

This Opinion is Not a
Precedent of the TTAB

Hearing: October 24, 2019

Mailed: December 4, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re La Mamba, LLC

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Serial No. 87791970

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Scott P. Shaw of Call & Jensen, APC,
for La Mamba, LLC.

Geraldine Ingold, Trademark Examining Attorney, Law Office 121,
Richard White, Managing Attorney.¹

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Before Rogers, Chief Administrative Trademark Judge, and Taylor and Ritchie,
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

La Mamba, LLC (“Applicant”) seeks registration on the Principal Register of the
mark PARC & LEX (and design), as shown below, for goods ultimately identified as

¹ The case was assigned to this Examining Attorney after the appeal was filed. Managing Attorney Richard White represented the Office at the oral hearing.

“Clothing, namely, t-shirts, sweatshirts, skirts, pants, jeans, coats, dresses, underwear, tops and bottoms; headwear; footwear,” in International Class 25:²



The application contains the following description: “The mark consists of Parc & Lex with a dash on each side through the center of a circle.” Color is not claimed as a feature of the mark.

The Examining Attorney refused registration of Applicant’s mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a prior registration of the mark PARK & LEX, in standard characters, for “Jewelry, namely, necklaces, bracelets and earrings,” in International Class 14.³ After the Examining Attorney made the refusal final, Applicant filed a request for reconsideration and an appeal. When the request for reconsideration was denied, the appeal was resumed. Both Applicant and the Examining Attorney filed briefs. Applicant requested an oral hearing, which was presided over by this panel.

² Serial No. 87791970, filed on February 9, 2018, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), claiming a bone fide intent to use the mark in commerce.

³ Registration No. 5357823 issued December 19, 2017.

For the reasons discussed herein, based on the evidence of record and following full consideration of the arguments of Applicant and the Examining Attorney, 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 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). 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 (CCPA 1976). *See also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). We consider the *du Pont* factors for which arguments or evidence were presented. The other factors, we consider to be neutral.

A. The Marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir.



2005). The cited mark is PARK & LEX. Applicant's mark, , contains the literal element PARC & LEX, which is almost identical to the cited mark,

with the only difference a “c” instead of a “k” at the end of the first word: PARK/PARC. While the literal portion of Applicant’s mark is in a particular font, the cited mark is in standard characters, and thus may be presented in any font, style, size, or color. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012) (“Indeed, our decision in *Citigroup* only broadens the potential variations of the standard character XCEED mark to be considered in the likelihood of confusion analysis and, if anything, makes the Board’s decision less vulnerable to attack.”) We accordingly must presume that the cited mark may be presented in the same font as the literal element in Applicant’s mark.

Moreover, although Applicant’s mark contains a design element, the circle and dashes are less significant than the wording, by which consumers are more likely to call for, or refer to, the goods. *See Viterra*, 101 USPQ2d at 1908 (“In the case of a composite mark containing both words and a design, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed” (internal quotation marks omitted)); *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999) (“In the case of marks which consist of words and a design, the words are normally accorded greater weight because they would be used by purchasers to request the goods.”). We note, furthermore, that common geometric shapes, such as the design in Applicant’s mark, are not generally considered to be source-indicating. *See In re Benetton Group S.p.A.*, 48 USPQ2d 1214 (TTAB 1998). Thus, the marks are overall highly similar in appearance.

With regard to pronunciation, Applicant argues that as a foreign word, consumers will pronounce “PARC” differently from “PARK,” with a French pronunciation. Case law dictates that there is no correct pronunciation of a trademark. *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1651 (Fed. Cir. 2014) (“There is no correct pronunciation of a trademark that is not a recognized word.”) (citing *In re Belgrade Shoe Co.*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969)); *In re Allegiance Staffing*, 115 USPQ2d 1319, 1325 (TTAB 2015) (no correct pronunciation of mark that is coined term). Nevertheless, since consumers are likely to view “PARC & LEX” as a misspelling of “PARK & LEX,” we find that they are likely to pronounce the marks in the same, or a very similar, manner.

The Examining Attorney argues that the connotations and commercial impressions of the marks are the same, conveying the enviable style of New York City embodied in the famous avenues of Park and Lexington, also known as Lex. In this regard, the Examining Attorney submitted into the record evidence of “Park Avenue” as “a wealthy residential street in New York City, regarded as a symbol of high society, fashion, etc.”⁴ The Examining Attorney further submitted a Wikipedia entry for “Lexington Avenue” that states, “Lexington Avenue, often colloquially abbreviated as ‘Lex’ is an avenue on the East Side of the borough of Manhattan in New York City”⁵ The record further contains evidence, submitted by Applicant, from the

⁴ Collinsdictionary.com, attached to December 7, 2018 Final Office Action, at 8.

⁵ <https://en.wikipedia.org>, attached to December 7, 2018 Final Office Action, at 6.

Registrant's website, regarding the meaning of the term Park & Lex as referring to the neighboring avenues in Manhattan:

The name Park & Lex comes, of course, from two parallel, consecutive avenues in Manhattan: Park Avenue and Lexington Avenue. While these two thoroughfares never intersect, they exist simultaneously, and represent the diversity of the city.⁶

Applicant argues that its mark has a different commercial impression, asserting in its brief, "PARC & LEX connotes European style and a child, not a commercial strip in New York."⁷ Applicant does not dispute that the term "parc" is a French word that may be translated as "park."⁸ Applicant argues, nevertheless, that consumers will not translate the term, nor associate it with Park Avenue in New York.⁹ Applicant further argues that "Lex' is a common nickname in the United States for Alex, Alexander, or Lexington."¹⁰ In this regard, Applicant submitted a Wikipedia entry for "Lex" that states "Lex is a given name. It is a common male name in the Netherlands, and is sometimes short for Alexander, Alexandra, Alexandria or Lexington."¹¹

Despite this reference, there is no evidence that Lex is a given name commonly known to consumers in the United States. Applicant's evidence referencing census

⁶ Attached to June 7, 2019 Request for Reconsideration, at 45.

⁷ 6 TTABVUE 7.

⁸ Applicant submitted a translation of "parc" as French for "park." <https://en.wiktionary.org>, attached to June 7, 2019 Request for Reconsideration, at 4. Applicant's evidence also noted the same meaning for "parc" in Catalan, Romanian, and Welsh. *Id.*, at 4-7.

⁹ 6 TTABVUE 10.

¹⁰ 6 TTABVUE 12.

¹¹ <https://en.wikipedia.org>, attached to June 7, 2019 Request for Reconsideration, at 36.

search results for the names Alexander, Alex, Alexandra, Alexandria and Lexington does not actually establish that individuals in the United States with these names are referred to as “Lex.”¹² Therefore, we give little probative value to Applicant’s argument that:

While there does not appear to be any census data on how many people use nicknames, it may be inferred that because Lex is noted as a common nickname for those names, thousands, if not tens of thousands of people in the United States go by the nickname Lex.¹³

Considering Applicant’s mark as a whole, as we must, we find that the literal element PARC & LEX is likely to be understood by consumers as a variation on, or misspelling of, the highly similar mark PARK & LEX. As noted, the design element in Applicant’s mark is less significant than the wording. We therefore find that the connotation and commercial impression of the marks is highly similar.

In making this finding, we may consider, in the alternative, the term “parc” as a French word with a translation as “park.” The doctrine of foreign equivalents applies when the “ordinary American purchaser” would “stop and translate” a foreign mark into its English equivalent. *Palm Bay Imps, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). The doctrine applies only where the English translation is “literal and direct” with no contradictory evidence of other relevant meanings or shades of meaning. TMEP 1207.01(b)(vi)(B) (October 2018). It is not an absolute rule, and does not include dead

¹² Applicant attached evidence regarding each of these names from HowManyofMe.com, to the June 7, 2019 Request for Reconsideration, at 22-34.

¹³ 6 TTABVUE 12.

or obscure languages. *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1351, 90 USPQ2d 1489, 1491 (Fed. Cir. 2009). Although arguing that the doctrine does not apply, Applicant did submit evidence that French is “the forth most-spoken language” in the United States, and in some parts of the country is the second or third.¹⁴ For the reasons explained, we further note that we would make the same finding without applying the doctrine of foreign equivalents. Therefore, we find that the marks are highly similar in sight and sound, and are also similar in commercial impression and connotation.

This first *du Pont* factor weighs in favor of finding a likelihood of confusion.

B. The Goods and Channels of Trade

When considering the relatedness of the goods, we note that with similar marks, goods need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that the goods are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used or intended to be used therewith, to a mistaken belief that they originate from, or are in some way associated with, the same producer, or that there is an association between the producers of the parties’ goods or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991).

¹⁴ <https://en.wikipedia.org>, attached to June 7, 2019 Request for Reconsideration, at 12.

The application identifies “clothing, namely, t-shirts, sweatshirts, skirts, pants, jeans, coats, dresses, underwear, tops and bottoms; headwear; footwear,” and the cited registration identifies “jewelry, namely, necklaces, bracelets and earrings.” To demonstrate the relatedness of the identified goods, the Examining Attorney submitted use-based, third-party registrations, covering various clothing items of the type identified in the application (t-shirts, pants) and jewelry items of the type identified in the cited registration (earrings, bracelets) may be offered under a single mark. These include Registration No. 5476142 (COLE HAAN), Registration No. 5315530 (TOWASHINE), Registration No. 5296212 (FOCAL20), Registration No. 5411324 (NOTHING SHOP), and Registration No. 5427725 (design mark).¹⁵ The Examining Attorney also submitted third-party web pages from American Eagle, Express, Kate Spade, Lands’ End, Tommy Bahama, Tony Burch, Tommy Hilfiger, and NorthStyle, advertising both clothing items of the type identified by Applicant (t-shirts, pants) and jewelry items of the type identified by Registrant (earrings, bracelets), under the same mark.¹⁶ Together with the third-party registrations, this evidence indicates that consumers are likely to assume that they derive from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *In re Detroit Ath. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (relatedness supported by evidence that third parties sell both types of goods under

¹⁵ Attached to May 24, 2018 Office Action, at 17-30.

¹⁶ Attached to May 24, 2018 Office Action, at 5, 8; to December 7, 2018 Final Office Action at 8-25; and to June 11, 2019 Denial of Request for Reconsideration, at 2-3.

the same mark, showing that “consumers are accustomed to seeing a single mark associated with a source that sells both”).

With regard to channels of trade, Applicant argues that, “The Registrant’s sale of fine jewelry, inspired by New York, is sold in a different trade channel than Applicant’s mass clothing apparel made in Los Angeles.”¹⁷ It is axiomatic, however, that because the restrictions asserted by Applicant are not listed in either the application or in the cited registration, we may not consider these alleged differences. *See Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.” (citations omitted)). Accordingly, we must assume that Applicant’s and Registrant’s goods may travel via all normal channels of trade for such goods and be marketed to typical consumers. *See Squirtco v. Tomy Corporation*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983). As indicated by the evidence of record, a number of third parties offer both types of goods to members of the general public that seek both clothing items identified by Applicant (t-shirts, pants) and jewelry items identified by Registrant (earrings, bracelets).

The second and third *du Pont* factors also weigh in favor of finding a likelihood of confusion.

¹⁷ 6 TTABVUE 20.

C. Conditions of Sale

Finally, we consider the conditions of sale and classes of consumers. Applicant argues that the “Registrant sells fine jewelry to higher end retailers.”¹⁸ Applicant further argues that Applicant’s clothing is “sold at much more affordable prices.”¹⁹ The goods identified in the application and in the cited registration are not limited by purchasers or classes of consumers, or by price points. We must make our determination based on the least sophisticated consumer, and we must assume that clothing and jewelry may be offered at varying qualities and prices.²⁰ *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) (affirming that TTAB properly considered all potential investors for recited services, which included sophisticated investors, but that precedent requires consumer care for likelihood-of-confusion decision to be based “on the least sophisticated potential purchasers”).

Overall, we find the fourth *du Pont* factor to be neutral.

D. Conclusion

After considering all of the arguments and evidence of record as they pertain to the relevant *du Pont* factors, we find that the marks are highly similar in sight and sound, and are also similar in connotation and commercial impression. We further

¹⁸ 6 TTABVUE 20.

¹⁹ *Id.*

²⁰ In this regard, evidence of record shows earrings listed on sale for less than ten dollars, under the same mark as shirts listed for sale under twenty dollars, from Express. See *www.express.com*, attached to May 24, 2018 Office Action at 8-9.

find that the goods are related and are likely to travel through overlapping channels of trade and be available to same classes of purchasers. Accordingly, we find that



there is a likelihood of confusion between Applicant's mark and the cited mark PARK & LEX, for the goods as identified.

Decision: The Section 2(d) refusal to register Applicant's mark is affirmed.