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Subject: U.S. TRADEMARK APPLICATION NO. 85179243 - PRINCESS KATE - N/A - EXAMINER BRIEF -
Message 1 of 2

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85179243

MARK: PRINCESS KATE



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: NIEVES & NIEVES LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF PART ONE

The applicant, Nieves & Nieves, LLC, has appealed the final refusal to register the proposed mark PRINCESS KATE on the Principal Register. Registration is refused pursuant to Trademark Act Section 2(a), 15 U.S.C. §1052(a).

FACTS

On November 17, 2010, the applicant filed an application under §1(b) of the Trademark Act for the mark PRINCESS KATE. On February 27, 2011, the examining attorney issued an Office action requiring the applicant to amend the classification and identification of goods and services and to clarify whether the name Princess Kate identifies a particular living individual. On August 25, 2011, the applicant submitted an acceptably amended classification and identification of goods and services along with a statement denying that the proposed mark identifies a particular living individual. On September 7, 2011, the examining attorney approved publication for opposition of the proposed mark. On October 6, 2011, publication of the proposed mark was withdrawn because further review of the application found the proposed mark, ROYAL KATE, may falsely suggest a connection with Catherine, Duchess of Cambridge, the wife of Prince William of England. In addition, a second refusal was issued under Section 2(c) because the proposed mark was found to consist of or include a name, portrait, or signature identifying a particular living individual whose written consent to register the mark is not of record.

On October 26, 2011, the examining attorney issued an Office action refusing registration of the proposed mark under Sections 2(a) and 2(c) of the Trademark Act. On April 26, 2012, applicant submitted a response traversing both refusals. On June 8, 2012, the examining attorney issued a Final Office action continuing and making final the refusal of registration of the proposed mark under Sections 2(a) and 2(c) of the Trademark Act. The applicant subsequently filed a Notice of Appeal and Request for Reconsideration. The Request for Reconsideration was denied on May 18, 2013. The applicant filed its brief on July 17, 2013.

ISSUES

The two issues on appeal are whether the name PRINCESS KATE in the proposed mark falsely suggests a connection with Catherine, Duchess of Cambridge, the wife of Prince William of England, and whether the proposed mark consists of or includes a name, portrait, or signature identifying a particular living individual whose written consent to register the mark is not of record.

ARGUMENT

FALSE ASSOCIATION ANALYSIS

The Office can refuse registration of a mark that falsely suggests a connection with a famous person. Here, that person is Catherine, Duchess of Cambridge, nee Kate Middleton. Although she is not connected with the goods and services provided by applicant under the applied-for mark, Kate Middleton is so famous that consumers would presume a connection. Trademark Act Section 2(a), 15 U.S.C. §1052(a); see TMEP §§1203.03, 1203.03(e). See generally *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985).

The following is required for a showing of false connection under Trademark Act Section 2(a):

- (1) The mark sought to be registered is the same as, or a close approximation of, the name or identity previously used by another person or institution.

- (2) The mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution.

- (3) The person or institution identified in the mark is not connected with the goods sold or services performed by applicant under the mark.

- (4) The fame or reputation of the named person or institution is of such a nature that a connection with such person or institution would be presumed when applicant's mark is used on its goods and/or services.

In re Jackson Int'l Trading Co., 103 USPQ2d 1417, 1419 (TTAB 2012); *In re MC MC S.r.l.*, 88 USPQ2d 1378, 1379 (TTAB 2008); TMEP §1203.03(e); *see also Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1375-77, 217 USPQ 505, 508-10 (Fed. Cir. 1983) (providing foundational principles for the current four-part test used to determine the existence of a false connection).

Two terms comprise the entirety of the proposed mark, "PRINCESS" and "KATE." A combination of terms that, independent of each other would not falsely suggest a connection with another person or institution may do so when combined. *See, e.g., In re U.S. Bicentennial Soc'y*, 197 USPQ 905, 907 (TTAB 1978) (finding that while "U.S." alone and "BICENTENNIAL" alone may not imply involvement by the Federal Government in the sponsorship of applicant's goods, the combination of these two terms is "too slick to pass as a legitimate trademark" and falsely suggests a connection). Here, the examining attorney acknowledges that neither "PRINCESS" alone nor "KATE" alone may suggest the endorsement by or any other connection with Kate Middleton. It is the combination of the two terms, PRINCESS KATE, that falsely suggests such connection.

The term at issue need not be the actual, legal name of the party falsely associated with applicant's mark to be unregistrable. TMEP §1203.03(a); *see, e.g., Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429-30 (TTAB 1985) (holding the wording MARGARITAVILLE to be the persona of singer Jimmy Buffett). The term must, however, be so uniquely and unmistakably associated with the named party as to constitute that party's name or identity. TMEP §1203.03; *see, e.g., In re Cotter & Co.*, 228 USPQ 202, 204 (TTAB 1985); *Buffett*, 226 USPQ at 429.

In view of the weight of the evidence and facts of this case, the term PRINCESS KATE falsely suggests a connection with Kate Middleton, whose official title is Catherine, Duchess of Cambridge.

**PRINCESS KATE IS A CLOSE APPROXIMATION OF BOTH THE NAME AND IDENTITY PREVIOUSLY USED BY
KATE MIDDLETON, OFFICIALLY KNOWN AS CATHERINE, DUCHESS OF CAMBRIDGE.**

“Kate” is the name by which Catherine Middleton is known because she has used the name to identify herself and continues to use the name. Her friends and family, including her husband, Prince William, know her as Kate because that is the name she uses. Picking up on that name when her engagement to Prince William was announced, the media has and continues to use the name Kate in reference to Kate Middleton, even now when her official title is Catherine Duchess of Cambridge. Thus, both her own use of the name Kate and the subsequent media use of the name Kate has resulted in the public’s recognition of Kate as the name of the wife of Prince William.

Although there is no evidence to support Kate Middleton’s use of the term PRINCESS KATE in reference to herself, the media’s pervasive use of the term has created a widespread association of PRINCESS KATE with Kate Middleton. Applicant argues the first prong of the test for false association under Section 2(a) of the Trademark Act has not been satisfied because Kate Middleton hasn’t used the term PRINCESS KATE, although others and the media have done so. Evidence of Kate Middleton’s use of the term PRINCESS KATE is not required to satisfy the first prong of the test because there is ample evidence that she has consistently used the name KATE. Applicant next argues that the addition of the title “princess” to the name KATE does not result in any association with Kate Middleton.

First, adding a term to someone’s name does not render the combined terms something other than a name because Section 2(a) does not require the proposed mark to be the actual name of the person in question. The term at issue need not be the actual, legal name of the party falsely associated with applicant’s mark to be unregistrable. TMEP §1203.03(a); *see, e.g., Buffett v. Chi-Chi’s, Inc.*, 226 USPQ 428, 429-30 (TTAB 1985) (holding the wording MARGARITAVILLE to be the persona of singer Jimmy Buffett). The term must, however, be so uniquely and unmistakably associated with the named party as to constitute that party’s name or identity. TMEP §1203.03; *see, e.g., In re Cotter & Co.*, 228 USPQ 202, 204 (TTAB 1985); *Buffett*, 226 USPQ at 429.

Moreover, the first prong of the Section 2(a) test is silent as to what constitutes a person's "use" of the exact name that appears in a proposed mark. To the extent that Kate Middleton publically demonstrates her role as royalty, through public appearances as a representative of the royal family, sitting for her first official royal portrait now on displayed in London's National Portrait Gallery, and that she has given birth to Prince George, it cannot be denied that Kate Middleton has adopted the persona of PRINCESS KATE. Although applicant argues the meaning of "princess" differs sufficiently from that of "duchess" as to eliminate any association between Kate Middleton and goods bearing the mark PRINCESS KATE, the evidence proves otherwise. Just as in the matter of Section 2(e)1 descriptiveness refusals, that a word has meanings other than the one seemingly implied by its inclusion in a proposed mark bears little consideration. "That a term may have other meanings in different contexts is not controlling." *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e). In the context of the name "Kate," and the media storm surrounding Kate Middleton's engagement and subsequent marriage to Prince William, along with giving birth to Prince George, there would be little doubt that the proposed mark PRINCESS KATE used in connection with stylish luxury goods, refers to the stylish royal persona of Kate Middleton.

Applicant argues there can be no false association of Kate Middleton with goods bearing the mark PRINCESS KATE because Kate is not officially a princess; she is a duchess, Catherine Duchess of Cambridge. Applicant's argument is based on the premise that the public would never associate "princess" with "duchess," a dubious proposition especially here in the United States. There is no evidence to support the notion that the buying public in the United States is so well-versed in the nuances of British royal titles as to recognize their significance and differences. It is more likely that the public here would generalize titles such as princess and duchess into an overall grouping of royalty. Moreover, dictionary definitions of "princess" establish several generalized meanings of the term "princess." Dictionary definitions alone may be competent to demonstrate that the mark sought to be registered is the same as, or a close approximation of, the named person or institution. *See, e.g., In re Cotter & Co.*, 228 USPQ 202, 204-05 (TTAB 1985) (relying on dictionary definitions to find that "West Point" has "come to be solely associated with and points uniquely to the United States Military Academy").

The examining attorney asks the Board to take judicial notice of the attached online dictionary definitions for “princess.” See attached. The Trademark Trial and Appeal Board may take judicial notice of definitions obtained from dictionaries that (1) are available in a printed format, (2) are the electronic equivalent of a print reference work, or (3) have regular fixed editions. TBMP §1208.04; see Fed. R. Evid. 201; 37 C.F.R. §2.122(a); TMEP §710.01(c); see, e.g., *In re Dietrich*, 91 USPQ2d 1622, 1631 n.15 (TTAB 2009) (taking judicial notice of definition from Merriam-Webster Online Dictionary at www.merriam-webster.com); *In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1334 n.1 (TTAB 2009) (taking judicial notice of definition from Dictionary.com because from The Random House Unabridged Dictionary); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006) (taking judicial notice of definition from *Encarta Dictionary* because it is readily available in specifically denoted editions via the Internet and CD-ROM).

The attached definitions include the following from [Cambridge Advanced Learner's Dictionary & Thesaurus](#) © Cambridge University Press): “an important female member of a royal family, especially a daughter or granddaughter of a king and queen or the wife of a prince.” See attached. Also attached is a *Wikipedia* article found at http://en.wikipedia.org/wiki/Royal_family that includes the following definition of a royal family: “[a] royal family typically includes the spouse of the reigning monarch, surviving spouses of a deceased monarch, the children, grandchildren, brothers, sisters, and paternal cousins of the reigning monarch, as well as their spouses.” See attached. The online version of *The American Heritage Dictionary of the English Language* viewed September 17, 2013 at <http://www.yourdictionary.com/princess> defines “princess” as the wife of a prince, or a woman having the status or qualities of a princess. See attached.

The provided definitions are but a sampling of similar definitions of the term “princess.” In light of such definitions, it is unlikely the American public would readily differentiate between the titles “princess” and “duchess” in the context of trademark use. Thus, PRINCESS KATE readily identifies Kate Middleton, as she is the wife of a prince and bears the status and qualities of a princess.

Even if there is no evidence Kate Middleton uses the term PRINCESS KATE, evidence that she uses the name Kate and that the modifying term is justifiably associated with her satisfies the first prong of the

Section 2(a) test. The language of Section 2(a) is that the term in the mark must be the name or a close approximation of the name. Kate is the actual name Kate Middleton uses and the wording “princess” added to Kate results in a close approximation of the name she uses. Registration was refused for the proposed mark BO BALL for use in connection with a sports ball that combines a baseball and football. The mark was found to make a false connection with Bo Jackson, a famous football and baseball player. *In re Sauer*, 27 USPQ2d 1073 (TTAB 1993), *aff'd*, 26 F.3d 140 (Fed. Cir. 1994) (registration of BO BALL for oblong shaped leather ball with white stitching properly refused under §2(a), since use of "Bo" would be recognized by purchasers as reference to football and baseball player Bo Jackson, and there was no connection between Jackson and applicant). That record is devoid of any evidence that Bo Jackson used the name Bo Ball. Indeed, a party’s interest in a name or designation does not depend on adoption and use as a technical trademark or trade name. *Univ. of Notre Dame du Lac*, 703 F.2d at 1375-77, 217 USPQ at 508-09.

**PRINCESS KATE WOULD BE RECOGNIZED AS A REFERENCE TO KATE MIDDLETON BECAUSE IT POINTS
UNIQUELY AND UNMISTAKENLY TO HER**

November 16, 2010 is a significant date for not only British citizens, but for much of the world. On that day Prince William and Kate Middleton announced their engagement. There is irrefutable evidence that Kate Middleton’s name has garnered international media attention from that day to the present - media attention that isn’t limited to any particular segment of the media. The examining attorney submitted ample evidence from diverse sources showing use of the term PRINCESS KATE in articles about Kate Middleton. Specifically, beginning with the October 26, 2011 Office action and concluding with the May 18, 2013 refusal to reconsider the Section 2(a) refusal, the examining attorney has submitted more than 40 articles that refer to Kate Middleton as PRINCESS KATE.

The dates are significant as they mark the day the couple became engaged and cover the period of time during which they couple was married and Kate was pregnant. Recognition of such major life events is important in evaluating the degree to which the public has been influenced by a name. The public was first introduced to the girlfriend, then fiancé and now wife of the future king of England. Each year since her engagement to Prince William, Kate Middleton has been a focus of the media. The coverage ranges

from her family history, to her favorite jeans, visits to the supermarket, and her favorite candles. That Princess Kate wore a blue Alexander McQueen dress to the Queen's Thanksgiving services and used reward cards at Topshop appeared in headlines and blogs, talk shows and debates. The effect of such exposure is overwhelming public awareness of Kate as Princess Kate.

The media coverage of what a beautiful young royal chooses to wear, eat and use creates an unmistakable association of the name Kate in connection with any related type of marketed goods, from clothing and skin care products to candles and home furnishings. The media scrutiny of this women has created a celebrity not simply because of her sense of style, but because she is perceived as the embodiment of a princess. Thus, the name Kate used in connection with applicant's identified goods more than implies a connection with Kate Middleton, now Catherine Duchess of Cambridge. The connection is strong and unique in that the connection is not shared with any other well-known Kate. There is no evidence that PRINCESS KATE is associated with anybody other than Kate Middleton.

Such association is not driven by tabloid and fashion magazines and blogs alone. The examining attorney submitted evidence of frequent coverage by all types of media, including websites provided by attorneys. On January 12, 2011, trademark attorney Susan Perera contributed an article to *DUETSBLOG*, a blog identified as a forum for "collaborations in creativity and law." The article reports on the Royal Family's warning issued to United Kingdom designers that "use of Kate's full name on a fashion label would be in violation of UK trademark and copyright laws." The article goes on to discuss "a rush to trademark [Kate's name.]" The author refers to applicant's application for PRINCESS KATE for use in connection with "clothing, shoes, bags, accessories, and household linens, filed November 17, 2010" as an example of attempts to profit from Kate's celebrity. The application is presented as an example of applications for marks that don't use Kate's full name, but make apparent that PRINCESS KATE refers to Kate Middleton. That assertion is "further supported by the filing date of [the application], one day after the announcement of William and Kate's engagement."

When applicant filed its application is significant when considering whether purchasers would uniquely and unmistakably perceive PRINCESS KATE as a reference to Kate Middleton. The official announcement

of Kate's engagement to Princess William was made on November 16, 2010. Applicant filed its application the following day. That timing appears to be more than coincidence. Business has long understood the advantage of using celebrity endorsement to promote goods. Section 2(a) is intended to guard the public against false association that contributes to the purchase of one brand over another. Moreover, although applicant argues that Kate's celebrity has diminished since the filing of its application and that the wording "princess" is no longer used in connection with her name, the evidence proves otherwise. On December 3, 2012, the royal couple officially announced Kate's pregnancy, fanning the flames of already intense public awareness of PRINCESS KATE as Kate Middleton. The announcement itself reinforced the association:

Their Royal Highnesses The Duke and Duchess of Cambridge are very pleased to announce that The Duchess of Cambridge is expecting a baby. The Queen, The Duke of Edinburgh, The Prince of Wales, The Duchess of Cornwall and Prince Harry and members of both families are delighted with the news."

Applicant observes that although some may argue that PRINCESS KATE may be "reasonably understood as referring to Kate Middleton, Duchess of Cambridge, it is not a close approximation of her name because PRINCESS is not a part of Middleton's name or title." When Kate is frequently referred to as "princess," or identified as PRINCESS KATE, the inclusion of "princess" in her actual name or title is not dispositive. The question is not whether the actual full name in question is part of the mark, but whether the actual parts of the mark cause the public to associate the mark with the actual name.

Finally, applicant argues against "the use of news articles to decipher [sic] whether or not the public perceives" Kate Middleton as PRINCESS KATE because "such use does not yield conclusive results". The media may or may not be the source of the name PRINCESS KATE, but use of the name would not be sustained over more than three years if the public did not understand the reference. The function of news articles is to inform the public. And the business of news is dependent upon the public's continued use of news articles to gather information. Were PRINCESS KATE an ambiguous moniker, it would not achieve the purpose of providing information about a public figure.

KATE MIDDLETON IS NOT CONNECTED WITH THE GOODS SOLD BY APPLICANT

Applicant concedes that Kate Middleton, now Catherine, Duchess of Cambridge, is not connected with the goods sold by applicant under its mark.

THE FAME OR REPUTATION OF KATE MIDDLETON IS OF SUCH A NATURE THAT A CONNECTION WITH HER WOULD BE PRESUMED WHEN APPLICANT'S MARK IS USED ON ITS GOODS

If applicant's goods and/or services are of a type that the named person or institution sells or uses, and the named party is sufficiently famous, then it may be inferred that purchasers of the goods and/or services would be misled into making a false connection of sponsorship, approval, support or the like with the named party. *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985); *In re Nat'l Intelligence Acad.*, 190 USPQ 570 (TTAB 1976).

The fact that purchasers would realize, at some point after purchase, that no connection exists between the listed goods and/or services and the person or institution falsely connected, is not relevant. The focus is on "the initial reaction or impact of the mark when viewed in conjunction with the applicable goods or services." *In re U.S. Bicentennial Soc'y*, 197 USPQ 905, 906 (TTAB 1978) (internal punctuation omitted) (quoting *In re Nat'l Intelligence Acad.*, 190 USPQ 570, 572 (TTAB 1976)).

All of applicant's identified goods are of the type used by Princess Kate/Kate Middleton. The evidence shows she is a style setter and that the initial reaction of those viewing applicant's goods would connect the proposed mark, PRINCESS KATE, to the woman they perceive as Princess Kate, Kate Middleton, the Duchess of Cambridge. Attached to the prior Office actions are screenshots from websites showing use of the name "Princess Kate" in reference to Kate Middleton. That "Princess Kate" is commonly used to identify Kate Middleton is evident in the following excerpt from that evidence, the first from a transcript of a televised show:

And when I look at their popularity in America, it's in a different vein. Kate is on the front cover of numerous magazines. NICK WATT (ABC NEWS)

(Voiceover) **The palace suits insists she's a duchess, not a princess, and they say we must call her Catherine, not Kate. Forget it, chaps. Princess Kate, that's her**

handle and she wears it well. [emphasis added]. ABC TV show televised April 27, 2012.

The above excerpt from a recent television show, aired on one of the three major broadcasting networks in the United States, speaks to the strongly held public perception of Kate Middleton as a princess. Notable is the date the show was aired, more than a year following the royal wedding. This firmly establishes that Kate Middleton's fame continues and will continue to do so. The public's reaction to Kate Middleton's royal marriage is not a fleeting one, limited to the time immediately preceding and following the wedding. Also evident in many of the articles is Princess Kate's impact on the fashion world. Many of the articles relate to her clothing and how the public looks to her as a style setter.

The evidence shows that from the time the relationship between Kate Middleton and Prince William became known in 2006, the media has provided coverage of what Kate Middleton wears. Even her most casual outfits are well-documented, and much is made of her fashion sense. Thus, it is likely purchasers

of clothing, makeup, jewelry, home goods and other goods bearing the mark PRINCESS KATE will mistakenly believe the goods are in some way endorsed by Kate Middleton.

Here, the examining attorney relies on evidence in the form of articles, websites and blogs about Kate Middleton to demonstrate that she uses the type of goods identified by applicant. The following are excerpts from evidence submitted with the Office actions issued October 27, 2011 and June 30, 2012:

On March 26, 2012, the *San Jose Mercury News* reported on Princess Kate's impact on the jeans market: "After Princess Kate wore coral-colored jeans recently, look for that to be the shade of the moment."

On November 26, 2010, *Drapers – The Fashion Business* reported on Kate Middleton's influence on purchasers. "Over-30s will worship Princess Kate. The Princess Kate effect is already in full swing. Tesco's [low-price] interpretation of the oh-so-demure navy Issa dress that the future queen wore to announce her engagement sold out within an hour of it hitting the retailer's transactional clothing website."

On April 17, 2011, *AFP – Relax News*, reported on London's role as the fashion capital of the world. "'We are seeing what the impact of two media stars, Princess Kate and Alexander McQueen, can have upon a global ranking. Our numbers show it was their presence that tipped the victory London over New York,' said Bekka Payack, the Manhattan-based fashion editor of the *Globe Language Monitor*."

On May 18, 2012, *CNN.com* reported on a visit by Kate to a preview of the Lucian Freud show that gave a comprehensive view of the great artist. The report states, "The royal [Kate] stepped from her chauffeur-driven car wearing a dress by Jesire, a high-street clothing range - a double breasted, 1950's-style grey gown in a marbled pattern."

In a July 9, 2011 article for *The National Post* (f/k/a *The Financial Post*) of Canada, John Moore commented on the media's coverage of the royal couple's visit to Canada: "Many otherwise sober members of our media may have drunk a little too deeply of the Royal wine. Whole paragraphs were dedicated to the full sweep of Kate's daily ensembles. She wore . . . an Alexander McQueen sailor-inspired frock, something by Malene Birger, a pair of super dark wash J. Brand (jeans) and a pair of Pied a Terre black wedges (shoes)."

On May 5, 2011, MSNBC.com reported that the "royal Kate" was spotted shopping for her own groceries. Kate was wearing "simple skinny jeans and a loose shawl" and was seen checking out the vegetable aisle and "hovering over a case containing fresh pizzas."

"From "Berkshire to Buckingham" is "A Facebook Page for the Duchess of Cambridge's Style." On October 14, 2011, it posted a photo of Kate wearing a red gown. The caption for the photo is "Daring Dress for Royal Kate."

On May 31, 2011, Bloomberg News ran an article with the headline "Royal Kate Leads the Way With Sapphire Ring." The article discussed the growing popularity of sapphire engagement rings.

On August 23, 2011, *The Tropic Post* ran an article with the headline "Royal Kate Wins Hearts." It reported on Kate's visit with "a little cancer victim child." Along with a photo of Kate hugging the child, the article included photos and descriptions of outfits Kate wore.

The website www.instantmoneytrick.com ran an article titled "Scented Candles Loved by Royal Kate Middleton."

Other submitted articles discuss Princess Kate's attendance at fashion shows, her shopping trips, and exacting descriptions of what she wears to even casual events: ". . . a mossy green Ralph Lauren..." The examining attorney does not dispute Kate Middleton's official title; she is the Duchess of Cambridge. But the general public knows her as Princess Kate and it is the public's perception that determines whether there is association with the name. That public awareness is significant in that Princess Kate appeared on many lists of the most influential people of 2011. *See evidence submitted June 8, 2012.* Her degree of fame is firmly established as is her influence on style, which is now entrenched in our popular culture.

Applicant points to several published marks as being analogous to its own in that the marks include the term "princess" along with the name of a living individual. Specifically, applicant references a series of applications for the mark PRINCESS VERA WANG. The issue, however, is not whether Vera Wang is an actual princess, but that she is a famous living individual who, most significant to this analysis, has provided her consent to the use of her name in connection with the identified goods and/or services. The consent is of record on each of the registrations. In contrast, applicant does not have the approval of Kate Middleton. Thus, the proposed mark is distinguished from those referenced by applicant in that any connection made with Kate Middleton is a false connection, whereas the connection to Vera Wang is true.

Applicant also references a line of PRINCESS MARCELLA BORGHESE applications and registrations. One of the registrations is Registration No. 1132028 for the mark PRINCESS MARCELLA BORGHESE for use in connection with cosmetics. The mark registered in 1980 and has since cancelled, but at the time of registration, Princess Marcella Borghese was alive and her consent to use her name is of record. Accordingly, any connection made with her was an accurate one. The recent applications do not have, nor require, her consent as she is no longer alive. Thus, the statement that the proposed Borghese marks do not include the name of a living individual precludes the issue of false association. The woman known as Princess Kate, however, is alive. And there is compelling evidence that the general public recognizes Kate Middleton as Princess Kate.

Applicant does not dispute that Kate Middleton is a well-known figure, but argues there is no evidence to support the assertion that a connection with PRINCESS KATE would be presumed when the proposed mark is used on applicant's goods because "the evidence submitted in support of this assertion is immaterial." In the absence of market surveys using actual purchasers to consider applicant's identified goods bearing the mark PRINCESS KATE, there is no absolute evidence of how purchasers would perceive the mark in the marketplace. But the examining attorney has submitted evidence, samples of which are provided above, that supports the presumption that purchasers would erroneously assume a connection between Kate Middleton and stylish, fashionable, goods of high quality bearing the mark PRINCESS KATE. Applicant argues purchasers won't make the connection because Kate Middleton is not involved in any of the relevant industries. But Section 2(a) does not require the named person to produce or sell the relevant goods. If applicant's goods and/or services are of a type that the named person sells **or uses**, and the named party is sufficiently famous, then it may be inferred that purchasers of the goods and/or services would be misled into making a false connection of sponsorship, approval, support or the like with the named party. *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985); *In re Nat'l Intelligence Acad.*, 190 USPQ 570 (TTAB 1976).

CONCLUSION

Based on the evidence of record, and for the reasons stated above, the examining attorney respectfully submits that the proposed mark, PRINCESS KATE, when used in connection with cosmetics, skin care products, fragrances, jewelry, leather goods, bed linens, towels and/or apparel falls within the purview of Section 2(a) of the Trademark Act, and registration of the proposed mark must be denied. The examining attorney respectfully requests that the Board affirm the false association refusal.

The applicant, Nieves & Nieves, LLC, has appealed the final refusal to register the proposed mark PRINCESS KATE on the Principal Register. Registration is refused pursuant to Trademark Act Section 2(c), 15 U.S.C. §1052(c).

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ARGUMENT

TRADEMARK ACT SECTION 2(c) ANALYSIS

Registration is refused because the applied-for mark consists of or includes a name, portrait, or signature identifying a particular living individual whose written consent to register the mark is not of record. Trademark Act Section 2(c), 15 U.S.C. §1052(c); TMEP §1206; *see, e.g., In re Hoefflin*, 97 USPQ2d 1174 (TTAB 2010).

For purposes of Section 2(c), a name in a mark identifies a particular living individual if the person bearing the name will be associated with the mark as used on the goods or services because he or she (1) is “so well known that the public would reasonably assume [a] connection” or (2) is “publicly connected with the business in which the mark is being used.” *In re Hoefflin*, 97 USPQ2d 1174, 1175-76 (TTAB 2010); *see also Krause v. Krause Publ’ns, Inc.*, 76 USPQ2d 1904, 1909-10 (TTAB 2005); *In re Sauer*, 27 USPQ2d 1073, 1075 (TTAB 1994).

A determination that a person is publicly connected with the business in which the mark is being used may be based on evidence that he or she is well known in the relevant field of goods or services, is associated with the entity using the mark (e.g., the named individual is a corporate officer or partner of the applicant), and/or is actually connected to the goods or services at issue (e.g., the named individual invented the identified goods in the application). *See Krause v. Krause Publ’ns Inc.*, 76 USPQ2d 1904,

1909-10 (TTAB 2005); *In re New John Nissen Mannequins*, 227 USPQ 569, 570 (TTAB 1985); *Reed v. Bakers Eng'g & Equip. Co.*, 100 USPQ 196, 199-200 (PTO 1954); TMEP §1206.02.

Section 2(c) applies not only to full names, but also to any first name, surname, shortened name, pseudonym, stage name, title, or nickname that identifies a particular living individual. *See In re Hoefflin*, 97 USPQ2d 1174, 1177-78 (TTAB 2010) (holding registration of the marks OBAMA PAJAMA, OBAMA BAHAMA PAJAMAS, and BARACK'S JOCKS DRESS TO THE LEFT barred under Section 2(c) in the absence of consent to register, because the marks create a direct association with President Barack Obama); *In re Sauer*, 27 USPQ2d 1073, 1074-75 (TTAB 1993) (holding registration of a mark containing BO, used in connection with a sports ball, barred under Section 2(c) in the absence of consent to register, because BO is the nickname of a well-known athlete and thus use of the mark would lead to the assumption that he was associated with the goods), *aff'd per curiam*, 26 F.3d 140 (Fed. Cir. 1994); *In re Steak & Ale Rests. of Am., Inc.*, 185 USPQ 447, 448 (TTAB 1975) (affirming a Section 2(c) refusal of the mark PRINCE CHARLES because the wording identifies a particular well-known living individual whose consent was not of record).

The fact that a mark also contains other matter, in addition to a name, portrait, or signature, does not alter the requirement for written consent to register from the identified individual. *See Reed v. Bakers Eng'g & Equip. Co.*, 100 USPQ 196, 199 (PTO 1954).

The mere existence of other individuals with the same name does not alter the requirement for a written consent to registration if the applied-for mark identifies, to the relevant public, a particular living individual who is well known or is publicly connected with the business in which the mark is used. *See In re Steak & Ale Rests. of Am., Inc.*, 185 USPQ 447, 447-48 (TTAB 1975).

In view of the evidence and the facts of this case, the proposed mark, ROYAL KATE, identifies a particular living individual whose written consent to register is not of record.

THE NAME PRINCESS KATE IDENTIFIES CATHERINE, DUCHESS OF CAMBRIDGE, nee KATE MIDDLETON, BECAUSE SHE IS SO WELL KNOWN THAT THE PUBLIC WOULD REASONABLY ASSUME A CONNECTION.

For purposes of Section 2(c), a name in a mark identifies a particular living individual if the person bearing the name will be associated with the mark as used on the goods or services because he or she (1) is “so well known that the public would reasonably assume [a] connection” or (2) is “publicly connected with the business in which the mark is being used.” *In re Hoefflin*, 97 USPQ2d 1174, 1175-76 (TTAB 2010); *see also Krause v. Krause Publ’ns, Inc.*, 76 USPQ2d 1904, 1909-10 (TTAB 2005); *In re Sauer*, 27 USPQ2d 1073, 1075 (TTAB 1994).

Applicant argues the Duchess of Cambridge was not publicly connected with the business of clothing, makeup, home goods and the like at the time of the application’s filing. On October 27, 2011 and June 8, 2012, the examining attorney issued Office actions in which she submitted evidence to the contrary. Applicant filed its application on November 17, 2010, the day after Prince William announced his engagement to Kate Middleton. Thus, at the time of the application’s filing, Kate Middleton was perhaps the most famous bride-to-be in the world. The media long anticipated the official announcement of the engagement of the widely covered couple. Evidence of the wait is found in an article from the *Ottawa Tribune*, dated November 10, 2010. The headline reads: “The royal Kate wait; Rumours of an imminent engagement to Prince William are multiplying, but in Kate Middleton’s home village the locals are certain of one thing only: He’d be lucky to have her as his wife.” The article makes reference to the couple’s eight-year courtship that was often followed by the media, as well as to Kate’s work experience, which includes “a brief stint working as an accessories buyer for the clothing chain Jigsaw.”

Therefore, strictly speaking, applicant is correct that the “Duchess of Cambridge” was not publicly connected with the business of clothing, makeup, home goods and the like at the time of the application’s filing.” But the evidence shows Kate Middleton, even two years after her

marriage into the royal family, is commonly known as Kate. That the name in question was not connected with the relevant business at the time of applicant's filing is not dispositive. First, Section 2(c) does not require the named person be connected to the business at any time. Second, the Trademark Act clearly describes two ways of establishing that the name in a mark identifies a particular living individual. The person bearing the name will be associated with the mark as used on the goods or services because he or she (1) is "so well known that the public would reasonably assume [a] connection" *or* (2) is "publicly connected with the business in which the mark is being used." [Emphasis added].

Applicant concedes the Duchess of Cambridge is a well-known figure but relies upon the second option for establishing the name in the mark is not that of a particular living individual whose consent to register is not of record. Because Kate Middleton's fame is the crux of the case, it bears repeating that the examining attorney satisfies the Section 2(c) requirement by providing evidence that Kate Middleton is so well known that the public would reasonably assume a connection.

The evidence provided above to support the Section 2(a) refusal applies to the Section 2(c) refusal, as well. A determination that a person is publicly connected with the business in which the mark is being used may be evidence that he or she is well known in the relevant field of goods or services, is associated with the entity using the mark (e.g., the named individual is a corporate officer or partner of the applicant), and/or is actually connected to the goods or services at issue (e.g., the named individual invented the identified goods in the application). *See Krause v. Krause publ'ns Inc.*, 76 USPQ2d 1904, 1909-10 (TTAB 2005); *In re New John Nissen Mannequins*, 227 USPQ 569, 570 (TTAB 1985); *Reed v. Bakers Eng'g & Equip. Co.*, 100 USPQ 196, 199-200 (PTO 1954); TMEP §1206.02.

Here, the evidence demonstrates that Kate Middleton is well known in the relevant fields of applicant's goods. That clothing stores, fashion designers, and jewelry makers monitor what Kate wears and uses establishes the renown of Kate Middleton in those fields. Furthermore, it is not only designers and purveyors of these goods that follow what she wears, but the general public as well. The evidence submitted includes screenshots of blogs and websites established

by the general public, the fans of Kate Middleton. Thus, there is no question of Kate Middleton's fame, as acknowledged by the applicant, and her fame is based in part on how she presents herself as a modern royal. She not only demonstrates style and taste but is a style setter, as reported by the media.

Applicant argues that PRINCESS KATE is not Kate Middleton's given or adopted name and that the name "Kate" is sufficiently popular to question whether the name refers to any particular living individual named "Kate." As explained above, Section 2(c) applies not only to full names, but also to any first name, surname, shortened name, pseudonym, stage name, title, or nickname that identifies a particular living individual. Moreover, the mere existence of other individuals with the same name does not alter the requirement for a written consent to registration if the applied-for mark identifies, to the relevant public, a particular living individual who is well known or is publicly connected with the business in which the mark is used. *See In re Steak & Ale Rests. of Am., Inc.*, 185 USPQ 447, 447-48 (TTAB 1975). The proposed mark is "PRINCESS KATE," not "KATE." Applicant provides no evidence that any other living individual named Kate is understood to be PRINCESS KATE. The aforementioned evidence establishes that "KATE" is widely recognized and used as Catherine Middleton's nickname, which she has had since childhood. She is frequently referred to as PRINCESS KATE or "KATE" alone, without any reference at all to her surname.

The evidence submitted by the Examining Attorney establishes that Kate Middleton is internationally known as not only a member of the royal family, but as a major influence in the fields of fashion and beauty. Included in the evidence are articles that appear in newspapers, magazines and websites throughout many countries. Also included are screenshots from blogs, fanzines, and fan sites. These materials show that Kate Middleton is well known and has been and continues to be an arbiter of style.

The record is clear that Kate Middleton has achieved great fame as the wife of Prince William and mother to Prince George, so that when her nickname is used as part of the "PRINCESS KATE" mark on applicant's goods, purchasers will likely make a connection between her and applicant's products. The refusal under Section 2(a) of the Act is based on the contention that the

mark falsely suggests a connection with Kate Middleton, a member of the royal family. The refusal under Section 2(c) is based on the contention that the mark consists of the name identifying Kate Middleton, and thus cannot be registered by applicant without her written consent to registration. Purchasers of applicant's products would also recognize the name "KATE," as it appears in the mark on these goods, as Ms. Middleton's name. In the absence of a written consent from her, this runs afoul of Section 2(c) of the Act.

CONCLUSION

Based on the evidence of record, and for the reasons stated above, the examining attorney respectfully submits that the proposed mark, PRINCESS KATE, identifies a particular living individual whose consent to register is not of record and registration of the proposed mark must be denied. The examining attorney respectfully requests that the Board affirm the Section 2(c) refusal.

Respectfully submitted,

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princess (prɪn'ses )

Definitions

- noun**
- (in Britain) a daughter of the sovereign or of one of the sovereign's sons
 - a nonreigning female member of a sovereign family
 - the wife and consort of a prince
 - any very attractive or outstanding woman

Word Frequency 

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princess regent

Translations for 'princess'

British English: **princess** ♣️ A princess is a female member of a royal family, usually the daughter of a king or queen or the wife of a prince. The princess topped the guest list prn ses NOJIN

Arabic: **أميرة** ♣️ Brazilian Portuguese: **princesa** ♣️

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- Czech: **princezna** ♣️
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- Finnish: **prinsessa** ♣️
- German: **Prinzessin** ♣️ *Prinzessinnen*
- Italian: **principessa** ♣️
- Korean: **공주** ♣️
- Polish: **księżniczka** ♣️
- Romanian: **prințesă** ♣️ *prințese*
- Spanish: **princesa** ♣️
- Thai: **เจ้าหญิง** ♣️
- Ukrainian: **принцеса**
- Lebanese: **prinsesse** ♣️
- European Spanish: **princesa** ♣️
- French: **princesse** ♣️
- Greek: **πριγκίπισσα** ♣️
- Japanese: **王女** ♣️
- Norwegian: **prinsesse** ♣️
- Portuguese: **princesa** ♣️
- Russian: **принцесса** ♣️
- Swedish: **prinsessa** ♣️
- Turkish: **prinses** ♣️
- Vietnamese: **công chúa** ♣️

Example Sentences Including 'princess'

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GLUBE AND MAIL (2003)
I have too much to do to waste time playing games of intrigue with a Fardohyan princess.

Jennifer Fallon TREASON KEEP (2001)
In a humiliating, leaked letter to Sarah, the princess fumed. Never once have you hung your head in embarrassment.

GLASGOW HERALD (2002)
Maybe, like the toads in fairy tales, she would turn into a lascivious young princess.

Eric Newby A BOOK OF LANDS AND PEOPLES (2003)
Once upon a time, high on the mountains of Nepal, lived a beautiful princess with hair longer than the tallest of pine trees.

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INDIA TODAY (1998)
One of the things I learned in law school was, never cross a Jewish princess.
Val McDermid KICK BACK (2002)

All English words that begin with 'P'

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The goods were found at the home of neighbours, who told police they had bought them from the princess.
GLASGOW HERALD (2001)
The problem with that is that what works for a princess doesn't always work for humans.
GLOBE AND MAIL (2003)



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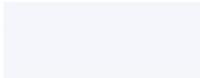
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