

This Opinion Is Not a
Precedent of the TTAB

Mailed: May 10, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
—

Louis Vuitton Malletier
v.
Quanzhou Viition Gifts Co., Ltd.
—

Cancellation No. 92072688
—

John P. Margiotta and Shelby P. Rokito of Fross Zelnick Lehrman & Zissu, P.C.
for Louis Vuitton Malletier.

Paulo A. de Almeida of Patel & Almeida PC
for Quanzhou Viition Gifts Co., Ltd.

—
Before Kuhlke, Lynch and Larkin,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Quanzhou Viition Gifts Co., Ltd. (Respondent) owns Registration No. 5772226 on

the Principal Register of the mark **viition** for the following goods:¹

Furniture; mirrors and looking glasses; furniture, namely,
works of art made of bamboo and wood; works of art made

—
¹ Registration No. 5772226 was filed on May 31, 2018 as a request for extension of protection under Section 66(a), 15 U.S.C. § 1141(f), and issued on June 11, 2019. The registration includes the following description of the mark: “The mark consists of the stylized wording ‘VIITION’ featuring a shaded circle centered between the letters ‘I.’”

of resin; decorations of plastic for foodstuffs; doors for furniture; bedding, namely, bed pillows, bed rests and bed rails; boxes of wood or plastic; photograph frames, International Class 20;

Tableware, namely, tea and coffee services; glassware, namely, plates, non-electric kettles, cups and glass jars; ceramics for household purposes, namely, plates, non-electric kettles, cups and ceramic jars; China ornaments; works of art of porcelain, terra-cotta or glass; liqueur pourers sets; porcelain ware for everyday use, namely, pots, bowls, plates and non-electric kettles; terra-cotta pottery ware for everyday use, namely, pots, bowls, plates, jars, crocks, marmite cooking pots and non-electric kettles; tableware of semiporcelain, namely, tea and coffee services; flower pots, International Class 21.

Louis Vuitton Malletier (Petitioner) has petitioned to cancel the registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Respondent's mark so resembles Petitioner's previously used and registered mark LOUIS VUITTON for a variety of goods including luggage, handbags, travel blankets, watches, clothing, sunglasses, hair accessories, phone accessories, paper goods, perfume, and services featuring such goods, as to be likely to cause confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).² In addition, Petitioner asserts a claim of dilution by blurring under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).

By its answer, Respondent denies the salient allegations but admits it is a Chinese company, the filing and issuance date of its registration, and that its "filing date and date of international registration of VIITION are decades after Petitioner's date of

² Pet. for Canc., 1 TTABVUE.

first use of its LOUIS VUITTON Trademark and decades after the date the LOUIS VUITTON Trademark were [sic] first registered in the USPTO.”³

I. Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the file of the registration subject to the petition for cancellation. In addition the record includes:

- Petitioner’s Testimony Declaration with exhibits of John Maltbie (Maltbie Decl.), Director of Civil Enforcement, Intellectual Property at Louis Vuitton North America, Inc., an affiliate of Petitioner;⁴
- Petitioner’s Notice of Reliance on Official Records;⁵
- Petitioner’s Notice of Reliance on Printed Publications;⁶
- Petitioner’s Notice of Reliance on Registrant’s Discovery Responses;⁷ and
- Respondent’s Testimony Declaration with exhibits of Wang Peijun (Peijun Decl.), Respondent’s General Manager.⁸

³ Answer ¶¶ 7-10, 5 TTABVUE 3.

⁴ 17-21 TTABVUE (public); 22-26, 28 TTABVUE (confidential).

⁵ 27 TTABVUE.

⁶ 29 TTABVUE.

⁷ 30 TTABVUE.

⁸ 31 TTABVUE.

II. Respondent's Objections

In its brief, Petitioner refers to its marks as “LOUIS VUITTON and VUITTON trademarks (together, the ‘VUITTON Mark’)” and presents evidence and testimony on goods beyond those specifically listed in its pleading. Respondent objects to the assertion of a separate VUITTON mark and the assertion of use on furniture and other goods not pleaded in the petition for cancellation. Resp. Brief, 35 TTABVUE 6-7. Petitioner responds that its pleading covers a wide variety of goods and services and points to the pleading which reads “Louis Vuitton has extensively used and promoted the LOUIS VUITTON Trademark in connection with a variety of goods **including** clothing, shoes, accessories, jewelry, bags, retail and online store services, **and related goods and services.**” Not. of Opp. ¶ 3, 1 TTABVUE 6 (emphasis added). Petitioner argues that:

This sentence provided notice to [Respondent] that [Petitioner] would be making the argument that the goods that it offers for sale are closely related to the goods in the VIITION registration. It is well-established that a Petition for Cancellation need only include a “short and plain statement” of the grounds for cancellation [and Respondent’s argument that Petitioner] is somehow foreclosed from making arguments as to the relatedness of any good not specifically mentioned in its Petition is baseless.

Pet. Rebut. Brief, 36 TTABVUE 10. Petitioner concludes that it “is relying on registrations cited in its Petition, its allegations that the goods at issue are similar, and its extensive evidence supporting that argument.” *Id.* at 11.

We do not read the wording “including” and “related goods and services” in Petitioner’s pleading, which focuses on “clothing, shoes, accessories, jewelry, bags,

retail and online store services” for any common law use, to specifically include furniture. Petitioner is correct that its registrations contain more than clothing, jewelry and fashion accessories, and that it may use evidence of use on a variety of goods and services as evidence of relatedness between its pleaded goods and Respondent’s identified goods. However, Petitioner may not rely on the unpleaded goods or services for priority purposes. *Fossil, Inc. v. Fossil Grp.*, 49 USPQ2d 1451 (TTAB 1998) (opposer may not rely on common law rights for clocks because it was not pleaded); *see also Pep Boys-Manny, Moe & Jack v. Edwin F. Guth Co.*, 197 F.2d 527, 94 USPQ 158, 159 (CCPA 1952) (“However, since the notice of opposition did not allege use of the mark on any product other than storage batteries, no other product can be considered in this proceeding.”); *see also Varsity Pajamas, Inc. v. Schackne*, 143 USPQ 428 (TTAB 1964) (Plaintiff may rely only on goods specifically pleaded but presumption of use is applied on all goods encompassed by the language of the registration).

In addition, Petitioner did not plead a separate mark VUITTON nor do we consider it tried by implied consent and we only address the pleaded mark LOUIS VUITTON. *Fossil, Inc.*, 49 USPQ2d at 1454; *see also Pep Boys-Manny, Moe & Jack.*, 94 USPQ at 159 (“However, Applicant’s argument that Opposer’s allegations regarding “WIZARDING-inclusive marks” are vague is well-taken. Allegations regarding marks not specifically identified in the notice of opposition fail to give Applicant fair notice of the basis of a claim of likelihood of confusion based on the unidentified marks.). The pleading very clearly does not include VUITTON by itself,

and Mr. Maltbie's reference in his trial deposition is not sufficient to determine that Respondent has consented to Petitioner's reliance on this mark and the other goods. However, this does not foreclose the analysis from considering the dominance of VUITTON in the LOUIS VUITTON mark or the practice in the industry to shorten names, in determining whether there is a likelihood of confusion or an association would be made.

III. The Parties and Their Marks

Both parties own registrations for various consumer goods.

A. Petitioner

Petitioner was founded by its namesake Louis Vuitton in 1854 and started with custom-made luggage and trunks. Over the years Petitioner expanded its product line into "high-quality handbags, eyewear, footwear, homeware, jewelry, watches, and other fashion and luxury goods."⁹ Petitioner has used the LOUIS VUITTON mark on goods in the United States since the early 1900's and currently "sells an enormous range of goods ... including ... paperweights, stationery, posters, coasters, plates, cups, cushions, blankets ... and candles."¹⁰

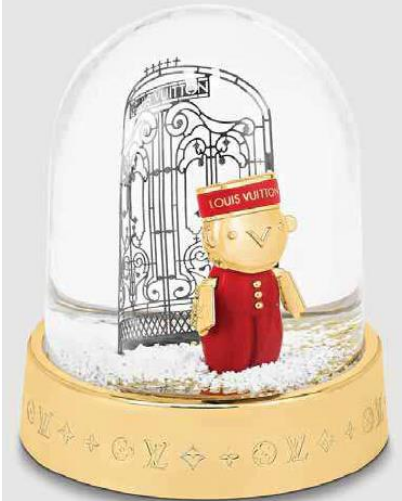
Petitioner uses its mark LOUIS VUITTON (and in a few examples VUITTON) on hangtags, embossed on the products and on store fronts as shown below:¹¹

⁹ Maltbie Decl. ¶ 4, 17 TTABVUE 3.

¹⁰ *Id.* ¶ 5.

¹¹ *Id.* ¶ 6-7, Exhs. 1, 2, 3, 17 TTABVUE 3-5, 263, 273, 282, 284, 289, 300, 309, 313, 315, 358.







Petitioner sells its products through company-owned and branded boutiques, stand-alone or within larger high-end retail stores such as Neiman Marcus and Saks Fifth Avenue, and through its website.¹²

Petitioner's registrations are valid and subsisting and are summarized below:¹³

Registration No. 5237988, issued on July 4, 2017, for the standard character mark LOUIS VUITTON for "perfumery; perfume; eau de toilette; eau de parfum; eau de cologne," in International Class 3;

Registration No. 4530921, issued on May 13, 2014, for the standard character mark LOUIS VUITTON for "sunglasses; accessories for telephones, mobile phones, smart phones; namely, covers, neck straps, neck cords, and bags and cases specially adapted for holding or carrying portable telephones and telephone equipment and accessories," in International Class 9, "paper bags; boxes of cardboard or paper; cardboard and paperboard envelopes and pouches for packaging; posters; postcards; catalogs featuring luggage, travel accessories, bags, small leather goods, and clothing; printed publications, namely, books, and magazines featuring luggage, travel accessories, purses, small leather goods, and clothing; photograph albums; stationery, namely, note pads, note books; diaries; office requisites, namely, paper weights, pencil holders, pen holders, pen cases," in International Class 16, "clothing, namely, pullovers, vests, shirts, tee-shirts, trousers, jackets, suits, coats, rain coats, waterproof jackets, overcoats, parkas, skirts, dresses, pajamas, gloves, neck ties, belts for clothing, leather belts, scarves, pocket squares, sashes for wear, shawls, stoles, bathing suits; headwear; shoes; slippers; boots; half-boots," in International Class 25, "buttons; shoe buckles; hair accessories, namely, barrettes, hair clips, hair bands, hair wraps; hair ornaments; brooches for clothing," in International Class 26;

¹² *Id.* ¶ 7, 17 TTABVUE 5.

¹³ Not. of Reliance Exhs. 22-25, 27 TTABVUE.

Registration No. 3904444 for the standard character mark LOUIS VUITTON for “Retail store services and on-line retail store services featuring clothing, footwear, headwear, bags, purses, eyewear, jewelry, watches, luggage, books; mail order services featuring clothing, footwear, headwear, bags, purses, eyewear, jewelry, watches, luggage, books; retail store services and on-line retail store services featuring phone-in order for clothing, footwear, headwear, bags, purses, eyewear, jewelry, watches, luggage, books,” in International Class 35; and

Registration No. 1990760, issued on August 6, 1996, for the typed mark LOUIS VUITTON for “watches and straps for wrist watches,” in International Class 14, catalogues featuring luggage and travel accessories, bags, small leather goods and garments; notebooks, anthologies and pamphlets referring to travel; calendars; telephone indexes; fountain pens, ballpoint pens, nibs, covers for pocket and desk diaries, and checkbook holders,” in International Class 16, “trunks; traveling trunks; suitcases; traveling bags; luggage; garment bags for travel; hat boxes for travel; shoe bags for travel; umbrellas; animal carriers; rucksacks; haversacks; leather or textile shopping bags; beach bags; handbags; vanity cases sold empty; attache cases; tote bags, travel satchels; clutch bags; briefcases; wallets; pocket wallets; credit card cases; business card cases; bill and card holders; checkbook holders; key cases; change purses; briefcase-type portfolios,” in International Class 18, “travel blankets,” in International Class 24, “shirts; sweatshirts; polo shirts; T-shirts; headwear; jackets; ties; belts; shawls; scarves,” in International Class 25.

Petitioner sells its products throughout the United States generating very large sales and engages in a broad advertising and marketing campaign to place its mark in the public eye and consumer consciousness.¹⁴ Petitioner advertises its various

¹⁴ The sales revenue and advertising expenditures were submitted under seal, but in general are very high, in the billions of dollars. More importantly, as outlined infra, Petitioner has shown the context of its advertising efforts. The sales, and advertising examples and schedules date back to 2016.

products under the LOUIS VUITTON mark in national and local magazines and newspapers, including The New York Times, The Los Angeles Times, Vogue, Vanity Fair, Elle, Harper's Bazaar, GQ, Esquire, Forbes, Marie Claire.¹⁵ In addition to its own website, Petitioner's Internet advertising includes banners and video advertisements on third-party platforms including Apple News, CNN Style, Conde Nast, Forbes, NYTimes.com, WSJ.com, Facebook, Instagram, Snapchat, Twitter, Hulu, Roku and YouTube.¹⁶ Petitioner promotes its mark through its website, social media accounts and keyword advertising. The numbers of commercial impressions, reflected in evidence submitted under seal, are very high. For decades Petitioner has used celebrity brand ambassadors, including Emma Stone, Michelle Williams, Alicia Vikander, Lea Seydoux, Sophie Turner Liu Yifei, Charlize Theron, Regina King, Tahar Ramin, Mark Ruffalo, John Boyega, Justin Bieber, Riz Ahmed, and Angelina Jolie, to promote the LOUIS VUITTON brand.¹⁷ Petitioner engages in several large sponsorship and partnership programs with cultural institutions, sporting events, and charities; these include the New York Metropolitan Museum of Art Costume Institute, America's Cup yacht racing series, the Monaco Grand Prix, the NBA and UNICEF.¹⁸ Examples appear below.

¹⁵ Maltbie Decl. ¶ 10, Exh. 4, 17 TTABVUE 7 (Exh. 4 was filed under seal but shows the extensive advertising schedule for these magazines and newspapers 2016-2021).

¹⁶ Maltbie Decl. ¶ 11, Exh. 5, 17 TTABVUE 7, 380-390.

¹⁷ Maltbie Decl. ¶ 13, 17 TTABVUE 8.

¹⁸ Maltbie Decl. ¶¶ 14-17.

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This spring, The Costume Institute at The Met brings to life a disrupted timeline of 150 years of fashion, exploring how clothes generate temporal associations that conflate past, present, and future.

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¹⁹ *Id.* Exh. 10, 17 TTABVUE 751.



FASHION

Louis Vuitton Launches NBA Capsule

• A virtual Madison Square Garden experience showcases the capsule and Larry O'Brien trophy and case.

BY CDE ANYANWU

Louis Vuitton and the NBA on Friday introduce the next installment of their partnership, a men's wear capsule by men's artistic director Virgil Abloh, and a virtual selling experience at Madison Square Garden.

Launching just days after the 2020 NBA Draft, the virtual experience features the Louis Vuitton emblem at center court, models in key looks from the capsule, an assortment of accessories and the Larry O'Brien NBA



The LV x NBA virtual experience.

Championship Trophy and trophy case, all made possible through drone footage captured at the arena.

The capsule collection, first revealed in

October following the Los Angeles Lakers' championship victory, is comprised of shoes, bags, ready-to-wear and jewelry inspired by an NBA player's wardrobe

and split into three concepts: travel, game arrival and the press conference.

"Louis Vuitton and the NBA are both icons and leaders in their respective fields, and the joining of the two promises exciting and surprising moments, forging historic memories together," said Louis Vuitton chairman and chief executive officer Michael Burke in a statement. "Louis Vuitton has long been associated with the world's most coveted trophies, and with this iconic partnership the legacy continues – victory does indeed travel in Louis Vuitton."

The partnership, which is Vuitton's first and only partnership with a North American sports league, began in January with the debut of the brand's bespoke trophy case for the Larry O'Brien trophy, which was presented for the first time in October to the 2020 NBA Champion Lakers. The fashion house hand-crafted the trophy at its Asnières workshop outside of Paris.

NBA deputy commissioner and chief operating officer Mark Tatum said in a statement, "The NBA Finals is defined by iconic players and memorable performances, culminating with the presentation of the Larry O'Brien trophy. The tradition, heritage and identity of Louis Vuitton create a natural synergy with the NBA, and this partnership provides a unique and fitting way to showcase our championship trophy to our fans around the world."

The LVxNBA digital experience is open to the public and developed exclusively for online access on louisvuitton.com.

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HARPERSBAZAAR.COM

Text by Chelsey Sanchez



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The LOUIS VUITTON mark receives unsolicited press coverage and LOUIS VUITTON branded products are frequently featured in high-circulation national

²⁰ *Id.* Exh. 11, 17 TTABVUE 762.

²¹ *Id.* Exh. 12, 17 TTABVUE 903.

publications.²² LOUIS VUITTON was ranked as the number 1 luxury brand and 9th most valuable brand overall by Forbes Magazine and Interbrand ranked LOUIS VUITTON the number 1 most valuable luxury brand and 17th most valuable global brand overall.²³ Because of its iconic status there have also been several books written about LOUIS VUITTON's history and popularity.²⁴

Petitioner has a robust enforcement program and regularly files extensions of time to oppose potentially infringing marks and sends cease-and-desist letters to applicants, frequently resulting in abandonment. In other cases, applicants default in opposition proceedings brought by Petitioner. From 2010 to 2020 Petitioner “has filed at least twelve opposition proceedings involving the LOUIS VUITTON mark. In fact, in an opposition filed with respect to Respondent’s eleven other VIITION-formative marks Respondent defaulted.”²⁵ Since 2010, Petitioner has filed approximately 120 lawsuits in federal district courts to protect its marks, including the LOUIS VUITTON mark.²⁶

²² Maltbie Decl. ¶¶ 21, 17 TTABVUE 10. The record includes 2,763 pages of press clippings dating back to 2015.

²³ *Id.* ¶ 22, Exhs. 17-18, 17 TTABVUE 11, 21 TTABVUE 3-10.

²⁴ *Id.* ¶ 24, 17 TTABVUE 11.

²⁵ *Id.* ¶ 27, 17 TTABVUE 14.

²⁶ *Id.* ¶ 28, Exh. 19, 17 TTABVUE 14, 21 TTABVUE 12-20.

Finally, like other luxury brands Petitioner has introduced secondary product lines with a shortened version of its name, VUITTON, and has expanded its product line to include more disparate products such as furniture.²⁷

B. Respondent

Respondent first used its **viition** mark in 2012 in China for furniture and houseware products and currently uses the mark on other consumer goods such as string lights, bird baths, etc.²⁸ Respondent promoted its products under the **viition** mark in various trade shows in Germany, Italy, and the U.K. Respondent has started selling some of the **viition**-branded products in the United States and intends to distribute its goods in the U.S. through large retail outlets featuring low-priced consumer goods such as Walmart and Amazon.²⁹

IV. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a requirement that must be proven by the plaintiff in every inter partes case.³⁰ *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, *3 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109

²⁷ *Id.* ¶¶ 30-32, 17 TTABVUE 13-14.

²⁸ Peijun Decl. ¶¶ 6-7, 31 TTABVUE 3.

²⁹ Peijun Decl. ¶¶ 8-9, 31 TTABVUE 3-4.

³⁰ Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” Despite the change in nomenclature, the Board’s prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain applicable. *See Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may seek to cancel a registration of a mark where such cancellation is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the party has a reasonable belief in damage that is proximately caused by continued registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, *6-7 (Fed. Cir. 2020).

Here, Petitioner's pleaded and proven registrations³¹ and prior use of its LOUIS VUITTON mark³² establish that it is entitled to petition to cancel registration of Respondent's mark on the grounds of likelihood of confusion and dilution. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (registration establishes "standing"); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (testimony that opposer uses its mark "is sufficient to support opposer's allegations of a reasonable belief that it would be damaged ..." where opposer alleged likelihood of confusion).

V. Dilution

Petitioner alleges dilution by blurring. To prevail, it must show that: (1) it owns a famous mark that is distinctive; (2) Respondent is using a mark in commerce that allegedly dilutes Petitioner's famous mark; (3) Respondent's use of its mark began after Petitioner's became famous; and (4) Respondent's use of its mark is likely to cause dilution by blurring or tarnishment. *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1502 (TTAB 2015) (quoting *Coach Servs. Inc. v. Triumph*

³¹ Pet. Not. of Rel. Exhs. 22-25, 27 TTABVUE 4-54.

³² Maltbie Decl. ¶ 5, Exh. 1, 17 TTABVUE 3, 22-353.

Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1723-24 (Fed. Cir. 2012)); *see also Spotify AB v. U.S. Software Inc.*, 2022 USPQ2d 37 (TTAB 2022). Petitioner did not allege dilution by tarnishment.

A. Petitioner Owns a Distinctive, Famous Mark

There is no dispute that Petitioner's mark LOUIS VUITTON is distinctive. It is registered on the Principal Register without a claim of acquired distinctiveness, and is presumed distinctive. *Spotify*, 2022 USPQ2d at, *21.

In analyzing the fame of the LOUIS VUITTON mark for dilution purposes, we must determine whether it "is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." *N.Y. Yankees P'ship*, 114 USPQ2d at 1502 (quoting 15 U.S.C. § 1125(c)(2)(A)).

In doing so, we consider:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

15 U.S.C. § 1125(c)(2)(A) .

1. Advertising and Publicity

Through three different centuries, Petitioner's mark has enjoyed wide advertising and publicity, both through Petitioner's own efforts and through unsolicited

references by third parties. The evidence from the record discussed above shows the extensive nature and consumer penetration of Petitioner's marketing, including broad advertising campaigns in all media, celebrity endorsements, and sponsorships of large cultural, sporting and charity events, exposing the mark to the general public.

2. Sales of Goods Offered Under the LOUIS VUITTON Mark

While the actual numbers were submitted under seal, the sales of goods under the LOUIS VUITTON mark before Respondent's filing date are quite significant, in the billions of dollars annually. Pet. Brief, 33 TTABVUE 11.

3. Actual Recognition of the Mark

"Perhaps the most significant of the four elements set forth in the Act to determine fame is the extent of actual public recognition of the mark as a source-indicator for the goods or services in connection with which it is used." *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1104 (TTAB 2018) (quoting *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1024 (TTAB 2011)).

The record contains ample evidence that demonstrates very high actual recognition of the LOUIS VUITTON mark by the general public. High actual recognition may be inferred from Petitioner's broad and large advertising campaigns across all media that includes the use of celebrities connected with LOUIS VUITTON-branded products and highly-visible events such as the NBA and Met Museum sponsorships. In addition, the examples of unsolicited mainstream media attention and the recognition of brand strength by two separate entities, Forbes and Interbrand, reflect public recognition of the LOUIS VUITTON mark.

4. LOUIS VUITTON is Registered on the Principal Register

Petitioner made four registrations for the mark LOUIS VUITTON of record. The oldest issued in 1996, 26 years ago.

5. LOUIS VUITTON is Famous

The record establishes that the LOUIS VUITTON mark is exceedingly famous, and entitled to protection against dilution under 15 U.S.C. § 1125(c).

B. Respondent is Using **viition**, a Mark that Allegedly Dilutes Petitioner's LOUIS VUITTON Mark

Respondent is using its **viition** mark in commerce and the mark is registered in the United States. Because Petitioner bases one of its grounds for cancellation on its allegation that **viition** dilutes Petitioner's LOUIS VUITTON mark, this element of the dilution test is also satisfied. *See Chanel, Inc. v. Majarczyk*, 110 USPQ2d 2013, 2023 (TTAB 2014).

C. Petitioner's LOUIS VUITTON Mark was Famous Before Respondent's First Use of **viition**

As described above, the record shows that the LOUIS VUITTON mark was famous prior to Respondent's constructive use date of May 31, 2018.

D. Respondent's Use of Its **viition** Mark is Likely to Cause Dilution By Blurring

Dilution by blurring is "an association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." *Coach Servs.*, 101 USPQ2d at 1724 (quoting 15 U.S.C. § 1125(c)(2)(B)). It "occurs when a substantial percentage of consumers, on seeing the junior party's mark on its goods, are immediately reminded of the famous mark and associate the

junior party's mark with the owner of the famous mark, even if they do not believe that the goods emanate from the famous mark's owner." *N.Y. Yankees P'ship*, 114 USPQ2d at 1509; *see also Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1298 (TTAB 2016) (quoting 15 U.S.C. § 1125(c)) (Blurring may occur "regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury."). The concern is that "the gradual whittling away of distinctiveness will cause the trademark holder to suffer 'death by a thousand cuts.'" *Nat'l Pork Board v. Supreme Lobster & Seafood Co.*, 96 USPQ2d 1479, 1497 (TTAB 2010) (citation omitted). *See also, Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 330 F.3d 1333, 66 USPQ2d 1811, 1816 (Fed. Cir. 2003) ("dilution law is intended to protect a mark's owner from dilution of the mark's value and uniqueness").

To determine whether Respondent's use of its mark is likely to cause dilution by blurring, we consider:

- (i) the degree of similarity between Respondent's mark and Petitioner's famous mark;
- (ii) the degree of inherent or acquired distinctiveness of Petitioner's mark;
- (iii) the extent to which Petitioner is engaging in substantially exclusive use of its mark;
- (iv) the degree of recognition of Petitioner's mark;
- (v) whether Respondent intended to create an association with Petitioner's LOUIS VUITTON mark; and
- (vi) any actual association between Respondent's mark and Petitioner's mark.

15 U.S.C. § 1125(c)(2)(B)(i-vi).

1. The Marks are Similar

We “consider the degree of similarity or dissimilarity of the marks in their entireties as to appearance, [sound], connotation, and commercial impression.” *N.Y. Yankees P’ship*, 114 USPQ2d at 1506 (citing *Rsch. in Motion Ltd. v. Defining Presence Mktg. Grp., Inc.*, 102 USPQ2d 1187, 1198 (TTAB 2012)). We must then determine whether Respondent’s mark is sufficiently similar to Petitioner’s as to “trigger consumers to conjure up” Petitioner’s mark. *Nike*, 100 USPQ2d at 1030 (quoting *Nat’l Pork Bd.*, 96 USPQ2d at 1497). “In the dilution context ‘the similarity between the famous mark and the allegedly blurring mark need not be substantial in order for the dilution by blurring claim to succeed.’” *TiVo Brands*, 129 USPQ2d at 1115 (quoting *Nike*, 100 USPQ2d at 1029).

Respondent’s mark **viition** is similar in appearance to the VUITTON portion of Petitioner’s LOUIS VUITTON mark. Each contains seven letters, begins with V has IT in middle and ends with ON with V I T O and N in the same order in one short word. Overall, **viition** has a similar visual commercial impression to the VUITTON portion of Petitioner’s mark.

Respondent argues that its mark does not share the first and dominant portion of Petitioner’s mark LOUIS and consumers are generally more inclined to focus on the first word of a mark. In addition, Respondent argues that the different spelling and stylization in its mark distinguish the marks. In particular, Respondent argues the marks are different in sound due to the suffix TION in its mark, and they are different

in meaning and commercial impression because LOUIS VUITTON is a full personal name but VIITION would not be perceived as a personal name.

There is no “correct” pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. *See, e.g., In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012) (upholding the Board’s affirmance of a Section 2(d) refusal to register XCEED for agricultural seed based on a likelihood of confusion with the registered mark X-SEED and design, SEED disclaimed, for identical goods); *Centraz Indus. Inc. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006) (acknowledging that “there is no correct pronunciation of a trademark” and finding ISHINE (stylized) and ICE SHINE, both for floor finishing preparations, confusingly similar). Thus, it is not clear how consumers may pronounce Respondent’s mark.

The LOUIS portion of Petitioner’s mark is not sufficient to distinguish them given VUITTON is the surname of Petitioner’s founder and namesake, and consumers are accustomed to seeing names shortened for fashion and lifestyle brands. It has been recognized that consumers have a propensity to shorten marks. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1188 (TTAB 2018); *see also In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (finding ML likely to be perceived as a shortened version of ML MARK LEES when used on the same or closely related skin care products); *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 has previously recognized the practice in the fashion industry of referring to surnames alone”); *In re Bay State*

Brewing Co., 117 USPQ2d 1958, 1961 (TTAB 2016) (recognizing “the penchant of consumers to shorten marks) (citing *In re Abcor Dev. Co.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring: “the users of language have a universal habit of shortening full names — from haste or laziness or just economy of words.”)). *In re SL&E Training Stable, Inc.*, 88 USPQ2d 1216, 1219 (TTAB 2008) (“consumers or members of the trade viewing the registrant’s mark EDELMAN may see it as an abbreviated form of applicant’s mark SAM EDELMAN”); *Big M Inc. v. U.S. Shoe Co.*, 228 USPQ 614, 616 (TTAB 1985) (“[W]e cannot ignore the propensity of consumers to often shorten trademarks ...”); *Nina Ricci S.A.R.L. v. Haymaker Sports, Inc.*, 134 USPQ 26, 28 (TTAB 1962) (“[I]t is common knowledge that various couturiers such as Christian Dior, Huber de Givenchi, and Jacques Fath are frequently referred to by their surnames alone”).

We also keep in mind Petitioner’s testimony that consumers tend to shorten trademarks such as these, as well as the caselaw which is consistent with that testimony. As Mr. Maltbie testified:³³

It is a popular practice in the luxury fashion industry for well-known brands to introduce secondary product lines that are branded with a mark that includes the primary brand name ... [g]iven this common practice by fashion brands, as well as the fact that consumers already know and refer to LOUIS VUITTON as VUITTON, consumers are likely to believe that products bearing Registrant’s VIITION mark are part of a secondary VUITTON brand line.

³³ Maltbie Decl. ¶¶ 30-31, 17 TTABVUE 13.

Here, some consumers would be likely to abbreviate Petitioner's mark as VUITTON, in the same manner Petitioner does on its products shown above. Thus, while we do not ignore the "LOUIS" component of Petitioner's mark, for the forgoing reasons, we find that VUITTON is the dominant term in Petitioner's mark.

Ultimately, due to the similarity in commercial impression of VUITTON and **viition**, the addition of the first name LOUIS does not serve to distinguish the marks. The stylization of the II with the single filled circle draws attention to that portion of Respondent's mark and away from the "-tion" suffix, and appears similar to the UI in Petitioner's mark. Consumers who did not notice the spelling variations would view **viition** as the shortened form of LOUIS VUITTON. *In re C. H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (C.H. HANSON confusingly similar to HANSON); *see also In re Chatham Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (JOSE GASPAR GOLD confusingly similar to GASPAR'S ALE); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1446-47 (TTAB 2014) (BRUCE WINSTON confusingly similar to WINSTON).

We find the comparison of the marks here similar to the comparison of the marks RALPH LAUREN and LA LOREN in *Polo Fashions, Inc. v. La Loren, Inc.*, 224 USPQ 509, 512 (TTAB 1984), a case under Section 2(d) of the Act:

In our view, these marks, when viewed in their entirety, readily engender the same commercial impression. As is often stated, similarity of connotation or commercial impression alone is sufficient to support a finding of likelihood of confusion between marks and this is true even if the marks exhibit aural or visual dissimilarity when they convey the same general idea or stimulate the same mental

reaction. See: *United Rum Merchants Limited v. Fregal, Incorporated*, 216 USPQ 217 (TTAB 1982) and cases cited therein. We think the “LAUREN” and “LOREN” portions of the respective marks, while spelled differently, may be pronounced the same way and, more importantly, when said marks are exposed to customers having imperfect recall of trademarks, would be likely to confuse said customers as to the origin of the respective goods. While opposers’ mark includes the name “RALPH LAUREN” and while opposers appear to make an effort to use the “RALPH LAUREN” name as a part of all their trademarks in order to capitalize on the status and celebrity of Ralph Lauren, customers are likely to think that “LA LOREN” bath sponges are yet another product having some connection with Ralph Lauren and/or the “LAUREN RALPH LAUREN” collection of personal products. This conclusion is buttressed by the fact that “LAUREN,” per se, is used in advertising material as a shorthand reference for the LAUREN RALPH LAUREN line of personal products and by the extensive articles referring to “LAUREN” in the trade as a shorthand term for Ralph Lauren and Ralph Lauren products.

We find that the marks are similar in their entirety, and that Respondent’s mark will “trigger consumers to conjure up” Petitioner’s famous mark. This weighs in favor of finding dilution by blurring.

2. Petitioner’s Mark is Highly Distinctive

Petitioner’s mark is registered on the Principal Register without a disclaimer or resort to a showing of acquired distinctiveness under Section 2(f) of the Act, and is among the most recognized marks in the United States. Indeed, a substantial portion of the United States population are exposed to Petitioner’s mark through its broad advertising and marketing. In any event, “[e]ven if the mark is not viewed as inherently distinctive, we found above that the mark is famous, which necessarily subsumes a finding that the mark has high acquired distinctiveness.” *N.Y. Yankees*

P'ship, 114 USPQ2d at 1507. *See also Chanel*, 110 USPQ2d at 2025. This factor also weighs in favor of finding dilution by blurring.

3. Petitioner's Use of LOUIS VUITTON is Substantially Exclusive

As discussed above, Petitioner engages in a robust policing program. This type of evidence has been found to establish "substantially exclusive use," *Chanel*, 110 USPQ2d at 2025-26, and there is no evidence of any third-party use of marks that would reduce the degree of Petitioner's exclusivity. *See also UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1899 (TTAB 2011); *Nike*, 100 USPQ2d at 1028.

This factor therefore also weighs in favor of finding dilution by blurring.

4. Petitioner's LOUIS VUITTON Mark is Widely Recognized in the United States

As explained above, Petitioner's mark is extremely famous and is widely recognized. This factor weighs heavily in favor of finding dilution by blurring.

5. Respondent's Intent to Create an Association with Petitioner's LOUIS VUITTON Mark

There is no evidence that suggests that Respondent intended to create an association with Petitioner's mark. In view thereof, this dilution factor is neutral.

6. Actual Association Between **vition** and LOUIS VUITTON

There is no evidence of actual public association between Respondent's and Petitioner's marks. Given the lack of (or minimal) concurrent use in the United States market this is not surprising.³⁴

³⁴ We have found that where an application challenged on the ground of dilution is based on an intent to use, and the applicant "has not engaged in any actual use of the junior mark, it is impossible to present any evidence of actual association between the marks in the

In the absence of direct evidence of association, we find this factor neutral.³⁵

VI. Conclusion: Use of Respondent's Marks is Likely to Impair the Distinctiveness of Petitioner's Exceedingly Famous and Highly Distinctive LOUIS VUITTON

Petitioner's LOUIS VUITTON mark is exceedingly famous and highly distinctive. In addition, the goods sold under the mark are widely used and recognized by a large percentage of the United States population. This is all prior to Respondent's use of and filing date for its mark. Further, the marks are sufficiently similar in overall commercial impression and such association is likely to impair the distinctiveness of Petitioner's LOUIS VUITTON mark. Respondent's mark will cause consumers to "conjure up" Petitioner's famous mark, and "associate the two." *N.Y. Yankees P'ship*, 114 USPQ2d at 1507. As we held in the *Nike* case with respect to JUST JESU IT, "[u]pon encountering applicants' mark, consumers will be immediately reminded of opposer's JUST DO IT mark and associate applicants' mark with opposer's mark." *Nike*, 100 USPQ2d at 1030.

The fact that there is no evidence of actual association between the marks and that the record does not show that Respondent intended such an association do not outweigh the other dilution factors. Inasmuch as the dilution doctrine was designed

marketplace," but that does not preclude a finding of dilution when the balance of dilution factors weighs in favor of such a finding. *Nat'l Pork Bd.*, 96 USPQ2d at 1498. Indeed, we have found dilution in several cases despite there being no evidence of actual association, when the balance of the dilution by blurring factors in 15 U.S.C. § 1125(c)(2)(B)(i-vi) weighed in favor of finding dilution. *See, e.g., TiVo Brands*, 129 USPQ2d at 1117-18 ("the fact that there is no evidence of actual association between the marks and none was intended by Applicant do not outweigh the other dilution factors"); *N.Y. Yankees P'ship*, 114 USPQ2d at 1509-10, 1512; *Nike*, 100 USPQ2d at 1030-32.

³⁵ At the same time, we recognize that direct evidence of an actual association may be difficult to come by.

to provide a remedy where the goods or services involved are neither competitive nor necessarily related, *Nike*, 100 USPQ2d at 1031, any possible distinction between the parties' goods and services does not obviate Petitioner's dilution claim.

Viewing the evidence as a whole, we conclude that Respondent's **vition** mark is likely to dilute the distinctive quality of Petitioner's famous LOUIS VUITTON mark.

DECISION: The petition to cancel is granted on Petitioner's dilution by blurring claim.³⁶

³⁶ We need not reach Petitioner's likelihood of confusion claim. *N.Y. Yankees P'ship*, 114 USPQ2d at 1512.