

This Opinion Is Not a  
Precedent of the TTAB

Hearing: February 11, 2020

Mailed: February 12, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Max Mara Fashion Group S.r.l.*  
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Application Serial No. 87786944  
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Rebecca Gan of Wenderoth LLP for Max Mara Fashion Group S.r.l.

Amanda Galbo, Trademark Examining Attorney, Law Office 125,  
Heather Biddulph, Managing Attorney.  
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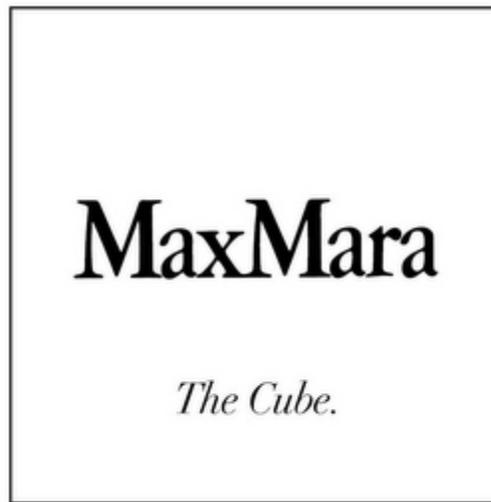
Before Bergsman, Adlin and English, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Max Mara Fashion Group S.r.l. (Applicant) seeks registration on the Principal  
Register for the mark MAXMARA THE CUBE. and design, shown below, for

Clothing, namely, coats; jackets; raincoats; pelisses; topcoats; heavy jackets; cloaks; blazers; ponchos; furs being clothing; clothing with fur inserts, namely, coats, and jackets; quilted coats; parkas; clothing accessories of fur, namely, cuffs, hoods, wraps, hood trims; clothing having embroidered parts, namely, coats and jackets; embroidered clothing accessories, namely, cuffs, hoods, wraps, and hood trims sold as integral parts of hoods, all of the foregoing being related to a customizable coat concept featuring coats and coat components that can be primarily transported

within a portable cube carrier, or clothing components therefor, in Class 25.<sup>1</sup>



The description of the mark reads as follows:

The mark consists of a square design with the words “MAXMARA” in the center, below which are the words “THE CUBE.”

Color is not claimed as a feature of the mark.

Applicant disclaims the exclusive right to use the term “The Cube.”

The Examining Attorney refused to register 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 THE CUBE, in standard character form, for “retail store services featuring clothing, footwear, sportswear, eyewear, handbags, and accessories,” in Class 35, as to be likely to cause confusion.<sup>2</sup>

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<sup>1</sup> Serial No. 87786944 filed February 6, 2018, under Sections 44(d) and (e) of the Trademark Act, 15 U.S.C. § 1126(d) and (e), based on European Trademark Registration No. 017686635, registered May 14, 2018, based on an application filed January 12, 2018.

<sup>2</sup> Registration No. 3512283 registered October 7, 2008; renewed.

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)); see also *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). “[E]ach case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); see also *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017)

(“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

### **I. The strength of the registered mark**

When making a determination of likelihood of confusion in an ex parte appeal, in order to determine the conceptual strength of the cited mark, we evaluate its intrinsic nature, that is, where it lies along the generic-descriptive-suggestive-arbitrary-fanciful continuum of words. Word marks that are arbitrary, fanciful, or suggestive are “held to be inherently distinctive.” *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000). *See also, In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1684 (Fed. Cir. 2010) (“In general, trademarks are assessed according to a scale formulated by Judge Friendly in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759 (2d Cir. 1976), which evaluates whether word marks are ‘arbitrary’ or ‘fanciful,’ ‘suggestive,’ ‘descriptive,’ or ‘generic.’”).

Registrant’s mark THE CUBE when used in connection with “retail store services featuring clothing, footwear, sportswear, eyewear, handbags, and accessories” is an arbitrary term because it is a known term used in an unexpected or uncommon way. *See Nautilus Group, Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173 (Fed. Cir. 2004) (defining an arbitrary mark as a “known word used in an unexpected or uncommon way” and observing that such marks are typically strong).

*See also Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (same).

At oral argument, Applicant argued that Registrant's use of THE CUBE is merely descriptive or highly suggestive because Registrant's in-store boutiques are cube shaped. However, the evidence shows that Registrant uses cube shaped point-of-sale displays on rack tops to advertise sales messages.<sup>3</sup> Registrant's use of cube shapes is a marketing theme, not descriptive or suggestive use.

There is no evidence of record regarding the number and nature of similar marks in use in connection with similar goods or services, nor is there any evidence regarding the registration of similar marks for similar goods or services.

Applicant argues that it has a competitive need to use the term "The Cube" because "The Cube" is merely descriptive of jackets and coats that "fit within a cube and are carried within a cube."<sup>4</sup> There are three problems with Applicant's argument.

First, the issue in this appeal is the strength of the registered mark, not Applicant's mark. Second, assuming *arguendo* that THE CUBE is merely descriptive of coats and jackets that fit within a cube and are carried within a cube, the issue in this appeal is whether Applicant's mark MAX MARA THE CUBE. and design so resembles Registrant's mark THE CUBE for retail store services featuring clothing as to be likely to cause confusion regardless of whether Applicant's use of THE CUBE is merely descriptive. *Cf. In re Bissett-Berman Corp.*, 476 F.2d 640, 177 USPQ 528,

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<sup>3</sup> "Marshalls Your Fashion Hot Spot Via La Cube," *Fixturescloseup.com*, attached to the March 5, 2019 Office Action (TSDR 13-16).

<sup>4</sup> Applicant's Brief, p. 14 (7 TTABVUE 20).

529 (CCPA 1973) (“Comparison of the language of sections 2(d) and 2(f) renders it clear that section 2(f) does not negate the requirements of Section 2(d) embracing the matter of likelihood of confusion.”). “When one incorporates the entire arbitrary mark of another into a composite mark, the inclusion of a significant, nonsuggestive element will not necessarily preclude a likelihood of confusion.” *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design is similar to the mark CONCEPT); *Coca-Cola Bottling Co. v. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL LANCER and Bengal Lancer soldier design is similar to the mark BENGAL).

Finally, we operate on the legal assumption, dictated by Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), that Registrant’s mark is a valid service mark entitled to the presumptions included in the statute (i.e., the validity of the registered mark and of the registration of the mark, Registrant is the owner of the mark, and Registrant has the exclusive right to use the mark in commerce). Thus, in view of these presumptions, we have no basis for presuming, as Applicant would have us do, that the mark in the cited registration has a limited scope of protection. “Indeed, in an *ex parte* proceeding, even an admittedly descriptive term, if subject of a registration on the Supplemental Register, can be relied upon as a basis for refusing registration to another’s confusingly similar term under Section 2(d) of the Act.” *In re Nat’l Retail Hardware Assoc.*, 219 USPQ 851, 853 (TTAB 1983).<sup>5</sup>

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<sup>5</sup> In this appeal, Applicant contends that the term THE CUBE is merely descriptive in connection with Applicant’s intended use of its mark. Despite Applicant’s contention at oral

We find that the registered mark THE CUBE for “retail store services featuring clothing, footwear, sportswear, eyewear, handbags, and accessories” is a conceptually strong mark, entitled to a broad scope of protection.

## **II. The similarity or dissimilarity of the marks.**

We now turn to the *DuPont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); accord *Krim-Ko Corp. v. Coca-Cola Bottling 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.”) (citation omitted).

“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.” *Cai v. Diamond Hong, Inc.*, 127 USPQ2d at 1801 (Fed. Cir.

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argument that Registrant’s use of THE CUBE is descriptive, discussed above, Applicant, in its brief and reply brief, did not contend that THE CUBE is merely descriptive when used by Registrant. Therefore, Applicant’s contention that its proposed use of THE CUBE is merely descriptive, not that Registrant’s use is merely descriptive, is not a collateral attack on the validity of the registered mark. Trademark Rule 2.106(3)(ii), 37 C.F.R. § 2.106(3)(ii) (“An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek cancellation of such registration.”); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1174 n.17 (TTAB 2011) (plaintiff’s mark is registered without either a disclaimer of the term at issue or a claim of acquired distinctiveness, and there is no counterclaim so Board cannot entertain any attack on the term as being merely descriptive).

2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); see also *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. 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. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., 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 coats and jackets are “related to a customizable coat concept featuring coats and coat components that can be primarily transported within a portable cube carrier” and the services at issue are retail store services featuring, inter alia, clothing, we find that the average customer is an ordinary consumer.

The marks are similar because they share the term “The Cube.” In fact, Applicant’s mark MAXMARA THE CUBE. and design incorporates Registrant’s entire mark. While there is no express rule that we must automatically find marks similar where a junior user’s mark contains the whole of another mark, the fact that the cited registered mark is subsumed by Applicant’s mark increases the similarity of the two. See, e.g., *China Healthways Inst. Inc. v. Xiaoming Wang*, 491 F.3d 1337, 83 USPQ2d 1123, 1125 (Fed. Cir. 2007) (applicant’s mark CHI PLUS is similar to

opposer's mark CHI both for electric massagers); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (applicant's mark VANTAGE TITAN for medical magnetic resonance imaging diagnostic apparatus is similar to TITAN for medical ultrasound diagnostic apparatus); *Broadcasting Network Inc. v. ABS-CBN Int'l*, 84 USPQ2d 1560, 1568 (TTAB 2007) (respondent's mark ABS-CBN is similar to petitioner's mark CBN both for television broadcasting services); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (applicant's mark MACHO COMBOS for food items confusingly similar to MACHO for restaurant entrees); *In re Riddle*, 225 USPQ 630, 632 (TTAB 1985) (RICHARD PETTY'S ACCU TUNE for automotive service centers confusingly similar to ACCU-TUNE for automotive testing equipment).

This is often true where, as here, Applicant's mark includes a house mark because the house mark suggests that Registrant's services are a retail extension based on Applicant's products. *See Saks & Co. v. TFM Indus. Inc.*, 5 USPQ2d 1762, 1764 (TTAB 1987) ("the use of the phrase BY FIRE ISLANDER [in FOLIO BY FIRE ISLANDER] may only tend to increase and not decrease the likelihood of confusion" with FOLIO); *In re Apparel Ventures, Inc.*, 229 USPQ 225, 226 (TTAB 1986) (SPARKS BY SASSAFRAS for women's clothing is likely to cause confusion with SPARKS for shoes, boots and slippers, in part, because "[t]he words 'by sassafras' indicate to prospective purchasers that 'sassafras' is the name of the entity which is the source of the 'SPARKS' brand clothing. Prospective purchasers do not necessarily know or care which business calls itself 'sassafras,' but they would assume that when

‘SPARKS’ appears on two similar products they both come from the same source.”); *Riddle*, 225 USPQ 630 (“Richard Petty’s Accu Tune” for automotive service centers specializing in engine tune-ups and oil changes, is likely to cause confusion with “Accutune” automotive testing equipment.).

[I]n line extensions into new product categories adaptations of existing brand names are frequently utilized to gain marketing advantages from the good will of the established brands in spite of the possible “blurring” of the brands’ perceived imagery which may occur as a result.

*Miles Labs. Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1451 n.26 (TTAB 1986). Thus, some fashion conscious purchasers of jackets and coats might be confused upon encountering a MAXMARA THE CUBE. coat or jacket, perceiving it as connected to Registrant’s retail store concept or representing an expansion by Applicant of Registrant’s THE CUBE store brand and marketing activities into a related market (coats and jackets). On the other hand, because Applicant asserts that it “is one of the most iconic and internationally recognized fashion houses in the world,”<sup>6</sup> consumers familiar with Applicant’s MAX MARA mark upon encountering Registrant’s mark mistakenly may believe that Applicant has expanded into retail store services. *See Schieffelin & Co. v. Molson Cos. Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989) (“Those consumers who do recognize the differences in the marks may believe that applicant’s mark is a variation of opposer’s mark that opposer has adopted for use on a different product.”); *Home Juice Co. v. Runmlin Cos. Inc.*, 231 USPQ 897, 900 (TTAB 1986) (purchasers mistakenly may believe that the additional matter in the

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<sup>6</sup> Applicant’s Brief, p. 8 n.1 (7 TTABVUE 14).

registered mark distinguishes two products having the same source rather than perceiving the additional matter as indicating a different source).

Applicant cites *Rocket Trademarks Pty Ltd. v Phard S.p.A.*, 98 USPQ2d 1066 (TTAB 2011) (ZU ELEMENTS (stylized) not confusingly similar to ELEMENTS in connection with identical clothing goods due, in part, to suggestiveness of term “elements”) and *Knight Textile Corp. v. Jones Inv. Co.*, 75 USPQ 1313 (TTAB 2005) (the mark ESSENTIALS found so highly suggestive that the addition of house mark NORTON MCNAUGHTON sufficed to distinguish the marks) for the proposition that when a house mark is added to a suggestive term, that may avoid a likelihood of confusion.<sup>7</sup>

*Rocket Trademarks* and *Knight Textile* are inapposite because in those cases the common terms “Elements” and “Essentials” were highly suggestive for the opposers’ products. In this appeal, Registrant’s mark THE CUBE is not highly suggestive for “retail store services featuring clothing, footwear, sportswear, eyewear, handbags, and accessories.”

Applicant argues that the marks are “manifestly different in sight, sound, and commercial meaning.”<sup>8</sup> While the marks are not identical, “exact similitude is not required to conclude that two marks are confusingly similar.” *Hercules Inc. v. Nat’l Starch & Chem. Corp.*, 223 USPQ 1244, 1246 (TTAB 1984) (NATROL is similar to NATROSOL). In this regard, the design element in Applicant’s mark is not so

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<sup>7</sup> *Id.* at p. 9 (7 TTABVUE 15).

<sup>8</sup> Applicant’s Brief, p. 8 (7 TTABVUE 14).

distinctive that it distinguishes the marks. Although we assess each mark in its entirety, wording often is considered the dominant feature of a mark comprising both literal and design elements because it is most likely to indicate the source of the services. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 982 (2016); *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the conclusion rests on a consideration of the marks in their entireties. *See Viterra*, 101 USPQ2d at 1908; *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant contends that its use of MAXMARA THE CUBE. within a cube design reinforces the descriptive import of THE CUBE. in connection with Applicant's coats and jackets.<sup>9</sup> However, the design element is merely a square that borders the wording. Assuming arguendo that Applicant is correct, then the cube design, in fact, highlights the term THE CUBE., drawing it even closer to Registrant's mark.

We find that the marks are similar in appearance, sound, connotation and commercial impression.

### **III. The similarity or dissimilarity and nature of the goods and services.**

The goods and services at issue need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080,

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<sup>9</sup> *Id.* at 10 (7 TTABVue 16).

1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

As noted above, Applicant’s goods are coats and jackets that may be transported in a portable cube carrier and Registrant’s description of services is “retail store services featuring clothing, footwear, sportswear, eyewear, handbags, and accessories.” The Court of Appeals for the Federal Circuit and the Board have found that use of similar marks on or in connection with both products and retail store services offering the products are related. *See In re Peebles, Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992) (holding the use of nearly identical marks for coats and for retail outlets featuring camping and mountain climbing equipment, including coats, likely to cause confusion, noting that “there is no question that store services and the goods which may be sold in that store are related goods and services for the purpose of determining likelihood of confusion”). *See also In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (“trademarks for goods find their principal use in connection with selling the goods” and accordingly marks for goods and marks for the service of selling such goods will have their impact on the purchasing public in the same marketplace.”); *In re House Beer, LLC*, 114 USPQ2d 1073, 1078 (TTAB 2015) (“The evidence is sufficient to persuade us that if customers

were to encounter beer under a mark that is identical to the mark of a retail store that features beer, they would likely believe that the product and the service are related.”);

Contrary to the Examining Attorney’s contention, there is no direct evidence showing traditional retail store services featuring clothing.<sup>10</sup> Rather, the evidence shows online retail sales of coats and jackets, not traditional, “brick and mortar” retail store services. *See e.g.*, Burberry website (us.burberry.com),<sup>11</sup> Coach.com,<sup>12</sup> Nordstrom.com,<sup>13</sup> Bloomingdales.com,<sup>14</sup> Saks Fifth Avenue website (saksfifthavenue.com),<sup>15</sup> Neiman Marcus website (neimanmarcus.com),<sup>16</sup> Orvis.com,<sup>17</sup> The North Face website (thenorthface.com),<sup>18</sup> Tumi.com,<sup>19</sup> Cole Haan

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<sup>10</sup> Examining Attorney’s Brief (9 TTABVUE 13).

<sup>11</sup> May 28, 2018 Office Action (TSDR 37).

All citations to documents contained in the Trademark Status & Document Retrieval (TSDR) database are to the downloadable .pdf versions of the documents.

<sup>12</sup> *Id.* at TSDR 42. The website has a “find a store” menu option.

<sup>13</sup> December 20, 2018 Office Action (TSDR 8-9).

<sup>14</sup> *Id.* at TSDR 14-15. The website has a “stores & events” menu option.

<sup>15</sup> *Id.* at TSDR 27. The webpage does not advertise the sale of coats and jackets, but the menu on the left side of the webpage lists coats and jackets as a product offering. In addition, the website has an option that reads, “In-store services at a location near you LEARN MORE.”

<sup>16</sup> *Id.* at TSDR 34.

<sup>17</sup> July 27, 2019 Denial of Request for Reconsideration (5 TTABVUE 13-14). The website has a “find a store” menu option.

<sup>18</sup> *Id.* at 5 TTABVUE 18-24. The website has a “find a store” menu option.

<sup>19</sup> *Id.* at 5 TTABVUE 28-29. The website has a “find a store” menu option.

website (colehaan.com),<sup>20</sup> Michael Kors website (michaelkors.com),<sup>21</sup> and Columbia.com.<sup>22</sup>

Nevertheless, it is common knowledge that department stores and fashion designers have both brick and mortar retail stores, as well as online sales capabilities. Thus, some of the websites that have menu options for locating stores indicate that those entities may offer retail store services. Moreover, because online retail sales services and retail stores services fall within the penumbra of retail sales, they are largely identical services. As noted above, the Federal Circuit explained why products and retail stores that sell those products are related:

Considering the facts (a) that trademarks for goods find their principal use in connection with selling the goods and (b) that the applicant's services are general merchandising--that is to say selling--services, we find this aspect of the case to be of little or no legal significance. The respective marks will have their only impact on the purchasing public in the same marketplace.

*Hyper Shoppes*, 6 USPQ2d at 1026. Thus, we find that online retail sales services and traditional retail store services are equivalent so that the reasoning supporting the principle that products and retail stores services that sell those products are related applies to products and retail online sales services that sell those products.

Applicant contends that because its jackets and coats are a customizable coat concept that can transported in a portable cube carrier they are

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<sup>20</sup> *Id.* at 4 TTABVUE 3-5. The website has a menu option for “stores.”

<sup>21</sup> *Id.* at 4 TTABVUE 11. The website has a “find a store” menu option.

<sup>22</sup> *Id.* at 4 TTABVUE 19-20. The website has a “store locator” menu option.

somehow distinguishable from retail store services that encompass such goods.<sup>23</sup> However, the fact that Applicant's jackets and coats may have an associated carrier is not so unique as to place those products into a category all of their own that consumers will distinguish from otherwise related services. The record shows that the entities listed below sell coats or jackets with a carrying case:

- Uniqlo (uniqlo.com/us/);<sup>24</sup>
- Orvis (Orvis.com);<sup>25</sup>
- The North Face (thenorthface.com);<sup>26</sup>
- Cole Haan (colehaan.com);<sup>27</sup>
- Macy's (macys.com);<sup>28</sup>
- Michael Kors (michaelkors.com);<sup>29</sup>
- Bernardo (bernadofashions.com);<sup>30</sup> and
- Columbia (columbia.com).<sup>31</sup>

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<sup>23</sup> Applicant's Brief, p. 13 (7 TTABVUE 19) ("The Examiner cannot simply shoehorn Applicant's products within some broad notion that mass retailers sell everything under the sun, including discount clothing.").

<sup>24</sup> July 25, 2019 Denial of Request for Reconsideration (5 TTABVUE 7-9).

<sup>25</sup> *Id.* at 5 TTABVUE 12-14.

<sup>26</sup> *Id.* at 5 TTABVUE 18-24.

<sup>27</sup> *Id.* at 4 TTABVUE 3-4.

<sup>28</sup> *Id.* at 4 TTABVUE 8-10.

<sup>29</sup> *Id.* at 4 TTABVUE 11.

<sup>30</sup> *Id.* at 4 TTABVUE 16-17.

<sup>31</sup> *Id.* at 4 TTABVUE 19-20.

Applicant also argues that “[c]onsumers of high-fashion coats would not expect that such products would emanate from a bargain-basement juniors’ section.”<sup>32</sup> More specifically, Applicant asserts that its jackets and coats sell for “upwards of \$1,000 dollars” [sic] in Applicant’s Max Mara stores and on Applicant’s Max Mara websites” whereas Registrant uses the mark THE CUBE to identify a “strip mall bargain ‘juniors’ store”<sup>33</sup> within its “MARSHALL’S branded-mass retail stores” targeted to the bargain basement shopper.<sup>34</sup> However, we must compare Applicant’s goods and Registrant’s services as identified in the application and the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Notwithstanding Applicant’s argument and evidence regarding the actual scope of its own goods (i.e., expensive,

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<sup>32</sup> Applicant’s Brief, p. 10 (7 TTABVUE 16).

<sup>33</sup> June 11, 2019 Request for Reconsideration (TSDR 8).

<sup>34</sup> Applicant’s Brief, p. 14 (7 TTABVUE 20). However, Applicant’s corroborating evidence points out that Registrant sells many popular brands, including luxury brands. “The Best Marshalls Shopping Secrets to Help You Score Major Deals,” (May 16, 2019) GoodHouseKeeping.com. *Id.* at TSDR 21. In addition, that article identifies THE CUBE as “an in-store boutique for juniors.” *Id.* at TSDR 28. *See also* “The CUBE at Marshalls: Steadily Improving!”,(June 15, 2009) (illegible URL) (*Id.* at TSDR 120); “Fashion Find: Marshall’s ‘The Cube,’” (July 31, 2008) FashionMeFabulous.com (*Id.* at TSDR 133). A “boutique” is defined as “a small shop or a small specialty department within a larger store, especially one that sells fashionable clothes and accessories or specialized selection of merchandise.” Dictionary.com based on THE RANDOM HOUSE UNABRIDGED DICTIONARY (2020) accessed February 12, 2020. Accordingly, some of Registrant’s customers shop at Registrant’s THE CUBE boutique in the hopes of finding a brand name deal similar to Applicant’s coats or jackets.

The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

high-fashion coats) and Registrant's services (i.e., retail store services featuring bargain basement, discount juniors' clothing within Registrant's MARSHALL'S retail stores) and their commercial use of their marks, we may not limit, by resort to extrinsic evidence, the scope of goods or services as identified in the cited registration or in the subject application. *E.g.*, *In re Dixie Rests. Inc.*, 105 USPQ2d, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *In re Fisher Scientific Co.*, 440 F.2d 43, 169 USPQ 436, 437 (CCPA 1971); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1646 (TTAB 2008); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). That is, Applicant does not restrict its description of goods to expensive, high-fashion coats and Registrant does not restrict its description of services to the retail sale of bargain basement, discount juniors' clothing within its MARSHALL'S-branded retail stores.

We find that Applicant's customizable coats and jackets that may be transported in a customized, portable cube carrier are related to Registrant's retail store services featuring clothing.

#### **IV. Established, likely-to-continue channels of trade and classes of consumers.**

The website evidence discussed above shows that customizable coats and jackets transported in a cube carrier and retail store services featuring clothing are offered in the same channels of trade (i.e., through retail store services and online retail sales services) to the same classes of consumers (i.e., shoppers who go to retail stores and who shop online).

**V. Conditions under which sales are made.**

Applicant argued at the oral hearing that its high-fashion coats retail for upwards of \$1,000 and are sold in Applicant's retail stores and on its website to prove that Applicant's customers exercise a high degree of care when making their purchasing decision. However, as noted above, we may not resort to extrinsic evidence to restrict the price or nature of the descriptions of goods and services. *See In re Bercut-Vandervoort & Co.*, 229 USPQ at 764 (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). *See also Stone Lion Capital Partners*, 110 USPQ2d at 1163-64 (recognizing Board precedent requiring consideration of the "least sophisticated consumer in the class"); *In re Sailerbrau Franz Sailer*, 23 USPQ2d 1719, 1720 (TTAB 1992) (finding that all purchasers of wine may not be discriminating because while some may have preferred brands, "there are just as likely to be purchasers who delight in trying new taste treats."). Therefore, the conditions under which sales are made is a neutral *DuPont* factor.

**VI. Conclusion**

Because the marks are similar, the goods and services are related, and there are no trade channel restrictions, we find that Applicant's mark MAXMARA THE CUBE and design for coats and jackets "related to a customizable coat concept featuring coats and coat components that can be primarily transported within a portable cube carrier, or clothing components therefor" is likely to cause confusion with the registered mark THE CUBE for "retail store services featuring clothing, footwear, sportswear, eyewear, handbags, and accessories."

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**Decision:** The refusal to register Applicant's mark MAXMARA THE CUBE. and design is affirmed.