

This Opinion is Not a  
Precedent of the TTAB

Mailed: November 4, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*Hachette Filipacchi Presse*

*v.*

*Lauren R. Schneider*

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Opposition No. 91202984

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Gary H. Fechter, Lori Shyavitz and Alice M. Pang of McCarter & English, LLP, for  
Hachette Filipacchi Presse.

Lauren R. Schneider, *pro se*.

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Before Zervas, Ritchie and Heasley,  
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Lauren R. Schneider (“Applicant”) seeks to register the mark ELLE SCHNEIDER  
in standard characters for the following International Class 41 services:

Film and video production; Film and video production consulting services; Film editing; Media production services, namely, video and film production; Multimedia entertainment services in the nature of development, production and post-production services in the fields of video and films; Multimedia entertainment services in the nature of recording, production and post-production

services in the fields of music, video, and films; Photography; Photography services; Post-production editing services in the field of music, videos and film; Production and distribution of videos in the field of fashion; Production of films; Script writing services; Writing of articles for periodicals other than for advertising or publicity; Writing of texts other than publicity texts.<sup>1</sup>

Hachette Filipacci Presse (“Opposer”) asserts the following three claims in opposition to the registration of Applicant’s mark in its amended notice of opposition:

1. Applicant is using the name “Elle Schneider” as her personal name and/or pseudonym, and not as a service mark in connection with the advertisement, promotion or provision of the services set forth in the application.
2. Confusion is likely under Trademark Act Section 2(d), 15 U.S.C. § 1052(d),

with Opposer’s previously registered marks listed below:<sup>2</sup>

- Registration No. 758137, issued on September October 8, 1963, for the mark ELLE in typed form<sup>3</sup> for “magazine” in International Class 16;

- Registration No. 1314558, issued on January 15, 1985,

for the mark **E L L E** for goods including notebooks, writing pads, pencils, and notebooks/writing pads in International Class 16;

- Registration No. 1732988, issued on November 17, 1992, for the mark ELLE DECOR for “magazines featuring interior and exterior decorating, architecture, landscaping,

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<sup>1</sup> Application Serial No. 85240605, filed February, 11, 2011, under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), claiming first use and first use in commerce in 2006.

<sup>2</sup> Each registration includes a translation statement providing that ELLE means “she” in English.

<sup>3</sup> Prior to November 2, 2003, “standard character” marks 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) (“until 2003, ‘standard character’ marks formerly were known as ‘typed’ marks.”)

gardening and horticulture; cuisine; art and sculpture, artifacts, antiques and collections, furniture; household accessories, accoutrements, and fixtures; critiques of residences; biographical sketches; electronics for the home; national and international lifestyles, travel, tourism and photography” in International Class 16;

- Registration No. 1668272, issued on December 17, 1991,

for the mark  for “printed matter and periodicals, namely, newspapers, reviews, pamphlets, brochures, newsletters, information or advertising letters, journals and magazines in the fields of interior and exterior decorating, architecture, landscaping, gardening and horticulture; cuisine” in International Class 16 and “publication of books, magazines, and newspapers” in International Class 41; and

- Registration No. 2242315 (“the ‘315 registration”), issued on May 4, 1999, for the mark ELLE in typed form for “telephone communications services, electronic transmission of data, images and sounds and documents via computer terminals; electronic transmission of information from data banks via computer terminals” in International Class 38, “forums in the field of fashion and beauty; entertainment services, namely, providing an on-line entertainment variety show, featuring fashion and beauty” in International Class 41 and “licensing of intellectual property; editing of written texts, book reviews, periodicals, magazines and publications of all types regardless of their form, including electronic and digitalized publications, compiling data bases and data banks for use by others” in International Class 42.<sup>4</sup>

We refer to these marks collectively as the “Elle Marks.”

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<sup>4</sup> Opposer also asserted U.S. Registration No. 1767100 for the mark ELLE. The USPTO cancelled this registration, and we give it no further consideration.

3. Registration of Applicant's mark is likely to dilute Opposer's famous ELLE marks by impairing the distinctiveness of Opposer's ELLE marks in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

Applicant, in its answer, denied the salient allegations of the amended notice of opposition.

Opposer filed a brief on the case. Applicant filed no brief and did not submit any testimony or other evidence. Even though Applicant filed no evidence or brief, Opposer, as plaintiff in this proceeding, must nonetheless prove its standing and its claims by a preponderance of the evidence. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

#### *The Record*

In addition to Applicant's opposed application, which is automatically of record pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the evidence of record consists of the following:

- Testimony deposition of Applicant, with exhibits.
- A copy of Opposer's pleaded registrations for the Elle Marks, submitted pursuant to Trademark Rule 2.122(d) with the original and amended notices of reliance, showing that the Elle Marks are subsisting and owned by Opposer.
- Opposer's first notice of reliance, submitting:
  - Opposer's first set of interrogatories and document requests and Applicant's responses thereto;
  - Applicant's responses to Opposer's first set of requests for admission; and

- Opposer's second requests for admission with exhibits and Applicant's responses thereto.
- Opposer's second notice of reliance, submitting, *inter alia*:
  - Decision issued by the Board in *Hachette Filipacchi Presse v. Ev International, LLC*, Opposition No. 91174433 (TTAB Sept. 5, 2008) (nonprecedential);
  - Final Judgment entered by the United States District Court for the Southern District of Florida in *Hachette Filipacchi Presse v. Ricardo Orduz d/b/a ELLAHAIRSTRAIGHTENER.COM*, Civil Action No. 14-cv-20599-UU on April 24, 2014;
  - Internet evidence;
  - Opposer's 2012 media kit, discussed below; and
  - February 21, 2012 declaration of Fabienne Sultan, Director of Opposer's Industrial Property Department, and exhibits, discussed below.

#### *Evidentiary Issues*

Opposer submitted the Sultan declaration in another Board proceeding titled *Hachette Filipacchi Presse v. Ellebodycare*, Opposition No. 91200547. According to Opposer's notice of reliance accompanying the declaration, Applicant produced the declaration in the course of discovery in this proceeding and did not object to its submission by Opposer. Opposer points out that the declaration is publicly accessible in the Board's electronic proceeding record ("TTABVUE" database) for the prior opposition.

There is no stipulation of record allowing for testimony by declaration. *See* Trademark Rule 2.123(b), 37 C.F.R. § 2.123(b). Absent an agreement in writing by the parties allowing testimony to be submitted in the form of a declaration, testimony must be taken by deposition upon oral examination in accordance with Trademark

Rule 2.123, 37 C.F.R. § 2.123, or by deposition upon written questions in accordance with Trademark Rule 2.124, 37 C.F.R. § 2.124. *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 703 (2016). An adverse party must be afforded a full opportunity to cross-examine the witness. *See* Trademark Rule 2.123(e)(3) and 124(d), 37 C.F.R. §§ 123(e)(3) and 124(d). While Applicant has not raised an objection to the testimony in the form of a declaration, neither did Applicant affirmatively waive such objection or treat the declaration as though it were of record. Where one party remains silent, as in the present case, the rule’s requirement of a “written agreement” has not been met. Where parties improperly introduce or submit non-conforming evidence such evidence “will not be considered even if the adverse party does not specifically object to it, as long as the adverse party does not specifically treat it as of record such that we can say it has been stipulated into the record.” *Calypso Technology, Inc. v. Calypso Capital Management, LP*, 100 USPQ2d 1213, 1216 (TTAB 2011). *Cf. Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1425 n. 8 (TTAB 1993) (objection waived where although there was no such agreement, plaintiff did not object to declarations with exhibits submitted by defendant and treated the evidence as if properly of record). Accordingly, we do not consider the declaration of Fabienne Sultan.

As for Opposer’s point that Applicant produced the Sultan declaration in discovery, a party that has obtained documents from another party under Fed. R. Civ. P. 34 may not make the produced documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under 37 CFR § 2.122(e) (as official records; or as printed publications, such as books and

periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in the proceeding; or Internet documents). *See* TBMP § 704.11. *See also* Trademark Rule 2.120(j)(3)(ii), 37 C.F.R. § 2.120(j)(3)(ii), and Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e), regarding printed publications.

Certain exhibits to Ms. Sultan's declaration, however, are appropriate for submission under notice of reliance (printed publication or internet printout with URL and date, or official record). We have considered such exhibits, if in English.

In addition, Opposer submitted a "media kit" with its second notice of reliance.<sup>5</sup> Opposer states, "Applicant produced this document during the course of discovery and did not object to its submission by Opposer ... ." As just discussed, a party that has obtained documents from another party under Fed. R. Civ. P. 34, may not make the produced documents of record by notice of reliance alone, with certain exceptions. *See* TBMP § 704.11. The "media kit" titled "The Elle Brand Vision" is not an official record or a printed publication available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in the proceeding, and there is no indication such as through a URL that it is an Internet document. Further, the fact that Applicant did not object to the document is not material in the present situation where Applicant did not submit evidence and did not file a brief. Thus, we have not considered the "media kit."

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<sup>5</sup> Exh. H to second notice of reliance, 31 TTABVUE 139.

*Standing*

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. To establish standing in an opposition or cancellation proceeding, a plaintiff must show “both a ‘real interest’ in the proceedings as well as a ‘reasonable basis’ for its belief of damage.” *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (quoting *ShutEmDown Sports, Inc., v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012)); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Opposer has established its standing through its submission of a copy of its pleaded registrations for the Elle Marks, which demonstrate that the registrations are valid and subsisting, and owned by Opposer. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (party’s ownership of pleaded registration establishes standing).

*Failure to Function as a Service Mark*

Applicant, who identifies herself as a filmmaker and a camera designer, testified that ELLE SCHNEIDER is a nickname that she has been using since approximately 2005 – 2006 “[in] credits for film projects.”<sup>6</sup> Applicant submitted the following specimen of use, a business card, with her application:

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<sup>6</sup> Schneider Test. at 6, 7 and 9, 21 TTABVUE 9, 10 and 12.



The business card contains ELLE SCHNEIDER next to the wording “DIRECTOR/WRITER” and Applicant’s email address.

Opposer argues that Applicant’s specimen consists solely of a business card, which, like any other business card, displays her name, Elle Schneider, but does not include any use of “Elle Schneider” as a service mark.<sup>7</sup>

A personal name mark, unless it is primarily merely a surname, is deemed to be inherently distinctive under the Lanham Act if the record shows that it is used in a manner that would be perceived by purchasers as identifying the services in addition to the person. *Compare In re Carson*, 197 USPQ 554 (TTAB 1977) (JOHNNY CARSON registrable as a service mark where name featured in advertisements for services) and *In re Ames*, 160 USPQ 214 (TTAB 1968) (NEAL FORD & THE FANATICS registrable as a service mark where name was used on advertisements that prominently featured a photograph of the group and gave the name, address and

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<sup>7</sup> Brief at 16-17, 32 TTABVUE 25-26.

telephone number of the group's booking agent), with *In re Mancino*, 219 USPQ 1047 (TTAB 1983) (BOOM BOOM would be viewed by the public solely as applicant's professional boxing nickname and not as an identifier of the service of conducting professional boxing exhibitions) and *In re Lee Trevino Enterprises, Inc.*, 182 USPQ 253 (TTAB 1974) (LEE TREVINO not registrable where specimens of use only identify a famous golfer not services). *See also* TMEP Section 1301.02(b). Thus, the question to be determined is whether the specimen of use shows use of ELLE SCHNEIDER to identify the services for which registration is sought.

We find Applicant's specimen, with the name ELLE SCHNEIDER, the internet address and wording "DIRECTOR/WRITER," similar to the specimen which was *not* accepted in *Ex parte TOAL*, 111 USPQ 450 (Comm'r Pat. 1956). There, the applicant sought to register "Marguerite Charlene" as a service mark for the writing of scripts and the composing of songs to be used by others in radio, television and other forms of entertainment. The applicant submitted, *inter alia*, a business card, which displayed "Marguerite Charlene," "Scripts and Songs for Radio and Television Performances" and the applicant's street address. *Id.* The Commissioner affirmed the refusal to register to accept the business card as a specimen, reasoning that the applicant had "adopted and was using the pseudonym or nom de plume of 'Marguerite Charlene' to identify herself in connection with song and script writing and possibly with the direction of musical numbers for recording," but that the record indicated that "Marguerite Charlene" "is a personal name identifying an individual who writes songs and scripts." *Id.* The Commissioner found that the "fact that it may be an assumed name used only in connection with her personal services does not alter the

fact that it identifies an individual and not a service” and concluded that the alleged mark was used to identify an individual rendering a personal service and not a name adopted and used by applicant to identify and distinguish her services from those of others. *Id.* The record in the present opposition reveals that Applicant has used “Elle Schneider” as an assumed name, and that she provides direction (of videos and film) and is a writer. The depiction of her assumed name, along with “DIRECTOR/WRITER” and her email address, on the business card also demonstrates the rendering of a personal service and not a name adopted and used by Applicant to identify and distinguish her services from those of others.

Our conclusion is supported by Applicant’s testimony:

Q. Is it correct to say that whenever you use the name “Elle Schneider” in connection with film or video services that you are referring to you as an individual?

A. Typically.

Q. When would that not be the case?

A. I would say it would not be the case if someone is hiring me say as a cinematographer and there is an assumption that I will be coming with some kind of crew, whether or not they are my employees directly, but it would denote the people that I am working with -- that work with me as opposed to the general group but typically, yes, it would refer to me as an individual.<sup>8</sup>

The exception noted by Applicant is not reflected in the business card. In view of the foregoing, we find that Applicant’s specimen does not function as a mark for the services identified in Applicant’s application.

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<sup>8</sup> Schneider Test. at 21, 21 TTABVUE 24.

*Priority and Likelihood of Confusion*

We now consider Opposer's claim pursuant to Section 2(d) of the Lanham Trademark Act, namely, priority of use and likelihood of confusion. We focus on the '315 registration for the mark ELLE in typed form because the mark and services identified in that registration are closest to the mark and services set forth in the subject application. If there is no likelihood of confusion with respect to the mark of this registration, there will be no likelihood of confusion with respect to the remaining registered marks asserted by Opposer.

Regarding priority, because Opposer's pleaded registrations are of record, including the '315 registration, and because Applicant has not filed a counterclaim to cancel Opposer's pleaded registrations, priority is not an issue with respect to the goods and services covered by Opposer's extant, pleaded registrations. *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

With respect to likelihood of confusion, our determination is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *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 considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

*Fame*

When an opposer's mark is famous, that fact "plays a 'dominant role in the process of balancing the *DuPont* factors,' ... and '[f]amous marks thus enjoy a wide latitude of legal protection.'" *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) (quoting *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)). It is settled that a strong mark "casts a long shadow which competitors must avoid." *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Opposer relies heavily on the Sultan declaration and the "media kit" to establish that the ELLE mark is famous. Because these materials were not properly submitted into evidence, we do not consider them.

Opposer also relies on Applicant's concession in her response to Interrogatory No. 18 where she stated, "Applicant contends that Opposer's Marks used in connection with Opposer's goods and services are famous generally within the fashion industry";<sup>9</sup> and repeated in her response to Interrogatory No. 19, where she stated, "Opposer's Mark is famous in relation to the fashion industry." In view of Applicant's concession, which she repeated, we consider Opposer's Elle Marks famous in the fashion industry.

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<sup>9</sup> 20 TTABVUE 28. Interrogatory No. 18 states, "To the extent that you contend that the Opposer's Marks are not famous within the fashion industry generally, set forth all facts and evidence to support that contention." Opposer's first notice of reliance, Exh. A, 20 TTABVUE 18.

*Similarity of Services, Channels of Trade and Classes of Consumers*

Turning next to the similarities or dissimilarities between Opposer's and Applicant's services, it is well established that the services of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the services, but rather whether there is a likelihood of confusion as to the source thereof. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

The '315 registration recites, *inter alia*, "entertainment services, namely, providing an on-line entertainment variety show, featuring fashion and beauty" in International Class 41, and "editing of written texts, book reviews, periodicals, magazines and publications of all types regardless of their form, including electronic and digitalized publications" in International Class 42. Applicant's identified services, repeated below for quick reference, are:

Film and video production; Film and video production consulting services; Film editing; Media production services, namely, video and film production; Multimedia entertainment services in the nature of development, production and post-production services in the fields of

video and films; Multimedia entertainment services in the nature of recording, production and post-production services in the fields of music, video, and films; Photography; Photography services; Post-production editing services in the field of music, videos and film; Production and distribution of videos in the field of fashion; Production of films; Script writing services; Writing of articles for periodicals other than for advertising or publicity; Writing of texts other than publicity texts.

We find as follows:

1. Opposer's "editing of written texts, book reviews, periodicals, magazines and publications of all types regardless of their form, including electronic and digitalized publications" is related to Applicant's "Writing of texts other than publicity texts." "Edit" is defined in *Merriam Webster Dictionary* (accessed at [www.merriam-webster.com](http://www.merriam-webster.com)) as "to prepare (something written) to be published or used : to make changes, correct mistakes, etc., in (something written)" and "write" is defined as a verb as "to produce (a written document, agreement, rule, etc.) by writing."<sup>10</sup> The editing and writing of texts are highly similar activities, and in fact, "editing" is an essential component of "writing."
2. Applicant's "Production and distribution of videos in the field of fashion" is related to Opposer's "entertainment services, namely, providing an on-line entertainment variety show, featuring fashion and beauty." Both the online entertainment variety show and the videos, which may entail a variety show for viewing on the Internet, are identified as being within the field of fashion.

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<sup>10</sup> The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

The content of the product produced by the services may be identical and viewed in the same venue.<sup>11</sup>

There are no recited restrictions as to the channels of trade or classes of purchasers with respect to either Opposer's or Applicant's services. Accordingly, the Board must assume that these services are available in all the normal channels of trade to all the usual purchasers for such services. *See Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Paula Payne Prods. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77-78 (CCPA 1973). Under this assumption, because of the close relationship between the writing and editing of texts (other than publicity texts), and because the writing of texts entails the editing of texts, the classes of consumers and trade channels are identical for the two services. In fact, a poorly written text may be passed to an editor for further editing. With regard to the services "production and distribution of videos in the field of fashion" and "entertainment services, namely, providing an on-line entertainment variety show, featuring fashion and beauty," Applicant stated in her response to Opposer's Interrogatory No. 19 that "[c]onsumers of both Applicant and Opposer's goods will be likely to encounter video content related to each Party's goods online, but not likely in any similar web space."<sup>12</sup> We agree that the product of both parties

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<sup>11</sup> Because we find that certain of Applicant's services are related to Opposer's services, we need not also determine the similarity or dissimilarity of Opposer's services to the other services identified in Applicant's application. Similarity as to any of the services identified in the application and pleaded registration will suffice as a basis for finding the respective services to be similar for purposes of the second *du Pont* factor. *See, Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

<sup>12</sup> 20 TTABVUE 29.

services, i.e., videos concerning fashion, will be available online, but see no reason why they may not be on the same or similar websites, in view of their fashion content.

*Similarity of the marks.*

We next consider the marks in their entirety as to appearance, sound, connotation and commercial impression, to determine the similarity or dissimilarity between them. *In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *du Pont*); *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In comparing the marks, we are mindful that where, as here, the goods are identical in part, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992); see also *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010). “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*, 101 USPQ2d at 1721 (citing *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007)).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, the analysis cannot be predicated on dissecting the marks into their various components. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). However, different features may be analyzed to determine

whether the marks are similar. *Id.* (nothing improper in giving more or less weight to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety). The average purchaser normally retains a general rather than a specific impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

Opposer’s mark in the ‘315 Registration is ELLE and Applicant’s mark is ELLE SCHNEIDER. The entirety of Opposer’s mark is encompassed within Applicant’s mark. Likelihood of confusion has been found where the entirety of one mark is incorporated within another. *See In re Mighty Leaf Tea*, 94 USPQ2d at 1260 (applicant’s mark ML is similar to registrant’s mark ML MARK LEES); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967) (THE LILLY as a mark for women’s dresses is likely to be confused with LILLI ANN for women’s apparel including dresses); *In re United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (CAREER IMAGE for women’s clothing stores and women’s clothing likely to cause confusion with CREST CAREER IMAGES for uniforms including items of women’s clothing).

ELLE is the dominant, or at the least, prominent, term in ELLE SCHNEIDER, and is easily recognizable as the first word in the mark. *See, e.g., Century 21 Real Estate Corp.*, 23 USPQ2d at 1700 (stating that consumers will first notice the identical lead word on encountering the marks); *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (stating that “it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and

remembered”). Opposer’s single-word mark is thus identical to the first, and dominant, term in Applicant’s two-term mark.

Because the marks share the term ELLE, which is the only term forming the registered mark and is a clearly recognizable and prominent element in Applicant’s mark, we find that there are strong similarities between the marks as a whole in terms of appearance, sound and commercial impression. Even if consumers would ordinarily regard “Elle Schneider” as a name, its registration as a mark, with the first term ELLE, which is famous in the fashion industry, would imply it is one of Opposer’s marks, suggesting another line emanating from the same relevant source. *See In re Collegian Sportswear, Inc.*, 224 USPQ 174, 176 (TTAB 1984). In a particular case, “two marks may be found to be confusingly similar if there are sufficient similarities in terms of sound *or* visual appearance *or* connotation.” *Kabushiki Kaisha Hattori Seiko v. Satellite Int’l, Ltd.*, 29 USPQ2d 1317, 1318 (TTAB 1991), *aff’d mem.*, 979 F.2d 216 (Fed. Cir. 1992); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016). Such similarities outweigh any potential difference in meaning of the marks.

*Balancing the Factors*

Applicant has conceded Opposer’s mark is famous in the fashion industry, and we have found that the marks are similar in appearance, sound and commercial impression, that certain services are similar, and that the trade channels and classes of consumers for such services are identical for certain services. In view thereof, we conclude that Applicant’s mark for the services identified in the subject application is likely to be confused with Opposer’s mark for the services set forth in the ‘315 registration.

*Dilution*

In addition to its Section 2(d) claim, Opposer has asserted a dilution claim.

Section 43(c)(1) of the Trademark Act, 15 U.S.C. § 1125(c)(1), provides:

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

Fame for dilution requires a stringent showing. *Palm Bay Imp.* 73 USPQ2d at 1694; *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001).

Applicant's concession of fame in the fashion industry, in and of itself, is not sufficient to establish that Applicant's mark is a famous mark for purposes of Section 43(c)(1). And since the remaining evidence in the record does not establish fame for dilution purposes, Opposer's dilution claim is dismissed.

**Decision:** Opposer's dilution claim is dismissed. Opposer's claims of failure to function as a mark and likelihood of confusion are sustained. Registration to Applicant is refused.