

This Opinion is Not a
Precedent of the TTAB

Hearing: September 6, 2018

Mailed: September 17, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Royal Chain, Inc.
v.
Mansur Gavriel LLC
—

Opposition No. 91214740
—

Robert Garson and Kevin Kehrli of Garson, Ségal, Steinmetz, Fladgate LLP,
for Royal Chain, Inc.

Jeffrey A. Wakolbinger, Jessica M. Garrett and Alexandra R. Caleca of Katten
Muchin Roseman LLP, for Mansur Gavriel LLC.

—
Before Bergsman, Shaw and Goodman,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Mansur Gavriel LLC (“Applicant”) filed an application to register the mark
MANSUR GAVRIEL (standard characters) for “handbags; tote bags; purses; wallets,”
in Class 18.¹

¹ Application Serial No. 85967953 filed June 24, 2013, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s first use of the mark anywhere as of March 22, 2013 and first use of the mark in commerce as of June 6, 2013.

Royal Chain, Inc. (“Opposer”) filed a Notice of Opposition against the 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 for the listed goods so resembled the registered mark PHILLIP GAVRIEL for the goods listed below as to be likely to cause confusion:

Diamonds; Jewelry; Precious and semi-precious stones;
Precious metals and their alloys; Precious metals, namely,
Gold, Silver, Platinum; Real and imitation jewellery;
Synthetic diamonds; Synthetic precious stones, in Class
14.²

Opposer also alleges common law use of the mark PHILLIP GAVRIEL in connection with a wide variety of products including jewelry.

Applicant, in its Answer, denied the salient allegations in the Notice of Opposition.

As discussed more fully below in the priority section of this decision, Opposer’s pleaded registration was cancelled for failure to file a Section 8 declaration of use during the prosecution of this proceeding. A cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). *See Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“a cancelled registration does not provide constructive notice of anything.”); *see also In Re Ginc UK Ltd.*, 90 USPQ2d 1472, 1480 (TTAB 2007); *In re Hunter Publ’g Co.*, 204 USPQ 957, 963 (TTAB 1979) (cancellation “destroys the Section [7(b)] presumptions and makes the question of registrability ‘a new ball game’

² Registration No. 3949235, issued April 19, 2011; cancelled. “The name ‘PHILLIP GAVRIEL’ identifies a living individual, Phillip Gabriel Maroof, whose consent is of record.”

which must be predicated on current thought.”). Accordingly, we give Opposer’s pleaded registration no consideration and we focus our likelihood of confusion analysis on Opposer’s common law use of its PHILLIP GAVRIEL mark.³

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant’s application file.⁴ The parties introduced the testimony and evidence listed below:

A. Opposer’s testimony and evidence.

1. Opposer’s first notice of reliance on the following items:

- a. A copy of the record of Applicant’s application Serial No. 86396504 for the mark MANSUR GAVRIEL for goods in Class 25 (clothing);⁵
- b. A copy of the record of Applicant’s application Serial No. 87009436 for the mark MANSUR GAVRIEL for goods in Class 3 (soaps, shampoos, cosmetics, etc.);⁶

³ Because Opposer’s pleaded registration was cancelled for failure to file a Section 8 declaration of use, Applicant asserts that its counterclaim to cancel Opposer’s pleaded registration is moot. Applicant’s Brief, p. 2 (68 TTABVUE 7). In view thereof, Applicant’s counterclaim to cancel Opposer’s pleaded registration is dismissed without prejudice.

⁴ Because Applicant’s application file is of record by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), it was unnecessary for Opposer to introduce a copy of it through a notice of reliance. 50 TTABVUE 8.

⁵ 50 TTABVUE 10.

⁶ 50 TTABVUE 18.

- c. A copy of Applicant's Registration No. 5149663 for the mark MANSUR GAVRIEL for services in Class 35 (retail store services);⁷
- d. A copy of Opposer's pleaded registration;⁸
- e. A copy of Opposer's Registration No. 4580170 for the mark PHILLIP GAVRIEL for goods in Class 3 (perfumes);⁹
- f. A copy of Opposer's Registration No. 5110450 for the mark PHILLIP GAVRIEL PRIVÉ for goods in Class 14 (jewelry);¹⁰
- g. A copy of the search results from the USPTO electronic database of marks with the name "Gavriel";¹¹
- h. A copy of the Notice of Opposition for Opposition No. 91226538;¹²
- i. A copy of a New York record identifying Mansur Gavriel Group Inc. as a New York business;¹³
- j. A copy of a New York record identifying Applicant as a New York business;¹⁴

⁷ 50 TTABVUE 24. Because Opposer introduced a copy of Applicant's registration, it was unnecessary for Applicant to introduce it. *See* Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a) ("When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.").

⁸ 50 TTABVUE 27.

⁹ 50 TTABVUE 30.

¹⁰ 50 TTABVUE 33.

¹¹ 50 TTABVUE 36.

¹² 50 TTABVUE 38.

¹³ 50 TTABVUE 51.

¹⁴ 50 TTABVUE 54.

- k. A copy of the complaint in *Mansur Gavriel LLC v. Pelleteria Pierre S.N.C. Di Scarselli Roberto & C. et. al.*, (S.D.N.Y. Civil Action No. 1:16-cv-01791);¹⁵ and
- l. A copy of Opposer's Registration No. 3991453 for the mark PG in Class 14 (jewelry).¹⁶
2. Opposer's second notice of reliance on advertisements for PHILLIP GAVRIEL PRIVÉ in publications in May, June, September, October, and April 2016 and for PHILLIP GAVRIEL in December 2015.¹⁷
3. Opposer's third notice of reliance on Internet news articles and other materials referring to PHILLIP GAVRIEL jewelry,¹⁸ Wikipedia entry for Mansur,¹⁹ and articles referring to Applicant.²⁰
4. Opposer's fourth notice of reliance on Applicant's responses to Opposer's first set of interrogatories,²¹ request for production of documents,²²

¹⁵ 50 TTABVUE 62.

¹⁶ 50 TTABVUE 127.

¹⁷ 50 TTABVUE 129-147.

¹⁸ 50 TTABVUE 154-194.

¹⁹ 50 TTABVUE 209-211.

²⁰ 50 TTABVUE 213-235.

²¹ 50 TTABVUE 239-254.

²² 50 TTABVUE 257-266. We consider Applicant's responses only to the extent that they state that there are no responsive documents. *See City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013) (responses to document production requests are admissible solely for purposes of showing that a party has stated that there are no responsive documents); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 n.7 (TTAB 2012) (written responses to document requests indicating that no documents exist may be submitted by notice of reliance).

declaration of Keith E. Sharkin, former counsel for Applicant,²³ and Applicant's privilege log.²⁴

5. Testimony declaration of Phillip Maroof, Opposer's Director and Creative Designer.²⁵
6. Testimony deposition of Rachel Mansur, one of Applicant's principals.²⁶
7. Testimony deposition of Floriana Gavriel, one of Applicant's principals.²⁷
8. Search results from the USPTO electronic database for registrations and applications including the names WANG, COLE, or GAVRIEL.²⁸

B. Applicant's testimony and evidence

1. Notice of reliance on the following items:²⁹
 - a. Opposer's responses to Applicant's interrogatories;³⁰

²³ 50 TTABVUE 268-270.

²⁴ 50 TTABVUE 272. Applicant's privilege log is not admissible through a notice of reliance and, therefore, it has been given no consideration. *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1806 n.21 (TTAB 2018) (Board did not consider privilege log submitted under notice of reliance).

²⁵ 53-54 TTABVUE. The portions of the Maroof testimony declaration designated confidential are posted on 51 and 52 TTABVUE.

²⁶ 57 TTABVUE. The portions of the Mansur testimony deposition designated confidential are posted at 56 TTABVUE.

²⁷ 59 TTABVUE. The portions of the Gavriel testimony deposition designated confidential are posted at 58 TTABVUE.

²⁸ 65 TTABVUE.

²⁹ Applicant's Exhibits 1-4 are superfluous inasmuch as they were introduced by Opposer. See footnote 7.

³⁰ 61 TTABVUE 23-34.

- b. Opposer's responses to Applicant's request for production of documents;³¹
- c. Opposer's responses to Applicant's requests for admission;³²
- d. Third-party registrations and Internet evidence purportedly "showing the coexistence of clothing and accessories offered in connection with marks that share a common name (e.g., CALVIN KLEIN and ANNE KLEIN)."³³

2. Testimony declaration of Rachel Mansur, one of Applicant's principals.³⁴

II. Standing

A threshold issue in every inter partes case is the plaintiff's standing to challenge registration. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94

³¹ 61 TTAVUE 36-46. We consider Applicant's responses only to the extent that they state that there are no responsive documents. *See City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d at 1674 n.10; *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d at 1036 n.7.

³² 61 TTABVUE 48-59. Only the admissions are admissible. Denials to admission requests cannot be submitted under a notice of reliance. Trademark Rule 2.120(k)(3)(i), 37 C.F.R. § 2.120(k)(3)(i); *see also Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1957 (TTAB 2008) ("[U]nlike an admission (or a failure to respond which constitutes an admission), the denial of a request for admission establishes neither the truth nor the falsity of the assertion, but rather leaves the matter for proof at trial. *Cf. Fed. R. Civ. P. 36(b).*").

³³ 61 TTABVUE 61-460. The list of registrations for trademarks with shared names (61 TTABVUE 462-469) is not sufficient to make the registrations of record. *See Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) (listing of third-party marks downloaded from Office database does not make registrations of record); *Calypso Tech. Inc. v. Calypso Capital Mgmt. LP*, 100 USPQ2d 1213, 1217 (TTAB 2011) (summaries of search results for third-party registrations are not official records and have not been considered).

³⁴ 62 TTABVUE. The portions of the Mansur declaration designated as confidential are posted at 63 TTABVUE.

USPQ2d 1942, 1945 (TTAB 2010). To establish its standing, Petitioner must prove that it has a “real interest,” i.e., a “reasonable” basis for its belief of damage. *See Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982). Opposer has established its standing through the testimony of Phillip Maroof, Opposer’s Creative Director and Designer, who testified about Opposer’s sales of goods under the PHILLIP GAVRIEL trademark.³⁵ Applicant does not contest Opposer’s standing.³⁶

III. Priority

Applicant’s constructive date of first use is the filing date of its application, June 24, 2013. Rachel Mansur, one of Applicant’s principals, testified that Applicant “started selling handbags in March 2013.”³⁷ We find that March 2013 is Applicant’s priority date.

As noted above, Opposer’s pleaded registration was cancelled for failure to file a Section 8 declaration of use during the prosecution of this proceeding. Opposer’s pleaded registration registered on April 19, 2011. Opposer had until October 19, 2017 (the end of the six-month grace period) to file a Section 8 declaration of use. Opposer’s

³⁵ Maroof Decl. (51-54 TTABVUE).

³⁶ Applicant’s Brief, p. 7 (68 TTABVUE 12).

³⁷ Mansur Decl. ¶3 (62 TTABVUE 2); *see also* Mansur Testimony Dep., p. 22 (57 TTABVUE 23) (Applicant first made its bucket bag, large tote and small tote available to consumers in 2013); Applicant’s response to Opposer’s Interrogatory No. 2 (50 TTABVUE 243 (“Applicant did not provide any products or services under its MANSUR GAVRIEL mark prior to March 22, 2013.”)).

pleaded registration was cancelled November 24, 2017. Based on the May 5, 2017 stipulation to extend trial dates, Opposer's testimony period closed July 24, 2017, Applicant's testimony period closed September 22, 2017, and Opposer's rebuttal testimony period closed November 22, 2017.³⁸ Accordingly, Opposer's pleaded registration was valid during Opposer's testimony period and Opposer apparently relied on the presumptions accorded a valid registration under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), to establish its priority.

However, because Opposer's pleaded registration was cancelled before the end of this proceeding, it is not entitled to rely on any of the statutory presumptions of Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). *See Action Temp. Servs. Inc. v. Labor Force Inc.*, 10 USPQ2d at 1309 ("constructive notice, pursuant to section 22 of the Lanham Act, exists, and lasts, only as long as the federal registration giving rise to that constructive notice remains in effect," and "use following the cancellation of Labor's federal registration was not subject to any former constructive notice effects of that registration."); *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1606 (TTAB 2018) (cancelled registrations reflect only that registrations issued and not that the registered marks were used); *Kellogg Co. v. Western Family Foods, Inc.*, 209 USPQ 440, 442 (TTAB 1980) (an expired or cancelled registration is not evidence of use of the registered mark at any time because it no longer benefits from the presumptions of Section 7(b) of the Trademark Act). This means that the Board must determine priority based on Opposer's common law use of its PHILLIP GAVRIEL

³⁸ 48 TTABVUE.

trademark even though Opposer intended to rely on the presumptions accorded its pleaded registration.

Phillip Maroof, Opposer's Creative Director and Designer, introduced a copy of Opposer's "sales records for goods sold in conjunction with the PHILLIP GAVRIEL mark,"³⁹ referring to Exhibit 1.⁴⁰

Attached hereto as Exhibit 1 is a true and accurate copy of [Opposer's] sales records for goods sold in conjunction with the PHILLIP GAVRIEL mark.⁴¹

The heading of Exhibit 1 is reproduced below:

Phillip Gavriel Sales by Style/Customer						
	From 5/1/10	Through 11/17/15	FROM:05/01/: HRU:11/17/15			
Style #	Page #	Customer	Invoice #	Type	Quantity	Sales

The Maroof declaration does not refer to a date that sales were made. The report indicates that the information covers a specific range of dates: May 1, 2010 through November 17, 2015. The report does not state the dates when any sales were made and, therefore, does not establish Opposer's date of first use. In other words, based on the sales report, it is possible that the earliest sale occurred after March 2013 or after the filing date of Applicant's application.

Mr. Maroof introduced two catalogs from 2013 and 2015.

³⁹ Maroof Decl. ¶2 (53 TTABVUE 2).

⁴⁰ Maroof Decl. Exhibit 1 (51 TTABVUE 4-1257) (confidential).

⁴¹ Maroof Decl. ¶2 (53 TTABVUE 2).

Attached hereto as Exhibit 2 are true and accurate copies of PHILLIP GAVRIEL catalogs from 2013 and 2015 given to [Opposer's] retailers and distributors.⁴²

Mr. Maroof does not testify as to when the 2013 catalog was distributed. The bottom of some of the catalog pages display a May 7, 2013,⁴³ date, which is after Applicant's March 2013 established priority date.⁴⁴ There are other dates subsequent to May 7, 2013 displayed on the bottom of other catalog pages.⁴⁵ Opposer's Exhibit 2 shows a priority date no earlier than May 7, 2013, subsequent to Applicant's March 2013 priority date.

Finally, Mr. Maroof introduced representative copies of PHILLIP GAVRIEL brochures from 2012 and 2016.

Attached hereto as Exhibit 3 are true and accurate copies representative [sic] PHILLIP GAVRIEL brochures and advertisements from 2012 and 2016 distributed in conjunction with various tradeshows and given to our retailers and distributors for in-store display.⁴⁶

As noted in footnote 42, we cannot discern where Exhibit 2 ends and where Exhibit 3 begins. Assuming arguendo that we could identify the 2012 brochures and advertisements, all this would prove is that Opposer advertised its goods in 2012 and not that the PHILIP GAVRIEL mark was placed on the goods or their containers or

⁴² Maroof Decl. ¶3 and Exhibit 2 (53 TTABVUE 2 and 5). It is not clear where the 2013 catalog ends and the 2015 catalog begins or ends.

⁴³ 53 TTABVUE 32 and 65.

⁴⁴ 53 TTABVUE 5.

⁴⁵ 53 TTABVUE 5-31, 33-64, and 66-86.

⁴⁶ Maroof Decl. ¶4 and Exhibit 3 (53 TTABVUE 3 and 54 TTABVUE 115-134).

that jewelry was sold or transported in commerce. Section 45 of the Trademark Act, 15 U.S.C. § 1127; *see also* the discussion regarding Opposer's sales *supra*.⁴⁷

In view of the foregoing, we find that Opposer failed to meet its burden of proving priority of use by a preponderance of the evidence and, therefore, the opposition is dismissed. *See Kemi Organics*, 126 USPQ2d at 1613 (petitioner proved, by a preponderance of the evidence, that it used the common law KEMI OYL mark prior to respondent's constructive use date); *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040 (TTAB 2018) ("To prevail on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, based on a previously used mark, it is the Opposer's burden to prove by a preponderance of the evidence both priority of use and likelihood of confusion."); *Moreno v. Pro Boxing Supplies, Inc.*, 124 USPQ2d 1028, 1034 (TTAB 2017) (quoting *Hydro-Dynamics Inc. v. George Putnam & Co. Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987)) ("the decision as to priority is made in accordance with the preponderance of the evidence.").

For purposes of completeness, we address the issue of likelihood of confusion.

⁴⁷ While a plaintiff may ground an opposition on the prior use of a term in a manner analogous to trademark use, such "analogous use" must be of such a nature and extent as to create public identification of plaintiff's mark with the plaintiff's goods. *See T.A.B. Sys. V. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996). Opposer's testimony and evidence falls short of establishing that the relevant public identified PHILLIP GAVRIEL with a single source prior to March 2013.

IV. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative 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, 567 (CCPA 1973) (“*Du Pont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *Du Pont* factor that is relevant or for which there is evidence of record. See *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.”). 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)).

A. Similarity or dissimilarity and nature of the goods.

Applicant is seeking to register its mark for “handbags; tote bags; purses; wallets” and Opposer uses its mark on jewelry.⁴⁸ Opposer introduced the evidence listed below to show that the goods are related:

1. *Vogue* magazine (December 2015) features a fashion article about handbags next to an advertisement for Opposer’s jewelry.⁴⁹
2. *Harper’s Bazaar* (harpersbazaar.com) pictorial entitled “9 Red-Hot Bags to Shop Now” (May 24, 2017) features the following:

- The statement that a handbag is an essential component to a fashion ensemble.

From a suede clutch to carryall tote, a handbag in a punchy red hue is the perfect pairing to any ensemble.⁵⁰

- A photograph of a model wearing a Dior jacket, skirt, bag and sneakers, Pandora earrings, and Opposer’s “jewelry bangle.”⁵¹

⁴⁸ Opposer’s reference to its Registration No. 4580170 for the mark PHILLIP GAVRIEL for “perfumes, aftershaves and colognes” (50 TTABVUE 30), in its brief (67 TTABVUE 27) does not give Opposer priority of use, nor does it establish actual use of the mark.

⁴⁹ 50 TTABVUE 143.

⁵⁰ 50 TTABVUE 165.

⁵¹ 50 TTABVUE 167-168; *see also* 50 TTABVUE 169-182 for different fashion ensembles, including clothing, handbags and jewelry.

3. *Harper's Bazaar* (harpersbazaar.com) article about Valentino designer Pierpaolo Piccioli (January 19, 2017) featuring Valentino ensembles with clothing, jewelry, and shoes (no handbags).⁵²
4. Amazon.com search for GAVRIEL retrieving advertisements for Opposer's jewelry and various brands of handbags.⁵³
5. *InStyle* magazine (instyle.com) (January 26, 2017) published an article "Bucket Bag Cult Fave Mansur Gavriel Is Expanding into Clothing."⁵⁴ The article reports that Applicant will debut its ready-to-wear clothing collection in September 2017. After the article, there are links to articles about jewelry: "You Need to See This New Curve-Friendly Collection" and "Amazon's Prime Day Sale Has the Prettiest Jewelry That Only Looks Expensive."⁵⁵

For reasons other than to show that the goods are related, Applicant introduced copies of third-party registrations for marks registered for both jewelry and "handbags; tote bags; purses; wallets."⁵⁶ Nevertheless, third-party registrations based on use in commerce that individually cover a number of different goods may have probative value to the extent that they serve to suggest that the listed goods are of a type that may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*,

⁵² 50 TTABVUE 183-188.

⁵³ 50 TTABVUE 190-194.

⁵⁴ 50 TTABVUE 213-216.

⁵⁵ 50 TTABVUE 219.

⁵⁶ 61 TTABVUE 61-460.

6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd mem.* 864 F.2d 149 (Fed. Cir. 1988). The registrations, with relevant portions of the identifications, are listed below.

MARK	REG. NO.	GOODS
CALVIN KLEIN	1993879	Watches and jewelry
CALVIN KLEIN	1604663	Women's handbags, wallets, French and change purses, tote bags
ANNE KLEIN	3304360	Jewelry
ANNE KLEIN	1052858	Purses, wallets
ANNE KLEIN	1016890	Pocketbooks
KENNETH COLE	2170135	Jewelry and watches
KENNETH COLE	1458352	Wallets
KENNETH COLE	1558017	Handbags
PAUL SMITH	1661631	Hand bags, tote bags, wallets, purses
PAUL SMITH	1703997	Brooches, cufflinks, tie pins, leather coin cases
JACLYN SMITH	1921873	Costume jewelry and watches and wallets
JACLYN SMITH	1532841	Handbags
ALEXANDER WANG	5329570	Jewelry and watches
ALEXANDER WANG	3801258	Handbags

The evidence shows that jewelry and handbags are accessories to a woman's fashion ensemble and, as such, they are complementary products. Applicant, in its brief, concedes "[i]n the sense that both may be considered fashion accessories, they are."⁵⁷ In this regard, a woman's ensemble may consist of a coordinated set of pants, a blouse, and a jacket along with matching jewelry and handbag. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (women's shoes and women's pants, blouses, shorts and jackets complementary because shoes must match or contrast with an ensemble). Accordingly, consumers encountering jewelry and handbags, tote bags, purses, and wallets all sold under similar marks are likely to believe that they emanate from a single source.

⁵⁷ Applicant's Brief, p. 17 (68 TTABVUE 22).

B. Established, likely-to-continue channels of trade and purchasers to whom sales are made.

Applicant’s “handbags; tote bags; purses; wallets” “are offered for sale in the United States at various retail stores and on various websites”⁵⁸ “to both retailers and consumers.”⁵⁹ Retailers that sell Applicant’s products include Barney’s New York, Neiman Marcus, and Bergdorf Goodman.⁶⁰ “Applicant has advertised and marketed its [handbags; tote bags; purses; wallets] on its website ... on Applicant’s social media sites, such as a Facebook and Instagram... through unsolicited third-party press and blog posts ... and through outdoor wild posting advertising in New York City.”⁶¹ With respect to the unsolicited third-party press, *InStyle* magazine published an article about Applicant launching its ready-to-wear clothing collection in September 2017.⁶² Also, *Harper’s Bazaar* (harpersbazaar.com) (January 26, 2017) posted an article about Applicant’s new product launch, “Mansur Gavriel To Expand Into ‘Ready-To-Wear.’”⁶³

Opposer’s “[PHILLIP GAVRIEL] jewelry is sold and marketed at tradeshow, then subsequently sold and marketed at various online and brick and mortar retailers, such as Walmart, Macy’s, Nordstrom, etc.”⁶⁴ In addition, Opposer’s jewelry may be

⁵⁸ Applicant’s response to Opposer’s interrogatory No. 11 (50 TTABVUE 247).

⁵⁹ Applicant’s response to Opposer’s interrogatory No. 12 (50 TTABVUE 247-248).

⁶⁰ Mansur Decl. ¶9 and Exhibits E and F (62 TTABVUE 3 and 49-54).

⁶¹ Applicant’s response to Opposer’s interrogatory No. 14 (50 TTABVUE 248-249).

⁶² 50 TTABVUE 213-216.

⁶³ 50 TTABVUE 228.

⁶⁴ Opposer’s response to Applicant’s interrogatory No. 3 (61 TTABVUE 25).

sold by “drop ship’ which involves a sale via a customer website and fulfillment directly from Opposer with the Customer [sic] packaging.”⁶⁵ Opposer’s jewelry is advertised, marketed and promoted online, in print and at tradeshow. ⁶⁶ “Customers of Opposer also promote via television, radio for which Opposer will arrange for creative input, such as photo shoots or video production, as required.”⁶⁷ Opposer has advertised its products in *Vogue*, *Harper’s Bazaar*, *Elle*, and *InStyle* magazines.⁶⁸

Applicant notes correctly that because Opposer does not own a registration for the mark PHILLIP GAVRIEL for jewelry, there are no presumptions on which it may rely in connection with channels of trade and classes of consumers.⁶⁹ However, when there are no limitations or restrictions in Applicant’s identification of goods, the Board must presume that Applicant’s goods move in all channels of trade that would be normal for such goods, and that they would be purchased by all potential customers. See *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Morton-Norwich Prods., Inc. v. N. Siperstein, Inc.*, 222 USPQ 735, 736 (TTAB 1984). As discussed above, those channels of trade include Opposer’s channels of trade such as brick and mortar retailers, online retailers, and similar fashion magazines (e.g., *InStyle* and *Harper’s Bazaar*).

⁶⁵ Opposer’s response to Applicant’s interrogatory No. 4 (61 TTABVUE 25-26).

⁶⁶ Opposer’s response to Applicant’s interrogatory No. 5 (61 TTABVUE 26).

⁶⁷ *Id.*

⁶⁸ Opposer’s response to Applicant’s interrogatory No. 8 (61 TTABVUE 27).

⁶⁹ Applicant’s Brief, p. 18 (68 TTABVUE 23).

We find that Applicant’s “handbags; tote bags; purses; wallets” and Opposer’s jewelry are offered in the same channels of trade to the same classes of consumers.

C. The conditions under which sales are made.

Opposer’s jewelry prices range from under \$100.00 to over \$10,000.00.⁷⁰ On the other hand, because Applicant’s “handbags; tote bags; purses; wallets” have no limitations or restrictions as to price, we must presume that the products fall in all price ranges. Opposer’s jewelry products and Applicant’s handbags, tote bags, purses and wallets may be purchased by brand-conscious consumers and ordinary consumers. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014) (recognizing Board precedent requiring consideration of the “least sophisticated consumer in the class”); *see also 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.”). Accordingly, we find that the conditions under which sales are made is a neutral factor.

D. The nature and extent of any instances of confusion.

Rachel Mansur testified that she is unaware of any reported instances of confusion between the marks MANSUR GAVRIEL and PHILLIP MANSUR.⁷¹ Likewise, Floriana Gavriel testified that she is unaware of any third-party inquiring whether

⁷⁰ Maroof Decl. Exhibit 1 (53 TTABVUE 11 and 15).

⁷¹ Mansur Decl. ¶18 (62 TTABVUE 5).

Applicant is related to PHILLIP GAVRIEL.⁷² On the other hand, Phillip Maroof testified that “[o]n many occasions, at trade shows and from our buyers both myself I [sic] have been asked of the connection between our brand and Mansur Gavriel.”⁷³

In essence, Opposer asserts that an unidentified number of trade show attendees and buyers have inquired as to whether there is an affiliation or other relationship between MANSUR GAVRIEL and PHILLIP GAVRIEL. This sort of ambiguous inquiry is not probative of actual confusion. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1475 (TTAB 2016) (disregarding inquiring evidence as hearsay and entitled to little weight because there is no way to ascertain what the consumers were thinking); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1334 (TTAB 1992) (inquiries as to corporate affiliations is not evidence of confusion because, without more, they “indicate that these persons were aware that [the companies at issue] were two different entities”); *Elec. Water Conditioners, Inc. v. Turbomag Corp.*, 223 USPQ 162, 164 (TTAB 1994) (“That questions have been raised as to the relationship between firms is not evidence of actual confusion of their trademarks.”).

As discussed in the priority analysis, Opposer has used its PHILLIP GAVRIEL and design mark since approximately May 2013 and Applicant’s MANSUR GAVRIEL mark has been used since March 2013.⁷⁴ Also, we have found that Opposer’s jewelry

⁷² Gavriel Testimony Dep., p. 126 (59 TTABVUE 127).

⁷³ Maroof Testimony Decl. ¶6 (53 TTABVUE 3).

⁷⁴ Mansur Decl. ¶3 (62 TTABVUE 2); *see also* Mansur Testimony Dep., p. 22 (57 TTABVUE 23) (Applicant first made its bucket bag, large tote and small tote available to consumers in 2013); Applicant’s response to Opposer’s Interrogatory No. 2 (50 TTABVUE 243 (“Applicant

and Applicant's "handbags; tote bags; purses; wallets" are related products, offered in the same channels of trade to the same classes of consumers. As discussed below, while we declined to find that Opposer's PHILLIP GAVRIEL mark is famous, we did find that it is a successful product line. *See* footnote 81. Likewise, Applicant has received significant unsolicited media attention including the Council of Fashion Designers of America ("CFDA") Swarovski Award for Accessory Design in 2015, the CFDA Accessory Designer of the Year Award in 2016 and a nomination in 2017.⁷⁵ Thus, there has been a reasonable opportunity for confusion to have occurred. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Central Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) ("the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring").

Accordingly, we find that the lack of actual confusion is a factor that weighs against finding that there is a likelihood of confusion.

did not provide any products or services under its MANSUR GAVRIEL mark prior to March 22, 2013.").

⁷⁵ Mansur Decl. ¶13 (62 TTABVUE 4); *see also* Mansur Decl. Exhibits A and G (62 TTABVUE 4-5, 8-10 and 56-115).

E. The number and nature of similar marks in use on similar goods.

Opposer introduced the results of a search for “Gavriel” in USPTO database.⁷⁶ The search results are set forth below:

1. MANSUR GAVRIEL

- Registration No. 5149663⁷⁷
- Serial No. 87009436 for goods in Class 3⁷⁸
- Serial No. 85967953 for the application at issue

2. PHILLIP GAVRIEL

- Registration No. 5110450 (PHILLIP GAVRIEL PRIVÉ)⁷⁹
- Registration No. 4580170 for goods in Class 3⁸⁰
- Registration No. 3949235 (Opposer’s canceled pleaded registration)

3. GAVRIEL RAFAEL (Serial No. 87204142).

There is no evidence of any third-party use of PHILLIP GAVRIEL or any other variation of GAVRIEL. Accordingly, PHILLIP GAVRIEL is an inherently distinctive mark and it is entitled to a broad scope of protection or exclusivity of use.⁸¹

⁷⁶ 50 TTABVUE 36.

⁷⁷ 50 TTABVUE 24.

⁷⁸ 50 TTABVUE 18.

⁷⁹ 50 TTABVUE 33.

⁸⁰ 50 TTABVUE 30.

⁸¹ We agree with Opposer’s assessment that PHILLIP GAVRIEL is not a household name. Opposer’s Brief, p. 26 (67 TTABVUE 33). Opposer’s evidence regarding its commercial strength is inconclusive. Opposer’s sales between May 1, 2010 and November 17, 2015 (designated confidential) show that Opposer’s PHILLIP GAVRIEL jewelry is successful, but it is not an extraordinary figure. Likewise, Opposer’s advertising figures (designated as confidential and not limited to its PHILLIP GAVRIEL mark) are not extraordinary. Also, Opposer did not testify as to the market share that PHILLIP GAVRIEL products have

F. The similarity or dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Du Pont*, 177 USPQ at 567. “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); *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). As indicated above, the average customer is an ordinary consumer seeking women’s jewelry and complementary accessories.

captured and Opposer failed to put its sales and advertising figures into context with comparative figures from competitors so that we could assess the market strength of the PHILLIP GAVRIEL trademark. *Cf. Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002).

Because Opposer is relying on its common law rights, we must look to how Opposer uses its mark. *Cf. RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1801 (TTAB 2018) (citing *Otto Roth & Co. v. Universal Foods Corp.* 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981)) (“Because Opposer filed its oppositions on the basis of its unregistered IPAD trademark, Opposer must establish proprietary rights in that pleaded common-law mark.”). Opposer uses its PHILLIP GAVRIEL mark as shown below:⁸²



The name PHILLIP GAVRIEL is the dominant element of Opposer’s mark inasmuch as it is that portion of the mark that first catches the eye. The fleur-de-lis is an insignificant design element and “New York” designates the geographic area where Opposer originates. In the case of marks consisting of words and a design, the words are normally accorded greater weight because the words are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the goods. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir 1983)). As noted above, we focus on the recollection of the average

⁸² Maroof Decl. Exhibit 2 (54 TTABVUE 17). Although Opposer only pleaded use of PHILLIP GAVRIEL as a standalone mark, Applicant, in its brief, argued that the similarity or dissimilarity of the marks has to be based on Opposer’s mark as actually used. Applicant’s Brief, p. 11 (68 TTABVUE 16). Applicant based its analysis of the marks using Opposer’s mark as displayed above. *Id* at p. 13 (68 TTABVUE 18). In view thereof, we find that the pleadings have been amended by implied consent to include the PHILLIP GAVRIEL and design mark as shown above. Fed. R. Civ. P. 15(b)(2).

purchaser, in this case, an ordinary consumer, who normally retains a general rather than a specific impression of trademarks. *See L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

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; that is, the decision must be based on the entire marks, not just part of the marks. *See Stone Lion Capital Partners*, 110 USPQ2d at 1161; *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Nevertheless, 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 ultimate conclusion rests on a consideration of the marks in their entirety. *In re Nat'l Data Corp.*, 224 USPQ at 751; *see also Viterro*, 101 USPQ2d at 1908.

Clearly MANSUR GAVRIEL is not identical to PHILLIP GAVRIEL. It is equally obvious that each of the marks consists, in part, of the surname GAVRIEL. Nothing in the record suggests that GAVRIEL has any inherent significance other than as a surname. Accordingly, to the extent that the two marks under consideration share the name GAVRIEL, they are at least in part identical in sound, appearance and commercial impression.

In comparing MANSUR GAVRIEL and PHILLIP GAVRIEL and design, it is clear that the dominant part of each mark is in the form of a given name and a surname; and it is obvious that MANSUR and PHILLIP are different in appearance and sound.

Under circumstances where the goods were identical, the Federal Circuit and the Board have found that marks sharing a common surname but different given names were similar. *See Nina Ricci S.A.R.L. v. E.T.F. Enter. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (NINA RICCI and VITTORIO RICCI);⁸³ *Jack Winter Inc. v. Lancer of California, Inc.*, 183 USPQ 445, 446-47 (TTAB 1974) (JACK WINTER and DAVID WINTER);⁸⁴ *Girard-Perregaux & Cie, S.A. v. Perregaux*, 122 USPQ 95, 96 (Comm’r. Pats. 1959) (PAUL PERREGAUX and GIRARD PERREGAUX).⁸⁵

As discussed previously, Applicant introduced copies of third-party registrations and Internet evidence to show the coexistence of companies using common surnames for clothing and accessories.⁸⁶ The following third-party evidence is illustrative of the goods at issue in this proceeding:

⁸³ In *Nina Ricci*, the Court compared the mark VITTORIO RICCI to an opposer’s marks NINA RICCI, MADEMOISELLE RICCI, SIGNOR RICCI and CAPRICCI. The Court pointed to several factors that “argue against according controlling weight to the differences in the marks based solely on the use by the parties of dissimilar first names.” These factors were the unifying and dominant term RICCI in the opposer’s marks; a practice in the fashion industry of referring to surnames alone; the fame of the opposer’s mark “inasmuch as less care may be taken in purchasing a product under a famous name”; and expanding sales in many lines of goods under opposer’s marks.

Likewise, in *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419 (TTAB 2014), the Board found that the marks HARRY WINSTON and BRUCE WINSTON were similar, in part, because the goods were in part identical (111 USPQ2d at 1436) and opposer’s mark HARRY WINSTON was famous (111 USPQ2d at 1440).

⁸⁴ In *Jack Winter*, the marks were used on identical products (i.e., shirts, pants, and jackets).

⁸⁵ In *Girard-Perregaux*, the marks were used on in part identical products (i.e., watches and watch movements).

⁸⁶ 61 TTABVUE 61-460.

- Registration No. 1993879 for the mark CALVIN KLEIN for “watches and jewelry”;⁸⁷
- Registration No. 1604663 for the mark CALVIN KLEIN for, inter alia, women’s handbags, wallets, tote bags, French purses, and change purses;⁸⁸
- Registration No. 3304360 for the mark ANNE KLEIN for jewelry;⁸⁹
- Registration No. 1046318 for the mark ANNE KLEIN for watches;⁹⁰
- Registration No. 1052858 for the mark ANNE KLEIN for, inter alia, purses, clutches, and wallets;⁹¹
- Registration No. 1016890 for the mark ANNE KLEIN for pocketbooks;⁹²
- Registration No. 1344683 for the mark ANNE COLE for clothing;⁹³
- Registration No. 2179237 for the mark KENNETH COLE for clothing;⁹⁴
- Registration No. 2170135 for the mark KENNETH COLE for watches and jewelry;⁹⁵
- Registration No. 1458352 for the mark KENNETH COLE for, inter alia, wallets and travelling bags;⁹⁶

⁸⁷ 61 TTABVUE 61.

⁸⁸ 61 TTABVUE 87; *see also* 61 TTABVUE 188.

⁸⁹ 61 TTABVUE 122; *see also* 61 TTABVUE 217.

⁹⁰ 61 TTABVUE 137; *see also* 61 TTABVUE 217.

⁹¹ 61 TTABVUE 147.

⁹² 61 TTABVUE 167.

⁹³ 61 TTABVUE 220.

⁹⁴ 61 TTABVUE 231.

⁹⁵ 61 TTABVUE 236; *see also* 61 TTABVUE 295 and 303.

⁹⁶ 61 TTABVUE 253.

- Registration No. 1558017 for the mark KENNETH COLE for handbags;⁹⁷
- Registration No. 1737633 for the mark COLE HAAN for, inter alia, handbags, purses, and wallets;⁹⁸
- Registration No. 1661631 for the mark PAUL SMITH for watches;⁹⁹
- Registration No. 1703997 for the mark PAUL SMITH for brooches, cufflinks and tie pins;¹⁰⁰
- Registration No. 1921873 for the mark JACLYN SMITH for costume jewelry and watches;¹⁰¹
- Registration No. 5239570 for the mark ALEXANDER WANG for jewelry and watches;¹⁰²
- Registration No. 3801258 for the mark ALEXANDER WANG for handbags;¹⁰³
- Registration No. 2504826 for the mark VERA WANG for jewelry;¹⁰⁴
- Registration No. 3362554 for the mark JOHN HARDY for jewelry;¹⁰⁵ and

⁹⁷ 61 TTABVUE 265.

⁹⁸ 61 TTABVUE 282.

⁹⁹ 61 TTABVUE 340.

¹⁰⁰ 61 TTABVUE 344.

¹⁰¹ 61 TTABVUE 361.

¹⁰² 61 TTABVUE 382.

¹⁰³ 61 TTABVUE 389; *see also* 61 TTABVUE 415.

¹⁰⁴ 61 TTABVUE 406.

¹⁰⁵ 61 TTABVUE 434; *see also* 61 TTABVUE 453.

- Registration No. 4159796 for the mark PIERRE HARDY for, inter alia, wallets, handbags, and purses.¹⁰⁶

Also, Applicant introduced third-party websites displaying advertising for the sale of products under marks sharing an identical surname and a different given name.

For example,

- Macy's (macys.com) advertises CALVIN KLEIN handbags, wallets, tote bags and shoes and clothing, as well as ANNE KLEIN clothing and shoes;¹⁰⁷
- Nordstrom (nordstrom.com) advertises CALVIN KLEIN clothing and shoes and ANNE KLEIN clothing and jewelry;¹⁰⁸
- Macy's (macys.com) advertises KENNETH COLE clothing, shoes and cufflinks, ANNE COLE clothing,¹⁰⁹ and COLE HAAN shoes and clothing;¹¹⁰
- KMART (kmart.com) advertises JACLYN SMITH cosmetics and fragrances and PAUL SMITH cosmetics fragrances;¹¹¹
- Nordstrom (nordstrom.com) advertises ALEXANDER WANG clothing, shoes and handbags¹¹² and VERA WANG clothing;¹¹³ and

¹⁰⁶ 61 TTABVUE 442.

¹⁰⁷ 61 TTABVUE 188-206.

¹⁰⁸ 61 TTABVUE 207-218.

¹⁰⁹ 61 TTABVUE 294-311.

¹¹⁰ 61 TTABVUE 314-326.

¹¹¹ 61 TTABVUE 378-380.

¹¹² 61 TTABVUE 416-425.

¹¹³ 61 TTABVUE 426-427.

- Saks Fifth Avenue (saksfifthavenue.com) advertises PIERRE HARDY shoes¹¹⁴ and JOHN HARDY jewelry.¹¹⁵

To rebut Applicant's evidence, Opposer introduced the results from searches in the USPTO database for the names Wang and Cole.¹¹⁶ However, Opposer's search results have little probative value because they are merely a list of marks without the goods or services. *See In re i.am.symbolic, LLC*, , 123 USPQ2d at 1751 (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration); *Key Chem., Inc. v. Kelite Chem. Corp.*, 464 F.2d 1040, 175 USPQ 99, 101 (CCPA 1972).

We draw the following inferences from the third-party registration and Internet evidence of designers with identical surnames and different given names:

- There is no per se rule that marks consisting of identical surnames and different given names are similar and likely to cause confusion;
- The USPTO has registered marks with identical surnames and different given names in the field of clothing and clothing accessories; and
- A number of different trademark owners have accepted, over a long period of time, that various marks with identical surnames and different common names can be used and registered side-by-side without causing confusion

¹¹⁴ 61 TTABVUE 449-452.

¹¹⁵ 61 TTABVUE 453-460.

¹¹⁶ 65 TTABVUE 4-16.

provided that there are differences between the marks and goods in the field of clothing and clothing accessories.

Cf. Plus Prods. v. Natural Organics, Inc., 204 USPQ 773, 779 (TTAB 1979) (third-party registration evidence shows that the USPTO has historically registered PLUS marks to different parties and that a number of owners believe that PLUS marks may coexist on the register so long as there is some difference between the marks); *Jerrold Elect. Corp. v. The Magnavox Co.*, 199 USPQ 751, 758 (TTAB 1978) (third-party registrations “reflect a belief, at least by the registrants, who would be most concerned about avoiding confusion and mistake, that various ‘STAR’ marks can coexist provided that there is a difference.”); *In re Sien Equip. Co.*, 189 USPQ 586, 588 (TTAB 1975) (the suggestive meaning of the word “Brute” explains the numerous third-party registrations incorporating that word with other wording or material no matter how little additional significance they may add to the word “Brute” *per se*).

We find that the marks are more dissimilar than similar in their entireties in terms of appearance, sound, connotation and commercial impression.

G. Analyzing the factors.

Despite the fact that the goods are related and complementary and are offered in the same channels of trade to the same classes of consumers, because of the differences in the marks, we find that Applicant’s mark MANSUR GAVRIEL for “handbags; tote bags; purses; wallets” is not likely to cause confusion with Opposer’s mark PHILLIP GAVRIEL and design for jewelry.

Decision: The counterclaim to cancel Opposer's pleaded registration is dismissed.

The opposition is dismissed.