

This Opinion is not a
Precedent of the TTAB

Mailed: May 9, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Montfort Services Sdn. Bhd.
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Serial No. 86167048
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Arthur J. DeBaugh of Bell, Davis & Pitt, P.A.,
for Montfort Services Sdn. Bhd.

Caitlin Watts-Fitzgerald, Trademark Examining Attorney, Law Office 111,
Robert L. Lorenzo, Managing Attorney.

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Before Kuczma, Gorowitz and Heasley,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Montfort Services Sdn. Bhd. (“Applicant”) seeks registration on the Principal
Register of the mark OSKALILY (in standard characters) for

Clothing, namely, lingerie, sleepwear, hosiery, stockings, pantyhose, socks, dresses, skirts, shirts, jackets, coats; knitwear, namely, jumpers, cardigans, and sweaters; pants, trousers; shapewear, namely, foundation garments, girdles, and corsets; formal wear, namely, jackets, coats, and tuxedos; footwear; headwear; swimsuits; bathing suits; bathing trunks; beach clothes, namely, sarongs, kaftans, beach cover-ups, swim trunks, and bikinis; beach shoes; sun visors; T-shirts; bath robes; scarves; shoes; linen garments, namely, shirts, pants, skirts, dresses, blouses,

suits, jackets, vests, coats, and body linen; sandals; underwear in International Class 25.¹

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the registered mark OSKA (in typed form)² for "women's and men's outer clothing, including of leather, namely, jackets, shirts, suits, pants, dresses, blouses, skirts, belts, Bermuda shorts, sweaters, tops, and sashes" in International Class 25 as to be likely to cause confusion, mistake or deception.³

After the Trademark Examining Attorney made the refusal final, Applicant appealed. We affirm the refusal to register.

I. Discussion.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or

¹ Application Serial No. 8916704 was filed on January 16, 2014, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

² Applicant mischaracterizes the cited mark as a "stylized mark." It is not. Rather, Registrant's mark is the legal equivalent of a standard character mark. Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings. A typed mark is the legal equivalent of a standard character mark. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012).

³ Registration No. 2868680, registered August 3, 2004, renewed June 11, 2014.

services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

A. Similarity of goods, channels of trade and class of customers.

We start our analysis with the second and third *du Pont* factors, the similarity of the goods, the channels of trade, and the class of customers. When determining the relationship between the goods,

[i]t is well settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the goods as they are identified in the involved application and cited registration, rather than on what any evidence may show as to the actual nature of the goods, their channels of trade and/or classes of purchasers.

In re Total Quality Group Inc., 51 USPQ2d 1474, 1476 (TTAB 1999). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-1162 (Fed. Cir. 2014).

The identifications of goods in both the application and the cited registration include shirts, jackets, pants, footwear, headwear, skirts, dresses and blouses. To that extent, the goods are identical. The other clothing items in the application are closely related to the clothing items in the cited registration.

Further, absent restrictions in the application and registration, [identical] goods and services are presumed to travel in the same channels of trade to the same class of purchasers. *Viterra*, 101 USPQ2d at 1908. Because the goods are in identical, they

are presumed to travel in the same channels of trade to the same classes of purchasers.

Accordingly, the second and third *du Pont* factors strongly favor a finding of likelihood of confusion.

B. Similarities of marks at issue.

We next determine the similarity or dissimilarity of the marks in their entireties, keeping in mind that “[w]hen marks appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likelihood of confusion declines.” *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (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*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). Moreover, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *In re Cynosure, Inc.*, 90 USPQ2d 1644, 1645 (TTAB 2009), citing *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

While “the similarity or dissimilarity of the marks is determined based on the marks in their entireties ... 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 the ultimate conclusion rests on a consideration of the marks in their entireties.” *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In this case, Applicant has adopted the Registrant’s entire mark OSKA combining it with the word LILY. Applicant argues that the word “LILY” in its mark is dominant because “OSKA” is not a familiar word. Appeal Brief, 4 TTABVUE 4. Applicant correctly contends that “OSKA” is not a familiar word – in fact – there is no evidence that it is a word at all. As such, OSKA constitutes a fanciful mark, which is “either totally unknown in the language or [is] completely out of usage, as with obsolete or scientific terms.” 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:5 (4th ed. 2016). “Fanciful marks are referred to as the “strongest” of all marks, in that their novelty creates a substantial impact on the buyer's mind.” *Id.* at § 11:6. Thus, contrary to Applicant’s assertion, OSKA is strong mark. Moreover, as OSKA is the first word in Applicant’s mark, it is the dominant portion thereof. *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“It is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.”) In the *Presto Products* case likelihood of confusion was found between KIDWIPES and KID STUFF for pre-moistened disposable towelettes).

Applicant cannot avoid likelihood of confusion by adopting Registrant's entire mark and adding subordinate matter thereto. *See Giant Food, Inc. v. Nation's Foodservice, Inc.*, 218 USPQ 390, 395 (Fed. Cir. 1983); *see also: Hewlett-Packard Co. v. Packard Press Inc.*, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1375 (TTAB 2006). In this case, the commercial impressions conveyed by the marks are similar. The primary impression in both mark is that of the arbitrary term OSKA, which is solely a source identifier. In Applicant's mark, the addition of the subordinate word LILY, conveys the impression that Applicant's clothes are a line of Opposer's OSKA clothes.

Moreover, the cases cited by Applicant to establish that OSKA is not the dominant part of its mark are distinguishable and unpersuasive. In each cited case, the common word contained in each of the marks was descriptive or highly suggestive. For example, in the *Hearst Corp.* case, the Federal Circuit found that there was no likelihood of confusion between the marks VARGA GIRLS and VARGAS for calendars. Since the calendars included the works of artist Alberto Vargas, the Court found that the common element VARGA or VARGAS was not the dominant element of the mark VARGA GIRLS. *See In re Hearst Corp.* 25 USPQ2d 1238, 1239 (Fed. Cir. 1992); *See also, Chairworks Taiwan, Ltd. v. Bannister*, 13 USPQ2d 2070 (M.D.N.C. 1989) (no preliminary injunction granted against plaintiff's use of CHAIRWORKS based in defendant's use of CHAIRMAN, both for chairs, since the word "CHAIR" is generic for "chairs.") *Luigino's, Inc. v. Stouffer Corp.*, 170 F.3d 827, 50 USPQ2d 1047, 1050 (8th Cir. 1999) (no likelihood of

confusion between LEAN CUISINE and LEAN 'N TASTY because the word “LEAN” is generally considered descriptive of food.); and *Al-Site Corp. v. VSI Int'l., Inc.*, 174 F.3d 1308, 50 USPQ2d 1161, 1175-6 (Fed. Cir. 1999), *reh'g denied, en banc suggestion declined* (May 25, 1999) (no likelihood of confusion between MAGNIVISION and MAGNA•DOT, both for eyeglass display racks, because MAGNA/MAGNI prefix is widely used in the eyeglass industry).

In the case at bar, the common portion of both marks is the arbitrary term, OSKA, which is the dominant part of both Applicant's mark as well as Registrant's entire mark.

Further, our finding is not affected by the fourteen third-party registrations for marks containing the name OSCAR or OSKAR submitted by Applicant⁴ to establish the weakness of the term OSKA. “Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Juice Generation, Inc. v. GS Enters. LLC*, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) citing 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:90 (4th ed. 2015). However, the third party registrations submitted by Applicant do not establish the meaning of the term OSKA, for the following reasons: (1) none of the registrations consist of or contain the term OSKA, which as discussed above, has no meaning; and (2) fourteen

⁴ Applicant submitted fourteen plain copies of registration certificates with its Response dated August 11, 2014. None of the copies of the certificates reflected the current title and status of the registrations.

registrations is not a sufficient number of registrations to establish that a term is commonly used, especially when use is not claimed in five of the registrations; three of the registrations are for marks consisting of the name OSCAR DE LA RENTA, all of which are owned by the same party; and since Applicant did not submit title and status copies of the registrations, it is not known if any of the registrations are still active.

Accordingly, based on the record, we find the marks to be confusingly similar and that the first du Pont factor favors a finding of likelihood of confusion.

C. Conclusion.

Having considered all the evidence and argument on the relevant *du Pont* factors, whether discussed herein or not, regarding likelihood of confusion between Applicant's mark OSKALILY (in standard characters) for

clothing, namely, lingerie, sleepwear, hosiery, stockings, pantyhose, socks, dresses, skirts, shirts, jackets, coats; knitwear, namely, jumpers, cardigans, and sweaters; pants, trousers; shapewear, namely, foundation garments, girdles, and corsets; formal wear, namely, jackets, coats, and tuxedos; footwear; headwear; swimsuits; bathing suits; bathing trunks; beach clothes, namely, sarongs, kaftans, beach cover-ups, swim trunks, and bikinis; beach shoes; sun visors; T-shirts; bath robes; scarves; shoes; linen garments, namely, shirts, pants, skirts, dresses, blouses, suits, jackets, vests, coats, and body linen; sandals; underwear

and the cited mark OSKA (in typed form) for "women's and men's outer clothing, including of leather, namely, jackets, shirts, suits, pants, dresses, blouses, skirts, belts, Bermuda shorts, sweaters, tops, and sashes" as to be likely to cause confusion,

we find that Applicant's mark is likely to cause confusion with the mark in the cited registration.

Decision: The refusal to register Applicant's mark OSKALILY is affirmed.