

THIS OPINION IS
NOT A PRECEDENT
OF THE T.T.A.B.

Hearing:
July 15, 2008

Mailed:
May 28, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Opposition No. 91169029

American Girl, LLC

v.

Barry Epstein

Lori S. Meddings and Katherine W. Schill of Michael Best & Friedrich LLP for American Girl, LLC.

Robert L. Epstein of Epstein Drangel Bazerman & James, LLP for Barry Epstein.

Before Grendel, Zervas and Mermelstein, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On January 4, 2005, Barry Epstein ("applicant") filed an application (Serial No. 78541889) for registration on the Principal Register of the mark AMERICAN BOY (in standard character form) for "clothing, namely, shirts, pants, tops, sweaters, sweatshirts and suits." Applicant claims a bona fide intent to use the mark in commerce under the provisions of Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b).

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Opposer, American Girl LLC filed a timely notice of opposition to registration of applicant's mark. In the notice of opposition, opposer pleaded, inter alia, that it is the owner of numerous registrations and applications for AMERICAN GIRL marks for clothing, dolls and doll accessories, including the following registrations for AMERICAN GIRL (in typed form):

1. Registration No. 2736477 for "slippers" (issued July 15, 2003);
2. Registration No. 2930013 for "clothing, namely tank tops" (issued March 8, 2005);
3. Registration No. 2930014 for "footwear, namely, thongs" (issued March 8, 2005);
4. Registration No. 2930015 for "clothing, namely, underwear and panties" (issued March 8, 2005);
5. Registration No. 2930016 for "clothing, namely, vests" (issued March 8, 2005);
6. Registration No. 2736476 for "clothing, namely bib overalls and overalls" (issued July 15, 2003);
7. Registration No. 2939083 for "clothing, namely, blouses" (issued April 12, 2005);
8. Registration No. 2937214 for "clothing, namely, jeans" (issued April 5, 2005);
9. Registration No. 2937215 for "clothing, namely sweat suits and sweat pants" (issued April 5, 2005); and
10. Registration No. 3018936 for "clothing, namely, sweatshirts, sweaters, v-neck sweaters, cardigans, bandannas baseball caps, gloves, mittens, pants, cropped pants, slacks, halloween costumes and masks, kerchiefs, parkas, sun visors, socks, pajamas, swim wear, bathing suits, and bathing suit cover-ups, night gowns, night shirts,

sleep shirts, and nightcaps, shorts, shirts, skorts, skirts, jackets, hats, camisoles, caps, t-shirts, belts, coats, dresses and slip dresses, robes, bathrobes, spa robes and hosiery, namely tights" (issued November 29, 2005).

We refer to these registered marks collectively as "Opposer's Marks." Opposer claims priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); that opposer's AMERICAN GIRL mark for various goods and services have achieved "tremendous fame"; and that applicant's intended use and registration of his mark is likely to dilute opposer's AMERICAN GIRL marks.

Applicant has denied the salient allegations of the notices of opposition. The parties have fully briefed this case, and the Board conducted an oral hearing on March 17, 2009.

The Record

In addition to the pleadings, the file of the opposed application is part of the record without any action by the parties. Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b). Additionally, opposer introduced the following evidence:

- (i) opposer's notice of reliance on
 - (a) certified status and title copies of the above identified registrations and others owned by opposer for the mark AMERICAN GIRL; (b) copies of various articles from printed publications; and
 - (c) printouts of various Office records showing abandoned applications for AMERICAN BOY and THE AMERICAN BOYS COLLECTION owned by opposer's predecessor-in-interest;

- (ii) the trial testimony of Julie J. Parks, opposer's director of public relations, with exhibits; and
- (iii) the declaration of Anthony L. Simms, opposer's vice-president of finance, with exhibits.¹

As for evidence introduced by applicant, applicant filed the following:

- (i) applicant's notice of reliance on printed publications and Office records;
- (ii) applicant's discovery deposition with exhibits; and
- (iii) the declaration of William C. Wright, an attorney with applicant's law firm, with exhibits.

Evidentiary Objections

Opposer objected to Exhibits 1 and 2 to Mr. Wright's declaration, which respectively comprise (i) search results for registrations and applications containing the term AMERICAN on the Office's Trademark Electronic Search System (TESS) database; and (ii) registration records for marks containing AMERICAN from the Trademark Application Registration Retrieval (TARR) database. According to opposer, the exhibits should be stricken because "Applicant has no personal knowledge related to these third party

¹ The parties have stipulated to the submission at trial of the declarations of Anthony Simms and William Wright, and of applicant's discovery deposition and exhibits. In stipulating to the submission of this evidence, each party reserved all objections with respect to the others submission, except as to those relating to the form in which the evidence was submitted.

registrations and they are unsupported by further evidence of use of the marks identified in those registrations."

Brief at pp. 2 - 3.

Opposer's objections to the exhibits to Mr. Wright's declaration are overruled. Personal knowledge of each of the third-party registrations which are the subject of the exhibits to Mr. Wright's declaration is not necessary and Mr. Wright has testified how and when he accessed the exhibits in his declaration. See *Raccioppi v. Apogee, Inc.*, 47 USPQ2d 1368 (TTAB 1998). Mr. Wright has suitably authenticated the exhibits.

Additionally, opposer objected to Exhibit 2 to applicant's notice of reliance on the ground of relevance. Exhibit 2 is a definition of "American" taken from *Random House Webster's College Dictionary* (2002), defining the term in relevant part as "of or pertaining to the United States of America or its inhabitants" and "a citizen of the United States of America." The dictionary definition is relevant to the meaning of the marks, which we consider in determining the similarity of the marks. See discussion *infra*. Thus, opposer's objection to Exhibit 2 is overruled.

Standing/Priority

Opposer has submitted status and title copies of the registrations for Opposer's Marks, showing that they are in full force and effect and are owned by opposer American

Girl, LLC. Because opposer has properly made these registrations of record, opposer has established its standing to oppose registration of applicant's mark and priority is not in issue.² *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).³

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the 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 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In the paragraphs that follow, we discuss only those *du Pont* factors which are relevant and of record. It is not required that every *du Pont* factor be considered but only

² Applicant has not contested opposer's standing.

³ The parties have argued extensively about priority based on common law use. Because opposer has pleaded and has entered its registrations into the record, we need not consider priority based on common law use.

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"those factors that are relevant and of record." See *M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006).

Fame

The first *du Pont* factor we consider is the factor of fame. The fame of the prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Fame for likelihood of confusion purposes arises "as long as a significant portion of the relevant consuming public ... recognizes the mark as a source indicator." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). In this case, because identifications of goods are for common clothing items and there are no restrictions as to gender or age, we find the relevant consuming public to be the public at large.

At p. 4 of its brief, opposer contends that since the first AMERICAN GIRL "offerings" in 1986, AMERICAN GIRL has become famous for dolls and doll accessories. At the oral hearing, when questioned whether it is opposer's position that AMERICAN GIRL is famous for clothing, opposer's

attorney responded that it is opposer's contention that opposer's mark is famous for dolls and doll accessories, and that such fame extends to clothing. We begin, therefore, by considering whether opposer has established that its mark is famous for dolls and doll accessories. The party asserting that its mark is famous bears the burden of clearly proving the asserted fame of its mark. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901 (TTAB 2007).⁴

In 1986, opposer's predecessor began using the mark AMERICAN GIRL in connection with dolls based on historical characters and accessories for such dolls, as well as books concerning such historical characters. Parks pp. 6-7. Opposer currently sells a number of different dolls based on historical figures as well as other dolls and doll accessories which are "contemporary in nature" and "encourages nurturing and educational behaviors for girls." *Id.* at p. 7. In 1992, opposer introduced "American Girl Magazine," which "sprung into advice and activity books for girls" that are part of opposer's current product line. *Id.*

⁴ Much of opposer's evidence in support of its contention that its mark is famous has been designated confidential. Some of this evidence is available to the public. For example, certain sales figures which have been marked confidential at pages 63 - 64 of Ms. Parks' testimonial deposition appear in the annual report of opposer's parent, Mattel, Inc. ("Mattel"). An annual report is a publicly available document, so the information in the annual report is not confidential. Also, Mr. Simms introduced Mattel annual reports through his declaration, and they were not marked confidential. Nevertheless, we have deferred to opposer and have not identified any information that

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Six years later, in 1998, opposer launched a retail store in Chicago, Illinois, and now has stores in New York, Los Angeles,⁵ Atlanta and Dallas, in addition to the Chicago store. Twenty-three million visitors have visited opposer's AMERICAN GIRL retail locations. *Id.* at p. 8. In these retail locations, customers may purchase dolls, doll clothing and accessories, and girl's clothing that matches the doll clothing. *Id.* at pp. 7, 8 and 10. Customers may also purchase opposer's goods, including clothing, through catalogs. *Id.* at pp. 9 - 10; Exhibits 1 - 6.

According to Ms. Parks, opposer has "sold 123 million books since 1986 ... 14 million dolls ... has 23 million visitors to our American Girl retail establishments ... [and] receive[s] roughly 50 million visits to our American Girl dot com web site per year." *Id.* at p. 8. It also released three made for television movies, one each in 2005, 2006 and 2007, based on the historical characters which are the subject of opposer's dolls and books. In July of 2008, opposer launched a feature film with an "all-star cast" performing in the movie. *Id.* at pp. 27 - 29. In addition,

opposer has marked confidential, even if it does not appear to be confidential in nature, but rather refer to it indirectly.

⁵ The New York, Chicago and Los Angeles stores average about 40,000 square feet in size, are several floors and "carry all of the product that you would normally see in America Girl catalog[s]." While in the stores, girls "can go to the café and have lunch, brunch, tea or dinner with their doll and their moms and dads. They can go to our theater, American Girl Theater, which is a live musical with girls. That brings to life our

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opposer has licensed the AMERICAN GIRL mark to (a) Hallmark, in whose stores (from 2002 - 2005) consumers could purchase AMERICAN GIRL brand cards, party favors, wrapping paper, ornaments, bookends and jewelry across the country; (b) Bath & Body Works, in whose stores (beginning in 2004) personal care products, magazines and advice books are offered; and (c) nonprofit organizations (approximately 65 per year). *Id.* at pp. 24 - 25, 47 - 48.

Opposer's evidence reflects that it has spent large sums in advertising AMERICAN GIRL goods and services through direct mail printings, mailings and a website. Parks, Ex. 21.⁶ The exact advertising figures have been designated as

historical stories in the American Girl collection." Parks at 10 - 11.

⁶ Exhibit 21, on which opposer heavily relies, in support of its contention that its mark is famous, is a document prepared by opposer's in-house counsel containing information taken from opposer's business records. Because Ms. Parks did not have personal knowledge of some of the information contained in the document, applicant's attorney objected to the admission of Exhibit 21 during Ms. Parks' testimonial deposition. (Ms. Parks did later testify that she is "familiar with the numbers and ... know[s] they're accurate because of my job ... and I know they're listed in the Mattel annual report because I get the Mattel annual report." Parks pp. 63 - 64.) Applicant did not renew his objections to Exhibit 21 in his brief. We therefore find that applicant has waived his objection to this exhibit and we have considered this exhibit. See *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504 (TTAB 2000) (objection to exhibit raised during deposition but not maintained in brief deemed waived); and TBMP § 707.03(c) (2d ed. rev. 2004). However, we have given certain statements in this document limited weight because they are hearsay. See, e.g., "source: Press Kit" regarding ranking as a children's publisher; and "source; B. Ziche/C. Horan" regarding sales of stuffed toys. Also, limited weight is given to the listing of awards opposer has received because there is no explanation of the significance of these awards.

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confidential. Opposer also has sent sizable numbers of email advertisements and catalogs to consumers. Parks Ex. 21. Its website receives roughly 50 million hits per year and opposer distributes over 60 million catalogs per year. Parks pp. 8 and 48 - 49.

Opposer has been the subject of media coverage. Articles regarding AMERICAN GIRL products and entertainment have appeared in publications such as the *Dallas Morning News*, *The Washington Post*, *Atlanta Magazine*, *Chicago Tribune* and *St. Louis Dispatch*. Parks at 48, 50, and 55; opposer's notice of reliance ex. 38 - 63. Nationally televised programs such as *The Today Show*, *Oprah Winfrey Show*, *NBC's Nightly News* and *ABC's Regis & Kelly* have featured AMERICAN GIRL products and services.

As far as sales figures, opposer maintains that it has enjoyed total sales of over \$2 billion. Simms Decl., Ex. A, p. 27; Ex. C, p. 21; Ex. F, pp. 24 and 42, Ex. G, p. 4; Ex. H, p. 48; Ex. I, p. 28. The record also includes total sales figures of clothing from the period 2001 - 2006. Parks, Ex. 21.

In carefully considering opposer's evidence bearing on the factor of fame, we find that opposer has not established that its mark is famous for dolls and doll accessories. Opposer has only provided total advertising and sales figures for all of its products and services on a yearly

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basis and has not identified the amounts specific to dolls and doll accessories. As indicated above, opposer earns income from a variety of goods and services. We elect not to make any assumptions about how much of opposer's income comes from sales of dolls and doll accessories.

Additionally, opposer has provided no context for these numbers in terms of comparing such amounts over the same period of time with others in the industry, or showing opposer's market share compared with that of other doll and doll accessory manufacturers. This also holds true with respect to the record evidence concerning the numbers of catalogs opposer distributes, the print media impressions and the broadcast television views. As for its email advertisements, from raw numbers of emails sent, we cannot determine whether this is a large number in comparison to industry averages and whether opposer has accounted for email addresses which are not active. Similarly, with regard to two of the three television movies and one feature length film, opposer has not indicated how many persons viewed its films and how this compares to industry averages.⁷ As the Federal Circuit has stated: "Raw numbers

⁷ In Exhibit 21, opposer identified the "viewership" of the movie *Samantha, An American Girl Holiday*. Opposer has designated this "viewership" confidential too; it is therefore not revealed. We also do not reveal the network on which the movie was shown; opposer too has designated this information confidential. Opposer's overreaching in designating material confidential that

of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, but raw numbers alone in today's world may be misleading ... Consequently, some context in which to place raw statistics is reasonable." *Bose*, 63 USPQ2d at 1309.

In light of the deficiencies in opposer's evidence, even when we consider other evidence such as media coverage for its goods and services and nationally televised programs, we are not persuaded of the fame of opposer's AMERICAN GIRL mark for dolls and doll accessories. We find, however, in light of opposer's evidence, that opposer's mark is a strong mark for dolls and doll accessories.

With regard to opposer's articles of clothing, we find that the strength of the AMERICAN GIRL mark extends to clothing for girls.⁸ Opposer has marketed its clothing items in the same stores and in the same catalogs in which it markets its dolls and doll accessories. Parks at pp. 10 - 11; Ex. 8 - 11. Its gross annual sales for clothing items are impressive. Parks Ex. 21. It has numerous registrations for clothing items. Opposer's notice of reliance ex. 1 - 17. Based on this evidence, we find that

is clearly not confidential is an abuse of the confidentiality provisions of the Trademark Rules. See TBMP § 703.01(p).

⁸ Exhibit 21 includes the results of a market research study which opposer conducted in 2006, including brand recognition for the AMERICAN GIRL MARK. We accord this study limited weight because there is no information about how the market research was conducted, the qualifications of the persons(s) who conducted the

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opposer has established that the public is aware of AMERICAN GIRL as a trademark for clothing and that the trademark function of AMERICAN GIRL for dolls and doll accessories has transferred to girl's clothing. See *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 942 (Fed. Cir. 1984) ("The strength of the tab as a trademark for pants might be relevant if there were evidence establishing public awareness and transference of its trademark function to related goods.").

The Goods

Next, we consider the similarity or dissimilarity of applicant's and opposer's goods, focusing on the registrations which recited goods identical or most similar to those of applicant. Registration Nos. 2930013, 2937214, 2939083, 2937215 and 3018936 recite goods which are identical or legally identical to all but one of applicant's goods. Specifically, applicant's shirts, pants, sweaters and sweatshirts are identical to those goods recited in opposer's Registration No. 3018936; applicant's "pants" include jeans, which are the goods of Registration No. 2937214; and applicant's "tops," "shirts" and "pants" are legally identical to the "tank tops," "blouses" and "sweat pants" of Registration Nos. 2930013, 2939083 and 2937215, respectively. None of the identifications include

research and what methodology opposer used in conducting the

limitations as to the intended gender of the customer who will wear the clothing, and we do not attach any gender limitations to the goods listed in the identifications.

Trade channels and classes of consumers

Because applicant's shirts, pants, sweaters, sweatshirts and tops are identical or legally identical to opposer's goods recited in certain of opposer's asserted registrations, and there are no trade channel or gender restrictions in any of the identifications of goods, we presume that the channels of trade and classes of purchasers are the same. See *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); and *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

Conditions of Sale

Applicant's and opposer's identifications of goods do not contain any limitations pertaining to the conditions of

research.

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sale of the goods. Therefore, their respective identifications of goods are broad enough to encompass inexpensive clothing which may be sold in discount stores to consumers who may not exercise a high degree of care.

The Marks

We now consider the *du Pont* factor regarding the similarity or dissimilarity of AMERICAN GIRL and AMERICAN BOY, focusing on whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports*, 73 USPQ2d at 1692.

The marks certainly look similar because they are both two word marks beginning with the longer term AMERICAN, followed by a single second word which is much shorter in length than AMERICAN. They sound similar too because the shared initial term AMERICAN has four syllables, and the succeeding wording only is one syllable in length. As for the meaning of the marks, applicant maintains they have opposite meanings. While "boy" and "girl" have different meanings, we do not find the marks to be devoid of any similarity; ultimately, they both refer to an American person of a young age and a particular gender. See *Manpower, Inc. v. Womenpower, Inc.*, 288 F. Supp 132, 159 USPQ 780, 782 (D.C.P.R. 1968) (regarding the marks MANPOWER and WOMENPOWER, "[t]he first syllables 'Women' and 'Man' are words with distinctly similar connotations and when combined

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with the word 'Power' are similar in appearance and sound and when spoken given rise to the suggestion that they are virtually identical.") As for the commercial impressions of the marks, they are highly similar. Both marks begin with the same term, AMERICAN, followed by a gender identification term. In the context of articles of clothing, which can be gender specific, AMERICAN GIRL and AMERICAN BOY give the impression that there is a common source of the goods, with one mark for a line of clothing for males and the other mark for a line of clothing for females. Opposer's notice of reliance, ex. 18 - 37. In view of the forgoing, and mindful that in cases such this case where an applicant's goods are identical to one or more of the goods identified in an asserted registration, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical, see *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992), we find the marks to be similar.

Applicant maintains that the word AMERICAN, which is the only shared term in applicant's and opposer's marks, is "extremely weak in the trademark sense, and has little if any source identification capability with respect to clothing." Brief at p. 3. In support, applicant relies on Mr. Wright's declaration which contains as exhibits numerous

use-based third-party registrations of marks containing the term AMERICAN registered for articles of clothing, with AMERICAN disclaimed.⁹ Additionally, applicant relies on the dictionary definition of AMERICAN, namely, "of or pertaining to the United States of America or its inhabitants."

As applicant points out, the Board in *American Hospital Supply Corporation v. Air Products and Chemicals, Inc.*, 194 USPQ 340, 343 (TTAB 1977), stated that third-party registrations are "competent to establish that a portion common to the marks involved in a proceeding has a normally understood and well known meaning; that this has been recognized by the Patent and Trademark Office by registering marks containing such a common feature for the same or closely related goods where the remaining portions of the marks are sufficient to distinguish the marks as a whole; and that therefore the inclusion of the term ... in each mark may be an insufficient basis upon which to predicate a holding of confusing similarity."

We do not predicate our finding that the marks are similar based only on the inclusion of AMERICAN in applicant's and opposer's marks. The marks are similar not

⁹ The listing of search results included with Mr. Wright's declaration taken from the Office's TESS database containing "live" and "dead" applications and registrations for marks containing "American" has limited probative value. The listing of applications is only proof that an application was filed with the Office, see *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047

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just because AMERICAN appears in both marks, but also because of the combination of AMERICAN and either BOY or GIRL. As noted above, the combination, AMERICAN GIRL and AMERICAN BOY are similar in meaning, sound, appearance and connotation. There is a similarity in the marks, not just from the shared term AMERICAN, but also from the other wording and word order in the marks. Thus, even if AMERICAN is widely registered and disclaimed, and even if the consuming public considers other wording in opposer's marks in determining the source of clothing goods, when the marks are considered as a whole, the composition of the marks suggests a commonality of source of the goods.

Actual Confusion

Applicant also argues that there has been no actual confusion between the AMERICAN GIRL and AMERICAN BOY marks. The Federal Circuit, however, has taken a skeptical view of statements asserting the absence of actual confusion stating that, "A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight (citation omitted)" *Majestic*, 65 USPQ2d at 1205. Moreover, the record does not reflect that there has been appreciable use

(TTAB 2002); there are no goods or services identified in the listing; and many of the registrations are identified as "dead."

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of the AMERICAN BOY mark.¹⁰ Epstein pp. 19 - 33. Thus, the fact that there has been no actual confusion carries little weight in our analysis.

Balancing the Factors

For the reasons stated above, we resolve the *du Pont* factors regarding the similarity of the marks, goods, trade channels and purchasers in favor of finding a likelihood of confusion. Because the lack of evidence of actual confusion carries little weight, the *du Pont* factor regarding actual confusion is neutral. We also have found the AMERICAN GIRL mark to be a strong mark for dolls and doll accessories, and that its strength extends to articles of clothing for girls, including those clothing items identified in the registrations asserted by opposer. Thus, even if AMERICAN is weak term in the clothing field, as applicant contends, we conclude that there is likelihood that applicant's marks will be confused with Opposer's Marks.

Dilution

Because we have found for opposer in connection with its likelihood of confusion claim, we do not reach its claim of dilution.

¹⁰ Even though applicant has filed his application under the intent-to-use provisions of the Trademark Act, applicant has submitted some evidence that he has used the mark prior to the filing date of the application, although that use may not have been continuous use.

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DECISION: The opposition on the ground of likelihood of confusion is sustained and registration to applicant of his mark is refused.