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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Tommy Hilfiger Licensing, Inc.

v.

Henri-Lloyd, Limited

Opposition No. 118,396
to Application Serial No. 75/489,129

Mary L. Greico, Louis S. Ederer and Charu Narang of Gursky & Ederer, LLP for Tommy Hilfiger Licensing, Inc.

Alan H. Levine and Howard F. Mandelbaum of Levine & Mandelbaum for Henri-Lloyd, Limited.

Before Chapman, Bucher and Rogers, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

An application has been filed by Henri-Lloyd, Limited to register the composite mark shown below.



At the request of the Trademark Examining Attorney, applicant described its mark as consisting of "an open crown, the letters H and L and a wreath, all placed upon a diamond background."

According to the application papers, applicant intends to use the mark on the following goods:

"marine, life saving, and emergency equipment and garments, namely, life saving belts, inflatable suits, buoys, jackets, nets and rafts, safety harnesses, safety ropes, and safety lines," in International Class 9;

"articles made from leather and imitation leather, namely, wallets, purses, handbags, and briefcases, trunks, traveling bags, suit cases, holdalls, overnight bags, sail bags, and duffle bags," in International Class 18; and

"clothing, footwear and headgear, namely, coats, suits, jackets, trousers, salopettes, overtrousers, pants, shorts, shirts, sweatshirts, t-shirts, vests, waistcoats, cagoules, anoraks, smocks, sweaters, pullovers, bodywarmers, scarfs, ties, gloves, belts, socks, hoods, caps, hats, headbands, underwear, neckwear, sandals, shoes, slippers, boots, and sneakers," in International Class 25.¹

Registration has been opposed by Tommy Hilfiger Licensing, Inc., but only as to the goods in International Classes 18 and 25, on the ground that it has previously used and registered its Hilfiger crest design as shown below;

¹ Application Serial No. 75/489,129 was filed on May 21, 1998, based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.



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as well as the same Hilfiger crest design lined for color shown below;

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- (1) Reg. No. 1,673,527 for "clothing for men and boys, namely, shirts, sweaters, sportcoats, pants, sweatshirts, shorts, sports jackets, raincoats, parkas, overcoats, bathing suits, vests, turtlenecks," in International Class 25, issued on January 28, 1992, renewed;
 - (2) Reg. No. 1,816,430, for "ties, socks, suspenders, hats, caps, suits and blazers," in International Class 25, issued on January 11, 1994, Section 8 affidavit accepted and Section 15 affidavit acknowledged;
 - (3) Reg. No. 1,879,005, for "retail store services," in International Class 42, issued on February 14, 1995, Section 8 affidavit accepted and Section 15 affidavit acknowledged;
 - (4) Reg. No. 1,935,702, for "articles of leather and imitation leather; namely wallets, credit card cases, umbrellas, traveling bags, billfold," in International Class 18, issued on November 14, 1995, Section 8 affidavit accepted and Section 15 affidavit acknowledged;
 - (5) Reg. No. 2,120,621, for "footwear, namely, shoes, boots, sneakers, sandals and slippers," in International Class 25, issued on December 9, 1997;
 - (6) Reg. No. 2,153,151, for "sunglasses, eyeglasses and eyeglass frames," in International Class 9, issued on April 21, 1998;
 - (7) Reg. No. 2,179,671, for "jewelry made of precious and nonprecious metals and stone, namely, cuff links," in International Class 14, issued on August 4, 1998.



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and its TH and laurel design shown below.



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Opposer also asserts various common law uses of a letter "H," examples of which will be discussed later in this opinion. Opposer asserts that each of these marks have been used since long prior to applicant's filing date herein. Opposer then asserts that applicant's mark, when used on its goods in International Classes 18 and 25, so resembles

³ Reg. No. 1,940,821, for "articles of clothing, namely, shirts, sweaters, sportscoats, pants, sweatshirts, shorts, sports jackets, raincoats, parkas, overcoats, bathing suits, vests, turtlenecks, ties, socks, suspenders, hats, caps, suits and blazers," in International Class 25, issued on December 12, 1995, Section 8 affidavit accepted and Section 15 affidavit acknowledged.

⁴ Reg. No. 2,050,013, for "shirts, hats, caps, pants, shorts and socks," in International Class 25, issued on April 1, 1997, Section 8 affidavit accepted and Section 15 affidavit acknowledged.

opposer's previously used and registered trademarks as to be likely to cause confusion, to cause mistake, or to deceive.

Applicant, in its answer, denied the salient allegations of the notice of opposition.

The record consists of the pleadings; the file of the opposed application; opposer's notice of reliance and supplemental notice of reliance; and the testimony, with exhibits, of opposer's Vice President and Associate Counsel, Jade H.J. Huang. Applicant took no testimony and offered no evidence at trial. The parties have fully briefed the case but an oral hearing was not requested.

Before turning to the merits of this case, we must discuss several preliminary matters.

First, applicant has objected to much of the testimony of opposer's only trial witness, Ms. Jade H.J. Huang. Although Ms. Huang testified that she was hired as associate counsel and vice president of opposer in March 1999, her testimony related to opposer's use of its various marks since 1985. Accordingly, applicant has objected to much of her testimony on the ground of hearsay.

In the face of repeated objections to this testimony by applicant's counsel at the time the deposition was being taken, opposer's counsel elicited detailed information from Ms. Huang about how her job duties had permitted her to

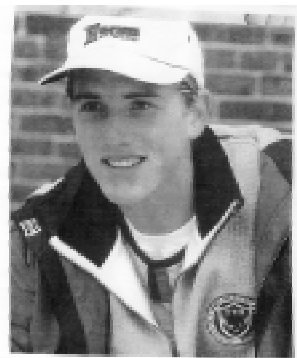
acquire her personal knowledge of relevant facts to which she was testifying. She explained her role as opposer's primary intellectual property manager, and how she gathered information regarding opposer's trademarks and franchising agreements. For example, she described her orientation to the firm in 1999 through contact with her predecessor and visits with the heads of each of opposer's divisions. She testified to her participation in discussions of Tommy Hilfiger's annual design directives, and of her review of existing files in the legal department she heads as well as the files existing in opposer's other divisions.⁵

In this case, we find that applicant's objections to Ms. Huang's testimony are not well taken. As opposer's primary in-house trademark counsel, she plays a distinct role in opposer's overall marketing function, and specifically in promoting opposer's brand image. She testified as to how she became aware of the history of the selection and use of opposer's various marks. The documents and files she relied upon are business information, and as such, fall within the business records exception to the hearsay rule. Accordingly, this witness is competent to testify to those matters of which she had personal

⁵ Trial testimony of Jade H.J. Huang, pp. 4 - 5, 7 - 8, 34 - 35.

knowledge, including her knowledge of company history based upon her personal and repeated review of, and familiarity with, company business records.

Next, we note that opposer has filed a motion to amend its notice of opposition to conform to the evidence under Fed. R. Civ. P. 15(b). Opposer has no federal trademark registration of a mark consisting of a letter "H," and while the notice of opposition discusses opposer's "crest design" and its "TH and laurel" design, nowhere in the notice of opposition does opposer allege rights in the letter "H" alone. Nonetheless, during the trial testimony of its witness, opposer's counsel spent substantial time eliciting information about opposer's use for more than a decade of a letter "H," such testimony being supported by exhibits demonstrating such usage.



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⁶ Trial testimony of Jade H.J. Huang, pp. 60 - 72, and Exhibit #14, pp. 1 and 4, letter "H" as applied to a jacket, rugby shirt and hat.

We also find that all of opposer's exhibits were clearly intended to be offered into evidence during this testimony period

Although applicant objected to this testimony on the basis of hearsay, etc., as discussed above, opposer made clear during its trial testimony that in addition to the "crest design" and the "TH and laurel design" marks it had initially pleaded, it was also basing its likelihood of confusion argument on the use of a prominent letter "H" as well.

Under Fed. R. Civ. P. 15(b), when issues not raised by the pleadings are tried by express or implied consent of the parties, the pleadings may be amended to conform to the evidence. Implied consent to the trial of an unpleaded issue can be found only where the non-offering party (1) raised no objection to the introduction of evidence on the unpleaded issue and (2) was fairly apprised that the evidence was being offered in support of the unpleaded issue. See Colony Foods, Inc. v. Sagemark, Ltd., 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984); Levi Strauss & Co. v. R. Josephs Sportswear Inc., 36 USPQ2d 1328 (TTAB 1994); and Devries v. NCC Corporation, 227 USPQ 705 (TTAB 1985).

We find that the issue of whether opposer has established common law rights in the letter "H" *per se* was tried by the implied consent of applicant. Applicant did

deposition. See 37 C.F.R. §2.123(e)(2) and TBMP §713.08 (2d ed. June 2003).

not raise objections to the introduction of this evidence on the ground that it was irrelevant or outside the scope of the proceeding; and applicant was fairly apprised that the evidence was being offered in support of the issue of likelihood of confusion. See TBMP Section 507.03(b)(2d ed. June 2003) and cases cited therein. In this case, there is direct testimony supported by evidence appropriately made of record from which we can say that applicant was or should have been on notice that opposer was asserting common law rights in the letter "H" *per se*. Applicant had the opportunity to meet this showing as it saw fit, and in fact, cross-examined the witness on this evidence. Amending the notice of opposition to include this claim does not create prejudice to applicant, and hence we grant opposer's motion and consider the notice of opposition to be amended to conform to the evidence pursuant to Fed. R. Civ. P. 15(b).

We turn next to applicant's objection to opposer's supplemental notice of reliance. Applicant argues that this notice was not timely and should be excluded. We disagree. Opposer's Registration No. 2,050,013 (TH and laurel wreath design) issued on April 1, 1997. Immediately upon receiving the registration certificate, opposer filed a Section 7 request for a corrected certificate because the mark was incorrect. The records of the United States Patent and

Trademark Office (USPTO) demonstrate that the new registration certificate was reprinted on June 30, 1997 to correct the USPTO's error. Opposer thought the error had been corrected until such time as it sought a certified copy of the registration from the USPTO to file with its Notice of Reliance in this proceeding dated March 14, 2002, but such copy did not reflect the correction. Opposer noted this problem in an extensive footnote of its Notice of Reliance, and the USPTO has since effected the change. The corrected registration appeared in the *Trademark Official Gazette* of July 9, 2002, and opposer submitted its supplemental Notice of Reliance on August 22, 2002. We find this involves a timely attempt on opposer's part to provide a certified copy of a subsisting registration despite USPTO error. Moreover, we find that permitting opposer to supplement its original Notice of Reliance in this manner does not involve prejudice to applicant.

Opposer's Priority

With respect to priority of use, because opposer has submitted proper status and title copies of its pleaded registrations (e.g., its "crest design" marks and its "TH and laurel design" mark), the issue of priority with regard to these marks does not arise. King Candy Co. v. Eunice

King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). With regard to opposer's claim of common law rights in the mark "H," the undisputed evidence of record establishes that opposer has used variations of the letter "H" in connection with specific clothing items for several years prior to the earliest date upon which applicant can rely, i.e., its May 21, 1998 application filing date.

In view of the above, opposer has established its priority.

Likelihood of Confusion

We turn then to the question of likelihood of confusion.

Opposer contends that its registered goods include a line of sailing apparel similar to applicant's identified goods; that opposer has created one of the best known lifestyle brands in the United States; and that a consumer familiar with opposer's "crest design," "TH and laurel design," and single letter "H" designations will associate applicant's applied-for mark with opposer's well-known marks.

By contrast, applicant contends that the parties' marks are dissimilar; that opposer's so-called "sailing" line of clothing does not even use any of the three marks claimed by

opposer; that even if HILFIGER, TOMMY and TOMMY HILFIGER may be famous marks, the same has not been shown for the "crest design" or the "TH and laurel design"; and that the goods of both parties are not "impulse" items, but rather would be purchased only after a period of deliberate and careful decision-making.

After careful consideration of the facts before us and the relevant law on the issue of likelihood of confusion, we hold that opposer has failed to show a likelihood of confusion herein, and that applicant is entitled to the registration it seeks.

In the course of determining the question of likelihood of confusion herein, we have followed the guidance of In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). The du Pont case sets forth each factor that should be considered, if relevant information is of record, in determining likelihood of confusion.

We turn first to the similarity or dissimilarity and nature of the goods as described in applicant's application and as listed in opposer's claimed registrations and in connection with which its prior marks have been in use as shown by the record for its unregistered but previously used "H" mark. As listed in the involved application and registrations, we find that the travel bags and luggage

items, as well as the items of clothing must be deemed to be legally identical. Likewise, the "H" mark of opposer has been proven to have been used, *inter alia*, on jackets, shirts and hats, which are legally identical to the same listed items in the involved application. This factor favors finding a likelihood of confusion as to these goods, as argued by opposer.

In a related du Pont factor focusing on the similarity or dissimilarity of established, likely-to-continue trade channels, we must assume that these identical and closely related goods identified in the application and registrations will be moving in identical channels of trade to the same types of consumers inasmuch as the identifications are not restricted to any specific classes of consumers or channels of trade.⁷

We turn next to the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. The parties spend

⁷ Similarly, while the extrinsic evidence made part of this record suggests both parties' goods may be pricier than the average lines of luggage and clothing, there are no restrictions to this effect in the identification of goods in the involved application or in the pleaded registrations. Thus, we much presume conditions of the level of care exercised by ordinary purchasers of articles of leather and traveling bags in International Class 18 as well as items of wearing apparel in International Class 25.

considerable time discussing the similarities or the dissimilarities of the marks:



Opposer argues as follows:

...Henri[-]Lloyd's [applicant's] Laurel Design Mark consists of a crest design comprised of a prominent letter "H" and a much smaller, less prominent, small interlocking "L," surrounded by laurel leaves, with a crown above and a ribbon below the two letters. ... [T]he Hilfiger Crest Design Mark is a stylized crest design comprised of a heraldic lion surrounded by laurel leaves with a crown above and a ribbon below the lion...

By contrast, applicant argues as follows:

The differences between Applicant's Mark and Opposer's Lion Design mark are numerous:

- (a) The most prominent feature of Opposer's Lion Design mark is the Lion Design at the Center. Applicant's Mark has no such element;
- (b) Applicant's Mark has the letters H and L at the center, and Opposer's Lion Design mark includes no letters whatsoever;
- (c) The sprigs of the laurel leaf designs of the two marks are different in shape as are the laurel leaves themselves;
- (d) Applicant's Mark includes a crown beneath the middle of the upper ends of the laurel leaf springs, whereas Opposer's Lion Design has a castle Design located between the ends of the laurel sprigs;

- (e) The two laurel sprigs of Applicant's Mark abut each other at their lower ends, whereas the lower ends of the laurel sprigs of Opposer's mark are spaced apart;
- (f) The ribbon designs of the two marks are totally different; and
- (g) Opposer's Lion Design mark has no element comparable to applicant's black diamond background.

Keeping in mind that the comparison of marks is not made on a side-by-side basis and that recall of purchasers is often hazy and imperfect, this decision cannot turn on the minimal differences in the laurel sprigs and ribbons (applicant's arguments (c), (e) and (f) above). On the other hand, we agree with applicant that there are significant differences between the appearances of these two marks that should obviate any likelihood of confusion. The central element in opposer's crest design is a lion while the central element of applicant's composite mark consists of the letters HL. Opposer's self-described crown design actually appears more to be a turret of a castle and hence is different from applicant's crown design. Accordingly, when considered in their entirety, the appearance and overall commercial impression of these two marks is quite different and, we find, would not lead to a likelihood of confusion.

The parties have also disagreed about the similarities between the second of opposer's pleaded marks (registered

for shirts, hats, caps, pants, shorts and socks in International Class 25 only) and the mark for which applicant seeks registration:



Opposer argues as follows:

...Henri[-]Lloyd's [applicant's] Laurel Design Mark consists of a crest design comprised of a prominent letter "H" and a much smaller, less prominent, small interlocking "L," surrounded by laurel leaves, with a crown above and a ribbon below the two letters. The Hilfiger Laurel Design Mark consists of a capital "T" and capital "H" surrounded by virtually identical leaves. ...

By contrast, applicant argues as follows:

The differences between Applicant's Mark and TH and Design mark are as follows:

- (a) Opposer's Mark has no black diamond background;
- (b) Applicant's Mark includes the letters H and L superimposed on each other, whereas Opposer's mark has the letters TH adjacent to each other;
- (c) Opposer's mark includes no crown;
- (d) Opposer's mark includes no ribbon.

Again, when considered in their entirety, while both marks do include a letter "H" within a laurel wreath, the two composite marks are dissimilar enough in appearance that

we find they create very different overall commercial impressions. Specifically, the letters "TH" are a significant part of opposer's mark while the crown and the large letter "H" are significant features of applicant's mark.

Finally, turning to opposer's common law marks, even though opposer has shown a variety of forms of usage of the letter "H" on items of outerwear, there is no consistency in overall commercial impression of these various usages permitting us to conclude that the letter "H" dominates each of these marks.⁸ Accordingly, we cannot find that opposer's composite marks containing the letter "H" are confusingly similar to applicant's composite mark, which clearly contains other arbitrary and prominent elements.

Opposer's theory of the case seems to turn on the fact that "[a] consumer familiar with the three Hilfiger marks upon which this opposition is based, all of which contain key elements that are found in the Henri[-]Lloyd Laurel Design Mark, will naturally associate the Henri[-]Lloyd Laurel Design with Hilfiger." (Opposer's trial brief, p. 9).

⁸ In some of these cases, for example, consumers may well find the HILFIGER or TOMMY HILFIGER portion more dominant.

In response to this line of reasoning, applicant argues that "[a]pparently recognizing the weakness of its case, Opposer ... attempts to pick and choose various elements from three different marks to contrive some similarity between such a composite and Applicant's Mark. Clearly, there is no basis in law for selecting portions of different marks in order to create an imaginary mark, i.e., a mark which does not exist in reality, so as to fabricate a basis for a likelihood of confusion." (Applicant's trial brief, p. 11).

We need not agree or disagree with the premise of applicant's argument (i.e., opposer's recognizing the weakness of its case), to concur with applicant's position that opposer cannot take elements of several distinct marks and then argue that a combination of these elements creates a likelihood of confusion.⁹ In looking at the similarity of the marks, we must compare applicant's applied-for mark separately against each of opposer's pleaded marks. Accordingly, as to this du Pont factor, the overall dissimilarity of the parties' marks favors applicant's position that there is not a likelihood of confusion.

⁹ Cf. H. D. Hudson Manufacturing Company v. Food Machinery and Chemical Corporation, 230 F.2d 445, 109 USPQ 48 (CCPA 1956) [Opposer cannot rely upon argument that respondent wrongfully combined parts of two or more different marks when creating a new composite mark when that combination of elements was never previously used by opposer.]

Turning to the fame of opposer's claimed marks, it is clear from this record that opposer has experienced significant sales, has spent large sums on advertising, and has created a strong brand awareness within the relevant market sectors. However, this general level of marketing and sales volume is in no way correlated with these pleaded, registered marks. In fact, opposer's catalogues, advertisements and annual reports prominently and frequently feature not the pleaded marks but the HILFIGER, TOMMY and TOMMY HILFIGER marks alone and in combination with opposer's red, white and blue nautical flag logo, as shown below:



Accordingly, while we treat opposer's pleaded, registered marks as distinctive and strong marks, we cannot, on this record, find them to be famous or accord them the broad scope of protection to which opposer argues they are entitled.

Finally, in looking at any other established fact probative of the effects of use, we note opposer's suggestion of bad faith intent on the part of applicant in choosing this composite mark: "[T]o bolster the evidence of Henri[-]Lloyd's intent, it is apparent that Henri[-]Lloyd copied elements from several of Hilfiger's marks to create

its own mark. Hilfiger is not picking and choosing bits and pieces from its marks." (Opposer's reply brief, p. 8).

Absent compelling and objective evidence of bad faith, however, we cannot infer such intent from the adoption of a mark that arguably only moves applicant close to an imaginary composite of opposer's several pleaded marks.¹⁰

In conclusion, we find that while the goods are identical or otherwise closely related and will move through the same channels of trade, the marks themselves are not confusingly similar, we do not regard opposer's pleaded marks as famous marks, and we do not impute any bad faith to applicant in adopting its applied-for mark.

Decision: The opposition as to International Classes 18 and 25 is dismissed, and the application will be forwarded for the issuance of a notice of allowance in all three classes, namely International Classes 9, 18 and 25, at the appropriate time.

¹⁰ Opposer seeks to make this point by contrasting the instant opposition with several of applicant's/Henri Lloyd's other marks to which opposer/Hilfiger does not object:

