

This Opinion is not a  
Precedent of the TTAB

Mailed: May 1, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Administrators of the Jean-Michel Basquiat Estate*  
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Serial No. 97291105  
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James P. Cinque, Esq., of Cinque & Cinque, P.C.,  
for Administrators of the Jean-Michel Basquiat Estate.

Giselle Agosto Hincapie, Trademark Examining Attorney, Law Office 102,  
Mitchell Front, Managing Attorney.

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Before Thurmon, Johnson, and Casagrande,  
Administrative Trademark Judges.

Opinion by Casagrande, Administrative Trademark Judge:<sup>1</sup>

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<sup>1</sup> As part of an internal Board pilot program exploring the possibility of broadening acceptable forms of legal citations in Board cases, the citations in this opinion vary from the citation forms recommended in Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 101.03 (June 2023). This opinion cites precedential decisions of the Court of Appeals for the Federal Circuit and the Court of Customs and Patent Appeals only by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). This opinion cites decisions of the Board and the Director only to WESTLAW (WL). To facilitate broader research, cited Board decisions also list the serial or proceeding number. Decisions issued before 2008, however, may not be available in TTABVUE. Unless otherwise noted, only precedential Board decisions are cited. *See id.* There will be no citations to the United States Patents Quarterly (USPQ). Practitioners, however, should continue to adhere to TBMP § 101.03 until further notice from the Board.

Administrators of the Jean-Michel Basquiat Estate (“Applicant”) seek registration on the Principal Register of the mark BASQUIAT (in standard characters) for “Alcoholic beverages, except beer” in International Class 33.<sup>2</sup>

The Trademark Examining Attorney refused registration of Applicant’s mark under Trademark Act Section 2(e)(4), 15 U.S.C. § 1052(e)(4), finding that the evidence shows that Applicant’s mark is primarily merely a surname.<sup>3</sup> Applicant responded by claiming under Section 2(f) of the Act that BASQUIAT has become distinctive of the goods.<sup>4</sup> The Examining Attorney rejected Applicant’s Section 2(f) claim and maintained the refusal under Section 2(e)(4).<sup>5</sup> When the refusals were made final,<sup>6</sup> Applicant appealed.<sup>7</sup> Applicant and the Examining Attorney filed briefs, and Applicant filed a reply.<sup>8</sup> The case is now ready for decision. We affirm the refusals to register.

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<sup>2</sup> Application Serial No. 97291105 was filed on March 2, 2022, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

<sup>3</sup> See December 14, 2022, Nonfinal Office Action. Citations in this opinion to the application record, including the request for reconsideration and its denial, are to pages in the Trademark Status and Document Retrieval (TSDR) database of the United States Patent and Trademark Office (USPTO). The page numbers, if any are given, correspond to the page numbers in the downloaded .pdf-format version of the documents.

<sup>4</sup> See January 19, 2023, Response to Nonfinal Office Action.

<sup>5</sup> See March 6, 2023, Nonfinal Office Action.

<sup>6</sup> See September 11, 2023, Final Office Action.

<sup>7</sup> See 1 TTABVUE. References to the briefs, other filings in the case, and the record cite the Board’s TTABVUE docket system. The number preceding “TTABVUE” represents the docket number assigned to the cited filing in TTABVUE and any number immediately following “TTABVUE” identifies the specific page(s), if any, to which we refer.

<sup>8</sup> See 4 TTABVUE (Applicant’s brief); 6 TTABVUE (Examining Attorney’s brief); 7 TTABVUE (reply).

## I. Legal Background

Applicant does not contest that BASQUIAT is primarily merely a surname and thus subject to refusal under Section 2(e)(4) of the Trademark Act. Accordingly, we deem Applicant to have forfeited any argument that BASQUIAT is not primarily merely a surname. *See In re Katch, LLC*, Ser. No. 86301765, 2019 WL 2560528, at \*2 (TTAB 2019) (applicant who briefed only the refusal to register under Trademark Act Section 23(c) waived arguments against refusal to register under Trademark Act Sections 1, 2, 3, and 45, as well as denial of its 2(f) claim); *In re Gibson Guitar Corp.*, Ser. No. 75513342, 2001 WL 1631369, at \*1 n.2 (TTAB 2001) (where applicant's brief addressed acquired distinctiveness but did not pursue claim that mark was inherently distinctive, Board did not consider the issue of inherent distinctiveness); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1203.02(g) (2023) ("If an applicant, in its appeal brief, does not assert an argument made during prosecution, it may be deemed waived by the Board.").<sup>9</sup> Accordingly, the Section 2(e)(4) refusal is affirmed.

But affirmance of the surname refusal does not resolve the case. That is because proposed marks that are found to be primarily merely surnames may qualify for registration under Section 2(f) if the applicant can prove that the proposed mark,

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<sup>9</sup> *See also Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, Opp. No. 91211014, 2016 WL 4474509, at \*1 (TTAB 2016) (where applicant seeks registration of a surname and asserts a claim under Section 2(f), the issue whether the proposed mark is primarily merely a surname drops out of the case); *cf. Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 1358 (Fed. Cir. 2009) ("Where an applicant seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive.").

through use, has acquired distinctiveness. *See, e.g., Schlafly v. Saint Louis Brewery, LLC*, 909 F.3d 420, 425 (Fed. Cir. 2018). Here, Applicant asserted a claim under Section 2(f), which provides:

Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.

15 U.S.C. § 1052(f).

The wrinkle here is that Applicant filed this application under Section 1(b), which is for marks that an applicant intends to use, but Section 2(f) depends on past “use ... as a mark by the applicant in commerce.” Still, there is a potential path for an applicant in this circumstance to prove acquired distinctiveness and obtain a registration. As noted in *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347 (Fed. Cir. 2001), Trademark Rule 2.41, 37 C.F.R. § 2.41, has long provided a means to prove acquired distinctiveness based on ownership of prior registrations. In its current form, Rule 2.41(a)(1) provides:

In appropriate cases, ownership of one or more active prior registrations on the Principal Register or under the Trademark Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the goods or services are sufficiently similar to the goods or services in the application; however, further evidence may be required.

As the *Dial-A-Mattress* Court further explained, under Rule 2.41(a)(1), “an applicant can establish acquired distinctiveness in an intent-to-use application where it can show that [1] ‘same mark’ [2] acquired distinctiveness [3] for related goods or services, and [4] that this acquired distinctiveness will transfer to the goods or services specified in the application when the mark is used in connection with them.” 240 F.3d at 1347 (brackets added); *see also id.* at 1348 (“Dial-A-Mattress can establish acquired distinctiveness in its intent-to-use application based on the premise that the ‘(212) M-A-T-R-E-S-S’ mark acquired distinctiveness for related goods or services, and a further showing that this acquired distinctiveness will transfer to the goods or services specified in the application when the mark is used in connection with them.”). That is Applicant’s position in this appeal.

## II. Analysis

Invoking *Dial-A-Mattress*, Applicant claims that its BASQUIAT mark in the application at issue would benefit from the transference of the acquired distinctiveness in three prior registrations that Applicant owns:

- Reg. No. 3668862 for BASQUIAT in standard characters, registered Aug. 2009, for “paintings; posters; art prints; printed art reproductions; paper merchandise bags,” in Class 16;
- Reg. No. 3786537 for BASQUIAT in standard characters, registered May 2010, for “Clothing, namely, t-shirts, hats, footwear, polo shirts, pants, blouses, shorts, jackets, dresses, skirts, swim-wear and coats,” in Class 25; and
- Reg. No. 5382640 for BASQUIAT in standard characters, registered January 2018, for “Cosmetic pencils; Cosmetics; Cosmetics and make-up; Cosmetics in general, including perfumes; Cosmetics sold as an integral component of non-medicated skincare preparations; Cosmetics, namely, lip primer; Body and beauty care cosmetics; Colognes, perfumes and cosmetics; Eyebrow cosmetics; Lip stains; Make-up kits comprised of various cosmetic products, namely, eye

shadows, lipsticks, eyeliners and blush; Nail paint; Private label cosmetics; Solid powder for compacts; Temporary tattoo transfers for use as cosmetics,” in Class 3.<sup>10</sup>

Referring to the standard in *Dial-A-Mattress*, 240 F.3d at 1347, we note that the mark in these registrations is the “same mark” as the mark we are considering, and, pursuant to 15 U.S.C. § 1057(b), these registered marks are presumed to be distinctive as to the goods they identify. *See also In re Binion*, Ser. No. 76590702, 2009 WL 5194992, at \*9 (TTAB 2009) (when assessing whether the same mark in prior registrations transfer their acquired distinctiveness to the mark in a Section 1(b) application, ownership of prior registrations on the Principal Register satisfies requirement that the other marks have acquired distinctiveness). The Examining Attorney does not argue otherwise. The only remaining issues are whether the evidence shows that the goods in these registrations are related to the goods in the current application and whether Applicant has made the “further showing that this acquired distinctiveness will transfer to the goods or services specified in the application when the mark is used in connection with them.” *Dial-A-Mattress*, 240 F.3d at 1348.

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<sup>10</sup> *See* January 19, 2023, Response to Nonfinal Office Action, at p.7. We note that Applicant never actually placed any of the three asserted registrations in the record. The Examining Attorney, however, did not point this out at any time and instead consistently addressed Applicant’s argument on the merits. In these circumstances, we, too, will consider the three asserted registrations. *See, e.g., In re Olin Corp.*, Ser. No. 86651083, 2017 WL 4217176, at \*10 n. 22 (TTAB 2017) (where applicant asserted it owned two registrations not in the record and examining attorney did not object and discussed them in her brief, the Board treated the registrations as of record); *In re 1st USA Realty Pros. Inc.*, Ser. No. 78553715, 2007 WL 2315610, at \*1 (TTAB 2007) (copy of own registration submitted for the first time with appeal brief allowed where examining attorney did not object and discussed registration).

Here, Applicant focuses on its prior Reg. No. 3786537 for BASQUIAT for clothing items, arguing that “there is a well-known relationship between the fashion (Class 25) and alcohol (Class 33) industries, such that notoriety in one industry will transfer to the other.”<sup>11</sup> In support of this argument, Applicant points to: (1) three articles discussing “collaborations” between fashion brands and alcohol brands; and (2) third-party registrations.

The three articles are:

- A 2011 article in Forbes Magazine discussing instances of collaboration whereby various brands of alcoholic beverages teamed up with fashion designers to create labels for the beverage brand, or champagne flutes to drink the champagne brand, and two instances where fashion designer made their own brand of wine;<sup>12</sup>
- A 2021 article in Editorialist article listing “some of the best alcohol fashion collabs that landed over the past few decades,” including “high-end designers” who contributed to bottle designs for Absolut- and Cîroc-branded vodka, Amaretto Disarrono, and various champagne brands, noting that “the whole point” of these collaborations is to “act as an organic way to introduce heritage alcohol brands—sometimes steeped in a history that spans centuries—to a whole new generation of thirsty 21+ fans, yet to pledge allegiance to their tipples of choice”;<sup>13</sup> and
- An undated article in Outlander magazine discussing, among other things, a few collaborations “glamorous” and “high-end” fashion designers to contribute to bottle and label designs for various alcoholic beverage brands.<sup>14</sup>

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<sup>11</sup> 4 TTABVUE 7.

<sup>12</sup> See May 31, 2023, Response to Nonfinal Office Action, at pp. 16-21.

<sup>13</sup> See *id.* at 22-28.

<sup>14</sup> See *id.* at 30-37.

In addition, Applicant supplied a list of “fourteen dead trademarks and seven live trademarks which contain both the applied-for Class 33 goods and at least one of the goods identified in Applicant’s registrations in Classes 3, 16 and 25.”<sup>15</sup>

Applicant argues that this evidence demonstrates that this evidence shows that “a sufficient relationship has been established for purposes of Section 2(f) transference.”<sup>16</sup>

The Board has previously explained what is required of an applicant seeking to prove a sufficient relationship between goods in a previously-obtained registration and the goods in a current intent-to-use application for the same mark:

that applicant must establish, by appropriate evidence, [1] the extent to which the goods or services in the intent-to-use application are related to the goods or services in connection with which the mark is distinctive, **and [2] that there is a strong likelihood that the mark’s established trademark function will transfer to the related goods or services when use in commerce occurs.**

*In re Rogers*, Ser. No. 75013108, 1999 WL 1427726, at \*5 (TTAB 1999) (brackets and emphasis added).

Before assessing Applicant’s evidence, we note a preliminary legal problem with Applicant’s argument. In its briefs, Applicant cites several decisions discussing the relatedness of goods and/or services in the context of likelihood of confusion disputes, asserting that those decisions show that transference has been sufficiently proved

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<sup>15</sup> See 4 TTABVUE 10.

<sup>16</sup> See 4 TTABVUE 9; *see also id.* at 14 (“sufficient evidence of transference”).



here.<sup>17</sup> These cases concern whether the goods or services in connection with which a prior mark has been used are related to the goods or services with which the junior user's mark is used. Such relatedness is implicated in the likelihood of confusion context, where it is one factor to be evaluated along with, potentially, many other factors to determine if, on balance, confusion is likely. *See, e.g., In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (listing 13 factors); *see also QuikTrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 1037 (Fed. Cir. 2021) (the *du Pont* factors are ultimately weighed in a "balancing test"). In likelihood-of-confusion cases, this final balancing of the relatedness of goods or services with other factors allows for consideration of varying degrees of relatedness in the ultimate weighing of all the implicated factors. A weak showing of relatedness might count a little in the balancing; a stronger showing might well count more.

To be sure, in the current context, relatedness is an element Applicant must prove, but it doesn't get Applicant all the way home: Applicant must prove that the goods are **so** related that the acquired distinctiveness in the prior registration can be found to have transferred to the goods in the current application. We therefore agree with the Examining Attorney<sup>18</sup> that likelihood-of-confusion cases discussing relatedness do not bear on what kind or amount of evidence is required to show the further and

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<sup>17</sup> *See, e.g.*, 4 TTABVUE 9 (citing *Alfred Dunhill of London, Inc. v. Kasser Distillers Prods. Corp.*, 350 F. Supp. 1341 (E.D. Pa. 1972)); 4 TTABVUE 13-14 (citing *In re Shark Eyes, Inc.*, Ser. No. 77965144 (TTAB Jan. 5, 2012) (nonprecedential slip op.)); 4 TTABVUE 14-15 (citing *In re Albert Trostel & Sons Co.*, Ser. No. 74186695, 1993 WL 596274 (TTAB 1993)); 7 TTABVUE 7 (citing *In re Mucky Duck Mustard Co.*, Ser. No. 603019, 1988 WL 252484 (TTAB 1988)).

<sup>18</sup> *See* 6 TTABVUE 10-11.

critical element at issue in this case: “a strong likelihood that the mark’s established trademark function will transfer to the related goods or services when use in commerce occurs.” This further element requires a rigorous showing, *see In re Olin Corp.*, Ser. No. 86651083, 2017 WL 4217176, at \*9 (TTAB 2017), and does not merely depend on showing enough relatedness to qualify for consideration of relatedness in likelihood-of confusion cases.

We now turn to Applicant’s evidence. Starting first with the three cited articles, we note that they discuss collaborations between fashion designers and alcoholic beverage brands. Here, however, there is no evidence that Applicant is a fashion designer. Not all sellers of clothing products are fashion designers. Applicant’s brief states that the late-Jean-Michel Basquiat was a “renowned artist,”<sup>19</sup> but that is not the same thing as being a fashion designer. In addition, the three articles chiefly discuss “collaborations” where alcoholic beverages are sold under the beverage-maker’s brand, to which the fashion designer adds characteristic fashion elements to the label or vessel. That is not the situation here. Here, Applicant, the estate of an artist, seeks to expand from offering clothing to offering alcoholic beverages under its own mark. These articles mention only one or two instances where fashion designers expanded to sell their own brand of alcoholic beverage.

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<sup>19</sup> *See* 4 TTABVUE 5. A Wikipedia entry for Mr. Basquiat appears in the Dec. 14, 2022, Nonfinal Office Action, at pp. 12-27, but does not mention any work by Mr. Basquiat as a fashion designer. In addition, the clothing registration (Reg. No. 3786537) claims a date of first use of 2003, about 15 years after Mr. Basquiat’s death.

Applicant also emphasizes that it submitted “fourteen dead trademarks and seven live trademarks,” but we agree with the Examining Attorney’s critique of this evidence. Acquired distinctiveness depends on consumer perception of a mark. *See, e.g., Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982) (“To establish [acquired distinctiveness], a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product ... .”); *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1336 (Fed. Cir. 2015) (same). Applications do not bear on consumer perception because they are evidence only of the fact that someone filed the application. *See, e.g., In re Mr. Recipe, LLC*, Ser. No. 86040643, 2016 WL 1380730, at \*6 (TTAB 2016); *In re Pedersen*, Ser. No. 85328868, 2013 WL 6926518, at \*10 n.45 (TTAB 2013); *In re Spirits of New Merced, LLC*, Ser. No. 78710805, 2007 WL 4365811, at \*5 (TTAB 2007). By themselves, they are not evidence of what consumers are exposed to. The Examining Attorney is further correct that cancelled registrations are equally unenlightening on consumer perception. *See, e.g., In re Embiid*, Ser. No. 88202890, 2021 WL 2285576, at \*17 n.48 (TTAB 2021) (“dead or cancelled registrations have no probative value at all”) (citations omitted); *Kemi Organics, LLC v. Gupta*, Can. No. 92065613, 2018 WL 2230555, at \*6 (TTAB 2018) (“cancelled registrations ... are only evidence that the registrations issued, and are not evidence of use of the registered marks at any time”) (citations omitted).

We are thus left with three existing registrations that might bear on consumer perception:

- Reg. No. 6457712 for the mark THE OFFICIAL WINE OF SPORTS, for goods that include wine as well as various clothing items;<sup>20</sup>
- Reg. No. 4992323 for the mark CLAYTON JAMES TENNESSEE WHISKEY, for goods that include spirits and various clothing items;<sup>21</sup> and
- Reg. No. 5754163 for the mark KENTUCKY MIST MOONSHINE, for distilled spirits.<sup>22</sup>

We can ignore the registration for KENTUCKY MIST MOONSHINE because it does not cover any clothing items, just distilled spirits. That leaves two live registrations supporting Applicant's argument.<sup>23</sup>

Viewing the three articles and the two registrations together, we find that Applicant's showing falls far short of satisfying its "heavy burden," *see Olin Corp.*, 2017 WL 4217176, at \*9, to demonstrate a "strong likelihood" that the acquired distinctiveness in the clothing mark would transfer to alcoholic beverages as soon as Applicant uses BASQUIAT in connection with such beverages, *see Rogers*, 1999 WL 1427726, at \*5.<sup>24</sup>

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<sup>20</sup> See 4 TTABVUE 12 (identified as Ser. No. 90197557); *see also* May 31, 2023, Response to Nonfinal Office Action, at pp. 49-50.

<sup>21</sup> See 4 TTABVUE 12 (identified as Ser. No. 86798866); *see also* May 31, 2023, Response to Nonfinal Office Action, at pp. 53-54.

<sup>22</sup> See 4 TTABVUE 12 (identified as Ser. No. 86577855); *see also* May 31, 2013, Response to Nonfinal Office Action at pp. 58-59.

<sup>23</sup> The two third-party registrations implicate only goods in Applicant's Reg. No. 3786537, so we give Applicant's other two registrations no more consideration.

<sup>24</sup> We further note that registrations do not bear significantly on the matter of what consumers are exposed to in the marketplace because, by themselves, they are not evidence of use. *See, e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 1347 (Fed. Cir. 2010); *In re Morinaga Nyugyo K.K.*, Ser. No. 86338392, 2016 WL 5219811, at \*8-9 (TTAB 2016).

Applicant cites two nonprecedential Board decisions involving transference to try to bolster its argument that it demonstrated a strong likelihood of transference of acquired distinctiveness. The first is *In re Petrossian Inc.*, Ser. No. 79177698, 2018 WL 11665196 (TTAB 2018).<sup>25</sup> In that case, the Board found that the acquired distinctiveness in an applicant's prior registrations covering "goods such as coffee, tea, chocolates, candy, vinegar and mustard," *see id.* at \*2, would transfer to goods in an intent-to-use application covering "Soaps; perfumery, essential oils, cosmetics; All the aforesaid goods being sold in delicatessen shops," *see id.* at \*1. The Board based its finding on evidence of thirteen (13) live, use-based third-party registrations containing the applied-for cosmetics/soaps as well as at least some of the goods" identified in the applicant's prior registration, as well as evidence that a third party used its mark on teas as well as soaps and creams. The evidence here—two live registrations and no evidence of third-party use—does not even remotely approach the level of evidence that persuaded the Board in *Petrossian*.

Applicant also highlights our nonprecedential decision in *In re Kipling Apparel Corp.*, Ser. No. 86356569, 2018 WL 4909824 (TTAB 2018).<sup>26</sup> That decision is even less helpful to Applicant than *Petrossian*. In *Kipling*, the intent-to-use application covered goods such as eyeglasses, eyeglass cases, and laptop bags. *Id.* at \*1. The applicant's prior registrations identified items such as cosmetic bags, handbags, and passport cases. *Id.* at \*13. The Board held that this evidence—which facially shows goods in

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<sup>25</sup> See 4 TTABVUE 9-13; 7 TTABVUE 4-5.

<sup>26</sup> See 4 TTABVUE 6-7, 14.

closer relation than those in this case—failed to satisfy the required strong showing, stating:

Because the goods as identified in those registrations are neither intuitively related nor complementary on the face of their identifications to the goods for which Applicant now seeks to register the mark KIPLING, there is little likelihood that the previously acquired distinctiveness of the KIPLING mark with respect to the travel bags, clothing items, metal locks for luggage, passport cases, pen or pencil holders and towels will transfer to the goods identified in Applicant's involved applications.

*Id.* at \*15. Applicant's showing pales, both quantitatively and qualitatively, in comparison to the showing that **failed** in *Kipling*.

In sum, we find that Applicant has come nowhere near demonstrating that the acquired distinctiveness we attribute to its prior registrations will transfer to its current application once Applicant begins use.

**Decision:** The refusal to register is affirmed.