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Paper No. 14
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Afendi, Inc.

Serial No. 75/873,722

Ajay A. Jagtiani of Jagtiani + Gutttag for Afendi, Inc.

Michael W. Baird, Trademark Examining Attorney, Law Office 109 (Ronald R. Sussman, Managing Attorney).

Before Cissel, Hairston and Rogers, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 17, 1999, applicant filed
the above-identified application to register the mark shown below

on the Principal Register for “boxes made of precious metal, ankle and wrist bracelets, brooches, cases made of precious metal, chains, costume jewelry, findings, identification bracelets, jewelry, jewelry pins for use on hats, lapel pins, and rings being jewelry,” in Class 14. The application was based on applicant’s claim that it had used the mark in commerce since October of 1991. Applicant claimed ownership of Registration No. 2,066,717 for the mark shown below.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that applicant’s mark, as used on the goods specified in the application, so resembles the marks shown below,

and

which are currently registered^{1[1]} for, respectively, “watches not made wholly or in part of precious metals, costume jewelry, namely, earrings, cufflinks, and ornamental pins, bracelets [and] necklaces,” and “watches, and parts therefor,” that confusion is likely.

Applicant responded to the refusal to register by amending the application to describe its goods as follows: “boxes made of precious metal, ankle and wrist bracelets, brooches, cases made of precious metal, chains, costume jewelry, findings, identification bracelets, jewelry, jewelry pins made of precious metal for use on hats, lapel pins, and rings being jewelry,” in Class 14. Applicant argued that confusion is not likely with the marks cited by the Examining Attorney because the marks, when considered in their entireties, are not similar, and, although the goods overlap, the trade channels differ and purchasers of these products are sophisticated.

The Examining Attorney accepted the amendment to the identification-of-goods clause in the application, but was not persuaded by applicant’s arguments

^{1[1]} Reg. No. 1,433,773 issued on March 24, 1987 to Fendi Paola E Sorelle, S.A.S, an Italian partnership; partial affidavit under Section 8 of the Act accepted; and Reg. No. 1,569,570 issued on December 5, 1989 to the same partnership; affidavits under Sections 8 and 15 accepted and acknowledged, respectively; renewed.

on the issue of likelihood of confusion. The refusal to register under Section 2(d) of the Act was continued and made final in the second Office Action.

Applicant responded by amending the application to delete the term “costume jewelry” from the identification-of-goods clause, and presenting arguments on the issue of likelihood of confusion.

Applicant concurrently filed a Notice of Appeal, which was timely followed by applicant’s appeal brief. The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for consideration of applicant’s response, which was deemed to be a request for reconsideration.

Responsive to the reconsideration request, the Examining Attorney maintained the refusal to register. Submitted in support of the refusal were photocopies from catalogues which demonstrate that watches are sold and promoted along with other items of jewelry, such as rings, necklaces and earrings. Also submitted were copies of a number of third-party registrations wherein the identification-of-goods clauses include “watches,” “necklaces,” “earrings,” “rings,” “chains” and “pins” as “jewelry.” The Examining Attorney asserted that this evidence shows that different items of jewelry, including watches, often emanate from a single source.

Applicant did not file a further response, so the Examining Attorney filed his appeal brief. Applicant then filed a timely reply brief,^{2[2]} but applicant did not request an oral hearing before the Board.

The issue before us in this appeal is whether confusion is likely in view of the prior registration of the two registered marks identified above. A third registered mark was originally cited as a bar to registration of applicant's mark, but the Examining Attorney subsequently withdrew the refusal based on that registration.

After careful consideration of the record in this application in view of the relevant legal authority and the arguments made by both applicant and the Examining Attorney, we hold that the refusal to register is well taken. Confusion is likely in this case because applicant's mark is similar to both of the cited registered marks and the goods specified in the application are related to those listed in the registrations.

We have analyzed this application in light of the facts in evidence which are relevant to the factors set forth in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). As in any likelihood of confusion

^{2[2]} Applicant attached additional evidence as "Exhibit A" to its reply brief. Trademark Rule 2.142(d) provides that the record is closed when a Notice of Appeal is filed, but the rule also provides a procedure whereby additional evidence can be submitted subsequently. Applicant did not follow this procedure, however, so we have not considered the additional evidence untimely submitted with applicant's reply brief.

analysis, two key considerations are the similarities between the goods and similarities between the marks. In re Azteca Restaurant Enterprises Inc., 5 USPQ2d 1209 (TTAB 1999).

We agree with the Examining Attorney that the goods must be considered to be in part identical. The application, as amended, still lists “jewelry,” and this term encompasses the registrant’s more narrowly identified “costume jewelry.”

Applicant presents a convoluted argument wherein a dictionary definition of “costume jewelry” is quoted as “jewelry designed for wear with current fashions and usually made of inexpensive materials” in support of its argument that costume jewelry is “separate” and “distinct” from jewelry. As applicant’s own definition shows however, costume jewelry is jewelry. Watches are also considered to be jewelry; even if this were not the case, this record plainly establishes that items of jewelry such as pins, bracelets and rings are promoted and marketed, together with watches, by the same businesses to the same potential purchasers. Moreover, the third-party registrations made of record by the Examining Attorney provide a basis for our conclusion that consumers have reason to expect that the use of the same or similar trademarks on these products is an indication that they emanate from a common source. Albert Trostel & Sons Co., 29 USPQ 2d 1783 (TTAB 1993); In re Mucky Duck Co., 6 USPQ2d 1467 (TTAB 1988).

Applicant’s arguments with respect to differences in the channels of trade and sophistication of the purchasers for its goods, as opposed to the goods sold

under the registered marks, are unsupported by evidence. Whether confusion is likely must be determined on the basis of the goods as they are identified in the application and the registrations, respectively. *Toys “R” Us, Inc., v. Lamps R Us*, 219 USPQ 340, (TTAB 1983). Neither the application nor the registration limits or restricts the trade channels or purchasers to whom these goods are sold. In the absence of such limitations, we must assume that the goods include all products which fall within the descriptions set forth in the application and registration, respectively, and that these products are sold to all the usual purchasers of them. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Thus in the instant case, where the goods identified in the application include “costume jewelry” and the cited registrations include both “jewelry” and “watches,” the goods are in part identical and therefore the trade channels and prospective purchasers, for purposes of determining whether confusion is likely, must be considered the same.

As noted above, applicant’s mark is similar to both of the registered trademarks cited by the Examining Attorney. Applicant’s mark combines the word “FENDI” with a design element consisting of a double letter “A,” one of which is inverted beneath the other. A small triangular design appears above the letter “I.” One of the registered marks is the word “FENDI.” The other combines “FENDI” with a design consisting of a double letter “F,” one of which is inverted beneath the other. When applicant’s mark is considered in its entirety and compared with the registered marks in their entireties, they are similar enough to

be likely to cause confusion when they are all used on the same or closely related goods.

We do not dispute that there are differences between applicant's mark and the cited registered marks, but these differences are insufficient to obviate the likelihood of confusion. Simply put, notwithstanding the distinctions argued by applicant, these marks create similar overall commercial impressions. The registrant uses "FENDI" by itself and "FENDI" with an inverted double-letter design. Applicant has appropriated the "FENDI" mark in its entirety, and has added to it an inverted double-letter design of its own, along with the aforementioned triangle design in place of the dot over the letter "I." Prospective purchasers of jewelry who are familiar with either of the registered marks are likely to assume that applicant's mark indicates that the products on which it is used emanate from the same source as the goods marketed under the registered marks. The use of a different letter inverted under itself before the mark of applicant is likely to be viewed simply as an indication of another line of "FENDI" jewelry or watches, perhaps even as an indication of a less expensive line of the goods for which applicant indicates registrant is famous.

In this regard, in its brief (at p. 16), applicant states that the registered marks "have substantial associated fame," but then proceeds to argue that the fame of the registered marks aids in distinguishing the origin of the goods "because of the desire of a purchaser to acquire a genuine 'FENDI' product." This argument is simply wrong-headed. In essence, applicant is contending that

the fame of the registered trademarks should be held against the registrant because purchasers will be aware that other sources of the same types of products are going to try to appropriate the goodwill the registrant has established in its famous mark and attach it to their own, less desirable, products. To the contrary, if this record provided a basis upon which we could conclude that the cited registered marks are famous, such a record would constitute an even stronger showing that confusion is likely. In reality, when a mark is famous, a purchaser is even less likely to perceive differences between the famous mark and one with which he or she is not familiar. In re Kenner Parker Toys, Inc., 963 F.2d 350, 22 USPQ2d 1453, (Fed. Cir. 1992). In the instant case, the fame of the registered mark certainly does not cut in applicant's favor.

We have no doubt that we have reached the proper resolution of this appeal, but even if we had doubts, they would necessarily have to be resolved in favor of the registrant and prior user, and against applicant, who, as the newcomer, had a duty to select the mark which is not

likely to cause confusion with the mark of the registrant and prior user.

Burroughs Wellcome Co. v. Warner-Lambert Co., 203 USPQ 191 (TTAB 1979).

DECISION: The refusal to register is affirmed.