

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Jones Investment Co., Inc.
v.
Angela Ng

Opposition No. 91167302
to application Serial No. 78372153
filed on February 23, 2004

Robert L. Sherman of Paul, Hastings, Janofsky & Walker LLP
for Jones Investment Co., Inc.

Michelle B. Lee of Lee & Amtzis, LLP for Angela Ng.

Before Walters, Holtzman and Bergsman, Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Angela Ng filed an intent-to-use application to register the mark LEI LEI, in standard character format, for "handbags, purses, wallets, and cosmetic bags sold empty," in Class 18 (Serial No. 78372153). During the prosecution of her application, applicant explained that LEI LEI does not have any significance in the trade or a direct translation, however, "[t]he closest translation is that it is a Chinese nickname for a young girl in the nature of 'sweet girl.'"

Jones Investment Co. Inc. opposed the registration of applicant's mark on the ground of priority of use and likelihood of confusion. Specifically, opposer alleged that applicant's mark LEI LEI, when used in connection with "handbags, purses, wallets, and cosmetic bags sold empty," is likely to cause confusion with the following L.E.I. marks:

1. L.E.I., in typed drawing form, for "apparel, namely, jeans, shirts, jackets, vests, pants, sweaters, jump-suits, shorts, skorts, overalls, shortalls, dresses, skirts, T-shirts, and sweatpants," in Class 25;¹
2. L.E.I., in typed drawing form, for "clothing, namely, tops, bottoms, lingerie, and footwear," in Class 25;²
3. L.E.I., in typed drawing form, for the following goods:

Sunglasses, in Class 9;
Watches, in Class 14; and,

¹ Registration No. 2326186, issued March 7, 2000; Sections 8 and 15 affidavits accepted and acknowledged.

² Registration No. 2402788, issued November 7, 2000. The certified copy of the registration showing the current status and title copy of the registration was prepared by the U.S. Patent and Trademark on August 17, 2006, prior to the due date of the Section 8 affidavit of continued use. However, opposer's notice of reliance introducing the registration was filed on January 17, 2007, after the Section 8 affidavit was due. Because the certified copy of the registration showing the status and title of the registration was filed after the opposition was filed and reasonably contemporaneously after it was prepared, we will consider the registration. In any event, we note that the Sections 8 and 15 affidavits were accepted and acknowledged.

Backpacks, book bags, briefcase type portfolios, fanny packs, gym bags, handbags, leather shopping bags, leather cases for business travel or leisure, mesh shopping bags, purses, rucksacks, school bags, school satchels, textile shopping bags, tote bags, traveling bags, and wallets, in class 18.³

(Emphasis added).

Applicant denied the salient allegations of the opposition.

Evidentiary Issue

Applicant introduced the following items into evidence through the Declaration of Michelle B. Lee, applicant's counsel:⁴

1. A photocopy of Registration No. 3154785 for the mark LEI LEI, owned by applicant, for toys, games, and playthings, in Class 28; and,
2. Excerpts from the applicant's discovery deposition taken by opposer.

³ Registration No. 2602044, issued July 30, 2002; Sections 8 and 15 affidavits accepted and acknowledged.

Opposer also pleaded ownership of the following registrations: Registration Nos. 2397083, 2480482, 2483062, 2688997, and 2643652 for the mark L.E.I. in a stylized format, and Registration Nos. 2636308, 2678625, and 2273883 for the mark L.E.I. LIFE ENERGY INTELLIGENCE in a stylized format. Because the L.E.I. marks identified in the body of this decision are closer to applicant's mark than the stylized L.E.I. marks identified in this footnote, and therefore the probative value of those registrations is cumulative, we have focused our analysis on the L.E.I. marks identified in the body of the decision.

⁴ Pursuant to Trademark Rule 2.123(b), 37 CFR §2.123(b), the parties have stipulated that testimony may be introduced through declarations.

On September 6, 2007, opposer filed a motion to strike the photocopy of applicant's LEI LEI registration and her discovery deposition. Opposer argued that a plain copy of applicant's registration and applicant's discovery deposition taken by opposer may not be introduced into evidence through a notice of reliance. Applicant did not file a brief in opposition to opposer's motion, nor did applicant address opposer's motion in her brief on the case.

A. Applicant's Registration No. 3154785.

Trademark Rule 2.122(d)(2), 37 CFR §2.122(d), provides the following:

A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration.

Applicant introduced her registration into evidence through the declaration of her attorney, and not simply through a notice of reliance. Because the parties stipulated that testimony could be introduced through declarations, applicant proffered the registration through the "testimony" of her counsel.

Applicant's counsel stated that "[a]pplicant is the owner of U.S. Federal Registration No. 3,154,785 for the

mark LEI LEI, which was registered on October 10, 2006 for use in connection with toys, games, and playthings in International Class 28," and identified the registration as Exhibit D that was attached to the declaration. While counsel's declaration is sufficient to establish applicant's ownership of the registration, the witness failed to testify as to its current status. In view thereof, applicant failed to establish the current status of the registration, and therefore opposer's motion to strike applicant's Registration No. 3154785 for the mark LEI LEI for toys, games, and playthings is granted. See *Alcan Aluminum Corp. v. Alcar Metals, Inc.*, 200 USPQ 742, 744 n.5 (TTAB 1978). Applicant's registration has been given no consideration.⁵

B. Excerpts from applicant's discovery deposition taken by opposer.

Trademark Rule 2.120(j) reads as follows, so far as pertinent (emphasis added):

(j) *Use of discovery deposition, answer to interrogatory, admission or written disclosure.* (1) **The discovery deposition of a party** or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, **may be offered in evidence by an adverse party.**

⁵ We note in any event that even if opposer's motion to strike applicant's registration had been denied and we considered the registration for whatever probative value it adds to applicant's case, it would not change our decision in this opposition.

* * *

(4) If only part of a discovery deposition is submitted and made part of the record by a party, an adverse party may introduce under a notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party. A notice of reliance filed by an adverse party must be supported by a written statement explaining why the adverse party needs to rely upon each additional part listed in the adverse party's notice, failing which the Board, in its discretion, may refuse to consider the additional parts.

The rule provides that a party may not introduce its own discovery deposition unless it is used to supplement an excerpt from that deposition relied upon by the adverse party. Opposer has not introduced into evidence any portion of applicant's discovery deposition. Accordingly, applicant may not introduce her own discovery deposition taken by opposer. Opposer's motion to strike applicant's discovery deposition is granted.

The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and the registration file for respondent's mark. The record also includes the following testimony and evidence:

A. Opposer's Evidence.

1. Declaration of David Melnick, Vice President of Consumer Marketing and Research for Jones Apparel Group, Inc., opposer's parent corporation, with attached exhibits;

2. Declaration of Helene Rosenfeld, Senior Marketing Director of Jones Apparel Group, Inc., with attached exhibits;

3. Declaration of Tami Fersko, Vice President and Treasurer of Import Technology of Texas, Inc., the General Partner of Jones Apparel of Texas II, Ltd., a licensee of opposer, with attached exhibits; and,

4. Declaration of Robin Mandell, opposer's Assistant Treasurer, with attached exhibits, including, *inter alia*, certified copies showing the current status and title of opposer's pleaded registrations.

B. Applicant's evidence.

1. Declaration of applicant, with attached exhibits; and,

2. Declaration of Michelle B. Lee, applicant's counsel.

Standing

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc.*

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v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189
(CCPA 1982).

Priority

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case. *King Candy Co. 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 issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, 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, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

A. The similarity or dissimilarity and nature of the goods.

It is well settled that likelihood of confusion is determined on the basis of the goods as they are identified in the application and in the pleaded registrations.

Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). The description of goods in the LEI LEI application is "handbags, purses, wallets, and cosmetic bags sold empty." Opposer's L.E.I marks are registered for clothing and other fashion accessories including, *inter alia*, handbags, purses, and wallets. Thus, at least some of the goods of the parties are identical.

Because the question of likelihood of confusion must be determined by analyzing the goods as described in the application and the registrations, we cannot consider applicant's argument and evidence that her handbags, purses and wallets are intended as gift items, rather than fashion accessories.

B. The similarity or dissimilarity of established, likely-to-continue trade channels and buyers to whom sales are made.

Because there is no limitation or restriction in the description of goods in the application or opposer's registrations, the handbags, purses, and wallets identified in the description of goods are presumed to travel in the same channels of trade to the same class of purchasers. See *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or

registration). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 62 USPQ2d at 1005; *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). As indicated above, because our analysis is based on the description of goods in the application and registrations, and not extrinsic evidence, applicant's evidence and argument that her products will be sold in gift shops, not department stores and national chain stores, and that her products are targeted to young girls age 5 to 8, not "fashion forward junior customers between the ages of 13-17," cannot be considered.

C. The strength of opposer's mark.

Opposer's registrations for the mark L.E.I. LIFE ENERGY INTELLIGENCE in a stylized format suggest that the opposer's mark L.E.I. comprises the initials for the words "Life," "Energy," and "Intelligence." There is no other evidence in the record regarding whether opposer's mark L.E.I. has any significance in connection with purses, handbags, and wallets, or any other clothing or fashion accessories. Accordingly, the mark L.E.I. is fanciful or arbitrary when used in connection with purses, handbags, wallets, clothing, and other fashion accessories.

With respect to the marketplace strength of its mark, opposer has submitted substantial evidence demonstrating the renown of its mark. Teenage Research Unlimited is a

research company focusing on teenage fashions.⁶ According to that company's 2004 quantitative survey of over 2,000 teenagers age 12 to 19, L.E.I. jeans were rated the favorite jeans brand among 13 to 17 year old girls.⁷

Opposer subscribes to NPD Group point-of-sale apparel reports.⁸ NPD Group provides point-of-sale market information from retailers to manufacturers who subscribe to its services.⁹ Based on the January 2006 NPD Fashionworld Womenswear POS [point-of-sale] data from retailers, L.E.I. brand jeans ranked first, based on unit volume of actual sales in department stores among junior jean brands.¹⁰ In national chain store sales, L.E.I. brand jeans ranked second among junior brands.¹¹

From 2004 through 2006, opposer has spent more than \$10,000,000 advertising and promoting L.E.I. branded products. This figure includes both national advertising and cooperative expenditures with retailers.¹² Advertisements for L.E.I. branded products have appeared in such national magazines as *Seventeen*, *Teen Vogue*, *Cosmogirl*,

⁶ Melnick Declaration, ¶3.

⁷ Melnick Declaration, ¶4; Exhibit A.

⁸ Melnick Declaration, ¶5.

⁹ Melnick Declaration, ¶3.

¹⁰ Melnick Declaration, ¶5; Exhibit B. For purposes of comparison, Levi's ranked second, DKNY Juniors was seventh and Guess? jeans was ninth.

¹¹ *Id.* Private labels were first, Levi's was third and GLO was fourth.

¹² Fersko Declaration, ¶5.

and *Teen People*.¹³ Consequently, between 2003 and 2006, opposer has grossed more than \$630,000,000 from sales of L.E.I. branded products. L.E.I. branded products are sold in department stores such as Macy's and Goody's, national chain stores such as Kohl's, Sears, and JCPenney, and off-price retailers such as Marshall's and TJ Maxx.¹⁴

Based on the foregoing, we find that opposer's L.E.I. marks would be widely recognized by consumers, and therefore may be characterized as strong marks entitled to a broad scope of protection.

D. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. Du Pont de Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). *See also In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988). In comparing the marks, we are mindful that where, as here, the goods are in-part identical, the degree of similarity necessary to find likelihood of confusion need

¹³ Rosenfeld Declaration, ¶7; Exhibit H.

¹⁴ Fersko Declaration, ¶4.

not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981); *ECI Division of E-Systems, Inc. v. Environmental Communications Incorporated*, 207 USPQ 443, 449 (TTAB 1980).

Applicant's mark LEI LEI is sufficiently similar in appearance to opposer's L.E.I. marks to create confusion especially because opposer's mark is a strong mark and both marks are used on identical products. Under these circumstances, opposer's use of periods between the letters and applicant's repetition of the word LEI are simply not sufficient to distinguish the marks. Even assuming that the marks are pronounced differently (e.g., opposer's mark may be pronounced as the individual letters L-E-I, while applicant's mark may be pronounced "Lay Lay"), we note that there is no correct pronunciation for marks and it is likely that at least some customers will pronounce the word LEI in both marks the same. Even considering the different commercial impressions that may be engendered by the different pronunciations, we find that the visual similarity of the marks outweighs any dissimilarities in sound, meaning, or commercial impression.

E. Balancing the factors.

Taking into account all of the evidence as it pertains to the relevant likelihood of confusion factors, we conclude that applicant's mark LEI LEI, when used on "handbags, purses, wallets, and cosmetic bags sold empty," is likely to cause confusion with opposer's L.E.I. marks used in connection with clothing and fashion accessories, including, *inter alia*, handbags, purses, and wallets. To the extent that any doubts might exist as to the correctness of this conclusion (and we have none), we resolve such doubts against applicant. See *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1285 (Fed. Cir. 1984), quoting, *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983); *Carlisle Chemical Works v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 11, 112 (CCPA 1970). See also, *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433, 437 (TTAB 1983).

Decision: The opposition is sustained and registration to applicant is refused.