

This Opinion is Not a  
Precedent of the TTAB

Mailed: September 15, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board

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*In re Ashley Lacer*

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Serial No. 88692683

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Andrea Sager and Patrick Lewis of Andrea Sager Law PLLC  
for Ashley Lancer.

John S. Yard, Trademark Examining Attorney, Law Office 115,  
Daniel Brody, Managing Attorney.

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Before Mermelstein, Adlin and Larkin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Ashley Lacer seeks registration of MICHELLE MAE, in standard characters, for “clothing sold wholesale, namely, hoodies, kimonos, shirts, and vests” in International Class 25.<sup>1</sup> According to the application, MICHELLE MAE “does not identify a particular living individual.” The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the registered mark MICHELLE MAY NEW YORK,

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<sup>1</sup> Application Serial No. 88692683, filed November 14, 2019 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on first use dates of August 15, 2007.

in standard characters (NEW YORK disclaimed), for “jewelry” in International Class 14, that it is likely to cause confusion.<sup>2</sup> According to the cited registration, MICHELLE MAY “identifies ‘Michelle May’, whose consent(s) to register is ... of record.” Thus, both marks contain phonetically equivalent names, one of which identifies a real person and one of which does not. After the refusal became final, Applicant appealed; the appeal is fully briefed.

### **I. Likelihood of Confusion**

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). 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. 5749906, issued May 14, 2019.

### **A. The Marks**

The marks – MICHELLE MAE and MICHELLE MAY NEW YORK – are highly similar “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). In fact, both contain phonetically identical names which also look almost identical, but for Registrant’s mark spelling the identified person’s surname as “MAY,” and Applicant’s mark spelling the identified person’s apparent surname as “MAE.”

Applicant does not dispute that the names in each mark are virtually identical. Instead, she claims that the marks create different commercial impressions because Registrant’s mark includes the disclaimed term NEW YORK following MICHELLE MAY, a term that is absent from Applicant’s mark and that “has a significant meaning in the fashion industry.” 4 TTABVue 17. Specifically, according to Applicant, NEW YORK “is known for having high-end and upscale fashion.” *Id.* at 18.

We are not persuaded. As Applicant herself points out, “adding a location to a mark linked to fashion goods is ... significant because often that’s where the goods are made. Where goods originate from is important in the fashion industry, and creates a specific commercial impression about the goods.” *Id.* at 19. In other words, Applicant not only concedes, but affirmatively asserts, that the term NEW YORK in Registrant’s mark is merely geographically descriptive of “where [Registrant’s] goods are made.” Descriptive and disclaimed terms such as NEW YORK are entitled to less

weight in our analysis. *See e.g. Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *Bd. of Regents, Univ. of Tex. Sys. v. S. Ill. Miners, LLC*, 110 USPQ2d 1182, 1188 (TTAB 2014) (“[I]t is well-settled that disclaimed, geographically descriptive matter, such as the wording SOUTHERN ILLINOIS, may have less significance in likelihood of confusion determinations.”); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (“Geographically descriptive terms are generally regarded as inherently weak and entitled to less protection than arbitrary or suggestive marks.”).

Furthermore, we are not convinced that the term NEW YORK, which “has a significant meaning in the fashion industry,” sufficiently distinguishes these marks in meaning or commercial impression. It is common knowledge, and, as discussed below, the record reflects, that personal name marks are common in the fashion industry; they often identify designers.<sup>3</sup> Thus, clothing consumers exposed to Applicant’s mark may very well assume that the mark identifies a designer because the mark appears to be a personal name<sup>4</sup>; this may be especially true of the

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<sup>3</sup> Applicant argued during prosecution that “Registrant’s commercial impression is that of a jewelry designer in New York named Michelle May.” August 20, 2020 Office Action response TSDR 15.

<sup>4</sup> Applicant claims that her mark “is derived from the middle names of Applicant’s two daughters.” August 20, 2020 Office Action response TSDR 15. There is no evidence that any consumers are aware of this, and even if some consumers are, others may perceive the mark

“wholesale” consumers exposed to Applicant’s mark, as they would likely have more exposure to and knowledge of the common use of personal names to identify fashion designers.

As for the slight spelling difference between Applicant’s mark (MICHELLE MAE) and the dominant portion of Registrant’s mark (MICHELLE MAY), we must keep in mind that “[t]he 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)). Thus, in considering whether consumers are likely to remember the slight spelling difference, or even notice it in the first place, we have taken into account: (1) “the fallibility of memory over a period of time;” and (2) that the “average” purchaser “normally retains a general rather than a specific impression of trademarks.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (“marks must be considered in light of the fallibility of memory”) (citation, internal quotation marks, and ellipsis omitted); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d*, 972 F.2d 1353 (Fed. Cir. 1992) (“The proper emphasis is thus on the recollection

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as a given name combined with a surname. While some consumers might perceive Applicant’s mark as two given names or a given name and a middle name, some consumers exposed to Registrant’s mark could perceive that mark the same way. In any event, the marks are quite similar no matter how consumers perceive the individual names the marks contain.

of the average customer, who normally retains a general rather than a specific impression of trademarks or service marks.”). In other words, while consumers who see Applicant’s mark right next to Registrant’s mark might notice the different spellings, those who see one mark and do not encounter the other until later (which is a more typical consumer experience and the scenario we must consider) would be unlikely to recall the minor spelling difference. Furthermore, the main takeaway for many of those hearing but not seeing the marks will be the exact same personal name, which will be perceived as the source of the goods offered thereunder.

Finally, consumers familiar with Registrant’s mark could perceive Applicant’s mark as a shortened version thereof, perhaps a version of Registrant’s mark which does not identify “where the goods are made,” or a mark which identifies different goods not made in New York.<sup>5</sup> Alternatively, consumers familiar with Applicant’s mark who encounter Registrant’s could perceive it as a version of Applicant’s mark which indicates where the goods are made.<sup>6</sup> In short, this factor weighs in favor of finding a likelihood of confusion.

#### **B. The Goods, Channels of Trade and Classes of Consumers**

The goods need not be identical or even competitive in order to find a likelihood of confusion. Rather, the question is whether the goods are marketed in a manner that “could give rise to the mistaken belief that they emanate from the same source.”

*Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d

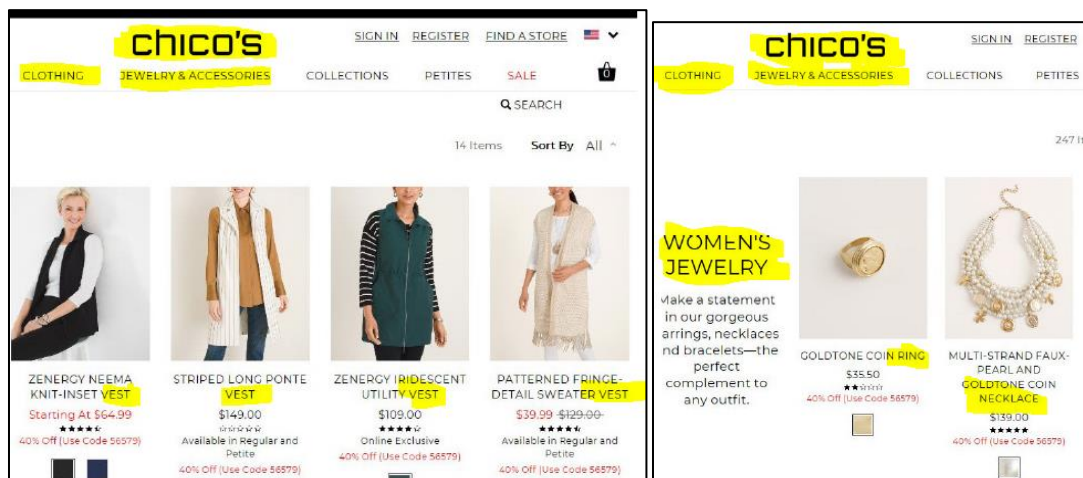
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<sup>5</sup> According to the involved application, Applicant resides in Oregon.

<sup>6</sup> It would not be surprising for a designer to manufacture clothing in one location and jewelry in another.

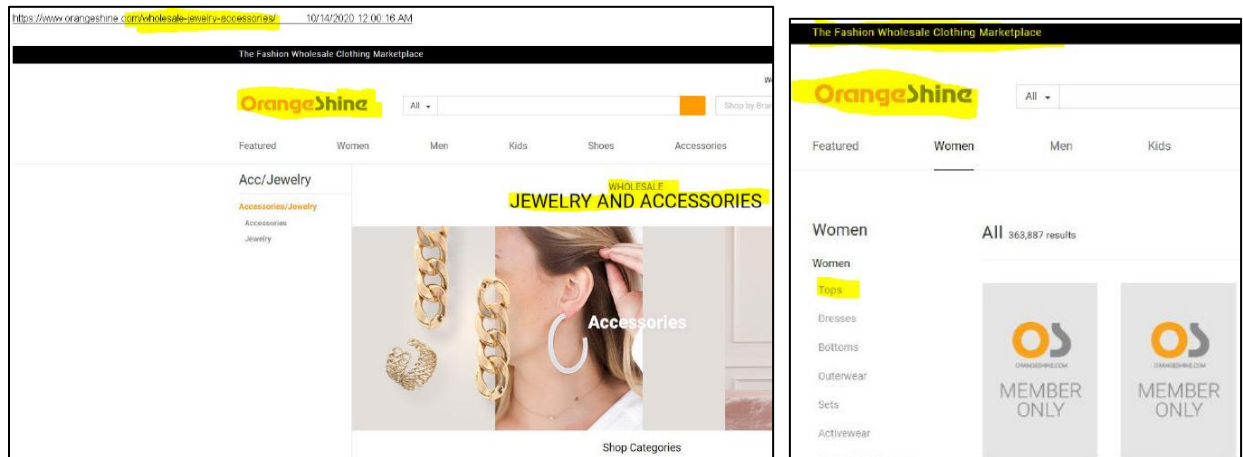
1715, 1724 (TTAB 2007)). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 227 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (“Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services.”); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods”); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1109 (2007).

Here, the Examining Attorney has established that goods such as those identified in the cited registration (jewelry) and goods such as those identified in the involved application (hoodies, shirts and vests) are offered under the same marks, and travel in the same channels of trade to the same consumers. For example, Chico’s offers vests (and shirts and kimonos) and jewelry on its website:

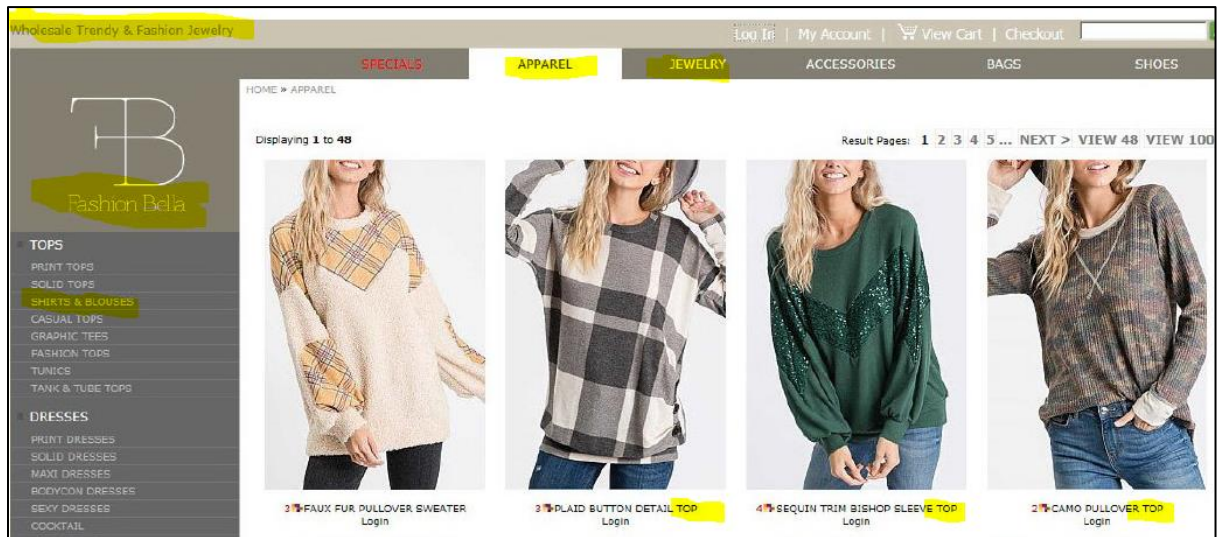


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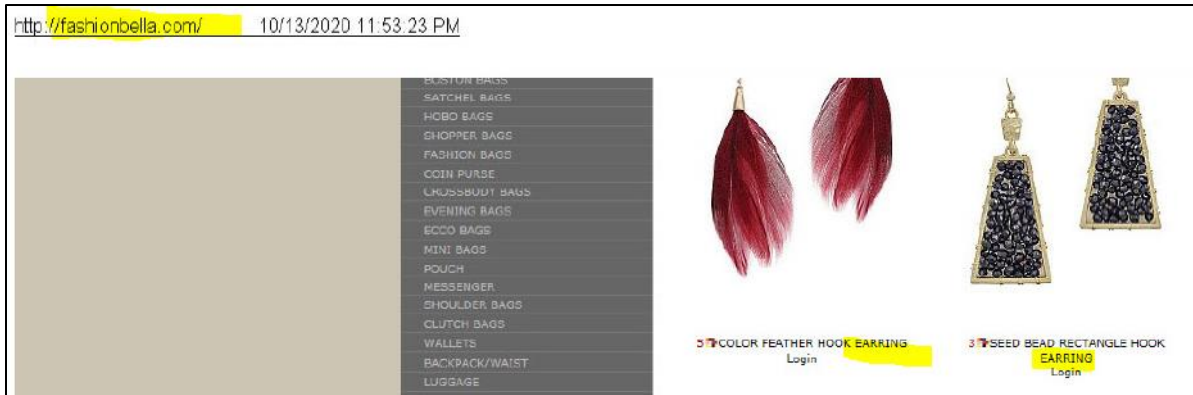
October 15, 2020 Office Action TSDR 158, 164 (emphasis added). Wholesaler OrangeShine, which uses the tagline “The Fashion Wholesale Clothing Marketplace,” offers “tops” (which encompass “shirts”) and jewelry on its site:



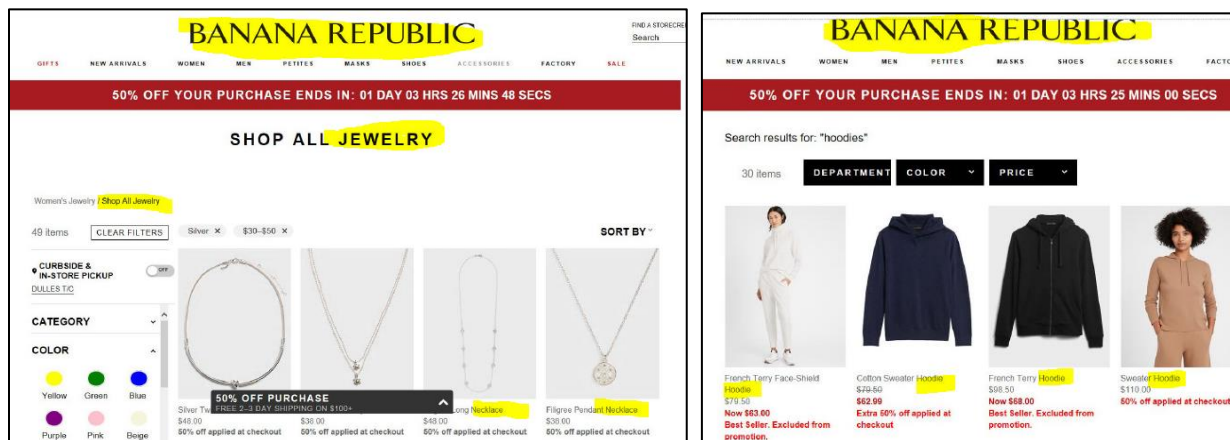
October 15, 2020 Office Action TSDR 141, 145 (emphasis added). Fashion Bella, another wholesaler, offers “Wholesale Trendy & Fashion Jewelry,” as well as a variety of tops, including shirts:



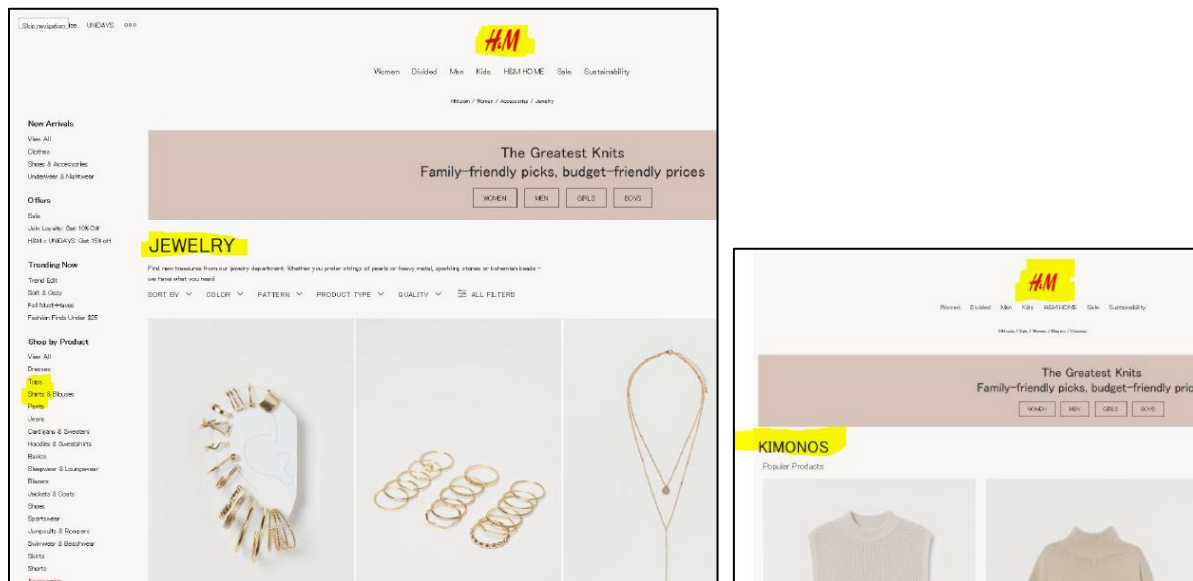




October 15, 2020 Office Action TSDR 132, 136 (emphasis added). Banana Republic offers jewelry and hoodies:

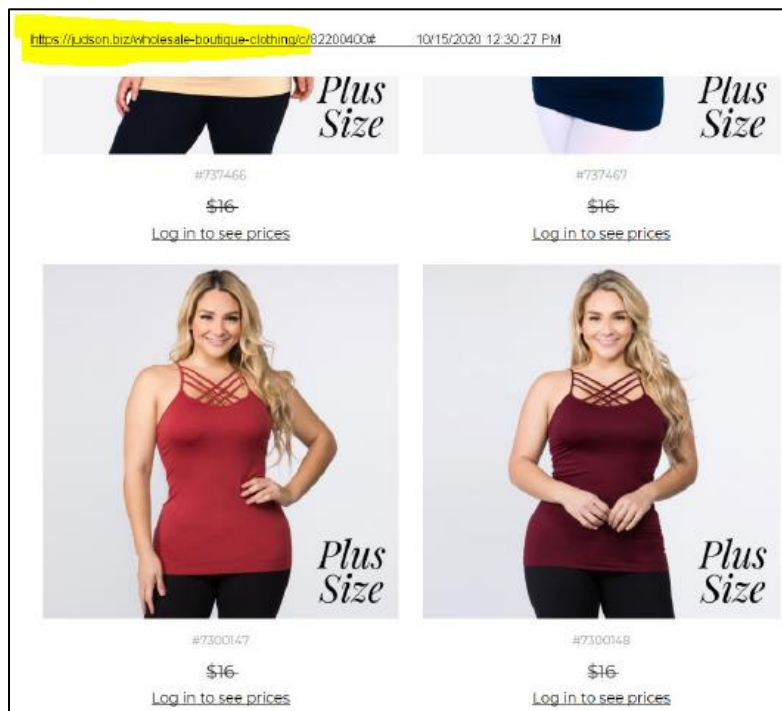
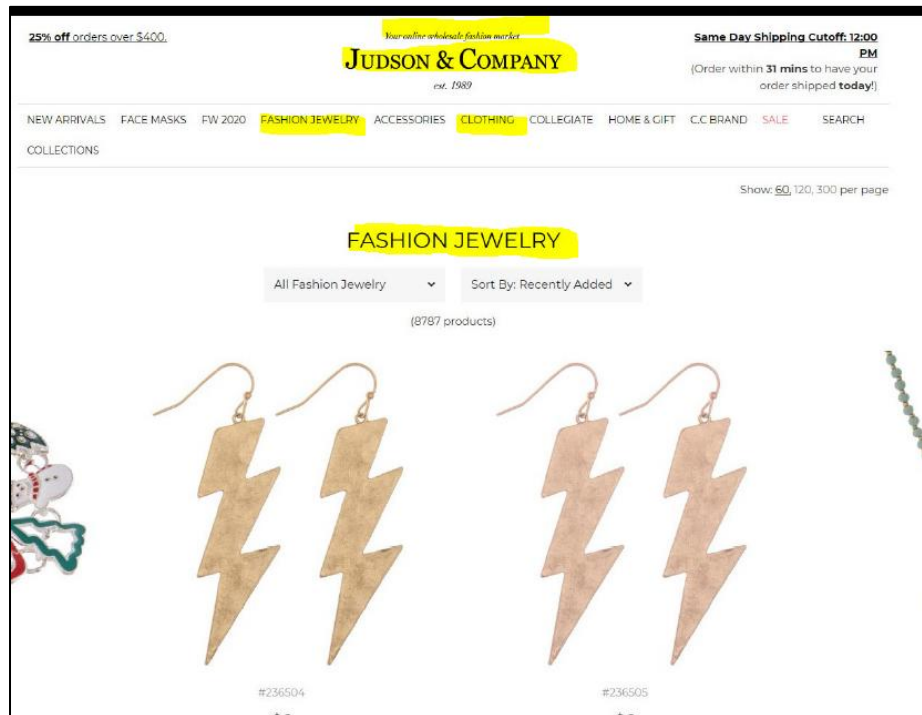


Id. at 62, 69 (emphasis added). H&M offers jewelry and kimonos:



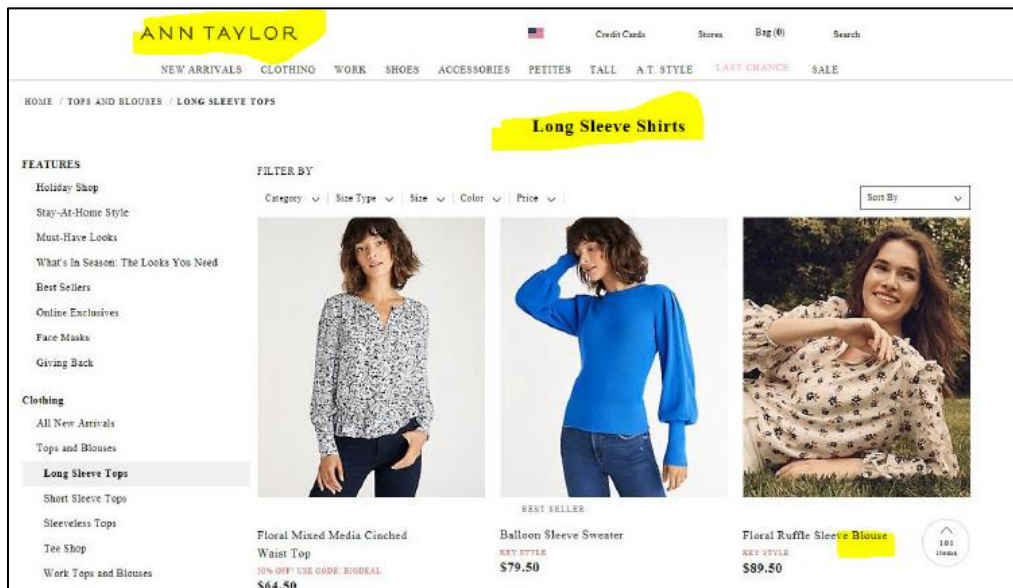
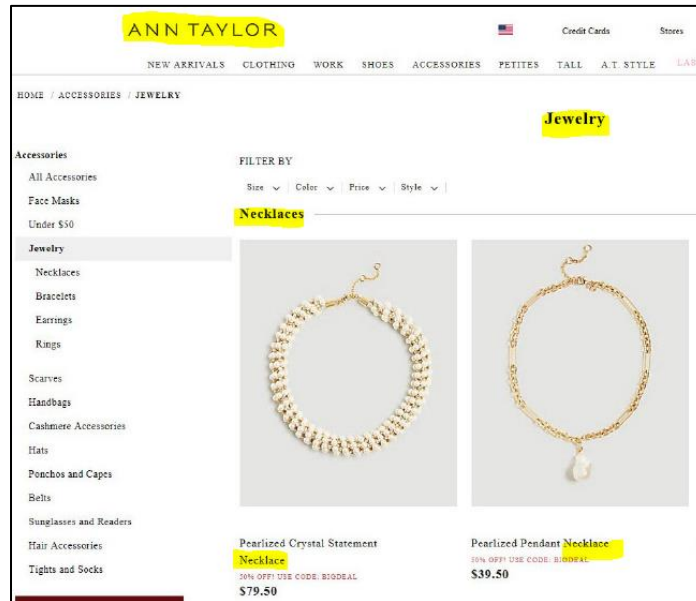
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*Id.* at 42, 56 (emphasis added). Wholesaler JUDSON & COMPANY, which uses the tagline “Your online wholesale fashion market” with its mark, offers jewelry and shirts on its website:



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October 15, 2020 Office Action TSDR 170, 182 (emphasis added). Ann Taylor offers jewelry and shirts:




*Id.* at 8, 24 (emphasis added).

The record reveals that ANN TAYLOR is far from the only personal name mark used for both clothing and jewelry. In addition, the marks KATE SPADE, VERA WANG and CALVIN KLEIN are all used for both clothing and jewelry. February 3,

2021 Denial of Request for Reconsideration TSDR 4-65. Registrant herself also sells clothing, including vests, under her MICHELLE MAY NEW YORK mark, in addition to the “jewelry” identified in the cited registration. *Id.*

In short, the Examining Attorney’s third-party use evidence establishes a relationship between the goods. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (crediting relatedness evidence showing that third parties use the same mark for the goods and services at issue because “[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both”); *Hewlett-Packard Co.*, 62 USPQ2d at 1004 (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”).

In addition, the Examining Attorney introduced more than 20 use-based third-party registrations showing that the same marks are registered in connection with Registrant’s goods (or similar goods) on the one hand and Applicant’s goods (or similar goods) on the other. The following are typical:

 (Reg. No. 5991238) is registered for “jewelry” and “kimonos.”

**ALEX MILL** (Reg. No. 5949658) is registered for “jewelry” and “shirts.”

BEN BALLER (Reg. No. 5943791) is registered for “jewelry, namely, bracelets, earrings, rings, broches, pendants, necklaces, polished diamonds, precious and semiprecious gemstones” and “hoodies.”

DAIVA (Reg. No. 5924259) is registered for “jewelry” and “shirts.”

BURNETT NEW YORK (Reg. No. 6149727) is registered for “jewelry” and “shirts.”



(Reg. No. 5688570) is registered for “jewelry” and “vests.”



(Reg. No. 5510977) is registered for “jewelry” and “vests.”



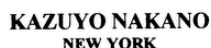
(Reg. No. 5129909) is registered for “jewelry” and “clothing, namely, tops and bottoms.”



(Reg. No. 5142292) is registered for “jewelry” and “shirts.”



(Reg. No. 4117742) is registered for “jewelry” and “shirts.”



(Reg. No. 2494917) is registered for “jewelry” and “shirts.”

October 15, 2020 Office Action TSDR 89-130; February 25, 2020 Office Action TSDR

8-37.<sup>7</sup> “Third-party registrations which cover a number of differing goods and/or

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<sup>7</sup> Of the 11 third-party registrations listed here, seven include the term NEW YORK, while 10 include personal or given names. This tends to support the findings that NEW YORK is

services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source.” *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1998).

Applicant’s primary counterargument is that the goods are not related and the channels of trade and classes of consumers do not overlap because Applicant’s goods are identified as “clothing sold **wholesale** ....” 4 TTABVue 10-16 (emphasis added). We are not persuaded.

The argument is belied by the Examining Attorney’s evidence from wholesalers OrangeShine, Fashion Bella and Judson & Company, which all manufacture or offer for sale clothing and jewelry under their respective marks. This evidence shows that consumers of wholesale clothing and jewelry encounter those types of goods under the same marks.

Furthermore, and relatedly, Registrant’s identification of goods is unlimited, meaning that Registrant’s jewelry may be sold at retail, or, like Applicant’s goods, wholesale. Indeed, we do not read limitations into unrestricted identifications such as Registrant’s. *See, e.g., In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (“It is well established that the Board may not read limitations

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not distinctive, and that personal or given name marks are commonly used in connection with jewelry and clothing.

into an unrestricted registration or application.”) (quoting *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983)). Thus, wholesale consumers may be exposed to and confused by Applicant’s and Registrant’s similar marks used for related goods (goods which are sometimes sold by the same wholesalers of clothing and jewelry, such as OrangeShine, Fashion Bella and Judson & Company).<sup>8</sup>

Finally, Applicant argues that the goods are not related based on “pairs” of registrations for marks (many comprised of personal names) owned by different owners, in which one mark is registered for jewelry and the other for clothing. August 20, 2020 Office Action response TSDR 27-83; January 8, 2021 Request for Reconsideration TSDR 16-54. For the most part, however, the evidence does not support the argument. In fact, most of the third-party registrations involve names or goods which are more different than those in this case, such as marks comprised of first names only, or registrations identifying “watches” but not “jewelry.” Only the LILY MAY/LILA MAE, LAUREN JAMES/LAURA JAMES and ELLA ROSE (Stylized)/ELLA ROSE marks are arguably analogous to those in this case, in that they are comprised of identical or similar personal names (or apparent personal names) and identify the goods in question here. But a mere three examples is not particularly significant, and they do not overcome the Examining Attorney’s evidence

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<sup>8</sup> While it is unclear whether Applicant’s clothing will bear the MICHELLE MAE mark when it is eventually sold at retail or otherwise distributed by Applicant’s wholesale customers, any use of MICHELLE MAE in connection with Applicant’s clothing could very well confuse the ultimate purchaser or wearer of Applicant’s goods.

showing that the goods are related. *See In re Embiid*, 2021 USPQ2d 577 \*37 n.55 (TTAB 2021).

Moreover, proving that marks coexisted on the Register “does not prove that they coexisted during that time without confusion in the marketplace.” *In re Thomas*, 79 USPQ2d 1021, 1028 (TTAB 2006). Similarly, we do not know whether there are licenses or coexistence agreements, much less the terms thereof, which could explain the coexistence of these registrations. In any event, ultimately, “neither the Trademark Examining Attorney nor the Board is bound to approve for registration an Applicant’s mark based solely upon the registration of other assertedly similar marks for other goods or services having unique evidentiary records.” *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); *see also In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“The Board must decide each case on its own merit .... Even if some prior registrations had some characteristics similar to Nett Designs’ application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”); *In re Embiid*, 2021 USPQ2d 577 \*44-45.

In short, these factors also weigh in favor of finding a likelihood of confusion.<sup>9</sup>

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<sup>9</sup> It is worth pointing out that we have previously found clothing and jewelry to be related, albeit on different records than the one in this case. *See e.g. David Crystal, Inc. v. Dawson*, 156 USPQ 573, 574 (TTAB 1967) (“jewelry and women’s wearing apparel are sold and promoted through the same channels of trade to the same classes of purchasers, **they are displayed and worn together, they may be purchased at the same time for coordinated wardrobes**”) (emphasis added); *cf. Societe Comptoir de l’Industrie Cotonniere, Etablissements Boussac v. Litwin and Sons, Inc.*, 130 USPQ 359, 359-60 (TTAB 1961) (“[I]t is common practice for retail outlets of [ladies’ wearing] apparel to also sell matching articles of jewelry therefor, and it is reasonable to assume that were purchasers to encounter articles of jewelry and items of ladies’ apparel being marketed under the same or closely similar marks, confusion as to their source would be likely.”). Here, as in *David Crystal*, the evidence reveals that clothing and jewelry may be purchased at the same time under the same mark.



### **C. Purchaser Sophistication and Care**

Applicant argues that her customers are “sophisticated” and “must be approved by applicant to place orders and such customers are only allowed to purchase items in bulk, which results in an expensive price.” 4 TTAB 12. There is no evidence supporting this argument, and it is therefore unpersuasive. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (“Attorney argument is no substitute for evidence.”) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)); *see also In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2006 (TTAB 2014) (finding that there was no proof to support the statements in the record by counsel).

Even if Applicant had introduced evidence about her alleged buyer approval process and the “expensive price” she charges for bulk clothing purchases, neither the process nor the prices are reflected in Applicant’s identification of goods, which identifies wholesale clothing without mentioning price or any approval process. We must base our decision on the “least sophisticated potential purchasers” for the goods as identified, which could encompass inexpensive wholesale shirts or hoodies, perhaps shirts or hoodies purchased by small souvenir shops or street vendors in relatively low “bulk” quantities. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162-63 (Fed. Cir. 2014). This factor is neutral.<sup>10</sup>

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<sup>10</sup> Even if Applicant’s identification of goods justified a finding of consumer sophistication and care, we would find this factor outweighed because the marks are similar, the goods are related and the channels of trade and classes of consumers overlap, *See, In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986); *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970); *see also HRL*

## II. Conclusion

The marks are similar, the goods are related, and the channels of trade and classes of consumers overlap. Therefore, confusion is likely.

**Decision:** The refusal to register Applicant's mark under Section 2(d) of the Trademark Act is affirmed.

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*Assoc., Inc. v. Weiss Assoc., Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods). Furthermore, Applicant's claim that Registrant "sells high-end jewelry at prices that range between \$65 and upwards of \$250," 4 TTABVue 13, is unavailing, because the cited registration identifies "jewelry" without limitation as to price, "so we must assume that the jewelry includes inexpensive items that consumers would purchase with nothing more than ordinary care." *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1649 (TTAB 2008).