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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

XOXO Clothing Company, Incorporated and Global Brand
Holdings, LLC¹

v.

Aytemizler Orgu Ve Dokuma Urunleri
Uretim Limited Sirketi.

Opposition No. 91155594
to application Serial No. 75549496

Louis S. Ederer of Torys LLP for XOXO Clothing Company,
Incorporated and Global Brand Holdings, LLC.

Jeremy Craft of Harrison & Egbert for Aytemizler Orgu Ve
Dokuma Urunleri Uretim Limited Sirketi.²

Before Quinn, Hairston, and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On 08 September 1998, applicant (Aytemizler Orgu Ve
Dokuma Urunleri Uretim Limited Sirketi) applied to register
the mark shown below on the Principal Register for the
following goods in Class 25:

¹ In view of the assignments of the pleaded registrations,
recorded at the Office's Assignment Branch at Reel 2823, Frame
0392, Global Brand Holdings, LLC is joined as party opposer. See
TBMP § 512 (2d ed. rev. 2004). To the extent we refer to
opposers by name, we will refer to assignee.

² Applicant did not file a brief in this case.

Skirts, sweaters, waistcoats, jackets, trousers, overcoats, raincoats, women's coats, hooded jackets, trench coats, sweat shirts, pullovers, blouses, skirts, parkas, masquerade costumes, dresses, T-shirts, shorts, blue jeans, evening dresses, suits, jump suits, uniforms, bathrobes, bath slippers, beach wear, neckties, bow ties, men's scarves, hats, capes, berets, scarves, gloves, shawls, arm bands, belts, sweat shirts, socks, undershirts, body suits, panties, singlets, brassieres, corsets, camisoles, garters, night dresses, morning dresses, shoes, high boots, sports shoes; parts of shoes, namely, heels, legs, and vamps



The application is based on an allegation of a bona fide intention to use the mark in commerce.

The registration of applicant's mark has now been opposed by Global Brand Holdings, LLC (opposer). Opposer has alleged that there is a likelihood of confusion under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) between applicant's mark as proposed to be used on its goods and the following registrations that opposer owns for the identified goods and services.

XOXO in standard character form for "clothing, namely, men's, women's and children's shirts, shorts, pants, jackets, T-shirts, sweatshirts, hats, socks, sweaters and swimwear" in Class 25.³

XOXO in standard character form for "luggage, handbags, purses all made from leather, imitations of leather and other material" in Class 18.⁴

³ Registration No. 2,009,243 issued 22 October 1996, affidavits under Sections 8 and 15 accepted or acknowledged.

⁴ Registration No. 2,102,098 issued 30 September 1997, affidavits under Sections 8 and 15 accepted or acknowledged.

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XOXO in standard character form for "eyeglasses and sunglasses" in Class 9.⁵

XOXO JEANS in standard character form for "women's, and children's clothing, namely jeans, dresses, skirts, shorts, jackets, shirts, pants, blouses, vests, blazers, jeans, overalls, sweatshirts, sweatpants, tank-tops, tee-shirts, [and] hats" in Class 25.⁶

XOXO in standard character form for "retail clothing store services" in Class 35.⁷

XOXO in standard character form for "women's and children's shoes" in Class 25.⁸

XOXO in standard character form for "jewelry, watches and other horological and chronometric instruments, namely, clocks" in Class 14.⁹

Applicant has denied the salient allegations of the notice of opposition.

The Record

The record consists of the pleadings, the file of the involved application; and opposer's stipulated testimony by declaration with exhibits of Jennifer Fettig, opposer's representative responsible for business development.

Priority

Inasmuch as opposer has shown that it owns several trademark registrations for the mark XOXO for various goods and services, opposer has priority. See King Candy Co. v.

⁵ Registration No. 2,269,840 issued 10 August 1999, affidavits under Sections 8 and 15 accepted or acknowledged.

⁶ Registration No. 2,320,710 issued 22 February 2000.

⁷ Registration No. 2,370,004 issued 25 July 2000.

⁸ Registration No. 2,436,377 issued 20 March 2001.

⁹ Registration No. 2,456,625 issued 05 June 2001.

Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

The central issue in this case is whether there is a likelihood of confusion. Applicant seeks registration for the mark OXXO (stylized) for numerous clothing items while opposer relies on its ownership of several registrations for the mark XOXO, most for those letters alone, in standard character form for various goods and services. The Federal Circuit and its predecessor court have set out the factors that are relevant in these types of cases. See In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

Two key considerations in likelihood of confusion cases are the similarities and dissimilarities of the marks and the relatedness of the goods and/or services. We will first consider the relationship between applicant's and opposer's goods and services. Numerous items in applicant's identification of goods are identical or virtually identical to opposer's goods in Registration Nos. 2,009,243 and 2,436,377. Opposer's registrations are for men's, women's and children's shirts, shorts, pants, jackets, T-shirts,

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sweatshirts, hats, socks, sweaters, swimwear, and women's and children's shoes. Applicant's identification of goods similarly includes shorts, trousers, jackets, T-shirts, sweat shirts, hats, socks, sweaters, beach wear, and shoes. Therefore, applicant's and opposer's goods are not only related, they are in part identical. "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, 1701 (Fed. Cir. 1992). Furthermore, since the goods are identical, "they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers." In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994).

The second factor we consider concerns the similarities and dissimilarities of the marks. Applicant seeks registration for the mark OXXO (stylized) and opposer relies on numerous registrations for the mark XOXO. Inasmuch as opposer's mark is depicted in a typed or standard character form, its marks are not confined to any particular display and, therefore, there is no viable difference in the marks based on applicant's stylization of its mark. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983).

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When we compare marks, we must examine "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (internal quotation marks omitted). A feature of these marks is the fact that they both consist of arbitrary letters. The case law distinguishes between marks that consist of arbitrary letters and marks that are recognizable words. HRL Associates, Inc. v. Weiss Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840, 1841 (Fed. Cir. 1990) ("On the issue that letters are confusing, this court also agrees with the Board. It is more difficult to remember a series of arbitrarily arranged letters than it is to remember figures"). See also Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH, 230 USPQ 530, 533 (TTAB 1986):

We must also consider the well-established principle of our trademark law that confusion is more likely between arbitrarily arranged letters than between other types of marks. This principle was set forth fifty years ago in the decision of the Court of Customs and Patent Appeals in Crystal Corp. v. Manhattan Chemical Manufacturing Co., 75 F.2d 506, 25 USPQ 5, 6 (1935) wherein the following reasoning was applied in holding Z.B.T. likely to be confused with T.Z.L.B. for talcum powder.

We think that it is well known that it is more difficult to remember a series of arbitrarily arranged letters than it is to remember figures, syllables, words, or phrases. The difficulty of

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remembering such lettered marks makes confusion between such marks, when similar, more likely.

Inasmuch as the parties' marks are not recognized words, they would not have any specific meaning. The only meaning the marks may have is that "the letter 'X' signifies 'kisses' and the letter 'O' signifies 'hugs.'" Fettig declaration at 11. If opposer's marks would have the meaning "kisses" and "hugs," opposer's witness points out that "consumers may forget, or not be concerned, as to the particular order of the 'X's' and 'O's' appearing on Global's XOXO products." Id. Even if purchasers associate the letters "X" and "O" as symbols for "kisses" and "hugs," these symbols can be used in different order. Furthermore, both marks would still have the same meaning, i.e., two kisses and two hugs.

When the marks are pronounced, because they consist of arbitrary letters, they would most likely be pronounced as the letters themselves (O-X-X-O and X-O-X-O). Under these circumstances, it is easy to understand how consumers may become confused as to the exact order of the letters. The appearances of the marks are also similar because they have the exact same letters with only the order of the first two letters being reversed. In addition, the commercial impressions of XOXO and OXXO would be similar because they are likely to be viewed as a series of letters "X" and "O"

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and the exact order of the "X's" and "O's" is not as significant as with recognized words.

Reversing the order of the first letters in certain circumstances may create significantly different marks as in the case of the words BABY and ABBY. The difference in the order of the "A" and "B" profoundly effects the meaning, pronunciation, appearance, and commercial impression of the words. Prospective purchasers are likely to assume that there is no association between ABBY and BABY goods or services. However, unlike the example, applicant's OXXO and opposer's XOXO marks are not recognizable words. Purchasers familiar with the mark XOXO may not recall the exact order of the arbitrary letters and we must keep in mind that "[h]uman memories ... are not infallible." In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), quoting, Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970). Furthermore, the presence of two "X's" in a short word or term in English is unusual and this fact also emphasizes the similarity of the marks. Therefore, we conclude that the marks OXXO (stylized) and XOXO are similar.

We also have considered that opposer has obtained registrations for its XOXO on a number of registrations involving clothing, luggage, handbags, purses, eyeglasses, sunglasses, retail clothing store services, and clocks. In

addition to the pleaded registrations, opposer's witness also introduced three additional registrations that opposer owns. Two are for the mark:



The first is for "women's and children's shoes" in Class 25.¹⁰ The second is for "women's, and children's clothing, namely dresses, skirts, shorts, jackets, shirts, pants, blouses, vests, blazers, jeans, overalls, sweatshirts, sweatpants, tank-tops, tee-tops, tee-shirts, [and] hats" in Class 25.¹¹ The third additional registration is for the mark FRAGILE BY XOXO in standard character form for "eyeglasses and sunglasses" in Class 9.¹² Opposer has also provided a list of licensees of its XOXO mark for products under the following headings: Apparel, Belts/Cold Weather, Dresses, Footwear, Fragrance, Handbags, Intimates, Kids, Outerwear, Sleepwear, Swimwear, and Sunglasses. Fettig declaration at 6 and Ex. B. The advertising (Exhibit D) shows that opposer is using the mark

¹⁰ Registration No. 2,484,317 issued 04 September 2001. The word "America" has been disclaimed.

¹¹ Registration No. 2,043,508 issued 11 March 1997; affidavits under Sections 8 and 15 accepted or acknowledged. The term "America" has been disclaimed.

¹² Registration No. 2,556,155 issued 02 April 2002.

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in association with a wide variety of clothing and fashion items, including shoes, boots, tops, jeans, swimwear, handbags, vests, and shirts. This evidence of registration and use of the XOXO mark on a wide variety of products favors opposer.

Opposer also argues that its "XOXO mark is a famous and strong mark, and therefore the XOXO mark should be accorded a wide scope of protection." Brief at 18. Opposer has submitted evidence that it regularly advertises its XOXO products in magazines such as *Teen Vogue*, *In Style*, *Vogue*, and *Cosmopolitan*. Fettig declaration at 7 and Ex. D. Ms. Fettig (p. 5) also testified that revenues for the XOXO brand "have increased to approximately \$150-200 million" and that opposer spent nearly \$2.2 million promoting its brand in 2003. Fettig Declaration at 8. Ms. Fettig also testified (p. 9) to other methods opposer uses to promote the XOXO mark.

In addition to the traditional methods of advertisement and promotion, the XOXO brand has been at the forefront of product placement and endorsement by celebrities in the television, film and music industries.

On television, the XOXO brand has sponsored such events as The Miss America Pageant, The VH-1 Fashion Awards and The Miss Teen USA Pageant, and its products have been seen on such shows as, "7th Heaven," "Charmed," "Ally McBeal," "E! A Makeover Story," "The Oprah Winfrey Show," "Los Bel Tran," "Motown Live," "MTV 120 Minutes," "MTV Beach House," "MTV Blame Game," "The Price is Right," "Pajama Party," "Solo En America" and "Studio Y."

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XOXO products have also been seen in movies, including, "Almost Famous," "100 Girls," "The Test," "Empire," "In Pursuit," "Licensed to Steal," "Like Mike," and "Lift," and worn by members of the musical groups 3LW, Before Dark, Darmozel, Flight 180, Icy and Jewel.

Finally, many celebrities have worn XOXO products to public events including, Britney Spears, Christina Aguilera, Cindy Blackman, Farrah Fawcett, Jessica Simpson, Kathy Griffen, Kylie Bax, Leslie Grossman, Mary J. Blige, Mena Suvari, Paula Cole, Pink and Spinderella.

Opposer has also submitted evidence that its XOXO mark has been the subject of numerous articles in the press. See, e.g., Chicago Sun-Times, 01 October 1995 ("Trendy sportswear makers such as Jalate, Doll House and XOXO are further feminizing these looks for fall"); Crain's New York Business, 24 February 1997 ("The industry's two hottest junior manufacturers, Rampage and XOXO"); WWD, 25 February 1998 ("Lola, Inc., which markets junior powerhouse XOXO"); and WWD, 20 July 2001 ("Key junior brands include XOXO, Guess and Tommy"). Fettig Ex. H. The Federal Circuit has held that the fame "of an opposer's mark, if it exists, plays a dominant role in the process of balancing the *DuPont* factors" and "likelihood of confusion fame varies along a spectrum from very strong to very weak." Palm Bay Imports, 73 USPQ2d at 1694 (internal quotation marks omitted). Opposer's evidence supports a conclusion that its XOXO mark has achieved some fame and, therefore, this factor must be resolved in opposer's favor.

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When we consider the evidence of record in light of the relevant factors, we conclude that there is a likelihood of confusion in this case. The goods of the parties are identical, at least in part, and the channels of trade and purchasers, therefore, would be the same. The marks OXXO and XOXO are similar and opposer's mark has achieved some fame. When prospective purchasers would encounter the mark OXXO (stylized) on clothing such as sweaters, shoes, and shorts, they are likely to believe that these products are associated with the source of the same or similar products sold under the mark XOXO.

Decision: The opposition to the registration of application No. 75549496 is sustained.