

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing:
November 21, 2013

Mailed:
November 29, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Steven Madden, Ltd.

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Serial No. 85313681

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Thomas M. Furth for Kudman Trachten Aloe LLP for Steven Madden, Ltd.

Zachary Bello, Trademark Examining Attorney, Law Office 111 (Robert Lorenzo,
Managing Attorney).

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Before Rogers, Grendel and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Steven Madden, Ltd. (“applicant”) filed an intent-to-use application to register the mark **Freebird by Steven**, in standard character form, for “shoes,” in Class 25.

The Trademark Examining Attorney refused to register applicant’s mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that applicant’s mark so resembles the previously registered mark FREE BIRD, in standard character form, for “A-shirts; Button-front aloha shirts; Camp shirts; Dress shirts; Golf shirts; Knit shirts; Long-sleeved shirts; Night shirts; Open-necked

shirts; Pique shirts; Polo shirts; Shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Pants; Lingerie; Jackets,” in Class 25, as to be likely to cause confusion.

Preliminary Issue

In its brief, applicant requested that the Board take judicial notice of the definition of the term “Free Bird” from the Wikipedia entry that it attached to its appeal brief. The Trademark Examining Attorney objected to applicant’s submission of the Wikipedia entry on the ground that the evidence was not timely filed. Further, the Trademark Examining Attorney argued that Wikipedia evidence is not the type of evidence of which the Board may take judicial notice.

In ex parte appeals, the Board may take judicial notice of such things as dictionary definitions, encyclopedia entries, standard reference works and commonly known facts. See authorities collected in TBMP §1208.04 (3d ed. rev.2 2013).

The Board addressed the admissibility of evidence derived from Wikipedia in *In re IP Carrier Consulting Group*, 84 USPQ2d 1028 (TTAB 2007).

There are inherent problems regarding the reliability of Wikipedia entries because Wikipedia is a collaborative website that permits anyone to edit the entries. See *in re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1475-1476 (TTAB 1999) (information retrieved from the Internet is probative to the extent that it is information available to the public, and of the way in which a term is used by the public, but the weight given to such evidence must be carefully evaluated because the source is often unknown). In fact, the “About Wikipedia” section of wikipedia.org warns users that articles can be edited by anyone with access to the Internet. That section

further explains that editors do not need any specialized qualifications to contribute. As a result, entries, especially newer entries and recent edits, may contain significant misinformation, false or debatable information, “unencyclopedic” content, unexpected oversights and omissions, vandalism, or unchecked information that requires removal. At any given time an article may be in the middle of an edit or controversial rewrite. The editors provide the following warning: “Therefore, a common conclusion is that it [Wikipedia] is a valuable resource and provides a good reference point on its subjects, but like any online source, unfamiliar information should be checked before relying on it.”

Id. at 1032 (Emphasis added). Because Wikipedia is a source whose accuracy may be questioned, it is not a source from which the Board may take judicial notice, and it must be offered into the record at a time when the non-offering party will have an opportunity to rebut the evidence. *Id.* at 1032 (“the Board will consider evidence taken from Wikipedia so long as the non-offering party has an opportunity to rebut that evidence by submitting other evidence that may call into question the accuracy of the particular Wikipedia information.”).

Also, Trademark Rule 2.142(d) provides the following:

The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may request the Board to suspend the appeal and to remand the application for further examination.

Accordingly, applicant’s evidence derived from Wikipedia and submitted for the first time with its brief was not timely filed, and was not offered at a time when the

examining attorney would have had a chance to rebut it, because Rule 2.142(d) bars the examining attorney from offering rebuttal evidence with his brief.

The objection is, therefore, sustained and we will not consider the evidence submitted with applicant's brief. Nevertheless, even if we had considered it, it would not have affected our decision.

Likelihood of Confusion

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, 567 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, 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, 29 (CCPA 1976). *See also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

A. The similarity or dissimilarity of the marks in their entirety in terms of appearance, sound, connotation and commercial impression.

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In comparing the marks, we are mindful 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 unpublished*, 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). As discussed below, since the applicant's goods are shoes and registrant's goods are shirts, pants, lingerie and jackets and neither description of goods has any limitations or restrictions, the average customer is an ordinary consumer.

Applicant's mark **Freebird by Steven** and the registered mark FREE BIRD are similar to the extent that they both include the term "Free Bird." The presence or absence of a space between applicant's display of "**Freebird**" and registrant's display of FREE BIRD is an inconsequential difference that even if noticed or remembered by consumers would not serve to distinguish these marks. *See, e.g., Seaguard Corp. v. Seaward International, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (SEA GUARD and SEAGUARD are "essentially identical"); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827 (TTAB 1984) ("there can be little doubt that the marks [BEEFMASTER for restaurant services and BEEF MASTER for frankfurters and bologna] are practically identical and indeed applicant has not

argued otherwise.) (Emphasis in the original). *See also Goodyear Tire & Rubber Company v. Dayco Corporation*, 201 USPQ 485, 489 n.4 (TTAB 1978) (“Fast-Finder” with hyphen is in legal contemplation substantially identical to “Fastfinder” without hyphen).

Applicant’s mark encompasses registrant’s entire mark FREE BIRD. In such circumstances, where the entirety of one mark is incorporated within another, likelihood of confusion often has been found. *See Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (applicant’s mark BENGAL LANCER for club soda, quinine water and ginger ale is likely to cause confusion with BENGAL for gin); *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (applicant’s mark EBONY DRUM for hairdressing and conditioner is likely to cause confusion with EBONY for cosmetics); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) (applicant’s mark HEAD START COSVETIC for vitamins for hair conditioners and shampoo is likely to cause confusion with HEAD START for men’s hair lotion and after-shaving lotion).

However, because the marks share the term “**Freebird**”/FREE BIRD, that in and of itself does not mean that the marks are similar. The similarity or dissimilarity of the marks is determined based on the marks in their entireties, and our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir.

1985). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 23, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion”). On the other hand, different features may be analyzed to determine whether the marks are similar. *Price Candy Company v. Gold Medal Candy Corporation*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). In fact, 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 a consideration of the marks in their entireties. *In re National Data Corp.*, 224 USPQ at 751.

We find that the term “**Freebird**” is the dominant element of applicant’s mark. Since it is the first part of applicant’s mark, it is that part of the mark which is most likely to catch the attention of consumers. *See Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). *See also Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

Moreover, in applicant's mark, **Freebird** would be seen as the product mark identifying the source of a specific item (*i.e.*, shoes), while "by Steven" would be seen as a house mark that may be used on a wide range of products manufactured by that entity. Consumers could well think that "**by Steven**" identifies the source of the FREE BIRD products or that registrant has licensed applicant to manufacture shoes under the **Freebird** brand. In other cases where an applicant has used a source modifier, such as "**by Steven**," with an otherwise registrable term, such as "**Freebird**," the Board has held that the source modifier does not distinguish the marks. *See In re Chica, Inc.*, 84 USPQ2d 1845, 1848-49 (TTAB 2007) (CORAZON BY CHICA v. CHICA: "BY CHICA" will be viewed as the identification of the previously anonymous source of the goods sold under the mark CORAZON); *Saks & Co. v. TFM Industries, Inc.*, 5 USPQ2d 1762, 1764 (TTAB 1987) (FOLIO v. FOLIO BY FIRE ISLANDER; "the use of the phrase BY FIRE ISLANDER may only tend to increase and not decrease the likelihood of confusion."); *In re Apparel Ventures, Inc.*, 229 USPQ 225, 226 (TTAB 1986) (SPARKS v. SPARKS by sassafras: "Those already familiar with registrant's use of its mark in connection with its goods, upon encountering applicant's mark on applicant's goods, could easily assume that 'sassafras' is some sort of house mark that may be used with only some of the SPARKS goods. Conversely, those familiar with only applicant's mark would, upon encountering the registered mark on related goods, assume that all SPARKS products come from a single source, and that source was in some instances further identified with the words 'by sassafras.'");

Nevertheless, applicant argues that the addition of the term “**by Steven**” is sufficient to distinguish the marks because Steven Madden is “almost synonymous with shoes.”¹ To corroborate its argument, applicant references the thirteen (13) registrations it made of record for STEVEN and STEVEN formative marks owned by applicant, and stories from general and fashion-oriented publications featuring extensive coverage of Steven Madden and his shoe designs and other business endeavors. Thus, applicant concludes that “[i]t is without question that consumers encountering FREEBIRD BY STEVEN as a mark for shoes will associate the mark with Steve Madden.”²

Applicant’s evidence and argument has some deficiencies. First, the registrations owned by applicant incorporating the name STEVEN are not evidence that consumers recognize the mark STEVEN as a reference to Steven Madden. Registrations are not evidence that marks are in use or that the public has become familiar with them. *Cf. Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office); *In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983).

Second, applicant’s evidence demonstrates that Steven Madden is a renowned shoe designer and entrepreneur; but there is no evidence that consumers seeing a mark incorporating the term “**by Steven**” in connection with clothing or shoes think of Steven Madden.

¹ Applicant’s Brief, p. 4.

² Applicant’s Brief, pp. 3-4.

Finally, even if the record showed that consumers associated “**by Steven**” with Steven Madden, the *du Pont* factors only list the fame of the prior mark (FREE BIRD) as relevant to our analysis. “A junior party’s fame cannot excuse likelihood of confusion created by its use of a mark similar to one already in use.” *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1602 (TTAB 2011), citing *In re Christian Dior SA*, 225 USPQ 533, 535 (TTAB 1985) (CACHET vs. LE CACHET DE DIOR: “those purchasers familiar with registrant’s ‘CACHET’ products would, upon encountering ‘LE CACHET DE DIOR’ shirts, assume that DIOR is the source of the CACHET products.”).

Applicant also argues that “when used in connection with women’s apparel, the term [FREE BIRD] is highly suggestive” and, thus, the addition of the source modifier “**by Steven**” is sufficient to distinguish the marks.³ Applicant’s argument regarding the distinctiveness of the term “FREE BIRD” is based on its reference to the lyrics of the Lynyrd Skynyrd song “Free Bird” which “refers to the relationships between men and women” and that the term “Bird” is British slang for a girl.”⁴ We disagree. First, British slang is not American slang and there is nothing in the record to prove that American consumers understand that the term “Bird” means girl. Second, even if the Lynyrd Skynyrd song “FREE BIRD” refers to the relationships between men and women, we fail to see how that has anything to do with shoes and clothing. We cannot conclude, in the absence of supporting

³ Applicant’s Brief, pp. 3-4.

⁴ Applicant’s Brief, p. 4.

evidence, that FREE BIRD is highly suggestive or that it is weak term when used in connection with shirts, pants, lingerie and jackets.

In view of the foregoing, we find that applicant's mark **Freebird by Steven** is similar to the mark FREE BIRD in terms of appearance, sound, meaning and commercial impression.

B. The similarity or dissimilarity and nature of the goods described in the application and the registration, the established likely-to-continue trade channels and classes of consumers.

Applicant is seeking to register its mark for "shoes." The registered mark is for shirts, pants, lingerie and jackets. The evidence demonstrating that shoes are related to shirts, pants, lingerie and jackets is sparse. However, applicant does not dispute the proposition that shoes can originate from the same source as other items of apparel.⁵

In the March 10, 2012 Office action, the Trademark Examining Attorney submitted the following evidence to show that shoes are related to shirts, pants, lingerie and jackets:

1. Registration Nos. 1097555 and 1168477 for the mark GUCCI for *inter alia* footwear and shirts.⁶ GUCCI is a well-known designer mark. Since it is well-recognized that designer marks can be used to identify a broad range of products,

⁵ Applicant's Brief, p. 6.

⁶ The Trademark Examining Attorney also submitted a copy of Registration No. 0078333 for the mark MACY'S (stylized) but shoes has been deleted from the description of goods. Because the description of goods does not include goods listed in both the application and registration, it has no probative value.

The Trademark Examining Attorney also submitted an excerpt from the GUCCI website displaying the sale of handbags and shoes. Because the excerpt does not show the sale of products in both the application and registration, it has no probative value.

the inclusion of shirts and footwear in the registrations is not particularly significant. *Cf. In re Donnay International, S.A.*, 31 USPQ2d 1953, 1954 n.3 (TTAB 1994) (registrations for house marks have little probative value in showing that goods are related); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (noting that large department stores sell a wide variety of goods and services and, therefore, registrations owned by department stores listing a wide variety of products have little probative value in showing that goods are related).

2. An excerpt from the Macy's website (macys.com) advertising a "weekend sale" for "shoes" and "women," "men," "juniors," and "kids" for which we presume means clothing for those groups. However, since the excerpt does not display any brands, the website does not show that shoes, pants, lingerie and jackets emanate from the same source. The website shows only that Macy's sells those products and, therefore, that the products move in the same channels of trade.

In the October 5, 2012 Office action, the Trademark Examining Attorney submitted the following evidence:⁷

1. Excerpts from the COLE HAAN website (colehaan.com) advertising the sale of footwear and jackets. However, there is no evidence that the footwear and jackets are identified by the same trademarks. It shows that the goods are sold in the same channels of trade.

⁷ The Trademark Examining Attorney submitted an excerpt from the StatMyWeb website (statemyweb.com) which provided statistical information about the Calvinklein.com website. The description of the website stated "shop calvin klein for women's and men's clothing, handbags, footwear, bedding, bath, dinnerware, and more." This website has very limited probative value because it does not actually show Calvin Klein offering the sale of any of these products or whether any of these products are sold under the same trademark.

2. Excerpts from the Michael Kors website (michaelkors.com) showing that Michael Kors sells women's and men's clothing and shoes. However, there is no evidence that the clothing and shoes are identified by the same trademarks. This website shows that the goods move in the same trade channels.

3. Excerpts from the John Varvatos website (johnvarvatos.com) showing that John Varvatos sells apparel and shoes. The excerpt shows that John Varvatos sells JOHN VARVATOS branded shirts, jackets, pants and shoes.

4. Excerpts from the Kate Spade website (katespade.com) showing the sale of shoes and clothing. However, there is no evidence that the clothing or shoes are identified by the same trademarks. The website shows that the goods move in the same trade channels.

5. Excerpts from the MARSHALL'S website (marshalls.com) showing the sale of shoes and clothing. However, there is no evidence that the clothing or shoes are identified by the same trademarks. The website shows that the goods move in the same trade channels.

6. Excerpts from the PUMA website (shop.puma.com) advertising the sale of shoes and hoodies. There is nothing that shows the sale of shirts, pants, lingerie or jackets.

7. Excerpts from the REEBOK website (shop.reebok.com) advertising the sale of shoes. There is nothing that shows the sale of shirts, pants, lingerie or jackets.

8. Excerpts from the Nordstrom website (Nordstrom.com) advertising the sale of Steven Madden shirts jackets and shoes. This evidence shows that applicant sells shirts, jackets and shoes.

In addition, applicant submitted the following evidence in its February 17, 2012 response to Office action that shows that applicant sells shoes and other items of apparel:

1. Registration No. 2856436 for the mark STEVEN for footwear; namely, sandals, shoes and boots; and clothing; namely, tee shirts, shirts, jackets, skirts, jeans, pants, dresses, coats, socks, undergarments and hats.

2. Applicant's website (stevemadden.com) states that applicant is expanding into apparel as well as shoes.

3. A March 3, 1997 article in brandweek.com reporting that applicant is "extending the brand in a range of new directions, including clothing – an unusual undertaking for a footwear manufacturer."

Madden, however, claims its core customer has already made the leap from shoe brand to clothes, via a series of T-shirts it designed and marketed in-house, made distinctive by their concept packaging and merchandising.

See also July 14, 1997 article in Newsday.com discussing applicant's expansion into designer sportswear and jeans.

We find it significant that applicant has expanded into apparel. This means that applicant is competing with the registrant. The same person may purchase **Freebird by Steven** shoes from applicant and later purchase FREE BIRD shirts, pants, lingerie or jackets, or vice versa. In either case, it is likely that the purchaser

will assume that there is a common source for shoes and apparel or an association between the sources of each because of the similarity of the marks. Thus, we find that applicant's shoes and registrant's shirts, pants, lingerie and jackets are related and that they may be sold to the same potential purchasers. In addition, the evidence also shows that shoes and other items of apparel are sold through the same channels of trade.

Applicant contends that applicant's shoes and registrant's apparel move in different channels of trade and are sold to different classes of consumers.

Applicant's evidence demonstrates that the goods offered by the Registrant, which are sold only via the internet and only to wholesalers who have registered on its website, are inexpensive items that are not sold in the same channels as Applicant's goods. Consumers are generally influenced by the price of a fashion item in assessing its quality. ... [R]egistrant's goods consist of inexpensive dresses, skirts and tops (no footwear) and they are not sold at prices that would lead to confusion among consumers when compared to the prices of [applicant's] merchandise. The average item on registrant's website sells for \$10-\$12 at wholesale. As shown in the evidence made of record by the Examining Attorney, the retail prices of [applicant's] shoes are often well in excess of \$100.⁸

The problem with applicant's argument is that this proceeding concerns applicant's right to registration of a trademark, and we cannot focus on applicant's actual circumstances relating to use of its trademark. Because the scope of the registration applicant seeks is defined by its application (and not by its actual use)

⁸ Applicant's Brief, p. 7.

it is the application (and not actual use) that we must look to in determining applicant's right to register:

The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom Syst. Inc. v. Houston Computers Svcs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Likewise, in considering the scope of the cited registration, we look to the registration itself, and not to extrinsic evidence about the registrant's actual goods, customers, or channels of trade. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), *citing Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139 (CCPA 1958). Because the description of goods in applicant's application and the description of goods in registrant's registration are not limited to any specific channels of trade or classes of consumers, it is presumed that the goods move in all the channels of trade normal for those goods and that they are available to all classes of purchasers for those goods. *See In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

Furthermore, we cannot resort to such extrinsic evidence to restrict the prices of applicant's or registrant's goods. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). We must presume that both

applicant's shoes and registrant's apparel would be sold at all the usual prices for such goods.

We find that applicant's shoes and registrant's shirts, pants, lingerie and jackets are related products that move in the same channels of trade and are sold to the same classes of consumers.

C. Balancing the factors.

Because the marks are similar and the goods are related and must be presumed to move in the same channels of trade and be sold to the same classes of consumers, we find that applicant's mark **Freebird by Steven** for shoes would be likely to cause confusion with the mark FREE BIRD for "A-shirts; Button-front aloha shirts; Camp shirts; Dress shirts; Golf shirts; Knit shirts; Long-sleeved shirts; Night shirts; Open-necked shirts; Pique shirts; Polo shirts; Shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Pants; Lingerie; Jackets.".

Decision: The refusal to register is affirmed.