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Paper No. 20
TJQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

MCB, Inc.
v.
Fashion Exp. (Taiwan) Co., Ltd.

Cancellation No. 29,940

Deanna Lyn Kwan of Wasserman, Comden & Casselman for MCB, Inc.

William W. Lai of the Law Offices of Albert J.C. Chang for Fashion Exp. (Taiwan) Co., Ltd.

Before Simms, Quinn and Drost, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

MCB, Inc., doing business as Wild Rose, has petitioned to cancel the registration owned by Fashion Exp. (Taiwan) Co., Ltd. for the mark WILD ROSE (in typed form) for "men's, women's and children's active, sport, casual, work and formal dress footwear, and boots."¹ As grounds for cancellation, petitioner alleges that there

¹ Registration No. 1,950,224, issued January 23, 1996; Section 8 affidavit filed and accepted.

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is a likelihood of confusion under Section 2(d) of the
Trademark Act. More

specifically, petitioner asserts that respondent's mark, when applied to respondent's goods, so resembles petitioner's previously used trade name and trademark WILD ROSE for women's apparel, namely, jackets, vests, shirts, blouses, t-shirts, pants, shorts, skorts, suits and dresses as to be likely to cause confusion.

Respondent, in its answer, has denied the allegations of the petition for cancellation. Respondent has set forth two "affirmative defenses" wherein respondent amplified its denial of likelihood of confusion.

The record consists of the pleadings; the file of the involved registration; a declaration of Ben Altshuler, an officer of petitioner,² and a memo from

² Trademark Rule 2.123(b) provides that testimony may be submitted by way of affidavit or declaration, but only by written agreement of the parties. In the present case, the declaration was not accompanied by any written agreement. Respondent subsequently made, however, the following statement at the conclusion of its notice of reliance: "Respondent Fashion shall also rely upon the documents noticed by Petitioner on January 18, 2001." Notwithstanding this remark, respondent, for the first time in its brief on the case, raised an objection to the declaration, relying on Trademark Rule 2.123(b) and the absence, in its mind, of a written agreement to allow the testimony to be filed in declaration form. Respondent argues at some length that its statement in its notice of reliance does not serve as a written stipulation, and that it would not stipulate to such form of testimony without the right to cross-examine the deponent.

We find respondent's statement in its notice of reliance to be clear and unambiguous. For whatever reasons, respondent indicated that it would rely on the evidence listed in petitioner's notices of reliance, and never even hinted that

him,³ various advertisements,⁴ respondent's responses to discovery requests,⁵ official records, including a certified copy of petitioner's now-expired prior registration, and assignments relating thereto,⁶ and petitioner's responses to discovery requests,⁷ all listed in petitioner's notices of reliance (the three notices were filed on the same day, January 19, 2001); a copy of

there was a problem with the submission. Accordingly, we construe respondent's statement in its notice of reliance to be a written stipulation to the submission of Mr. Altshuler's testimony in declaration form.

³ This evidence is not proper subject matter for a notice of reliance, but, in view of respondent's statement in the nature of a written stipulation, and respondent's failure to object to the improper submission, the evidence is of record.

⁴ Although some of these materials appear to be from printed publications, the notice of reliance does not specify the printed publication or otherwise conform with Trademark Rule 2.122(e). In view of respondent's statement, and respondent's failure to object to this evidence, it forms part of the record.

⁵ The responses include ones made relative to petitioner's production requests. Documents produced in response to production requests are not proper subject matter for a notice of reliance, except to the extent indicated in Trademark Rule 2.122(e). See TBMP § 711. These documents, however, have been considered in view of respondent's statement and its failure to make any objection to the improper submission.

⁶ This evidence shows that petitioner's predecessor obtained Registration No. 1,284,407 on July 3, 1984 for the mark WILD ROSE for "women's clothing, namely, dresses and suits," claiming a date of first use anywhere and first use in commerce of February 1, 1983. The registration was canceled for failure to file a Section 8 affidavit.

⁷ Ordinarily, an answer to an interrogatory may be submitted and made part of the record by only the inquiring party. In this case, respondent's statement as well as its failure to object thereto warrant consideration of this evidence in spite of the improper submission.

a letter between counsel,⁸ petitioner's additional responses to discovery requests,⁹ and respondent's responses to production requests,¹⁰ all listed in respondent's notice of reliance. The parties filed briefs. An oral hearing was requested, but the request subsequently was withdrawn by the mutual agreement of the parties.

PRIORITY

In our determination of priority of use, we need to address, at the outset, two of the arguments untimely raised by respondent. In defending against petitioner's claim of priority, respondent raises, for the first time in its brief, an affirmative defense of laches and an allegation that petitioner's mark has been abandoned. Petitioner contends, in its reply brief, that respondent's assertions are untimely inasmuch as respondent neither raised the matters in the answer, nor

⁸ Correspondence between counsel is not proper subject matter for a notice of reliance. Petitioner, however, made no objection thereto, and we have considered it to be of record.

⁹ The responses include documents submitted in response to production requests. As indicated earlier, such evidence is not proper for introduction by way of a notice of reliance. Petitioner made no objection thereto, and the evidence has been considered.

¹⁰ As pointed out earlier, reliance on one's own discovery responses is improper. However, in view of petitioner's failure to object thereto, the evidence has been considered.

ever made an attempt to amend the answer to include these assertions as defenses.

Petitioner's objections are well taken. An answer should include any defenses which the defendant may have to the claim asserted by the plaintiff. Trademark Rule 2.114(b)(1); and Fed. R. Civ. P. 8(b). Such defenses include laches and, in the context herein of disputing petitioner's common law priority claim, abandonment. In the present case, the defenses were not raised in the answer. Moreover, even at the end of petitioner's case-in-chief testimony period, the answer was never amended to include the defenses. Specifically with respect to priority, respondent was obligated, after petitioner completed its testimony, to at least amend its pleading (e.g. to assert that the pleaded mark was abandoned) to put petitioner on notice that there were perceived problems with petitioner's claim of prior and continuous use. However, it was not until the briefing stage that respondent raised any problems with petitioner's priority claim. Until this late juncture, petitioner had no formal notice that respondent viewed the use as anything but prior and continuous.¹¹

¹¹ The correspondence between counsel (specifically, respondent's letter dated January 18, 2001) does not excuse the failure to amend the answer. Further, to the extent that

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Accordingly, petitioner was never put on notice that these defenses would be raised against it. To consider the defenses at this late juncture unduly prejudices petitioner who did not have fair notice of the bases for the defenses. Further, given the way this case was litigated, the defenses certainly were never tried by the parties, either expressly or impliedly, as provided by Fed. R. Civ. P. 15(b).

In view of the above, respondent's defenses of laches and abandonment have been untimely raised and will not be

respondent viewed petitioner's discovery responses as deficient, the matter was never brought to the Board's attention by a motion to compel as provided by Trademark Rule 2.120(e).

considered.

Turning now to the merits of petitioner's priority claim, of record is the declaration of Benjamin Altshuler, one of petitioner's officers. Mr. Altshuler states, in pertinent part, that petitioner's trade name and mark WILD ROSE has been in continuous use in connection with women's clothing since 1983. Mr. Altshuler further stated that petitioner's clothing has been "favorably received in the marketplace." Also of record are invoices showing use of WILD ROSE (in script form) as a trade name. One invoice for each of the years 1985-2000 (except 1994) has been submitted, with the customers' names and addresses, units shipped and prices redacted. Various advertisements for petitioner's WILD ROSE brand of women's clothing have been submitted. The advertisements have been run by retailers, including Macy's, Robinson's, and Gantos. The record also includes a hang tag and a label showing use of the mark WILD ROSE (in script form). In his declaration, Mr. Altshuler indicated that petitioner's corporate policy is to destroy corporate documents after 7 years.

Respondent's registration is, of course, of record; it bears a filing date of May 31, 1994, and claims first use on January 1, 1985 (the registration issued on

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January 23, 1996). Of record are product catalogs for the years 1996-2000. Respondent's responses to interrogatories also are of record. The responses reveal that respondent obtained the involved registration by assignment on April 16, 1996; the earliest date of use set forth by respondent in the responses is April 16, 1996 (interrogatory no. 11).

Insofar as respondent's first use is concerned, respondent indicates that it commenced use when it obtained the involved registration on April 16, 1996. In any event, in the absence of testimony or other evidence, the filing date of the involved registration (i.e., May 31, 1994) is the earliest date upon which respondent could rely. See: Lone Star Mfg. Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974).

Because WILD ROSE is an inherently distinctive mark for women's clothing, petitioner has established trademark rights in WILD ROSE for women's clothing with its earliest uses of the mark which, according to the uncontradicted statements of Mr. Altshuler, date back to February 1, 1983. In addition, the invoices, which show trade name use, also support petitioner's priority. The

evidence is sufficient for purposes of proving petitioner's priority in this case.

LIKELIHOOD OF CONFUSION

The parties' arguments can be easily summarized. Petitioner maintains that the marks are identical, and that petitioner's women's clothing and respondent's women's footwear are closely related. With respect to the goods, petitioner argues that clothing and shoes are complementary items, often purchased in the same shopping trip in the same store.

Respondent contends, on the other hand, that the goods are "dissimilar and substantially unrelated." Respondent also asserts that the goods are sold in different trade channels and to different classes of purchasers. Respondent states that it sells its footwear to distributors who are sophisticated purchasers.

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).

The evidence of record shows use of WILD ROSE by petitioner in script form as indicated above. The use of WILD ROSE as a trade name on the invoices and as a trademark on the labels and hangtags (see petitioner's response to document request no. 10) is in script form. The use of WILD ROSE in typed form appears in the body of the invoices. Petitioner's mark is essentially identical to respondent's mark. In typed form, the marks are identical in every respect. In comparing petitioner's mark in script form with respondent's typed mark, the marks remain identical in sound and meaning, with some difference, albeit very slight, in appearance.

In view of the above, the parties have spent little time in discussing the marks, but rather have concentrated their briefing efforts on comparing the goods sold under the marks. With respect to the goods, we recognize, at the outset, that there is no per se rule governing likelihood of confusion in cases involving clothing and footwear. Nonetheless, petitioner's women's clothing and respondent's women's footwear are "all articles of apparel which would normally be marketed

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through the same class of retail merchants to the same class of purchasers." *Chaussures Bally Societe Anonyme de Fabrication v. Fritzi of California, Inc.*, 144 USPQ 609, 610 (TTAB 1965) [use of BALLY and VALLI on wearing apparel and on boots is likely to cause confusion]. See also: *General Shoe Corp. v. Hollywood-Maxwell Co.*, 277 F.2d 169, 125 USPQ 443 (CCPA 1960) [use of same mark on shoes and hosiery and on brassieres likely to cause confusion]; *General Shoe Corp. v. Lerner Bros. Mfg. Co., Inc.*, 254 F.2d 154, 117 USPQ 281 (CCPA 1958) [use of same mark on men's boots and shoes and on men's sport shirts likely to cause confusion]; *In re Kangaroos, U.S.A.*, 223 USPQ 1025 (TTAB 1984) [use of same mark on athletic shoes and on men's shirts likely to cause confusion]; *B. Rich's Sons, Inc. v. Frieda Originals, Inc.*, 176 USPQ 284 (TTAB 1972) [use of similar marks on women's knitted dresses, suits, skirts and blouses and on shoes is likely to cause confusion]; *In re United States Rubber Co.*, 155 USPQ 595 (TTAB 1967) [use of same mark on shoes and on shorts likely to cause confusion]; and *Shoe Corporation of America v. Petite Miss Co.*, 133 USPQ 215 (TTAB 1962) [use of same mark on shoes and on women's coats likely to cause confusion]. Further, in cases such as this where arbitrary marks are essentially identical, the

relationship between the goods on which the parties use their marks need not be as close as in the situation where the marks are not so similar. *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981). See also: *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

As articulated in some of the cited cases, women's clothing and women's footwear are viewed as complementary fashion items. Clothing and footwear are often bought on the same shopping trip, in the same store (albeit in different departments of the store), and by the same purchaser to complete an ensemble.

In the absence of any specific limitation in respondent's registration, we must assume that respondent's women's footwear travels in the usual channels of trade for such goods. *In re Apparel Ventures, Inc.*, 229 USPQ 225 (TTAB 1986). Thus, the differences in trade channels pointed to by respondent are of no moment. Normal channels of trade for women's footwear would include retail stores, that is, the same type of trade channel wherein petitioner's women's clothing would appear to be ultimately sold.¹² As to

¹² Petitioner's clothing initially is sold in its own showroom at wholesale. The clothing is then sold to retail outlets wherein the goods are ultimately purchased by consumers.

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classes of purchasers, the same ones would purchase at retail both women's clothing and women's footwear.

We conclude that consumers familiar with petitioner's women's clothing sold under the previously used trade name and trademark WILD ROSE (in script form) would be likely to believe, upon encountering respondent's mark WILD ROSE for women's footwear, that the goods originated with or were somehow associated with or sponsored by the same entity.

Decision: The petition for cancellation is granted, and Registration No. 1,950,224 will be canceled in due course.