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OF THE T.T.A.B.**

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Hearing:
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Paper No. 81
JQ

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Sara Lee Corporation
v.
Goldstone Hosiery Company

—
Cancellation No. 22,732
—

J. David Mayberry and William M. Bryner of Kilpatrick
Stockton for Sara Lee Corporation.

Barry A. Cooper and Donna L. Mirman of Gottlieb, Rackman &
Reisman for Goldstone Hosiery Company.

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Before Hanak, Quinn and Bucher, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Sara Lee Corporation has petitioned to cancel a
registration owned by Goldstone Hosiery Company of the mark
GOLDEN LEGS for "hosiery for men, women and children."¹ As
grounds for cancellation under Section 2(d) of the Trademark
Act, petitioner alleges that respondent's mark, when applied
to respondent's goods, so resembles petitioner's previously
used and registered famous mark L'EGGS, and the L'EGGS

¹ Registration No. 1,767,054, issued April 20, 1993 on the
Supplemental Register; Section 8 affidavit filed and accepted.

family of marks, all for hosiery, as to be likely to cause confusion.

Respondent, in its amended answer, denied the salient allegations of the petition for cancellation.

The voluminous record consists of the pleadings; the file of the involved registration; trial testimony, with related exhibits, taken by each party (including two surveys undertaken by petitioner); certified copies of petitioner's registrations, discovery depositions and related exhibits, responses to interrogatories and certain requests for admissions, official records, and excerpts from printed publications, all made of record by way of petitioner's notices of reliance; and a dictionary listing for the term "leg," copies of third-party registrations, and other official records introduced by respondent in its notices of reliance.² The parties filed briefs, and both were represented by counsel at an oral hearing held before the Board.³

² The record includes a non-executed protective agreement to cover confidential materials. The agreement was submitted with a request from petitioner for entry of the agreement, which the Board granted as conceded in an order dated December 27, 1999. The Board presumes that the parties have since executed the agreement to provide for the handling of such materials.

³ Petitioner filed, shortly before the oral hearing, a motion "to submit controlling precedent decided after the close of the briefing period." The motion is superfluous inasmuch as the Board on its own can consider recent case law. Moreover, the Board is obviously aware of these two opinions involving appeals of Board decisions to the Federal Circuit, the Board's primary reviewing court. The court's opinions have been considered in reaching our determination in the present case.

The Parties

Petitioner began to develop in 1969 a line of pantyhose in an effort to fill what petitioner identified as a void in the hosiery market. According to Anne Jardine, petitioner's vice president, consumer marketing, petitioner perceived that an untapped market existed for the sale of women's hosiery through food stores and drug stores, mostly because, in petitioner's view, the quality of hosiery offered in those trade channels was horribly inconsistent. Petitioner determined that women would buy hosiery in supermarkets and drug stores if there existed a recognized, reliable brand of quality hosiery. Petitioner's product was test marketed, and then was rolled out nationally in October 1970.

Ms. Jardine testified that petitioner coined the mark L'EGGS for the product. According to Ms. Jardine, the mark "combined the simple egg (which played off the shape of the package in which the product was offered), a women's leg, and an apostrophe, which gave it a French flair." Over the years, petitioner has used a variety of marks (including slogans), with each one, almost without exception, featuring L'EGGS as a portion of the mark. The original L'EGGS mark first appeared, and is still being used, in the following stylized fashion as shown below.

Petitioner owns the following valid and subsisting registrations issued on the Principal Register: L'EGGS, L'EGGS (stylized), SUMMER L'EGGS, WINTER L'EGGS (stylized), OUR L'EGGS FIT YOUR LEGS, NOTHING BEATS A GREAT PAIR OF L'EGGS, LITTLE L'EGGS ("LITTLE" disclaimed), L'EGGS CLASSICS ("CLASSICS" disclaimed), GREAT LEGS (stylized), LITTLE L'EGGS (stylized) ("LITTLE" disclaimed), NOTHING BEATS A GREAT PAIR OF L'EGGS (stylized), L'EGGSWEAR (stylized) and THE FIT OF L'EGGS IN A WHOLE NEW FASHION.⁴ The various registrations cover, for the most part, hosiery and pantyhose. Some registrations cover leotards, tights, warm-up suits, shorts, leggings, knee-highs, socks, footwear and slippers. Petitioner also has used slogans such as "She's Got L'EGGS" and "It Pays To Show Off Your L'EGGS."

Petitioner's products are sold in food, drug and mass merchandising stores, and through petitioner's own catalogs. Over the years, sales of goods bearing the L'EGGS marks total \$10 billion. In 1998, petitioner's sales accounted for nearly 54% of all women's sheer hosiery sales in the United States. Petitioner's L'EGGS mark enjoys a 98% brand awareness among female hosiery consumers. The goods are

⁴ A check of Office records shows that the registrations of the marks SHE'S GOT LEGS, L'EGGS CLASSICS COLOR EDITIONS (stylized) ("CLASSICS COLOR EDITIONS" disclaimed) and NOTHINGS MORE FITTING THAN L'EGGS CLASSICS have been canceled pursuant to Section 8 of the Act. We take judicial notice of this updated information. *Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 146-47 (TTAB 1979).

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extensively advertised on television and in the print media. Female celebrities have been featured in some of petitioner's television commercials, and petitioner's L'EGGS brand products have been promoted in conjunction with petitioner's sponsorship of sport competitions, such as the Olympics, and of concert tours. Promotional expenditures over the years are in excess of \$1.8 billion. Petitioner also has been the beneficiary of unsolicited publicity in various printed publications.

Respondent was founded in the late 1970's by Zoltan Goldstein who came to the United States from eastern Europe after surviving the Holocaust. Respondent continues to be run as a family-operated private company. In 1984, respondent adopted the mark GOLDEN LEGS to identify its hosiery line. In addition to this line, respondent services private label accounts under marks other than GOLDEN LEGS. Respondent's hosiery is sold to discount stores, including "mom-and-pop" and dollar stores. Sales in 1998 exceeded \$9 million. Respondent's advertising efforts have been aimed at the retail trade, and advertisements have appeared in various trade publications, including *Women's Wear Daily*.

Respondent owned a prior registration of the mark GOLDEN LEGS for hosiery (Registration No. 1,371,966 issued on the Supplemental Register on November 19, 1985), but the

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registration was canceled due to respondent's inadvertent failure to file a Section 8 affidavit.

Priority of Use

The first issue for us to consider is priority of use. Respondent does not dispute petitioner's priority of use, and indeed the record establishes petitioner's use of its mark L'EGGS long prior to respondent's first use of its registered mark.

Likelihood of Confusion

We now turn to the merits of petitioner's likelihood of confusion claim. Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These, and other du Pont factors deemed pertinent in the proceeding now before us, are discussed below.

Similarity of the Goods

We turn first to compare the goods of the parties. With respect to this factor, for purposes of our likelihood

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of confusion analysis, the goods are, at least in part, legally identical. The record establishes use of petitioner's L'EGGS marks in connection with ladies' hosiery, and many of petitioner's registrations list "ladies' hosiery" in the identification of goods. Otherwise, petitioner's products such as pantyhose, tights, leggings and socks are substantially similar to respondent's "hosiery for men, women and children." See: Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

In attempting to distinguish the parties' products, respondent points out that about 15-20% of respondent's overall sales comprise men's socks, and 12% of total sales comprise girls' tights. Respondent further contends that "there is no competition between Registrant's and Petitioner's goods because Registrant's products are of a higher quality than are Petitioner's".⁵ (brief, p. 18) Simply put, these distinctions are of little moment in making our determination. See: Tom Cunningham v. Laser Golf Corp., 55 USPQ2d 1842 (Fed. Cir. 2000) [identifications in the involved registrations frame the likelihood of confusion issue].

⁵ Respondent also attempts to distinguish the products based on price. The record reveals, however, that the products are comparable in price range, between around \$1-\$5.

Trade Channels

Insofar as trade channels are concerned, respondent contends that "[t]he dissimilarities between the retail outlets for the predominant consumers of Petitioner's and Registrant's are substantial" and that "Registrant targets its goods to very different customers than does Petitioner." (brief, p. 19) Specifically, respondent points to the fact that its hosiery is sold in small discount stores while petitioner's hosiery is sold in food, drug and mass merchandising stores. Respondent also points to the different ways the products are advertised, with respondent's efforts being directed solely to the retail hosiery trade whereas petitioner's advertising is directed to the end consumer.

As petitioner is quick to point out, the perceived differences in trade channels are largely irrelevant. Nothing in the involved registration limits the trade channels in which respondent's hosiery is sold, and we must assume that the hosiery moves through all normal and usual channels of trade and methods of distribution. *Squirtco v. Tomy Corporation*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983). Those would include the very same trade channels in which petitioner's identical goods move. The record also includes some testimony that respondent has begun to offer its hosiery to retail chains, although no

goods have actually been sold to them as yet.⁶ The fact that the parties have advertised their products in different publications is irrelevant to our analysis.

Conditions of Sale

Respondent contends that hosiery is not an impulse purchase item, but rather "hosiery is a very personal item of clothing, so special care has to be taken when faced with considerations of fit, color, sheerness..." (brief, p. 33) In this connection, respondent points to the testimony of Adrienne Weinbaum, a salesperson employed by respondent, that women spend between five and twenty minutes in selecting hosiery. Petitioner's witness, Ms. Jardine, testified, on the other hand, that consumers spend "next to no time at all," literally "nanoseconds," in buying hosiery.

The parties' hosiery sells for between \$1 and \$5. Given the relatively low price point of these goods, we do not think that considerations such as size, color or texture appreciably add to the time spent in making a purchasing decision. After reviewing the record, our sense is that the purchase of everyday hosiery tends to be more of an impulse purchase or, at most, an item purchased without a great deal of care by ordinary consumers. Such consumers are not

⁶ Exhibit No. 11 to Zoltan Goldstein's (respondent's founder and president) testimony deposition is an advertisement placed in a trade publication by respondent wherein respondent states that it is "now ready to accommodate mass merchants, chain stores, licensing and private label accounts."

likely to devote a great deal of thought or analysis to the marks in order to determine whether respondent's mark indicates a different source from petitioner. Rather, given the fame of petitioner's L'EGGS mark, such consumers are likely to assume that GOLDEN LEGS is a trademark of petitioner's, being a variation on their L'EGGS marks.

In sum, on this du Pont factor, given the relatively inexpensive nature of hosiery, and the fact that hosiery is subject to frequent replacement, ordinary consumers are not likely to exercise any great care in purchasing these goods. See: Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984). This factor weighs in favor of finding a likelihood of confusion.

Family of Marks

With respect to petitioner's claim that it owns a family of L'EGGS marks, we look to our primary reviewing court for guidance:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. Recognition of the

family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family.

J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). In the past, the Board has looked at whether the marks asserted to comprise a "family" have been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and, thereafter, recognition of common ownership based upon a feature common to each mark. American Standard, Inc. v. Scott & Fetzer Co., 200 USPQ 457, 461 (TTAB 1978).

We do not view petitioner's evidence as establishing that it has a family of L'EGGS marks. While the record includes a few instances where the L'EGGS mark is used together with another one of petitioner's marks (including slogans such as "NOTHING BEATS A GREAT PAIR OF L'EGGS"), the record does not establish that such conjoint use is petitioner's common practice. In point of fact, the documents highlighted by petitioner (brief, p. 7) on this point show that while petitioner has engaged in conjoint promotion of different products in its line, the various products for the most part bore the L'EGGS mark as opposed to any of the other marks also claimed by petitioner. Moreover, the record is devoid of any *direct* evidence that purchasers consequently would recognize common ownership

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based on the feature common to each mark. The mere fact of adoption, use and/or registration of several marks incorporating L'EGGS, as in the case here with petitioner, does not in itself prove that a family of marks exists. Polaroid Corp. v. Richard Mfg. Co., 341 F.2d 150, 144 USPQ 419 (CCPA 1965); Trek Bicycle Corp. v. Fier, 56 USPQ2d 1527, (TTAB 2000); and Consolidated Foods Corp. v. Sherwood Medical Industries, Inc., 177 USPQ 279 (TTAB 1973).

Fame

It hardly need be said that fame of petitioner's L'EGGS mark is a critical du Pont factor in petitioner's favor in this case. Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992)["[F]ame of the prior mark plays a dominant role in cases featuring a famous or strong mark."]. Indeed, the record clearly establishes the widespread fame of petitioner's L'EGGS mark for women's hosiery and pantyhose.

Petitioner's L'EGGS mark has been the subject of extensive exposure in the marketplace as a result of petitioner's efforts. In addition, petitioner's L'EGGS mark and the products sold thereunder have been the subjects of a significant amount of unsolicited publicity in various printed publications. In 1998, petitioner's hosiery was sold in over 45,000 retail stores nationwide, and through petitioner's catalogs which have a distribution run of 50

million copies. Petitioner's claim that its mark is famous is supported by truly impressive revenue figures, significant promotional expenditures, and a high degree of brand awareness. More specifically, petitioner's sales spanning a thirty-year period exceed \$10 billion, with promotional expenditures of over \$1.8 billion. Further, as noted above, petitioner's sheer hosiery market share stands at 54%, and petitioner's L'EGGS mark enjoys tremendous brand awareness. About 98% of female hosiery consumers have heard of the L'EGGS brand, and 61% of those consumers will name L'EGGS as a brand of hosiery without prompting. In *Women's Wear Daily* (in the 1993, 1995 and 1997 editions of the "Fairchild Report," a bi-annual study of apparel brands published by *WWD*), the L'EGGS mark has been listed as the most recognized brand name in the apparel industry.

Taking into consideration the totality of the evidence introduced on this factor, we have every confidence in finding that the mark L'EGGS, as used in connection with women's hosiery and pantyhose, is famous. We are not alone in making this assessment. See: *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 38 USPQ2d 1449 (4th Cir. 1996), cert. denied, 519 U.S. 976, 117 S.Ct. 412, 136 L.Ed.2d 325 (1996)[*"L'eggs [has] become [a] household name...a strong, distinctive mark"*]. This finding of fame plays a significant role in our analysis. See: *Recot Inc. v.*

Becton, 54 USPQ2d 1894 (Fed. Cir. 2000), on remand, 56 USPQ2d 1859 (TTAB 2000); and Kenner Parker Toys Inc. v. Rose Art Industries Inc., supra at 1458[factors that both marks appear on inexpensive products purchased by diverse buyers without exercising much care accentuate the significance of a famous mark].

Third-Party Use

In considering the fame factor, we have taken into account, of course, respondent's evidence of third-party uses and registrations of marks containing the term "LEGS."

The record includes a dictionary definition of the term "leg:" the part of a garment that covers the leg: *the leg of a stocking; trouser leg.* *Random House Unabridged Dictionary* (2d ed. 1993).

Given this meaning, and the fact that the term also is defined in the same dictionary as "either of the two lower limbs of a...human being...that support and move the body," it comes as no surprise that there are a number of third-party uses and registrations of marks in the hosiery and wearing apparel fields wherein the term "LEG" or "LEGS" appears.

Turning first to the registration evidence, respondent has introduced over twenty third-party registrations. Such evidence, as often stated, is of little probative value in determining likelihood of confusion issues. These

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registrations do not establish that the marks shown therein are in use, much less that consumers are so familiar with them that they are able to distinguish among such marks by focusing on components other than the ones shared by the marks. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). Any value that these registrations have to the likelihood of confusion analysis is limited to their showing, as in the case of a dictionary listing, the sense in which the word "leg" or "legs" is employed in the language. In this case, the registrations show that the words "LEG" or "LEGS" have in the past appealed to others in the hosiery field as an appropriate portion of part of a mark. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973).

Respondent also has introduced testimony and evidence regarding actual use of "LEG" or "LEGS" as a part of marks by third parties in the hosiery field. The bulk of this evidence comes from the testimony of Ms. Weinbaum, a salesperson for respondent. At the instruction of Mr. Goldstein, Ms. Weinbaum visited various stores in the New York City metropolitan area to identify third-party uses in the trade. Ms. Weinbaum identified about a dozen uses, and purchased hosiery bearing six of the marks.

This evidence of third-party uses is balanced by petitioner's evidence of the considerable fame of its L'EGGS

mark for hosiery. We have no problem maintaining the view that petitioner's L'EGGS mark is famous, even in the face of respondent's evidence.

The probative value of the third-party uses also is diminished by the fact that respondent failed to furnish any evidence regarding the extent of use of the marks by these third parties. See: *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, supra at 463. In point of fact, some of the testimony (highlighted by petitioner in its reply brief at pp. 6-8) would suggest that the actual use of the various marks has been minimal.

In considering this factor, we have taken into account petitioner's testimony and evidence showing that petitioner has been fairly vigorous in policing its L'EGGS mark. That is not to say that petitioner's protection efforts have been perfect; nevertheless, petitioner has been vigilant over the years, resulting in a number of successful actions against allegedly confusingly similar marks.

In sum, respondent's evidence is of limited probative value to support its position.

Similarity of the Marks

We next turn our focus to the similarity between the marks. As noted above, the parties' goods are, in significant part, identical. In such situations, "the degree of similarity [between the marks] necessary to

support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In comparing the marks, we again note that petitioner's L'EGGS mark is famous as applied to women's hosiery.

In comparing the marks, the "LEGS" portion of respondent's mark is identical in sound to petitioner's mark L'EGGS. Also, although there are specific differences between the spellings of "L'EGGS" and "LEGS," the terms look alike such that the marks L'EGGS and GOLDEN LEGS are similar in overall appearance.

In addition, respondent's mark is constructed similarly to several of petitioner's marks which begin with a modifier and end with "L'EGGS," including SUMMER L'EGGS, WINTER L'EGGS and LITTLE L'EGGS.

A significant fact in our comparison of the marks concerns the way in which respondent at present actually uses its mark. Petitioner's marks are registered in both typed form and special form. The drawing of the mark in respondent's involved registration is in typed form. Such a typed drawing indicates that respondent is not restricting its word mark to a particular form. Trademark Rule 2.52(a)(1). In comparing the marks, "we must not be misled by considering [respondent's] mark only in its printed or type-written form, with all characters being of equal

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height." Philips Petroleum Co. v. C.J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). See also: Squirtco v. Tomy Corp., supra. In view of respondent's typed mark, we must consider all reasonable manners in which GOLDEN LEGS could be depicted, and in particular, the Board can and should in this case give special consideration to the manners in which respondent has actually depicted it mark. INB National Bank V. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992); and In re Richardson Ink Co., 171 USPQ 818 (TTAB 1971). In the present proceeding, we have the benefit of exhibits which illustrate how the respondent's mark is actually used in commerce.

After this cancellation proceeding was commenced, respondent commissioned a redesign of its packaging. Respondent's redesign significantly enhanced the prominence of the word "LEGS" as its mark appeared on the packaging. In addition, this redesign began to appear in respondent's advertisements in trade magazines. The mark, as actually used on packaging and in advertisements, is reproduced below (ex. no. 1, J. Velez dep.):

The prominence of the "LEGS" portion of respondent's mark as actually used and as actually encountered by

prospective purchasers is clear. This certainly would increase the likelihood that purchasers would see a similarity between the parties' marks and, therefore, would mistakenly believe that respondent's hosiery originated from the same source as the hosiery sold under petitioner's L'EGGS mark. See: *Jockey International Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1235-36 (TTAB 1992). See also: *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, supra at 1284[trade dress may provide evidence of whether a word mark projects a confusingly similar commercial impression].

In sum, we find, when the parties' marks are considered in their entireties, that the mark L'EGGS and a number of petitioner's other marks are similar in overall commercial impression to respondent's mark GOLDEN LEGS.

Survey Evidence

Petitioner introduced the results of two shopping mall intercept surveys, with the supporting testimony of Dr. Thomas Dupont, a survey expert, who designed the surveys and analyzed the results. Petitioner conducted the original survey which was then criticized by respondent's survey expert. Petitioner subsequently conducted a replication survey which, according to petitioner, tested the criticisms.

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In the original survey, a total of 422 respondents were interviewed at six shopping malls (Washington, DC, Los Angeles, Dallas/Fort Worth, Cleveland, Philadelphia and Nashville). The survey was taken of women, aged eighteen years and older, who had bought or worn hosiery in the six months prior to the survey. The interviewer handed 212 qualified respondents a white card as shown below.

After viewing the card, each respondent was asked the following question: "What company do you think puts out that brand of hosiery?" Respondents who answered something other than "don't know" to the first question were then asked: "Why do you say that?"

A second control group of 210 respondents saw a different control name (Golden Step, Golden Spirit, Golden Sheers, Golden Fit, Golden Touch or Golden Kicks), and then were asked the same two questions. As explained by Dr. Dupont, the purpose of this control group was to control the survey for "noise," that is, the tendency of consumers in this particular situation to attribute manufacture to L'EGGS because it is a familiar brand.

After accounting for the "noise," the survey shows that around 21% of the respondents indicated that GOLDEN LEGS

hosiery is put out by the same entity that makes L'EGGS hosiery. Almost an identical percentage stated that it was the mark L'EGGS that caused them to believe that GOLDEN LEGS was put out by the same source as L'EGGS hosiery. Dr. Dupont's conclusion is that "[t]hese converging estimates give us a high degree of confidence that at least 21% of consumers will mistakenly believe that GOLDEN LEGS is put out by L'eggs." (Dupont dep., ex. no. 2, p. 3)

Respondent countered with the testimony of Dr. Alexander Simonson, a university professor of marketing and a survey researcher with ten years of experience in designing and conducting surveys for litigation. Dr. Simonson essentially criticized the methodology used in conducting the survey. More specifically, he stated that the survey's instructions encouraged guessing; that the card bearing respondent's mark which was shown to the respondents omitted the category of men's hosiery products; that the universe is flawed in that men and teens under 18 years of age were excluded; that the survey does not reflect a random geographic sampling, but rather one that is oversampled in the southern part of the country; that the names used in the control groups resulted in skewed results; and that the survey did not track actual market conditions since the respondents were not exposed to the parties' respective packaging and trade dress. Respondent also criticized

petitioner's replication survey because it did not employ a control group.

In response to two of these criticisms, namely the encouragement of guessing and the perceived misidentification of the product category on the sample card, petitioner, under the guidance of Dr. Dupont, undertook a replication survey. Accordingly, the stimulus card shown to respondents indicated that the GOLDEN LEGS product is "hosiery for men, women and children" (as opposed to the earlier version "hosiery for women and children"). The instructions were modified in relevant part to read "For any of my questions please give me an opinion if you have one, but if you don't know or have no opinion, that's OK" (as opposed to the earlier instruction "Please give me your opinion, even if you are not absolutely sure"). With the exception of the stimulus card and the guessing instructions, the survey methodology and procedures were identical in both surveys. No control group was used in the second survey.

The replication survey, taken of 122 respondents, shows results which are very similar to the results of the original survey. Dr. Dupont concluded that the replication survey results "clearly demonstrate that the two 'flaws' which Prof. Simonson found to be most serious ('misidentification of the product category' and

'encouragement of guessing') had absolutely no impact on the survey results." (Dupont dep., ex. no. 2).

We note, at the outset, that "[i]t is notoriously easy for one survey expert to appear to tear apart the methodology of a survey taken by another." Carl Karcher Enterprises v. Stars Restaurants Corp., 35 USPQ2d 1125, 1133 (TTAB 1995) citing J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition* §32:178. Courts and the Board long have recognized that there is no such thing as a perfect survey and, like any survey, the one presently before us involves a bit of a guessing game by the survey's respondents.

Petitioner's surveys employ a fairly standard format used in likelihood of confusion cases, the so-called *Eveready* format. Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366, 188 USPQ 623 (7th Cir. 1976), cert. denied, 429 U.S. 830, 50 L.Ed.2d 94, 97 S.Ct. 91, 191 USPQ 416 (1976). This survey format has been approved by a number of courts. See also: Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc., 1 USPQ 1445 (TTAB 1986). See generally: J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §32:174 (4th ed. 2000). We find that the surveys here support petitioner's position on the issue of likelihood of confusion.

The replication survey certainly disposed of two of the significant criticisms made by respondent's expert. The

replication survey results were remarkably similar to the ones of the original survey. Further, we see no major problem with the universe selected by Dr. Dupont inasmuch as it included consumers most likely to purchase the parties' products, that is, women who are eighteen years of age or older. We also find no fault with the choice of survey cities. See: Carl Karcher Enterprises Inc. v. Stars Restaurant Corp., supra at 1132-33. Likewise, the controls in the original survey appear to be proper, and the lack of controls in the replication survey are of little moment.

In sum, we find Dr. Simonson's criticisms to be largely without substantial merit, and that the surveys' results buttress our finding of likelihood of confusion. So as to be clear on this point, even if we were to throw out the surveys and accord them no probative value whatsoever, we would reach the same result on the ultimate question herein in view of the weight of the du Pont factors in petitioner's favor.

Actual Confusion

The next factor to consider is actual confusion. Petitioner has introduced testimony and evidence regarding one instance of what it characterizes as actual confusion. The alleged confusion, on the part of a retail store salesperson, Jaslyn Velez, was the result of a question posed to her at the store. The question regarding a common

source of the parties' respective products was posed by an individual (Ms. Walsh) on petitioner's behalf. Thus, we view this instance as somewhat contrived. Ms. Velez went on to testify that, prior to the question posed by Ms. Walsh, she never made an association between the sources of the two parties' products. In any event, given the years of overlapping use of the parties' goods, we find this lone instance, even if viewed as credible, to be *de minimis*.

On the flip side, the absence of evidence of actual confusion does not trouble us in the least. Given the relatively inexpensive nature of the parties' hosiery, consumers would be unlikely to go to the trouble to report any confusion. Further, it was not until only recently in 1997 that respondent began to emphasize the "LEGS" portion of its mark which, in our view, enhances the likelihood of confusion.

Intent

Given the prominence of petitioner and its L'EGGS marks in the marketplace, and Mr. Goldstein's involvement in the hosiery business for many years, we are rather surprised by Mr. Goldstein's testimony that he was unaware of petitioner and its L'EGGS mark until the petition was filed. Having said this, we also note testimony regarding Mr. Goldstein's lack of formal education outside of Torah studies at Yeshiva, and that due to his strict religious observations,

he spends little time on reading English publications or watching television. We further note Mr. Goldstein's explanation regarding the talmudic genesis of respondent's mark. Lastly, we note that before adopting its mark, respondent did not conduct a trademark clearance search.

Notwithstanding Mr. Goldstein's lack of exposure to the secular world, it still is surprising that Mr. Goldstein did not encounter, at least in a business context, the famous L'EGGS mark of petitioner, a direct competitor. Be that as it may, our more serious concern involves respondent's changes to its mark *after* it became aware of petitioner and its marks. As discussed above, after the petition for cancellation was filed, respondent redesigned its packaging so as to emphasize the "LEGS" portion of its mark. While we note respondent's fairly extensive testimony regarding the innocence of the changes to the packaging, such conduct, at a minimum, calls into question respondent's post-adoption intentions.

In any event, there is "no excuse for even approaching the well-known trademark of a competitor...and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous..." *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989). See also: *Giant Food*,

Inc. v. Nation's foodservice, Inc., 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

Conclusion

Given the voluminous record in this case and the lengthy briefs, the Board is compelled to make an additional point. Both parties' briefs have made and debated, and we have considered, arguments other than those specifically mentioned in this opinion. We find it unnecessary, however, to comment on each and every one.

We agree with petitioner that after commencement of these proceedings, respondent's business practices have appeared to edge closer to the L'EGGS brand. The redesign of respondent's mark, followed by respondent's first substantial advertising efforts, and then respondent's attempt to sell its hosiery in the same retail outlets in which petitioner's hosiery is sold, all add up to the "collision course" referred to by petitioner.

Based on the record before us, we conclude that consumers familiar with petitioner's ladies' hosiery and pantyhose sold under petitioner's L'EGGS marks would be likely to believe, upon encountering respondent's mark GOLDEN LEGS for hosiery for men, women and children, that the goods originated with or are somehow associated with or sponsored by the same entity.

Cancellation No. 22,732

Decision: The opposition is sustained, and registration to applicant is refused.