the figures are substantial.

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The only information we have about applicant is from the discovery responses made of record by opposer. Based on those responses, applicant has used the mark in connection with jewelry at least since 1994. Applicant's jewelry includes black pearls, and 14K and 24K gold pendants, bracelets and necklaces. Applicant adopted the mark SL to reflect the initials of applicant's primary division and the president and owner of applicant, Steven Lee. Applicant applies its mark to packaging for the jewelry, and its jewelry is sold in retail jewelry stores in at least 40 states. Applicant advertises its jewelry in newspapers and on its website, www.stevenlee.net. Applicant spends approximately \$10,000 a year on advertising; and has an annual volume of sales of approximately \$1 million.

Standing and Priority

As previously noted, opposer attempted to introduce plain copies of its two pleaded registrations (Nos. 1712999 and 1711127) by a notice of reliance. This type of document does not constitute a proper status and title record as contemplated by Trademark Rule 2.122(d). Opposer also submitted TARR printouts of the registrations through the testimony of Mr. Lardi and Mr. Savoldi. However, although opposer's witnesses testified that opposer is the owner of the registrations, they did not testify as to the validity of the registrations. Thus, the testimony was insufficient to show that opposer is the owner of currently existing registrations. Nevertheless, applicant admitted in its

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answer that opposer is the owner of and has priority based on these registrations, and therefore we have given these registrations full effect.⁷ Registration No. 1712999 is for the mark YSL in typed form;⁸ and Registration No. 1711127 is for the mark shown below:⁹



Both registrations identify the following goods:

Keyholders and metal pillboxes (in Class 6).

Sunglasses, optical frames and cases for glasses (in Class 9).

Jewelry, clocks and watches (in Class 14).

Stationery, pens, pencils and playing cards (in Class 16).

Handbags, luggage, tote bags, briefcases, wallets, billfolds, change purses, and key fobs (in Class 18).

Handkerchiefs (in Class 24).

Women's and girls' apparel; namely, dresses, gowns, skirts, slacks, pants, suits, blouses, shirts, sweaters, jeans, neckwear, scarves, belts, sleepwear, underwear, lingerie,

⁷ Opposer has also attempted to introduce, in the same improper manner, several registrations which were not pleaded in the notice of opposition. Opposer did not amend the pleading to assert these registrations, and there are no admissions in the answer as to these registrations. Accordingly, these unpleaded registrations have been given no consideration.

⁸ Issued September 8, 1992 under Section 44(e) of the Trademark Act based on a Benelux registration; renewed as to the above classes; not renewed as to Classes 8, 20, 21 and 28.

⁹ Issued September 1, 1992 under Section 44(e) of the Trademark Act based on a Benelux registration; renewed as to the above classes; not renewed as to Classes 8, 20, 21 and 28.

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robes, camisoles, slippers, brassieres, robes, swimwear, beach cover-ups, shoes, slippers, sandals, boots, gloves, hosiery, tights, coats, raincoats, jackets, capes, shawls, fur muffs and headwear; men's and boys apparel; namely, outercoats, raincoats, blazers, sportcoats, vests, suits, pants, jackets, tuxedos, shirts, jeans, sweaters, neckwear, pocket squares, pajamas, night shirts, robes, bath wraps, shoes, sandals, slippers, hosiery, socks, gloves, scarves, hats, swimwear, belts and suspenders (in Class 25).

Cigarette cases not of precious metal, cigar cutters and lighters (in Class 34).

Thus, opposer's standing has been established, and its priority with respect to the registered marks for the goods identified in those registrations is not in issue. King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of confusion

Our determination 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 likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

In our analysis we will focus on opposer's registered mark and class of goods which can be considered closest to the mark and goods in the subject application, namely Registration No.

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1711127 for the mark YSL in stylized form for "jewelry, clocks and watches."

We turn first to the goods, keeping in mind that the question of likelihood of confusion is determined on the basis of the identification of goods set forth in the application and registration, without limitations or restrictions as to the actual nature of the goods, their channels of trade and/or classes of purchasers that are not reflected therein. See *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 Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

Applicant's goods are "men's and women's fine jewelry." Opposer's broadly identified "jewelry" fully encompasses the "fine jewelry" identified in the application. Thus, the respective goods are in part legally identical. Because there are no restrictions as to the channels of trade for the goods or their classes of purchasers, the goods must be deemed to be sold in the same channels of trade and directed to the same purchasers. See *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

The channels of trade for fine jewelry, as the evidence shows, include department stores and retail jewelry stores. We

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find that the purchasers for such goods would include ordinary consumers as well as discriminating consumers. We have no information regarding the retail pricing of opposer's jewelry. However, according to applicant's discovery responses, applicant's fine jewelry ranges in price from \$20 to \$10,000, although it is not clear what proportion of applicant's jewelry is sold at the lower price point. Purchasers of at least the lower cost items of jewelry are likely to be less careful in their purchasing decisions, and therefore more prone to confusion. However, even those purchasers of the more expensive, or very expensive, items of jewelry who may be considered "discriminating" and careful purchasers can be confused as to source under circumstances where identical goods are sold under similar marks. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49 (Fed. Cir. 1986).

Thus, we turn to a consideration of the marks, and first to the factor regarding the fame of opposer's YSL mark. We find, in view of the evidence of opposer's use of the mark for over 40 years, its substantial sales and advertising expenditures, the extensive media recognition and coverage of the mark, and the significant exposure of the mark to the public over the years, that opposer's YSL mark is strong and famous in the fashion field

and entitled to a broad scope of protection.¹⁰ We also note that there is no evidence in the record of any third-party use or registration of similar marks for similar goods.

We turn then to a comparison of applicant's stylized SL mark with opposer's stylized YSL mark, and a determination of the similarity or dissimilarity of the marks in their entirety. See *du Pont*, supra. See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The marks are shown below.



In analyzing composite letter marks, it is important to consider both the literal and visual elements of the marks. In *re Electrolyte Laboratories, Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) ("the nature of stylized letter marks is that they partake of both visual and oral indicia. ... [A] stylized letter design can not be treated simply as a word mark"). Where the letters are so highly stylized that the marks are essentially design marks incapable of being spoken, the decision would turn primarily on the basis of the visual

¹⁰ We have not considered the untimely evidence of opposer's asserted policing activities which was submitted for the first time with opposer's brief.

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similarity of the marks. See *Textron Inc. v. Maquinas Agricolas "Jacto" S.A.*, 215 USPQ 162 (TTAB 1982). That is not the situation here. In this case, the marks are easily recognizable as the letters YSL and SL, and the letters are essential features of each mark. Compare, e.g., *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 204 USPQ 697 (CCPA 1980); *In re Burndy Corporation*, 133 USPQ 196 (CCPA 1962); and *In re Johnson Products Co., Inc.*, 220 USPQ 539 (TTAB 1983). Thus, these marks are capable of being spoken, and when spoken, they are similar in sound. Applicant's mark SL contains two of the three letters in YSL and they are in the same sequence in both marks.

The visual similarity of these marks is striking. The marks contain two letters in common, S and L, the letters are in the same size and proportion to each other in both marks, and the arrangement of the letters, in vertical interlocking form, is essentially identical. The rectangular border in applicant's mark is an inconsequential difference. It is far overshadowed by the letters and their design which make the strongest commercial impact.

As to meaning, the marks may be perceived as merely a combination of arbitrary letters having no inherent meaning. As stated by the Court in *Dere v. Institute for Scientific Information, Inc.*, 420 F.2d 1068, 164 USPQ 347, 348 (CCPA 1970), "it is more difficult to remember a series of arbitrarily arranged letters than it is to remember figures, syllables, or

phrases," and further that "the difficulty of remembering such multiple-letter marks makes the likelihood of confusion between such marks, when similar, more probable." See also Weiss Associates Inc., supra at 1841. On the other hand, in view of the promotion of a close association of YSL with the name Yves Saint Laurent in opposer's product packaging and advertisements, and in media stories, purchasers may be aware of the derivation of YSL as the initials for the designer's name, Yves Saint Laurent. To the extent opposer's mark would have this meaning, the meaning of applicant's stylized SL mark would be similar, if not the same.¹¹ Because of the visual similarities of the marks, and considering the fame and recognition of YSL, applicant's SL mark, particularly in this format, may be perceived as simply a slightly different or more abbreviated version of opposer's stylized YSL mark, perhaps identifying a particular line of Yves Saint Laurent jewelry.

In view of the foregoing, we find that even careful purchasers when confronted with these highly similar marks on or in connection with identical goods are likely to be confused.¹²

¹¹ We note that applicant's mark is derived from the initials of its president and owner, Steven Lee. However, there is no evidence of record that consumers would be aware of Mr. Lee or otherwise associate the mark with his name.

¹² To the extent opposer is making the argument that applicant adopted its mark in bad faith, there is insufficient evidence to show or from which we can infer this. Mere knowledge of the existence of opposer's mark does not, by itself, constitute bad faith. See Action Temporary Services Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ2d 1307 (Fed. Cir. 1989). Opposer must show that applicant intentionally sought to trade on opposer's good will or reputation. See Big Blue Products Inc.

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Decision: The opposition is sustained.

v. International Business Machines Corp., 19 USPQ2d 1072 (TTAB 1991). While applicant indicated in its discovery responses that the letters SL were adopted to reflect its owner's name, there is no testimony or other evidence regarding applicant's intent in adopting the mark in its present form.