

1/29/02

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 11  
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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In re *St. Clair Apparel, Inc.*  
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Serial No. 75/649,382  
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*Susan B. Flohr* of *Blank Rome Comisky & McCauley* for *St. Clair Apparel, Inc.*

*Nora Buchanan Will*, Trademark Examining Attorney, Law Office 101 (*Jerry Price*, Managing Attorney).

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Before *Quinn, Bottorff and Rogers*, Administrative Trademark Judges.

Opinion by *Bottorff*, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark ST. CLAIR APPAREL, in typed form, for goods identified in the application as "men's, women's and children's clothing, namely, tops, sport shirts, T-shirts."<sup>1</sup>

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<sup>1</sup> Serial No. 75/649,382, filed March 2, 1999. The application is based on use in commerce, and December 1998 is alleged as the date of first use of the mark and first use of the mark in commerce.

Applicant has disclaimed the exclusive right to use APPAREL apart from the mark as shown.

The Trademark Examining Attorney issued three refusals of registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark, as applied to applicant's goods, is confusingly similar to three registrations owned by three different registrants: the mark CARLY ST. CLAIRE, registered in typed form for "clothing, namely, sweaters";<sup>2</sup> the mark MARIE ST. CLAIRE, registered in typed form for "women's clothing, namely, dresses";<sup>3</sup> and the mark NINA ST. CLAIRE, registered in stylized form for "women's clothing, namely, skirts, pants, shorts, culottes, jackets, vests, jumpsuits, blouses, shirts, tops, belts and scarves."<sup>4</sup>

When the refusals were made final, applicant filed this appeal. Applicant and the Trademark Examining Attorney filed main briefs, and applicant filed a reply

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<sup>2</sup> Registration No. 2,029,041, issued January 1, 1997, owned by Tiara International, Inc.

<sup>3</sup> Registration No. 1,797,894, issued October 12, 1993 (Section 8 and 15 affidavits accepted and acknowledged), owned by LCEL Collectibles, Inc.

<sup>4</sup> Registration No. 1,642,124, issued September 11, 1990 (Section 8 and 15 affidavits accepted and acknowledged), owned by Teddi of California.

brief. No oral hearing was requested. We affirm each of the refusals of registration.

The only evidence of record on appeal are the six third-party registrations the Trademark Examining Attorney attached to her final refusal.<sup>5</sup> Those registrations, all of which cover clothing items, are of the marks CLAIBORNE and LIZ CLAIBORNE (both of which are owned by a single registrant), LAUREN and RALPH LAUREN (both of which are owned by a single registrant), and ADRIENNE VITTADINI and VITTADINI SPORT (both of which are owned by a single registrant). The Trademark Examining Attorney offered this evidence in support of her contention that, in the apparel industry, it is common for a company to market its clothing products under the name of an individual, and for such a company to use both a trademark consisting of the individual's surname as well as a trademark consisting of the individual's full name.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E.I. du*

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<sup>5</sup> We note that applicant submitted numerous evidentiary materials with its reply brief. These materials were not previously made of record prior to the filing of the appeal. Accordingly, we have not considered them, nor applicant's arguments based thereupon. See Trademark Rule 2.142(d).

*Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Based on the identifications of goods in the application and in the three cited registrations, we find that applicant's goods are legally identical to certain of the goods identified in the NINA ST. CLAIRE registration (i.e., "blouses, shirts, tops") and closely related to the remainder of the goods identified in that registration, and that they are closely related to the goods identified in the CARLY ST. CLAIRE and MARIE ST. CLAIRE registrations. Furthermore, given this close relationship between the respective goods, and in view of the absence of any restrictions in the respective identifications of goods, we find that applicant's goods and the goods identified in each of the cited registrations are marketed in the same or highly similar trade channels, and to the same or highly similar classes of purchasers. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1

USPQ2d 1813 (Fed. Cir. 1987); *In re Elbaum*, 211 USPQ 639 (TTAB 1981). These *du Pont* factors weigh in favor of a likelihood of confusion finding in this case. Applicant does not contend otherwise.

We turn next to a determination of whether applicant's mark and each of the cited registered marks, when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Finally, where, as in the present case, the marks would appear on legally identical and/or closely related goods, the degree of similarity between the marks which is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ 1698 (Fed. Cir. 1992).

Initially, we find that the designation ST. CLAIR is the dominant feature of applicant's mark, and that it therefore is the feature which is entitled to the greatest weight when we compare applicant's mark to the cited registered marks. In making those comparisons, we do not disregard the presence of the disclaimed, generic word APPAREL in applicant's mark, but we find that it contributes relatively little to the mark's commercial impression, and we therefore have accorded it relatively less weight in our analysis of the marks. See *In re National Data Corp.*, *supra*.

In terms of appearance and sound, we find that applicant's mark is essentially identical to each of the cited registered marks to the extent that it, and they, include the designation ST. CLAIR or ST. CLAIRE. We find that the difference in spelling between ST. CLAIR and ST. CLAIRE is inconsequential, and that the marks are legal equivalents in terms of appearance and sound to the extent

that they each include ST. CLAIR or ST. CLAIRE. Applicant's mark and the registered marks obviously differ in terms of appearance and sound to the extent that applicant's mark contains the generic word APPAREL while the registered marks do not, and to the extent that the registered marks each include a first name, while applicant's mark does not. However, viewing the marks in their entireties, we find that the similarity in appearance and sound resulting from the presence in each mark of the term ST. CLAIR or ST. CLAIRE outweighs the dissimilarities which result from the presence or absence of the other words in the respective marks.

In terms of connotation, we find that applicant's mark is similar to each of the cited registered marks in that each of the marks connotes the name of a person named ST. CLAIR or ST. CLAIRE. The presence in applicant's mark of the generic word APPAREL does not negate or detract from that connotation. Applicant argues that its mark would be perceived as connoting apparel originating from a geographic place called ST. CLAIR, a connotation not shared by any of the cited registered marks. However, there is no evidence in the record that such a place exists, or that, if it does exist, that it is anything more than a remote or

obscure place.<sup>6</sup> We cannot conclude that any such geographic significance of ST. CLAIR suffices to negate the obvious surname significance and connotation of the term, or that purchasers viewing applicant's mark necessarily would see it only as a geographic term and be able to distinguish it from any of the cited registered marks on that basis. We find that applicant's mark, viewed in its entirety, has a connotation which is similar to the connotation of each of the cited registered marks.

In view of the Trademark Examining Attorney's evidence that clothing companies often use personal name marks, and that those marks can be either the surname alone or a full name (first name and last name), we find that purchasers familiar with any of the cited registered marks would be likely to mistakenly assume, upon encountering applicant's mark used on the same or closely related goods, that a source connection exists. Applicant's mark is confusingly similar to each of the registered marks, and each of those previous registrations bars issuance of the registration that applicant seeks.

Applicant argues that the designation ST. CLAIRE in the registered marks is a descriptive or otherwise weak

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<sup>6</sup> We note that, according to the application, applicant is located in South Bend, Indiana.

term, such that the minor points of distinction between applicant's mark and the cited registered marks suffice to eliminate any likelihood of source confusion. We are not persuaded. Contrary to applicant's contention, none of the registered marks is merely descriptive by virtue of its being a personal name. Personal name marks (so long as they are not primarily merely surnames) are deemed to be inherently distinctive and are registrable on the Principal Register without resort to the acquired distinctiveness provisions of Section 2(f).<sup>7</sup> Accordingly, we reject as inapposite the cases applicant cites for the proposition that merely descriptive marks are to be accorded a narrow scope of protection. Equally inapposite are the cases cited by applicant for the proposition that registrations can be used in the manner of dictionaries as evidence of the meaning of the terms appearing in the registered marks. Applicant has not specified, and we cannot discern, how the presence of ST. CLAIRE in the three cited registrations constitutes evidence of what ST. CLAIRE means, or how that revealed meaning of the term affects this case. Finally,

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<sup>7</sup> Indeed, the three registrations cited by the Trademark Examining Attorney in this case each issued on the Principal Register, and two of them are now incontestable. To the extent that applicant, by calling the registered marks merely descriptive, is challenging the validity of the registrations, such challenge is without legal or procedural basis in this ex parte proceeding.

we find that *Taj Mahal Enterprises, Ltd. v. Trump*, 15 USPQ2d 1641 (DC NJ 1990), in which the court found that the mark TAJ MAHAL for restaurants was weak and diluted based on evidence that there were twenty-four third parties using the term in connection with restaurants, is so readily distinguishable from the present case (which involves three registered marks) that it is of no persuasive value as authority here.

We likewise are not persuaded by applicant's argument that if the three cited registered marks can co-exist in the marketplace and on the register, applicant's mark can co-exist as well. Rather, we find that the three registered marks are readily distinguishable from each other, inasmuch as each of them would be perceived as connoting or referring to a different person, each with a readily distinguishable first name. Applicant's mark, in contrast, does not readily or necessarily connote an additional or different person. Instead, it connotes a person with the surname ST. CLAIR, who, given the industry practice of using both surnames alone and full names as marks, could readily be perceived to be the NINA ST. CLAIRE, or CARLY ST. CLAIRE, or MARIE ST. CLAIRE who is identified in the respective registered marks.

In summary, we have considered all of the evidence properly made of record with respect to the *du Pont* evidentiary factors, and we conclude that a likelihood of confusion exists as between applicant's mark and each of the three cited registered marks.

Decision: Each of the Section 2(d) refusals is affirmed.