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Paper No. 37
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Eredi Chiarini S.R.L.
v.
Braemore Neckwear Company

Opposition No. 111,483
to Application No. 75/269,411
filed on April 4, 1997

Theresa W. Middlebrook and Charles R. Halloran of
Christie, Parker & Hale for opposer.

Bruce A. Tassan, Esq. for applicant.

Before Simms, Walters and Holtzman, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Eredi Chiarini S.R.L. filed its opposition to the
application of Braemore Neckwear Company to register the
mark CHIARINI for "clothing, namely, neckties, ascots,
scarves, pocket squares, bow ties, belts, suspenders,
braces, cummerbunds, vests, socks, gloves, dress shirts,
sports shirts, knit shirts, boxer shorts, briefs,

sweaters, pullovers, knit ties, and leather ties" in International Class 25.¹

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and famous marks EREDI CHIARINI and CHIARINI for men's clothing items, including neckties, as to be likely to cause confusion, under Section 2(d) of the Trademark Act.²

Applicant, in its answer, denied the salient allegations of the claim; although applicant admitted "it was aware of one retail store in Italy using the mark EREDI CHIARINI and Design."

The Record

The record consists of the pleadings; the file of the involved application; a certified status and title copy of applicant's Registration No. 2,421,357; applicant's responses to opposer's first set of interrogatories; and excerpts from printed publications, all made of record by notices of reliance. The record

¹ Application Serial No. 75/269,411, filed April 4, 1997, based upon use of the mark in commerce, alleging dates of first use and first use in commerce as of December 1996.

² Opposer appears to assert in its notice of opposition a claim under Section 2(a) of the Trademark Act, based on a false suggestion of a connection with opposer's company and its founders. However, this issue is not raised again by opposer, nor has it been tried by the parties. Therefore, we consider any claim under Section 2(a) to have been abandoned by opposer.

also includes the testimony depositions by opposer of Stefano Larese DeSanto, president of UniSource, the U.S. distributor of opposer's neckwear under the ERIDI CHIARINI mark; Massimo Somenzini, a co-owner of Big Ben, opposer's licensee for design and manufacture of its neckwear; and Marco Chiarini, a member of opposer's board of directors, all with accompanying exhibits. Both parties filed briefs on the case³ but a hearing was not requested.

Facts and Analysis

As a preliminary matter, we address applicant's assertion for the first time in its "supplemental reply brief" of a *Morehouse* defense. *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969). Applicant is the owner of a prior United States trademark registration, No. 2,421,357, for the CHIARINI mark shown below.

³ Because the Board reopened applicant's testimony period, the parties were given time to supplement their briefs. Opposer declined to do so. Applicant's brief entitled "Supplemental Reply Brief" has been considered by the Board as a properly submitted supplement to its originally filed brief. However, the photocopies of trademark registrations in Mexico and Canada, which are attached to this brief, are untimely and have not been considered. Furthermore, registration in

This mark registered on January 16, 2001 and has a filing date, its constructive date of first use, of February 4, 2000. The goods listed in the registration are almost identical to the goods recited in the application in this case. Applicant alleges that opposer had the opportunity to oppose or petition to cancel applicant's registration, but did not do so; that the marks and goods in applicant's registration and its pending application are substantially the same; and that, therefore, opposer cannot be damaged by the issuance of a registration in this case. A *Morehouse* defense is an equitable defense. *O-M Bread, Inc. v. United States Olympic Committee*, 65 F.2d 933, 36 USPQ2d 1041 (Fed. Cir. 1995) [wherein the Federal Circuit discusses the burden necessary to successfully prove such a defense.] It is an affirmative defense, which applicant did not plead; and it was not tried by the parties by consent, implicit or otherwise. Thus, without addressing the merits of applicant's late claim, we have given applicant's contentions in this regard no consideration.

Mexico and Canada is not relevant to the issue of registrability before us.

Turning to the facts of the case before us, the record establishes that opposer is an Italian company that sells men's clothing, labeled EREDI CHIARINI, through its retail men's boutique of the same name in Florence Italy. Since 1993, another Italian company, Big Ben, has been opposer's exclusive licensee for the design, manufacture and worldwide distribution of opposer's EREDI CHIARINI collection of products. Big Ben, in turn, has an agreement with UniSource, a United States company, to be Big Ben's agent for the distribution of neckwear, including opposer's EREDI CHIARINI collection, in, at least, the United States and Canada. Neckwear, specifically, men's ties, is the only EREDI CHIARINI product from opposer available in the United States.⁴ UniSource is primarily a marketing company with the main objective of distributing European consumer goods, particularly, men's and women's clothing and accessories.

In the United States, UniSource sells EREDI CHIARINI collection ties directly to retailers from its New York showroom; it shows the collection at trade shows, where

⁴ There is insufficient evidence in the record to support a finding that opposer uses the term CHIARINI as a mark without EREDI. Thus, we base our decision on consideration of opposer's mark EREDI CHIARINI for neckwear.

it takes orders from retailers; and it sells the collection through visits to retail clients. Upon receipt of an order through UniSource, Big Ben produces a sample collection of the order, which is sent to the purchaser, either directly or through UniSource. The full order is shipped within four months. Approximately 20% of the ties from the EREDI CHIARINI collection, which consists of designs particular to the collection, are sold to the ultimate consumer under other trademarks. The remaining 80% of EREDI CHIARINI collection ties sold in the United States have the EREDI CHIARINI label sewn directly on the ties. The mark also appears on packaging for ties sold at retail and on shipping cartons to the retailer. The same logo, shown below, is used on all ties sold under the EREDI CHIARINI mark.

The evidence supporting opposer's use of the EREDI CHIARINI mark on ties includes facts not pertinent to use of the mark for ties in the United States. For example, the evidence includes sales figures and invoices for EREDI CHIARINI ties sold in Canada and for ties sold in

the United States from the collection, but not identified by the EREDI CHIARINI mark.⁵ We have considered only the evidence pertaining to use of the mark EREDI CHIARINI in the United States.⁶

Regarding opposer's first use in the United States of its mark EREDI CHIARINI on ties, Mr. DeSanto, UniSource's president, testified that UniSource first presented EREDI CHIARINI ties in January 1995 at a trade show in Florence, Italy, where UniSource made its first sales; and that UniSource first made sales to U.S. companies in January and March 1995, with delivery in July 1995. The evidence shows continuous sales from January 1995 to the present of EREDI CHIARINI-labeled ties to retailers in the United States.

Opposer has alleged, but not established, that its mark is famous. The evidence and testimony concerning

⁵ Applicant has objected to opposer's invoice evidence as not the best evidence because it consists of photocopies rather than originals. For the same reason, applicant has objected to evidence excerpted from magazines, and because several of the excerpts are from magazines not for the U.S. market. Opposer's witnesses have testified that these are authentic copies and applicant has not presented any evidence indicating otherwise. Additionally, opposer's witnesses have translated or explained pertinent portions of those invoices not in English. The magazines are similarly acceptable. Those magazines not distributed in the United States are not relevant to establish use of the mark on ties in the United States; however, the excerpts are relevant to opposer's claim that its mark is famous in the United States. Therefore, we have considered this evidence to the extent indicated.

⁶ While both the documentary evidence and the testimony evidence are, at times, confusing, taking the evidence as a whole we find it sufficient

sales figures are confidential and, therefore, have not been disclosed in this opinion. Considering only those ties sold in the United States under the EREDI CHIARINI mark, opposer's sales in the United States are not substantial.⁷ Opposer has provided no statistics regarding overall men's tie sales in the United States to form a basis for comparison. Nonetheless, considering the large number of men in the United States who purchase ties, and who presumably purchase more than one tie, opposer's sales figures are relatively small. Other than its own conclusory testimony, opposer has submitted no evidence regarding the significance of the EREDI CHIARINI name to consumers.⁸ We cannot conclude that it is a famous mark for ties in the United States.

Applicant is a Canadian company. Besides evidence, *supra*, of applicant's existing registration, the only additional facts concerning applicant in the record are its admission in its answer that "it was aware of one retail store in Italy using the mark EREDI CHIARINI and

to establish the facts of opposer's use of its EREDI CHIARINI mark on ties in the United States.

⁷ Although opposer's sales are not substantial, opposer has established valid use of its mark in commerce. Applicant's argument that opposer's use is merely unacceptable token use is not well taken.

⁸ The appearance of EREDI CHIARINI ties in a few pictures and endorsements in a couple of magazines distributed in the United States does not establish fame.

design"; and its answers to opposer's first set of interrogatories, which were submitted by opposer's notice of reliance.

In its answers to interrogatories, applicant stated that it sells only men's neck ties under the mark CHIARINI (No. 2); that applicant first began selling goods under the mark CHIARINI in January 1997 and started shipping goods in May 1997⁹ (No. 3); and that applicant's goods are sold through retail stores (No. 13). Regarding its choice of the CHIARINI mark, applicant, in its responses to these interrogatories, stated that "[t]he term CHIARINI was selected by the applicant because of the sound of the name and also the fact that it is of Italian origin and therefore consistent with the origin of the fabric used for the product" (No. 6); that "on a trip to Florence, Italy, [applicant's principals] visited a menswear boutique by the name of Eredi Chiarini ... to purchase some personal items [and that] this trip would have taken place some time in 1995 and 1996" (No. 10); and that applicant's guidance or inspiration in the creation of the logo format in the application herein was

⁹ Applicant is a Canadian company and these dates of use neither specify whether this first use was in the United States nor distinguish between its use in the United States and Canada. Thus, this statement does not establish applicant's first use in the United States of its mark in connection with any of the identified goods.

"[a] business card from the Eredi Chiarini menswear boutique" (No. 12).

Turning to consider the issues of priority and likelihood of confusion, applicant, in both its original brief and its "supplemental reply brief," argues only procedural matters dealt with *supra* and the issues of use and priority, appearing to concede the issue of likelihood of confusion. We find that the record before us clearly establishes opposer's priority. Whether we consider opposer's agent's first sales to retailers of January 1995 or its first deliveries of July 1995, opposer's dates of use of the mark EREDI CHIARINI on men's ties pre-date the constructive use date available to applicant, the April 4, 1997 filing date of the application in this case.¹⁰

Considering the issue of likelihood of confusion, it is clear that opposer's goods, men's ties, are identical to the same goods listed in applicant's identification of goods. Regarding the marks, both marks contain the identical term CHIARINI. The initial term EREDI does not sufficiently distinguish opposer's mark from applicant's mark, CHIARINI. The marks are substantially similar in

¹⁰ Applicant has not otherwise established dates of use in this proceeding.

sound, appearance, connotation and overall commercial impression. This conclusion is supported by the clear evidence that applicant based its mark on opposer's mark. Consumers are likely to consider men's ties identified by CHIARINI and EREDI CHIARINI to be different styles or collections from the same source.

Thus, we conclude that opposer has established its priority of use of its pleaded mark EREDI CHIARINI on its goods; and that there exists a likelihood of confusion as to source with respect to the parties marks on the goods involved herein.

Decision: The opposition is sustained.