

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: September 5, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Hachette Filipacchi Presse  
v.  
Ev International, LLC

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Opposition No. 91174433  
to application Serial No. 78545895  
filed on January 11, 2005

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Perla M. Kuhn of Hughes Hubbard & Reed LLP for Hachette  
Filipacchi Presse.

Karla C. Shippey of Law offices of Karla Shippey for Ev  
International, LLC.

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Before Kuhlke, Cataldo and Taylor, Administrative Trademark  
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Ev International, LLC, seeks registration of  
the mark shown below for goods identified in the application  
as "clothing, namely, bras, underwear, thong underwear,  
nightgowns, pajamas, camisoles, robes, maternity support  
underwear, maternity support belts, breast-feeding bras,  
breast-feeding night gowns, maternity swimwear, maternity  
panty hose, maternity camisoles, maternity pajamas, maternity

robes, and maternity thong underwear" in International Class 25.<sup>1</sup> The word LINGERIE is disclaimed and the application includes the translation statement that "the foreign wording, CHEZ ELLE in the mark translates into English as 'House of the Women.'"



Opposer, Hachette Filipacchi Presse, opposed registration of applicant's mark on the grounds that, as applied to applicant's goods, the mark so resembles opposer's previously used and registered ELLE and ELLE formative marks for "including, among others, goods and services in the magazine, apparel, footwear, jewelry, cosmetics, food, home décor, publishing, news, advertising and multimedia fields" 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).<sup>2</sup>

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<sup>1</sup> Serial No. 78545895, filed January 11, 2005. The application is based on an allegation of a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

<sup>2</sup> Opposer's assertion of dilution under Section 43(c) in the pleading is deficient inasmuch as opposer did not plead that its mark became famous prior to the filing date of the involved application. *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000). In any event, in its brief opposer stated that it is not pursuing the dilution claim.

Applicant filed an answer by which it admitted the allegations in paragraphs 4 and 5 of the notice of opposition concerning the status and title of opposer's pleaded registrations and otherwise denied the salient allegations. Applicant's answer also included "Affirmative Defenses" that are more in the nature of amplifications of applicant's general defense that there is no likelihood of confusion.

The evidence of record consists of the pleadings herein; the file of the opposed application; and the "Joint Stipulated Facts and Submissions of Evidence." The parties also filed main briefs and opposer filed a reply brief.

We begin by noting the efficient and cooperative manner in which the parties and their attorneys have litigated this case, resolving discovery issues without the need for Board interference and presenting the case on stipulated facts.

**PRIORITY/STANDING**

Priority is not in dispute. With respect to the opposer's pleaded registrations, as noted above applicant admitted "the existence of the registrations." In addition, the registrations are stipulated into the record by the joint stipulation and the attached printouts from the Trademark Applications and Registrations Retrieval (TARR) database. Opposer's registrations as well as the stipulated facts regarding both the registrations and opposer's common

law use, establish opposer's priority of use of the ELLE and ELLE formative marks for all of the various goods and services listed in the registrations and the stipulations. In view thereof, opposer has also established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

Accordingly, we turn to the question of likelihood of confusion.

**LIKELIHOOD OF CONFUSION**

We begin by noting that while opposer has made sixteen registrations of record, for our analysis of the other du Pont factors we focus our attention on the following most relevant registrations:

Reg. No. 758137 for the mark ELLE (in typed form) for a "magazine," renewed;

Reg. No. 862001 for the mark ELLE (in typed form) for "dresses, cloaks, capes, skirts, jackets, suits, two-piece costumes or suits, coats, sweaters, bathing suits, jodphurs, knickers, ties, scarves, square shawls, hats, caps, gloves, and slippers," renewed; and

Reg. No. 2242315 for the mark ELLE (in typed form) for, inter alia, "entertainment services in the nature of a cable television variety show featuring fashion and beauty," Sections 8 and 15 affidavits accepted and acknowledged.

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

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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).

Another key factor, is the fame of the prior mark. We begin with this factor, because fame "plays a 'dominant' role in the process of balancing the du Pont factors." *Recot Inc. v. Benton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). See also, *Palm Bay Imports, Inc. v. Veuve Clicquot*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). In addition, fame "varies along a spectrum from very strong to very weak." *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003).

It is stipulated that the mark ELLE is used in connection with "the world-famous women's magazine." Stip. ¶3. It is further stipulated that the French language magazine has been distributed in the United States since 1945 and the United States edition was first published in 1985, Stip. ¶4; ELLE magazine is read by over four million readers each month, id.; 24 % of women aged 18 to 49 have read one or more issues of ELLE in the past six months, id.; ELLE's online magazine receives 26 million page views per

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month and 600,000 unique user's per month, id.; since 1965 opposer has sold women's clothing, Stip. ¶5; it advertises its clothing line in various publications, Stip. ¶7; and opposer uses its ELLE mark in connection with "the fashion and clothing featured in the popular television series Project Runway," where one of the judges on the show is the fashion director for ELLE magazine and approximately 5.6 million viewers watched the third season's finale, Stip. ¶9.

As shown through the stipulated facts and evidence, opposer has extensive sales and readership in connection with the magazine under the ELLE mark. In addition, the ELLE mark is broadly connected generally with the fashion industry, in particular for women's clothing, as evidenced by its high profile position in sponsoring the extremely popular cable show Project Runway. Moreover, the mark is used with a wide variety of goods and services, including magazines, umbrellas, luggage, hand bags, swimwear, dresses, watches, promoting the sale of women's apparel by others by staging style shows and by preparation of various types of advertising, technical assistance services for fashion shows and fashion wear boutiques, and entertainment services in the nature of a cable television variety show featuring fashion and beauty. On this record, we find that opposer's ELLE mark is famous in connection with its magazine and within the fashion industry generally, and is entitled to

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broad protection. *Bose Corp. v. QSC Audio Products, Inc.*,  
293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002).

Applicant argues that:

The mere fact that Opposer's mark has a strong reputation in the field of women's fashion and designer clothing and magazines does not automatically mean that there would be likelihood of confusion with Applicant's mark used in connection with the limited field of maternity lingerie.

Br. p. 20.

The cases cited by applicant do not support its position. In *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998), the Board found there was insufficient evidence upon which to support a finding of fame. Here, applicant has conceded that opposer "has submitted significant evidence of the strength of its mark."

Br. p. 20. In the ex parte decision *In re Comexa Ltda.*, 60 USPQ2d 1118 (TTAB 2001), the Board found a likelihood of confusion. Finally, in the ex parte decision *In re General Motors Corp.*, 23 USPQ2d 1465, 1471 (TTAB 1992), the Board found no confusion based on an evidentiary showing that the term *Grand Prix* was highly suggestive in the field of automobiles and auto parts, and that given 30 years of coexistence there was no incidence of actual confusion despite the fame of applicant's mark. Here, there is no evidence that ELLE is diluted by third-party use nor has there been an opportunity for actual confusion inasmuch as

there has been little coexistence in the United States marketplace. Stip. ¶¶32-33.

Applicant further argues that the term ELLE is weak in connection with opposer's goods and services because it translates to "she" in English and thus "actually labels the market for Opposer's goods and would be considered a descriptive mark without sufficient evidence of acquired distinctiveness." Br. p. 15. First, other than the translation "she," there is nothing in the record to support applicant's argument that ELLE is weak, such as, for example, third-party use. See *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559, 1565-1566 (TTAB 1996). Second, there is no counterclaim challenging the registrations and we must accord them all the presumptions afforded by Section 7(b). Thus, to the extent applicant argues that ELLE is descriptive, in the absence of a counterclaim, it is an improper collateral attack. Finally, in view of our finding of fame, even considering the term ELLE to be suggestive rather than completely arbitrary when used in connection with opposer's goods and services, it is a strong mark.

We turn next to a consideration of the similarities between opposer's and applicant's goods and services, channels of trade and class of purchasers. We must make our determinations under these factors based on the goods and services as they are recited in the application and

registrations, respectively. See *In re Elbaum*, 211 USPQ 636 (TTAB 1981).

As a preliminary matter, in the stipulated facts, paragraph 30 lists the goods identified in the application. However, paragraph 31 provides as follows:

31. Applicant has sold or intends to sell women's maternity underwear, namely maternity bras, maternity support underwear, maternity support belts, breast-feeding bras, breast-feeding night gowns, maternity swimwear, maternity pantyhose, maternity camisoles, maternity pajamas, and maternity robes. Applicant has agreed to modify its specification of goods to limit the coverage to maternity goods only and this opposition proceeding will continue against such modified identification of goods.

However, opposer continues to refer to the applicant's identification of goods as listed in the application which includes items that are not restricted to maternity wear. In view of the stipulation, we make our determination based on the maternity wear alone. We further note that considering only applicant's maternity wear does not change our analysis, inasmuch as opposer's registrations do not exclude this subset of clothing and we must presume they encompass these goods.

Applicant argues that its goods are distinguished from opposer's goods because applicant's "focus is on maternity lingerie and all goods in its amended specification are for maternity use" and "opposer has been in business since 1945 but has not in more than 50 years extended its business to

cover maternity underwear or lingerie. Its registered marks do not constitute constructive notice of exclusive rights in this field." Br. p. 17.

While applicant is correct that "if a cited registration contains a limitation as to the nature, type, channels of trade, or class of purchasers, an applicant's narrow identification of unrelated goods can avoid likelihood of confusion," there is no such limitation in opposer's registration. The designation "bathing suits" in Reg. No. 862001 is not limited and, therefore, encompasses all types of bathing suits including maternity bathing suits. Thus, applicant's identified "maternity swimwear" is encompassed by opposer's "bathing suits" in Reg. No. 862001 and, as such, are legally identical.

Moreover, even taking into account the differences in maternity versus nonmaternity clothing items, as opposer argues:

There is no limitation in the registration excluding maternity wear from these items of clothing. Pregnant women wear dresses, skirts, bathing suits, and slippers, as well as lingerie and underwear. Further, as women go through the different stages of life, including before, during, and after pregnancy, they will purchase different articles and lines of clothing under the same brand. These consumers, seeing Hachette's ELLE mark along with other terms on Applicant's women's clothing, will think that the clothing originates from the same source, namely Hachette. Moreover, the fact that Hachette, which is well known as a magazine that contains features and articles on clothing, also licenses the sale of clothing and other items of apparel (jewelry,

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footwear, and spectacles) under the ELLE Marks, reinforces to consumers the relatedness of the goods and the likelihood that clothing bearing a mark containing the term "elle" originates from Hachette.

Reply Br. pp. 9-10.

As to the magazine in Reg. No. 758137 and the entertainment services in the fashion field in Reg. No. 2242315, we find that these goods and services are related to applicant's maternity clothing to the extent that consumers have already seen opposer expand its use of the famous mark ELLE from the magazine and cable show to its own line of clothing.

With regard to the channels of trade and class of purchasers, inasmuch as there are no restrictions in the registrations and the application, we must presume that applicant's goods would be sold in all appropriate channels of trade, including those in which opposer's goods are sold and to the same relevant purchasers. 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). These channels of trade for the clothing items would include retail clothing stores. Applicant's argument that it only sells its clothing through a specific website is unavailing inasmuch as we must make our determination on the unrestricted goods as identified in the application.

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. Applicant's goods range in price from \$9.99 to \$38.99 retail. Stip.

¶32. Opposers pricing is also moderate.<sup>3</sup> Although it may be that consumers would exercise some higher level of care with regard to at least maternity 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 applicant's 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 Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). Therefore, to the extent there is some

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<sup>3</sup> Although it is not clear why retail prices are confidential, opposer's prices were submitted under seal.

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discretion in purchasing applicant's maternity wear, we find it is not sufficient to offset the other du Pont factors in this case.

We turn then to the first du Pont factor, i.e., whether applicant's mark CHEZ ELLE LINGERIE and design and opposer's mark ELLE 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 of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

As discussed above, opposer's ELLE mark is famous. Thus, to the extent the mark is suggestive of goods and services directed towards women, in that ELLE translates to "she," opposer's mark nonetheless is a very strong mark due to its fame and entitled to broad protection.

Applicant's mark incorporates the entirety of opposer's famous mark. The disclaimed term LINGERIE is the generic

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name of some of the identified goods. With regard to the design of the woman, we first note that in general words will dominate over a design element inasmuch as it is the words by which consumers call for the goods. In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1554 (TTAB 1987). Moreover, this design of a woman in either lingerie or a bathing suit is suggestive of the goods.

The last element, CHEZ, is merely a preposition. CHEZ is defined as, "prep. At, to, in (the house, family or country of) ... je viens de chez ma mere I have come from my mother's." See Cassell's New French Dictionary (5th ed. 1951).<sup>4</sup> As noted by opposer, "the addition of the pronoun 'chez' in Applicant's Mark adds meaning to the mark - namely, it conveys location - but it does not change the meaning of the word 'elle,' which is still a female pronoun." Reply Br. 7. Thus, although the translation in the application is "House of the Women," "chez elle" could also translate to "her house," or, given the fame of the ELLE mark in the fashion industry, could be perceived as ELLE'S house or House of ELLE for those consumers who would translate CHEZ. For those consumers who do not speak French, "CHEZ ELLE" would have no meaning other than the

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<sup>4</sup> The Board may take judicial notice of dictionary definitions. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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instantly recognizable ELLE mark when viewed in connection with women's clothing. In general, ELLE stands out in applicant's mark as the more memorable element. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

With regard to sound, applicant argues that in its mark "the word 'elle' does not stand alone in pronunciation, but is slurred into 'chez' so that the second syllable actually becomes 'zel.'" Thus, the first word of Applicant's mark is "shayzel," and "elle" is not said separately. Again, there is no added emphasis on the word "elle"; it does not dominate the sound of the mark." Br. p. 13. However, "[t]here is no correct pronunciation of a trademark, and it obviously is not possible for a trademark owner to control how purchasers will vocalize its mark." *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006). Moreover, it is impossible to know how consumers who do not speak French will pronounce "chez" and "elle."

In view of the above, the marks as a whole are similar, and even though there are some differences in appearance due to the design component and additional wording in applicant's mark, these differences are not sufficient to distinguish applicant's mark from opposer's mark, in particular given the fame of opposer's mark; overall they convey similar commercial impressions. Thus, we find that

the similarities in the parties' marks outweigh the differences and the similarity of the marks weighs in favor of a finding of likelihood of confusion.

Finally, opposer argues that "consumers are accustomed to seeing marks containing the term 'elle' as well as an additional term, such as Hachette's marks ELU PAR ELLE, ELLE ACCESSORIES, and ELLE GIRL, for clothing and related goods, and understanding those marks as conveying that the goods originate from Hachette. The additional terms in Applicant's Mark do not function differently." Reply Br. pp. 7-8. However, opposer did not plead a family of marks. Moreover, although opposer submitted its registrations, there is no evidence of use of these specific ELLE formative marks to support a finding that "the pattern of usage of the common element is sufficient to be indicative of the origin of the family." *The Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1490 (TTAB 2007) citing *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991).

Considering the respective marks in their entireties, we conclude that the evidence of record as it pertains to the relevant du Pont factors supports a finding of likelihood of confusion as to opposer's ELLE mark, and that registration of applicant's mark, CHEZ ELLE LINGERIE and design, therefore, is barred under Trademark Act Section

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2(d). To the extent we have any doubt, we resolve it, as we must, in favor of opposer, the prior user and registrant. *Hewlett-Packard Co. v Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002) ("This court resolves doubts about the likelihood of confusion against the newcomer because the newcomer has the opportunity and obligation to avoid confusion with existing marks").

**Decision:** The opposition is sustained.