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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**

<p>MAPPIN & WEBB, LIMITED,</p> <p>Opposer</p> <p>v.</p> <p>M WEBB, LLC</p> <p>Applicant.</p>	<p>Opposition No. 91213413</p> <p>Mark: M WEBB</p> <p>Serial No.: 85460569</p>
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OPPOSER'S REPLY ACR BRIEF

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I. INTRODUCTION

The following facts are not contested: (1) the parties' goods are in-part identical and/or closely-related; (2) the parties' trade channels are presumed identical; (3) the parties' consumers are presumed identical; and (4) because the parties' applications contain no restrictions, the likelihood-of-confusion analysis should be considered from the standpoint of least sophisticated purchasers. What is contested, however, is whether the parties' marks are similar.

Placing these facts in the proper legal context, and considering the common elements between M WEBB and MAPPIN & WEBB, those marks should be considered similar. The entirety of Applicant's mark is encompassed with the MAPPIN & WEBB Marks. Both begin with the identical letter "M," followed by the identical element "WEBB." Moreover, Applicant does not dispute that consumers are prone to abbreviate, and that the "M" in its mark will be perceived as an abbreviation.

In the face of these facts, Applicant contends that confusion is unlikely by improperly disregarding the impact of the MAPPIN & WEBB mark's inherent strength; relying on contradictory, inadmissible, self-serving opinions of Applicant's designer and its financial investor about how consumers perceive and abbreviate brands; and impermissibly dissecting the marks.

First, although it concedes that the MAPPIN & WEBB Marks are arbitrary and thus conceptually strong, Applicant argues the marks are "weak" because they have not yet achieved widespread commercial recognition in the U.S. But it is fundamental that *inherently* unique and arbitrary marks are entitled to a broad scope of protection. Under Applicant's logic, even the most conceptually strong marks (including those in Mappin & Webb's intent-to-use applications, and *every* intent-to-use application for that matter) would automatically be downgraded to "weak" and undeserving of protection against confusion if new to the marketplace. The fallacy of this logic is clear on its face. Applicant also argues that Mappin & Webb improperly relied on evidence of foreign sales/advertising to prove recognition in the U.S. and failed to prove fame in the U.S.

marketplace. Applicant's arguments here are likewise misplaced. Mappin & Webb offered evidence of its foreign sales/advertising to illuminate the brand's history and plans for the U.S. market expansion to demonstrate both its *bona fide* intent to use the MAPPIN & WEBB Marks on the applied-for goods in the U.S. and its standing in this action. Additionally, fame is not required for a finding of confusion between similar marks applied to identical/closely-related goods, which is the case here.

Applicant further speculates that consumers will not abbreviate MAPPIN & WEBB to M WEBB because it is "counterintuitive" and because this is purportedly not how other double-surname brands are abbreviated. Applicant's conclusion is belied by the very examples it provides, among others. Contrary to Applicant's theory, Abercrombie & Fitch has abbreviated its name to "A & Fitch," Cutter & Buck has a C-BUK line of men's clothing, and consumers abbreviate Dolce & Gabanna to "D Gabanna."

Applicant also argues that because MAPPIN & WEBB has previously been abbreviated to M & W, MW, and MAPPIN, consumers will not abbreviate it to M WEBB. If anything, the multitude of prior and possible abbreviations shows that brands are often shortened in different ways and that consumers are accustomed to various forms of abbreviation (e.g., Abercrombie & Fitch is abbreviated to "A&F," "Abercrombie," and "A & Fitch"; "Neiman Marcus" to "NM" and "N Marcus"; Cutter & Buck to "CB" and "C-Buk", etc.). While arguing that its designer's name MARISSA WEBB will be abbreviated as M WEBB, Applicant nevertheless contends that this same method of abbreviation will not be applied to MAPPIN & WEBB. Applicant cannot have it both ways; its own arguments on consumers' propensity to abbreviate brands show why confusion is likely here.

Finally, Applicant relies upon an improper dissection of the parties' marks in its efforts to distinguish among them. Applicant contends that "Opposer's Marks overlap with the M WEBB mark only through their weak element," i.e. "WEBB." (App. ACR Br. 15.) Not so. Applicant's

mark is M WEBB—not “WEBB”—and “M” can be perceived as an abbreviation of “MAPPIN.” Moreover, in arguing that the common term “WEBB” is weak, Applicant relies on meager third-party evidence—none of which includes the element “M” or anything similar.

Applicant’s varied arguments cannot obscure the simple fact that Applicant has applied to register a similar mark, for similar/overlapping goods, offered via identical trade channels to identical, non-sophisticated consumers. Confusion is thus likely.

II. ARGUMENT

A. MAPPIN & WEBB Marks Are Strong and Entitled to a Broad Scope of Protection

Applicant concedes that the MAPPIN & WEBB Marks are arbitrary and thus conceptually strong. (App. ACR Br. 10; Opp. Main ACR Brief 17.) That notwithstanding, Applicant argues that “Opposer’s marks are weak marks entitled to a narrow scope of protection” because they have yet to achieve marketplace notoriety in the U.S. (App. ACR Br. 9.) Applicant contends that lack of commercial strength “narrows the scope of protection that should be afforded Opposer’s Marks.” (App. ACR Br. 10.) In so arguing, Applicant accords undue importance to the concept of commercial over conceptual strength—an obvious and fundamental error in a proceeding concerned with registrability as contrasted with use.

Although the Board generally looks to both conceptual and commercial strength of an opposer’s mark, a mark’s lack of marketplace notoriety does not, as Applicant contends, *diminish* the broad scope of protection afforded arbitrary and thus conceptually strong marks. As one court explained:

[W]e have never held that an arbitrary or fanciful mark (i.e., a conceptually strong mark) can have its overall strength diminished by feeble commercial success. We decline to do so today. Rather, we hold that a lack of commercial strength cannot diminish the overall strength of a conceptually strong mark so as to render it undeserving of protection. Otherwise, a mark which is conceptually strong may never have the opportunity to blossom into its full commercial potential through effective marketing.

M2 Software, Inc. v. Medacy Entm't, 421 F.3d 1073, 1081 (9th Cir. 2005).

Under Applicant's reasoning, all newly-adopted conceptually strong marks (including those in Mappin & Webb's intent-to-use applications, and every intent-to-use application) would automatically be downgraded as "weak" and undeserving of the appropriate protection against confusion. Not surprisingly, Applicant offers no primary authority to support this untenable proposition.¹

Indeed, contrary to Applicant's position, a mark's "unique and arbitrary" nature "not only entitles [it] to a broad scope of protection, but *significantly increases* the likelihood that the marks, when used in connection with the identical goods, would cause confusion." *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1479 (TTAB 2007) (emphasis added).² Here, the arbitrary nature of the MAPPIN & WEBB Marks not only entitles them to a "broad" scope of protection, but "significantly increases" the likelihood of confusion with Applicant's M WEBB mark for closely-related and in-part identical goods, offered to the same consumers, through the same trade channels.

B. The MAPPIN & WEBB and M WEBB Marks, Applied to Closely-Related and In-Part Identical Goods, Are Similar

1. When Analyzed in Their Entireties, the MAPPIN & WEBB and M WEBB Marks Are Similar

In arguing that the parties' marks are dissimilar, Applicant ignores several fundamental legal principles.

¹ Moreover, Applicant's reliance on McCarthy's treatise is misplaced. The treatise nowhere states that newly-adopted marks (specifically the marks shown in intent-to-use applications) should be downgraded as "weak" before they even had a chance to develop commercial strength. 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:83 (4th ed. 2015).

² See also *In re Biltmore Co.*, 2014 WL 7172036, *4 (TTAB Nov. 21, 2014) (non-precedential) ("[T]he terms SECOLO and CENTURY are arbitrary as applied to table wine, and thus SECOLO is conceptually strong as a trademark"; such a "strong mark" "significantly increases" likelihood of confusion with marks used in connection with identical goods); *In re Earlybirdcapital, Inc.*, 2012 WL 4285363, *5 (TTAB Sept. 7, 2012) (non-precedential) ("[R]egistrant's marks which prominently feature the arbitrary term HYPHEN must be considered strong marks entitled to a broad scope of protection This is a factor that increases similarity of the marks, and the likelihood that the marks, when used in connection with similar or closely related services, would cause confusion.")

First, Applicant ignores the “basic principle in determining confusion between marks ... that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used.” *In re Nat’l Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985). Applicant concedes, as it must, that the parties’ marks cover closely-related and in-part identical goods. “When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Second, Applicant concedes that “the Board 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.” (App. ACR Br. 24) (emphasis in the original). Low purchaser sophistication is recognized to increase the likelihood that confusion can occur. *In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006) (given lack of restrictions as to channels of trade and purchasers, the Board held that jewelry is likely “to be purchased casually and on impulse, thus increasing the risk of confusion”).

Third, Applicant argues, incorrectly, that Mappin & Webb must demonstrate that the marks are similar in *each of* sight, sound, connotation, *and* overall commercial impression to prevail. Yet any *one* of these categories is sufficient to support a finding of likelihood of confusion. See *United Rum Merchs. Ltd. v. Fregal, Inc.*, 216 USPQ 217, 219 (TTAB 1982) (“It is well established that similarity of connotation or commercial impression alone is sufficient to support a finding of likelihood of confusion between marks,” and “this is true even if the marks exhibit aural and optical dissimilarity when they convey the same general idea or stimulate the same mental reaction”); *Gen. Foods Corp. v. Wis. Bottling, Inc.*, 190 USPQ 43, 45 (TTAB 1976) (“Concerning the question of the similarity of the marks, it is well established that similarity in any one of the elements of sound, appearance, or meaning is sufficient to indicate likelihood of confusion.”); *In re White Swan, Ltd.*, 8

USPQ2d 1534, 1535 (TTAB 1988) (“similarity as to any one factor (sight, sound or meaning) alone ‘may be sufficient to support a holding that the marks are confusingly similar’”).

When analyzed properly in their entirety, and taking into account low purchaser sophistication and that the parties’ goods are in-part identical/closely-related, the M WEBB and MAPPIN & WEBB marks are similar. Both begin with the identical letter “M,” followed by the identical element “WEBB.” And while Applicant seeks to minimize the significance of same (App. ACR Br. 2), the fact remains that the entirety of Applicant’s mark is encompassed with the MAPPIN & WEBB Marks.

Hoping to underplay the marks’ undeniable similarities, Applicant argues that the marks are different because the MAPPIN & WEBB Marks consist of four syllables and M WEBB mark of two syllables, and that the letter “M” is pronounced “with a short ‘ma’” in the MAPPIN & WEBB Marks and “with an ‘em’ sound” in Applicant’s mark. (App. ACR Br. 12.) This minutia is irrelevant because

the test to be applied in determining likelihood of confusion is not whether marks are distinguishable on the basis of a side-by-side comparison but rather whether they so resemble one another as to be likely to cause confusion, and this necessarily requires [the Board] to consider the fallibility of memory over a period of time. That is to say, the emphasis must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks.

Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975). This is especially true here, where, as Applicant argues, the proper audience consists of the “least sophisticated potential purchasers.” (App. ACR Br. 24.) “To the average buyer, the points of similarity are more important than minor points of difference,” and “[a] court should not engage in ‘technical gymnastics’ in an attempt to find some minor differences between conflicting marks.” 4 *McCarthy* at § 23:41. Applicant’s arguments rely precisely on this type of improper “technical gymnastics.”

2. When Applied to Identical/Closely-Related Goods, Consumers Will Likely Perceive M WEBB as an Abbreviation of MAPPIN & WEBB and/or as Another Line/Label by Mappin & Webb

Applicant does not dispute that the “M” that precedes the word “WEBB” in its M WEBB mark will be perceived as shorthand for something. But Applicant speculates that consumers will not abbreviate MAPPIN & WEBB to M WEBB because it is “counterintuitive.” (App. ACR Br. 1.) Applicant’s argument fails for several reasons.

First, Applicant speculates that “M Webb’s mark carries the meaning of a single person’s name with an abbreviated first name.” (App. ACR Br. 12.) By contrast, Applicant claims, double-surname marks, such as MAPPIN & WEBB, are abbreviated to the first initial of each word (“MW”) or just the first word (“Mappin”), but never to “M WEBB.” This, Applicant says, is based on alleged “[w]ell-established principles of consumer perception.” (*Id.* at 15.) Yet in support of this bold statement, Applicant offers neither legal nor factual support, but merely the self-serving opinions of its designer and her financial investor. As detailed in Mappin & Webb’s evidentiary appendix, neither Applicant’s designer nor her investor are qualified to offer expert opinions on “principles of consumer perception,” and their opinions are inadmissible, lack foundation, and should be stricken. Fed. R. Evid. 701, 602.³ Moreover, Applicant’s theory on how consumers abbreviate marks is belied by the very examples it provides. Specifically, Applicant attaches to its brief “website printouts showing various third-party fashion brands whose marks consist of two words separated by an ampersand (‘&’) or the word ‘and,’ and which have been shortened or abbreviated to the first word or the first initials of each word,” including Abercrombie & Fitch (“Abercrombie,” “A&F”), Cutter & Buck (“CB”), and Dolce & Gabbana (“Dolce,” “D&G”). (Declaration of David Diamond in Support of App. ACR Br. ¶ 12, July 31, 2015 (“Diamond Decl.”).) Contrary to Applicant’s theory, Abercrombie & Fitch has abbreviated its name to “A & Fitch” on clothing:

³ Logically, if people are going to perceive M WEBB as an abbreviation for MARISSA WEBB, there’s no reason to believe they won’t also do so for MAPPIN & WEBB.

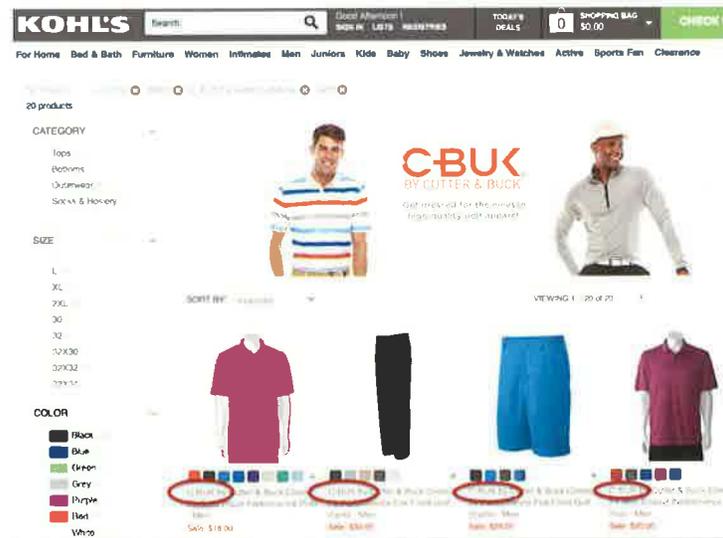


Logo Graphic Tee

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(Ex. 69 to Declaration of Morgan Smith in Support of Opp. Main ACR Brief, June 26, 2015.)

And Cutter & Buck has a C-BUK line of men's clothing:



(Ex. 2 to Declaration of Hugh Brian Duffy, Sept. 3, 2015 (“Duffy Reply Decl.”).)

Similarly, consumers abbreviate Dolce & Gabanna to “D Gabanna.” (Ex. 3 to Duffy Reply Decl.) There are plenty of other examples of the public abbreviating double-surname brands to the first letter of the first word and the second word, including Dooney & Bourke to “D Bourke”; Fannie Mae and Freddie Mac to “F Mae” and “F Mac”; Neiman Marcus to “N Marcus”; Bristol-Myers Squibb to “BM Squibb”; Procter & Gamble to “P Gamble,” etc. (Exs. 4-12 to Duffy Reply Decl.)

Nor is Applicant correct in its contention that “M Webb’s mark carries the meaning of a single person’s name with an abbreviated first name.” A useful contrary example can be found in J. Crew, a company for which Applicant worked. The “J” in front of “Crew” is not an abbreviation of a first name, but, apparently does not stand for anything. (Ex. 13 to Duffy Reply Decl.) A popular jewelry brand W. BRITT is an abbreviation of its designer’s name—Brittany Weiss. But the single consonant “W” is shorthand for the designer’s last name, not her first name. (Ex. 14 to Duffy Reply Decl.)

Second, Applicant proclaims that Marissa Webb is a “renown fashion designer” and consumers will thus associate M WEBB with her, not with the MAPPIN & WEBB brand. Aside from the self-serving statements of Applicant’s designer and investor, the record is devoid of any evidence that consumers associate M WEBB with Marissa Webb. Applicant attached media articles discussing Marissa Webb and her MARISSA WEBB label. Tellingly, *none* of them state that Marissa Webb is known as “M WEBB” or even mention M WEBB.

Nor has Marissa Webb shown that she and/or her MARISSA WEBB label are famous. Applicant launched her MARISSA WEBB label only three years ago, and many articles discuss the label’s recent debut, but shed no light on whether consumers are familiar with Marissa Webb.⁴ Moreover, many of the articles discuss that Marissa Webb has worked as a designer for J. Crew (a well-known brand that, as noted, combines a letter with a full word) and Banana Republic, but there is no evidence that consumers know who she is or what brands she has worked for. *In re SL & E Training Stable Inc.*, 88 USPQ2d 1216, 1220 (TTAB 2008) (“These articles are evidence that Sam Edelman was referenced in seven articles. However, they do not prove that Sam Edelman is well-known in the fashion industry. Apparently ... Sam and Libby Edelman created the ‘Caroline’ ballet

⁴ Indeed, notwithstanding many years of experience in the fashion industry (including serving as Ralph Lauren’s European President for over a decade), Mappin & Webb’s CEO had never heard of Marissa Webb before this proceeding. (Duffy Reply Decl. ¶ 4.)

flat that sold in the millions. However, it is not apparent from these articles that consumers know that Sam Edelman created the ‘Caroline’ or that consumers recognize Sam Edelman.”) Moreover, Applicant cannot meet the high burden for proving fame because it provided no evidence of its sales figures, advertising expenditures, and/or consumer surveys or testimony about the recognition of the MARISSA WEBB brand. *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1635 n.13 (TTAB 2007) (claims that ARDENBEAUTY is famous and ELIZABETH ARDEN “is one of the more established names in our industry” are “conclusory and unsupported”; ARDENBEAUTY had “only been in use for three years,” there was “no evidence of actual sales,” “no evidence of national advertising,” and insufficient evidence of advertising expenditures).⁵

In any event, the fact that Applicant’s designer is named Marissa Webb and her public recognition (if any) neither excuses nor diminishes the likely confusion between MAPPIN & WEBB and M WEBB. *SL & E Training Stable, Inc.*, 88 USPQ2d at 1220 (confusion likely between EDELMAN and SAM EDELMAN; “even if applicant had proven that Sam Edelman had a high degree of recognition in the fashion industry, applicant does not make clear how the renown of Sam Edelman would diminish the likelihood of confusion with the registered mark and, in any event, it would not change the result”); *Opp. Main ACR Br. 27-28*.

Third, Applicant speculates that because MAPPIN & WEBB has previously been abbreviated to M & W, MW, and MAPPIN, consumers will not abbreviate it to M WEBB. If anything, the multitude of possible abbreviations shows that brands, including MAPPIN & WEBB, are routinely abbreviated in many different ways and that consumers are accustomed to various forms of abbreviation. Accordingly, they may very well perceive M WEBB to be just another shorthand for MAPPIN & WEBB. Indeed, as discussed above, Abercrombie & Fitch is abbreviated to “A&F,”

⁵ *Compare Emilio Pucci Int’l B.V. v. El Corte Ingles, S.A.*, 2010 TTAB LEXIS 105, *25 (TTAB Apr. 1, 2010) (non-precedential) (holding, based on extensive evidentiary record, that Emilio Pucci’s “long use, advertising, and extensive mention [of the EMILIO PUCCI mark] in the general press makes it clear that ‘the average Joe on the street’ has indeed been exposed to opposer’s brand”).

“Abercrombie,” and “A & Fitch”; “Neiman Marcus” to “NM” and “N Marcus”; Cutter & Buck to “CB” and “C-Buk”, etc. The issue here is not whether consumers *actually* use M WEBB to refer to MAPPIN & WEBB (which Applicant contends), but whether consumers are likely to confuse/associate M WEBB with MAPPIN & WEBB taking into account the legal principles and examples discussed above (i.e., that consumers are prone to abbreviate, that brands are abbreviated in a multitude of different ways, and that the parties’ marks will appear on in-part identical/closely-related goods sold to the same consumers).

Applicant’s reliance on *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321 (TTAB 1992) is misplaced. There, the Board found no likelihood of confusion because the petitioner’s MARSHALL FIELD’S mark was “famous” and “respondent’s mark ha[d] also achieved a significant degree of fame in the marketplace. It is because both marks are famous that we believe the public will easily recognize the differences in the marks and distinguish between them.” *Id.* at 1332. Unlike *Fields*, this is not a case of two famous brands that consumers have learned over time to recognize and distinguish. “Applicant currently does not and has never used the mark M WEBB on any goods in the United States.” (Stipulation of Fact for ACR ¶ 8, Dkt. # 17, Apr. 27, 2015.) Mappin & Webb also has not yet launched its MAPPIN & WEBB-branded products in the U.S. Indeed, Applicant spends much of its brief arguing that the MAPPIN & WEBB marks are not used and not recognized in the U.S.

Nor can Applicant credibly distinguish the cases relied on by Mappin & Webb. In *SL & E Training Stable*, the Board found a likelihood of confusion because the opposer’s EDELMAN mark could be perceived as an abbreviation of the applicant’s SAM EDELMAN mark. 88 USPQ2d at 1219. Applicant makes much of the fact that “Webb” is a common surname, but so is “Edelman.” And although the applicant’s SAM EDELMAN mark incorporated only the common surname “EDELMAN” from the registrant’s mark, here the M WEBB mark does more; in addition to incorporating the entirety of the “WEBB” element, it also begins with the letter “M.” Similarly, in

Big M. Inc. v. U.S. Shoe Corp., the Board found that MANDEE could be perceived as an abbreviation of T.H. MANDY and that the marks were “strikingly similar” even though the shared elements “MANDEE” and “MANDY” differed in spelling. 228 USPQ 614, 616 (TTAB 1985). Here, the “WEBB” elements in the parties’ marks are identical.

Applicant also asks the Board to ignore *Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 USPQ2d 1913, 1913-14 (TTAB 2015) (PMONEY may be perceived as an abbreviation of POPMONEY) and *In re Restoration Hardware, Inc.*, 2015 WL 1227732, at *5 (TTAB Feb. 23, 2015) (R.H. VINTAGE and RH) because the cases “clearly did not involve surnames, and therefore these cases have no bearing on how consumers abbreviate in that distinct context.” (App. ACR Br. 16 n.1.) As detailed above, Applicant’s theory that consumers will not abbreviate a double-surname mark to the first letter of the first word plus the second word is belied by numerous examples (e.g., “A & Fitch,” “C-Buk,” etc.). Nor has Applicant come forward with a shred of credible and admissible evidence showing that consumers perceive abbreviations of fashion brands differently from other brands.

3. In an Attempt to Obfuscate Similarity, Applicant Improperly Dissects the Marks

It is a fundamental error to dissect marks and compare their component pieces without analyzing them as a whole. As the Federal Circuit explained, “[i]t is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue.” *China Healthways Inst., Inc. v. Wang*, 83 USPQ2d 1123, 1125 (Fed. Cir. 2007).⁶

Rather than focusing on comparing the MAPPIN & WEBB and M WEBB marks in their entireties, Applicant engages in a twisted dissection of both its own and the MAPPIN & WEBB

⁶ See also *Franklin Mint Corp. v. Master Mfg. Co.*, 212 USPQ 233, 234 (CCPA 1981) (a “mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion”); 4 *McCarthy* at § 23:41 (“[c]onflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison”).

Marks. First, Applicant erroneously contends that “Opposer’s Marks overlap with the M WEBB mark only through their weak element,” i.e. “WEBB.” (App. ACR Br. 15.) Not so. Applicant’s mark is M WEBB—not “WEBB”—and “M” can be perceived as shorthand for “MAPPIN.”

Applicant also impermissibly dissects the MAPPIN & WEBB Marks by arguing that consumers will focus on “MAPPIN” because it is a rare surname and ignore “WEBB” because it is purportedly a more common surname.⁷ *In re Standard Elektrik Lorenz A.G.*, 152 USPQ 563, 566 (CCPA 1967) teaches, however, that it is an error to dissect a double-surname mark and analyze each term separately; rather a mark that is a combination of two surnames should be analyzed in its entirety (and when analyzed as a whole, a double-surname mark is inherently distinctive). In fact, under well-established precedent, it is an error to dissect and ignore even disclaimed (i.e., generic and/or highly-descriptive) elements of a mark. *See Opryland USA Inc. v. Great Am. Music Show, Inc.*, 23 USPQ2d 1471, 1476 (Fed. Cir. 1992) (Board erred by giving no weight to generic term); *Shen Mfg. Co. v. Ritz Hotel, Ltd.*, 73 USPQ2d 1350, 1355 (Fed. Cir. 2004) (disclaimed elements of a mark “are relevant to the assessment of similarity”); *In re Nat’l Data*, 224 USPQ at 751 (Fed. Cir. 1985) (“The technicality of a disclaimer...has no legal effect on the issue of likelihood of confusion.”). Consequently, Applicant cannot credibly argue that *half* of the MAPPIN & WEBB Marks—“& WEBB”—will have no impact on purchasers’ memory.

Applicant’s meager third-party evidence is fatally flawed for the same reason; it is based on a piecemeal analysis of the parties’ marks. *None* of the very few third-party registrations and/or uses relied on by Applicant include a combination of “WEBB” with either “M” or another “M”-formative

⁷ Applicant’s Internet evidence on this point does not reflect the current population, as it is now fifteen years old. (Exs. 4-6 to Declaration of Randy Kercho in Support of App. ACR Br., July 28, 2015; U.S. census data from 2000.) It also has, under established Board precedent, “little probative value. [Internet evidence is] admissible only to show what has been printed, not the truth of what has been printed.” *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1040 (TTAB 2010). “In other words, although Internet printouts may be admitted into evidence, the truth of any statements shown in those printouts remains subject to the rule against hearsay embodied in Federal Rules of Evidence 801 and 802.” *Hesen-Minten v. Petersen*, 2013 WL 3188908, at *5 (TTAB Feb. 26, 2013) (non-precedential).

element evocative of MAPPIN. Instead, all of Applicant’s third-party references involve a combination of “WEBB” with another distinct term (e.g., “GARDNER-WEBB UNIVERSITY,” “CORNELIA WEBB,” etc.), creating an overall commercial impression that differs from the marks at issue. *In re Mighty Leaf Tea*, 2009 WL 1692502, *5 (TTAB May 8, 2009) (non-precedential) (“Applicant has merely submitted a group of registrations that have the letters ‘ML’ as part of a longer letter string The indiscriminate citation of third-party registrations without regard to the similarity of the marks involved is not indicative that the letters ML have a suggestive or descriptive connotation”).⁸

4. Applicant’s Meager Third-Party Evidence Cannot Avoid Likelihood of Confusion and the Cases It Relies on Are Inapplicable

Even if the Board were to consider Applicant’s third-party evidence related to the purported weakness of the “WEBB” element alone, its evidence does not support the contention that “WEBB” is weak for jewelry and apparel.

Of the “over a dozen third-party registrations” that Applicant relies on (App. ACR Br. 13), six are owned by the same entity—David Webb LLC. (Diamond Decl. ¶ 8.) Two more are owned by Gardner-Webb University in North Carolina. (*Id.*) And three references in the chart of purported “third-party” registrations/applications are marks owned by Mappin & Webb, including the two applications at issue in this proceeding. (*Id.*)

Moreover, “the Board and the courts have on more than one occasion stated that third party registrations are to be given little or no weight ... because they do not establish that the marks shown therein have been used, that they have been advertised or promoted or that products have been sold

⁸ *In re Carnation Co.*, 196 USPQ 716, 718 (TTAB 1977) (disregarding third-party registrations; “[m]ost significantly, none of the registrations is for a mark composed of the word ‘PARTNER’ preceded by the name of a food, as is each of the marks in issue”); *In re Oralabs, Inc.*, 2006 WL 337546, *4 (TTAB Jan. 31, 2006) (non-precedential) (disregarding evidence of third-party registrations because “none of the marks in the third-party registrations is as similar to the cited mark as applicant’s mark”).

thereunder and that they thus have some significance to the purchasing public.” *Econ. Lab., Inc. v. Scott’s Liquid Gold, Inc.*, 224 USPQ 512, 514 (TTAB 1984).⁹

Applicant’s evidence of “use in commerce” of these third-party registrations/applications fares no better. Applicant relies on only five third parties purportedly using marks that contain “WEBB” for jewelry/clothing. Three out of five alleged third-party uses of “WEBB”-formative marks are foreign, which is ironic given Applicant’s emphatic and repeated argument that foreign uses of a mark and foreign sales are irrelevant and should be stricken.

Specifically, CORNELIA WEBB is a Swedish brand, based in Stockholm, with prices for its products listed in Swedish Krona on its website:



(Ex. 24 to Diamond Decl.; Ex. 1 to Naydonov Decl.)

THE WEBB ELLIS CUP and WEBB ELLIS & Design references link to UK websites, listing prices in British pounds:

⁹ See also *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982) (“[I]t has frequently been held that third-party registrations are entitled to little weight in resolving a particular issue of likelihood of confusion because they are insufficient, per se, to establish that the marks shown therein are in use or that the purchasing public is aware of them, nor can their existence aid an applicant in its attempt to register a similar mark for like or related goods if confusion is likely to occur.”).

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Balls
 A wide range of options available for all levels.


Training
 All the gear needed for the best pre-season yet.

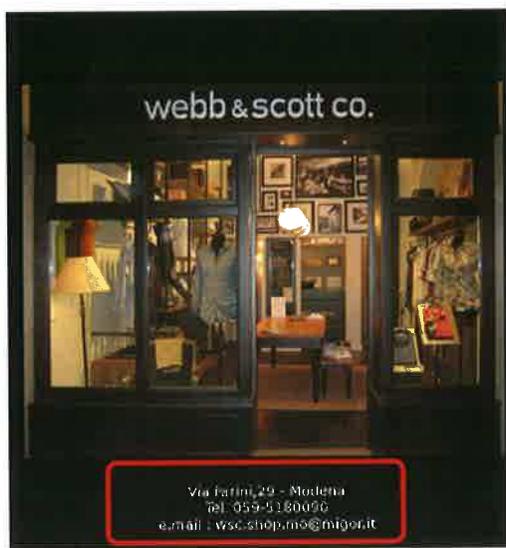

Teamwear
 Kit out your amazing team with our bespoke teamwear range.

Best Selling Products...



(Exs. 27-28 to Diamond Decl.)

And the WEBB & SCOTT CO. reference relates to an Italian brand/website, listing a store location and telephone number in Italy:



(Ex. 29 to Diamond Decl.; Ex. 2 to Naydonov Decl.)

This leaves Applicant with only two U.S. website printouts: David Webb, LLC for jewelry and Gardner-Webb University in North Carolina. Leaving aside that these references do not combine “WEBB” with “M” or another element evocative of “MAPPIN” (and are thus irrelevant), this evidence is “manifestly insufficient” to prove that WEBB-formative marks are weak in connection with jewelry and clothing. *Penthouse Int’l, Ltd. v. Dyn Elecs., Inc.*, 196 USPQ 251, 258 (TTAB

1977) (“[O]ne or two ... third-party registrations or uses ... manifestly insufficient to show that the existence of these registrations or uses are known to the general public so that they have been exposed to such a plethora of goods or services in the marketplace under the mark ‘PENTHOUSE’ that they have become conditioned not to associate all products and services bearing said mark with a single entity.”); *Carnation*, 196 USPQ at 718 (“[F]our registrations are insufficient to establish common adoption of a term.”); *In re Oralabs*, 2006 WL 337546, at*4 (“[E]vidence of two third-party uses of GENTLE GEL is insufficient to show widespread use of the term to establish that registrant’s mark is weak in relation to the identified goods, or that the public is so familiar with marks containing the word GENTLE that they will rely on other portions of the marks to distinguish them.”).¹⁰

The cases Applicant relies on are inapposite. *In re Broadway Chicken, Inc.* involved a refusal to register the BROADWAY CHICKEN mark based on the marks BROADWAY PIZZA and BROADWAY BAR & PIZZA. 38 USPQ2d 1559 (TTAB 1996). The applicant there presented evidence of *hundreds* of third parties using BROADWAY-formative marks for restaurant services, including “more than 500 entities” from the Dun & Bradstreet database, a “record large number” of yellow/white pages listings, and “well over 300 entities” from the American Business Directory. *Id.* at 1561-62. Here, Applicant’s meager evidence of just two entities (David Webb, LLC and Gardner-Webb University) using “Webb” for jewelry and/or apparel in the U.S. pales in comparison to the widespread third-party use in *Broadway*. See *Kicking Horse Coffee Ltd. v. Original Coffee Brake*,

¹⁰ Moreover, for these third-party references to have any legal significance, Applicant must show that they had an actual impact in the marketplace. As explained in the oft-cited articulation of this rule:

The significance of third-party trademarks depend wholly upon their usage. Defendant introduced no evidence that these trademarks were actually used by third parties, that they were well promoted, or that they were recognized by consumers.

Scarves By Vera, Inc. v. Todo Imps. Ltd., 544 F.2d 1167, 1173 (2d Cir. 1976). Far from meeting this requirement, Applicant’s website printouts fail to show the manner and length of time the entities have used the marks, whether the marks are “well promoted,” “recognized by consumers,” and/or have had any impact on the marketplace.

2011 WL 4090448, *5 (TTAB Aug. 23, 2011) (“Unlike *Broadway Chicken* where there [were] hundreds of third parties using the name at issue, in this case, four third parties is not sufficient to show that the term KICK ASS is so commonly used that KICK ASS is a weak mark.”).

Moreover, in *Broadway*, the parties’ marks contained the distinct “PIZZA” and “CHICKEN” elements that consumers could use to distinguish different types of restaurant services/food offered by them. In contrast, Applicant’s mark is comprised of the letter “M” and the term “WEBB,” with no additional elements that distinguish it from MAPPIN & WEBB (all of which identify similar and overlapping goods).

Similarly, in *Steve’s Ice Cream, Inc. v. Steve’s Famous Hot Dogs*, 3 USPQ2d 1477 (TTAB 1987), the Board found no likelihood of confusion between STEVE’S and a hot dog design for restaurants selling hot dogs and STEVE’S for ice cream in view of 137 third-party restaurants and 89 food stores using STEVE’S-formative marks. Further, the design element of the applicant’s STEVE’s mark was “extremely suggestive of the fact that applicant’s restaurants feature hot dogs” (not ice cream) because of the “highly stylized depiction of humanized frankfurters.” *Id.* at 1479.

In *Citigroup Inc. v. Capital City Bank Group, Inc.*, CAPITAL CITY BANK was found not confusingly similar to CITIBANK because Citigroup itself admitted that the shared element “‘City’ [was] a commonly used prefix for financial services” and the “CITI prefix ha[d] coexisted with many ‘City’ entities for years in virtually every jurisdiction.” 98 USPQ2d 1253, 1257 (Fed. Cir. 2011). The “CAPITAL CITY BANK [did] not share the characteristics of the CITIBANK family of marks” because of the differences in spelling between “CITI” and “CITY” and the distinguishing term “CAPITAL.” *Id.* Moreover, unlike the meager third-party evidence here, the Board in *Citigroup* “considered *forty* different websites for banking entities whose names contained the term ‘City Bank.’” *Id.* (emphasis added). And unlike here (where neither party has used the marks at issue in the U.S.), CITIBANK and CAPITAL CITY BANK coexisted for about 36 years with no actual confusion. *Id.* at 1260.

Applicant's reliance on *Knapp-Monarch Co. v. Poloron Prods., Inc.*, 134 USPQ 412 (TTAB 1962) also misses the mark because the only shared element between the parties' THERMEX and THERM-A-JUG marks was the term "THERM," which, far from source-identifying, merely described the heat insulation properties of the parties' food and beverage containers. The remainder of the marks—"EX" and "A-JUG"—could not be more different in sound, appearance, and overall commercial impression.¹¹

Finally, unlike here, where the parties' goods are closely-related and in-part identical, *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 USPQ 529 (CCPA 1970) involved the marks PEAK and PEAK PERIOD as applied to distinct goods—dentifrice and deodorants. The court found that the "term 'PEAK PERIOD,' a well-known phrase, conveys the meaning of reaching the high point of an activity ... a meaning which is substantially different than that elicited by the word 'peak' alone." *Id.* at 530. The court held that the "[a]pplicant's mark [PEAK PERIOD] as applied to a personal deodorant would readily suggest that the product is most effective at a critical time." *Id.* The "difference in meaning of the involved marks when applied to the specific goods of the parties" and the resulting "cumulative differences between the marks and the respective goods" led to a finding of no likelihood of confusion. *Id.* at 531.

C. "Fame" Is Not Required for a Finding of Likelihood of Confusion

As noted above, Applicant faults Mappin & Webb for not proving "fame" and widespread commercial recognition in the U.S. Unless a mark is "famous" or "well known," Applicant erroneously contends, it merits "narrow trademark protection." (App. ACR Br. 23.) Yet, protection from confusion is clearly not restricted to only those select few marks that achieved nationwide fame. To the contrary, and particularly in a trademark opposition involving a mark's *registrability* rather

¹¹ Similarly, in *Societe Anonyme de la Grande Distillerie E. Cusenier Fils Aine & Cie. v. Julius Wile Sons & Co.*, 161 F. Supp. 545, 547 (S.D.N.Y. 1958), the only shared element between the parties' FREEZOMINT and FRAPPEMINT marks for mint-flavored liquor was the "concededly descriptive and common to the trade" term "mint," and the prefixes "FREEZO" and "FRAPPE" were distinct.

than *use*, a showing of marketplace strength, much less fame, is unnecessary for a finding of confusion between similar marks applied to identical and/or similar goods (which is the case here). Indeed, even if the Board were to find that the MAPPIN & WEBB Marks are weak (which they are not), “it is settled that a weak mark is entitled to protection against the registration of a similar mark for closely related goods or services.” *In re Luxebaby*, 2015 WL 3826703, *2 (TTAB June 12, 2015) (non-precedential) (confusion likely between LUXEBABY LLC for diapers and BABY LUXE for wash cloths and pads for babies) (citing *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 182 USPQ 108, 109 (CCPA 1974) (“Confusion is confusion. The likelihood thereof is to be avoided, as much between ‘weak’ marks as between ‘strong’ marks, or as between a ‘weak’ and a ‘strong’ mark.”)).

Mappin & Webb does not shy away from the fact that it has not yet used the MAPPIN & WEBB Marks in the U.S. (and is currently in the process of preparing to launch its products in the U.S.). Nor has Mappin & Webb tried to rely on its global sales figures and long-standing commercial success in the United Kingdom (and other countries) to prove “fame” in the U.S.—as Applicant contends when arguing that portions of Elizabeth Galton’s declaration discussing Mappin & Webb’s history, promotional activities, and sales are irrelevant and should be excluded. (App. Evidentiary Objections 2-3, 5.) These facts were raised for their relevance to the issue of standing. As the opposer, Mappin & Webb has the burden to prove standing at trial. TBMP § 309.03(b). Here, Mappin & Webb’s standing is based on its prior-filed intent-to-use applications for the MAPPIN & WEBB Marks. (Notice of Opposition ¶¶ 7, 10-13.) Mappin & Webb included its history and information about its plans for the U.S. market to provide useful background about the brand and show its *bona fide* intent to use the MAPPIN & WEBB Marks on the applied-for goods in the U.S. Such evidence of *bona fide* intent is relevant to the issue of standing. *Kaplan v. Brady*, 98 USPQ2d 1830, 1834 (TTAB 2011) (non-precedential) (“Because petitioner bears the ultimate burden of proof on the standing issue, petitioner may be required to go beyond the mere pendency of his applications and establish his entitlement to file the application upon which his standing claim is

based.”). The Board thus may consider paragraphs 6-8, 12, 19, 20, 28-31 of, and Exhibit 2 to, the Declaration of Elizabeth Galton in Support of Opposer’s Main ACR Brief (“Galton Decl.”) as evidence of Mappin & Webb’s *bona fide* intent to use its marks in the U.S. and its standing to bring this opposition. But even without background brand details, Mappin & Webb has amply and persuasively established a likelihood of confusion based on the factors discussed above and in its moving brief.

D. The Channels of Trade and Classes of Purchasers Are Identical

Applicant correctly states that “the Board must presume that the goods under [Applicant’s 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.” (App. ACR Br. 24.) Here, because neither Mappin & Webb’s nor Applicant’s trade channels are restricted, they are presumed identical. *Hewlett-Packard Co. v. Packard Press Inc.*, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002) (“[A]bsent restrictions . . . goods and services are presumed to travel in the same channels of trade to the same class of purchasers.”). And this reflects reality. In planning its launch into the U.S. market, Mappin & Webb met with several department stores, including [REDACTED] (Opp. Main ACR Br. 14.)

Applicant plans to offer its goods in several of the same stores, including Barneys, Neiman Marcus, and Bergdorf Goodman. (App. ACR Br. at 7.)

Applicant’s apparel products (under the MARISSA WEBB mark) and Mappin & Webb’s products have also appeared in the same fashion magazines, including *Harper’s Bazaar*, *Marie Claire*,¹² and *Glamour*. (Opp. Main ACR Br. 27; Ex. 31 to Galton Decl., Ex. 4 to Naydonov Decl., App. ACR Br. 7.) Applicant relies on *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998) to argue that the Board should exclude the *Harper’s Bazaar* publication because it is

¹² In its evidentiary objections, Applicant argues that the Board should exclude the *Marie Claire* publication because it does not contain a URL or publication date. (App. Evidentiary Objections 4.) To address Applicant’s concerns, Opposer has resubmitted this publication as Exhibit 3 to Naydonov Decl.

foreign. (App. Evidentiary Objections 4.) In *Hard Rock Café*, the Board excluded foreign publications as irrelevant to the opposer's fame in the United States. *Id.* at 1405. Mappin & Webb does not offer this publication as evidence of fame, but rather to show the overlap in the parties' trade channels and classes of purchasers. Because Mappin & Webb has not yet launched in the U.S., it does not pay for advertising space in U.S. magazines. But when it does, it plans to target consumers similar to its UK audience. (Galton Decl. ¶¶ 11, 41.) The Board should therefore consider the *Harper's Bazaar* publication to show the overlap in the parties' purchasers; although, again, it is not needed. Because the parties' channels of trade and classes of purchasers are not only presumed identical, but are identical in fact, these factors also weigh in favor of likelihood of confusion.

E. Because Both Parties' Marks Have Not Yet Been Used in the U.S., There Has Been No Opportunity for Actual Confusion to Occur

Applicant argues that the lack of actual confusion warrants "greater consideration...than is otherwise given in the [intent-to-use] context." (App. ACR Br. at 25.) But Applicant ignores that *both* parties have yet to use their respective marks in the U.S. Without *use*, a lack of actual confusion is meaningless. *Gillette Canada, Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992) (lack of actual confusion only meaningful if "the record indicated appreciable and continuous use by applicant of its mark for a significant period of time in the same markets as those served by opposer under its marks"); *Hasbro, Inc. v. Mattel, Inc.*, 2002 WL 834489, at *6 (TTAB Apr. 30, 2002) (non-precedential) (Board "would not expect to find evidence of actual confusion" in a case where the applicant had not yet begun to use its mark). Applicant's reliance on the lack of actual confusion between its MARISSA WEBB mark and the MAPPIN & WEBB Marks is similarly misplaced. This case does not concern the likelihood of confusion between MARISSA WEBB and MAPPIN & WEBB. Consequently, any alleged lack of actual confusion between these marks is wholly irrelevant to the likelihood of confusion between M WEBB and MAPPIN & WEBB. Because neither party has

commenced use of its marks in the U.S., a lack of actual confusion is expected, predictable, and immaterial to the Board's analysis of likelihood of confusion.

III. CONCLUSION

For the reasons and authorities detailed in Mappin & Webb's Main ACR Brief and Reply Brief, Mappin & Webb respectfully requests that the Board sustain its opposition and refuse registration of Applicant's M WEBB mark.

Dated: September 3, 2015

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CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing OPPOSER'S REPLY ACR BRIEF was served by first class mail, postage prepaid, on this 3rd day of September 2015, upon counsel for Applicant at the following address of record:

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