

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB**

Hearing:
October 19, 2002

Mailed:
February 24, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

PEI Licensing, Inc., substituted for Perry Ellis
International, Inc.

v.

Stacey L. Ellis

Opposition No. 91151870
to application Serial No. 76167306
filed on November 18, 2000

Kim Kolback of Sarah Steinbaum, P.A. for PEI Licensing, Inc.
Stacey L. Ellis, pro se.

Before Seeherman, Walters and Bottorff, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Stacey L. Ellis¹ has applied to register the mark ELLIS
BLACK, with the word BLACK disclaimed, for

Clothing, namely, shirts, tops, vests,
blouses, sweaters, sweatshirts, shorts,
skirts, pants, trousers, slacks,

¹ During the course of his testimony Mr. Ellis indicated that his company had been incorporated. However, no assignment of the application has been recorded, and we therefore continue to treat Mr. Ellis, an individual, as the owner of the involved application and the ELLIS BLACK mark.

overalls, jeans, sweatpants, dresses, footwear, socks, stockings, tights, pantyhose, coats, scarves, ties, suspenders, gloves, belts, handbags, purses, wallets slippers, backpacks, coats, jackets, parkas, underwear, lounging pants and taps, pajamas, long johns, robes, men's briefs and boxers, leather pants, leather coats, leather tops, leather skirts, leather dresses, leather vests, and uniforms, including uniform slacks, uniform shirts, uniform jackets, and uniform sweaters."²

On April 19, 2002 Perry Ellis International, Inc. filed a notice of opposition. On February 9, 2004, opposer filed a motion to substitute PEI Licensing, Inc. as opposer herein. Opposer has explained that on October 3, 2002 the U.S. Patent and Trademark Office recorded a document dated May 16, 2002 assigning "the family of Perry Ellis marks" from Perry Ellis International, Inc. to PEI Licensing, Inc. The Notice of Recordation of Assignment Document submitted by opposer indicates various applications and registrations for marks comprising or containing the words PERRY ELLIS. The record further shows that PEI Licensing, Inc. is a

² Application Serial No. 76167306, filed November 18, 2000, and asserting a bona fide intent to use the mark in commerce. It is noted that, although the identification of goods is for Class 25, "clothing, namely...", the specified items include goods which are classified in Class 18, e.g., handbags, purses, wallets and backpacks. In addition, these goods appear to be beyond the scope of the original identification of goods, which was "clothing." Accordingly, if applicant is ultimately successful in this proceeding, the file will be remanded to the Trademark Examining Attorney pursuant to Trademark Rule 2.131 to consider whether a requirement for an acceptable identification of goods should issue.

wholly-owned subsidiary of Perry Ellis International, Inc. In view of the transfer of ownership of the registrations and applications, the motion is granted and PEI Licensing, Inc. is hereby substituted as opposer in this proceeding.

As grounds for opposition, opposer has alleged ownership of a number of registrations and applications for "PERRY ELLIS" marks, including PERRY ELLIS and PERRY ELLIS AMERICA for various clothing items, and has further alleged that if applicant's mark were to be registered, it would likely be confused with opposer's registered marks and family of PERRY ELLIS marks, and because applicant's mark would result in niche market dilution of opposer's family of marks.

In his amended answer applicant has admitted that "opposer owns the following marks in class 025" and lists what it characterizes as fourteen registrations. However, it is noted that, although they were characterized as registrations in the notice of opposition, some of these "registrations" are identified by serial numbers and are, in fact, applications. The registrations are for PERRY ELLIS AMERICA,³ PERRY ELLIS⁴ and PERRY ELLIS PORTFOLIO.⁵ The applications are for PERRY ELLIS AMERICA,⁶ PERRY ELLIS

³ Registration No. 2323085; 2164539; 1395816;

⁴ Registration NO. 1428486; 1279975; 1249025; 1641343.

⁵ Registration No. 1905523.

⁶ Serial No. 75829600 and 76257368.

KHAKIS,⁷ PERRY ELLIS AMERICAN DENIM,⁸ PERRY ELLIS SOFTWARE⁹ and PERRY ELLIS AMERICA DENIM FIRST ISSUE QUALITY TESTED PERFORMANCE INSPIRED.¹⁰ Applicant has otherwise denied the salient allegations in the notice of opposition.¹¹

The record includes the pleadings; the file of the opposed application; the trial testimony, with accompanying exhibits, of applicant, which was taken by opposer; and the affidavit, with exhibits, of opposer's witness, Maria Folyk-Kushner.¹² Opposer also filed a notice of reliance on two third-party registrations and one third-party application for marks containing the name ELLIS.¹³ Applicant did not

⁷ Serial No. 76070868.

⁸ Serial No. 76313515.

⁹ Serial No. 76332340.

¹⁰ Serial No. 76199431.

¹¹ Applicant's answer also includes argument/allegations as to why he believes that there is no likelihood of confusion.

¹² Trademark Rule 2.123(b) provides, in part, that by written agreement of the parties the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses. Although applicant had consented to submitting Ms. Folyk-Kushner's testimony by affidavit, opposer, because of delays in obtaining applicant's written stipulation to this effect, filed a motion to either allow the affidavit testimony or enter a default judgment against applicant or extend opposer's testimony period so that opposer could take the trial deposition of its affidavit witness. The stipulation bearing both parties' signatures was filed shortly thereafter, and opposer confirmed at the oral hearing that its motion was therefore moot.

There is a further pending motion which we must also address. On June 23, 2003 opposer filed a second motion to compel discovery or for sanctions. In view of the fact that opposer continued with trial, briefing and oral argument, and the proceeding is now ready for decision, we deem this motion to be moot.

¹³ Opposer also submitted a notice of reliance on its annual reports for the years 2002 and 2003. Annual reports are not considered printed publications or official records, and are therefore not acceptable material for a notice of reliance. See

submit any evidence. Only opposer filed a brief,¹⁴ but applicant as well as opposer appeared at a hearing before the Board.

The information we have about opposer and its activities comes from the affidavit, and accompanying exhibits, of Maria Folyk-Kushner, opposer's (PEI Licensing, Inc.) Vice President of Licensing.

We find that the current opposer, PEI Licensing, Inc., is a wholly-owned subsidiary of Perry Ellis International, Inc., the party which originally filed the notice of opposition. (Hereafter, we will use the term "opposer" to refer to both of these entities.) Opposer is a designer, distributor and licensor of apparel and accessories for men, women and youth. During the mid-1970's, Mr. Perry Ellis was a prominent designer of clothing and the original owner of PERRY ELLIS trademarks.

Logicon, Inc. v. Logisticon, Inc., 205 USPQ 767, 768, n. 6 (TTAB 1980); Litton Industries, Inc. v. Litronix, Inc., 188 USPQ 407, 408 (TTAB 1975). However, these annual reports are of record herein because they were introduced through the affidavit testimony of Ms. Folyk-Kushner.

¹⁴ Opposer has attached various exhibits to its brief. Evidence that is first submitted with a brief is manifestly untimely. Therefore, only those exhibits that were introduced during the testimony of Ms. Folyk-Kushner and Mr. Ellis, and the two third-party registrations and the third-party application that was submitted under notice of reliance--in other words, the only evidence that is properly of record--have been considered. In particular, the Board has given no consideration to trial brief exhibit 9, consisting of a search of the USPTO database for ELLIS marks in Class 25. Nor has the Board considered the certified status and title copies of opposer's registrations submitted as Exhibit 3 to the trial brief.

Opposer promotes a variety of marks using the words PERRY ELLIS, both separately and together with other words.¹⁵

Opposer markets and sells hundreds of different product lines bearing various PERRY ELLIS marks, including fashion formal, dress, casual and sport wear for men; fashion dress, casual and sport wear for women; fashion dress, casual and sport wear for youth between the ages of two to fifteen; and accessories, including hats, belts, bags, small leather goods, ties, underwear, hosiery, backpack, wallets, key holders, shoes, eyewear, perfume, cologne, skin soap, body lotion, deodorants, outerwear, scarves, gloves, watches, sleepwear and swimwear.

Opposer markets its products through television commercials, national billboard campaigns, fashion shows, magazines such as "GQ," "Vogue" and "Vanity Fair," in-store events, and on its website. Opposer spent over \$7 million in 2002 and over \$8 million in 2003 promoting its PERRY ELLIS trademarks. It sells its goods at retail department stores and chains throughout the country, including Robinson's, Foley's, Bon Marche, Hecht's, Macy's, Burdines, Marshall Fields, Filene's, Lord & Taylor, Nordstrom and

¹⁵ Ms. Folyk-Kushner refers to the PERRY ELLIS trademarks as the "PERRY ELLIS family of trademarks." "Family of marks" is a legal term, and therefore we have considered this reference as relating to opposer's various marks which consist of or contain the name PERRY ELLIS.

Bloomington, at other retail outlets, and on its website. The average price of its products ranges from \$15 to \$150, and opposer posted total revenues of \$278 million in 2002 and almost \$306 million in 2003.

Applicant started developing his clothing line in 1994, designing clothing that would be structured to fit what he characterizes as the African-American figure. He first called his line ELLIS BLACK in 1999, although the mark was not used on labels at the time. He first used it on clothing in 2001, but because of this opposition proceeding, he is not putting the mark on items other than the 200 pairs of jeans that had been produced previously.

Applicant's business must be characterized as start-up. He is still in the design stage, finalizing his patterns so the clothing will have the fit he envisions. He is not trying to market or sell his clothing to the public yet, although he has sold some items to friends or friends of friends. He estimates that he sells to 20 or 30 people a year.

Applicant plans on advertising his clothing through his web site, black magazines, BET or any place that has a black ethnic market. This market includes Latinos and anyone who has what applicant characterizes **as** the black body structure, even Caucasian women. He also plans on selling

his goods only in his own stores (although he does not yet have any stores), through his own catalogs and on-line.

Applicant has not done any advertising for his ELLIS BLACK clothing, although **he** ~~it~~ does have a web site.

As noted above, opposer pleaded ownership of various registrations and applications, and applicant admitted opposer's ownership of them in his answer. To the extent that these pleaded applications have since matured into registrations, we have treated the pleadings to be amended to assert them as registrations. Ms. Folyk-Kushner introduced these registrations during her affidavit testimony. However, Ms. Folyk-Kushner's affidavit testimony also made reference to other PERRY ELLIS registrations and applications, including marks in classes other than clothing. Because these registrations/applications were not pleaded, and because we cannot deem the issue of likelihood of confusion with respect to these registrations/applications to have been tried, we cannot consider the pleadings to have been amended pursuant to FRCP 15(b). Accordingly, we consider the issue of likelihood of confusion only with respect to the pleaded registrations and the registrations issuing from the pleaded applications.¹⁶

¹⁶ Applications which have not matured to registration are evidence only of the fact that they were filed; they do not carry the presumptions of validity, etc. provided by Section 7(b) of the Trademark Act. Therefore, we have not considered these applications in our determinations of either priority or

Opposer owns registrations for the following marks and goods:

| | | |
|-----------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------|
| PERRY ELLIS | Men's apparel, namely suits, pants, shirts, sweaters and sports jackets | Reg. No. 1428486, issued Feb. 10, 1987; Section 8 & 15 affidavits accepted/acknowledged |
| PERRY ELLIS | Ladies' apparel-namely, skirts, blouses, jackets, coats, shirts and slacks | Reg. No. 1249025, issued Aug. 23, 1984; Section 8 & 15 affidavits accepted/acknowledged; renewed |
|  (The design portion is the signature Perry Ellis) | Men's apparel, namely, shirts, pajamas and robes | Reg. No. 1641343, issued April 16, 1991; Section 8 & 15 affidavits accepted/acknowledged; renewed |
| PERRY ELLIS AMERICA (AMERICA disclaimed) | Footwear | Reg. No. 2164539, issued June 9, 1998; Section 8 and 15 affidavits accepted/acknowledged |

likelihood of confusion. Similarly, we have not considered those pleaded registrations which have been cancelled or which have expired. In particular, we note that the pleaded registration for PERRY ELLIS PORTFOLIO, which opposer states in its brief is owned by opposer in connection with its discussion of the similarity of the marks, was cancelled on July 20, 2002, almost two years before the brief was filed. Also, Registration No. 1279975 for PERRY ELLIS for footwear issued on May 29, 1984. The grace period for filing a renewal of this application expired on November 29, 2004, and Office records do not indicate that the registration has been renewed. Accordingly, we have not relied on this registration rendering our decision.

| | | |
|-----------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------|
|  <p>(AMERICA disclaimed)</p> | <p>Clothing, namely sweaters, shirts, jackets, pants, shorts, caps, footwear, and sweatshirts</p> | <p>Reg. No. 2553470, issued March 26, 2002</p> |
|  <p>(AMERICA disclaimed)</p> | <p>Men's women's and children's apparel, namely, jackets, sport jackets, pants, shirts, sweaters, skirts, shorts, vests, neckwear, coats, suits, dresses, pajamas, robes, headwear, gloves, scarves, hosiery, tights, pantyhose, swimwear, underwear, footwear (Cl. 25) (as well as various eyewear, including eyeglasses, sunglasses, and eyeglass frames in Cl. 9, and leather goods, including wallets, belts and handbags in Cl. 18)</p> | <p>Reg. No. 2323085, issued February 29, 2000</p> |
|  <p>(AMERICA disclaimed)</p> | <p>Pants, shorts, skirts, tops, jackets, vests, and dresses</p> | <p>Reg. No. 1395816, issued June 3, 1986; Section 8 & 15 affidavits accepted/acknowledged</p> |
| <p>• SOFTWEAR (SOFTWEAR disclaimed)</p> | <p>Clothing, namely, men's jackets, and sport coats</p> | <p>Reg. No. 2677104, issued Jan. 21, 2003</p> |

Priority is not in issue in view of opposer's ownership of the above-identified registrations. See King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182

USPQ 108 (CCPA 1974). Ms. Folyk-Kushner's affidavit states, after listing the particulars of fourteen of opposer's registrations (one of which, PERRY ELLIS PORTFOLIO, has been cancelled), that "many of these marks have been in continuous use as early as January 1977." Because of the vagueness of this testimony, and the lack of information as to the specific mark(s) which were used on particular goods as of January 1977, we have not relied on actual use in our finding that opposer has met the priority prong of its Section 2(d) claim.

We turn then to the issue of likelihood of confusion. Preliminarily, we note that opposer has pleaded ownership of a family of marks. And, as we stated previously, throughout her affidavit opposer's witness Maria Folyk-Kushner has referred to opposer's ownership of a family of PERRY ELLIS trademarks. However, the existence of a family of marks is an issue for us to determine based on the evidence, and the fact that Ms. Folyk-Kushner uses the term in her testimony does not make it so. In this case, opposer has not submitted any evidence to demonstrate that it has promoted its marks together, such that we can find that it has a family of PERRY ELLIS marks. Cf. *J & J Snackfoods Corp. v. McDonald's Corp.*, 932 F.2d 1360, 18 USPQ2d 1889 (Fed. Cir. 1991). This is not to say, however, that opposer cannot rely on its various registrations consisting of or

comprising the words PERRY ELLIS in asserting a likelihood of confusion with each of various PERRY ELLIS marks.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *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, 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).

Applicant's identification of goods includes many of the same goods that are identified in opposer's registrations. For example, opposer's registrations for PERRY ELLIS (typed drawing) include such goods as women's skirts, blouses, jackets, coats, shirts and slacks and men's pants, shirts, sweaters, and its registration for PERRY ELLIS and signature is for, inter alia, pajamas and robes. These goods are legally identical to the goods identified in applicant's application, and are otherwise closely related to the other goods in applicant's identification of goods.

Similarly, opposer's PERRY ELLIS AMERICA registrations also include goods which are legally identical to those in applicant's application, such as footwear (PERRY ELLIS AMERICA typed drawing); sweaters, shirts, jackets, pants, shorts, caps, footwear and sweatshirts (PERRY ELLIS AMERICA and triangle design, Reg. 2553470); and vests, neckwear, coats, dresses, hosiery, tights, pantyhose and underwear (PERRY ELLIS AMERICA and abstract line design, Reg. 2323085.)¹⁷ Because these goods are legally identical, they must be deemed to be sold in the same channels of trade and to the same classes of customers. We recognize that applicant intends to sell its goods primarily to an ethnic consumer base, consisting of people whose body structure he describes as being the same as African-Americans, and that he intends to sell his goods in his own stores. However, his identification of goods is not limited to such channels of trade or to such customers, and we therefore must consider his goods to be sold in all the channels of trade and to all the consumer groups that are appropriate to clothing items in general. This would include the public at large, and the channels of trade must be deemed to include all retail outlets that sell clothing, including the

¹⁷ Although, as noted in footnote 2, some of applicant's goods are not clothing, but would be properly classified in Class 18, opposer has submitted registrations that include some of these Class 18 goods, too, e.g., the identification for Reg. No 2323085

department stores in which opposer's goods are sold. See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A., 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (in a proceeding such as this, the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in an opposer's registration, rather than what the evidence shows the goods and/or services to be). We also note that opposer promotes and markets its goods to people of all cultures, including African-Americans and Latin Americans, and that it has adopted many "designs desirable to these ethnic cultures." Folyk-Kushner test, ¶13.

Thus, the du Pont factors of the similarity of the goods and trade channels favor opposer.

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, 1700 (Fed. Cir. 1992).

In this case, opposer's marks are PERRY ELLIS in typed form, PERRY ELLIS with the signature of Perry Ellis, PERRY ELLIS with the word SOFTWEAR (which has been disclaimed), and PERRY ELLIS AMERICA, both alone and with a design

specifies, as part of its Class 18 goods, wallets, billfolds,

feature. In the PERRY ELLIS AMERICA registrations, the geographic term AMERICA has been disclaimed. In applicant's mark, ELLIS BLACK, the word BLACK has been disclaimed.

It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue 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 of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In this case, we find PERRY ELLIS to be the only or the dominant feature of opposer's marks, and ELLIS to be the dominant feature of applicant's mark. As noted, the word AMERICA has been disclaimed in opposer's marks, and applicant has disclaimed the word BLACK. AMERICA is a geographically descriptive term, and BLACK is merely descriptive. Such words generally are accorded less source-identifying significance. In terms of opposer's marks that contain a design element, when a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request or refer to the goods or services. See In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). Thus, even though in some of the PERRY ELLIS AMERICA

belts and handbags.

and design registrations the design is prominently displayed, PERRY ELLIS is the dominant portion of all of opposer's PERRY ELLIS marks. The only exception to this is opposer's registration for PERRY ELLIS SOFTWEAR in stylized form. Although the word SOFTWEAR has been disclaimed as merely descriptive, and, as we said, descriptive matter is generally accorded less significance, the word SOFTWEAR in this mark is so prominently displayed, to the point of obscuring, at least as shown in the registration, the name PERRY ELLIS, that we cannot consider PERRY ELLIS to be the dominant element in this mark. Therefore, we do not find that this mark is sufficiently similar to applicant's mark to support a finding of likelihood of confusion.

With respect to the opposer's other pleaded registrations, because of the common element ELLIS in both parties' marks, the marks share a similarity in appearance and pronunciation. Moreover, they have a similar connotation in that ELLIS is clearly a surname in opposer's marks, and as used in applicant's marks it will appear to many consumers to be a surname as well. Because the word BLACK in applicant's mark describes the ethnic group to which the clothing is directed, the connotation of the mark is of ELLIS clothing which is specifically designed for a black audience. As applicant **himself** ~~itself~~ stated, his mark has the meaning that "it's created by Ellis, you know,

for the black body structure." Test. p. 110.¹⁸ Although opposer's marks do not describe its goods as being for a specific ethnic clientele, the marks have a similar connotation, in that they indicate clothing from the ELLIS designer line, and specifically from PERRY ELLIS. When the parties' marks are compared in their entirety, they convey the same commercial impression. This du Pont factor, too, favors opposer.

The du Pont factor regarding the conditions under which and buyers to whom sales are made also favors opposer. The buyers are the public at large, and cannot be presumed to have a particular sophistication in the purchase of clothing. Further, the clothing items identified in the respective registrations encompasses relatively inexpensive goods, a conclusion which is further supported by opposer's evidence that its products retail for as little as \$15. In view of this, we find that the purchases would not be made with a great deal of care.

¹⁸ We recognize that BLACK may also describe the color of clothing and, in fact, this is reason the Examining Attorney gave in requiring the disclaimer. To the extent that consumers do have this impression, ELLIS BLACK would still convey a connotation similar to opposer's marks, i.e., it would indicate black-colored clothing emanating from a designer named ELLIS. We also recognize that, because ELLIS can be a given name, consumers could view the mark ELLIS BLACK as referring to the full name of a person. However, because of the context in which the mark is used, we believe that, at least for the majority of consumers, they will understand the mark as indicating clothes designed by ELLIS for the black audience.

With respect to the du Pont factor of "the number and nature of similar marks in use on similar goods," there is no evidence of any such third-party use. In his testimony, applicant stated that he had conducted a search of USPTO records for ELLIS marks, but third-party registrations are not evidence that the marks shown therein are in use. In any event, the only third-party registrations that are of record are two that were submitted by opposer, and only one, for a label design prominently bearing the mark LANYA with the words GAY ELLIS, SHEFFIELD, VERMONT in much smaller letters is for clothing. Thus, this factor favors opposer.

Moreover, we find that opposer's PERRY ELLIS marks are strong marks. During his deposition applicant agreed with opposer's counsel's statement that "the Perry Ellis trademark's well known." Test., p. 168. Applicant further testified that PERRY ELLIS clothing is sold worldwide, and that he was aware the clothing is carried in many stores, including Macy's and Nordstrom's. "He's in every store, I think." Test., p. 138. Applicant also stated that Perry Ellis has "been around for a while." Test., p. 107, and that he himself bought a PERRY ELLIS jacket when he was 13. Ms. Folyk-Kushner stated in her affidavit that opposer spent over \$7 million in 2002 and over \$8 million in 2003 promoting its PERRY ELLIS trademarks. She also stated that many of opposer's marks for or containing the name PERRY

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ELLIS have been in use since January 1977. Although this evidence goes to the strength of opposer's marks, we find it falls short of establishing that opposer's marks are famous. As noted previously, the testimony of Ms. Folyk-Kushner was submitted by affidavit, and she therefore had the opportunity to carefully compose the affidavit, and have the input of counsel in determining what evidence should be submitted. Despite this, Ms. Folyk-Kushner did not identify which marks have been in use since January 1977 (her exact words, after listing registrations owned by opposer in Class 25, were "many of these marks have been in continuous use as early as January 1977." Nor has she provided any examples, in the form of exhibits, of the advertising on which opposer has expended the recited sums. Therefore, we cannot conclude what impact the advertising may have had. We also have considered Ms. Folyk-Kushner's statement that opposer posted total revenues of \$278 million in 2002 and almost \$306 million in 2003. However, we note from the document showing the recording of opposer's registrations with the U.S. Patent and Trademark Office that not all of opposer's marks include the name PERRY ELLIS. For example, the document lists TEMPO LIBERO, PRO PLAYER and P. Therefore, we have no way of knowing, from the evidence of record, the amount of opposer's sales for goods under the PERRY ELLIS

marks. Accordingly, we do not accord to opposer's marks the broad protection to which a famous mark is entitled.

As for the du Pont factors regarding actual confusion, applicant has not begun to use his mark. Therefore, these factors must be regarded as neutral.

In considering all the applicable du Pont factors, we find that all either favor opposer or are neutral. We further find that consumers who are aware of opposer's PERRY ELLIS mark, or its various marks which contain the name PERRY ELLIS with other matter, are likely to believe, upon seeing the mark ELLIS BLACK on identical or closely related items of clothing, that opposer is using ELLIS BLACK as a variation of its various PERRY ELLIS marks. Because applicant has testified that his goods are designed specifically to fit the African-American body, they are likely to be promoted in this fashion. As a result, consumers who are familiar with the PERRY ELLIS marks are likely to assume that ELLIS BLACK is a mark which is used by opposer to identify its goods that are made for African-Americans.

Decision: The opposition is sustained. As indicated in footnote 2, if applicant is ultimately successful in this proceeding, the file will be remanded to the Trademark Examining Attorney pursuant to Trademark Rule 2.131 to

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consider whether a requirement for an acceptable
identification of goods should issue.