

This Opinion is not a
Precedent of the TTAB

Mailed: September 29, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Alia Sonara Design Works, LLC
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Serial No. 86338224

Alia M. Sonara,
for Alia Sonara Design Works, LLC.

Betty Chang, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

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Before Bergsman, Gorowitz, and Heasley,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Alia Sonara Design Works, LLC (“Applicant”) seeks registration on the Principal

Register of the mark  ~  for

Bow ties; boxer briefs; boxer shorts; head scarves; shoulder
scarves; silk scarves; ties, in International Class 25.¹

¹ Application Serial No. 86338224 was filed on July 15, 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, 15 U.S.C. § 1051(b).

The description of the mark entered is: “The mark consists of one heart composed of blue and red lines, one wavy line in the form of a ‘~’ mark in black and the name ‘ALIA SONARA’ in black. The color white in the drawing represents transparent background and is not part of the mark.”

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 ALIA (in typed format)² for “ladies’ clothing, namely jackets, skirts, blouses, tops, pants, pant suits, shirts, coats, sweaters, tunics, housecoats, jumpers, jeans, t-shirts, vests, tank tops, culottes, tunics, and suits,” in International Class 25, as to be likely to cause confusion, mistake or deception.

When the refusal was made final, Applicant appealed. We affirm the refusal to register.

I. Likelihood of Confusion.

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.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

² Registration No. 1365686, issued on October 15, 1985, renewed.

Prior to November 2, 2003, “standard character” drawings were known as “typed” marks. A typed mark is the legal equivalent of a standard character mark. *In re Vitterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or 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). All of the goods in Applicant's identification of goods, "bow ties; boxer briefs; boxer shorts; head scarves; shoulder scarves; silk scarves; ties," are articles of clothing. The goods in the identification of goods in the cited registration, "ladies' clothing, namely jackets, skirts, blouses, tops, pants, pant suits, shirts, coats, sweaters, tunics, housecoats, jumpers, jeans, t-shirts, vests, tank tops, culottes, tunics, and suits," are also articles of clothing.

The Examining Attorney has submitted web pages evidencing use of the same mark for scarves and: (1) jackets, skirts, cardigans, sweatshirts and blouses;³ (2) jackets and blazers;⁴ and (3) jackets, shirts, blouses, and sweaters.⁵ The evidence establishes that Applicant's scarves are related to the following goods in the cited registration: jackets, skirts, cardigans, sweatshirts, shirts, blouses, and sweaters. If we find there is a likelihood of confusion as to these goods, it is not necessary to consider likelihood of confusion with respect to the rest of the goods in the application. *See, e.g., Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (If there is a likelihood of confusion involving any of the goods set forth in the application and cited registration, the refusal applies to all of the goods in the same class).

Evidence of sales of both Applicant's goods and the goods in the cited registration on the Ann Taylor, Brooks Brothers, and Jones New York websites also establishes that these goods are sold in the same channels of trade to the same classes of customers.

On similar evidentiary records, both the Court of Patents and Customs Appeals⁶ and the Board have held that for likelihood of confusion purposes, many different

³ Ann Taylor, www.annataylor.com, Exhibit to Office Action dated October 26, 2014, TSDR pp. 6 & 9.

⁴ Brooks Brothers, www.brooksbrothers.com, Exhibit to Office Action dated October 26, 2014, TSDR pp. 12 -14.

⁵ Jones New York, www.jny.com, Exhibit to Office Action dated October 26, 2014, TSDR pp. 16 -18.

⁶ The predecessor to our primary reviewing court, the Federal Circuit Court of Appeals.

articles of clothing are related. *See Cambridge Rubber Co. v. Cluett, Peabody & Co.*, 286 F.2d 623, 128 USPQ 549, 550 (CCPA 1961) (women's boots related to men's and boys' underwear); *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1236 (TTAB 1992) (underwear related to neckties); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 398-399 (TTAB 1982) (TTAB 1982) (hosiery related to trousers).

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

B. Similarity or dissimilarity of the marks at issue.

Next, we determine the similarity or dissimilarity of the marks. 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).

Applicant has adopted the entire cited mark ALIA and added the surname SONARA and a design element thereto. Likelihood of confusion cannot be avoided by adopting a prior mark and adding other matter thereto. *See. e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. Mar. 26, 2014) (affirming TTAB's finding that applicant's mark STONE LION

CAPITAL incorporated the entirety of the registered marks LION CAPITAL and LION, and that the noun LION was the dominant part of both parties' marks); *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260-61 (Fed. Cir. 2010) (affirming TTAB's finding that applicant's mark, ML, is likely to be perceived as a shortened version of registrant's mark, ML MARK LEES (stylized), when used on the same or closely related skin-care products)

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's mark is a composite mark consisting of a verbal or literal portion and a design. When evaluating a composite mark containing both words and designs, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed because it is the portion of the mark that consumers would use to refer to or request the goods. *Viterra*, 101 USPQ2d at 1908 and 1911. While Applicant's design is not insubstantial, it is the literal portion of the mark that dominates.

Since the cited mark, “ALIA” is in typed format-- the legal equivalent of a standard character mark⁷- it “make[s] no claim to any particular font style, color, or size of display and, thus, [is] not limited to any particular presentation.” *Citigroup Inc. v.*

⁷ See footnote 2.

Capital City Bank Group Inc., 637 F3d 1344, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011). The literal portion of Applicant's mark consists of the name "ALIA SONARA" in a script format. Since the cited mark is in typed form, it may be depicted in the same script format as Applicant's mark.

Applicant argues that the meaning of the cited mark ALIA is "others" or "other things" and that the commercial impression of the cited mark is different from the commercial impression of its mark since the word ALIA in its mark is "a proper name meaning 'elevated' or 'light of god.'" Appeal Brief, 4 TTABVUE 6. There is no evidence supporting Applicant's contention that when used on or in connection with scarves and closely related articles of clothing, the commercial impression of the word "ALIA" in each mark will be different. To the contrary, according to Applicant, "ALIA' is a female first name *recognizable as such in multiple languages*; in this case it is of Arabic origin ... Response dated April 7, 2015, TSDR, p. 6. (emphasis added). It is most likely that as used in connection with clothing, the commercial impression of both marks will be that of a person's name.

The Examining Attorney has established that designers use their given names alone and with their surnames as marks in connection with clothing, e.g. Ralph Lauren,⁸ Tommy Hilfiger,⁹ and Stella McCartney.¹⁰ This practice is reflected in the

⁸ Webpage from Ralph Lauren website using both RALPH LAUREN and RALPH as marks, www.ralphlauren.com, Exhibit to Office Action dated April 10, 2015, TSDR p.6.

⁹ Webpage from Tommy Hilfiger website using both TOMMY HILFIGER and TOMMY as marks, www.usa.tommy.com, Exhibit to Office Action dated April 10, 2015, TSDR p.13.

¹⁰ Webpage from Stella McCartney website using both STELLA MCCARTNEY and STELLA as marks, www.stellamccartney.com, Exhibit to Office Action dated April 10, 2015, TSDR p. 17.

case law. *See: SMS, Inc. v. Byn-Mar, Inc.*, 228 USPQ 219, 220 (TTAB 1985) (Likelihood of confusion between ALSO ANDREA and ANDREA SPORT for blouses, pants, skirts and jackets, and ANDREA SIMONE for various articles of women's clothing.); *Tony Lama Company, Inc. v. Anthony Di Stefano*, 206 USPQ 176, 185 (TTAB 1980) (Likelihood of confusion between TONY D. for riding boots, and TONY LAMA for boots); *Helga, Inc. v. Helga Howie, Inc.*, 182 USPQ 629 (TTAB 1974) (Likelihood of confusion between HELGA for women's clothing and HELGA HOWIE for women's clothing).

Accordingly, we find that the marks are similar and that the first *du Pont* factor favors a finding of likelihood of confusion.

C. Conclusion.

After considering all the evidence and argument on the relevant *du Pont* factors regarding likelihood of confusion between Applicant's mark  for "bow ties; boxer briefs; boxer shorts; head scarves; shoulder scarves; silk scarves; ties" and the cited mark ALIA (in typed format) for "ladies' clothing, namely jackets, skirts, blouses, tops, pants, pant suits, shirts, coats, sweaters, tunics, housecoats, jumpers, jeans, t-shirts, vests, tank tops, cullotes, tunics, and suits," we find that there is a likelihood of confusion.

 ~ *Aliq Soudat* is

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