

ESTTA Tracking number: **ESTTA687365**

Filing date: **08/03/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91213413
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

MAPPIN & WEBB, LIMITED)	
)	Opposition No. 91213413
Opposer,)	
)	
v.)	Application Serial No. 85/460569
)	
M WEBB, LLC)	For the Mark: M WEBB
)	
Applicant.)	

APPLICANT'S MAIN ACR BRIEF

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I. INTRODUCTION

Fashion designer Marissa Webb is a prominent figure within the United States fashion industry, having led the major U.S. fashion brands J. Crew and Banana Republic and indelibly marking the U.S. fashion community with her distinctive style for well over a decade. Ms. Webb launched her eponymous fashion label after forming Applicant M Webb LLC (“M Webb”) in 2011, with the vision to diversify its fashion lines under additional labels while capitalizing on her own reputation through brand names synonymous with her personal name. As a part of that strategy, M Webb filed the intent-to-use application for the M WEBB mark in 2011, covering women’s apparel, bags, and accessories.

M Webb and its principal were surprised in 2013 when Mappin & Webb Limited (“Opposer”), a British firm unfamiliar to Ms. Webb, filed a Notice of Opposition on the basis that the M WEBB mark was confusingly similar with its MAPPIN & WEBB and MAPPIN & WEBB LONDON marks (“Opposer’s Marks” or “the MAPPIN & WEBB Marks”). Although Opposer filed the MAPPIN & WEBB Marks on an intent-to-use basis and has produced evidence of only a single sale of goods under those marks to customers in the U.S., it nonetheless would have the Board deny registration for the M WEBB mark on the counterintuitive premise that consumers are likely to perceive it as an abbreviation of Opposer’s Marks. Rather, confusion is unlikely between these marks because they are dissimilar, Opposer has a weak reputation and is unlikely to be recognized among relevant consumers, and there have been no instances of actual confusion.

First, Opposer's Marks and the M WEBB mark only share the initial consonant "M" and common surname "Webb." The stand-alone letter is pronounced differently in the M WEBB mark and Opposer's Marks, and the surname "Webb" is the weak element of Opposer's Marks and unlikely to make a strong commercial impression on consumers. Consumers' and the fashion industry's tendency to truncate or abbreviate marks would simply widen the dissimilarity between the marks at issue, as consumers are likely to focus on the more distinctive surname "Mappin" or the initials "MW" in the case of Opposer's Marks, while by contrast they are likely to truncate the personal name mark M WEBB to "Webb."

Second, the Board's tolerance of similarity between marks varies inversely with the fame of the prior mark, and Opposer has a weak reputation within the United States. Only a fraction of Opposer's purported history and sales efforts within the United Kingdom pertain to the U.S. market, which is the only relevant market in this proceeding.

Third, the Board presumes that goods and services flow through all normal channels of trade and classes of purchasers when, as here, no restrictions are identified in the applications at issue, and the Board must focus on the least sophisticated class of purchasers in making its determination of likelihood of confusion based on Opposer's prior filed intent to use applications. Opposer's stated tradition as the jeweler of British royalty and its affiliation with high-end sporting and fashion events is less likely to be recognized by such purchasers.

Finally, although Opposer's Marks are based on its intent to use, Opposer spends considerable time discussing its purported well-known reputation under the MAPPIN & WEBB Marks. There is no evidence of actual confusion, however, between Opposer's

Marks and the M WEBB mark, nor is there any evidence of actual confusion between Opposer's Marks and M Webb's MARISSA WEBB brand or with Marissa Webb. Marissa Webb has developed a distinctive, recognizable style throughout the entirety of her career, both preceding and including her work under the MARISSA WEBB brand. Her distinctive, continuous style, when coupled with the general tendency among consumers to shorten designers' personal names to their surnames, renders a continuing commercial impression. The absence of actual confusion under such circumstances weighs against likelihood of confusion.

II. STATEMENT OF ISSUES

Whether there is a likelihood of confusion between Opposer's MAPPIN & WEBB and MAPPIN & WEBB LONDON marks and Applicant M Webb's M WEBB mark where:

1. The only similarity between the MAPPIN & WEBB Marks and the M WEBB mark is the beginning letter "M" and the common surname "WEBB";
2. The word "MAPPIN" is the dominant element of the "MAPPIN & WEBB" Marks;
3. Opposer identifies itself as "MAPPIN & WEBB," "MAPPIN," "MW," or "M&W";
4. Consumers are unlikely to abbreviate "Mappin & Webb" to "M Webb" and therefore are unlikely to perceive the M WEBB mark as an abbreviation of the MAPPIN & WEBB Marks;
5. Opposer and its Marks are not famous within the United States, and the relevant class of U.S. purchasers is unlikely to recognize Opposer or its Marks;

6. There is no evidence of actual confusion between the MAPPIN & WEBB Marks and the M WEBB mark, nor is there any evidence of actual confusion between Marissa Webb or the MARISSA WEBB mark and the MAPPIN & WEBB Marks throughout Ms. Webb's seventeen-year career as a fashion designer.

III. DESCRIPTION OF THE RECORD

The evidence of record in this case consists of:

1. The Declarations of Elizabeth Galton, Brian Duffy, and Morgan Smith, with exhibits, filed in support of Opposer's Main ACR Brief.

2. The Declaration of Randy Kercho, President of Bedrock Brands I, LLC, with Exhibits 1-18, discussing, among other issues, M Webb, its principal Marissa Webb, the creation of the M WEBB and MARISSA WEBB marks, the MARISSA WEBB brand, the abbreviation of the MAPPIN & WEBB Marks, the uniqueness of the surnames "Mappin" and "Webb," the dissimilarity of Opposer's and M Webb's marks, and the absence of actual confusion between the marks at issue and between Opposer and its Marks and M Webb, Marissa Webb, or the MARISSA WEBB mark.

3. The Declaration of Marissa Webb, principal of M Webb, with Exhibits 1-23, discussing, among other issues, her reputation and career as a fashion designer, the creation of M Webb and the MARISSA WEBB and M WEBB marks, the advertising, marketing, and promotion of the MARISSA WEBB mark, the dissimilarity of Opposer's and M Webb's marks, and the absence of confusion between the marks at issue and between Opposer and its Marks and herself, M Webb, or the MARISSA WEBB mark.

4. The Declaration of David J. Diamond, counsel for M Webb, with Exhibits 1-87 offering into evidence materials admissible under notice of reliance under TBMP § 704 and the ACR Stipulation (Doc. 16).

5. The file histories of M Webb's applications for the MARISSA WEBB and M WEBB marks and Opposer's applications for the MAPPIN & WEBB LONDON and MAPPIN & WEBB marks are automatically of record. 37 C.F.R. § 2.122.

IV. RECITATION OF FACTS

A. M Webb and its principal Marissa Webb

Applicant M Webb LLC was formed by famed U.S. fashion designer Marissa Webb in 2011 to launch her own lines of apparel, bags, and accessories. (Declaration of Marissa Webb [hereinafter "Webb Decl."] ¶ 6; Declaration of Randy S. Kercho [hereinafter "Kercho Decl."] ¶ 7.) After studying at the prestigious Fashion Institute of Technology and being involved with various fashion brands, she led the renowned U.S. apparel brand J. Crew as head of women's design and accessories. (Webb Decl. ¶ 4.) Ms. Webb turned around J. Crew's fashion image and has become a well-recognized name in U.S. fashion design. (Kercho Decl. ¶ 5.) While creating M Webb, Ms. Webb transitioned to become the creative director of famed U.S. apparel brand Banana Republic, and continues in that position today. (Webb Decl. ¶ 7.)

The vision behind M Webb was to diversify Ms. Webb's fashion lines of women's and men's apparel, bags, and accessories under trademarks that would be identifiable with Ms. Webb's personal name and thereby benefit from her considerable reputation. (*Id.* ¶ 6; Kercho Decl. ¶ 8.)

B. The MARISSA WEBB and M WEBB marks

In furtherance of Ms. Webb's vision, M Webb filed an intent-to-use application with the U.S. Patent & Trademark Office for registration of the M WEBB mark on October 31, 2011, identifying "handbags, purses, wallets, [and] tote bags" in International Class 18, and "women's apparel and accessories, namely, shirts, t-shirts, pants, dresses, skirts, short, jackets, coats, sweaters, lingerie, pajamas, robes, socks, hosiery, scarves, gloves, hats, belts and footwear" in International Class 25. (Webb Decl. ¶ 8; Declaration of David J. Diamond [hereinafter "Diamond Decl."] ¶¶ 3-4, Exs. 1-2.) The M WEBB mark was selected because M Webb believed it was immediately identifiable as an abbreviation of Marissa Webb's personal name, and therefore the intended line would capitalize on the reputation she had developed in the U.S. fashion industry. (Webb Decl. ¶ 8; Kercho Decl. ¶ 10.)

M Webb filed an intent-to-use application with the PTO for registration of the MARISSA WEBB mark on February 14, 2012, covering "women's accessories, namely, jewelry" in International Class 14; "handbags, purses, wallets, [and] tote bags" in International Class 18; and "women's apparel and accessories, namely, shirts, t-shirts, pants, dresses, skirts, shorts, jackets, coats, sweaters, lingerie, pajamas, robes, socks, hosiery, scarves, gloves, hats, belts and footwear" in International Class 25. (Diamond Decl. ¶ 3, Ex. 1). As with the selection of the M WEBB mark, M Webb's motivation in choosing the MARISSA WEBB name was to capitalize on the considerable reputation Ms. Webb has developed in the U.S. fashion industry. (Kercho Decl. ¶ 9.)

C. Ms. Webb's eponymous MARISSA WEBB line

Ms. Webb launched her eponymous MARISSA WEBB label in 2012, creating a line of women's clothing and accessories that reflected the feminine elegance and masculine edge synonymous with her image. (Kercho Decl. ¶¶ 12-13.) This distinctive style is recognizable throughout Ms. Webb's career, both preceding and pervading her work for the MARISSA WEBB line to create a continuous identifiable imprint within U.S. fashion. (Webb Decl. ¶¶ 5, 20.)

Though M Webb has yet to launch its M WEBB label, MARISSA WEBB branded fashion goods are offered through M Webb's website located at the domains <mwebb.com> and <marissa-webb.com>. (*Id.* ¶ 9; Kercho Decl. ¶ 13.) U.S. customers may purchase MARISSA WEBB items directly through the website, and M Webb focuses its sale of the MARISSA WEBB line through high-end retailers and boutiques in major urban centers across the United States, including Intermix, Barneys, Neiman Marcus, Viola Lovely, Bergdorf Goodman, Pas De Deux, Latrice, 20Twelve, Canary, Mario's, Shop Bop, Lyndon's, and MI Place. (*Id.* ¶ 9; Kercho Decl. ¶ 13.) The MARISSA WEBB brand markets to sophisticated, higher-end female customers. (Kercho Decl. ¶ 12.)

Ms. Webb and the MARISSA WEBB line have enjoyed critical acclaim and broad media attention, appearing in unsolicited major media outlets and fashion publications such as *InStyle*, *Cosmopolitan*, *Elle*, *Lucky*, *People*, *Shape*, *Women's Health*, *Los Angeles Times*, *The New York Times*, *The Wall Street Journal*, *Marie Claire*, *Glamour*, *Esquire*, *Harper's Bazaar*, *O The Oprah Magazine*, *E!*, *CBS News*, and *ABC News*. (Webb Decl. ¶ 12, Exs. 1-18.) In addition, MARISSA WEBB fashion lines appear

in semiannual fashion shows, including in New York's renowned Fashion Week for the past three (3) years. (*Id.* ¶ 10.) Marissa Webb herself commands a strong social media presence, and M Webb likewise vigorously promotes the MARISSA WEBB label through various social media platforms. (*Id.* ¶ 10-11.) Ms. Webb and her MARISSA WEBB line have likewise been featured in online look books and fashion blogs such as *Atlantic-Pacific*, *Fashionista*, and *Who What Wear*. (*Id.* ¶ 13.)

D. Opposer's MAPPIN & WEBB Marks

On June 20, 2011, Opposer filed its intent-to-use applications for the MAPPIN & WEBB mark and MAPPIN & WEBB LONDON mark. (Opposer's Main ACR Brief [Doc. 22, hereinafter "Opp.'s Br.,"] at 15.) These applications identify goods across a range of classes, including cutlery in International Class 8, leather articles in International Class 9, precious metal articles and watches in International Classes 14 and 16; leather articles in International Class 18; mirrors, frames and home furnishings in International Class 20, domestic kitchen and bar utensils, containers, house wares, and table ware in International Class 21, and retail store services in International Class 35. (*Id.*)

U.S. customers are unable to purchase Opposer's goods through its website, and any purchase of Opposer's online goods by U.S. consumers requires the assistance of customer service to complete an order. (*Id.* at 13.) Any other direct purchases by U.S. customers require in-person visitation of Opposer's British and other foreign store locations. (*Id.* at 12-13; Factual Stipulation [Doc. 17, hereinafter "Stip.,"] ¶¶ 5-6.) In the course of this proceeding, Opposer has produced evidence of only a single sale from Opposer to customers in the U.S. for goods covered under the MAPPIN & WEBB and MAPPIN & WEBB LONDON marks. (Opp.'s Br. at 13 n.3; Declaration of Elizabeth

Galton [Doc. 24, hereinafter “Galton Decl.”] ¶ 40, Ex. 25; Diamond Decl. ¶¶ 5-6, Ex. 3 at 5-6 & Ex. 4 at 2-3.)

Though Opposer has purportedly met with U.S. retailers for the sale of goods under the MAPPIN & WEBB Marks, it has no stores in the U.S. (Opp.’s Br. at 14-15; Stip. ¶ 5.). Opposer’s U.S. market presence consists predominately of vintage items offered through online resellers such as eBay, but such goods are limited to decades-old collectibles. (*see* Galton Decl. ¶ 15; Diamond Decl. ¶ 7, Ex. 5 at 1-5.) There is no evidence of any actual confusion between Opposer’s Marks and the M Webb’s marks per the stipulation of the parties, and M Webb is unaware of any instances of confusion between Opposer’s marks and either itself or Ms. Webb throughout the entirety of her career. (Stip. ¶ 11; Webb Decl. ¶ 20; Kercho Decl. ¶ 25.)

V. ARGUMENT

Opposer’s claims of likelihood of confusion are based upon a form of abbreviation that disregards well-established principles of consumer perception, while the strength of Opposer’s Marks is bolstered by foreign use devoid of trademark significance in this proceeding. There is no likelihood of confusion between Opposer’s Marks and the M WEBB mark, and Opposer’s factually implausible and legally flawed claims to the contrary should be denied.

A. **The MAPPIN & WEBB Marks are weak.**

Opposer’s marks are weak marks entitled to a narrow scope of protection. Trademark strength is determined by both conceptual strength and commercial strength. *Coach/braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 U.S.P.Q.2d 1458, 1476 (TTAB 2014) (“In determining the strength of a mark, we consider both its inherent

strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark.”). Even conceptually strong arbitrary and suggestive terms may be relatively weak marks if they receive little publicity. 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (4th ed. 2014) (hereinafter “MCCARTHY”). Regardless of whether Opposer’s double-surname marks possess conceptual strength, their utter lack of exposure within the United States underscores their commercial weakness.

Opposer’s evidence of media exposure and stated history as jewelers and silversmiths of British royalty simply do not translate to trademark strength within the U.S. market – the only market relevant for this proceeding. *Hard Rock Café Licensing Corp. v. Elsea*, 48 U.S.P.Q.2d 1400, 1405 (TTAB 1998) (“While the alleged fame of opposer’s mark is a factor to consider in relation to opposer’s claim of likelihood of confusion, only the fame of opposer’s marks among consumers in the United States is of relevance to us.”); *Double J of Broward, Inc. v. Skalany Sportswear GmbH*, 21 U.S.P.Q.2d 1609, 1612 (TTAB 1991) (“Information concerning applicant’s foreign activities . . . is not relevant to the issues in an opposition proceeding.”). As detailed below, once Opposer’s evidence has been properly distilled to only those activities within the U.S. market, its marks are stripped of commercial strength. Regardless of conceptual strength, the stark commercial weakness of Opposer’s marks result in weak marks on the whole, which narrows the scope of protection that should be afforded to Opposer’s Marks and mitigates likelihood of confusion. *See* MCCARTHY 11:76. (*See* Applicant’s Main ACR Brief, *infra* at Section V.B.2.)

B. Confusion is not likely between Opposer's Marks and the M WEBB mark.

“A determination of likelihood of confusion is the ultimate legal conclusion based on findings of fact for each pertinent *DuPont* factor considered together.” *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 202, 22 U.S.P.Q.2d 1542, 1544 (Fed. Cir. 1992). The Board is “not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.” *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 717, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (quoting *Witco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d 1403, 1405, 164 U.S.P.Q. 43, 44-45 (CCPA 1969)). In applying Section 2(d) of the Lanham Act, “two key considerations are the similarities between the marks and the similarities between the [goods and] services.” *Coach/braunsdorf Affinity, Inc.*, 110 U.S.P.Q.2d at 1475. The dissimilarity of the marks alone may be dispositive of likelihood of confusion, and the Board may rely solely on the dissimilarity of the marks in finding in favor of an applicant and dismissing an opposition. *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375, 47 U.S.P.Q.2d 1459, 1460-61 (Fed. Cir. 1998). Opposer's MAPPIN & WEBB marks and the M WEBB mark are dissimilar, and under the pertinent *DuPont* factors, Opposer's claims of likelihood of confusion should be denied.

1. The MAPPIN & WEBB and M WEBB marks are dissimilar.

a. M Webb's mark is dissimilar to Opposer's Marks in sight and sound.

Opposer's MAPPIN & WEBB marks and the M WEBB mark are visually and aurally dissimilar. Opposer's MAPPIN & WEBB marks consist of four (4) and six (6) syllables, respectively, with the first word consisting of the surname “MAPPIN.” M

Webb's M WEBB mark consists only of two (2) syllables. (*See* Webb Decl. ¶ 16.) Though both Opposer's marks and the M WEBB mark begin the letter "M," Opposer's marks are pronounced with a short "ma" sound, whereas the "M" in the M WEBB mark is pronounced with an "em" sound customary for pronouncing the stand-alone consonant. (*Id.* ¶ 17.) The only overlapping word or phonetic sound is the surname "Webb." (*See id.*) Despite the visual and aural dissimilarity with the majority of Opposer's Marks, Opposer erroneously concludes without any evidence or authority that the marks are similar in sight and sound.

b. M Webb's mark is dissimilar to Opposer's Marks in connotation.

Opposer's Marks and the M WEBB mark are likewise dissimilar in their connotation. The M WEBB mark is synonymous with its owner's corporate name, which is in turn an abbreviation of its principal, the renowned fashion designer Marissa Webb. (Webb Decl. ¶¶ 6, 8, 18.) The use of a single consonant followed by a surname carries the meaning of an abbreviated first name, and is in fact the diminutive name by which Marissa Webb herself is actually known. (*See id.* ¶ 18.) By contrast, Opposer's Marks begin with the distinctive surname "MAPPIN" rather than a common first name, followed by a second surname "WEBB" separated by an ampersand. Opposer's Marks thus connote two distinct surnames as is common among company names, which are commonly referred to by the two beginning initials or simply the first surname, as Opposer itself does. (Opp.'s Br. at 9-10; Webb Decl. ¶ 15; Kercho Decl. 16-17; Diamond Decl. ¶¶ 11-12, Exs. 32-66.) By contrast, M Webb's mark carries the meaning of a single person's name with an abbreviated first name, as is common for personal name marks. (*See* Webb Decl. ¶ 18.)

c. M Webb's mark is dissimilar to Opposer's Marks in commercial impression.

It is well established that the similarity or dissimilarity of the marks in their entirety is to be considered, and more or less weight may be given to particular features of the marks. *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1357, 56 U.S.P.Q.2d 1351, 1353-54 (Fed. Cir. 2000). Accordingly, the dominant element of a mark receives greater weight in determining likelihood of confusion. *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1351, 98 U.S.P.Q.2d 1253, 1257 (Fed. Cir. 2011) (quoting *Kangol, Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 163, 23 U.S.P.Q.2d 1945, 1946 (Fed. Cir. 1992)). The dominant element is most often the first word consumers encounter for literal word marks and is most likely to be remembered. *Id.*; *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 U.S.P.Q.2d 1895, 1897 (TTAB 1998).

The relative uniqueness of the surname "MAPPIN" coupled with its positioning at the beginning of each of Opposer's Marks reinforces its dominance. The surname "Webb" is among the top 150 most common surnames in the United States, while the surname "Mappin" does not even rank among the top 1,000. (Kercho Decl. ¶ 18, Ex. 6 at 3; *see also id.* ¶¶ 19-24.) Furthermore, there are over a dozen active third-party registrations for goods within the classes at issue in this opposition involving the surname "Webb," whereas Opposer owns the only active registrations within the classes at issue on the Federal Register involving the surname "Mappin." (Diamond Decl. ¶¶ 8-9, Exs. 6-20, 24-31.)

Indeed, Opposer's own materials and authority support the conceptual dominance of the surname "MAPPIN" over "WEBB." (Diamond Decl. ¶ 14, Ex. 84 (document

produced by Opposer illustrates use of solely the surname “Mappin” to identify Opposer.) *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 U.S.P.Q.2d 1689, 1692 (Fed. Cir. 2005) (holding that of opposer’s VEUVE CLIQUOT mark, VEUVE “remains a ‘prominent feature’ as the first word in the mark” and “constitutes ‘the dominant feature’ in the commercial impression created by [opposer’s] marks.”); *In re Restoration Hardware, Inc.*, Serial No. 85885460, 2015 WL 1227732, at *4 (TTAB Feb. 23, 2015) (non-precedential) (“The position of the letters ‘R.H.’ as the first part of the mark R.H. VINTAGE further reinforces the importance of ‘R.H.’ as the dominant element of the mark”). The relative weakness of the surname “Webb” in the marketplace indicates that consumers are able to distinguish between “Webb” marks based on small distinctions. *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 U.S.P.Q.2d 1477, 1479 (TTAB 1987); see *In re Broadway Chicken, Inc.*, 38 U.S.P.Q.2d 1559, 1565-66 (TTAB 1996) (“Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to other elements of the marks as a means of distinguishing the source of goods or services in the field.”). (See Kercho Decl. ¶¶ 19-24, Exs. 7-18.)

Where the common element of two marks is a weak word like the surname “Webb,” likelihood of confusion is reduced. MCCARTHY § 23:48; see *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 1401-02, 167 U.S.P.Q. 529, 530 (CCPA 1970); *Knapp-Monarch Co. v. Poloron Products, Inc.*, 134 U.S.P.Q. 412, 414 (TTAB 1962) (finding no likelihood of confusion between THERMEX and THERM-A-JUG because the common word “THERM” was suggestive); *Societe Anonyme De La Grande*

Disillerie E. Cusenier Fils Aine & Cie. v. Julius Wile Sons & Co., 161 F. Supp. 545, 547, 117 U.S.P.Q. 257, 259 (S.D.N.Y. 1958) (“In the instant case the term ‘mint’ which is common to both marks, is concededly descriptive and common to the trade and even when joined with a more fanciful prefix is not likely to provide the source of confusion.”). Thus the commercial impression of Opposer’s Marks and the M WEBB mark reinforce their dissimilarity.

d. Consumer patterns of abbreviation amplify the marks’ dissimilarity.

Given the dissimilarity of Opposer’s Marks and the M WEBB mark, Opposer’s claim turns on whether consumers are likely to abbreviate Opposer’s MAPPIN & WEBB Marks to “M Webb.” The Board has indeed recognized consumers’ propensity to shorten or abbreviate trademarks, but Opposer misconstrues the Board’s precedent to claim *any* abbreviation regardless of the broader framework of how consumers retain impressions of trademarks, particularly within the fashion industry. Well-established principles of consumer perception, however, do not give Opposer such a wide berth.

Opposer’s Marks overlap with the M WEBB mark only through their weak element. As detailed above, the dominant impression formed by Opposer’s Marks is the unique and initial “Mappin” surname. Opposer’s reliance on *In re SL&E Training Stable, Inc.* is therefore misplaced, as in that case the registrant’s mark consisted of the sole – and therefore unequivocally dominant – surname “EDELMAN,” while the applicant’s mark consisted of the personal name “SAM EDELMAN.” 88 U.S.P.Q.2d 1216, 1216-17 (TTAB 2008). As the Board recognized, fashion designers are “frequently referred to by their surnames alone,” which resulted in a likelihood of confusion because the applicant designer’s surname was synonymous with the opposer’s

single-surname mark. *Id.* at 1219 (quoting *Nina Ricci S.A.R.L. v. Haymaker Sports, Inc.*, 134 U.S.P.Q. 26, 28 (TTAB 1962)). The *Big M. Inc. v. U.S. Shoe Corp.* decision illustrates a similar overlap, in which the applicant's mark – consisting of initials and the surname MANDY – was phonetically identical to the registrant's single-surname MANDEE mark upon abbreviation of applicant's mark to the surname.¹ 228 U.S.P.Q. 614, 616 (TTAB 1985).

By contrast, the overlapping word of Opposer's and M Webb's marks – the surname "Webb" – comprises the weak element of Opposer's double-surname marks. The claim that "M WEBB" would be perceived as an abbreviation of "MAPPIN & WEBB" thus contravenes consumer tendencies to focus on the dominant portion of a compound mark, in this case the unique surname "Mappin" at the beginning of each of Opposer's Marks. Furthermore, Opposer has offered no evidence that it abbreviates its marks as "M Webb." Rather, Opposer claims to abbreviate to its "MW" monogram or to "M&W," and Opposer's own materials support that of the two surnames, "Mappin" is used in isolation as an abbreviation of Opposer's Marks. (Opp.'s Br. at 9-10; Diamond

¹ The *In re Restoration Hardware* and *Fiserv, Inc. v. Elec. Transaction Syst. Corp.* decisions cited by Opposer are inapposite in that the second word in the applicants' compound marks R.H. VINTAGE and POPMONEY clearly did not involve surnames, and therefore these cases have no bearing on how consumers tend to abbreviate within that distinct context. *In re Restoration Hardware, Inc.*, 2015 WL 1227732, at *3, 5; *Fiserv, Inc. v. Elec. Transaction Syst. Corp.*, 113 U.S.P.Q.2d 1913, 1918-19 (TTAB 2015). In *Restoration Hardware*, the word "Vintage" carried a descriptive meaning, and the marks in *Fiserv* had no relation to the commercial impression of personal or surname marks or the fashion industry whatsoever. *See id.*; *Reidl Uhrengrosshandels-Gesellschaft M.B.H. v. Viva Time Corp.*, Serial No. 74542908, 1999 WL 590698, at *3 (TTAB July 30, 1999) (non-precedential) (finding no likelihood of confusion between JACQUES LAURENT and JACQUES LEMANS after giving greater weight to the surname portions of the marks and distinguishing the Board's contrary conclusion between DUCA D'AREZZO and DUCA D'AOSTA on the basis that the DUCA marks did not consist of a given name and surname) (Diamond Decl. ¶ 16, Ex. 86).

Decl. ¶ 14, Ex. 84.) Indeed, the only trademark that Opposer has registered in the U.S. that focuses on one surname over the other is MAPPIN PLATE (U.S. Reg. No. 1,270,685), which reinforces its dominance and is probative of how consumers would likewise abbreviate Opposer's marks. *See Saks & Co. v. TFM Industries, Inc.*, 5 U.S.P.Q.2d 1762, 1764 (TTAB 1987) (finding it likely that purchasers may likewise tend to abbreviate applicant's mark FOLIO BY FIRE ISLANDER to simply FOLIO in part because "applicant's president and chief executive officer was prone to [such] abbreviation"). (Diamond Decl. ¶ 8, Ex. 23.)

The *Marshall Field & Co. v. Mrs. Fields Cookies* decision more accurately reflects consumer perceptions for the marks at issue. In *Marshall Field*, the petitioner claimed likelihood of confusion between its FIELD'S mark for department store services and MARSHALL FIELD'S mark for baked goods and department store services on the one hand, and the respondent's MRS. FIELDS marks for baked goods and bakery store services on the other, which, as here, began with the letter "M" and shared a common surname. 25 U.S.P.Q.2d 1321, 1323 (TTAB 1992). The Board recognized that companies are "frequently called by their shortened names," and that the petitioner not only used its MARSHALL FIELD'S mark for baked goods, but also used the abbreviation FIELD'S for baked goods similar to those covered by respondent's MRS. FIELDS marks. *Id.* at 1330, 1333. The Board acknowledged that retail channels of trade for the parties existed in close proximity and that the petitioner had even at one time proposed locating one of the respondent's retail baked goods stores inside one of the petitioner's department stores, and the Board ultimately concluded that the parties' goods were so related that use of confusingly similar marks was likely to cause confusion. *Id.* at

1331, 1334. Nonetheless, it found no likelihood of confusion between the two based in large part on the weakness of the shared surname “FIELD”:

[W]e do not have to find proof of use of FIELD(S) as a trade or service mark in order to conclude that this is a common surname easily recognized as such and that purchasers are accustomed to distinguishing between such common surnames by whatever slight differences may exist in the marks as a whole. In this case, the question is whether the addition to FIELD(S) of, on the one hand, the given name MARSHALL and, on the other, the title MRS., is enough of a difference to enable purchasers to make that distinction. We believe that, given the fame of MARSHALL FIELDS for department store services and the fame shown to have been afforded to MRS. FIELDS for its bakery services and goods, the public will readily recognize the differences in the marks as used on the respective goods and services and are not likely to be confused as to the sources of the goods and services offered thereunder.

25 U.S.P.Q.2d at 1331-32. Just as in *Marshall Field*, consumers are likely to recognize the commonness of the “Webb” surname in Opposer’s and M Webb’s marks and readily distinguish them, forestalling any likelihood of confusion.

Consumer inclination to dissimilarly shorten or abbreviate Opposer’s and M Webb’s marks is reinforced by marketplace realities. Particularly within the fashion industry, the personal name marks of designers are often shortened to surnames alone. *In re SL&E Training Stable, Inc.*, 88 U.S.P.Q.2d at 1219 (TTAB 2008) (quoting *Nina Ricci S.A.R.L.*, 134 U.S.P.Q. at 28 (“it is common knowledge that various couturiers such as Christian Dior, Huber de Givenchi, and Jacques Fath are frequently referred to by their surnames alone”)). While this tendency supports that the M WEBB mark might be shortened to WEBB, the same principle fails to apply to compound surname marks such as Opposer’s. Rather, any abbreviation of Opposer’s marks, based on established principles of consumer perception and Opposer’s own track record in marketing its brand, would focus on “MAPPIN” or on the initials “MW.” (Opp.’s Br. at 9-10; Diamond Decl. ¶ 11-14, Exs. 32-66, 84; Kercho Decl. ¶ 17, Exs. 2-3.)

Opposer's portrayal of "marketplace realities" on this issue is either misleading or unresponsive to confusion between the parties' marks. Of the examples cited in Opposer's Brief, several are abbreviations of compound word marks to their beginning initials (Kentucky Fried Chicken – KFC, Bank of America – BofA, Dolce & Gabbana – D&G, Hewlett-Packard – HP), while others support M Webb's contention that abbreviation of Opposer's marks would focus on the dominant "Mappin" portion (Budweiser – Bud, Chevrolet – Chevy, MacIntosh – Mac). (Opp.'s Br. at 21.) Of the two-word marks purportedly supportive of Opposer's claims, it is noteworthy that the names Facebook and Starbucks feature non-surname words, and in the case of Abercrombie & Fitch, the domain for the company's own website is www.abercrombie.com, while its related children's brand features only the first word "Abercrombie" in common. (*Id.*; Diamond Decl. ¶ 12, Exs. 56-58.)

Of the *Fortune* 500 companies with compound name marks, a substantial number are abbreviated to the first word of their names or to their initials. (Diamond Decl. ¶ 11, Exs. 32-55; Declaration of Morgan E. Smith [Doc. 25] ¶ 9, Exs. 84, 105, 109, 110.) More importantly, the tendency to abbreviate compound word marks to first initials separated by an ampersand is common in the fashion industry, as is the tendency for the brands of individual fashion designers to be shortened to only their surnames. (Diamond Decl. ¶ 13, Exs. 67-83.) Because Opposer's marks are likely to be shortened to "Mappin," "MW," or "M&W," whereas general proclivities would favor shortening the M WEBB mark to "Webb," the likely abbreviation of the marks would actually decrease the similarity between the parties' marks, which heavily weighs against a finding of likelihood of confusion.

2. Opposer's Marks are not famous or well known within the United States, and relevant purchasers are unlikely to recognize Opposer's Marks.

Opposer goes to great lengths in its Brief to detail its heritage, commercial performance, and the promotion of the MAPPIN & WEBB Marks. Opposer itself does not argue fame as a relevant *DuPont* factor, nor could it, as the competent evidence of Opposer's reputation reflects minimal impact on U.S. consumers, who are the relevant focus of this proceeding. The Board considers the advertising, sales, and length of use of Opposer's Marks to gauge fame, and "the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark." *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 352-53, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992). It thus stands to reason that while a more famous mark merits wider protection, a less famous mark merits narrower protection.

As the Board made clear in *Hard Rock Café Licensing Corp. v. Elsea*, "only the fame of opposer's marks among consumers *in the United States* is of relevance. The renown of opposer's marks outside the United States or exposure of the foreign public to opposer's marks is irrelevant." 48 U.S.P.Q.2d 1400, 1405 (TTAB 1998) (emphasis added); *see also Double J of Broward, Inc. v. Skalony Sportswear GmbH*, 21 U.S.P.Q.2d 1609, 1612 (TTAB 1991) ("Information concerning applicant's foreign activities is not relevant to the issues in an opposition proceeding"). Therefore none of Opposer's purported history within the British market as silversmiths to royalty, designers of elite sports trophies, and sellers of jewelry and fashion goods within the United Kingdom have any bearing on this proceeding unless it can be tied to the U.S. marketplace. The

competent evidence reveals that merely a sliver of Opposer's activities meet this threshold.

Opposer's own retail channels are clearly not oriented toward U.S. consumers. Opposer has no brick-and-mortar store locations within the U.S., and its website cannot process purchases from U.S. customers. (Opp.'s Br. at 12-13; Stip. ¶¶ 5-6.) Though Opposer touts the purported visibility of its Heathrow airport locations to U.S. travelers, there is conspicuously no evidence of any purchases by U.S. customers from these locations despite the supposed "millions" of U.S. travelers Opposer impermissibly speculates to have encountered its stores. (*Id.* at 11-13.) Indeed, only a *single* documented sale from Opposer to customers within the U.S. was produced in the course of discovery. (Galton Decl. ¶ 40, Ex. 25; Diamond Decl. ¶¶ 5-6, Ex. 3 at 5-6 & Ex. 4 at 2-3.) Though Opposer is purportedly planning expansion into the U.S. market through meetings with U.S. retail executives, there is no evidence these contacts reflect consumer awareness of Opposer's Marks within the United States, and they are therefore of little, if any, trademark significance. *See Linville v. Rivard*, 26 U.S.P.Q.2d 1508, 1513 (TTAB 1993), *vacated and remanded on other grounds*, 11 F.3d 1074, 31 U.S.P.Q.2d 1218 (Fed. Cir. 1993), *later proceeding at* 41 U.S.P.Q.2d 1731 (TTAB 1996) (concluding that meetings and site evaluations that ultimately did not result in the opening of hair salons in the U.S. did not evidence use of mark for hair dressing services).

The advertising and promotion of Opposer's Marks is likewise Anglo-centric and ill-postured to reach the U.S. marketplace. Although Opposer claims to have appeared in some of the same publications as Marissa Webb and her line, such printed publications

are limited to circulation in the United Kingdom.² (Opp.'s Br. at 10; Diamond Decl. ¶ 5, Ex. 3 at 6-7). Apart from the Ryder Cup, special events cited by Opposer are held in British venues, with no evidence of U.S. attendance figures. (Opp. Br. at 11; Galton Decl. ¶¶ 27-29.)

Although Opposer details its global sales over recent years, these figures fail to reflect U.S. consumption, and without this critical context, this information fails to qualify as competent evidence and should be ignored. *Fossil Inc. v. Fossil Group*, 49 U.S.P.Q.2d 1451, 1457 (TTAB 1998) (“If a party plaintiff in a Board proceeding is to rely simply on sales and advertising figures in an effort to establish that its mark is famous, then it is incumbent upon that party plaintiff to place the sales and advertising figures in context Raw sales and advertising figures—unless they are extraordinarily large . . . are simply not sufficient by themselves to establish that the mark is famous.”). In addition, sales of Opposer’s goods within the U.S. is predominately comprised of third-party resale of decades-old handbags through resellers such as eBay, which is of dubious, if any, trademark significance for this proceeding. *See Bayer Consumer Care AG v. Belmora LLC*, 90 U.S.P.Q.2d 1587, 1591 (TTAB 2009) (finding territoriality allegations fatally deficient after noting that a third party’s importation and resale of goods does not by constitute “use” without some allegation that the third party was

² Indeed, the single magazine cover submitted into evidence to substantiate Opposer’s claim that the parties appear in the same publications notes sales prices in British Pounds and identifies itself as a British publication. (Galton Decl. ¶¶ 25, 58, Ex. 31.) The only other copy of a media publication submitted to support this claim fails to provide the publication information to allow for verification as required by the TMBP. Such publications are not competent evidence and should be disregarded, as argued in M Webb’s Motion to Strike filed contemporaneously with this Brief. *Elsea*, 48 U.S.P.Q.2d at 1405 (sustaining applicant’s objections to the relevance of opposer’s exhibits consisting of excerpts from foreign publications or that did not clearly indicate the publications were U.S. editions).

licensed or authorized by petitioner to use petitioner's mark on its behalf). These leather goods have been discontinued by Opposer for over thirty years, and therefore such items traveling through reseller channels are limited to vintage collectibles. (Opp.'s Br. at 5; Galton Decl. ¶¶ 14-16; Diamond Decl. ¶ 7, Ex. 5 at 2-4.)

When stripped of irrelevant elements of its reputation and promotional activities, Opposer is left with third-party resale of vintage collector's items, its social media and web presence, *Forbes* editorials, its purported association with British royalty and actress Grace Kelly (who has been deceased for over thirty years), limited involvement in two sporting events, and incidental visits by U.S. consumers to its foreign stores and events, from which only a single sale to customers within U.S. has been documented. (Opp. Br. at 4-6, 10-13; Galton Decl. ¶ 40, Ex. 25; Diamond Decl. ¶ 15 Ex. 85.) Opposer's reputation is thus substantially diminished once the veneer has been reduced to the relevant evidence, leaving a foreign mark owner with lofty aspirations but narrow trademark protection.

On the other hand, M Webb's principal Marissa Webb has been a prominent figure in the U.S. fashion industry for several years. (Webb Decl. ¶¶ 4, 7; Kercho Decl. ¶ 5.) In addition to promoting her own brand, she has been a visible and high-ranking figure for the U.S. apparel brands J. Crew and Banana Republic. (*Id.*) U.S. consumers of women's apparel, handbags, and accessories are unlikely to be aware of Opposer or its Marks, and moreover are likely to associate M WEBB with Marissa Webb. (*See* Webb Decl. ¶ 14; Kercho Decl. ¶¶ 10, 14, 20-21, Exs. 10 & 12.) Marissa Webb had not even heard of Opposer before this proceeding, but rather her mark selection was designed to

capitalize on the considerable reputation she has built up in her own name within the U.S. fashion industry. (Webb Decl. ¶¶ 8, 14; Kercho Decl. ¶¶ 8-10.)

Any reputational value Opposer's Marks may be deemed to carry among U.S. consumers is further attenuated once the relevant purchasers are brought into focus. The proper evaluation for the fame of a mark is "the class of customers and potential customers of a product or service, and not the general public." *Palm Bay Imports Inc.*, 396 F.3d at 1375, 73 U.S.P.Q.2d at 1695. Although Marissa Webb enjoys a prestigious reputation and sells her fashion apparel and accessories in couture boutiques at prices bordering luxury brands, the Board must presume that goods under the M WEBB mark and Opposer's Marks move in all channels of trade and are available to all classes of purchasers normal for those goods because there are no restrictions in the applications. *See Elsea*, 48 U.S.P.Q.2d at 1407. (Kercho Decl. ¶ 12.)

The Board accordingly must base its decision on the *least* sophisticated potential purchasers, which in this case extends to the least sophisticated purchasers of women's apparel, accessories, and bags. *Gen. Mills, Inc. & Gen. Mills Ip Holdings II, LLC v. Fage Dairy Processing Indus., S.A.*, 100 U.S.P.Q.2d 1584, 1600 (TTAB 2011), *judgment set aside, opinion not vacated sub nom. Gen. Mills, Inc. v. Fage Luxembourg S.A.R.L.*, 110 U.S.P.Q.2d 1679; *see also In re SL&E Training Stable, Inc.*, 88 U.S.P.Q.2d at 1219 (noting that the identification of luggage and handbags in the application and registration at issue were not restricted in any way and therefore could be sold in discount stores to the unsophisticated consumer). It strains credulity that such purchasers would be familiar with the silversmiths and jewelers of British royalty, frequently traverse London's Heathrow airport, or be familiar with the designers of the Ryder Cup and Royal Ascot

trophies. *See In re Park Lane Shoes Limited*, Serial No. 79073835, 2011 WL 4517803, at *4 (TTAB Sept. 6, 2011) (non-precedential) (after concluding that footwear under applicant's PARK AVENUE mark and registrant's PARK LANE mark are bought by ordinary consumers, the Board noted that "[i]n finding that the marks have different meanings and overall commercial impressions, we realize that consumers in this country may be more familiar with Park Avenue than they are with Park Lane," the fashionable London street). In short, the history, global sales, and marketing activities detailed in Opposer's Brief are largely irrelevant for this proceeding. This mitigated reputation weighs against likelihood of confusion, and the Board's presumed sophistication of purchasers further resolves this factor in M Webb's favor.

3. There are no instances of actual confusion, either between the marks at issue or between Opposer and Marissa Webb.

Actual confusion is normally not relevant where intent-to-use applications are at issue. Although Opposer's commercial reputation prior to the filing of its ITU applications for the MAPPIN & WEBB Marks is largely irrelevant as detailed above, Marissa Webb herself has developed a signature style throughout her career in the U.S. fashion marketplace that has created a continuing commercial impression in her personal name and the M Webb marks. This long-standing commercial impression within the U.S. fashion marketplace warrants greater consideration for the actual confusion *DuPont* factor than is otherwise given in the ITU context.

The absence of any actual confusion and the length of time and the conditions under which there has been concurrent use without evidence of actual confusion are probative of likelihood of confusion when there has been a reasonable opportunity for confusion to have occurred. *Citigroup Inc. v. Capital City Bank Group Inc.*, 94

U.S.P.Q.2d 1645, 1660-61 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 U.S.P.Q.2d 1253 (Fed. Cir. 2011). The parties have stipulated that they are unaware of any instances of confusion between Opposer's Marks and either the MARISSA WEBB or M WEBB marks. (Stip. ¶ 11.) Although M Webb is not currently offering goods under its M WEBB mark, it has been actively selling goods claimed in its application for the M WEBB mark under its MARISSA WEBB brand since 2012. (Diamond Decl. ¶ 4, Ex. 2; Webb Decl. ¶¶ 8-9.) Furthermore, M Webb's principal, the fashion designer Marissa Webb, has been active within the U.S. fashion industry since 1998, developing a prominent reputation and appearing in major media outlets and magazines such as *InStyle*, *Cosmopolitan*, *Elle*, *Lucky*, *People*, *Shape*, *Women's Health*, *Los Angeles Times*, *The New York Times*, *The Wall Street Journal*, *Marie Claire*, *Glamour*, *Esquire*, *Harper's Bazaar*, *O The Oprah Magazine*, *E!*, *CBS News*, and *ABC News*. (Webb Decl. ¶¶ 2, 12, Exs. 1-18; Kercho Decl. ¶ 5.) In addition to launching her own fashion line under MARISSA WEBB brand, she has served prominent roles in the major U.S. fashion brands J. Crew and Banana Republic. (Webb Decl. ¶¶ 4, 7.) For the entirety of this period, there is no evidence of any confusion between M WEBB, MARISSA WEBB, and Ms. Webb herself on the one hand, and Opposer and its Marks on the other. (*Id.* ¶ 20; Kercho Decl. ¶ 25; Stip. ¶ 11.)

As detailed above, the personal names of fashion designers are often abbreviated to their surnames, and M Webb selected the MARISSA WEBB mark to be identifiable with Marissa Webb herself. (Webb Decl. ¶ 6; Kercho Decl. ¶¶ 8-10.) Ms. Webb's personal name, the MARISSA WEBB mark, and the M WEBB mark thus create the same commercial impression. (*See* Webb Decl. ¶¶ 5, 20.) Therefore the lack of actual

confusion not only between the marks at issue, but between the MARISSA WEBB mark and Opposer's Marks and between Ms. Webb and Opposer's Marks for the entirety of her career is probative of a lack of likelihood of confusion. *See Citigroup Inc.*, 94 U.S.P.Q.2d at 1660-61 (finding absence of actual confusion probative where applicant made prior use of its design registrations that were materially different from its pending application at issue, but which shared a common dominant element and created the same commercial impression); *G.H. Mumm & Cie v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 1295, 16 U.S.P.Q.2d 1635, 1638 (Fed. Cir. 1990) (lack of actual confusion in over a decade was a significant factor showing that confusion was unlikely). The absence of actual confusion under these circumstances therefore weighs in M Webb's favor.

VI. SUMMARY

Based on the above analysis of the relevant *DuPont* factors and the evidence of record, there is no likelihood of confusion between M Webb's M WEBB mark and Opposer's MAPPIN & WEBB and MAPPIN & WEBB LONDON marks. The marks are readily dissimilar in appearance, sound, connotation, and commercial impression, which alone is sufficient basis to determine there is no likelihood of confusion. When consumer tendencies for truncation and abbreviation are considered in the proper context of consumer behavior, the likely abbreviation of the marks simply amplifies their dissimilarity. Indeed, the popularity of the surname "Webb" reflects that consumers are accustomed to distinguish between differences among "Webb"-formative marks in the fields at issue and would be unlikely to be confused. After the relative fame of each of the parties is distilled to the relevant evidence, Opposer exerts nothing more than a weak commercial impression within the United States, which accordingly narrows the scope of

CERTIFICATE OF SERVICE

I hereby certify that on the 3rd day of August, 2015, a true and correct copy of the foregoing Applicant's Main ACR Brief was been served upon Opposer through its counsel of record, Douglas A. Rettew, via U.S. First Class Mail, postage prepaid, to the following address:

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