

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: January 22, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

So Sweet LLC
v.
Dong Yun Park and Jung Ae Park.

Opposition No. 91160319
to application Serial No. 76384690
filed on March 20, 2002

Howard F. Mandelbaum of Levine & Mandelbaum for So Sweet LLC.

David Belasco for Dong Yun Park and Jung Ae Park.

Before Seeherman, Kuhlke and Bergsman, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicants, Dong Yun Park and Jung Ae Park, individuals and citizens of the Republic of Korea, seek registration of the mark ANGEL JEANS (in typed form)¹ for goods identified in the application as "clothing, namely, jeans, denim

¹ Prior to November 2, 2003, standard character drawings were known as typed drawings and typed drawings that are still pending after November 2, 2003 are acceptable under the old rules. See TMEP § 807.03(i).

Opposition No. 91160319

jackets, denim dresses, denim skirts" in International Class 25.² The word JEANS is disclaimed.

Opposer, So Sweet LLC, opposed registration of applicants' mark on the grounds that, as applied to applicants' goods, the mark so resembles opposer's previously used marks ANGELS SO SWEET for "women's, girls' and children's jeans, pants, skirts, including denim skirts, shorts, shirts, knit tops, jackets, including denim jackets, jumpers, and dresses, including denim dresses," "ANGELS and Design" for "women's, girls' and children's jeans, pants, skirts, including denim skirts, shorts, shirts, knit tops, jackets, including denim jackets, jumpers, and dresses, including denim dresses," and "ANGELS JEANSWEAR BRAND and Design" for "women's, girls' and children jeans, pants, skirts, including denim skirts, shorts, shirts, knit tops, jackets, including denim jackets, jumpers and dresses, including denim dresses" as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d).³

² Serial No. 76384690, filed March 20, 2002. The application is based on allegations of first use and use in commerce of April, 1999 under Trademark Act Section 1(a), 15 U.S.C. §1051(a).

³ In its brief, opposer also argues what appears to be a claim that applicants are not the owners of the mark in issue. This claim was not set forth in the notice of opposition and the record does not reflect that the issue was tried by either express or implied consent of the parties. Fed. R. Civ. P. 15(b). We cannot say, based on the questions raised during cross-examination of Mr. Park, that applicants were aware that the issue of ownership had been tried. In addition, contrary to

Opposition No. 91160319

Applicants filed an answer by which they denied the salient allegations of the notice of opposition. Applicants also asserted the affirmative defenses of laches, unclean hands, and acquiescence. However, the only affirmative defense pursued in the brief was "laches and estoppel"; therefore, we consider the other defenses waived. In addition, applicants have only referenced a laches defense and no other form of estoppel, nor was any other form of estoppel pleaded. In view thereof, we have only considered the laches defense. Applicants' argument on this issue is set forth below:

Opposer did not notify Applicants in any of the first five years of the Applicants' use of the ANGEL JEANS mark in connection with denim apparel. Instead, Opposer waited until Applicants sufficiently invested in the creation, promotion, and use of their mark, and filed for Federal Registration of their mark to finally mention their use and fear of injury to their business ... The notice did not come until Opposer filed the instant Opposition on April 28, 2004. Notably, Applicants' use of its ANGEL JEANS mark was very public ... Opposer's lack of action demonstrates Opposer's own belief that consumers are unlikely to be confused in the marketplace and, in any event, consented to Applicants' use of their mark. Further, any argument of likelihood of confusion should be barred under a laches and estoppel defense since Opposer's five year inaction is indicative of a lack of confusion.

Br. pp. 32-33.

opposer's contention, the inclusion in applicants' answer of the statement "Applicant has made prior or concurrent use of its trademark Angel Jeans in United States Commerce than [sic] Opposer's use of its alleged trademarks" did not raise the issue of applicants' ownership of the mark.

Opposition No. 91160319

Applicants' assertion of laches as an affirmative defense is unavailing in this case. When the right to register is at issue, the earliest date the affirmative defense of laches may begin to run is the date the application is published for opposition. *National Cable Television Association, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991). See also *Bridgestone/Firestone Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460, 1462-63 (Fed. Cir. 2001).

The evidence of record consists of the pleadings herein; the file of the opposed application; the testimony depositions (with exhibits) of Mr. Carl Eckhaus, opposer's president, and Mr. Dong Yun Park. In addition, on rebuttal opposer submitted notices of reliance upon applicants' responses to opposer's interrogatories, and a certified copy of Articles of Incorporation of the corporation Hip & Hip, Inc. The parties also filed main briefs and opposer filed a reply brief.

As a preliminary matter, we must first determine which of opposer's marks are in issue in this case. In its brief and Mr. Eckhaus' deposition opposer frequently refers to its "ANGELS" marks; however, opposer has pleaded one mark in typed form, "ANGELS SO SWEET," and two marks that consist of words and designs, referred to by opposer as "ANGELS and

Opposition No. 91160319

design" and "ANGELS JEANSWEAR BRAND and design." Opposer did not include in the pleadings a picture of these marks or describe the design; however, in the pleading opposer referenced two trademark applications that relate to these alleged marks inasmuch as they are for combined words and design marks for the same goods, and printouts of these applications from the Trademark Electronic Search System (TESS) were introduced into the record under the testimony of Mr. Eckhaus. The drawings from the applications are shown below:



In its reply brief, opposer argues that "Applicants' analysis of likelihood of confusion between the marks of the parties is seriously flawed insofar as it is limited to Opposer's registered mark ANGELS SO SWEET and the marks of two of Opposer's applications for trademark registration, i.e., ANGELS and hearts design, and ANGELS JEANSWEAR BRAND DESIGN and design. The evidence shows that Opposer's use of ANGELS as a word mark for jeans and other garments has never been limited to the form of its marks that were or are pending in the Patent and Trademark Office." Reply Br. pp. 5-6. However, opposer's pleading is so limited that we cannot say that applicants were fairly apprised of any other

marks claimed by opposer. Nor do we consider the pleadings amended by implied consent under Fed. R. Civ. P. 15(b) to assert any additional ANGELS marks. On the contrary, applicants' cross examination of Mr. Eckhaus wherein applicants focused on the above-noted marks and applicants' brief, which is restricted to the above-noted marks, shows that applicants considered only the pleaded registration and the two pleaded applications to be opposer's marks. Therefore, we will confine our decision to the following three marks.

ANGELS SO SWEET



STANDING

As discussed below, opposer has established trademark rights in the marks ANGELS SO SWEET,  and  (hereinafter, unless otherwise noted, we will refer to all three marks as "the ANGELS marks") as used in connection with pants, shorts, skirts, overalls (all of which include denim varieties, i.e., jeans), and has demonstrated a real interest in preventing registration of the proposed mark.

Opposition No. 91160319

See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Thus, opposer has established its standing.

PRIORITY

Turning first to the issue of priority, although opposer pleaded one registration, opposer did not submit a status and title copy of this registration during the trial period. The copy attached as Exhibit 7 to the deposition of Carl Eckhaus is merely a copy of the registration and Mr. Eckhaus did not testify as to the current status of the registration. See *Alcan Aluminum Corp. v. Alcar Metals Inc.*, 200 USPQ 742, 744 n.5 (TTAB 1978). In addition, applicants' admission in their answer regarding opposer's allegations that it has registered its trademark ANGELS SO SWEET is limited to an admission only "to the extent that it [paragraph 2] refers to matters of the public record with the United States Trademark Office, applicant admits so much as the public record reveals." We cannot treat this statement as an admission that opposer is the current owner of the registration. Therefore, opposer must rely on its common law use to prove its priority in the mark ANGELS SO

Opposition No. 91160319

SWEET, as well as in the marks which are the subject of its pending applications.

Applicants may rely on the filing date of their application, March 20, 2002; in addition, the record shows that applicants first used their mark in the United States in April of 1999. See Park Dep. pp. 74-78. Thus, in order to establish priority, opposer must show that it used its mark(s) in connection with its goods prior to April, 1999.

Opposer's witness, Mr. Eckhaus, testified that since at least November 1997 opposer has used the ANGELS marks on pants sold to companies throughout the United States. See Eckhaus Dep. pp. 6-9; 23, 24; 89-90. In addition, Mr. Eckhaus testified that since 1997 opposer has used the ANGELS marks on jeans and denim skirts. Eckhaus Dep. pp. 15, 18.

Opposer's testimony regarding these sales is supported by documentary evidence in the form of invoices for various sales. In addition, opposer has submitted and identified various labels that are placed on the clothing and has submitted examples of the clothing items (skirts, shorts, jeans) with the labels and tags attached to them.

In view of the evidence and testimony presented as to opposer's use prior to applicants' use in April, 1999, opposer has established its priority with respect to its common law rights in the ANGELS marks for pants, skirts, and

shorts, including denim varieties (i.e., jeans). Moreover, applicant does not dispute this. Br. p. 6 ("Opposer has provided evidence as to the use of its of the marks [sic] as early as November 25, 1997.")

LIKELIHOOD OF CONFUSION

Our likelihood of confusion determination under Section 2(d) 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 and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

In any likelihood of confusion analysis, however, 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).

We turn first to a consideration of the goods, channels of trade and class of purchasers. Applicants' identified jeans and denim skirts are identical to opposer's jeans and jean skirts. In addition, applicants' denim jackets and denim dresses are related clothing items to opposer's jeans and jean skirts, in that they are made of the same material, such that consumers would assume that they come from the

Opposition No. 91160319

same source if they were sold under confusingly similar marks.

Applicants argue that their goods are distinguished from opposer's goods by their "style" in that their goods are "appealing to a vastly different consumer by their trendier, sexier, more suggestive clothing styles...[and t]his difference in goods means a difference in the trade channels for their goods [which] is evidenced by the fact that although both applicants' and Opposer's goods are sold in retail clothing stores throughout the country, of the hundreds of stores Applicants' apparel is sold in, and the hundreds of stores Opposer sells in, only 8 stores have been identified as also being retailers for both Applicant and Opposer." Br. p. 21. Applicants also argue that their goods, in contrast to opposer's goods, will be relatively expensive, ranging in price from \$60 to \$120 (Park Dep. p. 92), and opposer's goods are "positioned financially lower," ranging in price from \$24 to \$46 (Eckhaus Dep. p. 92); therefore, opposer's goods are in a "lower" market. In discussing the marketing differences between their products, applicants' reliance on a line of infringement cases is not useful in this context because they deal with present marketing. In this opposition, we have to determine likelihood of confusion on the assumption that applicants may sell their goods in every market at any price inasmuch

Opposition No. 91160319

as we are concerned with the goods as identified in the application, and there are no restrictions in the application.

There is sufficient evidence in the record demonstrating the overlap in trade channels. As admitted by applicant, the parties' goods are sold in some of the same stores (Park Dep. p. 79). Thus, the channels of trade are, to some extent, identical. Even aside from this, we do not find the difference in price point sufficient to consider the respective goods to be sold in different channels of trade. The difference is not that great that, even if the parties' goods were limited to the current pricing structure, consumers would not encounter both parties' goods, whether in the same store or in other retail outlets. Moreover, inasmuch as there is no limitation in applicants' identification, if applicants were to obtain a registration, it would receive all the presumptions of Section 7(b), including the presumption that the goods would be sold in all appropriate channels of trade, including those in which opposer's goods are sold. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987).

We also find that the goods are sold to the same class of purchasers. Opposer's goods are sold to women and girls,

Opposition No. 91160319

including teenage girls, see e.g., Eckhaus Dep. Exh. Nos. 57, 61 and 63, and applicants' goods are sold to "females between early teens to fifty years of age." Jung Park Response to Interrogatory No. 15(a). Thus, potential purchasers of the parties' goods overlap and come from the general public.

In view of the above, the du Pont factors of the similarity of the goods, channels of trade and class of purchasers favor a finding of likelihood of confusion.

As to the level of care in the purchasing decision, clothing generally is an ordinary consumer item which would not be purchased with the same level of care as, for example, computer equipment. Potential purchasers are from the general public and it is also the case that clothing includes a wide range of products and pricing. Although it may be that consumers would exercise some higher level of care with regard to at least more expensive clothing, the parties' goods are not priced so high to find that this factor would offset the other du Pont factors, in particular with regard to clothing in the lower price range of applicants' goods. In addition, given that these goods are ordinary consumer items and potential purchasers would not necessarily know the price range of products of the parties, they are not likely to assume different sources for the goods based on a perceived price difference. See In re

Opposition No. 91160319

Decombe, 9 USPQ2d 1812 (TTAB 1988); In re Pellerin Milnor Corp., 221 USPQ 558 (TTAB 1983). Most importantly, as discussed below, because of the strong similarities in the marks, ordinary consumers, even if they exercise some care in their purchasing decisions, are not likely to distinguish between the sources of these identical and closely related goods. Therefore, we do not find the level of care or the sophistication of the potential purchasers to offset the other du Pont factors in this case.

We turn then to the first du Pont factor, i.e., whether applicants' mark ANGEL JEANS and opposer's marks ANGELS SO SWEET, ANGELS and heart design and ANGELS JEANSWEAR BRAND DESIGN and heart and diamond design are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under this du Pont factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions 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

Opposition No. 91160319

of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

We begin by noting that opposer's marks are strong marks to the extent that ANGELS is an arbitrary designation and inherently distinctive. Applicants attempt to show that opposer's ANGELS marks are not strong for clothing by relying on opposer's responses to applicants' interrogatory no. 36 which reads as follows:

State whether Opposer is aware of any past or present third-party uses or registrations of the designation ANGELS and or any variation thereof with respect to any goods or services, and if so, identify each such third party and the goods or services for which the designation has been or is used or registered.

Opposer's response is a list of approximately 81 marks that include the word ANGEL or ANGELS. While a registration number is given for each entry, the goods are not listed and the registrations have not been made of record. More importantly, there is nothing in the record to indicate that these marks are in use on similar goods to those in issue in this case. Third-party registrations are not evidence of use and, thus, are of little probative value in an analysis of the strength of the marks. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). Third-party registrations may be "useful to demonstrate the sense in which a term is used in ordinary parlance and they can show that a particular term has been adopted by those

Opposition No. 91160319

engaged in a certain field or industry and that said term has less than arbitrary significance with respect to certain goods or services." In re Dayco Products-Eaglemotive, Inc., 9 USPQ2d 1910, 1912 (TTAB 1988) (IMPERIAL adopted by others in the vehicular field to refer to that term's ordinary significance as a laudatory designation). However, because the registrations were not made of record, we do not know the goods for which the various ANGEL(S) marks are registered, and therefore cannot determine whether ANGEL has a particular significance in the clothing industry. Thus, this list has little probative value.

The word ANGELS is the dominant element in opposer's marks ANGELS and heart design inasmuch as it is by the words that consumers will call for or refer to the goods. In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1554 (TTAB 1987). As for opposer's mark ANGELS JEANSWEAR BRAND DESIGN and heart and diamond design, in view of the prominent visual appearance of ANGELS in comparison to the additional wording JEANSWEAR BRAND DESIGN, as well as the descriptive nature of this additional wording, it is likely that consumers will use the word ANGELS to call for the goods. Similarly, in applicants' mark the word JEANS is the generic term for the goods and is disclaimed; thus, ANGEL is the dominant element in applicants' mark. "That a particular feature is descriptive [or otherwise lacking in

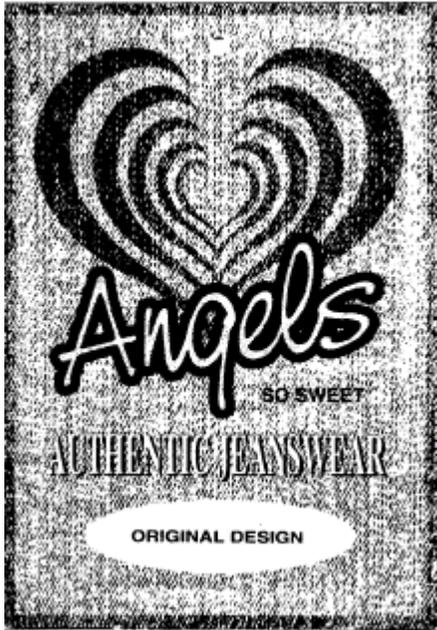
Opposition No. 91160319

distinctiveness] ... with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark..." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Therefore, the dominant elements of each mark, ANGELS and ANGEL, are entitled to the most weight in our analysis under the first du Pont factor. Id. Except for the pluralization, these elements are identical. In re Belgrade Shoe, 411 F.2d 1352, 162 USPQ 227, 227 (CCPA 1969) (pluralization not a material difference). In view of the similarity of the dominant elements, the marks as a whole are similar in sound and connotation, and even though there are some differences in appearance due to the design components and additional descriptive wording in opposer's marks, these differences are not sufficient to distinguish applicants' mark from opposer's; overall they convey similar commercial impressions.

Applicants also note that opposer's marks depict ANGELS in cursive script. However, applicants' mark is in typed form and could appear in any reasonable form of stylization, and because applicants sometimes use ANGELS JEANS in a cursive script it is certainly reasonable to assume they will continue to do so. Park Dep. Exhs. L and S.

With regard to opposer's mark ANGELS SO SWEET, as shown below, opposer uses its mark with the word ANGELS depicted

in larger script so that it is visually the most prominent part of the mark, far more prominent than the words SO SWEET.



In view thereof, we also find that ANGELS is the dominant element of the mark ANGELS SO SWEET. While the addition of the modifying words SO SWEET does present a difference between this mark and applicants' mark, we do not find it sufficient to obviate a likelihood of confusion.

Overall we find that the similarities in the parties' marks outweigh the differences. Thus, the similarity of the marks weighs in favor of a finding of likelihood of confusion.

Finally, opposer argues that there has been actual confusion and points to evidence consisting of misdirected bills from a shipping company (Eckhaus Dep. p. 71 Exh. No.

Opposition No. 91160319

66) which were mailed to opposer for shipping done for applicants. As noted by applicants, this evidence only serves to show that the shipper "mistyped the address and not that they were actually confused as to which company sent them their apparel." Br. p. 30. On the other hand, applicants argue that there has been no confusion by the "ultimate customer" despite five years of concurrent and overlapping use in at least eight retail stores. We do not find the evidence presented by opposer on this factor to be probative for the reasons articulated by applicants and because the shipper is not the consumer of the goods. However, we are not persuaded by applicants' argument that the parties' presence in eight retail stores without evidence of actual confusion shows that confusion is not likely. There is nothing in the record that shows how the parties' clothing was displayed or to what extent both parties' items were sold at the same store. Moreover, it is notoriously difficult to obtain evidence of actual confusion. Thus, although longstanding concurrent use without confusion can weigh in favor of a finding of no likelihood of confusion, such compelling circumstances have not been presented in this case. Compare, *Genesco Inc. v. Martz*, 66 USPQ2d 1260 (TTAB 2003) (twenty years of contemporaneous use significant amount of time, Board found this factor neutral or in applicant's favor). In any event,

Opposition No. 91160319

it is unnecessary to show actual confusion to establish likelihood of confusion. *Herbko Intern., Inc., v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002).

Considering the respective marks in their entireties, we conclude that the evidence of record as it pertains to the relevant du Pont factors clearly supports a finding of likelihood of confusion as to opposer's ANGELS marks, and that registration of applicants' mark, ANGEL JEANS, therefore, is barred under Trademark Act Section 2(d).

Decision: The opposition is sustained.