

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Oral Hearing:
December 10, 2009

Mailed:
March 23, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Kenneth Cole Productions (LIC), Inc.

v.

Andrew Craig

Opposition No. 91161781
to application Serial No. 75730916
filed on June 17, 1999

Cathy E. Shore-Sirotnin of Lackenbach Siegel LLP for Kenneth Cole Productions (LIC), Inc.

Ernest I. Gifford of Gifford, Krass, Groh, Sprinkle, Anderson & Citkowski, P.C. for Andrew Craig.¹

Before Cataldo, Taylor, and Wellington,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Kenneth Cole Productions (LIC), Inc. (hereinafter, "opposer" or "KC") has opposed the application of Andrew Craig to register LE TIGRE, in standard character format, for "writing instruments namely fountain pens, ball point pens, felt and fiber tip pens and markers" in International

¹ At oral hearing, applicant was represented by Mark Schneider.

Opposition No. 91161781

Class 16; and "small leather goods, namely, cases for diaries and daily planners; and brief case type portfolios" in International Class 18.²

As a preliminary matter, we address the status of the party opposer(s) in this proceeding. As originally filed, the notice of opposition identified Le Tigre, LLC and LT2, LLC as joint opposers. On December 11, 2007, these joint opposers filed a motion, with applicant's consent, to substitute KC as the sole party opposer or, in the alternative, to join KC as a joint opposer. On the following day, the Board issued an order granting the motion to the extent that KC was substituted for Le Tigre, LLC, and that LT2, LLC remained of record as a joint opposer. However, upon further review of the consented motion that resulted in the Board order, we note that counsel for opposers represented that KC "is now the real party in interest and the proper opposer" and that "upon further

² Application Serial No. 75730916, based on Section 1(b) (intent to use). The application contains a statement that the English translation of the mark is "the tiger."

On June 1, 2006 and after commencement of this opposition, applicant filed a proposed amendment to both classes of goods to add the following language at the end of the present identification, "all the foregoing goods not relating to baseball or softball or a baseball or softball team." Opposer did not consent to this proposed amendment and, in its trial brief, specifically states that the proposed amendment is "improper and should be denied." Brief, p. 4. We note that for purposes of this opposition, the proposed amendment is irrelevant inasmuch as the amendment does not change in any meaningful way the degree of relatedness between the parties' respective goods. Accordingly, our decision herein is not affected by this proposed amendment and, as a result, it has been given no further consideration.

information and belief, Le Tigre was dissolved, and no longer exists as an entity." Based on this information and the fact that the record in this proceeding does not establish that LT2, LLC is an ongoing entity or continues to have an interest in this proceeding, we deem KC to be the sole opposer and the caption for this proceeding has been amended accordingly (as shown above).

As grounds for opposition to the registration of applicant's mark in both classes of goods, opposer alleged that it is the owner of the registration for the trademark:

Le TIGRÉ

(hereinafter, "LeTIGRÉ (stylized)") for "men's, women's and children's apparel-namely, sweaters, shirts, jackets, sport coats, all-weather coats, raincoats, slacks, jeans, shirts, swim trunks, gym trunks, headwear and robes" in International Class 25;³ that opposer, and its predecessors-in-interest, have used the mark LE TIGRE "and variations thereof" for "a wide variety of products falling within International Class 25" since "at least as early as September 25, 1979"; that opposer's "Le TIGRE marks are famous trademarks pursuant to Section 43(c) (15 U.S.C.

³ Registration No. 1186863 issued on January 19, 1982; renewed. On November 13, 2007, an assignment of ownership of the registration was recorded with the USPTO from Le Tigre, LLC to opposer, Kenneth Cole Productions (LIC), Inc. (recorded at reel 3659, frame 0949). The registration contains a statement that "the words 'Le Tigre' mean 'The Tiger'."

Opposition No. 91161781

1125(c)) of the Trademark Act"; that applicant's applied-for mark is "identical" to opposer's registered mark and "covers goods which are confusingly similar to [opposer's] goods"; that "in view of applicant's claim to such exclusive rights [in the applied for trademark], members of the trade and public familiar with [opposer's] use of [the registered trademark] would be likely to believe...that applicant's goods originate from opposer, or from an entity in some way associated with or related to [opposer]"; and that "registration and use of applicant's purported mark will cause dilution of...[opposer's mark]." ⁴

In his answer, applicant denied all salient allegations in the notice of opposition.

The record includes the pleadings and the file of the opposed registration, by operation of Trademark Rule 2.122(b)(1).

Opposer filed the deposition testimony, with exhibits, of the following individuals: Andrew Craig, applicant; ⁵

⁴ On September 8, 2008, opposer moved to amend the notice of opposition under Fed. R. Civ. P. 15(a) and (b) to assert a separate and new claim of fraud. In an order dated November 21, 2008, the Board denied the motion to the extent it was based on Rule 15(a), but deferred consideration of the Rule 15(b) basis for the motion. Opposer, however, did not argue this ground in its trial briefs or otherwise reference the outstanding motion. Accordingly, and in light of opposer's failure to even argue a fraud ground in its trial briefs, we find a lack of interest and construe the motion to amend the notice of opposition, under Rule 15(b), as effectively withdrawn. We therefore do not give consideration to any fraud ground in our determination herein.

⁵ Deposition taken on April 21, 2008.

Opposition No. 91161781

Sharon Seelig, Group Vice President of Licensing at Kenneth Cole Productions, Inc.; and Leah Caras, Trademark and Licensing Manager at Kenneth Cole Productions, Inc.

During its testimony period, opposer also introduced, under its first notice of reliance, a status and title copy of the pleaded registration, namely, Registration No. 1186863 for LeTIGRÉ (stylized as shown above); status and title copies other registrations owned by opposer; copies of registrations owned by third-parties for purposes of showing a relationship between the parties' respective goods; printouts from USPTO databases involving applications owned by opposer; a copy of a New York Times article; and copies of self-described "unsolicited press coverage reflecting KC's predecessors-in-interest's exploitation of the Le TIGRE mark." Under a second notice of reliance, opposer introduced copies of articles and photographs from various periodicals that opposer describes as "unsolicited press coverage"; and a copy of an article entitled, "Licensing Seen as Key to Strong Brand Presence."

Applicant filed the deposition testimony, with exhibits, of the following individuals: Shannon Jennings, litigation paralegal for the law firm representing applicant; and Andrew Craig, applicant.⁶

⁶ Deposition taken on July 28, 2008.

Applicant also introduced, under a notice of reliance, copies of third-party registrations for marks that contain the term "Tiger"; and printouts from the USPTO electronic database "TESS" listing the status of various applications and registrations for marks that contain the term "Tiger."

Opposer and applicant have filed trial briefs.

Objections to Evidence

In its trial brief, opposer raised various objections to certain evidence and testimony offered by applicant.

(a) Exhibit 390 to Applicant's Notice of Reliance

Opposer has objected to this exhibit, consisting of search result printouts from the USPTO's electronic database TESS, on the basis that such materials are not "official records" or otherwise appropriate for submission solely by notice of reliance. This objection is overruled inasmuch as this same exhibit is also attached to Ms. Jennings' testimony deposition wherein she testified how and when she accessed the materials.⁷ Accordingly, it has been authenticated.

(b) Exhibits 1-390 to Applicant's Notice of Reliance

⁷ In any event, the Board recently ruled that "if a document obtained from the Internet identifies its date of publication or date it was accessed and printed, and its source (e.g., the URL), it may be admitted into evidence pursuant to a notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e)." . See *Safer, Inc. v. OMS Investments, Inc.*, ___ USPQ2d ___ (TTAB, Opposition No. 91176445, February 23, 2010).

Opposition No. 91161781

Opposer objects to these exhibits because the notice of reliance does not contain a statement as to why applicant believes they are relevant and, opposer argues, the documents should have been produced by applicant in response to opposer's discovery request.

Objections to notices of reliance on procedural grounds, such as not indicating the general relevance of the submitted documents, ordinarily should be raised promptly by way of a motion to strike if the defect is one that can be cured. See TBMP § 707.02 (2d ed. rev. 2004). Here, had opposer promptly raised this objection, applicant could have cured the defect by providing the relevance statement (as they did in their trial brief). Accordingly, opposer's objection to the notice of reliance for failing to include a general relevance statement is untimely and thus overruled.

As to opposer's objection based on its contention that these documents should have been produced earlier in response to discovery requests, we consider this objection to have been waived inasmuch as it was not timely raised at trial. We further note that during the testimony deposition of Ms. Jennings, when these same documents were being introduced as exhibits, opposer's counsel also failed to raise this objection.

(c) Exhibits to the Testimony of Shannon Jennings

Opposition No. 91161781

Opposer objects to all exhibits, except Exhibit 1, to Ms. Jennings testimony deposition because, opposer argues, the exhibits should have been produced by applicant in response to opposer's discovery requests and they were not. Again, because it was not raised at trial, we consider this objection to be untimely and thus waived.

(d) Exhibit 1 to the Testimony of Andrew Craig

Opposer objects to Exhibit 1 to Mr. Craig's testimony deposition on the basis that it consists of a final version of a settlement agreement versus the draft version that was produced in response to opposer's discovery requests. Opposer argues that the final version contains material changes to the draft version and that it should have been produced earlier. Opposer promptly raised this objection during Mr. Craig's deposition. This objection is sustained. To the extent the settlement agreement is relevant, we only have considered the draft version; thus, should there be any reliance or argument based on provisions or language not contained in the draft version, it will not be given consideration.

(e) Testimony of Shannon Jennings

Opposer objects to the submission of Ms. Jennings testimony deposition because "she was never identified as a person with knowledge or a potential witness in this case" and applicant was required to do so in response to opposer's

discovery requests. Specifically, opposer points to Interrogatory 18 requesting applicant to "identify all witnesses whom you expect to call during this proceeding" in addition to other information regarding the witness. Applicant's response was "Applicant has not yet determined who its witnesses will be."

This objection is overruled. The Board has long held that a party need not, in advance of trial, identify the witnesses it intends to call, except that the names of expert witnesses intended to be called are discoverable. See TBMP § 414 (note 7) (2d ed. rev. 2004) and cases cited therein.

(f) Other Objections

As to opposer's objections to the introduction of the testimony depositions of Mr. Craig and Ms. Jennings based on applicant's failure to file copies showing that they were signed under penalty of perjury, these objections were not timely raised and are thus waived. As with opposer's objection to the notice of reliance, an objection to a testimony deposition must be raised promptly if the defect is one that can be obviated or removed, failing which it is waived. See TBMP § 707.03(a) (2d ed. rev. 2004). We find that opposer waived this objection by not raising it earlier and thus permitting applicant a chance to cure this defect by filing a signature copy page.

Opposer's objections based on the lack of relevance of the testimony and/or exhibits are overruled. Nevertheless, we note that many of the documents submitted by applicant have little, if any, probative value. For example, opposer is correct in noting that applicant's introduction of a TESS database list of registration numbers does not make any of the identified registrations of record. See TBMP § 704.03 (2d ed. rev. 2004). Moreover, even for the copies of third-party registrations which have been properly made of record, their probative value is limited, particularly when, as in this case, the issue to be determined is likelihood of confusion. This is because the registrations, by themselves, are not evidence of actual use of the mark shown in the registration. *Id.*

Opposer also raised several objections as to the clarity or legibility of certain documents. Opposer timely raised these objections during Ms. Jennings deposition. These objections are sustained to the extent that the Board will give no consideration to any document containing illegible wording or that is not sufficiently clear such that any reference thereto cannot be easily viewed and understood by the Board.

Standing and Priority

Opposer has established its standing in this proceeding through its registration, which is of record, for the mark

LeTIGRÉ (stylized). *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Also, because opposer's pleaded registration is of record, Section 2(d) priority is not an issue in this case as to the mark and the goods covered by the registration vis-à-vis applicant's mark and goods. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Opposer also alleged common law use, through its predecessors-in-interest, of a LE TIGRE mark on goods other than those identified in the pleaded registration. However, opposer did not establish its priority of use with respect to any common law use on these goods.⁸ Accordingly, we limit our likelihood of confusion analysis to opposer's mark and goods covered by the pleaded registration vis-à-vis applicant's mark and goods identified in the application.

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

⁸ Although Ms. Seelig testifies in her deposition that opposer has used the "Le Tigre" mark on other goods, and there are exhibits showing such use, there is no testimony or other evidence to establish that such use began before the filing date of the subject application.

Opposition No. 91161781

USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (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 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Accordingly, we turn first to the first *du Pont* factor, which requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). Here, we find that applicant's mark LE TIGRE (in standard character form) and opposer's registered mark LeTIGRÉ (stylized) are nearly identical in terms of appearance, sound, connotation and commercial impression. Although the registered mark appears in stylized lettering, it is only minimally so and the rather ordinary upper and lower case lettering employed does not sufficiently distinguish the two marks. In any event, because applicant's mark appears in standard character format in the application, we must consider that it may

Opposition No. 91161781

reasonably be displayed in the same stylized lettering form as opposer's mark. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000) (typed drawings are not limited to any particular rendition of the mark). *See also Phillips Petroleum v. C.J. Webb*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971).

As to the accent mark appearing above the last letter "e" in opposer's mark, but not present in applicant's mark, we acknowledge that this may result in slightly different pronunciations of the marks; however, it does very little to distinguish the marks visually. And, insofar as connotation or commercial impression is concerned, the presence or absence of the accent mark does not affect the meaning or perception of the term "LE TIGRE." Indeed, both the subject application and opposer's pleaded registration contain a translation statement to the effect that their marks are translated into English as "the tiger." Consequently, to the extent that persons are familiar with this translation and encounter the marks, the marks convey the same connotation and commercial impression. Even for those unfamiliar with the translation of the term, they will perceive the marks to create the same impression, e.g., that LE TIGRE (with or without the accent) is a coined term or a foreign word, even if the meaning is unknown.

Opposition No. 91161781

Because of the near identity of the marks, this *du Pont* factor weighs heavily in favor of opposer and a finding of likelihood of confusion.

We next consider the arguments put forth by the parties regarding the *du Pont* factors of the alleged fame of opposer's prior mark and the number and nature of any third-party similar marks in use. Specifically, opposer argues that its LeTIGRÉ (stylized) mark is "clearly well-known, and likely famous, entitling it to a broad scope of protection." Brief, p. 23. It also argues that the mark is "arbitrary and thus a strong mark." *Id.* at 25. Applicant, on the hand, disputes that opposer's mark is famous and contests the overall strength of the mark because "the mark is used by others on similar goods." Brief, p. 14.

When fame is present it plays a dominant role in the determination of likelihood of confusion. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). However, it is the duty of a party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Based on the record before us, opposer has not established that its pleaded mark LeTIGRÉ (stylized) is famous. Opposer relies heavily upon the fact that the pleaded registration is now over 28 years old and that the mark has received what opposer characterizes as "enormous unsolicited publicity and media attention," including evidence that mark has been featured in news articles and persons wearing clothing bearing opposer's mark has been featured on magazine covers. In addition, there is evidence that certain celebrities have worn clothing with the LeTIGRÉ (stylized) brand. While this evidence may be impressive, it does not suffice for purposes of proving that the mark is famous under the *du Pont* factor. Indeed, noticeably absent from the record are any actual dollar figures for opposer's (or its predecessors-in-interest's) sales and advertising of clothing bearing opposer's LeTIGRÉ (stylized) mark. Without this type of evidence, it is nearly impossible to gauge the level of success of the mark or the degree of exposure the general public has had to the mark. Further, without these numbers and those of competitors, it is difficult to place any success or relative fame into context. In other words, it is impossible to ascertain from this record the extent to which consumers have been exposed to opposer's goods under its mark vis-à-vis their competitors, and, thus, whether opposer's evidence of media exposure translates into fame of

its pleaded mark. Ultimately, opposer's evidence falls short of establishing that the LeTIGRÉ (stylized) mark is famous. See *Leading Jewelers Guild Inc.*, 82 USPQ2d at 1904.

Although, on this record, we have found that opposer's mark is not famous, the evidence shows that it is certainly a strong mark for clothing. That is, opposer's LeTIGRÉ (stylized) mark has achieved a level of recognition as demonstrated in numerous magazines and has been regarded in article excerpts as a well-known brand of clothing. Moreover, opposer's mark is intrinsically strong inasmuch as it is an arbitrary term in the context of the parties' identified goods. While "le tigre" may be translated into English as "the tiger," there is no evidence showing the mark or its English equivalent has any special meaning with respect to the clothing, writing instruments, small leather goods or briefcase-type portfolios.

Accordingly, the *du Pont* factor of fame is neutral; however, our finding that opposer's mark is strong and distinctive weighs in opposer's favor.

As to applicant's argument that opposer's mark is somehow weak based on third-party use of the same or similar marks on similar goods, we initially note that the bulk of his evidence consists of third-party registrations for marks containing the term "tiger." As the Board has oft-stated, registrations are not evidence of actual use of similar

Opposition No. 91161781

marks for similar goods. See *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983) and *National Aeronautics and Space Administration v. Record Chemical Co.*, 185 USPQ 563 (TTAB 1975) (third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of those marks); see also *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (third-party registrations are not entitled to any weight when evaluating the strength of plaintiff's marks). We are also not persuaded by applicant's argument that opposer's mark is weak or should be entitled to a narrower scope of protection based on internet printouts of purported third-party use of the same or similar marks. First, nearly all of this internet evidence shows use the term "tiger," and not the marks at issue. Applicant argues that this evidence is still relevant because the marks may be translated to "the tiger." However, we find little, if any, relevance to this type of evidence because in order to show how purchasers will be able to distinguish between the two parties' marks, the evidence should demonstrate that the common element (in this case, nearly the entire marks) have been so extensively used by others that purchasers will rely on other elements of the marks to distinguish source. *Carl Karcher Enterprises Inc. v. Stars Restaurant Corp.*, 35 USPQ2d 1125, 1131 (TTAB 1995). See also *NCTA v. American*

Opposition No. 91161781

Cinema Editors, 937 F.2d 1572, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991). In other words, it is applicant's burden to show how purchasers will perceive "Le Tigre" by showing some measurable or intense exposure to that term in the context of the parties' goods. *In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 343 (CCPA 1978). See also *Carl Karcher Enterprises Inc. v. Stars Restaurant Corp.*, 35 USPQ2d at 1131; *Tiffany & Co. v. Classic Motor Carriages*, 10 USPQ2d 1835, 1840-1841 (TTAB 1989). In this regard, we note that the only evidence of actual third-party use of the term "Le Tigre" were a few internet printouts that reference a musical band by that name, including use of the band's name on shirts, and a company that renders "business and technology integration" services under that name. See Jennings deposition, Exhibit 2. This hardly amounts to the intense or extensive exposure envisioned whereby we could find that opposer's mark may be considered weak or only entitled to limited protection.

Accordingly, the *du Pont* factor involving third-party use of the same or similar marks on similar goods is neutral.

We now consider the *du Pont* factor involving the similarity or dissimilarity of opposer's clothing apparel and applicant's goods, namely, the writing instruments and "small leather goods, namely, cases for diaries and daily

planners; and brief case type portfolios." While it is clear that, on their face, the goods are different, it is also settled that it is not necessary that these respective goods be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). The goods need only be sufficiently related that consumers would be likely to assume, upon encountering the goods under similar marks, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). In addition, "the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion." *In re Concordia International Forwarding Corp.*, 222 USPQ 352, 356 (TTAB 1983). See also, *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) [Contemporaneous use of identical or nearly identical marks can lead to the

Opposition No. 91161781

assumption that there is a common source "even when [the] good or services are not competitive or intrinsically related"].

Based on the record, we are able to find that it would not be uncommon for consumers to encounter the same trademark being used as a source identifier for clothing apparel as well as accessory items that would include applicant's identified goods, e.g., pens and small leather goods such as daily planners, diaries and portfolios. Leah Caras, a trademark and licensing manager for Kenneth Cole Productions, Inc., testified to such use and the exhibits attached to her deposition include examples of several "high-end" brands being used in this manner: the COACH trademark being used on daily planners, pens, and sweaters (Caras dep., 8:16 to 10:14, Exhibits 42-45); the LUIS VUITTON trademark being used on a pen, a shirt and a daily planner (Caras dep., 10:16 to 13:5, Exhibits 46-49); the KATE SPADE trademark being used on a leather daily planner and a blouse (Caras dep., 13:10 to 15:8, Exhibits 50-52); and the EMILIO PUCCI trademark being used on a pen, a sweater (Caras dep., 15:11 to 18:14, Exhibits 53-55). Ms. Caras' testimony also includes several examples of similar use of "mid to high-end" brands being used on the same aforementioned goods. Ms. Caras also testified:

Opposition No. 91161781

Q. ...Based on your shopping experience, did you find that clothing, writing items and portfolios were frequently sold in the same stores?

A. Yes.

Q. Was this true for high end goods?

A. Yes.

Q. And was this true for mid to low end goods?

A. Yes

(Caras dep., beginning at 40:13).

Ms. Caras' testimony is corroborated by the testimony by Sharon Seelig, vice-president of licensing for Kenneth Cole Productions, Inc. Based on her eighteen years of experience as a retail buyer within apparel or accessories, she provided uncontroverted testimony that it is common for clothing apparel companies to also sell pens and small leather goods, such as those identified in the subject application, under the same trademark.

Q. Is it common for companies in this industry to sell goods under the same trademark in both the clothing apparel category and the handbag category?

A. Yes.

Q. Is it common for those companies to sell clothing and small leather goods?

A. Yes.

Q. Under the same mark?

A. Yes.

Q. Is it common for them to sell pens and pencils and small leather goods?

A. Yes.

Q. Under the same mark? Sorry.

A. Yes.

Q. Is it common for them to sell, I guess, clothing and pens and pencils and small leather goods?

A. Yes.

(Seelig depos., beginning at 30:23)

Ms. Seelig further testified to specific examples of trademarks, including KC's own use of marks other than its pleaded mark, being used on apparel as well as writing

instruments and small leather goods, including portfolio briefcases.

Opposer's introduction of a number of third-party registrations, in addition to those owned by opposer for other marks,⁹ further suggests that applicant's goods, on the one hand, and clothing apparel, on the other hand, are of a type which may emanate from a single source and would thus be related in the mind of the public. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1469 (TTAB 1988), *aff'd* (unpublished) No. 88-1444 (Fed. Cir. Nov. 14, 1988).

On this record, we find that the goods listed in the subject application and the pleaded registration are related; accordingly, this factor weighs in favor of opposer.

With respect to trade channels and classes of purchasers for the parties' goods, it is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods identified in opposer's pleaded registration. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). And

⁹ For sake of clarity, opposer's registrations (for the marks KENNETH COLE NEW YORK, KENNETH COLE and KENNETH REACTION) are only being considered in the same manner as the other third-party registrations; that is, KC is one entity that has registered

Opposition No. 91161781

where there is an absence of any restrictions in the application at issue and/or in the pleaded registration as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefore, and that they would be purchased by all potential buyers thereof. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

In the present case, both the identifications of goods in the application and the opposer's registration have no restrictions relating to trade channels or classes of purchasers. Thus, we must take into consideration that the clothing items identified in opposer's registration may be sold in the stores that carry "high-end" brands and in the stores that carry "low-end" brands. This would include boutiques as well as a variety of other retail stores that sell clothing, e.g., The Gap, Bloomindale's, Neiman Marcus, Sears, Wal-Mart, etc. Likewise, we must consider that applicant's writing instruments and "small leather goods, namely, cases for diaries and daily planners; and brief case type portfolios" will be offered in all price-ranges and encountered in all the normal trade channels for such goods.

three marks that each cover some of the same goods contained in

Opposition No. 91161781

Based on the record, there is clearly some overlapping in the trade channels of the parties' goods. At least with respect to the "high end" brands of clothing, the record shows that goods such as pens, daily planners and portfolios are offered for sale in the same commercial establishment as the "high-end" apparel.

In sum, when we consider the evidence of record in light of the relevant *du Pont* factors, we conclude that there is a likelihood of confusion. Although opposer's mark is not truly famous, it is strong and nearly identical to applicant's proposed mark, the respective goods are related, and the trade channels and classes of purchasers are potentially overlapping. If prospective purchasers were to encounter the mark LE TIGRE on applicant's writing instruments and "small leather goods, namely, cases for diaries and daily planners; and brief case type portfolios," they would be likely to believe that these products come from, are sponsored by or associated with the source of the LeTIGRÉ (stylized) clothing.¹⁰

Decision: The opposition is sustained.

the pleaded registration and the subject application.

¹⁰ Because we sustain the opposition on the priority and likelihood of confusion ground, we need not consider the dilution ground. However, because we have found that opposer's mark is not famous for purposes of the likelihood of confusion analysis, it stands to reason that opposer cannot prevail on the dilution ground which requires an even stronger showing of fame.