

**This Opinion is Not a
Precedent of the TTAB**

Mailed: September 26, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

—————
Trademark Trial and Appeal Board
—————

In re The Marshall Retail Group, LLC
—————

Serial No. 87293691
—————

Lauri S. Thompson and Shauna L. Norton of Greenberg Traurig, LLP for
The Marshall Retail Group, LLC

Leigh Caroline Case, Trademark Examining Attorney, Law Office 118,
Michael W. Baird, Managing Attorney.

—————
Before Wellington, Greenbaum and Dunn,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

The Marshall Retail Group, LLC (“Applicant”) seeks registration of the standard character mark **FIRST LADY** on the Principal Register for “aprons” in International Class 25.¹

¹ Application Serial No. 87293691 was filed on January 9, 2017, and is based on Applicant’s claim of a bona fide intent to use the mark in commerce, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). On April 25, 2019, subsequent to the filing of the appeal and appeal briefs, Applicant amended the application to delete “jackets” from the identification and sought reconsideration of the refusal based on this amendment (12 TTABVUE). The Examining Attorney accepted the amendment but maintained the refusal (14 TTABVUE).

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the following two registered marks (owned by the same entity):

FIRST LADY (in standard characters)
(Reg. No. 3515250)² for:

Women's clothing, namely, suits, blazers, jackets, pants, skirts, in International Class 25; and

FIRST LADY SUITS (in standard characters)
(Reg. No. 2526101)³ for the same goods listed in the previous cited registration, but also covers “dresses.”

After the refusal was made final, Applicant filed an appeal and twice requested reconsideration.⁴ Reconsideration was denied by the Examining Attorney and the appeal has been briefed. For the following reasons, we affirm the refusal.

I. Applicable Law

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor for which there is argument and evidence of record. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v.*

² Registration No. 3515250 issued on October 14, 2008; renewed.

³ Registration No. 2526101 issued on January 1, 2002; renewed.

⁴ The first request for reconsideration (4 TTABVUE) involved a pending renewal of one of the cited registrations, and the second request for consideration involved Applicant's amendment to the identification of goods (see Note 1).

GFA Brands, Inc., 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). “[E]ach case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

We will focus on registrant’s FIRST LADY mark (Reg. No. 3515250) because it does not have the additional term SUITS and, when considered vis-à-vis the applied-for mark and identified goods, it is the mark that is most likely to support a finding of likelihood of confusion. In other words, if confusion is likely based on this registration, there is no need for us to consider the likelihood of confusion with the other cited registration. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Identical Marks

Under the first *du Pont* factor, we compare the involved marks “in their entirety as to appearance, sound, connotation and commercial impression.” *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (quoting *du Pont*, 177 USPQ at 567); *see also Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d

1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). In this case, the marks are identical and thus this factor weighs strongly in favor of finding confusion likely.

B. Related Goods and Same Trade Channels

With respect to the second and third *du Pont* factors, the similarity of the goods and their channels of trade, we must make our determinations as to these factors based on the goods as they are identified in the application and cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The goods need not be the same and a likelihood of confusion may be found even when the respective goods are not “competitive or intrinsically related.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1737 (Fed. Cir. 2017). “Instead, likelihood of confusion can be found ‘if the respective products are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (internal citations omitted).

Finally, we also keep in mind that when the involved marks are identical, as is the case here, the relatedness of the goods required to support a finding of likelihood

of confusion declines. *See In re i.am.symbolic*, 116 USPQ2d at 1411 (internal citation omitted), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017).

The Examining Attorney has submitted screenshot printouts from different websites showing aprons being offered for sale along with either jackets, pants or skirts, all under the same mark or house mark on the same retail website.⁵ These include a Kate Spade “diner stripe apron” being sold on the same site (www.katespade.com) as the Kate Spade skirts, jeans, and blazers;⁶ Nordstrom (www.shop.nordstrom.com) offering a “Draper James” branded apron and “Draper James” branded skirt;⁷ an apron, jeans, and skirt all offered under the Levi’s brand and with red Levi’s tab logo on the Levi’s website (www.levi.com);⁸ and the Blair website (www.blair.com) offering for sale a “print cobbler apron,” denim pants, jacket and jacket dress.⁹

The record establishes relatedness of the involved goods because Applicant’s aprons and registrant’s jackets, pants or skirts, are the types of goods that may be offered under the same brand. We also note that the goods related on their face because aprons are intended to be used in conjunction with and protection for clothing such as skirts and pants. Moreover, the goods may be offered in the same type of retail outlets to the same classes of consumers – namely the general public shopping

⁵ Attached to Office Action issued on October 27, 2017.

⁶ *Id.* at TSDR pp. 8-12.

⁷ *Id.* at TSDR pp. 13-15.

⁸ *Id.* at TSDR pp. 16-19.

⁹ *Id.* at TSDR pp. 20-22.

online for women's clothing. Accordingly, the *du Pont* factors involving the relatedness of the goods, as well as the channels of trade and classes of consumers to whom the goods are being offered, all weigh in favor of finding a likelihood of confusion.

C. Applicant's Prior Registration

Applicant points out that it is the owner of a registration for the same mark, FIRST LADY, for "caps, socks and t-shirts."¹⁰ Applicant further notes that its registration issued after registrant's FIRST LADY SUITS mark registered, but before the registrant's FIRST LADY registration. Based on this sequence of registration, Applicant concludes that the Board "found, on not one, but two different occasions that these marks were not confusingly similar" and posits that "[t]he likely reason is that despite sharing the terms 'FIRST LADY,' the marks are used in connection with dissimilar products, and create unique and separate commercial impressions that are not likely to cause confusion in the marketplace."¹¹

We consider Applicant's prior registration argument under the thirteenth *du Pont* factor which relates "to 'any other established fact probative of the effect of use.'" *In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 1400 (TTAB

¹⁰ 7 TTABVue 3-4. We note that Applicant's registration, Registration No. 3227319, issued on April 10, 2007, based on an application filed on March 3, 2006; renewed. Applicant mentioned ownership of this registration in its response (filed October 6, 2017) to the first Office Action, and the Examining Attorney acknowledged Applicant's ownership in the next Office Action (issued on October 27, 2017). Although a formal claim of ownership should be listed in the involved application file pursuant to Rule 2.36, the lack of claim of ownership has no bearing on our ultimate decision in this appeal.

¹¹ *Id.* at 4.

2012) (quoting *du Pont*, 177 USPQ at 567). In *Strategic Partners*, the Board addressed the “unique situation” of coexistence of an applicant's existing registration with a cited registration for over five years, and when the applicant's applied-for ANYWEAR mark is substantially similar to its existing registered ANYWEARS mark and both are for identical goods (footwear). The Board noted that the latter registered mark had co-existed with the cited ANYWEAR BY JOSEPH NATORI (stylized with a design) mark for jackets, shirts, pants, stretch T-tops and stoles. The Board ultimately held:

Applicant's registered mark, a mark that is substantially similar to the applied-for mark, both covering “footwear,” has coexisted with the cited mark for over five years. At this stage, applicant's existing registration is over five years old, and thus is not subject to attack by the owner of the cited registration on a claim of priority and likelihood of confusion. *Cf. In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994). We find that these facts tip the scale in favor of applicant and a finding of no likelihood of confusion.

Id.

Despite a five-year plus coexistence between Applicant's prior registration and the cited registrations, the situation in this proceeding is readily distinguishable from that in *Strategic Partners*. Unlike the circumstances in that case, Applicant's prior registration here is for goods that are different than that identified in the involved application. *Compare In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1745-46 (TTAB 2018) (*Strategic Partners* distinguished because “Applicant's applied-for mark — 5IVE STEAKHOUSE and design — moves closer to the cited registration — 5IVESTEAK and design — than the mark in Applicant's prior registration — 5IVE RESTAURANT and design — rendering the new mark more similar in appearance,

sound, and meaning to Registrant's mark"). Specifically, Applicant's prior registration covers, inter alia, "caps, socks and t-shirts," and it now seeks registration for the same mark on "aprons." These are clearly not the same goods and, for reasons mentioned *supra*, we find aprons are related to the goods listed in the cited registration, namely, pants, skirts and jackets. We further point out that we not privy to the reasoning or bound by the decisions made by examining attorneys in determining whether a likelihood of confusion existed between Applicant's prior registration and the registered marks cited in this proceeding. *The Pierce-Arrow Society v. Spintek Filtration, Inc.*, 2019 WL 3834985, *17 (TTAB 2019) ("the Board is not bound by decisions of examining attorneys"), *citing In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court.")

Accordingly, in contrast to our finding in *Strategic Partners*, we find that Applicant's prior registration in this case does not 'tip the scale' and lead us to conclude that there is no likelihood of confusion.

D. Conclusion

Given the identity of the Applicant's proposed mark, FIRST LADY, with the registered mark and our finding that Applicant's aprons are related to registrant's pants, skirts and jackets, and these goods may be offered to the same classes of purchasers in the same trade channels, we find that confusion is likely.

Decision: For the aforementioned reasons, the refusal under Section 2(d) to register Applicant's mark is affirmed.