

This Opinion is not a
Precedent of the TTAB

Mailed: November 16, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re My Other Bag Inc.

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Serial No. 85521133

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Brian J. Philpott and Gregory Z. Boger of Koppel Patrick Heybl & Philpott
for My Other Bag Inc.

Kathleen Lorenzo, Trademark Examining Attorney, Law Office 109,
Michael Kazazian, Managing Attorney.

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Before Lykos, Greenbaum and Adlin,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On January 20, 2012, My Other Bag Inc. (“Applicant”) filed an application to register on the Principal Register the mark **My Other Bag...** in standard characters for “tote bags” in International Class 18.¹

The Trademark Examining Attorney refused registration of 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 registered mark **THE OTHER BAG BY**

¹ Application Serial No. 85521133, filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging November 1, 2011 as the date of first use anywhere and November 28, 2011 as the date of first use in commerce. The application includes a disclaimer of the word “Bag” apart from the mark as shown.

ALDO also in standard characters for “[h]andbags, carry-all bags, clutch bags, cosmetic bags sold empty, messenger bags, shoe bags for travel, sports bags” in International Class 18,² that, when used on or in connection with Applicant’s identified goods, it is likely to cause confusion or mistake or to deceive.

When the refusal was made final, Applicant appealed and requested reconsideration, based primarily on its amendment of the identification of goods to “parodic canvas tote bags screen-printed with an artist’s cartoonish rendering of a well-known designer handbag.” The Trademark Examining Attorney accepted the amendment but maintained the refusal to register and denied the Request for Reconsideration. Thereafter, the appeal was resumed and is now fully briefed.

For the reasons set forth below, we affirm the Section 2(d) refusal.

Parody “Defense”

At the outset we address Applicant’s parody “defense” arguments and the significance, if any, of “parody”-based limitations to an identification of goods. Applicant argues that its mark is not confusingly similar to the registered mark because it is meant to be a “tongue-in-cheek statement on behalf of the owner that while this eco-conscious, reusable tote bag I’m carrying may not have cost me a fortune, ‘My Other Bag ...’ may have.” Applicant’s Brief, p. 5; 8 TTABVUE 6. Applicant also points to the amended identification of goods which specifically states that the tote bags bear a design consisting of a cartoonish rendering of a well-

² Registration No. 4363077, issued on July 9, 2013 on the Principal Register pursuant to Section 44(e) based on a Canadian registration. The registration includes a disclaimer of the word “BAG” apart from the mark as shown.

known designer handbag, which, as Applicant contends, constitutes a parody of the “ubiquitous” bumper sticker joke “My other car...is a Jaguar.” *Id.*

Applicant’s mere assertions regarding the “ubiquitous” nature of the bumper sticker joke “My other car is ...” are not supported by any evidence of consumer recognition of this phrase. The fact that a mark is intended to be a parody is not, by itself, sufficient to overcome a likelihood of confusion refusal. *See* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 31.153 (4th ed. 2010). Parody is a potential defense only if the involved marks otherwise would not be found confusingly similar, and as explained below, this is not the case here. *See Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1592 (TTAB 2008) (“In finding that the marks are not similar, we have given no weight to applicant’s argument that his mark is a parody. Parody is not a defense if the marks would otherwise be considered confusingly similar.”). We further note the guidance provided in *Research in Motion Ltd. v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1191-92 (TTAB 2012):

Applicants assert that they should prevail on the question of likelihood of confusion inasmuch as their mark is a parody of opposer’s mark. In some reported infringement cases from the federal courts, a successful parody seems to make confusion less likely. *See Hormel Foods Corp. v. Jim Henson Productions Inc.*, 73 F.3d 497, 37 USPQ2d 1516, 1519-22 (2d Cir. 1996) [Henson's use of “Spa’am” on merchandise for its “Muppet” movie is not likely to cause confusion with Hormel's SPAM mark for luncheon meat]. Furthermore, when federal courts are dealing with questions of alleged infringement, the protective penumbra of free speech may well support the premise that members of the public have a right to use words in the English language to interest and amuse other persons. However, when this Board is asked the narrower question of applicants’ right to *registration* under Section 2(d) of the Lanham Act, the First Amendment claim is not as strong as with issues of restraint on *use*. The center of

balance changes even further when the risk of confusion of source, affiliation, approval, or endorsement by the source of the known expression outweighs the newcomer's claim to the right to adopt and register a humorous moniker. Especially if we should find under the du Pont factors that the respective goods and services are not readily distinguishable, that they might be targeted to the same consumers through overlapping trade channels, and in the event that prospective purchasers of applicants' goods and services might well believe that both parties' goods and services come from the same source, then the likelihood of confusion will usually trump any First Amendment concerns.

(emphasis added). Nothing in the record points to why Applicant's so-called parody should trump likelihood of confusion as to the source of the goods.

In addition, Applicant's attempt to limit the nature of its goods is futile. We cannot conclude based on the amended identification that consumers are less likely to be confused as to source. *Cf. In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1410 (TTAB 2015) ("The language 'associated with William Adams, professionally known as 'will.i.am' is precatory language, and not binding on consumers when they encounter Applicant's mark.").

For all of the aforementioned reasons, Applicant's arguments that its applied-for mark constitutes a parody or that the goods themselves embody the concept of parody are unavailing.

Likelihood of Confusion Analysis

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*"). See also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (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 In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The Marks

We commence with the first *du Pont* likelihood of confusion factor which involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007)). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Binion*, 93 USPQ2d 1531 (TTAB 2009); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Our analysis cannot be predicated on dissection of the involved marks. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). Rather, we are obliged to consider the marks in their entireties. *Id. See also Franklin Mint Corp. v. Master Mfg. Co.*,

667 F.2d 1005, 212 USPQ 233, 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.”).

Applicant argues that because the marks begin with different words, “MY” and “THE,” and because Registrant’s mark includes the wording “BY ALDO,” the appearance, sound, connotation and commercial impression of the marks are very different. Applicant contends that the last portion of the cited mark, “BY ALDO,” is the dominant feature, because it is an explicit designation of source, leaving the most impactful impression to the consumer reading or hearing the mark.

Applicant’s arguments are unconvincing. With regard to the registered mark, we note the well-established principle that in reaching a conclusion on the issue of likelihood 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 a consideration of the marks in their entirety. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Stone Lion*, 110 USPQ2d at 1161. Applying this principle, we find the initial phrase “THE OTHER BAG” to be the dominant feature of Registrant’s mark. The remaining wording “BY ALDO” is more likely to be perceived by consumers as a tag line or house mark, and as such, fails to obviate the likelihood of confusion. *See In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366-67 (TTAB 2007) (finding CLUB PALMS MVP and MVP confusingly similar); *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985) (finding LE CACHET DE DIOR and

CACHET confusingly similar); *In re Chica, Inc.*, 84 USPQ2d 1845, 1848-49 (TTAB 2007) (holding CORAZON BY CHICA with design, and CORAZON with design, both for jewelry, likely to cause confusion, noting that, “to many consumers, applicant’s mark for the identical word ‘Corazon’ followed by the phrase ‘BY CHICA’ will simply be viewed as the identification of the previously anonymous source of the goods sold under the mark CORAZON”). Furthermore, the first part of a mark is often dominant, as it is here given the likely perception of BY ALDO. *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). *See also Palm Bay*, 73 USPQ2d at 1692.

While the possessive determiner “MY” in Applicant’s mark and the definite article “THE” in Registrant’s mark may sound different and have different meanings, their significance is minimized by the subsequent, identical and more distinctive phrase “OTHER BAG,” notwithstanding Applicant’s and Registrant’s disclaimers of the word “bag.” Both marks imply that their respective bags are distinct from a previously known bag, as if to say – “not this one, but that one.” Thus, although Applicant’s and Registrant’s marks may have some recognizable differences in sight and sound, there are also similarities in connotation, and, ultimately, overall commercial impression. The first *du Pont* factor therefore weighs in favor of finding a likelihood of confusion.

The Goods

The next step in our analysis is a comparison of the goods identified in Applicant’s application vis-à-vis the goods identified in the cited registration, the

second *du Pont* factor. See *Stone Lion*, 110 USPQ2d at 1161; *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). Both Applicant's and Registrant's goods are highly similar in nature, if not identical, and Applicant does not contend otherwise. In addition, the Examining Attorney has made of record numerous third-party, used-based registrations identifying both one or more of Registrant's enumerated items "[h]andbags, carry-all bags, clutch bags, cosmetic bags sold empty, messenger bags, shoe bags for travel, sports bags," and "tote bags," which by definition may encompass Applicant's more narrowly identified "parodic canvas tote bags screen-printed with an artist's cartoonish rendering of a well-known designer handbag." See Office Action dated December 27, 2013 (Reg. Nos. 4147166, 4179954, 4218431, 4144011, 4429661, 4452293, 4417445, 4425101, and 4454305). As a general proposition, although third-party registrations alone are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless may have probative value to the extent they are based on use in commerce and may serve to suggest that the goods are of a kind that emanate from a single source. See *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

Further, Registrant's goods are unrestricted and therefore we must assume that these related items could also include "parodic" designs similar to those displayed

on Applicant's goods. The Examining Attorney also provided evidence from the Kate Spade online retail site offering for sale tote bags with whimsical designs as well as clutch bags. *See* Denial of Request for Reconsideration dated March 23, 2015 (excerpts obtained from www.katespade.com). This evidence further suggests that prospective consumers may be accustomed to simultaneously encountering these items in the marketplace under the same mark.

In view of the evidence of record, we find that the goods identified in the application and registration are related. As such, the second *du Pont* factor also weighs in favor of finding a likelihood of confusion.

Conclusion

After considering all of the evidence properly of record and arguments pertaining to the *du Pont* likelihood of confusion factors, both the first and second *du Pont* factors discussed above favor a finding of likelihood of confusion. To the extent that there are any other relevant *du Pont* factors, we treat them as neutral. We therefore find that there is a likelihood of confusion between Applicant's mark **My Other Bag ...** for "parodic canvas tote bags screen-printed with an artist's cartoonish rendering of a well-known designer handbag" and Registrant's mark **THE OTHER BAG BY ALDO** for "[h]andbags, carry-all bags, clutch bags, cosmetic bags sold empty, messenger bags, shoe bags for travel, sports bags."

Decision: The Section 2(d) refusal to register Applicant's mark is affirmed.