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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PRL USA Holdings, Inc.

Serial No. 77634450

G. Roxanne Elings of Greenberg Traurig for PRL USA Holdings, Inc.

Alec Powers, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Quinn, Kuhlke and Ritchie, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

PRL USA Holdings, Inc. filed, on December 16, 2008, an intent-to-use application to register the mark RALPH LAUREN STIRRUP COLLECTION ("COLLECTION" disclaimed) in standard characters for "horological and chronometric instruments and parts thereof" in International Class 14.

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously

registered mark STIRRUP in typed letters for "jewelry" in International Class 14¹ as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.²

Applicant contends that the term "stirrup" is highly suggestive, and that the cited mark is entitled to only a narrow scope of protection when used in connection with "equestrian styled" jewelry. Applicant argues that the examining attorney has improperly dissected the mark, by focusing on the STIRRUP portion, while at the same time ignoring the additional wording in applicant's mark, namely RALPH LAUREN and COLLECTION. According to applicant, the addition of applicant's famous RALPH LAUREN house mark, already registered for numerous luxury items, including watches, to the highly suggestive term "STIRRUP," ensures

¹ Registration No. 2817509, issued February 24, 2004; Section 8 affidavit accepted, Section 15 affidavit acknowledged.

² The examining attorney submitted, for the first time with his appeal brief, copies of documents from the file history of applicant's companion application Serial No. 77634444 (now abandoned) to register the mark STIRRUP for "horological and chronometric instruments and parts thereof." Applicant, in its reply brief, objected to the untimely submission. The documents comprise third-party registrations, as well as some of applicant's prior registrations, suggesting that jewelry and watches may emanate from the same source. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Clearly this type of evidence could have and should have been submitted at the earlier stage of examination of the application. To do so at the briefing stage is untimely, and applicant's objection is sustained. The evidence has not been considered in reaching our decision.

that there is no likelihood of confusion between the marks. To establish that the term "stirrup" has a highly suggestive meaning in the jewelry field, applicant submitted evidence of third-party uses of the term in connection with a variety of jewelry items. Applicant also submitted evidence to show that both registrant's and applicant's goods are "equestrian styled." Applicant goes on to argue, however, that the goods are specifically different. Applicant claims that its watches are highly sophisticated, and are sold to wealthy consumers through authorized distributors such as Nordstrom's, Saks, Macy's and Neiman Marcus. Registrant's goods, on the other hand, are custom-made decorative jewelry items sold via registrant's website. Although applicant concedes that watches may fall under the general category of "jewelry," it is highly unlikely that consumers will believe that decorative jewelry and sophisticated timepieces emanate from the same source. Applicant points out that its watches range in price from \$9,000 to \$70,000, and that this cost, coupled with the sophistication of purchasers, ensures against the likelihood of confusion in the market place.

The examining attorney maintains that the marks are similar and that the goods are closely related. The marks

share the common element "STIRRUP," and, thus, the examining attorney argues, the overall commercial impressions of the marks are similar. In this regard, the examining attorney contends that the addition of the RALPH LAUREN house mark in applicant's mark adds to the likelihood of confusion with registrant's mark, rather than acting to distinguish the marks. As to the goods, the examining asserts that watches and jewelry have similar uses, and that they are marketed through the same trade channels. To the extent that the record shows that the cited mark is weak, the examining attorney contends that even weak marks are still entitled to protection against the registration by a subsequent user of a similar mark for related goods.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods

and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first turn to consider the goods. It is not necessary that the respective goods be competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). The question of likelihood of confusion is determined based on the identification of goods in the application vis-à-vis the goods as set forth in the cited registration. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); and *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). The issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods.

In view thereof, we compare applicant's "horological and chronometric instruments and parts thereof" with

registrant's "jewelry." We recognize that watches may be worn as jewelry, and that jewelry and watches may move through the same trade channels (e.g., jewelry stores). Applicant submitted (for a purpose not related to this *du Pont* factor) copies of its Registration No. 3764868 of the mark RALPH LAUREN listing "watches" and "jewelry watches" in the identification of goods; further, applicant's Registration No. 1835393 of RALPH LAUREN covers "jewelry." Thus, in point of fact, applicant has registered the same mark for both types of goods involved herein. Although we have not considered the examining attorney's evidence relating to this *du Pont* factor (see footnote 2, supra), applicant's own prior registrations support the same suggestion, namely that watches and jewelry may emanate from the same source. See *In re Albert Trostel*, supra. The goods are presumed to be sold in the same trade channels to the same classes of purchasers, including ordinary consumers.

We accordingly find that the similarity between the goods weighs in favor of a finding of likelihood of confusion. We have reached our finding on this factor without giving any probative value to the evidence and applicant's arguments based thereon regarding the expensive nature of its watches and the sophistication of the

purchasers thereof, as opposed to the relatively inexpensive cost of registrant's "decorative" jewelry. Suffice it to say, neither applicant's nor registrant's identification of goods includes any restrictions in these regards; accordingly, the points regarding price and sophisticated purchasers are irrelevant to our analysis.

Insofar as the marks are concerned, the marks must be considered in their entirety as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test, under the first *du Pont* factor, 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).

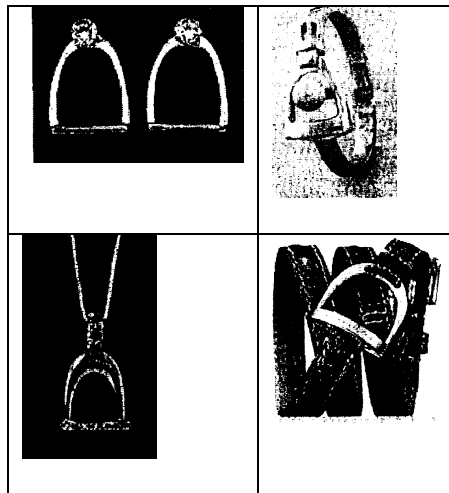
We must compare applicant's mark RALPH LAUREN STIRRUP COLLECTION with registrant's mark STIRRUP. It is a general

rule that likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding or deleting a house mark. *See, e.g., In re Chica*, 84 USPQ2d 1845 (TTAB 2007). *See generally* TMEP §1207.01(b)(iii) (7th ed. 2010). Exceptions to the general rule regarding additions or deletions to marks may arise if: 1) the marks in their entireties convey significantly different commercial impressions; or 2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. *See, e.g., Shen Manufacturing CO. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645 (TTAB 2010) (CAPITAL CITY BANK held not likely to be confused with CITIBANK); and *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

We view the present case as an exception, specifically the second exception identified above, to the general rule. Our reason is based on the rampant use of the term "stirrup" in connection with a certain type of jewelry.

The common element to the marks is "STIRRUP." The term "stirrup" is defined as "a loop, ring, or other contrivance of metal, wood, leather, etc. suspended from the saddle of a horse to support the rider's foot." (Random House Dictionary (2011)).³

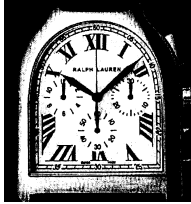
Applicant introduced excerpts of numerous third-party websites showing the listings for sale of a wide variety of jewelry items consistently described as "Stirrup Jewelry"; in each case, the item is in the shape of an equestrian stirrup. The jewelry items include earrings, pendants, necklaces, bracelets, rings and charms. Examples of some items are shown below.



³ Dictionary definitions are proper subject matter for judicial notice. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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Applicant's watches are "equestrian inspired" and are sold in a similar stirrup shape (with saddle leather used for the strap for one of the editions) as shown below.



Registrant's rings, one of the jewelry items offered under the cited mark, are sold in a stirrup shape as shown below.



Based on the record, we find that the term common to the marks, "STIRRUP," is less likely to be perceived by purchasers as a distinctive term serving to distinguish source because it is diluted in the jewelry field. Thus, the addition of applicant's house mark, RALPH LAUREN, in applicant's mark is sufficient to distinguish its mark from the cited mark. Because of the widespread use of "stirrup" in the jewelry field, we see the likelihood of confusion refusal as amounting to only a speculative, theoretical possibility. Language by our primary reviewing court is

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helpful in resolving the likelihood of confusion issue in this case:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 21 USPQ2d at 1391 (Fed. Cir. 1992), *citing* *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g* 153 USPQ 412 (TTAB 1967).

Decision: The refusal to register is reversed.