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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re Lipstik, Inc.*

Serial No. 85663715

Michael A. Painter of Isaacman, Kaufman & Painter, P.C. for Lipstik, Inc.

Dominick J. Salemi, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Quinn, Taylor, and Hightower, Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On June 28, 2012, applicant Lipstik, Inc. applied to register the mark ELISA B., in standard characters, for coats, dresses, jackets, skirts, sweaters, t-shirts, tank tops, and vests in International Class 25.<sup>1</sup> The examining attorney refused registration of applicant's mark on the ground of a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with the prior registered marks **LISA B.** for "clothing, namely, women's tops, bottoms,

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<sup>1</sup> Application Serial No. 85663715, alleging first use and first use in commerce at least as early as February 2011.

sweaters and dresses”<sup>2</sup> and **LISA B.** for “footwear,”<sup>3</sup> all in International Class 25.<sup>4</sup> Both registrations are owned by Lisa B. & Company, Inc.

Applicant timely appealed. Both applicant and the examining attorney filed appeal briefs. Neither applicant nor the examining attorney submitted any evidence except printouts of the cited registrations.<sup>5</sup>

#### Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *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 Company, 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. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

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<sup>2</sup> Registration No. 2473408, issued July 31, 2001; renewed.

<sup>3</sup> Registration No. 2335234, issued March 28, 2000; renewed. This registration also covers goods in Class 18.

<sup>4</sup> Both registered marks are in the form of “typed” drawings. Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. Trademark Manual of Examining Procedure (TMEP) § 807.03(i) (October 2013).

<sup>5</sup> Applicant also made of record a consent to registration of Elisa Barretta. *See* Section 2(c) of the Trademark Act, 15 U.S.C. § 1052(c).

We focus our analysis on cited Registration No. 2473408, which presents the stronger case for the refusal due to the nature of the identified goods. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Similarity of the Goods and Channels of Trade

We turn first to the similarity of the goods and the channels of trade, the second and third *du Pont* factors, respectively. Applicant's goods in Class 25 include sweaters and dresses. The goods in cited Registration No. 2473408 include women's sweaters and dresses. Therefore, with respect to sweaters and dresses, we presume that the application encompasses the goods in the prior registration, the goods move in all normal channels of trade, and they are available to all potential classes of ordinary consumers. *See Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Moreover, because the sweaters and dresses described in the application are legally identical to the women's sweaters and dresses in the cited registration, we presume that the channels of trade and classes of purchasers are the same. *See American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding the Board entitled to rely on this legal presumption in determining likelihood of confusion).

It is sufficient for a finding of likelihood of confusion if confusion is likely with respect to use of the mark on any item that comes within the description of goods in the application or registration. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.net*,

*Inc.*, 90 USPQ2d 1393, 1397 (TTAB 2007). Accordingly, in our likelihood of confusion analysis, our findings under the second and third *du Pont* factors strongly support a finding of likely confusion.

B. Similarity of the Marks

We next consider the *du Pont* factor focusing on the similarity or dissimilarity of “the marks in their entireties as to appearance, sound, connotation, and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “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) (citation omitted). We also keep in mind that when, as here, marks would appear on identical goods or services, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007). The purchaser’s fallibility of memory over a period of time must be kept in mind. *Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, 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 Nat'l 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 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.”). On the other hand, 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 Nat'l Data Corp.*, 224 USPQ at 751. Slight differences in marks do not normally create dissimilar marks. *See, e.g., In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985) (CAYNA similar to CANA); *In re Bear Brand Hosiery Co.*, 194 USPQ 444, 445-46 (TTAB 1977) (KIKS similar to KIKI).

Here, applicant's mark is ELISA B. and the mark in cited Registration No. 2473408 is **LISA B.**. Applicant's mark incorporates the cited registered mark in its entirety and simply adds the initial letter E. Likelihood of confusion has been found where the entirety of one mark is incorporated within another. *See Coca-Cola Bottling Co. of Memphis, Tenn., Inc. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (BENGAL LANCER for club soda, quinine water and ginger ale likely to cause confusion with BENGAL for gin);

*Johnson Publ'g Co. v. Int'l Dev. Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY DRUM for hairdressing and conditioner likely to cause confusion with EBONY for cosmetics); *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design for men's cologne, hair spray, conditioner and shampoo likely to cause confusion with CONCEPT for cold permanent wave lotion and neutralizer).

The initial letter E adds a syllable to applicant's mark, slightly distinguishing it visually and aurally from the cited registered mark. The marks otherwise are identical, however, and we find that distinction to be minimal. Considering the marks in their entirety, we find that the marks are very similar in sight, sound, connotation, and overall commercial impression. The first *du Pont* factor also supports a conclusion that confusion is likely.

C. Conclusion as to Likelihood of Confusion

To the extent that any other *du Pont* factors for which no evidence was presented by applicant or the examining attorney may nonetheless be applicable, we treat them as neutral. In view of our findings that the marks are similar and the goods are in part legally identical and move in the same channels of trade and to the same customers, we find that applicant's mark is likely to cause confusion with the mark in cited Registration No. 2473408 when used in association with applicant's goods.

Having reached this conclusion, we need not consider the issue of likelihood of confusion with Registration No. 2335234. We note, however, that the Board has often found apparel of the types identified in the application related to footwear as

identified in this registration. *See, e.g., In re Pix of Am., Inc.*, 225 USPQ 691, 691-92 (TTAB 1985) (women's shoes related to outer shirts; collecting cases); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (women's pants, blouses, shorts and jackets related to women's shoes); *B. Rich's Sons, Inc. v. Frieda Originals, Inc.*, 176 USPQ 284, 285 (TTAB 1972) (shoes and women's wearing apparel closely related); *Craddock-Terry Shoe Corp. v. Billy Boy Co.*, 133 USPQ 218, 219 (TTAB 1962) (jackets related to shoes).

*Decision:* We affirm the examining attorney's refusal to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).