

**This Opinion is Not a
Precedent of the TTAB**

Mailed: October 23, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Mappin & Webb Limited

v.

M Webb, LLC

—
Opposition No. 91213413
—

Douglas A. Rettew of Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.
for Mappin & Webb Limited.

Molly Buck Richard of Richard Law Group for M Webb, LLC.

—
Before Kuhlke, Bergsman and Adlin,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

M Webb, LLC (“Applicant”) seeks registration on the Principal Register of the
mark M WEBB (in standard characters) for

Handbags, purses, wallets, tote bags, in 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 Class 25.¹

¹ Application Serial No. 85460569 was filed on October 31, 2011, based upon Applicant’s
allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the
Trademark Act.

In its application, Applicant identified “M WEBB” as “Marissa Webb’ whose consent(s) to register is made of record.”

Mappin & Webb (“Opposer”) filed a Notice of Opposition against the registration of Applicant’s mark on the ground of likelihood of confusion, Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d). Opposer alleged prior use and ownership of a prior-filed pending application for the mark MAPPIN & WEBB for, *inter alia*, “jewelry,” in Class 14, and “leather articles, namely, wallets, credit card holders and calling card holders, luggage tags, purses, trunks and travelling bags; umbrellas, parasols and walking sticks; articles made of precious metals or coated or plated therewith, namely, credit card holders and calling card holders,” in Class 18,² and that Applicant’s mark so resembles Opposer’s mark as to be likely to cause confusion.

Applicant, in its Answer, denied the salient allegations in the Notice of Opposition.

On June 4, 2015, the parties filed a “Stipulation for Accelerated Case Resolution,” or “ACR.” Specifically, the parties stipulated to the filing of testimony by affidavit or declaration and that documents and things produced in response to

² Application Serial No. 85350960, filed June 20, 2011. Opposer also filed an application to register the mark MAPPIN & WEBB LONDON (standard character form) (Serial No. 85350965). Because the name “London” contains an additional point of difference with Applicant’s mark, we confine our analysis to the issue of likelihood of confusion between Applicant’s mark and Opposer’s MAPPIN & WEBB mark. That is, if confusion is likely between those marks, there is no need for us to consider the likelihood of confusion with MAPPIN & WEBB LONDON because if there is no likelihood of confusion between Applicant’s mark and MAPPIN & WEBB, then there would be no likelihood of confusion with the mark MAPPIN & WEBB LONDON. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

written discovery are authentic and may be submitted as exhibits to their ACR briefs.³

I. Evidentiary Issue

The parties have lodged numerous evidentiary objections. None of the evidence sought to be excluded is outcome determinative. Given this fact, coupled with the number of objections, none of which warrant excluding the evidence, we see no reason to discuss the specific objections. Suffice it to say, we have considered all of the testimony and exhibits submitted. In doing so, we have kept in mind the various objections raised by the parties, and we have accorded whatever probative value the subject testimony and evidence merit.

In this regard, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence, including any inherent limitations. Given the circumstances herein, we choose not to make specific rulings on each and every objection. As necessary and appropriate, we will point out in this decision any limitations in the evidence or otherwise note that the evidence cannot be relied upon in the manner sought. As noted above, while we have considered all the evidence of record and the parties' arguments, we do not rely on evidence not discussed herein.

³ The parties reserved their right to object to documents on the grounds of hearsay, competency, accuracy, relevance, and materiality.

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file. The parties submitted the testimony and evidence listed below:

A. Stipulated Facts and Legal Conclusions

The parties stipulated to the following:⁴

1. Opposer has standing;
2. Opposer has priority;
3. Opposer does not have any stores in the United States;
4. "Opposer currently sells jewelry, watches, picture frames, glassware, gift items, and cutlery at MAPPIN & WEBB stores in the UK and on its website at www.mappinandwebb.com (which currently does not allow for shipment of goods into the United States).";
5. Opposer does not sell clothing; and
6. There are no reported instances of actual confusion.

B. Opposer's testimony and evidence.

1. Testimony declaration of Elizabeth Leocardia Galton, Creative Director of the Aurum Group Limited, with attached exhibits;⁵
2. Testimony declaration of Brian Duffy, CEO of the Aurum Group Limited;⁶

⁴ 17 TTABVUE.

⁵ 24 TTABVUE (public version) and 21 TTABVUE (confidential version). "Mappin & Webb Limited is a subsidiary of the Aurum Group Limited, and is the owner of the MAPPIN & WEBB trademarks, which it licenses to Aurum." 24 TTABVUE 3.

⁶ 23 TTABVUE (public version) and 20 TTABVUE (confidential version).

3. Testimony declaration of Morgan Smith, one of Opposer's attorneys, who introduced into evidence the following:⁷

- a. Opposer's applications;
- b. Applicant's responses to Opposer's first set of interrogatories Nos. 3-6, 12 and 14;
- c. Applicant's responses to Opposer's first set of requests for production of documents;⁸
- d. Applicant's responses to Opposer's first set of requests for admission Nos. 1, 14, 15, 23, 24, 33, and 34;
- e. Excerpts from third-party websites of companies that sell goods listed in both parties' applications;
- f. Copies of use-based, third-party registrations covering goods in Classes 14 (jewelry), 18 (purses, wallets, travelling bags, and trunks) and 25 (clothing);
- g. Excerpts from third-party websites of companies that have abbreviated or shortened their names or whose names have been shortened by the public; and
- h. Excerpts from online fashion publications discussing ensembles with apparel, handbags and jewelry.

4. Rebuttal testimony declaration of Brian Duffy with attached exhibits;⁹ and

⁷ 25 TTABVUE.

⁸ Responses to document production requests are admissible solely for purposes of showing that a party has stated that there are no responsive documents. *See City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013); *ShutEmDown Sports Inc. v. Lacy*, 102USPQ2d 1036 at n.7 (TTAB 2012).

⁹ 37 TTABVUE.

5. Rebuttal testimony declaration of Anna Naydonov, one of Opposer's attorneys, who introduced into evidence the following:¹⁰

- a. An excerpt from the Cornelia Webb website (corneliawebb.com);
- b. A printout from a 2012 *Marie Claire* article noting that Jane Fallon wore Mappin & Webb jewelry at the Golden Globe Awards;
- c. An article posted (July 5, 2015) on Glamour.com about the outfit Kate Middleton wore for Princess Charlotte's christening that noted she wore a pendant from Mappin & Webb; and
- d. An excerpt from the allacronyms.com website for KFC and AMEX.

C. Applicant's testimony and evidence.

1. Testimony declaration of Marissa Webb, Applicant's President and majority owner, with attached exhibits;¹¹

2. Testimony declaration of Randy S. Kercho, President of Bedrock Brands I, LLC, a holding company that invests in fashion and apparel brands, including Applicant, with attached exhibits;¹² and

3. Testimony declaration of David J. Diamond, one of Applicant's attorneys, who introduced into the evidence the following:¹³

- a. Application Serial No. 85542114 for the mark MARISSA WEBB;
- b. Opposer's responses to Applicant's first set of interrogatories;

¹⁰ 38 TTABVUE.

¹¹ 29 TTABVUE.

¹² 30 TTABVUE.

¹³ 31 TTABVUE.

- c. Opposer's responses to Applicant's first request for admissions;
- d. Opposer's responses to Applicant's first request for production of documents;¹⁴
- e. Copies of third-party registrations for marks including the name "Webb," in Classes 14, 18 and/or 25;¹⁵
- f. Copies of registrations for marks including the name "Mappin," in Classes 14, 18 and/or 25;¹⁶
- g. Excerpts from third-party websites showing marks including the name "Webb" used for the sale of goods in Classes 14, 18 and/or 25;
- h. Excerpts from third-party websites "showing various third-party companies included on the 2015 *Fortune* 500 companies list (publicly available at <fortune.com/fortune500>), whose names consist of compound surnames that have

¹⁴ See Note 8 *supra*.

¹⁵ Applicant also included third-party applications. We give the applications no consideration because pending applications are evidence only that the applications were filed on a certain date and they are not evidence of use of the marks. *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007); *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1468 n.6 (TTAB 2003); *In re Juleigh Jeans Sportswear, Inc.*, 24 USPQ2d 1694, 1699 (TTAB 1992); *Olin Corp. v. Hydrotreat, Inc.*, 210 USPQ 62, 65 n.5 (TTAB 1981); *Merritt Foods Co. v. Americana Submarine*, 209 USPQ 591, 594 (TTAB 1980).

¹⁶ Applicant also included a copy of a cancelled Registration No. 1270685 for the mark MAPPIN PLATE. We give this registration no consideration because a cancelled registration is evidence only that the registration issued, it is not evidence of any use of the mark at any time, and it does not afford the owner any legal presumptions under Section 7(b) of the Trademark Act. See *Anderson, Clayton and Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46, 47 (CCPA 1973) (statutory benefits of registration disappear when the registration is cancelled); *Kellogg Co. v. Western Family Foods, Inc.*, 209 USPQ 440, 442 (TTAB 1980).

been shortened or abbreviated to the first word or the first initials of each word, either by the companies themselves or by the general public.”;¹⁷

i. Excerpts from third-party websites 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, either by the companies themselves or by the general public.”;¹⁸

j. Excerpts from third-party websites “showing various third-party fashion designers whose brands have been shortened or abbreviated to the designer’s surname, either by the designers (or their companies) themselves or by the general public.”;¹⁹

k. A document produced by Opposer that purportedly “illustrates the use of solely the surname “Mappin” to identify Opposer through the following language: “Mappin’s solve [sic] your gift problems . . . beautifully!”;²⁰

l. The obituary of Princess of Monaco Grace Kelly published in *The New York Times* on September 15, 1982; and

m. An excerpt from the Company Information page of Heathrow Airport Holdings Limited.

¹⁷ 31 TTABVUE 22.

¹⁸ 31 TTABVUE 23.

¹⁹ 31 TTABVUE 23.

²⁰ 31 TTABVUE 24.

III. Standing and Priority

The parties stipulated that Opposer has standing and priority.

IV. Likelihood of confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. The similarity or dissimilarity and nature of the goods and services, established, likely-to-continue channels of trade, and classes of consumers.

As noted above, Applicant is seeking to register its marks M WEBB (in standard characters) for

Handbags, purses, wallets, tote bags, in 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 Class 25.

Opposer, relying only on its prior-filed application for MAPPIN & WEBB, is seeking to register its mark for “jewelry” and “leather articles, namely, wallets, credit card holders and calling card holders, luggage tags, purses, trunks and travelling bags; umbrellas, parasols and walking sticks; articles made of precious metals or coated or plated therewith, namely, credit card holders and calling card holders.”

1. Class 18

Both parties intend to use their marks to identify wallets and purses; therefore, the Class 18 goods are in-part identical. It is sufficient for a finding of likelihood of confusion that relatedness of the goods is established for any item encompassed by the identification of goods in a class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB Jan. 22, 2014); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1397 (TTAB 2007).

Because the goods described in Class 18 of the applications are in part identical, we must presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011).

2. Class 25

To prove that the goods of the parties are related, Opposer introduced excerpts from 14 third-party websites showing third-parties advertising the sale of jewelry, wallets or purses on the one hand, and clothing on the other under the same mark.²¹ For example, Kate Spade, Gap, J CREW and AÉROPOSTALE offer both types of goods. These websites further demonstrate that the goods move in the same channels of trade.

Also, Opposer introduced copies of 48 third-party registrations for products listed in both Opposer's application and Applicant's Class 25 application.²² Third-party registrations which individually cover a number of different goods that are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods are of a type which may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786; *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

Finally, Ms. Galton, Creative Director of the Aurum Group Limited, testified that “[h]andbags, leather goods, and jewelry are often chosen to complement clothing or complete a desired ‘look.’”²³ See *In re Melville*, 18 USPQ2d 1386, 1388 (TTAB 1991) (“A woman's ensemble, which may consist of a coordinated set of

²¹ 25 TTABVUE 75-577.

²² 25 TTABVUE 580-744.

²³ 24 TTABVUE 34-35. Ms. Galton is responsible for, *inter alia*, advertising, marketing, and sales. 24 TTABVUE 4. We find that by virtue of her work experience, Ms. Galton has personal knowledge about the sales of jewelry, purses and wallets and, therefore, is competent to testify that the products at issue are complementary. Fed.R.Evid. 602 (personal knowledge) and 701(a) and (b) (opinion testimony may be rationally based on the witness's perception and not based on scientific, technical or other specialized knowledge).

pants, a blouse and a jacket, is incomplete without a pair of shoes which match or contrast therewith. Such goods are frequently purchased in a single shopping expedition. When shopping for shoes, a purchaser is usually looking for a shoe style or color to wear with a particular outfit. The items sold by applicant and registrant are considered to be complementary goods.”).

In its brief, Applicant did not discuss the similarity or dissimilarity of the goods. In fact, in its “Statement Of Issues” Applicant did not identify the similarity or dissimilarity and nature of the goods or established, likely-to-continue channels of trade as issues.²⁴

In view of the foregoing, we find that Applicant’s clothing is related to Opposer’s jewelry and leather products, that such products move in the same channels of trade and are sold to the same classes of consumers.

B. The strength of Opposer’s mark, including the number and nature of similar marks in use in connection with similar goods and services.

The sixth *du Pont* factor requires us to consider evidence pertaining to the number and nature of similar marks in use on similar goods. “The purpose of a defendant introducing third-party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers ‘have been educated to distinguish between different such marks on the bases of minute distinctions.’”

Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005), *quoting Veuve Clicquot*

²⁴ 28 TTABVue 8.

Ponsardin v. Palm Bay Imports, Inc., Opp'n No. 115,438, 2000 WL 21953664 (TTAB Aug. 4, 2003). To show that Opposer's mark is weak, Applicant introduced into evidence excerpts from third-party websites advertising the goods listed in Opposer's applications under marks incorporating the surname "Webb." The two relevant websites are listed below:²⁵

1. Cornelia Webb website (corneliawebb.com) advertising jewelry;²⁶ and
2. David Webb website (davidwebb.com) advertising jewelry.²⁷

²⁵ Applicant introduced excerpts from the Webb Ellis website (rweshop.com and webb-ellis.co.uk) advertising the sale of clothing and cufflinks but in pounds not dollars. 31 TTABVUE 148-153 and 155. Because there was no evidence indicating that these websites are directed to American consumers or visited by American consumers, they have little probative value. Also, we note that Applicant introduced a copy of Registration No. 4654656 registered on December 16, 2014 for the mark THE WEBB ELLIS CUP for clothing. 31 TTABVUE 101. However, that registration was based on Section 66(a) of the Trademark Act, not use in commerce and it therefore has no probative value in showing that the WEBB ELLIS trademark has been used in the United States. Applicant also introduced into evidence Registration No. 3435362 for the mark WEBB ELLIS and design for rugby clothing. 31 TTABVUE 113. However, as noted above, there is no evidence regarding its use in the United States and, thus, there is nothing on which we can base a finding that United States consumers are aware of the mark.

Likewise, we gave little consideration to the excerpt from the Migor Camiceria website ("migor.it") advertising WEBB & SCOTT clothing because it is an Italian website and there is no evidence that it would be accessed by American consumers. 31 TTABVUE 157. The English version of the website is directed to the U.K. market as indicated by the flag of the United Kingdom. Applicant introduced a copy of Registration No. 3950102 for the mark WEBB & SCOTT CO. and design for clothing. 31 TTABVUE 107. However, that registration was based on Section 66(a) of the Trademark Act, not use in commerce and, therefore, it has no probative value in showing that the mark has ever been used in the United States.

Applicant also introduced an excerpt from the Gardner-Webb University website (gardner-webb.edu) advertising educational services. 31 TTABVUE 143. There was no evidence regarding the university's sale of jewelry, purses, wallets, or clothing. Even if Applicant had introduced a relevant excerpt, such evidence would have little probative value because jewelry, purses, wallets, and clothing sold by universities are collateral merchandising products promoting the schools and, as such, move in different channels of trade than the products sold by the parties in this case.

²⁶ 31 TTABVUE 129-139. Although the Cornelia Webb website is of Swedish origin, it offers prices in dollars facilitating sales to U.S. consumers.

Two examples of third-parties using the surname “Webb” as part of their marks do not persuade us that the surname “Webb” is so widespread that minor differences between the marks will enable consumers to distinguish them.

In determining the strength of a mark, we consider not only its commercial strength, based on the marketplace recognition value of the mark, but also its inherent strength based on the nature of the mark itself. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014); *Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); **McCARTHY ON TRADEMARKS AND UNFAIR COMPETITION** § 11:83 (4th ed. 2015) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use.”). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899. In other words, it is similar to acquired distinctiveness.

When applied to “jewelry” and “leather articles, namely, wallets, credit card holders and calling card holders, luggage tags, purses, trunks and travelling bags;

²⁷ 31 TTABVUE 141.

umbrellas, parasols and walking sticks; articles made of precious metals or coated or plated therewith, namely, credit card holders and calling card holders”, although Opposer’s mark MAPPIN & WEBB is comprised of two surnames, it is inherently distinctive. *See In re Standard Elektrik Lorenz A.G.*, 371 F.2d 870, 152 USPQ 563, 566 (CCPA 1967) ((holding SCHAUB-LORENZ not primarily merely a surname); TMEP § 1211.01(b)(i) (July 2015).

With respect to commercial strength, based on the record, Opposer’s mark MAPPIN & WEBB has little, if any, commercial strength in the United States.²⁸

The evidence below is illustrative:

1. Opposer does not have any stores in the United States that sell goods under the mark MAPPIN & WEBB.”;²⁹

2. “Opposer currently sells jewelry, watches, picture frames, glassware, gift items, and cutlery at MAPPIN & WEBB stores in the UK and on its website at www.mappinandwebb.com (which currently does not allow for shipment of goods into the United States).”³⁰ “U.S. customers may view Opposer’s products, including but not limited to jewelry, watches, silverware, barware, and other gift items, on

²⁸ Although Opposer asserts that it is not contending that its MAPPIN & WEBB mark is famous, it introduced evidence *ad nauseum* of Opposer’s renown. Opposer contends that it “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,” (35 TTABVUE 6-7) even though the parties stipulated to Opposer’s standing prior to the opening of trial and that Opposer’s *bona fide* intent to use its mark for the applied-for goods in the U.S. was not at issue in this case. For purposes of completeness, we analyze the commercial strength in the United States of Opposer’s mark.

²⁹ 17 TTABVUE 3.

³⁰ 17 TTABVUE 3.

Opposer's website and contact [Opposer's] showroom in the UK (via email or through the Customer Service number posted on Opposer's website for customers outside the UK, including the U.S.), where a representative will help a U.S. consumer complete the purchase of the item seen on Opposer's website."³¹ This evidence does not describe a consumer friendly sales process conducive to completing sales with U.S. consumers, much less indicate United States consumers' familiarity with Opposer or its mark;

3. Although Opposer asserts that it has shipped products under the mark MAPPIN & WEBB to customers in the U.S., it identified only one such sale:

For example, earlier this year, Opposer received inquiries from customers located in the U.S. regarding the MAPPIN & WEBB "Fortune" pendant worn by Katherine, Duchess of York. At least one of these customers purchased the "Fortune" pendant, which Opposer shipped to the U.S.³²

Also, "Opposer is aware that its Lizard Kelly handbag ... has been offered on eBay," otherwise, Opposer admits that it has not sold any leather goods, including, *inter alia*, wallets, purses, and travelling bags, in the United States in the past five years.³³ Finally, while Elizabeth Leocardia Galton testified as to Opposer's global sales, she did not offer any testimony regarding Opposer's sales in the U.S.³⁴

³¹ Opposer's response to Applicant's interrogatory No. 1; 31 TTABVUE 44. *See also* Opposer's response to Request for Admission No. 2 ("Opposer's website is not currently capable of automatically completing online transactions (including shipping) for consumers in the U.S."); 31 TTABVUE 66.

³² Opposer's response to Applicant's Interrogatory No. 1; 31 TTABVUE 45.

³³ Opposer's response to Applicant's Request for Admission No. 4; 31 TTABVUE 67.

³⁴ 21 TTABVUE 6 (confidential).

4. Opposer advertises its MAPPIN & WEBB products “in national UK national magazine titles, including *Vogue*, *Harper’s Bazaar*, *Tatler*, and *Vanity Fair* (which also circulate in the United States), in addition to regional titles such as *The Run Wild Group* and national and regional newspapers in the UK.”³⁵ Opposer did not provide any evidence as to the United States circulation figures for the UK versions of the magazines.

5. Though Opposer advertises on FACEBOOK and TWITTER, there is no evidence or testimony as to Opposer’s following in the United States;³⁶ and

6. Opposer failed to offer any testimony or evidence regarding its advertising expenditures in the United States.

In sum, the number and nature of similar marks in use in connection with similar goods is neutral and while Opposer’s mark MAPPIN & WEBB is inherently distinctive, based on the record, it has little commercial strength in the United States.

C. The similarity or dissimilarity of the marks in their entirety in terms of appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, “two marks may be found to be confusingly similar if there are sufficient similarities in terms of sound *or* visual appearance *or*

³⁵ Opposer’s response to Applicant’s Interrogatory No. 3; 31 TTABVUE 47.

³⁶ Opposer’s response to Applicant’s Interrogatory No. 3; 31 TTABVUE 47.

connotation.” *Kabushiki Kaisha Hattori Seiko v. Satellite Int’l, Ltd.*, 29 USPQ2d 1317, 1318 (TTAB 1991), *aff’d mem.*, 979 F.2d 216 (Fed. Cir. 1992) (citation omitted). *See also Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1519 (TTAB 2009) (citing *Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”)).

In comparing the marks, we are mindful that where, as here, the goods are in part identical and otherwise closely related, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721. *See also San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed.

Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Because the goods at issue are jewelry, handbags, purses, wallets, tote bags, and clothing, without any restriction as to channels of trade or classes of consumers, the average customer is an ordinary consumer.

As noted above, Opposer's mark is MAPPIN & WEBB and Applicant's mark is M WEBB. While both marks share the surname "Webb," the prefix terms "MAPPIN" and "M" incorporated into the respective marks are different. The issue is whether MAPPIN & WEBB and M WEBB suggest a single same source.

Opposer contends that the marks are similar because "[b]oth marks begin with the identical letter 'M,' followed by the identical element 'Webb.' And while Applicant seeks to minimize the significance of same ... the fact remains that the entirety of Applicant's mark is encompassed with the MAPPIN & WEBB Marks."³⁷ Indeed, the Board has previously recognized the practice in the fashion industry of referring to surnames alone. *See Polo Fashions, Inc. v. La Loren, Inc.*, 224 USPQ 509, 512 (TTAB 1984) ("Lauren" is a shorthand term for Ralph Lauren); *Nina Ricci, S.A.R.L. v. Haymaker Sports, Inc.*, 134 USPQ 26, 28 (TTAB 1962) ("While applicant has never used 'RICCI' as a trademark, it is common knowledge that various

³⁷ 35 TTABVUE 11. *See also* 22 TTABVUE 26 and.

couturiers such as Christian Dior, Hubert de Givenchi, and Jacques Fath are frequently referred to by their surname alone and, in this regard, it has been shown by the record that both opposer corporation and applicant's designer are sometimes identified as or referred to in the trade as 'RICCI.'"). *See also Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) ("the Board has previously recognized the practice in the fashion industry of referring to surnames alone"); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1333 (TTAB 1992) ("companies are frequently called by shortened names, such as Penney's for J.C. Penney's, Sears for Sears and Roebuck ... , Ward's for Montgomery Ward's, and Bloomies for Bloomingdale's); *Big M. Inc. v. United States Shoe Corp.*, 228 USPQ 614, 616 (TTAB 1985) ("[W]e cannot ignore the propensity of consumers to often shorten trademarks and, in the present case, this would be accomplished by dropping the 'T.H.' [in T.H. MANDY] in referring to registrant's stores.").

Applicant, on the other hand, argues that Opposer's mark is two surnames while Applicant's mark is a single person's name.³⁸ In this regard, the use of a single consonant followed by a surname carries the meaning of an abbreviated first name, and Applicant asserts that it is the diminutive name by which Marissa Webb is

³⁸ 28 TTABVUE 18. As the Board noted in *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, at 1447 (TTAB 2014), "[a] surname preceded by a given name is a common, highly conventional combination of word elements." However, Opposer's mark MAPPIN & WEBB does not fit that pattern because it is a combination of two surnames and a mark must be considered in its entirety. *In re Standard Elektrik Lorenz A.G.*, 371 F.2d 870, 152 USPQ 563, 566 (CCPA 1967).

known.³⁹ Thus, Applicant concludes that the marks have different meanings and engender different commercial impressions.

Although Applicant adopted the trademark M WEBB because it closely resembled its principal's personal name,⁴⁰ there is no evidence that Marissa Webb is referred to as M WEBB. Marissa Webb testified that "the MARISSA WEBB line [has] enjoyed extensive unsolicited exposure in numerous U.S. media outlets and nationally circulated magazines,⁴¹ but none of them refer to MARRISA WEBB as M WEBB. In fact, when the exhibits attached to Marissa Webb's declaration shorten or abbreviate her name, they refer to Marissa Webb as Webb.⁴²

Ms. Galton testified that Opposer has continuously used its MAPPIN & WEBB marks in the United Kingdom since 1860.⁴³ In all that time, Opposer has never abbreviated its name to WEBB, M WEBB or M & WEBB. To the contrary, Opposer has abbreviated the MAPPIN & WEBB marks as MW and placed the MW monogram on some of its leather products⁴⁴ and M&W on some of its precious metal products.⁴⁵ Like Applicant, Opposer has been featured in unsolicited editorials in

³⁹ 28 TTABVUE 18.

⁴⁰ 29 TTABVUE 3.

⁴¹ 29 TTABVUE 5.

⁴² *See for example*, 29 TTABVUE 13 ("Pennsylvania-bred Webb"), 14 ("Look out for Webb's first collection in stores in fall 2015), 20 ("sequined shorts from Webb's spring lookbook").

⁴³ 24 TTABVUE 18.

⁴⁴ 24 TTABVUE 20.

⁴⁵ 24 TTABVUE 20. While we previously did not consider evidence of sales outside of the United States in analyzing the commercial strength of Opposer's mark or the effect of foreign websites on U.S. consumers, we nevertheless find Opposer's failure to abbreviate its name and mark as WEBB, M WEBB or M & WEBB, and Opposer's failure to find any

various fashion magazines and blogs without any evidence that its name has been shortened or abbreviated to WEBB, M WEBB or M & WEBB or variations thereof.

Even though after 150 years, neither Opposer nor the public shortens or abbreviates MAPPIN & WEBB to WEBB, M WEBB or M & WEBB, Opposer hypothesizes that consumers will shorten or abbreviate MAPPIN & WEBB to WEBB, M WEBB or M & WEBB. In this regard, Opposer introduced 41 third-party website excerpts “showing various third-party companies that have abbreviated or shortened their name and/or whose names are abbreviated and/or shortened by the general public.”⁴⁶ The relevant excerpts are from companies whose names are composed of two surnames. For example,

1. Abercrombie & Fitch has abbreviated its name to A&F and A & Fitch;⁴⁷
2. Dolce & Gabbana has abbreviated its name to D&G;⁴⁸

websites so abbreviating its mark as being probative of the likelihood that consumers will shorten or abbreviate MAPPIN & WEBB to M WEBB.

⁴⁶ 25 TTABVUE 31. Brian Duffy, Chief Executive Office of the Aurum Group, licensee of the MAPPIN & WEBB trademark, testified that even though Opposer has not abbreviated MAPPIN & WEBB to WEBB, M WEBB or M & WEBB, “[t]here is, however, no magical formula for abbreviating brand names in the fashion industry.” 37 TTABVUE 3.

⁴⁷ 25 TTABVUE 746-750.

⁴⁸ 25 TTABVUE 767. Although it is improper rebuttal evidence, Mr. Duffy testified that Dolce & Gabbana has been abbreviated to D Gabbana and introduced supporting documentation. 37 TTABVUE 5 and 71-98. Evidence that Dolce & Gabbana has been abbreviated to D Gabbana should have been introduced as part of Opposer’s case-in-chief because it supports Opposer’s *prima facie* case that consumers will construe MAPPIN & WEBB as M WEBB. Evidence which should constitute part of an opposer’s case in chief, but which is made of record during the rebuttal period, is not considered when the applicant objects.

Applicant is entitled to an opportunity to rebut, during its testimony period, any testimony and evidence proffered in support of the allegations in the notice of opposition. This opportunity is foreclosed if opposer withholds the evidence

3. Hewlett Packard has abbreviated its name to HP;⁴⁹
4. Metro-Goldwyn-Mayer abbreviated its name to MGM;⁵⁰
5. Barnes & Noble has abbreviated its name to BN;⁵¹
6. Standard & Poor has abbreviated its name to S&P;⁵²
7. Procter & Gamble has abbreviated its name to P&G;⁵³ and
8. Sears, Roebuck & Company has abbreviated its name to Sears.⁵⁴

Of the eight relevant companies whose names comprise multiple surnames, there is evidence that four have relevant abbreviations: Abercrombie & Fitch (A & Fitch on t-shirts and polo shirts), Procter & Gamble (P Gamble), Dolce & Gabbana (D Gabbana), and Hewlett Packard (H Packard). However, there is no evidence regarding how extensively those abbreviations are used. For example, with respect to the Abercrombie & Fitch website, the menu on the left-hand side of the website identifies Abercrombie clothing, not A & Fitch clothing; the Procter & Gamble

until its rebuttal testimony period, *which is intended to be limited to denials, refutations or explanations of applicant's testimony and evidence.* (Emphasis added).

General Electric Company v. Graham Magnetics Incorporated, 197 USPQ 690, 692 n.5 (TTAB 1977). However, because Applicant did not lodge an objection to Mr. Duffy's rebuttal declaration, we consider the evidence therein.

⁴⁹ 25 TTABVUE 821-824. Mr. Duffy introduced an excerpt from the fixya.com website posted by an anonymous source referring to Hewlett Packard as H Packard. 37 TTABVUE 34.

⁵⁰ 26 TTABVUE 25-31.

⁵¹ 26 TTABVUE 33-36.

⁵² 26 TTABVUE 38-39.

⁵³ 26 TTABVUE 48-49. Mr. Duffy introduced an excerpt from the chestercountymoms.com website referring to Procter & Gamble as P & Gamble. 37 TTABVUE 46.

⁵⁴ 26 TTABVUE 51.

abbreviation is posted on the Chestercountymoms.com website; and the Hewlett Packard abbreviation is posted on the fixya.com website by an anonymous source. While “D. Gabbana” appeared as a title on Pinterest.com, all of the numerous photographs “pinned” by others were labelled as “Dolce & Gabbana,” “Dolce and Gabbana,” or “Dolce Gabbana.”

Applicant introduced excerpts from 23 third-party websites from companies “whose names consist of compound surnames that have been shortened or abbreviated to the first word or the first initials of each word, either by the companies themselves or the general public, and which have otherwise not been submitted by Opposer into evidence.”⁵⁵ *See for example*, Bristol-Myers Squibb (Bristol-Myers),⁵⁶ Archer Daniels Midland (ADM),⁵⁷ and Goldman Sachs Group (Goldman).⁵⁸

Applicant also introduced excerpts from seven third-party fashion brand websites “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, either by the companies themselves or the general

⁵⁵ 31 TTABVUE 22.

⁵⁶ 31 TTABVUE 236-239. Mr. Duffy introduced an excerpt from thepharmaletter.com website referring to Bristol-Myers Squibb as B-M Squibb in a headline for an article posted online. 37 TTABVUE 53.

⁵⁷ 31 TTABVUE 189.

⁵⁸ 31 TTABVUE 211-214.

public.”⁵⁹ *See for example*, Cutter & Buk (CB),⁶⁰ Matt & Nat (MN),⁶¹ and Stella & Bow (SB).⁶²

After carefully considering the testimony and evidence, the record fails to support Opposer’s contention that consumers will perceive M WEBB as a shortened version or abbreviation of MAPPIN & WEBB. Unlike in the cases cited by Opposer, in this case, after 150 years, there is no evidence that Opposer or anyone else referred to Opposer as WEBB, M WEBB or M & WEBB. Moreover, the evidence regarding abbreviations for similarly structured trademarks is unpersuasive based on the relatively few relevant abbreviations and the obscure sources for some of those abbreviations.

MAPPIN & WEBB is a mark comprised of two surnames: Mappin, a relatively obscure surname, and Webb, a relatively common surname.⁶³ Applicant’s mark M

⁵⁹ 31 TTABVUE 23.

⁶⁰ 31 TTABVUE 315. However, Brian Duffy testified that Kohl’s advertises a C-BUK (Cutter & Buck) line of men’s clothing. 37 TTABVUE 4 and 16-18.

⁶¹ 31 TTABVUE 341-343.

⁶² 31 TTABVUE 345-351.

⁶³ 30 TTABVUE 8 and 35-58. According to the United States Census Bureau (census.gov) tabulation of surnames occurring 100 or more times in the 2000 Census, Webb is the 137th most common surname with 163,481 entries. Mappin did not make the top 1000 entries. The 1000th entry was Cooke with 31,860 entries. Opposer objects to this evidence as hearsay. 39 TTABVUE 11. The tabulation of surnames is an official record of the United States Census Bureau and is admissible pursuant to Trademark Rule 2.122(e), 37 CFR § 2.122(e). The term “official records” as used in 37 CFR § 2.122(e) refers to the records of public offices or agencies, or records kept in the performance of duty by a public officer. TBMP § 704.07 (June 2015). In lieu of the actual “official record or a copy thereof,” the notice of reliance or testimony may be accompanied by an electronically generated document (or a copy thereof) which is the equivalent of the official record, and whose authenticity is established under the Federal Rules of Evidence. *See The Conde Nast Publications, Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979).

WEBB suggests one person. Based on the uniqueness of MAPPIN and the familiarity of WEBB, consumers will not shorten or abbreviate Opposer's mark to WEBB, M WEBB or M & WEBB. Rather, consumers will likely focus their attention on the MAPPIN element of the mark. The inclusion of the surname MAPPIN in MAPPIN & WEBB distinguishes the marks MAPPIN & WEBB and M WEBB as indicating different sources of goods.

This case differs from *Nina Ricci S.A.R.L. V.E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989), where the Federal Circuit noted that “the RICCI surname is a unifying name in Opposer's marks and is the dominant and significant part of opposer' s marks in identifying its goods” and that the RICCI mark had significant commercial strength. 12 USPQ2d at 1904. In this case, Opposer's mark has no commercial strength in the United States and the relatively obscure surname MAPPIN in combination with the relatively common surname WEBB is sufficient to distinguish the marks.

Also, we find that this case is distinguishable from *Big M. Inc. v. The United States Shoe Corporation*, 228 USPQ 614 (TTAB 1985), where the Board found MANDEE likely to cause confusion with T.H. MANDY. In that case, T.H. MANDY and MANDEE both suggest one person and the inclusion of the initials “T.H.” in the mark T.H. MANDY did not distinguish the marks; while in this case, MAPPIN & WEBB suggest two persons because the mark is comprised of two surnames and,

Also, the Board may take judicial notice of census data. *In re Aquamar, Inc.*, 115 USPQ 1122, 1127 n.6 (TTAB 2015); *In re Tokutake Indus. Co.*, 87 USPQ2d 1697, 1700 n.1 (TTAB 2008).

thus, the inclusion of MAPPIN serves to distinguish the marks. As for the propensity of consumers to shorten trademarks, in *Big M*, the Board found that consumers would drop the “T.H.” from T.H. MANDY whereas, in the present case, because of the uniqueness of the MAPPIN surname, consumers would be unlikely to drop MAPPIN in favor of WEBB.

On balance, we find that MAPPIN & WEBB and M WEBB are more dissimilar than similar in terms of appearance, sound, connotation and commercial impression.

D. Balancing the factors.

Despite the fact that the marks are used on goods that are in part identical and otherwise closely related, because the marks are dissimilar in their entireties, we find that Applicant’s mark M WEBB for “handbags, purses, wallets, tote bags” 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” is not likely to cause confusion with Opposer’s marks MAPPIN & WEBB and MAPPIN & WEBB LONDON both for, inter alia, “jewelry “and “leather articles, namely, wallets, credit card holders and calling card holders, luggage tags, purses, trunks and travelling bags; umbrellas, parasols and walking sticks; articles made of precious metals or coated or plated therewith, namely, credit card holders and calling card holders.”

Decision: The opposition is dismissed.