

This Opinion is not a  
Precedent of the TTAB

Oral Hearing: May 7, 2019

Mailed: January 9, 2020

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

*Kate Spade LLC*

*v.*

*Thatch, LLC and The Spades Trademark Company, LLC*

Opposition No. 91216585

Opposition No. 91217168

G. Roxanne Elings and L. Danielle Toalton, Davis Wright Tremaine LLP,  
for Kate Spade LLC.

Deborah K. Squiers, Jonathan Z. King, and Joelle A. Milov of Cowan, Liebowitz &  
Latman, P.C. and Schwartz & Cera LLP,  
for Thatch, LLC and The Spades Trademark Company, LLC.

Before Ritchie, Wolfson, and Shaw,  
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

On May 14, 2013, Thatch, LLC applied to register PATIO BY THE SPADES, in standard characters, on the Principal Register, for “Handbags, all purpose carrying bags, tote bags, traveling bags, backpacks, wallets and cosmetic bags sold empty,” in International Class 18, and “Clothing, namely dresses, pants, tops, shirts, blouses, sweaters, sleepwear, pajamas, beach cover ups, scarves, gloves, jackets, hats and

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caps; footwear, namely shoes, sandals and boots,” in International Class 25.<sup>1</sup> On January 29, 2014, The Spades Trademark Company, LLC applied to register THE SPADES, in standard characters, on the Principal Register, for “fragrance,” in International Class 3.<sup>2</sup>

Kate Spade LLC (“Opposer”) filed a notice of opposition to both of the applications filed by Thatch, LLC and The Spades Trademark Company, LLC (collectively, “Applicants”). At the request of all of the parties, the opposition proceedings were consolidated by a Board order dated July 14, 2015, which noted that “apparently the two defendants are related and represented by the same attorney,” and which designated Opposition No. 91216585 as the parent case.<sup>3</sup> In the notices of opposition, Opposer alleges priority and likelihood of confusion with Opposer’s previously registered marks, including, *inter alia*, the following three (collectively, “Opposer’s KATE SPADE marks”):

1. Registration No. 2064708 for KATE SPADE, in typed drawing form,<sup>4</sup> for  
“Handbags, all-purpose carrying bags, tote bags, traveling bags, shoulder bags,

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<sup>1</sup> Application Serial No. 85932097, filed May 14, 2013 under Section 1(b) of the Trademark Act; 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce.

<sup>2</sup> Application Serial No. 86179137, filed July 29, 2014 under Section 1(b) of the Trademark Act; 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce.

<sup>3</sup> 17 TTABVUE 1-2. Unless otherwise noted, all references in this decision will be to docket entries in Opposition No. 91216585. Pursuant to the Board’s order, Applicants confirmed that “they are affiliated companies with common controlling ownership and management.” 19 TTABVUE 2. A third case, Cancellation No. 92059594, was initially included in the consolidation order, but was separately resolved, and the subject Registration No. 3647470 was cancelled. 37 TTABVUE.

<sup>4</sup> “Prior to November 2, 2003, ‘standard character’ drawings were known as ‘typed’ drawings. The mark on a typed drawing was required to be typed entirely in capital letters. A typed mark is the legal equivalent of a standard character mark.” TMEP § 807.03(i) (Oct. 2018).

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clutch purses, all purpose athletic bags, backpacks, wallets, coin purses and cosmetic bags sold empty,” in International Class 18;<sup>5</sup>

2. Registration No. 2578942 for KATE SPADE, in typed drawing form, for “Clothing, namely, dresses, skirts, pants, tops, shirts, T-shirts, blouses, sweaters, suits, sport coats, blazers, vests, sleepwear, pajamas, bathrobes, beach coverups, footwear, shoes, socks, caps, hats, bandannas, scarves, coats, jackets, rainwear and gloves,” in International Class 25;<sup>6</sup>
3. Registration No. 2724972 for KATE SPADE, in typed drawing form, for “Cologne, cologne spray, perfumes, body lotions, body creams,” in International Class 3.<sup>7</sup>

In addition to alleging a likelihood of confusion, Opposer alleges, in each notice of opposition, that “[d]ue to the fame of Opposer’s KATE SPADE Marks in the United States, registration of Applicant’s mark will dilute the distinctiveness of Opposer’s KATE SPADE Marks . . . .”<sup>8</sup>

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<sup>5</sup> Registered May 27, 1997. Section 8 and 15 affidavits accepted and acknowledged. Renewed twice. The registration contains the following statement: “KATE SPADE’ identifies a living individual whose consent is of record.”

<sup>6</sup> Registered June 11, 2002. Section 8 and 15 affidavits accepted and acknowledged. Renewed. The registration contains the following statement: “The mark identifies a particular living individual whose consent is of record.”

<sup>7</sup> Registered June 10, 2003. Section 8 and 15 affidavits accepted and acknowledged. Renewed. The registration contains the following statement: “The mark identifies a particular living individual whose written consent authorizing this application is of record.”

<sup>8</sup> 1 TTABVUE 26 (paragraph 9). As further indicated herein, based on our finding of likelihood of confusion, we do not consider the claim of dilution.

In its answers, Applicants deny the salient allegations of the notices, except to make the following admissions regarding Opposer's ownership and use of its marks:<sup>9</sup>

Paragraph 2: Since at least as early as 1993, and long prior to May 14, 2013, the filing date of Applicant's intent-to-use application, Opposer has used its KATE SPADE and other related trademarks to identify its products in the United States.

Paragraph 5: By virtue of the extensive distribution and success of Opposer's bags, clothing, accessories, and related services, Opposer's KATE SPADE Marks are recognized and relied upon by the public and trade as identifying Opposer's goods and related services and distinguishing them for [sic] the goods and services of others and have come to represent and symbolize extremely valuable goodwill and a widespread reputation belonging exclusively to Opposer.

Both parties filed briefs, and Opposer filed a reply brief.<sup>10</sup> An oral hearing was requested by Applicant, and was presided over by this panel.

## **I. The Record and Evidentiary Issues**

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of both subject applications, as well as the following submitted evidence:

### **A. Evidence Submitted by Opposer**

- Trial testimony of Mary Beech, Opposer's Executive Vice President and Chief Marketing Officer, with exhibits thereto, dated January 27, 2017.

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<sup>9</sup> 1 TTABVUE 20, 25, with admissions at 9 TTABVUE 2, 3. The same allegations were made and admitted in 91217168 at 1 TTABVUE 19, 24 and 7 TTABVUE 2, 3.

<sup>10</sup> Opposer filed an amended trial brief the same day as its initial brief filing. 144 TTABVUE. Both parties filed briefs on the public record, along with redacted information submitted only in the confidential record.

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- Trial testimony of Geri L. Mankoff-Elias, consultant and former Vice President and Intellectual Property Counsel for Opposer, with exhibits thereto, dated January 26, 2017.
- Opposer's first notice of reliance on Opposer's trademark registrations, including Opposer's KATE SPADE Marks.
- Opposer's second notice of reliance on Opposer's policing activities.
- Opposer's third notice of reliance on unsolicited media regarding Opposer's KATE SPADE Marks.
- Opposer's fourth notice of reliance on advertising and solicited media regarding Opposer's KATE SPADE Marks.
- Opposer's fifth notice of reliance on certain of Applicants' responses to Opposer's interrogatories.
- Opposer's sixth notice of reliance on excerpts of a book by Opposer, and unsolicited media regarding Opposer and Opposer's KATE SPADE Marks.
- Opposer's seventh notice of reliance on Internet materials regarding Opposer's KATE SPADE Marks.
- Opposer's eighth notice of reliance on unsolicited media regarding Opposer's KATE SPADE Marks.
- Opposer's ninth notice of reliance on excerpts from the discovery deposition of Andy Spade, November 12, 2015.
- The oral cross-examination of Applicants' witness Gabriel Mann, dated April 17, 2018.

- The oral cross-examination of Applicants' witness Mehdi Neyestanki, dated April 24, 2018.
- On rebuttal, the declaration of Orrin Falby, paralegal for Opposer's counsel, Davis Wright Tremaine LLP, dated July 10, 2018, and exhibits thereto.
- On rebuttal, Opposer's tenth, eleventh, and twelfth notices of reliance on third-party use or non-use of the term "spade."

**B. Evidence Submitted by Applicants**

- Trial testimony of Elyce Arons, Managing Partner of Thatch LLC, with exhibits thereto, dated March 8, 2017.
- Trial declaration of Nart-Anong Chinda, paralegal at Cowan, Liebowitz & Latman, co-counsel for Applicants, with exhibits thereto, dated April 10, 2017.
- Trial declaration of Gabriel Mann, Principal of Mannco Apparel LLC, with exhibits thereto, dated March 20, 2017.
- Trial declaration of Mehdi Neyestanki, Chair and CEO of Spade Skin Care & More, with exhibits thereto, dated March 15, 2017.
- The oral cross-examination of Opposer's rebuttal witness Orrin A. Falby, dated August 8, 2018.
- Applicants' first notice of reliance on third-party applications and registrations, as well as on print publications and Internet materials regarding use of the terms SPADE or SPADES, or of a spade design.
- Applicants' second notice of reliance on definitions of the term "spade."

- Applicants' third notice of reliance on a third-party answer to a petition to cancel its trademark registration for BLACKSPADE FITS PERFECT (and design).
- Applicants' fourth notice of reliance on excerpts from the discovery deposition of Andy Spade, dated November 12, 2015.
- Applicants' fifth notice of reliance on excerpts from the discovery depositions of Mary Beech and Geri Lynn Elias, dated February 11, 2016.

Opposer objected to exhibits Applicants introduced during Applicants' cross examination of Opposer's rebuttal witness Orrin Falby. Applicants responded that they had not moved to enter the exhibits into the record.<sup>11</sup> Therefore the objection is moot, and we will not consider the exhibits. To the extent Applicants urge us to consider all of the testimony by Mr. Falby without regard to the objected-to exhibits, we consider the testimony for such probative value as it may have.

Applicants objected to Opposer's first and ninth notices of reliance on the grounds that Opposer did not adequately indicate the relevance, and that Opposer submitted into evidence registrations not pleaded by Opposer. With regard to the relevance, we find that Opposer has sufficiently indicated the purpose of its evidence. With regard to the submitted registrations, we base our analysis and conclusion herein only on the three most relevant registrations that were pleaded by Opposer, referenced above as Opposer's KATE SPADE Marks. Thus, Applicants' objection to purportedly unpleaded registrations is moot.

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<sup>11</sup> Specifically, Applicants state that the motion is "not justiciable for the simple reason that Applicants never moved such exhibits into evidence." 148 TTABVUE 64.

Applicants also objected to evidence submitted by Opposer regarding the fame of its marks. In particular, Applicants objected that while Opposer, Kate Spade, LLC, is the record owner of its trademark registrations, the marks are instead used by “Opposer’s parent corporation, Kate Spade & Co. and/or Tapestry, Inc. and/or purported licensees, not Opposer.”<sup>12</sup> *See generally Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1421, (TTAB 2016).

We note that Applicant did not put Opposer on notice of this claim during a time when Opposer could respond. We further note that Opposer included in the confidential record testimony from Ms. Elias, indicating the relationship between Opposer and its parent corporation as related companies. Finally, as noted above, Applicants, in their respective answers, admitted Opposer’s assertions regarding the use, ownership and renown of Opposer’s KATE SPADE Marks, as follows:<sup>13</sup>

Paragraph 2: Since at least as early as 1993, and long prior to May 14, 2013, the filing date of Applicant’s intent-to-use application, Opposer has used its KATE SPADE and other related trademarks to identify its products in the United States.

Paragraph 5: By virtue of the extensive distribution and success of Opposer’s bags, clothing, accessories, and related services, Opposer’s KATE SPADE Marks are recognized and relied upon by the public and trade as identifying Opposer’s goods and related services and distinguishing them for the goods and services of others and have come to represent and symbolize extremely valuable goodwill and a widespread reputation belonging exclusively to Opposer.

We thus consider the evidence of use and fame properly submitted by Opposer for such probative value as it may have, as further discussed herein. To the extent

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<sup>12</sup> 148 TTABVUE 60.

<sup>13</sup> 1 TTABVUE 20, 25, with admissions at 9 TTABVUE 2, 3. The same allegations were made and admitted in 91217168.

Applicants object to other evidence and argument from Opposer, such objections are noted. As they are not outcome determinative, nevertheless we need not discuss the objections in a detailed fashion.

## **II. Standing and Priority**

To have standing, a plaintiff must have a real interest, i.e., a personal stake in the outcome of the proceeding and a reasonable basis for its belief that it will be damaged. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-28 (Fed. Cir. 1999).

As a result of Opposer's submission of status and title copies of Opposer's KATE SPADE Marks, among others, Opposer has established its standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Likewise, because Applicants have not counterclaimed to cancel Opposer's registrations, priority is not at issue with respect to the marks and goods set out in the registrations. *King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

## **III. Background Findings**

In or around 1993, Kate Brosnahan, along with some partners including her husband, David Spade, and friend Elyce Arons, began designing and selling handbags under the mark KATE SPADE.<sup>14</sup> In accordance with legal documents signed by her,

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<sup>14</sup> 85 TTABVUE 10.

Ms. Brosnahan, as an individual, is “also known as Kate Spade.”<sup>15</sup> Mr. Arons stated in his testimony that Kate Brosnahan “is my best friend since college.”<sup>16</sup> The business was successful, and in December of 1999, a controlling share was purchased by the Neiman Marcus Group,<sup>17</sup> which later purchased the remainder for resale to Opposer and its affiliated companies.<sup>18</sup>

After the sale of their business and the KATE SPADE marks, the three friends went on to pursue other ventures. Among these, Andy Spade began what Mr. Arons referred to as “an advertising agency called Partners & Spade.”<sup>19</sup> In his trial testimony, Mr. Arons testified that the three together were owners of Applicant Thatch LLC, while Applicant The Spades Trademark Company was owned by spouses Kate Brosnahan and Andy Spade.<sup>20</sup> Ms. Brosnahan passed away during the course of these proceedings, after the completion of Applicants’ trial period.<sup>21</sup>

#### **IV. Likelihood of Confusion**

Our determination under Section 2(d) is based on an analysis of all of the relevant, probative evidence in the record related to a likelihood of confusion. *See In re E. I. du*

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<sup>15</sup> See 99 TTABVUE. Since this document is marked “Confidential,” we refer to it only in general terms.

<sup>16</sup> 85 TTABVUE 17.

<sup>17</sup> 85 TTABVUE 12. Supporting documentation was submitted in 99 TTABVUE (confidential).

<sup>18</sup> 85 TTABVUE 13-14; 18. Supporting documentation and testimony was submitted in 94 TTABVUE 23 and 95 TTABVUE (confidential).

<sup>19</sup> 85 TTABVUE 16. The parties dispute the exact nature of the business conducted by Partners & Spades, and the role of Ms. Brosnahan in the various ventures.

<sup>20</sup> 85 TTABVUE 8.

<sup>21</sup> 148 TTABVUE 14.

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*Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See 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.”). We discuss the *du Pont* factors for which there is relevant argument and evidence.

For purposes of our likelihood of confusion analysis, we focus on the most relevant pleaded registrations, referred to above as Opposer’s KATE SPADE Marks, as further discussed herein. If we find a likelihood of confusion as to these pleaded registrations, we need not find it as to the other pleaded registrations. On the other hand, if we do not find likelihood of confusion with the mark in these registrations for the goods identified, then we would not find it as to the other pleaded registrations. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Goods, Channels of Trade, and Classes of Consumers

We first consider the similarities or dissimilarities of the goods at issue in this proceeding. The goods identified in the subject applications overlap with those in Opposer’s KATE SPADE Marks. In particular, regarding the goods in International Class 18, both Application No. 85932097 (PATIO BY THE SPADES) and Registration

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No. 2064708 (KATE SPADE) identify “Handbags, all purpose carrying bags, tote bags, traveling bags, backpacks, wallets and cosmetic bags sold empty.” Regarding the goods in International Class 25, both Application No. 85932097 (PATIO BY THE SPADES) and Registration No. 2578942 (KATE SPADE) identify “Clothing, namely dresses, pants, tops, shirts, blouses, sweaters, sleepwear, pajamas, beach cover ups, scarves, gloves, jackets, hats and caps; footwear, namely shoes.” Regarding the goods in International Class 3, Application No. 86179137 (THE SPADES) identifies “Fragrance” and Registration No. 2724972 (KATE SPADE) identifies, “Cologne, cologne spray, perfumes, body lotions, body creams,” all of which we must presume may also contain fragrance.<sup>22</sup> See *Octocom Sys., Inc. v. Houston Comput. Servs. 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)). Thus the parties’ identified goods in these three classes are overlapping and identical in part.

As for the channels of trade, where the goods are identical in part, it is presumed that the channels of trade are the same as well. *In re Viterra Inc.*, 671 F.3d 1358, 101

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<sup>22</sup> In particular, we note that Opposer’s identified “cologne,” “cologne spray,” and “perfumes” may be characterized as “fragrance,” and are thus legally identical to Applicant’s identified “fragrance,” while Opposer’s “body lotions” and “body creams” may also be presumed to include those items that contain fragrance, and thus those goods are also closely related to Applicant’s “fragrance.”

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USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (“Even assuming there is no overlap between Stone Lion’s and Lion’s current customers, the Board correctly declined to look beyond the application and registered marks at issue. An application with ‘no restriction on trade channels’ cannot be ‘narrowed by testimony that the applicant’s use is, in fact, restricted to a particular class of purchasers.’”). Accordingly, despite Applicants’ arguments to the contrary, we must presume that Opposer’s handbags, clothing, and perfumes/fragrances may be sold through the same retail outlets as those of Applicants, and to the same general consumers.

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

#### B. Strength of Opposer’s Mark

We next consider the commercial and conceptual strength of Opposer’s KATE SPADE mark. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1735 (Fed. Cir. 2017) (per curiam) (fame in the 2(d) context is not an all-or-nothing measure and a showing of some fame “warrants reasonable weight, among the totality of the circumstances”). Fame, where it exists, plays a dominant role in assessing a likelihood of confusion. *Kenner Parker Toys Inc. v. Rose Arts Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293

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F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc*, 22 USPQ2d at 1456.

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods identified by the marks at issue, “by the length of time those indicia of commercial awareness have been evident,” by widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as by the general reputation of the products or services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-06 and 1309.

With regard to sales and advertising, Ms. Beech explained that Opposer advertises in digital and social media channels as well as in print.<sup>23</sup> This includes, she noted, various product categories.<sup>24</sup> Ms. Beech also noted that Opposer conducts regular billboard advertising in major cities around the country.<sup>25</sup> She also indicated that twice a year, Opposer provides fashion shows, which are in turn covered by major media such as Vogue.com, Elle, InStyle, and Marie Claire, among others.<sup>26</sup>

Ms. Beech mentioned a significant amount of unsolicited press as well for its KATE SPADE merchandise over the years.<sup>27</sup> The record includes examples of media references to KATE SPADE handbags, clothing, and perfume ranging from 2012 to

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<sup>23</sup> 94 TTABVUE 50-51.

<sup>24</sup> 94 TTABVUE 59; and 95 TTABVUE (confidential).

<sup>25</sup> 94 TTABVUE 56; and 95 TTABVUE (confidential).

<sup>26</sup> 94 TTABVUE 87-89.

<sup>27</sup> 94 TTABVUE 51; and 95 TTABVUE (confidential).

2017 from media outlets such as Essence, InStyle, Harper's Bazaar, Glamour, Bride, Self, New York Post, Cosmopolitan, Elle, People, and Teen Vogue, among others.<sup>28</sup> Many celebrities have been featured in KATE SPADE attire over the years, including Sasha Obama, Pippa and Kate Middleton, Millie Bobby Brown, and Taylor Swift, with ensuing press coverage.<sup>29</sup>

Since Opposer's specific sales and advertising information are in the confidential record, we note only generally that they are substantial. As noted by Ms. Beech, the company has had success across categories, with regard to sales, marketing, and awards.<sup>30</sup> We further note, again, the admissions in Applicants' answers of Opposer's "long prior" use of its marks, as well as that the KATE SPADE marks "have come to represent and symbolize extremely valuable goodwill and a widespread reputation belonging exclusively to Opposer."<sup>31</sup> Overall, Opposer has demonstrated significant exposure of its KATE SPADE mark for the goods at issue in this proceeding.

In response to Opposer's allegations and evidence of fame, Applicant points out that the term "SPADES" is a known word in English, which may be understood from its dictionary meaning. Applicants submitted excerpts of dictionary definitions, including the following from Merriam Webster:<sup>32</sup>

Spade: 1. A digging implement adapted for being pushed into the ground with the foot; 2. A spade-shaped instrument.

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<sup>28</sup> 48 TTABVUE.

<sup>29</sup> 94 TTABVUE 82; and 95 TTABVUE (confidential); *see also* 55 TTABVUE 355.

<sup>30</sup> 94 TTABVUE 35, *et. seq.*

<sup>31</sup> 9 TTABVUE 2 and 3, admitting to Paragraphs 2 and 5 of the Notice, at 1 TTABVUE 20, 25. As noted above, the same allegations were made and admitted in 91217168.

<sup>32</sup> 77 TTABVUE 8, 9.

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Spades: 1.a. the suit comprising cards marked with spades; a black figure that resembles a stylized spearhead on each playing card of one of the four suits; also: a card marked with this figure.

In spades – to an unusually great degree: in the extreme.

Applicants included similar definitions from Oxford, Cambridge, American Heritage, and Collins dictionaries.

Applicants also submitted third-party registrations and Internet evidence indicating third-party use of the term “SPADES.” See *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). While Applicants’ evidence pointed to as many as thirty third-party uses and registrations, most are not very probative as to the strength of Opposer’s KATE SPADE mark. First, Opposer’s mark is clearly understood as a reference to an individual with the first name KATE and the last name SPADE.<sup>33</sup> While Opposer does own registrations that contain the shape of a spade, we need not consider any design or composite marks in our analysis. Thus, the most probative third-party uses and registrations are for marks that contain the literal term “SPADE” and which may be construed as referring to an individual or individuals. These include PARTNERS & SPADE, for marketing services, including

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<sup>33</sup> As noted above, each of Opposer’s KATE SPADE Marks is registered with a statement that the consent of the individual named therein is “of record.”

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for fashion;<sup>34</sup> STARSPADE, for online retail of clothing;<sup>35</sup> SPADELIFE, for clothing;<sup>36</sup> SPADES BEAUTY BAR, for salon services;<sup>37</sup> SPADES NAIL PARLOUR, for beauty services;<sup>38</sup> and SPADES BOUTIQUE, for retail clothing store services.<sup>39</sup>

By contrast, most of the third-party uses and registrations submitted by Applicant either contain a reference to the term “SPADES” in the context of the mark as referring to a card suit (i.e., JACK OF SPADES),<sup>40</sup> or contain a design thereof, without any apparent reference to “SPADE” or “SPADES” as one or more individuals.<sup>41</sup> As Applicants ultimately submitted evidence of only a half-dozen marks that might even arguably be understood as referring to an individual or individuals by the name of SPADE, for similar goods or services, we find that this does not detract substantially from the strength Opposer has demonstrated of the KATE SPADE mark.

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<sup>34</sup> See 74 TTABVUE 250, et. seq. and 436. As noted above, this mark is owned at least in part by Andy Spade, who is also an owner of both Applicants. The parties argue as to whether the mark has been used for clothing. Since we consider the mark in our analysis, we need not decide whether it is specifically used on clothing or only on marketing services, since the latter use pertains to the fashion and apparel industry as well, and thus is relevant to the strength of Opposer’s KATE SPADE Marks.

<sup>35</sup> 74 TTABVUE 554, et. seq.

<sup>36</sup> 75 TTABVUE 199, et. seq.

<sup>37</sup> 75 TTABVUE 239, et. seq.

<sup>38</sup> 75 TTABVUE 303, et. seq.

<sup>39</sup> 75 TTABVUE 324, et. seq.

<sup>40</sup> 74 TTABVUE 471, et. seq.

<sup>41</sup> In this regard, we do not consider very probative Applicants’ references to other marks including SPADE SKIN CARE & MORE, which includes a design of a spade, and does not appear to refer to an individual or individuals, to BLACK SPADE, to THE SPADES (and design) or to the other marks referenced by Applicants, for the same reason.

Overall, we find the KATE SPADE mark to be conceptually strong and commercially very strong, including specifically for the goods at issue in this proceeding, and the fifth and six *du Pont* factors weigh strongly in favor of finding a likelihood of confusion.

### C. Comparison of the Marks

We next consider the similarity or dissimilarity of the parties' marks in their entireties as to appearance, sound, connotation and commercial impression. *Stone Lion Capital Partners*, 110 USPQ2d at 1160; *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567; *Palm Bay Imps.*, 73 USPQ2d at 1692. In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Elecs. 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 unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average consumer, who retains a general rather than specific impression of the marks. *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). Moreover, and of particular relevance here, when the goods are identical, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. *See Bridgestone Ams. Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012).

Opposer's mark is KATE SPADE, in typed drawing form. Applicants' mark are THE SPADES and PATIO BY THE SPADES, both in standard characters. While the marks have some obvious differences in sight and sound, they all end with the term SPADE/S. We note that differences between singular and plural "is almost totally insignificant in terms of the likelihood of confusion of purchasers." *In re Pix of Am., Inc.*, 225 USPQ 691, 692 (TTAB 1985); *see also Wilson v. Delaunay*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) (finding no material difference between the singular and plural forms of ZOMBIE such that the marks were considered the same mark); *Weidner Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) (SHAPES is similar to SHAPE).

The parties dispute the connotation and commercial impression of the marks. As discussed above, Opposer's KATE SPADE mark is clearly understood as a reference to an individual with the first name KATE and the last name SPADE. This is further noted in the registrations themselves.

We next consider the connotation and commercial impression of Applicants' marks. Regarding THE SPADES, Applicants argue that "the common English meaning of THE SPADES standing alone eclipses its obscure status as a surname."<sup>42</sup> With regard to PATIO BY THE SPADES, Applicants argue similarly that this would be seen as referring to the dictionary meaning of "patio" and "spades."<sup>43</sup>

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<sup>42</sup> 148 TTABVUE 37.

<sup>43</sup> 148 TTABVUE 33-36.

Opposer, by contrast, argues that Kate Brosnahan, who has also been publicly known as Kate Spade, and her husband Andy Spade, “are often referred to as ‘the Spades.’”<sup>44</sup> Indeed, the record contains several indications of this characterization. In an article cited by Opposer, WWD Milestones referred to “Kate and Andy Spade” repeatedly as “the Spades.”<sup>45</sup> Other submissions by Applicants further support this public perception of “THE SPADES” as referring to the couple who are credited as the original creators of the KATE SPADE mark.

In particular, in his trial testimony, Mr. Arons conceded that while “THE SPADES” could refer to “anything,” it could very well be perceived as referring to people, including Andy Spade and his brother David Spade.<sup>46</sup> He further indicated that Andy Spade had liked the idea of a company that reflected his relationship with wife Kate:

Andy has loved the idea of using The Spades for a long time. He really liked a company that we used to know called The Smith’s, and so I can’t tell you how many years it has been, but he has been very interested in it for a long time.<sup>47</sup>

Finally, Mr. Arons stated that the marks, and particularly PATIO BY THE SPADES came about from a conversation that Andy Spade had with “a woman at Target” in 2013, regarding “a line that we would design in conjunction with them.”<sup>48</sup> Applicants

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<sup>44</sup> 144 TTABVUE 40.

<sup>45</sup> See WWD Milestones, February 4, 2013; 96 TTABVUE 42.

<sup>46</sup> 85 TTABVUE 41.

<sup>47</sup> 85 TTABVUE 18.

<sup>48</sup> 85 TTABVUE 21. The information regarding relevant correspondence and the intentions of Applicants regarding the marks is further confirmed in the confidential testimony of Andy Spade, which we refer to herein only in general terms. 79 TTABVUE.

submitted the subject emails between Andy Spade and his contact at Target as an exhibit to Mr. Aron's deposition.<sup>49</sup> Keeping in mind that at that time, Andy Spade had already formed a company called Partners & Spade,<sup>50</sup> and later The Spades Trademark Company,<sup>51</sup> one of the Applicants herein, there is little doubt that Applicants intended for the marks THE SPADES and PATIO BY THE SPADES to refer to two of its founders, who are publicly known as Andy and Kate Spade.<sup>52</sup> Overall, we find that in the context of the goods at issue in this proceeding, and taking into account the fame of the KATE SPADE mark, THE SPADES is most likely to be perceived by consumers as having the connotation and commercial impression of a mark identifying handbags, clothing, and fragrances offered by people known as "the Spades." Similarly, PATIO BY THE SPADES is most likely to be perceived by consumers as having the connotation and commercial impression of goods offered by "the Spades," and with, as Mr. Arons notes, "an outdoor patio feeling."<sup>53</sup>

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<sup>49</sup> 85 TTABVUE 115-18. The emails were introduced by Applicants' counsel, and were authenticated as "business records" of the company. 85 TTABVUE 21-23. Indeed, Opposer's counsel objected to the line of questioning, and Applicants' counsel persisted with the questioning, and the entry of the emails into evidence. Thus, to the extent Applicant disagrees with our discussion of the testimony and email evidence, Applicant will not be heard to object to its own submitted testimony and evidence.

<sup>50</sup> 85 TTABVUE 16.

<sup>51</sup> 85 TTABVUE 8.

<sup>52</sup> In its response to Opposer's First Interrogatory, Applicants referred to "[t]he members" of The Spades Trademark Company, LLC as "Andrew Spade, Katherine Brosnahan Spade and Elyce Arons." 50 TTABVUE 7. We note that to the extent the parties discussed as a separate *du Pont* factor the former affiliation of Applicants' principals with Opposer and the KATE SPADE mark, we find it to be most relevant to our findings and analysis regarding the connotation and commercial impression of the marks.

<sup>53</sup> 85 TTABVUE 42. This information is collaborated by testimony and evidence in the confidential record, which we refer to only generally; 84 TTABVUE; 79 TTABVUE.

Overall, considering the marks in their entirety, we find that dissimilarities in sight and sound are outweighed by strong similarities in connotation and commercial impression as to the terms SPADE/S, particularly given the renown of the KATE SPADE marks.

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

#### D. Conditions of Sale

Applicants urge us to consider the high cost of goods offered by Opposer under the KATE SPADE mark. Although the record may indicate a particular price range or target consumer, we are bound in our analysis of this factor by the identifications of goods, which are not limited to particular prices or consumers. Therefore, we must consider that handbags, apparel, and fragrances may be sold at a variety of prices to general consumers exercising only a general degree of care. *Stone Lion Capital Partners*, 110 USPQ2d at 1163 (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”).

We find the fourth *du Pont* factor to be neutral.

#### E. Summary

Considering all of the arguments and evidence of record as they pertain to the relevant *du Pont* factors, in comparing Opposer’s typed drawing KATE SPADE mark in Registration Nos. 2064708, 2578942, and 2724972, with Applicants’ marks THE SPADES and PATIO BY THE SPADES, we conclude that the parties’ goods are in-part identical and are likely to be marketed through the same channels of trade to

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some of the same general consumers; that Opposer has established a high degree of renown for its KATE SPADE mark; and with particular regard to the fame established by Opposer and the identity of the goods, the marks are similar and convey a similar commercial impression.

Accordingly, we find a likelihood of confusion.<sup>54</sup>

**Decision:** The oppositions are sustained to Application Serial Nos. 85932097 and 86179137 on the ground of likelihood of confusion with Opposer's pleaded Registration Nos. 2064708, 2578942, and 2724972.

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<sup>54</sup> Given our decision, it is not necessary for us to consider Opposer's dilution claim.