

This Opinion is not a
Precedent of the TTAB

Mailed: October 5, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re LaLa Berlin GmbH
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Serial No. 79153836
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Michael J. Bevilacqua and Barbara A. Barakat of Wilmer Cutler Pickering Hale and
Dorr LLP,
for LaLa Berlin GmbH.

Doritt Carroll, Law Office 116,
Christine Cooper, Managing Attorney.
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Before Quinn, Ritchie, and Wolfson,
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

LaLa Berlin GmbH (“Applicant”) seeks registration on the Principal Register of
the mark LALA BERLIN,¹ in standard characters, for, as relevant, “clothing for men,
women and children, namely, trousers, pants, dresses, skirts, blouses, tops, pullovers,
t-shirts, scarves, bottoms, jackets, sweaters, bathing suits, and swim trunks;

¹ Application Serial No. 79153836 was filed on July 28, 2014, under Section 66(a) of the
Trademark Act, 15 U.S.C. § 1141f, and disclaiming exclusive rights to the term “BERLIN”
apart from the mark as shown. The application contains goods in other classes which are not
subject to this refusal.

stockings; socks; headwear; underwear; nightwear; swimwear; bathrobes; belts; belts of leather; shawls; accessories, namely, headscarves, neckerchiefs, shoulder wraps; ties; gloves; shoes,” in International Class 25. The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, when applied to the identified goods, so resembles the previously registered mark, LALA,² also in standard character format, for “clothing and apparel, namely, undergarments and intimate apparel, namely, panties, brassieres, crop top, tank tops, pajamas and sleepwear,” also in International 25, as to be likely to cause confusion, mistake, or to deceive.

When the refusal was made final, Applicant appealed. For the reasons discussed below, we affirm the refusal to register.

I. Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all 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 Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, 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). *See also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

² Registration No. 2727844 issued June 17, 2003. Renewed.

We consider the *du Pont* factors for which arguments or evidence were presented. The other factors, we consider to be neutral.

Goods/Channels of Trade

We consider first the relatedness of the goods. The cited registration identifies various “undergarments and intimate apparel” including “panties, brassieres, crop top, tank tops, pajamas and sleepwear” while the application includes “underwear,” “tops” and “nightwear.” The “underwear” and the “tops” identified in the application are broad enough to encompass the more specific “panties, brassieres,” and “crop top, tank tops” identified in the cited registration, and the “nightwear” is broad enough to encompass the more specific “pajamas and sleepwear.” The goods are therefore legally identical. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012).

Because the goods named in the application and in the cited registration are legally identical, we must presume that the channels of trade and classes of purchasers for these goods are the same. *See In re Viterra Inc.*, 101 USPQ2d at 1908 (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). The trade channels would include boutiques and clothing sections of department stores, and purchasers would include ordinary consumers.

Applicant does not dispute the identity of the goods and the channels of trade, and we find that these *du Pont* factors weigh heavily in favor of finding a likelihood of consumer confusion.

The Similarity/Dissimilarity of the Marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In comparing the marks, we are mindful that 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 so that confusion as to the source of the services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Indeed, when, as here, the goods at issue are legally identical, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than if the goods were not as close. *In re Viterra Inc.*, 101 USPQ2d at 1912.

The mark in the cited registration is LALA. Applicant's mark incorporates in full the term "LALA" and adds the geographically descriptive term "BERLIN," which is disclaimed. We find the inherently distinctive term "LALA" to be the dominant term in Applicant's mark. *Id.*; See also *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ

749, 751 (Fed. Cir. 1985) (“[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.”). Furthermore, as our precedent dictates, the first term of Applicant’s mark, which is the term shared with Registrant’s mark, is the term “most likely to be impressed upon the mind of a purchaser and remembered.” *Presto Products, Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988); *see also Palm Bay Imports*, 73 USPQ2d at 1692. We thus find the marks as a whole to convey essentially identical meanings, with consumers likely to believe that Applicant’s LALA BERLIN is a variation on the LALA mark or an additional offering thereof, based in Berlin. The marks are also similar in sight, sound and overall commercial impression.

This first *du Pont* factor also weighs in favor of finding a likelihood of confusion.

Strength of the Mark

Applicant argues that the shared term “LALA” is commercially weak and that consumers will recognize subtle differences between the marks due to the number and nature of similar marks in use on similar goods. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); *Promark v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1244 (TTAB 2015) (“Such third-party registrations

and uses are competent to show that the common term has an accepted meaning in a given field and that marks containing the term have been registered and used for related goods because the remaining portions of the marks may be sufficient to distinguish the marks as a whole from one another.”).

In this regard, Applicant submitted evidence of five active, use-based registrations³ that contain the term “LALA” and are registered for similar clothing: LALALAND (Registration No. 4092191); OHLALA (Registration No. 4502561); Ookie & Lala (and design) (Registration No. 4539705); THE LALAS COUTURE (Registration No. 4465295, and disclaiming “couture”); and LALAWOW (Registration No. 4637013).

Evidence of extensive registration and use of a term by others can be “powerful” evidence of weakness. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 116 USPQ2d at 1136; *Juice Generation, Inc. v. GS Enters. LLC*, 115 USPQ2d at 1674. We note, however, that in *Juice Generation*, there were at least twenty-six relevant third-party uses or registrations of record, *see* 115 USPQ2d at 1672 n. 1, and in *Jack Wolfskin*, there were at least fourteen, 116 USPQ2d at 1136 n. 2. By comparison, a handful of use-based registrations is not very availing. We find this factor to be neutral. In any event, to the extent that consumers will look to slight differences in the marks, as noted

³ Applicant also submitted evidence of one cancelled registration for LA L.A. CONNECTION (and design) and two applications, one cancelled for LALA REBEL, and one for SOUS LALA. These have no probative value in our analysis. TBMP § 1208.02 (June 2016).

above, they are likely to perceive Applicant's LALA BERLIN as a variation on Registrant's LALA mark.

Consumer Sophistication and Degree of Purchaser Care

Applicant urges us to consider the consumer sophistication and degree of purchaser care likely to be exercised for the various types of clothing at issue in this proceeding. Applicant has not presented any evidence, however, that the consumers of these items will have a particular level of sophistication, or that the goods are of a particular price range. We must make our determination based on the least sophisticated consumer, and assume that the clothing at issue is of various qualities and prices. *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) (affirming that TTAB properly considered all potential investors for recited services, which included sophisticated investors, but that precedent requires consumer care for likelihood-of-confusion decision to be based “on the least sophisticated potential purchasers”). We find this factor to be neutral.

II. Conclusion

On balance, after considering all of the arguments and evidence of record as they pertain to the relevant *du Pont* factors, we find that the goods are legally identical and would travel through some of the same channels of trade to some of the same consumers, and that the marks, when viewed in their entirety, are also similar in sight, sound, connotation and commercial impression. Accordingly, we find a likelihood of confusion between the mark LALA BERLIN for which Applicant seeks registration in International Class 25, and the mark in the cited registration, LALA.

Decision: The refusal to register the goods in International Class 25 in Applicant's mark under Section 2(d) of the Trademark Act is affirmed.

The application will proceed to publication in International Classes 9 and 24.