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Paper No. 11  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **L.C. Licensing, Inc.**

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Serial No. 75/**914,519**

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**David B. Kirschtein** of **Kirschtein, Ottinger, Israel & Schiffmiller, P.C.** for **L.C. Licensing, Inc.**

**Tami Cohen Belouin**, Trademark Examining Attorney, Law Office 108 (**David Shallant**, Managing Attorney).

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Before **Hohein, Walters** and **Rogers**,  
Administrative Trademark Judges.

Opinion by **Rogers**, Administrative Trademark Judge:

L.C. Licensing, Inc. has filed an application to register the mark ELISABETH for goods identified, following amendment, as "sleepwear, namely nightgowns, pajamas, sleepshirts, bedjackets and robes designed for women requiring larger sizes."<sup>1</sup> The Examining Attorney refused registration of applicant's mark under Section 2(d) of the

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<sup>1</sup> Serial No. 75/914,519, filed February 10, 2000, asserting applicant's bona fide intention to use the mark in commerce.

Lanham Act, 15 U.S.C. §1052(d), because of the prior registration of ELIZABETH for "women's hosiery."<sup>2</sup>

When the Examining Attorney made the refusal of registration final, applicant appealed. Both applicant and the Examining Attorney have filed briefs, but an oral argument was not requested.

It is the Examining Attorney's position that registration must be refused under Section 2(d) because there is a likelihood that consumers of the respective goods would be confused or mistaken as to their source or sponsorship, if marketed contemporaneously under the respective marks. Applicant contends there is no likelihood of confusion or mistake.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, key considerations are the virtually identical nature of the marks, the related nature of the goods, and the presumptively similar classes of consumers for these goods.

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<sup>2</sup> Registration No. 2,001,669 issued September 17, 1996, and lists dates of first use and first use in commerce of July 1, 1983.

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*Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Considering the marks, we note that applicant does not argue that the marks are different in sound or connotation and concedes in its brief that "[t]he use of an 's' instead of a 'z' in applicant's mark has never been urged as a difference." Further, we must remain mindful that the average purchaser of the involved goods normally would retain a general, rather than a specific, impression of the marks and that there is a certain fallibility of memory. *See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992). Thus, the virtually identical nature of the marks is a factor that militates strongly in favor of a finding that confusion is likely.

Turning to the goods, we note that our analysis of the similarity or relatedness of the goods, their channels of trade and their classes of consumers must be based on the identifications in the involved application and registration. *See Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990), and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1

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USPQ2d 1813, 1815-16 (Fed. Cir. 1987). Moreover, in the absence of restrictions, we must presume that the identified goods move in all normal channels of trade and to all usual classes of consumers therefor. See *CBS Inc. v. Morrow*, 218 USPQ 198, 199 (Fed. Cir. 1983).

Applicant has restricted its items of women's sleepwear to those "designed for women requiring larger sizes," and argues that this is significant; but the cited registration is for women's hosiery without restriction, which is more significant. We must consider the hosiery in the cited registration to encompass hosiery for women requiring larger sizes. Thus, the goods must be presumed, based on the identifications, to be marketed to at least some of the same consumers, i.e. women requiring larger sizes.

Applicant also argues that the involved goods are not complementary, since a "women [sic] might well wear a jacket and hosiery, but it is hardly likely that she would wear hosiery with sleepwear." It is well settled, however, that goods marketed under virtually identical marks need not be competitive or complementary for a likelihood of confusion to exist. They only need to be of the type that consumers may conclude there is a relationship, as for example, origination in the same source, or common

sponsorship. See *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983) ("If the marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion.").

The Examining Attorney has made of record voluminous evidence that women's hosiery and sleepwear can emanate from the same source under the same mark. See *In re Albert Trostel & Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993) (Third-party registrations listing goods of an applicant and a registrant whose registration has been cited against the applicant's application are probative evidence that such goods may emanate from a single source under the same mark.). In fact, the Examining Attorney contends that applicant itself uses the same mark, albeit not the mark in the involved application, for sleepwear and hosiery.<sup>3</sup> The relevance of this evidence is not, as applicant apparently believes, related to the question whether applicant will eventually expand its use of its involved mark to cover women's hosiery, but whether sleepwear and hosiery are the types of goods which consumers will believe emanate from a single source or sponsor when marketed under the same mark.

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<sup>3</sup> Applicant concedes that it has registered the mark FIRST ISSUE for apparel items including hosiery.

We find the goods related and targeted to at least some of the same consumers. Also, since there are no restrictions as to channels of trade, we must presume that marketing of the goods to these common consumers may be through the same channels of trade.

In sum, when we consider the two *du Pont* factors that are usually the most important, i.e., the similarity or dissimilarity in the marks and the relatedness or lack thereof of involved goods or services, our conclusion is that a likelihood of confusion exists. These two factors, however, are not the only factors to be considered in this case.

Without explicitly saying so, applicant essentially contends that several other *du Pont* factors come into play in this case. Specifically, it appears applicant is relying on "the length of time during and the conditions under which there has been concurrent use without evidence of actual confusion," "the market interface between applicant and the owner of a prior mark," and "any other established fact probative of the effect of use." *du Pont, supra*, 177 USPQ at 567.

Applicant asserts that it "has been using the mark ELISABETH alone or in combination [with "A LIZ CLAIBORNE COMPANY" or "LIZ CLAIBORNE INC" or "BY LIZ CLAIBORNE"] for

various items of wearing apparel for women's [sic] requiring larger sizes since 1988." Further, applicant asserts that because its goods do not include hosiery, "no conflicts whatsoever have been experienced in the marketplace." Applicant does not, however, explicitly state that it is not aware of any instances of actual confusion.

We cannot assume that applicant's report of "no conflicts" should be taken to mean there are no known instances of actual confusion. It may mean simply that applicant perceives the goods of the parties as unrelated and, therefore, it has not experienced any competitive conflicts with registrant. Moreover, even if we were to accept applicant's representation as meaning that applicant has not experienced instances of actual confusion, we find the contention of limited probative value, as we have little information about the extent of use of the respective marks and, therefore, the extent of opportunities for confusion to arise. *Cf. Cooper Industries, Inc. v. Repcoparts USA Inc.*, 218 USPQ 81, 85-86 (TTAB 1983) (apparent absence of actual confusion of minimal value given only brief history of contemporaneous use and insufficient record on subject of use).

In addition, we have no information from registrant regarding any instances of confusion of which it may be aware. Finally, there is nothing in the record tending to corroborate applicant's presumptive report that there has been no actual confusion, as would be present, for example, if applicant had presented us with a consent agreement between the parties. Thus, the "actual confusion" factor does not aid applicant.

In regard to the "market interface" factor, while our reviewing court has directed that our Section 2(d) analysis consider registrant's goods as theoretically traveling in all normal channels of trade to all possible classes of consumers, we must still consider the actual marketplace interface if we are provided with probative evidence of the same. Applicant, however, has not made of record any information which would aid our determination as to whether this factor militates in favor of, or against, finding a likelihood of confusion.

Finally, we come to the *du Pont* factor of "any other established fact probative of the effect of use." In this regard, applicant recounts how it obtained certain of its ELISABETH/LIZ CLAIBORNE mark registrations, for various items of women's apparel, prior to issuance of the cited registration. Applicant also notes that it obtained

another registration for one of these combination marks, as well as two registrations for ELISABETH alone, all for various items of women's apparel, *after* issuance of the cited registration. Applicant asserts that "neither the applicant nor the cited registrant has opposed an application by the other party—nor sought to cancel a registration of the other party..." Though it has not said it in so many words, we presume applicant to be asserting that the parties do not view the effect of their uses of their respective marks as likely to involve confusion and, therefore, neither has challenged the other's attempts to obtain registrations. Again, however, there is no evidence to support applicant's argument. Applicant does not allege that the parties have ever discussed their respective uses; or allege that their respective applications and registrations have gone unchallenged because of any agreement or understanding.

We note that the cited registration at least claims dates of first use prior to any date claimed by applicant in its registrations or in the involved application; this may explain applicant's apparent decision not to challenge the cited registration. Also, while applicant's registrations provide legal notice to the owner of the cited registration, there is no information of record upon

which we could conclude that registrant has actual notice of applicant, its activities and its registrations, so that we could accept applicant's contention that registrant has chosen not to challenge applicant's applications or registrations. Thus, the "any other established fact probative of the effect of use" factor also does not aid applicant.

In short, the two *du Pont* factors of the similarity of the involved marks and relatedness of the involved goods strongly militate in favor of a finding of likelihood of confusion; and we have no probative evidence on which we could resolve any of these additional *du Pont* factors in applicant's favor. Thus, we find that there is a likelihood of confusion and that the refusal of registration must be affirmed.

We cannot, however, close without briefly noting applicant's equitable arguments. Applicant argues that a basic principle of the Lanham Act is that the register established thereby should reflect "the realities of the marketplace" and the statute encourages registration. We readily concede the existence of the principle, but note that Section 2(d) of the statute bars registration when use of the mark proposed for registration would likely result in confusion or mistake among consumers.

Another point made by applicant concerns the apparent inequality of treatment of its applications by the Office. In essence, applicant argues that use of its mark for the involved goods is no more likely to cause confusion or mistake than is use of that mark for other goods and services that already are the subject of issued registrations. We do not pretend to be able to explain the processing and examination of each of applicant's applications; nor is it our responsibility to do so in this appeal from the refusal of the involved application. We are constrained to review the record before us insofar as it bears on the various *du Pont* factors. See *In re Nett Designs Inc.*, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Needless to say, this court encourages the PTO to achieve a uniform standard for assessing registrability of marks. Nonetheless, the Board (and this court in its limited review) must assess each mark on the record ... submitted with the application."). Having done so, we find that there exists a likelihood of confusion or mistake among consumers. We cannot set that conclusion aside because of general equitable arguments, even if we were to find them compelling.

Decision: The refusal of registration is affirmed.