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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Park Lane Shoes Limited

Serial No. 79073835

Dermot M. Sheridan of Epstein Drangel for Park Lane Shoes Limited.

Howard Smiga, Trademark Examining Attorney, Law Office 102 (Karen M. Strzyz, Managing Attorney).

Before Quinn, Kuhlke and Taylor, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Park Lane Shoes Limited filed an application to register the mark PARK LANE for "leather and imitation leather bags and handbags" (in International Class 18); and "articles of clothing for men, women and children, namely tops, bottom and jackets; footwear; belts" (in International Class 25).¹

¹ Application Serial No. 79073835, filed June 23, 2009, under Section 66(a) of the Trademark Act, 15 U.S.C. §1141f, based on International Registration No. 1015828, issued June 23, 2009.

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 in International Class 25, so resembles the previously registered mark shown below

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for "women's hosiery and footwear" (in International Class 25)² as to be likely to cause confusion.

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

So as to be clear, the examining attorney, in his final refusal, refused registration in both Classes 18 and 25. In his appeal brief, however, the examining attorney only addressed the refusal in Class 25, indicating the following in footnote 1: "The applicant's refusal is limited to International Class 25 only and does not bar registration of its goods in International Class 18." Accordingly, this appeal only involves Class 25.

² Registration No. 1294538, issued September 11, 1984; renewed.

Applicant argues that the commonality of "PARK" in the marks is an insufficient basis upon which to find the marks to be similar. Rather, applicant contends, the marks must be considered in their entirety and, when so considered, the marks differ in connotation and overall commercial impression. Applicant asserts that Park Avenue in Manhattan is one of the most famous thoroughfares in the world, conjuring up, in the minds of consumers, images of a fashionable, glamorous and sophisticated lifestyle in New York City. The mark PARK AVENUE, as a whole, engenders a much different commercial impression than does the word PARK standing alone. Further, applicant's mark PARK LANE refers to a well-known street in London, England, an address synonymous with wealth and an aristocratic English lifestyle. Although applicant acknowledges that the terms "avenue" and "lane" may be similar in certain contexts, when the terms are used in the marks PARK AVENUE and PARK LANE, applicant contends they are very different. Moreover, according to applicant, the term "PARK" is weak when applied to clothing, with applicant pointing to several third-party registrations that it introduced, most especially, PARK STREET and PARK PLACE. In support of its arguments, applicant also submitted information about "Park

Avenue" and "Park Lane" retrieved from third-party websites.

The examining attorney maintains that the goods in Class 25 are, in part, identical, namely as to "footwear." The examining attorney argues that the first portion of the marks, PARK, is identical, and that this is the portion most likely to be remembered by purchasers. Further, the examining attorney asserts, on the basis of dictionary definitions, that the second portions of the marks, AVENUE and LANE, have similar meanings, and that, therefore, the marks have similar connotations and similar overall commercial impressions.

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

Applicant's and registrant's identification of goods in Class 25 each includes "footwear." Thus, for purposes of our likelihood of confusion analysis, the goods are considered to be legally identical. Likelihood of confusion may be found based on any item that comes within the identification of goods in the involved application or registration. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Given that applicant's and registrant's goods are, in part, identical, we presume that they travel in the same trade channels (e.g., shoe stores), and that the footwear is bought by the same classes of purchasers. These classes would include ordinary consumers, who would be expected to exercise nothing more than ordinary care in making their purchasing decision.

The identity or otherwise close relationship between the goods, and the identity in trade channels and purchasers are factors that weigh in favor of a finding of a likelihood of confusion.

We next turn to compare the marks in their entireties 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 Fondée 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).

Finally, where, as in the present case, the marks are used on identical goods (at least in part), the degree of similarity between the marks that 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 USPQ2d 1698 (Fed. Cir. 1992).

The marks share a common first word, PARK. Thus, the marks are somewhat similar in sound and appearance. Further, the examining attorney submitted dictionary definitions of the second words in the respective marks: "lane: narrow street; a narrow path, road or street, typically in older town areas or in the countryside, often enclosed by walls or hedges"; and "avenue: a wide street or road in a town." (www.encyarta.msn.com). Although the

words "avenue" and "lane" may have a vaguely similar meaning as identifying a type of street or road, the marks PARK AVENUE and PARK LANE, when considered in their entireties, nevertheless have different meanings and commercial impressions.

As often stated, the marks must be considered in their entireties, and when so compared, PARK AVENUE and PARK LANE as a whole take on different meanings and commercial impressions. In this connection, applicant introduced evidence bearing on these two commonly recognized locations, Park Avenue in New York City, and Park Lane in London. The following is of record: "Park Avenue: a wide thoroughfare extending north to south on the East Side of Manhattan Island. Traditionally associated with luxurious apartment houses, it is now the location of many high-rise commercial buildings." (www.answers.com); and "Park Lane: name of a street in the West End of London, running alongside Hyde Park, used allusively to refer to the wealthy and aristocratic lifestyle traditionally typified by it." (www.encyclopedia.com). Park Lane became a fashionable address from the eighteenth century onwards, offering both views across Hyde Park and a position at the most fashionable western edge of London. Park Lane is the second most valuable property in the London edition of the

MONOPOLY brand game, and has been the address of notable residents, such as the Duke of Westminster and the former owner of Harrods. (www.wikipedia.com).

The Board in the past has held that even if similar marks are used for the same goods, there may be no confusion as to source if the meanings and/or commercial impressions of the marks are different. See, e.g., *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear, with the term being suggestive of sportswear that "crosses over" the line between informal and more formal wear when applied to ladies' sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes, the Board finding that the term PLAYERS implies a fit, style, color, and durability adapted to outdoor activities when applied to shoes, but "implies something else, primarily indoors in nature," when applied to men's underwear); and *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing, the Board finding that the term connotes the drinking phrase "Drink Up" when applied to men's suits, coats, and trousers, but does not have this

connotation when applied to ladies' and children's underwear). We find this to be the case between the marks PARK AVENUE and PARK LANE. PARK AVENUE suggests a lifestyle for an address in New York City. See *Philip Morris, Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487 (TTAB 1990) (PARK AVENUE represents a certain "upscale, affluent" imagery and style; mark is used to suggest a sophisticated aura linked to that street associated with fashionable living in Manhattan). PARK LANE suggests sophistication associated with a fashionable address in London. Accordingly, we find that the marks PARK AVENUE and PARK LANE are different in meaning, and engender different overall commercial impressions. These differences outweigh any similarities in sound and appearance. See *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) (CRISTAL for champagne held not confusingly similar to CRYSTAL CREEK for wine); and *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992) (VARGAS GIRL for calendars held not confusingly similar to VARGAS for calendars).

In finding that the marks have different meanings and overall commercial impressions, we realize that consumers in this country may be more familiar with Park Avenue than

they are with Park Lane. But, their familiarity with Park Avenue, in itself, is likely to sufficiently distinguish the marks in terms of meaning and commercial impression.

We have considered applicant's evidence of third-party registrations, including PARK STREET for "industrial uniforms, namely, shirts" (RN 2073480); and PARK PLACE and design for clothing (RN 1219913). Suffice it to say, this evidence is of limited probative value to support applicant's position because "[t]he existence of [third-party] registrations is not evidence of what happens in the market place or that consumers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive." *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); and *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

Based on the record before us, we see the likelihood of confusion as amounting to only a speculative, theoretical possibility. Because of the differences between the marks PARK AVENUE and PARK LANE in meaning and overall commercial impression, we find that the examining attorney has not met his burden of establishing that confusion is likely to occur, even when identical goods are

involved. Language by our primary reviewing court is 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.