Fashion Apparel Law Blog

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Valentino Receives Favorable TTAB Ruling in Sixteen-Year Trademark Dispute

On June 25, 2010, the Trademark Trial and Appeal Board ("TTAB") of the United States Patent and Trademark Office rendered its decision in the case of *Valentino U.S.A., Inc. v. Florence Fashions (Jersey) Limited*, Opposition Nos. 91094961 and 91095203, Cancellation Nos. 92029390 and 92029476, 2010 WL 2783891 (TTAB June 25, 2010), marking the culmination of a sixteen-year dispute -- the opposition proceedings were filed in June 1994 and the cancellation proceedings were commenced in June 1999. Defendant Florence Fashion (Jersey) Limited ("Florence") had filed applications and registrations for the marks "Gianni Valentino" and "Giovanni Valentino" that it used on a variety of clothing and accessory items, including coats, dresses, handbags, and belts. Plaintiff Valentino U.S.A. ("Valentino") brought the proceedings on ground that, as applied to Florence's goods, the marks so resembled Valentino's previously used marks "Valentino" and "Valentino Garavani" for similar goods as to be likely to cause confusion under the Lanham Act, 15 U.S.C. § 1052(d) (*i.e.*, consumers would see a Florence Fashion "Giovanni Valentino" purse and think that it was produced by famed designer Valentino Garavani).

Florence asserted the affirmative defense that the "pleaded common law marks are comprised of or contain the common surname VALENTINO [and t]he pleaded marks are primarily merely a surname and lack distinctiveness." TTAB op. at 17; *2010 WL 2783891,* at *7. The TTAB disagreed, finding "that VALENTINO GARAVANI is obviously not primarily merely a surname, and, as a personal name, is considered to be inherently distinctive. . . ." TTAB op. at 19; *2010 WL 2783891, at *7*. The TTAB also found that the record did not establish that "Valentino" was primarily merely a surname. *Id.* Additionally, the TTAB said that even if "Valentino" was primarily merely a surname, the record established that the mark acquired distinctiveness in connection with clothing, handbags, footwear and accessory items prior to Florence's date of constructive use in 1991. TTAB op. at 19-20; *2010 WL 2783891,* at *8.

The TTAB found that Florence's proffered evidence to establish an alleged 1977 first use date, fourteen years before its intent-to-use applications and date of first use alleged in its registrations, was "far from clear and convincing." TTAB op. at 16; *2010 WL 2783891,* at *6. On the other hand, the TTAB held that it was an "inescapable conclusion" that "[Valentino]'s predecessor began selling clothing under the VALENTINO mark sometime in the 1960's." TTAB op. at 26; *2010 WL 2783891,* at *10. Additionally, the TTAB found Valentino's predecessor-in-interest first used the "Valentino Garavani" mark in sales of luxury items at least

as early as 1989, and acquired distinctiveness in connection those items prior to Florence's constructive use date in 1991. TTAB op. at 27; *2010 WL 2783891,* at *11.

The TTAB applied the traditional "du Pont factors" analysis (citing *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973)) to determine whether the use of the marks by Florence were likely to cause confusion. TTAB op. at 28-47; *2010 WL 2783891,* at *11-17. The TTAB found that because the plaintiff failed to introduce evidence showing the extent of sales and advertising, it was unable to meet its burden to show that its mark was famous. TTAB op. at 31; *2010 WL 2783891,* at *12. The Board thought that consumers, when presented with identical goods under the respective marks "Valentino" and "Giovanni Valentino" or "Gianni Valentino," were likely to perceive these two marks as the same name with one being the shortened form of the other. The TTAB also stated that the similarity occasioned by the name "Valentino" occurring in both marks "has particular weight in the clothing and accessories industry where it is common for designers to shorten their name marks." TTAB op. at 38-39; *2010 WL 2783891, at *15.* The TTAB concluded:

> In balancing the relevant factors, we conclude that because defendant's marks GIOVANNI VALENTINO and GIANNI VALENTINO are similar to plaintiff's marks VALENTINO and VALENTINO GARAVANI, the goods are identical, in part, and otherwise closely related, and there is an overlap in the channels of trade and the classes of purchasers, there is a likelihood of confusion. Further, plaintiff has established priority of use. In view thereof, plaintiff has proven its claim under Section 2(d) of the Trademark Act. Finally, to the extent we have any doubt we resolve it, as we must, in favor of the prior user.

TTAB op.at 47-48; 2010 WL 2783891, at *17. The TTAB sustained the oppositions and granted the petitions to cancel on the respective claims under Section 2(d). TTAB op. at 48; 2010 WL 2783891, at *17.