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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Chantelle

v.

De Millus Comercio e Industria De Roupas S.A.

Opposition No. 91094834
to application Serial No. 73349031
filed on January 15, 1993

John M. Keene and John H. Anderson of Graham, Campaign
P.C. for Chantelle

Stephen L. Baker of Baker & Rannells for De Millus
Comercio e Industria De Roupas S.A.

Before Cissel, Seeherman and Hohein, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Chantelle has opposed the application of De Millus
Comercio e Industria De Roupas S.A. to register DANTELLE

as a trademark for ladies' hosiery.¹ As grounds for opposition, opposer has alleged that it is the prior user of the mark and trade name CHANTELLE in the United States; that it owns a registration for this mark for brassieres, slips, panties, girdles and one-piece body briefers; and that applicant's mark DANTELLE is likely to cause confusion.

In its answer, applicant has admitted that it has not used its mark in commerce and that it made no use of its mark in the United States or in commerce regulable by Congress prior to the filing of its application on January 15, 1993, and denied the remaining allegations in the notice of opposition.²

The record includes the pleadings, the file of the opposed application, and the testimony, with exhibits, of opposer's witness, Sonja Winther, managing director of

¹ Application Serial No. 74349031, filed January 15, 1993, pursuant to Section 44(e) of the Trademark Act, based on a Brazilian registration.

² Applicant also asserted as "affirmative defenses" that the notice of opposition failed to state a claim upon which relief may be granted, that Chantelle is a common given name and is not inherently distinctive, and that the marks are not similar. Opposer moved to strike these "defenses". The Board struck the defense that Chantelle is not an inherently distinctive mark as an impermissible collateral attack on opposer's registration. Noting that applicant was not barred from pleading the remaining matters as affirmative defenses, even though these defenses may be similar or even identical to applicant's denials of opposer's allegations, the Board otherwise denied the motion to strike.

Chantelle, Inc, the U.S. subsidiary of opposer.³

Applicant did not submit any evidence, and only opposer filed a brief. An oral hearing was not requested.

The record shows that opposer is a French corporation which started doing business in the United States under the trade name and trademark CHANTELLE in 1971. Since at least 1999, when opposer's witness joined its U.S. subsidiary, the mark has been used on bras, panties, girdles, body suits, garter belts, slip dresses and body briefers. Opposer's products are considered "high end," and are sold in "luxury" department stores such as Neiman Marcus, Saks Fifth Avenue, Nordstrom, Jacobson's and Bergdorf Goodman. Opposer's goods are

We note that applicant did not subsequently submit any evidence or argument with respect to the remaining defenses.

³ A portion of Ms. Winther's testimony deposition was submitted under seal. Although this excerpt does include some confidential material, the latter portion of the excerpt clearly does not contain confidential information, and it appears that counsel simply failed to indicate, during the deposition, when the confidential part was at an end. Accordingly, in our opinion we have treated as confidential only that portion of the excerpt which is truly confidential. Further, during Ms. Winther's deposition, opposer's counsel put into evidence material of which Ms. Winther had no previous knowledge; in effect, opposer's counsel, by his statements, was attempting to testify himself. We have considered Exhibit 20, a copy of a consent judgment, because it is a public record and because there has been no objection, although opposer's counsel's remarks characterizing the proceeding have not been considered. We have also considered Exhibit 18, a package of DANTELLE pantyhose, and Ms. Winther's testimony as to her assessment of the product. However, opposer's counsel's remarks as to how and where the product was obtained have not been considered.

also sold through mail order, and in particular, through Bra Smyth.

Opposer advertises its products nationally in such magazines "Elle," "InStyle" and "Vogue," and also advertises in catalogs of department stores such as Neiman Marcus, Saks Fifth Avenue and Nordstrom. Occasionally opposer does newspaper advertising, including in "WWD Magazine," a trade paper. It also has a website, and it distributes its catalogs to department store buyers. Although opposer does not do any television commercials, it got some publicity on a local New York City morning news show in September 2000 in which opposer's witness talked about trends and four models exhibited its lingerie products. In addition, opposer has participated, along with the manufacturers of products bearing 30-40 other brands, in an intimate apparel fashion show in New York City on September 9, 2001, which received media attention. Specifically, clips from this show were broadcast on a program called New York One on September 10.

The department store and mail order advertisements which opposer has made of record are primarily for brassieres, and in some cases also feature panties. Opposer's own catalogs show its entire collection.

Priority is not in issue because opposer is the owner of a registration for CHANTELLE for "brassieres, slips, panties, girdles and one-piece body briefers, a status and title copy of which it has made of record."⁴ King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Turning to the issue of likelihood of confusion, our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

With respect to the marks, although there are similarities in the ending of each mark, we find that they are outweighed by the overall differences in

⁴ Registration No. 1,636,190, issued February 26, 1991; Sections 8 and 15 affidavit accepted; renewed.

appearance and connotation. In particular, the marks begin with different letters, and these differences, because they are at the beginning of the marks, are more likely to be noted by the consuming public. Moreover, these differences are emphasized by the manner in which the marks are depicted in actual use, with the initial letters "C" and "D" shown in larger size, capital letters. The "h" in CHANTELLE is also emphasized because, although it is in lower case, it is in fact larger in height than the capital "C."⁵ Further, the major similarity in the appearance and pronunciation of the marks is the ending syllable ELLE; however, opposer's witness has testified that "the ending 'elle' is the word for 'she' in French and it is a common ending to any word that is feminine, so it connotes femininity." Dep, p. 11. As a result, consumers are not likely to give this suggestive element much weight, or to regard the fact that both marks contain this element as indicating that the marks identify goods coming from a single source. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

⁵ Opposer has pointed out that the typestyles of the marks are very similar. However, the marks are shown in a very ordinary upper and lower case typestyle, similar to a New Times Roman font, and as a result consumers are not likely to view the

As for the connotations of the marks, opposer's witness has testified that CHANTELLE has no meaning. If anything, it is somewhat similar to the given name "Chantal." On the other hand, opposer's witness testified that applicant's mark, DANTELLE, is likely to be pronounced in the same manner as the French word for "lace." To that extent, the connotation of DANTELLE is clearly different from the connotation of CHANTELLE.⁶

As for the pronunciation of the marks, because the marks are not English words, we cannot say that there is a correct pronunciation for them. Thus, although it is possible that they may be pronounced such that they rhyme with each other, it is equally likely that "Chan" in CHANTELLE may be pronounced as the "shan" in "shan't" and DANTELLE may be pronounced, as opposer suggests, as "dontelle," or vice versa. However, even if we view the

similar typestyles as indicating that the marks represent a single source.

⁶ Opposer makes the argument in its brief that that almost all of opposer's CHANTELLE products consist at least partly of lace, and therefore DANTELLE is descriptive of an element of opposer's goods. It is not clear to us the purpose of this argument. Opposer is not asserting that DANTELLE is merely descriptive, since to be merely descriptive under Section 2(e)(1) of the Act, it would have to be descriptive of applicant's goods, not opposer's. Nor has opposer asserted mere descriptiveness as a ground for opposition. Opposer's argument that applicant's mark has a meaning with respect to opposer's goods serves only to reinforce the connotative differences between the marks, since opposer contends that its mark has no meaning.

marks as rhyming, the initial sounds of CHANTELLE and DANTELLE create different pronunciations.

There are also differences in the parties' goods. Although opposer's witness has stated that pantyhose on the one hand, and bras, girdles, panties and body briefers on the other, are all classified as intimate apparel, the mere fact that a particular term can be used to describe products does not necessarily make those goods related. See General Electric Company. V. Graham Magnetics Incorporated, 197 USPQ 690 (TTAB 1977); Harvey Hubbell Incorporated v. Tokyo Seimitsu Co., Ltd., 188 USPQ 517 (TTAB 1975). In this case, there are clear differences between hosiery and the intimate apparel identified in opposer's registration. The closest item to applicant's hosiery sold by opposer are garter belts. It is noted that this item is not covered by opposer's registration, and opposer has not submitted evidence of use of its mark on such goods prior to the January 15, 1993 filing date of applicant's application. However, even if we accept that garter belts are within the natural scope of expansion of opposer's goods, opposer has not shown that hosiery is also within such a scope of expansion. There is no evidence of record to prove that companies which sell brassieres, panties, garter belts

and opposer's other items of intimate apparel also sell hosiery.⁷ Opposer's witness specifically testified that she was unaware of any plans of opposer to sell pantyhose.

We would also point out that hosiery, on one hand, and brassieres, panties and the like on the other, are not complementary items in the sense that handbags and shoes, or sweaters and skirts would be considered complementary. That is, consumers do not match hosiery and brassieres, panties or garter belts in the same way that they might match these other items.

Thus, although we do not find that the parties' goods are entirely unrelated, the degree of relatedness is not so great that, given the differences in the marks,

⁷ In its brief, opposer states that it is common knowledge "that many women wear pantyhose over or under panties or body briefers in cold or inclement weather," and that "many types of pantyhose available today have 'panty' tops." pp. 11-12. As a general rule, the Board does not take judicial notice of this type of information. Opposer's witness testified extensively about the intimate-apparel industry, the buying habits of consumers, etc., and we see no reason why opposer could not have adduced evidence relating to how and when consumers would wear pantyhose and panties or body briefers. In any event, although we accept that there is an obvious connection between the use of pantyhose and panties, we cannot conclude on this record that consumers are likely to assume that both products emanate from the same source, any more than consumers are likely to assume that pantyhose and shoes emanate from the same source, even though pantyhose are worn with and in shoes. As we pointed out above, opposer has submitted no evidence that hosiery and intimate apparel such as panties and brassieres are produced by the same companies.

consumers are likely to assume that the goods come from the same source.

In reaching this conclusion, we have also taken into consideration the other duPont factors on which there is evidence in the record. In particular, we note that both parties' goods are of a type which can be sold in the same channels of trade. Opposer's witness has, in fact, testified that these products can be found in the same retail outlets, and even in the same departments in department stores. Although this factor favors opposer, it does not outweigh the dissimilarities in the marks and goods which we have previously discussed.

In terms of the number and nature of similar marks in use on similar goods, applicant has not submitted any evidence of such marks. However, opposer has made of record the use by C & F Enterprises, Inc. of the identical mark, CHANTELLE, for bedding. Opposer objected to this use in 2000, but was advised by C & F that they did not believe that confusion would result from their use of the mark. Opposer's witness was unaware of any further action that opposer might have taken. Although we do not regard this third-party use for bedding as seriously impacting the strength of opposer's mark, we

cannot say that this duPont factor strongly favors opposer.⁸

As a further argument regarding the strength of its mark, opposer has cited *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 936 F.2d 350, 22 USPQ2d 1463 (Fed. Cir. 1992) for the proposition that "marks that are strong and distinctive enjoy the widest scope of protection that the courts can give to a trademark." Brief, p. 10. In point of fact, the Kenner Parker case involved a famous mark. With respect to the duPont factor of fame, we find that opposer has failed to prove that its mark is famous. Opposer does not attempt to assert that its CHANTELLE products are dominant sellers for these goods in general; rather, opposer identifies its sales position as being for a niche product, designer lingerie which is "positioned high-end in the market." Dep. p. 17. Even in this niche, however, opposer is not the leader. Rather, it is a company called Wacoal which is the overall leader and, even in the high-end stores in which opposer's goods are sold, opposer's products may in

⁸ In its brief opposer makes reference to two registered marks "that are colorably similar to CHANTELLE in the U.S. women's clothing and accessories fields"—CHANTAL THOMASS and CHANTAL. Brief, p. 13. These third-party registrations are not of record, and have not been considered.

some cases be only 20% of Wacoal's volume, while in others they may have equal volume.

Although opposer has provided its net sales figures since 1993,⁹ it has not put these sales in context, and therefore we cannot determine how they compare with other leading brands. As indicated above, the only information opposer has provided shows that its sales are limited, and this evidence falls far short of proving that CHANTELLE is a famous mark.

Similarly, the evidence opposer has submitted with respect to its advertising expenditures and promotional efforts does not demonstrate that consumers have been so exposed to the CHANTELLE mark that they would immediately recognize it. Opposer has submitted its advertising expenditures under seal, but these figures do not appear to us to be extremely large and, again, opposer has not submitted any comparisons with advertising expenditures for other, famous marks for similar products. Although opposer has engaged in advertising efforts since at least 1993, they appear to us to be rather limited, consisting primarily of print advertisements in a few issues of certain magazines, and in store catalogs and one mail-

⁹ Opposer has marked its sales figures as "confidential," and therefore we will not reveal them in this opinion.

order catalog. Some amount of its advertising expenditures are for its own catalogs, which are distributed to department store buyers, rather than to ultimate customers. Opposer has engaged in no television advertising, and its television publicity efforts consisted of one local New York City program, and some publicity given to a fashion show in which opposer took part, along with 30 or 40 other brands.¹⁰

As for the conditions under which and buyers to whom sales are made, again we cannot say that this factor favors opposer. Opposer's witness testified that customers give a lot of thought to the purchase of lingerie, and particularly to the purchase of brassieres. She also testified that pantyhose may be the subject of careful purchasing. "The higher the price, I think the more time is spent on it...." Dep. p. 87. In this connection, we note that the package of DANTELLE pantyhose which is of record shows a suggested retail price of \$11.00 printed on the packaging, although an adhesive tag bears of price of "5,90," which we assume is

¹⁰ We note that this fashion show took place two days before the terrorist attacks in New York and Washington. Whatever television publicity it may have received on September 9 and 10, (and opposer identified only a local New York City program on September 10), there is no evidence that it continued after that date.

\$5.90. Opposer's witness also stated that people who do not wear pantyhose often will "spend a lot of time looking around at the different brands and types," although she said that "if you wear them more often, it's a commodity, and you know what you like and you buy it quickly." Dep. p. 87. We conclude from this testimony that the parties' goods, although bought by ordinary consumers, are generally not the result of an impulse purchase, and that consumers who buy pantyhose on a regular basis will know the brand that they prefer and will look for that brand. Thus, we do not find that this duPont factor favors opposer.

Opposer contends that applicant adopted its mark in bad faith, based on the alleged similarity of the marks; the fact that the French pronunciation of applicant's mark is the same as the French word for lace; and the typestyle of applicant's mark as it appears on its packaging is the same as opposer's. We have previously discussed these arguments, and for the reasons already given in this opinion, decline to find that applicant's mark was adopted in bad faith.

In conclusion, even if we accept that certain of the duPont factors favor opposer (in particular, the similarity in channels of trade, and lack of third-party

use of similar marks for similar goods), we find that the differences in the marks and the goods preclude a finding of likelihood of confusion. See *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (dissimilarity of marks alone may play a dominant role in the likelihood of confusion determination).

Decision: The opposition is dismissed.