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Paper No. 31
JQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Le Lido

Serial No. 74/115,369

Martin E. Goldstein and Randi S. Miller of Darby & Darby
for applicant.

Jessie W. Billings, Trademark Examining Attorney, Law
Office 103 (Michael Szoke, Managing Attorney).

Before Hanak, **Quinn** and Hohein, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Le Lido, a French
limited liability company, to register the mark shown below

for a wide variety of products falling into seven international classes, namely class nos. 9, 14, 16, 18, 21, 25 and 33.¹ With the exception of the listing of the alcoholic beverages in class no. 33, every identification of goods in the other classes concludes with the terminology "all the aforementioned goods related to a cabaret show." According to applicant, the goods are collateral to the nightclub cabaret show it produces under the same mark.

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered mark LIDO for "men's, women's and children's clothing, namely T-shirts, sweatshirts, pants and shorts" and "retail and discount store services featuring men's, women's and children's clothing, gift items and stationery"² as to be likely to

¹ Application Serial No. 74/115,369, filed November 14, 1990, alleging a claim of priority under Section 44(d) of the Trademark Act based on French application Serial No. 210,761 filed on May 18, 1990. The application matured into French Registration No. 1602916. The application includes the following statements: "The design element of the mark depicts a set of ostrich feathers."; and "An English translation of the mark is 'Lido of or from Paris.'" Applicant has disclaimed "de Paris" apart from the mark.

² Registration No. 1,538,205, issued May 9, 1989; combined Sections 8 and 15 affidavit filed. The registration includes the following statement: "The English translation of the word 'Lido' in the mark is 'seashore, land or beach.'"

cause confusion.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs.³ An oral hearing was not requested.

Applicant argues that the cited mark LIDO is weak and is entitled to only a narrow scope of protection due to its significance as a geographic term identifying a tourist destination in Florida where registrant is located. Applicant also asserts that the geographic designation "DE PARIS" and the design feature in its mark serve to clearly distinguish its mark from registrant's mark. Applicant further contends that the goods and services travel in different channels of trade, pointing to the limitation set forth in applicant's identification of goods. Applicant states that its mark "is used exclusively on items that are intended to be sold in connection with a Parisian style cabaret (musical review) that is performed either in a permanent location or on tour at various locations throughout the country" and that the goods "will be sold only at the theaters or night clubs where the cabaret is being performed or at shops that are adjacent to or in very close proximity to those facilities." The goods, according

³ The substitute appeal brief filed by applicant on February 10, 2000 is the operative brief for applicant.

to applicant, "are collateral items that are sold for promotional purposes and will not be marketed separately" and, "[t]hus, the consumers who buy applicant's goods will be attending or at least [be] familiar with applicant's productions and will understand that the source of these items is the production company." (brief, p. 12)

The Examining Attorney maintains that applicant's mark is dominated by the term "LIDO" which is identical to the cited mark. The Examining Attorney also contends that applicant's goods are related to registrant's goods and services, and that the channels of trade therefor are not necessarily dissimilar because the identification of goods and services in the cited registration does not include any limitation.

Before turning to the merits of the likelihood of confusion issue, we direct our attention to an evidentiary matter. Earlier in the appeal, applicant filed a request for remand and an appeal brief. By way of remand, applicant sought to comply with a requirement pertaining to the identification of goods, as well as to introduce additional evidence. The Board, in an order dated December 29, 1999, granted the remand request only to the extent that the Examining Attorney could consider the proposed amendment to the identification of goods. The remand

request with respect to the additional evidence was denied in view of applicant's failure to provide any reason why the additional evidence could not have been made of record prior to the filing of the notice of appeal. In the Board's order applicant also was advised that it would be given the opportunity to file a substitute brief if it so desired. Applicant later filed a substitute brief to which it attached exhibits (exhibits A-G). Applicant has asked that judicial notice be taken of this evidence. The Examining Attorney, in her brief, has objected to the submission as untimely, citing Trademark Rule 2.142(d) (but see discussion, infra, regarding Exhibit F).

The evidence attached to the substitute appeal brief comprises, by and large, the very same submission that the Board previously found, in its order dated December 29, 1999, to be untimely. In view of this earlier order, the Board is unpleasantly surprised by applicant's counsel's second attempt to introduce the same evidence. Applicant's counsel should refrain from such practice in the future.

Some of the exhibits in question, in any event, hardly present a case where judicial notice is proper.

Accordingly, exhibits B, D and E have not been considered. Notwithstanding the Board's annoyance at counsel's behavior on this particular point, exhibit A, a summary of the

prosecution history, could have been included as part of the brief and, therefore, the Board will consider it. Exhibit C (a geographical dictionary listing) and Exhibit G (a federal district court order involving third parties) are proper subjects of judicial notice, and we have considered them in reaching our decision. Exhibit F comprises TRADEMARKSCAN copies of two registrations owned by applicant.⁴ Although the Board does not take judicial notice of registrations issued by the Office, the Examining Attorney, in her brief, has treated these registrations as if properly of record. Accordingly, we have considered the registrations.

We now turn to the merits of the refusal. Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or

⁴ Registration No. 741,072, issued November 20, 1962 (renewed), for the mark LE LIDO for "organization and presentation of shows for presentation in various places;" and Registration No. 779,078, issued October 27, 1964 (renewed), for the mark LE LIDO for "printed display cards, menu cards, invitational cards, magazines, newspapers, newsletters, house organs, posters and programs."

services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). At the outset, we would point out that there is no *per se* rule governing likelihood of confusion in cases involving clothing items, but rather each case is to be determined on its own particular facts and circumstances. See, e.g., *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) and cases cited therein.

With respect to the marks, we find that, when the marks are considered in their entirety, the differences outweigh the similarities. The addition in applicant's mark of the terminology "DE PARIS," although geographically descriptive, must be considered in comparing the marks in their entirety. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). We find that this addition gives applicant's mark an overall commercial impression sufficiently different from the term "LIDO" standing alone.⁵ Further, applicant's mark includes a prominent design feature which is recognizable as the type of feather plume that is worn by performers during a cabaret show. Although we view the

⁵ As noted earlier, the term "LIDO," according to the cited registration, means "seashore, land or beach." The term appears in *Merriam-Webster's Geographical Dictionary* (3rd ed. 1998) and is identified as the island reef outside the Lagoon of Venice, Italy.

words in applicant's mark as being the dominant portion, the design nevertheless must be taken into account when the marks are compared.

Insofar as applicant's goods and registrant's goods and services are concerned, the fact that applicant has restricted its goods (except for the alcoholic beverages which obviously are not related to registrant's goods or services) to ones "related to a cabaret show" is of great significance. Although, as the Examining Attorney points out, registrant's goods and services are not restricted (that is, they will travel in all of the normal trade channels for such goods and services), we do not believe that the goods and retail store services of registrant must be construed to include products related to a cabaret show. We agree with applicant in this case that the restriction in its identification of goods serves to avoid likelihood of confusion. The restriction comports with applicant's remarks that its goods are collateral products to its cabaret shows and that the goods are not marketed separately, but rather in close connection with the shows performed under the same or a similar mark. Applicant's goods, as restricted in the identification of goods, simply are not the normal types of items encompassed within the breadth of registrant's identification of goods and

services. This is one of those cases which involves "particular facts and circumstances" where the restriction in an applicant's identification plays a significant role in the likelihood of confusion analysis because the restriction distinguishes the goods and/or services in a meaningful way. See: *In re The Shoe Works Inc.*, 6 USPQ2d 1890 (TTAB 1988).

Based on the relatively small record before us, we see the Examining Attorney's view of the likelihood of confusion as amounting to only a speculative, theoretical possibility, especially in view of the limitation in applicant's identification of goods. Language by our primary reviewing court is helpful in resolving the likelihood of confusion issue in this case:

We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), *citing* *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g* 153 USPQ 412 (TTAB 1967).

In sum, in view of the cumulative differences between the marks and between registrant's goods and services and

applicant's goods which, in applicant's case, are limited to "goods related to a cabaret show," we conclude that consumers are unlikely to be confused as to the source of the goods.

Decision: The refusal to register is reversed.

It is noted that the underlying French registration was due to expire on May 18, 2000. The foreign registration must be in force at the time the United States issues the registration based on that foreign registration. *Fioravanti v. Fioravanti Corrado S.R.L.*, 230 USPQ 36, 41 (TTAB 1986). The Board has received a copy of the renewal of the registration in France, and applicant's counsel indicates that it will provide a certified copy and an English translation of the renewal in due course. Accordingly, the application file is being forwarded to the Examining Attorney to await receipt of proof of renewal of the French registration. *Trademark Manual of Examining Procedure*, §1004.03.

E. W. Hanak

T. J. Quinn

G. D. Hohein
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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