

This Opinion is not a
Precedent of the TTAB

Mailed: July 13, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Gucci America, Inc.

v.

UGP, LLC

Consolidated Opposition Nos. 91223733 and 91223735

Andrea L. Calvaruso, Ana Y. Correa and Ryan C. Steinman
of Kelley Drye & Warren LLP for Gucci America, Inc.

Edward Raymond and Tatjana Labato for UGP, LLC.

Before Wellington, Adlin and Heasley, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant UGP, LLC seeks registration of the marks



and



for "electronic cigarettes"¹ in

¹ Application Serial Nos. 86436040 (the "040 Application"), the subject of Opposition No. 91223733, and 86435978 (the "978 Application"), the subject of Opposition No. 91223735, respectively, were each filed on October 27, 2014, based on an alleged intent to use the marks in commerce under Section 1(b) of the Trademark Act. Both applications indicate that the

International Class 34. In its notices of opposition, Opposer Gucci America, Inc. alleges prior use and registration of the mark GUCCI, in standard characters and a variety of stylized and design forms, for an exceedingly wide variety of goods and services, including, for example, leather goods, purses, shoes, clothes, jewelry and perfume. Many of Opposer's pleaded registrations are over five years old. As grounds for opposition, Opposer alleges that use of Applicant's marks would be likely to cause confusion with, and dilute, Opposer's marks. In its answer, Applicant admits that Opposer owns its pleaded registrations and "the world famous GUCCI mark in the United States," and that Applicant's president and namesake Uberto Gucci "is a blood relative and great grandson of the famous designer and [Opposer's] original founder

signature shown in the drawings identifies Uberto Gucci, who provided consent to register the marks. According to the '040 Application, "[t]he mark consists of the wording 'BY UBERTO GUCCI' in gold and white, outlined in black, with 'UBERTO GUCCI' underlined by a gold and white line outlined in black." According to the '978 Application, "[t]he mark consists of the wording 'DESIGNED' in pink, 'BY' in gold and white outlined in black and 'UBERTO GUCCI' in gold and white outlined in black and underlined by a gold and white line outlined in black and designs comprising a purple, dark purple, red and pink armor helmet featuring a pink and dark purple necklace wearing a pink and red crown with black circular stone designs and red and white diamond and rectangular stone designs. The crown features a gold top featuring green and white circles and rests on a pink and white cushion. Attached to both sides of the armor are floral arrangements featuring red, purple, pink, dark blue, blue-gray, black and purple flowers. Below the armor is a shield outlined in black, with a yellow top portion featuring a red flower outlined in dark blue and a dark blue carriage wheel/gear. Below the yellow portion are dark blue and red vertical bars with white borders. On top of the shield is a red, pink and gold crown with black and white circles on top, black circle stone designs and red and white diamond and rectangle stone designs. The remaining white areas in the drawing represent the transparent areas in the mark." The '978 Application includes a disclaimer of DESIGNED BY.

Guccio Gucci.” 4 TTABVUE 2, 3 (Answer ¶¶ 2, 4, 5).² Applicant denies most of the other salient allegations in the notice of opposition.

We denied Opposer’s motion for summary judgment on both of its claims in our May 23, 2017 order (the “Summary Judgment Decision”). 20 TTABVUE. We nevertheless found, in connection with Opposer’s dilution claim, that there is “no genuine dispute of material fact that Opposer’s word mark GUCCI became famous prior to the filing date of the involved intent-to-use applications.” *Id.* at 8. We further found that because Opposer did not plead “rights in the GUCCI marks for cigarettes, cigarette cases, lighters, matches or ashtrays,” and its registrations of GUCCI marks for these products were cancelled, its evidence of prior use and registration of GUCCI for these types of products would not be considered. *Id.* at 7. Opposer did not thereafter amend its notice of opposition to plead rights in its marks for these products, Applicant has not admitted that Opposer has trademark rights for these products and the question was not tried by implied consent. Accordingly, have not considered Opposer’s trial evidence regarding these products or the marks therefor.

I. The Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), the files of Applicant’s involved applications. In addition, Opposer introduced:

² Citations are to the record in Opposition No. 91223733 and refer to TTABVUE, the Board’s online docketing system. Specifically, the number preceding “TTABVUE” corresponds to the docket entry number(s), and any number(s) following “TTABVUE” refer to the page number(s) of the docket entry where the cited materials appear.

Trial testimony (by declaration) of Christine Iacuzzo, its Vice President of Marketing and Communications, and the exhibits thereto (“Iacuzzo Dec.”). 23 TTABVUE.

Notice of Reliance (“NOR”) on official records, including a patent application, third party trademark applications, and two of Applicant’s related, but abandoned and uninvolved trademark applications. 25 TTABVUE.

NOR on Applicant’s written discovery responses. 26 TTABVUE.

NOR on third-party trademark registrations. 27 TTABVUE.

NOR on printouts from an Office database showing the status and title to all but one of Opposer’s pleaded registrations. 28 TTABVUE.³

NOR on Internet printouts. 29 TTABVUE.

Applicant did not take any testimony, submit any evidence or file a Trial Brief.

II. The Parties

Guccio Gucci opened his first GUCCI-branded store in Florence, Italy in 1921, focusing on leather goods, and eventually offering handbags and luggage. 23 TTABVUE 3 (Iacuzzo Dec. ¶ 2). Since the 1950s, Opposer has used the GUCCI Marks⁴ (discussed below) in the United States for a wide variety of goods and services. *Id.* ¶ 5. There are now “approximately 100 GUCCI branded, company-owned/operated

³ Opposer did not introduce its pleaded Registration No. 3660060 into evidence. In any event, had it been introduced it would be at most cumulative and not change our ultimate decision or even our discussion of the case.

⁴ Opposer’s “Gucci Marks” include GUCCI, the Gucci “signature” marks and the Gucci “crest” marks, as well as those in which Opposer owns common law rights. 23 TTABVUE 4 (Iacuzzo Dec. ¶ 5).

retail boutiques in the United States ... and Puerto Rico alone,” and “Opposer also distributes its GUCCI branded products on a wholesale basis through high-end retail department stores such as Neiman Marcus, Saks Fifth Avenue, Nordstrom and Bloomingdale’s. The dedicated Gucci counters and floor sections within these retail locations prominently display the GUCCI mark.” *Id.* ¶¶ 3-4.

Opposer’s product line has expanded significantly over time, and now includes (and for “decades” has included) footwear, apparel, jewelry, fragrances, cosmetics, home goods and retail store services. In addition, “for decades” Opposer has also used GUCCI in connection with some seemingly far-flung products, including bicycles, automobiles and mobile applications. *Id.* ¶ 6 and pp. 83, 99, 101, 388, 406

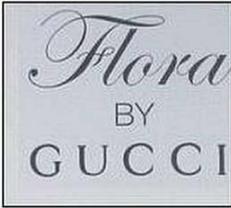
Opposer’s GUCCI Marks include not only GUCCI in standard characters, but also what Opposer refers to as “signature marks,” a version of which is displayed below on the left, and “crest marks,” a version of which is displayed below on the right:



Id. ¶ 5. Opposer’s pleaded registrations include, among others:

Mark	Reg. No./Issue Date	Goods/Services
GUCCI 2(f)	1321864 Feb. 26, 1985	Eyeglasses and parts therefor
GUCCI 2(f)	1200991 July 13, 1982	bracelets, rings, necklaces, cufflinks, pendants, pins, money clips, keyrings, all

		made wholly or in part of precious metal
GUCCI 2(f)	1168477 Sept. 8, 1981	neckties; scarves; belts; footwear; shirts; sweaters; coats; suits; dressing gowns; hats; socks; dresses and bathing suits
GUCCI	1140598 Oct. 21, 1980	Perfume; after-shave; and cologne
GUCCI 2(f)	4255187 Dec. 4, 2012	Automobiles and bicycles
GUCCI	4563132 July 8, 2014	Handbags, shoulder bags, clutch bags, tote bags, briefcases, business card cases, credit card cases, backpacks, key cases, passport cases, cosmetic cases sold empty, valises, suitcases, luggage, all the foregoing being made in whole or in part of leather; pet accessories, namely, carriers, collars and leashes; pet collar accessories, namely, charms
GUCCI	4563098 July 8, 2014	Protective covers and cases for mobile electronic communication devices and computers; computer application software for all mobile devices, namely, software for providing information in the field of fashion, the arts and lifestyle
GUCCI	972078 Oct. 30, 1973	Retail apparel, jewelry and leather goods store services
GUCCI	4567127 July 15, 2014	Advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media; retail store and retail outlet store services featuring clothing, footwear, handbags, luggage, small

		leather goods, jewelry, watches, eyewear, fragrances, and accessories; online retail stores featuring clothing, footwear, handbags, luggage, small leather goods, jewelry, watches, eyewear, fragrances and accessories
FLORA BY GUCCI	3627729 May 26, 2009	essential oils for personal use, perfumes, eau de parfum, eau de toilette
GUCCI 2(f)	1093769 June 20, 1978	Pens
	3061918 Feb. 28, 2006	Wallets, purses, handbags ... business card cases, credit card cases ...
	3627732 May 26, 2009	essential oils for personal use, perfumes, eau de parfum, eau de toilette
 2(f)	4222044 Oct. 9, 2012	Automobiles and bicycles
	1097555 July 25, 1978	Neckties, scarves, belts, footwear, shirts, sweaters, coats, suits, dresses and bathing suits
	1097483 July 25, 1978	wallets, purses, handbags, shoulder bags, clutch bags, tote bags, card cases, key cases, passport cases, cosmetic cases, attache cases, valises, suitcases, duffle bags, necktie cases, umbrellas, wholly or partially made of leather

	<p>1132675 April 8, 1980</p>	<p>candle holders made wholly or partly of precious metal, watches, cufflinks of precious metal, bracelets, pendants, earrings, rings, necklaces, stylized animal containers made wholly or partly of precious metal</p>
	<p>4555582 June 24, 2014</p>	<p>Bicycles</p>

As indicated, Uberto Gucci is Guccio Gucci’s great grandson. 4 TTABVUE 3 (Answer ¶ 5).⁵ Applicant concedes that “[t]his familial connection is of public knowledge.” 26 TTABVUE 14 (Applicant’s response to Interrogatory No. 21(a)). Uberto Gucci was “Vice President of the Gucci Parfums Spa (Guccio Gucci SPA related company).” 26 TTABVUE 13 (Applicant’s response to Interrogatory No. 20). He created the mark in the ‘978 Application “with the ‘use’ of the Gucci family crest which was existing several hundred years ago and belonging to the Gucci family ... Uberto Gucci’s personal and natural signature was placed on the logo.” 26 TTABVUE 8, 21 (Applicant’s response to Interrogatory No. 2 in each opposition). Opposer has no business relationship with Applicant or Uberto Gucci, and has not authorized either to use the GUCCI Marks. 23 TTABVUE 33-34 (Iacuzzo Dec. ¶ 56).

⁵ Applicant indicates in its discovery responses, however, that Uberto Gucci is Guccio Gucci’s “grand nephew.” 26 TTABVUE 14 (Applicant’s response to Interrogatory No. 21(a)). Whether Uberto Gucci is Guccio Gucci’s great grandson or grand nephew is not material to our decision.

III. Standing and Priority

Opposer's pleaded registrations, 28 TTABVue 30-102, establish its standing. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Because Applicant has not counterclaimed to cancel any of Opposer's pleaded registrations, priority is not at issue with respect to the marks and goods identified therein. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

IV. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *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."). Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. We consider the likelihood of confusion factors about which there is evidence or argument, and treat the remaining factors as neutral.

A. The Strength/Fame of Opposer's Marks

We found in the Summary Judgment Decision that Opposer's GUCCI mark is famous for dilution purposes, and Applicant concedes the point. 4 TTABVUE 2-3 (Answer ¶ 2); 20 TTABVUE 8; 26 TTABVUE 15, 39, 43 (Applicant's responses to Interrogatory No. 25 and Request for Admission No. 5). This finding and admission establish that Opposer's GUCCI mark is exceedingly strong, famous and entitled to a broad scope of protection against confusion. *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1724 (Fed. Cir. 2012) ("Fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing."); *Cf. Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733 (Fed. Cir. 2017).

In fact, where fame exists, as it does here, it "plays a 'dominant role in the process of balancing the *DuPont* factors,' ... and '[f]amous marks thus enjoy a wide latitude of legal protection.'" *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002)(quoting *Recot, Inc. v. Benton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)). A strong mark "casts a long shadow which competitors must avoid." *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

While consumer surveys may provide direct evidence of fame, they are not necessary; indeed, they "rarely appear." *Bose*, 63 USPQ2d at 1305. Rather, "fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Id.* Other relevant

factors include “length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark.” *Coach Servs.*, 101 USPQ2d at 1720.

We keep in mind that fame remains “a dominant factor in the likelihood of confusion analysis ... independent of the consideration of the relatedness of the goods.” *Recot*, 54 USPQ2d at 1898. That is, “when a product reaches the marketplace under a famous mark, special care is necessary to appreciate that products not closely related may nonetheless be confused as to source by the consumer because of the fame of the mark.” *Bose Corp.*, 63 USPQ2d at 1310.

Here, GUCCI is Opposer’s primary trademark, as well as its company and primary domain name, and has been in extensive use in the United States for over 60 years.

In fact, GUCCI is a “household name.” For example:

“[S]ince Opposer’s first promotion and sale of the products [bearing the Gucci Marks] in the U.S., the sale of products bearing the Gucci Marks has generated billions of dollars.” 23 TTABVUE 20 (Iacuzzo Dec. ¶ 15). The record supports the testimony that the sales were in the “billions,” with a “b.”

While the specific figures are confidential, between 2010-2017 alone, Opposer’s sales of products bearing the GUCCI word mark are a substantial fraction of the total referenced above, and significantly more than we typically see in Board cases, even cases involving other famous marks. Similarly, Opposer’s sales of products bearing the Gucci “signature” marks during that same time period are quite impressive, and exceed sales figures which have previously and consistently been found to support a finding of fame. Opposer’s sales of products bearing the GUCCI “crest” marks are also impressive by any measure *Id.* (Iacuzzo Dec. ¶¶ 16-17).

Since 2011, Opposer’s advertisements featuring Gucci Marks have appeared in many well-known publications,

with a combined circulation exceeding 220 million, including Vogue, New Yorker, Vanity Fair, GQ, Glamour, Esquire, Harper's Bazaar, Los Angeles Times, Newsweek, New York Times Magazine, Wall Street Journal and Business Week. *Id.* (Iacuzzo Dec. ¶ 19), 320-323.

While the specific figures are confidential, Opposer has spent a significant sum advertising and promoting the Gucci Marks between 2010-2016. *Id.* (Iacuzzo Dec. ¶ 20). As with Opposer's sales figures, its advertising expenditures are at the highest end of what is typically seen in Board cases. 24 TTABVUE 35-57 (confidential).

Retailers including Neiman Marcus and Saks Fifth Avenue also advertise products bearing the Gucci Marks.

Opposer has almost 4.9 million Twitter followers, 17.4 million Instagram followers, almost 16 million Facebook followers, and has received over 16.2 million Facebook "likes." Opposer's "gucci.com/us" website received almost 83 million visits between 2012-2014, and 105 million between 2015-August 2017. Approximately 700,000 people in the United States have downloaded the GUCCI mobile app. The L2 Digital IQ Index ranks GUCCI first among 85 luxury fashion brands in "digital performance." 23 TTABVUE 22-23 (Iacuzzo Dec. ¶¶ 22-26), 340, 355, 358.

GUCCI was 47th on Forbes Magazine's 2017 list of the world's most valuable brands, with an estimated "brand value" of \$12.7 billion. Millward Brown's list of "Top 100 Most Powerful Brands" has included GUCCI from 2006 to the present, and Interbrand has ranked GUCCI among the "Best 100 Brands" since 2005. *Id.* at 24-25 (Iacuzzo Dec. ¶¶ 29-30); 29 TTABVUE 89.

There are a number of books about the GUCCI brand and family, and GUCCI products have appeared in many movies and television shows, including *The Wolf of Wall Street*, *The Blind Side*, *La Land*, *Annie*, *The Americans*, *The Today Show* and *Empire*. According to the *Huffington Post*, Gucci topped the list of "10 Most Mentioned Fashion Brands in Hip Hop." 23 TTABVUE 25-26 (Iacuzzo Dec. ¶¶ 33-36); 29 TTABVUE 317-343, 345.

Opposer made of record many depictions of its products being featured in popular culture (for example, the movie poster below on the left features the GUCCI “horsebit loafer”), and being worn by famous celebrities (for example, the article below on the right depicts Princess Grace Kelly, Audrey Hepburn, Jacqueline Kennedy Onassis and Princess Diana):

50 WWD WEDNESDAY, FEBRUARY 23, 2011

WWD MILESTONES / GUCCI AT 90

Dressing With the Stars

By CHRISTINE LEE

WHEN PRINCESS GRACE strode into Gucci's Via Montenapoleone boutique a half-century ago, she not only catapulted the Flora print to fame, she thrust the brand's love affair with celebrities into high gear. Through the years, Gucci would become known for accessorizing and dressing everyone from stars and aristocrats to celebrity brats. Another notable moment came in 1965 with Tom Ford's first — and quite provocative — fall collection for the house, from which Madonna selected her outfit for the MTV Video Music Awards that year.

Last May, creative director Frida Giannini restyled the brand's jet-set flair. The setting was the red carpet at the Cannes Film Festival, one of the most glamorous venues in the film world. It was there, at the "Robin Hood" premiere that the house launched Giannini's Gucci Premiere collection of one-of-a-kind couture gowns on a radiant Salma Hayek.

Over the next few days, Hayek appeared twice more in Premiere dresses, along with a slew of other Gucci-clad VIPs including Naomi Watts, Kate Beckinsale, Jennifer Lopez, Marc Anthony, Camilla Belle, Lea

(Continued on page 52)

Princess Grace Kelly in Rome in the 1950s.

Jacqueline Kennedy Onassis, New York, 1970.

Audrey Hepburn in Rome in the 1950s.

Princess Diana, Rome, 1991.

23 TTABVUE 711, 713. Applicant admits that GUCCI is a “famous mark” and “world famous.” 26 TTABVUE 15, 39, 43 (Applicant’s responses to Interrogatory No. 25 and Request for Admission No. 5).

In short, the evidence of record establishes that Opposer’s GUCCI Marks are famous, and significantly so. More specifically, not only is the GUCCI word mark quite famous, but the GUCCI “signature” marks and the GUCCI “crest” marks are

also famous, though less so.⁶ In addition, the mark FLORA BY GUCCI not only incorporates the famous GUCCI mark, but in fact its commercial impression is of a Gucci product, i.e. essential oils for personal use and perfumes named “FLORA” which are made “by GUCCI.” Thus, in analyzing FLORA BY GUCCI, we take into account the fame of GUCCI, and as we assess the other *du Pont* factors, we give the GUCCI mark’s fame “its full measure of weight.” *Recot*, 54 USPQ2d at 1898.

B. The Marks

We consider the marks “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). In doing so, we are mindful that “the Lanham Act’s tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark’s fame increases, the Act’s tolerance for similarities in competing marks falls.” *Kenner Parker Toys*, 22 USPQ2d at 1456. In this case, given how famous GUCCI and the GUCCI “signature” marks are, the Act’s tolerance for similarity to those marks is quite low.

⁶ While the figures are confidential, suffice it to say that from 2010-2017, Opposer’s sales of goods bearing the GUCCI “signature” marks exceed many millions of dollars, as do its sales of goods bearing the GUCCI “crest” marks during the same time period, though the sales of goods under the GUCCI “crest” marks are less than those for goods bearing the GUCCI and GUCCI “signature” marks. Opposer’s advertising expenditures in connection with the GUCCI “signature” and “crest” marks are also impressively high, though also confidential. 24 TTABVUE 19-21, 39-41, 43, 45-57 (Iacuzzo Dec. ¶¶ 16, 17, 19, 20 and Exs. D, E, I).

The degree of similarity between the marks is, however, quite high. With respect to the mark in the '040 application, the similarities between it and the GUCCI standard character and “signature” marks are manifest:



Because Opposer’s word mark is registered in typed/standard character format,⁷ it could be displayed in any font, including the same stylized font as Applicant’s mark. *In re Viterra*, 101 USPQ2d at 1910. As for the GUCCI “signature” mark, it and Applicant’s mark are written in fairly similar and underlined cursive script, with both “G”s featuring similar and fairly distinctive flourishes. Applicant’s mark and Opposer’s standard character and “signature” marks all feature the famous name and mark GUCCI, and while Applicant’s mark prefaces the famous name and mark GUCCI with “By Uberto,” this is of relatively little significance. Indeed, “Gucci” is an obvious and famous surname and “Uberto” is an obvious (and also Italian-sounding) personal name. *See generally, In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004) (finding JOSE GASPAR GOLD for tequila confusingly

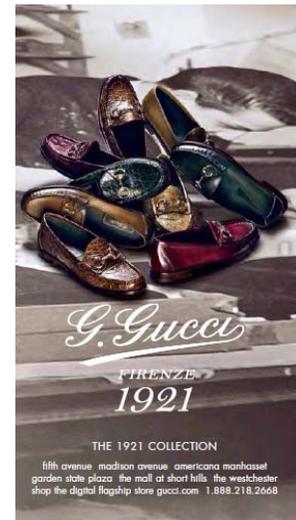
⁷ *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) (“until 2003, ‘standard character’ marks formerly were known as ‘typed’ marks, but the preferred nomenclature was changed in 2003 to conform to the Madrid Protocol ... we do not see anything in the 2003 amendments that substantively alters our interpretation of the scope of such marks”).

similar to GASPAR'S ALE for beer, based in large part on affirming findings that “the first name JOSE and the word GOLD both simply modify the name GASPAR” and that JOSE “simply reinforces the impression that GASPAR is an individual’s name,” and thus “does not alter the commercial impression of the mark”); *Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) (“... the Board failed to consider the other marks of opposer and their effect on the similarity or dissimilarity of ETF’s mark. These marks, MADEMOISELLE RICCI, SIGNORICCI and CAPRICCI, according to Nina Ricci, indicate that the RICCI surname is a unifying name in opposer’s marks and is the dominant and significant part of opposer’s marks in identifying its goods.”).

In addition, the record belies any claim that consumers would perceive “By Uberto Gucci” as distinguishing. First, Applicant’s president Uberto Gucci is related to Guccio Gucci, the “founder of Opposer’s GUCCI brand.” Moreover, Uberto Gucci “is formerly the Vice President of the Gucci Parfums Spa (Guccio Gucci SPA related company).” Applicant itself admits that “[t]his familial connection is of public knowledge.” 4 TTABVUE 3 (Answer ¶ 5); 26 TTABVUE 14 (Applicant’s response to Interrogatory No. 21(a)); 26 TTABVUE 13 (Applicant’s response to Interrogatory No. 20). Given the conceded “public knowledge” that Uberto is part of the famous GUCCI family, and was part of the family business, the public would not be likely to perceive “By Uberto” as identifying a different source; to the contrary, it would be natural to assume that family member Uberto is still affiliated with the source of other GUCCI products, as he once was, and in a leadership capacity. Furthermore, Opposer has

Opposition Nos. 91223733 and 91223735

introduced evidence that major fashion industry brands sometimes introduce “secondary” or “diffusion” product lines, which add a term to a house mark, such as “by [personal name],” for example: Balmain’s secondary line “Pierre Balmain;” Marc Jacobs’s secondary line “Marc by Marc Jacobs;” Armani’s secondary line “Emporio Armani;” and Chloé’s secondary line “See by Chloé.” 23 TTABVUE 33 (Iacuzzo Dec. ¶¶ 53-55); 27 TTABVUE 1-39 (registrations for diffusion product lines); 29 TTABVUE 405-408. And Opposer sometimes prefaces its GUCCI “signature” mark with the initial “G”:



23 TTABVUE 235, 236, 246. In short, the mark in Applicant’s ‘040 Application includes the dominant, literal and famous portion of Opposer’s marks, and the visual and aural distinction in Applicant’s mark, “By Uberto,” only accents the connotation that, like Opposer’s marks, it identifies the famous GUCCI brand and source.

As for the mark in Applicant’s ‘978 Application, its appearance is obviously different from GUCCI alone, or in “signature” form. Nevertheless, especially given the fame of GUCCI, the words DESIGNED BY UBERTO GUCCI should be given

greater weight than the stylization. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012) (“the verbal portion of a word and design mark likely will be the dominant portion”); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). In any event, Applicant created the design element of its mark “with the ‘use’ of the Gucci family crest.” 26 TTABVUE 8, 21 (Applicant’s response to Interrogatory No. 2 in each opposition). Therefore, the difference in appearance between this mark and Opposer’s GUCCI word and “signature” marks is not particularly significant, as the Gucci crest design would heighten, rather than reduce, the likelihood of confusion, at least among those aware or made aware of the Gucci crest.

Furthermore, Opposer’s “crest” marks are sufficiently similar in appearance to Applicant’s design mark for confusion to occur. Both feature a human figure, the famous name and word mark GUCCI and other similar elements, including flowers, armor, shields, and Opposer’s helmet and Applicant’s crown. These similarities should not be surprising given Applicant’s admitted use of the Gucci family crest to create its involved design mark.

Under the circumstances of this case, including the renown of Opposer’s GUCCI Marks, Applicant’s marks are also confusingly similar to FLORA BY GUCCI. In fact, GUCCI is the dominant portion of each, based on its fame, being a surname and its place in each mark. Both FLORA BY GUCCI and BY UBERTO GUCCI convey that the associated products are “by,” i.e. originate from, GUCCI, whether “Gucci” is further identified by a personal name or the product is further identified by, for

example, “Flora.” Therefore, we have taken into account the GUCCI mark’s fame in analyzing FLORA BY GUCCI. In short, the source of each product will likely be perceived as “Gucci,” with FLORA BY GUCCI and BY UBERTO GUCCI likely to be perceived as brand or product extensions.

The similarity of these marks also weighs in favor of finding a likelihood of confusion.

C. The Goods, Channels of Trade, Classes of Consumers and the Variety of Goods on Which Opposer’s Marks Are Used

Here, given the exceedingly wide range of goods and services Opposer offers under its GUCCI Marks, it is appropriate to consider the goods, channels of trade and classes of consumers (the second, third and fourth *du Pont* factors) along with “the variety of goods on which a mark is or is not used” (the ninth factor). Indeed, the goods Opposer offers under its GUCCI Marks range from handbags to vacuum bottles, from business card cases to perfumes, from books to bubble bath, from stationery to bicycle helmets, from eyewear to computer application software for all mobile devices, from pet accessories to jewelry, from advertising services to bicycles, from hats to retail and online store services, from money clips to automobiles, from sunglasses to socks, from fur capes to umbrellas, from candle holders to pens and from stylized animal containers to shaving preparations.

In other words, Opposer has a proven ability to offer, and a business practice of offering, goods such as cars, bikes, pens, money clips, mobile apps and other products no more different from the clothes and handbags for which Opposer is perhaps best known than electronic cigarettes. *See Gucci America v. Gucci*, 2009 WL 8531026 at

*17 (S.D.N.Y. 2009) (“the substantial similarity between the Gucci Trademarks and the marks used by Defendants (*i.e.* the JENNIFER GUCCI name, the GEMMA GUCCI name ...) ‘entitles [Gucci’s] marks to protection over a broader range of related products’) ... “because the Gucci Trademarks are ‘famous’ and ‘well known’ ... [there is a] greater likelihood that use [of the JENNIFER GUCCI or GEMMA GUCCI names] on noncompetitive products will cause confusion”) (citations omitted). Therefore, it would not be a stretch, at all, for consumers to believe that Opposer -- which offers goods somewhat similar in kind or manufacturing requirements to electronic cigarettes (including essential oils and pens) -- could offer electronic cigarettes under the GUCCI Marks, given that it has already offered, if not everything under the sun, then at least an atypically wide range of products and services. *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1195 (TTAB 2007) (“The fact that opposer applies its marks to a variety of sports products makes it more likely that purchasers, aware of opposer’s use of the mark on a variety of sports products, when seeing a similar mark used in connection with backpacks, duffel bags and other sports bags, are likely to believe that these products are also being produced or sponsored by opposer.”); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1271 (TTAB 2003) (“this factor may favor a finding that confusion is likely even if the goods are not obviously related”); *Uncle Ben’s Inc. v. Stubenberg Int’l Inc.*, 47 USPQ2d 1310, 1313 (TTAB 1998) (“Section 2(d) of the Trademark Act also covers situations where the public, because of the similarity of the marks, is likely to believe that a recognizably

different product, because of the similarity of the marks, emanates from, or is authorized, sponsored or licensed by the prior user or registrant.”).

In considering the parties’ goods, we are mindful that they need not be identical or even competitive in order to find likelihood of confusion. Rather, the question is whether the goods are marketed in a manner that “could give rise to the mistaken belief that [the] goods emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 227 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (“Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services.”); *Recot*, 54 USPQ2d at 1898 (“even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods”); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1109 (2007).

Moreover, not only could the vast scope of Opposer’s goods and services offered under the Gucci Marks, the familial relationship between Applicant’s and Opposer’s namesakes, and the close similarity of the parties’ marks give rise to source confusion, but we must also keep in mind the overwhelming fame of the GUCCI word and “signature” marks. Indeed, fame is “a dominant factor” in our analysis, “independent of the consideration of the relatedness of the goods.” *Recot*, 54 USPQ2d at 1898. *See also Bose Corp.*, 293 F.3d 1367, 63 USPQ2d at 1310 (“when a product reaches the marketplace under a famous mark, special care is necessary to appreciate that

products not closely related may nonetheless be confused as to source by the consumer because of the fame of the mark”).

We are also mindful that while Opposer did not plead or prove that it owns a “family” of GUCCI marks, “it is, nonetheless, appropriate to note that consumers who may be familiar with various products in the [Gucci] product line, when confronted with applicant’s mark, would be likely to view goods marked therewith as additional products from [Opposer].” *In re Hitachi High-Technologies Corp.*, 109 USPQ2d 1769, 1774 (TTAB 2014). Even “those who do notice the difference in the marks will not necessarily conclude that there are different sources for the goods, but will see the marks as variations of each other, pointing to a single source.” *Id.* This is especially so because of the admitted “public knowledge” that Uberto Gucci is a member of the famous Gucci family. *See In re Collegian Sportswear Inc.*, 224 UPQ 174, 176 (TTAB 1984) (“we have considered the ‘OF CALIFORNIA’ portion of the mark but are of the view that the addition of this term does not obviate likelihood of confusion since customers familiar with registrant’s ‘COLLEGIENNE’ clothing might believe that ‘COLLEGIAN OF CALIFORNIA’ clothing was a new line of clothing from registrant featuring a ‘California’ or west coast style”).

Furthermore, while Opposer is a famous “luxury” brand, known primarily for expensive products, many of its identified goods, including essential oils for personal use, money clips and pens, are without any limitations, in price, type of consumer, or otherwise. Opposer offers bottles of nail polish for \$29.00, fragrances for as low as \$68.00, and jewelry and accessories starting at less than \$100.00. 23 TTABVUE 17

(Iacuzzo Dec. ¶ 7). Based on Opposer’s identifications of these goods without limitation, we must presume that Opposer could offer “money clips,” “pens” or “essential oils for personal use” at a low price, to ordinary consumers, and run of the mill consumer items such as these could be sold in, for example, convenience or drug stores, which might also offer electronic cigarettes. We must base our decision on the “least sophisticated potential purchasers” for the goods as identified. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) (quoting *Gen. Mills, Inc. v. Fage Dairy Proc. Indus. S.A.*, 100 USPQ2d 1584, 1600 (TTAB 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB 2014)).

Under these circumstances, consumers could very well assume that BY UBERTO GUCCI is a new line of GUCCI-branded products. In fact, the differences between what consumers will “smoke” through electronic cigarettes, and the essential oils for personal use offered under FLORA BY GUCCI, are not so significant that consumers would not assume an affiliation of some type between Applicant and Opposer. The same is true of the difference between electronic cigarettes and the pens offered under GUCCI. That is, the inputs, know-how and manufacturing (or licensing) abilities needed to offer essential oils for personal use and pens, as Opposer does under its GUCCI and FLORA BY GUCCI marks, would not be substantially different than what would be required to offer an electronic cigarette or its contents, which is what Applicant intends to do under its BY UBERTO GUCCI marks.

In short, given the “known” family connection between Uberto Gucci and the famous Gucci family, Opposer’s history and fame, the nature of the goods and similarity of the marks, we find source confusion likely between, at the very least, Applicant’s mark UBERTO BY GUCCI for electronic cigarettes, and Opposer’s marks FLORA BY GUCCI for “essential oils for personal use” and “perfumes” (Reg. No. 3627729) and GUCCI for pens and moneyclips (Reg. Nos. 1093769 and 1200991). We have found confusion likely in analogous circumstances. For example, ENYCE for custom auto accessories was found confusingly similar to the same mark for clothing. *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1889 (TTAB 2008) (“it is common knowledge, and a fact of which we can take judicial notice, that the licensing of commercial trademarks on ‘collateral products’ has become a part of everyday life”). And LLOYD’S OF LONDON for aftershave was found confusingly similar to the same mark for insurance services. *The Corporation of Lloyd’s v. Louis D’Or of France, Inc.*, 202 USPQ 313 (TTAB 1979). The predecessor to our primary reviewing court affirmed our finding that K2 for “filter cigarettes” is likely to be confused with the same mark for “snow skis,” stating “[w]hile the goods involved may not be competitive or intrinsically related, other factors” supported the finding. *Philip Morris, Inc. v. K2 Corp.*, 555 F.2d 815, 194 USPQ 81, 82 (CCPA 1977). *See generally, DC Comics v. Pan Am. Grain Mfg. Co.*, 77 USPQ2d 1220, 1225-27 (TTAB 2005) (“Because opposer has used KRYPTONITE as a merchandising mark with respect to a variety of goods; because consumers recognize that, in the general marketing environment, merchandising marks are used to identify a variety of goods and services; and because

opposer has used the term KRYPTONITE in connection with the promotion of certain food and beverage products, we find that, in the sense discussed in the *Recot* and *Hewlett Packard* cases, applicant's goods and opposer's goods are related. In short, based on the above, we find that consumers, seeing KRIPTONITA on prepared alcoholic fruit cocktails, are likely to believe that the mark has been licensed by opposer for such goods, and that the goods are therefore sponsored by opposer."); *Time Warner Entm't. Co. v. Jones*, 65 USPQ2d 1650, 1661-62 (TTAB 2002); *Harley-Davidson Motor Co., Inc. v. Pierce Foods Corp.*, 231 USPQ 857 (TTAB 1986) (HARLEY-HOG for pork likely to be confused with HARLEY-DAVIDSON and HARLEY for motor vehicles and a wide range of unrelated consumer products including beverages and chocolate bars but not meat).⁸

While we must presume that Opposer's goods as identified could be offered to unsophisticated, ordinary consumers, at the same time we also have considered Opposer's evidence that electronic cigarettes are sometimes marketed as luxury products, or to style-conscious consumers. In fact, third parties have attempted to use

⁸ After filing its involved applications, Applicant sought registration of the same marks involved here for leather goods and clothing. 25 TTABVUE 134-36, 284-87. This may serve to suggest a relationship between leather goods and clothing (which Opposer offers under its marks) and electronic cigarettes. *See generally Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990) (finding a relationship between the applicant's "modems" and the opposer's "computer programs," finding that the relationship between the goods "is shown," in part, "by [applicant's] original application, which indicates [applicant] itself used the mark OCTOCOM for both modems and computer programs").

Opposition Nos. 91223733 and 91223735

Opposer's GUCCI Marks for electronic cigarettes and closely related products such as "e-cigarette juice" (which is inhaled using an electronic cigarette), until receiving cease and desist letters from Opposer. 23 TTABVUE 30 (Iacuzzo Dec. ¶ 48) and 802-817. Perhaps not surprisingly, an article in Business Insider explains that a third-party markets e-cigarettes which "double as necklaces" and have "all the style of your designer handbag." These electronic cigarettes are offered in flavors named to evoke luxury, such as "Rodeo Drive":

BUSINESS INSIDER

Yes, This Sparkly E-Cigarette Necklace Actually Exists



HAYLEY PETERSON
MAR. 18, 2014, 11:09 PM

An online retailer of e-cigarettes is trying to lure female smokers with bejeweled vaporizers that double as necklaces and come in flavors like "Rodeo Drive" and "Strawberry Champagne."

A video ad for the brand, called Vapor Couture, encourages women to "break free from the pack" with the "slim, sleek, sparkling" e-cigarettes in colors that come "straight off the runway."

The brand has a complementary line of accessories including [charging cases](#) available in brushed platinum and rose gold and [\\$59.95 leather clutches](#) with "all the style of your designer handbag."

The e-cigarettes can also be worn as pendants on a [\\$49.95 sterling silver charm necklace](#) that come with Vapor Couture starter packs, costing upwards of \$99.

Here's the e-cig being worn as a necklace:



29 TTABVUE 51. These associations between electronic cigarettes and luxury goods further support a finding that consumers encountering Applicant's goods under Applicant's involved marks could be confused as to source. Indeed, the involved applications identify "electronic cigarettes," also without any limitations, meaning that Applicant's goods could include electronic cigarettes aimed at consumers of luxury/designer goods, and Applicant's electronic cigarettes could even "double as"

Opposition Nos. 91223733 and 91223735

jewelry, or have “all the style” of a designer handbag, or otherwise resemble products for which Opposer’s GUCCI, GUCCI “signature” and other GUCCI marks are registered. Consumers could also be confused because Opposer uses GUCCI for retail jewelry (and other luxury goods) store services (Reg. No. 972078).

These factors also weigh in favor of finding a likelihood of confusion.

V. Conclusion

Because Opposer’s GUCCI and GUCCI “signature” marks are exceedingly famous and strong, Applicant’s marks contain GUCCI preceded by the personal name of an individual “known” be a member of Opposer’s founder’s family, the scope of products offered under Opposer’s marks is so vast, and electronic cigarettes are sometimes marketed as luxury or fashionable items, including under infringing GUCCI marks, consumers could believe that Applicant’s goods come from the same source as, for example, pens offered under the GUCCI mark in Registration No. 1093769, or essential oils for personal use offered under the FLORA BY GUCCI mark in Registration No. 3627729. Confusion is therefore likely.

Decision: The oppositions are sustained.⁹

⁹ We therefore need not reach Opposer’s dilution claim.