

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed:  
November 15, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Lonely Hearts Club Limited*

—  
Serial No. 79174419  
Serial No. 79176727

**CONSOLIDATED<sup>1</sup>**

—  
Bradley P. Heisler of Heisler & Associates  
for Lonely Hearts Club Limited.

Jeffrey Chery, Trademark Examining Attorney,<sup>2</sup>  
Law Office 120 (David Miller, Managing Attorney).

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Before Kuhlke, Lykos, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Lonely Hearts Club Limited (“Applicant”) filed applications for extension of protection to the United States of its International Registrations of the two marks shown below:

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<sup>1</sup> In this decision, citations to TTABVUE refer to the record in Serial No. 79174419.

<sup>2</sup> Application Serial No. 79176727 was examined by Shaila Lewis of Law Office 114. The application was reassigned to Examining Attorney Jeffrey Chery for the purpose of these consolidated appeals.

LONELY (U.S. Serial No. 79174419)<sup>3</sup>

A handwritten word 'Lonely' in a cursive script, with the 'L' being significantly larger and more stylized than the other letters.

(U.S. Serial No. 79176727)<sup>4</sup>

Each application requests registration with respect to “Clothing, namely, lingerie excluding socks and stockings,” in International Class 25.<sup>5</sup> In each case, the Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as used in connection with Applicant’s goods, so resembles the registered mark LONELYSHOES as to be likely to cause confusion, or to cause mistake, or to deceive. The cited mark is registered in standard character form for:

Footwear, ballet shoes in the nature of flat shoes, slippers, shoes, half-boots, sandals, clogs being footwear, soles, socks and stockings, in International Class 25.<sup>6</sup>

When the refusals were made final, Applicant appealed to this Board and requested reconsideration. Applicant also requested consolidation of the appeals and the

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<sup>3</sup> Application Serial No. 79174419 was filed on July 1, 2015 under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a), based on International Registration No. 1269323 dated July 1, 2015, with a priority date of March 2, 2015. The mark is in standard character form.

<sup>4</sup> Application Serial No. 79176727 was filed on July 1, 2015 under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a), based on International Registration No. 1274521 dated July 1, 2015, with a priority date of March 2, 2015.

<sup>5</sup> Applicant amended its identification of goods to exclude “socks and stockings” in an effort to avoid the refusal of registration discussed herein.

<sup>6</sup> Reg. No. 4566039 issued on July 15, 2014.

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Board consolidated them on March 16, 2017.<sup>7</sup> In each case, the Examining Attorney denied the request for reconsideration, and the appeal resumed. The cases are fully briefed.

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 as set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In this case, Applicant and the Examining Attorney have also submitted evidence and arguments regarding trade channels and the strength of the cited mark.

(a) The goods.

We first consider the similarity or dissimilarity of the goods as identified in the application and the cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-62 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Applicant's goods are lingerie (specifically excluding socks and stockings), and Registrant's goods include shoes, socks, stockings, and footwear in general. In our analysis, we will focus on a comparison of shoes and lingerie.

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<sup>7</sup> 10 TTABVUE in Serial No. 79174419 and 8 TTABVUE in Serial No. 79176727.

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To demonstrate that the goods of Applicant and Registrant are commercially related, the Examining Attorney submitted evidence, in each application, of direct-to-consumer websites that offer lingerie and shoes under a single brand. In the record of Serial No. 79176727, the Examining Attorney showed that shoes and lingerie are both sold under the brands VENUS, H&M, GUESS, and PAPAYA.<sup>8</sup> In the record of Serial No. 79174419, the Examining Attorney showed that shoes and lingerie are both sold under the brands RALPH LAUREN and NIKE;<sup>9</sup> and under the brands BANANA REPUBLIC, H&M, CALVIN KLEIN, and LEG AVENUE.<sup>10</sup>

In the record of Serial No. 79174419, the Examining Attorney has also submitted 32 use-based, third-party registrations<sup>11</sup> that cover both lingerie and shoes or footwear, as follows:

<b>Reg. No.</b>	<b>Mark</b>	<b>Reg. No.</b>	<b>Mark</b>
4571078	WET SEAL +	4717321	COOKIE JOHNSON
4927998	THE NATIONAL BUREAU OF PRODUCT RESEARCH	4871282	MR. PLAYBOY
5013391	868 NYC	4905801	BELIEVE BY CJ
4899176	MONA NUNEZ	5059977	BLACK BANANAS

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<sup>8</sup> (79176727) Office Action of April 6, 2017 at 3-13. We have not considered, for this purpose, the web pages attached to the Office Action of October 6, 2016, because those web pages do not show (or it is not clear that they show) that the different goods are offered under the same mark. Rather, they show websites that offer both types of goods, but they are goods of various different brands.

<sup>9</sup> (79174419) Office Action of October 22, 2015 at 74-6; 83-7; 100-101; 104. *See also* Office Action of December 7, 2016 at 23-26.

<sup>10</sup> (79174419) Office Action of December 7, 2016 at 11-13; 15-17; 19-20; 22; 42-44.

<sup>11</sup> *Id.* at 46-157.

Reg. No.	Mark	Reg. No.	Mark
4847437	IT'S THE PERFECT TIME TO BE YOU	5082698	ST8LINE
4916951	JR. SWIM	4825967	OPT.
5096283	SEX POSITIVE	4864544	PERFORMANCE SKIN
4830837	CUPCAKE MAFIA	4851043	CHEEKY BLISS
4874280	M	4863331	ZUUC
4931894	SYAO	5083364	FIRPEARL
4951218	Design only	5089351	SMASTAR
4997093	HEMSMITH	5092747	YOFOCOO
5076857	AIMIER	5092923	IWUHOOYA
5058590	GINASY	5058929	YIYIPIG
5059207	AZYUAN	5073162	IJOYOJI
5082009	TACVASEN	5095199	VOCOSI

Third-party registrations that are based on use in commerce and that individually cover a number of different goods 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, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

Applicant argues that “[m]ost of the evidence ... shows that websites which provide lingerie related goods and shoe related goods separate these goods within

their websites”;<sup>12</sup> and that “the way that lingerie and shoes (and related footwear) are typically marketed makes confusion less likely because most marketing of such goods is separated in the marketplace.”<sup>13</sup> The fact that merchants may place lingerie and shoes on separate web pages of a single website is merely a process of organization, designed to make it easy for a computer user to find both goods. Considering the web pages of record, we find that customers would understand that even though they have viewed two web pages they are still dealing with the same source of goods. There is no other evidence of record to support Applicant’s contention that such goods are “typically ... separated in the marketplace”; and there is no reason for us to believe that the internet is the only marketplace in which these goods are offered.

Applicant also argues that the Examining Attorney’s evidence demonstrates only a “limited and uncommon intersection of lingerie ... and ... footwear”; and that “an isolated intersection of goods ... in such a vast compendium of data as is the internet” is not enough to demonstrate that goods are related.<sup>14</sup> We find the evidence of record in each of these applications sufficient to persuade us that customers know that lingerie and shoes sometimes emanate from a single source, such that, if they saw such goods offered under confusingly similar marks, they would likely believe they come from the same source. We find that this *du Pont* factor weighs in favor of a finding of likelihood of confusion.

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<sup>12</sup> Applicant’s brief at 6, 13 TTABVUE 7.

<sup>13</sup> *Id.* at 7, 13 TTABVUE 8.

<sup>14</sup> Applicant’s reply brief at 7-8, 18 TTABVUE 8-9.

(b) Trade channels.

Because there are no limitations or restrictions as to trade channels in the application and the cited registration, we presume that the goods at issue would be marketed in all normal trade channels for such goods. *See, e.g., Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012). Applicant argues that “lingerie and shoes tend rather strongly to be marketed in different channels (although not exclusively).”<sup>15</sup> To support this contention, however, Applicant points only to the Examining Attorney’s evidence showing the respective goods offered on separate web pages of a single website, which we have discussed above. Besides the evidence showing that companies sell their own lingerie and shoes on their own websites, there is no evidence of trade channels in the record of Serial No. 79174419. In the record of Serial No. 79176727, there is evidence showing that retail websites under the names Athleta, Victoria’s Secret, and Lyst offer lingerie and shoes of various third-party brands. This is only a small amount of evidence, but it does show that the goods at issue sometimes are offered in the same third-party online retail channels. The *du Pont* factor of trade channels therefore weighs slightly in favor of a finding of likelihood of confusion.

(c) The marks.

We next consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369,

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<sup>15</sup> Applicant’s brief at 7, 13 TTABVue 8.

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73 USPQ2d 1689 (Fed. Cir. 2005). “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. While we consider each mark in its entirety, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided that our ultimate conclusion rests upon a comparison of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). “Indeed, this type of analysis appears to be unavoidable.” *Id.*

Applicant’s standard character mark LONELY and Registrant’s mark LONELYSHOES resemble each other in appearance, sound, and meaning because they share the term LONELY. The suffix -SHOES in Registrant’s mark is a point of difference in appearance, sound, and meaning. However, in the field of apparel, customers would immediately perceive -SHOES as the generic name of an apparel product; therefore, they would look primarily to the term LONELY-, and not the generic term -SHOES, as an indicator of the source of the goods. Thus, the LONELY- component of Registrant’s mark plays the dominant role in indicating to customers the source of Registrant’s goods. *In re National Data Corporation*, 224 USPQ at 752 (“In a sense, the public can be said to rely more on the non-descriptive portion of each mark.”); *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1478 (TTAB 2007).

Applicant argues that the component -SHOES in Registrant's mark has an important impact on the meaning of the cited mark. Applicant contends that Registrant "directly notif[ies] ... customers and clients that its mark relates to 'shoes' by placing this term in the mark."<sup>16</sup> There is truth to this. However, this factor is unlikely to alleviate confusion when customers who are aware of the mark LONELYSHOES see Applicant's mark LONELY applied to lingerie. As we have discussed above, customers know that lingerie and shoes may come from the same source. To such customers, it would seem plausible that a business would choose not to put the word SHOES on its lingerie.

Applicant also argues that the combined term LONELYSHOES has an anthropomorphizing effect that is absent from Applicant's mark LONELY. Applicant contends that LONELYSHOES suggests the idea of shoes that are unhappy because they are alone; while LONELY applied to lingerie suggests a person, the wearer, who is unhappy and alone.<sup>17</sup>

When the mark "LONELY" is seen by itself on or adjacent to the goods worn by a model, and with no following noun as part of the mark, the mark begs the question "who is lonely?" The most logical inference is that the wearer of the lingerie is lonely. ...

In contrast, the mark of the cited registration is "LONELYSHOES." Because a noun "shoes" follows (and is attached to) the adjective "lonely" a consumer encountering the "LONELYSHOES" mark is likely to

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<sup>16</sup> Applicant's brief at 4, 13 TTABVUE 5.

<sup>17</sup> *Id.* at 5, 13 TTABVUE 6.

logically tie the term “lonely” to the shoe goods of the registrant.<sup>18</sup>

Applicant’s argument is not persuasive. Both marks at issue are susceptible to both of the possible interpretations proposed by Applicant. That is, in both marks the term LONELY (or LONELY-) could be perceived as saying something about the product or about the wearer of the product. We doubt that the term -SHOES in Registrant’s mark would have the definitive effect on the meaning of the mark that Applicant suggests. The only support that Applicant provides for this interpretation is a series of photographs found on internet blogs at <lonelyshoes.tumblr.com>; <strangelonelyshoes.tumblr.com>; and @LonelyShoes.<sup>19</sup> These photographs do not demonstrate that the public would understand LONELY to have two different meanings in the two marks at issue.

Applicant points out that LONELYSHOES is presented as a single word, without a space.<sup>20</sup> The absence of a space between two recognizable words like “lonely” and “shoes” is not unusual in the commercial realm, and does very little to distinguish the marks at issue. *See In re Narwood Productions, Inc.*, 223 USPQ 1034, 1034 (TTAB 1984) (“The fact that the presentation in the mark of the cited registration is as a single word rather than two words is obviously insignificant in determining the likelihood of confusion.”).

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<sup>18</sup> Reply brief at 5, 18 TTABVUE 6.

<sup>19</sup> (79176727) Applicant’s response of September 30, 2016 at 8-23.

<sup>20</sup> Reply brief at 3, 18 TTABVUE 4.

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Overall, we find that the standard character marks LONELY and LONELYSHOES, as applied to lingerie and shoes, respectively, create similar commercial impressions.

We next consider Applicant's stylized mark:

The image shows the word "Lonely" written in a casual, handwritten style. The letters are black and have a slightly irregular, cursive quality. The 'L' is tall and thin, the 'o' is a simple circle, the 'n' has a small hump, the 'e' is a simple oval, and the 'y' has a long, thin tail that curves slightly to the left.

Our comments, above, relating to Applicant's standard character mark apply equally to the literal portion of Applicant's stylized mark. The stylized lettering of Applicant's mark is an additional point of difference in appearance as compared to Registrant's mark. However, we generally give less weight to the style and design elements of a mark than to the wording, because the wording would be used by consumers to request the goods. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999). *See also Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); *Giant Food, Inc. v. Nation's Food Serv., Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983). Moreover, Registrant's mark is registered in standard character form, such that it is not limited to any particular form of display, *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983), and could be displayed in stylized letters that resemble those of Applicant's mark. In any event, customers would find the stylized presentation of LONELY in Applicant's mark immediately legible and would appreciate its similarity to Registrant's mark.

Overall, both of Applicant's marks are similar, albeit not identical, to the cited registered mark in appearance, sound, and meaning, and we find that they create highly similar commercial impressions. The *du Pont* factor of the similarity or dissimilarity of the marks weighs in favor of a finding of likelihood of confusion.

(d) Strength of the marks.

Applicant has not argued in its brief that Registrant's mark is not inherently or commercially strong. However, Applicant made of record two "hit lists" resulting from searches of the USPTO's TESS database.<sup>21</sup> These indicate that there are 17 active records in the database relating to applications or registrations for marks that include the term LONELY in Class 25; and 56 such records in all classes. A mere list of such records provides too little information about the listed marks (or purported marks) to constitute any meaningful evidence of the strength or weakness of a given term. *Cf. Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-5 (CCPA 1976). Thus, the strength or weakness of Registrant's mark is a neutral factor in our analysis.

(e) Conclusion.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. Both of

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<sup>21</sup> (79174419 and 79176727) Response of February 13, 2017 at 11-13.

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Applicant's marks, when considered as a whole, are similar in appearance, sound, meaning, and commercial impression to the cited mark; the goods are related and are marketed through the same trade channels. Overall, we find that Applicant's marks for Applicant's goods so resemble the cited registered mark for Registrant's goods as to be likely to cause confusion or to cause mistake or to deceive.

Decision: With respect to each application, the refusal under Section 2(d) is affirmed.