

ESTTA Tracking number: **ESTTA1382055**
Filing date: **09/06/2024**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|------------------------------|--|
| Ex Parte Appeal - Serial No. | 98044168 |
| Appellant | SAINT GEORGE ATELIER LLC |
| Applied for mark | SAINT GEORGE ATELIER |
| Correspondence address | LUCIAN C. CHEN MANDELBAUM BARRETT PC 570 LEXINGTON AVENUE, 21ST FLOOR NEW YORK, NY 10022 UNITED STATES Primary email: lchen@mblawfirm.com Secondary email(s): kchen@mblawfirm.com, collivierre@mblawfirm.com, tmowners@mblawfirm.com 212.324.1880 |
| Submission | Appeal brief |
| Attachments | FINAL 98044168 EX PARTE APPEAL.pdf(5586415 bytes) |
| Appealed classes | Class 025. First Use: Mar 22, 2023 First Use In Commerce: Apr 2, 2023 All goods and services in the class are appealed, namely: Clothing, namely, shirts, pants, tee shirts, sweaters, sweatshirts, sweatpants, socks, shoes, sneakers, boots, sandals, jackets, coats, vests, hats and caps Class 035. First Use: Mar 22, 2023 First Use In Commerce: Apr 2, 2023 All goods and services in the class are appealed, namely: On-line retail store services featuring clothing |
| Filer's name | Lucian C. Chen |
| Filer's email | lchen@mblawfirm.com, tnosher@mblawfirm.com, kchen@mblawfirm.com, collivierre@mblawfirm.com |
| Signature | /lucianchen/ |
| Date | 09/06/2024 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Serial No: 98044168
Applicant: Saint George Atelier LLC
Mark: SAINT GEORGE ATELIER (standard characters)
Class(es): 025; 035
Examining Attorney: Eddie Nolasco Arias, Law Office 116

EX PARTE APPEAL

APPLICANT / APPELLANT'S OPENING BRIEF

Table of Contents

| | | |
|------|--|----|
| I. | PROCEDURAL HISTORY | 6 |
| II. | APPLICANT’S EVIDENCE | 6 |
| III. | EXAMINING ATTORNEY’S EVIDENCE | 6 |
| IV. | STATEMENT OF THE ISSUES | 6 |
| V. | FACTUAL BACKGROUND | 6 |
| VI. | ARGUMENT | 7 |
| A. | There is No Likelihood of Confusion | 7 |
| 1. | Differences in the Marks | 7 |
| 2. | The Marks Look Completely Different | 8 |
| 3. | The Marks Also Sound Different..... | 13 |
| 4. | The Marks Have Completely Different Meanings and Commercial Impressions..... | 13 |
| 5. | Third-Party Use of Similar Marks on Similar Goods Belies Confusion | 16 |
| 6. | Differences in Goods and Services | 19 |
| B. | Examiner’s Disclaimer Should Not Be Required | 19 |
| VII. | CONCLUSION..... | 22 |

TABLE OF AUTHORITIES

| | Page(s) |
|---|----------------|
| Cases | |
| <i>A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.</i> , 237 F.3d 198 (3d Cir. 2000)..... | 14 |
| <i>In re Abcor Development Corp.</i> , 588 F.2d 811, 200 USPQ 215 (CCPA 1978)..... | 21 |
| <i>Arrowpoint Capital Corp. v. Arrowpoint Asset Mgmt.</i> , LLC, 2014 WL 2123572 (D. Del. May 20, 2014)..... | 11 |
| <i>Bongrain International (American) Corporation v. Delice de France</i> , 811 F.2d 1479 (Fed. Cir. 1987)..... | 8 |
| <i>CDOC, Inc. v. Liberty Bankers Life Ins. Co.</i> , 844 Fed. Appx. 357 (Fed. Cir. 2021)..... | 9 |
| <i>Ceccato v. Manifattura Lane Gaetano Marzotto & Fugli S.p.A.</i> , 32 USPQ2d 1192 (TTAB 1994)..... | 12 |
| <i>In re Chamber of Commerce of the U.S.</i> , 675 F.3d 1297 (Fed. Cir. 2012)..... | 20 |
| <i>Champagne Louis Roederer, S.A. v. Delicato Vineyards</i> , 148 F.3d 1373 (Fed. Cir. 1998)..... | 9, 16 |
| <i>Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.</i> , 269 F.3d 270 (3d Cir. 2001)..... | 19 |
| <i>Coach Servs. Inc. v. Triumph Learning LLC</i> , 668 F.3d 1356 (Fed. Cir. 2012)..... | 9, 19 |
| <i>In re Covalinski</i> , 113 USPQ2d 1166 (TTAB 2014)..... | 9 |
| <i>Crystal Corp. v. Manhattan Chem. Mfg. Co.</i> , 75 F.2d 506 (C.C.P.A. 1935)..... | 11 |
| <i>In Re Dune Med. Devices Ltd.</i> , No. 77377330, 2011 WL 1495445 (TTAB Mar. 31, 2011)..... | 21 |
| <i>In re E. I. du Pont de Nemours & Co.</i> , 476 F.2d 1357 (C.C.P.A. 1973)..... | 8 |

| | |
|--|-------|
| <i>In re Electrolyte Lab'ys, Inc.</i> , 929 F.2d 645 (Fed. Cir. 1990)..... | 9, 12 |
| <i>Exxon Corp. v. Texas Motor Exchange, Inc.</i> , 628 F.2d 500 (5th Cir. 1980) | 15 |
| <i>Franciscan Vineyards, Inc. v. Domaines Pinnacle, Inc.</i> , 2013 WL 5820844 (TTAB Oct. 16, 2013) | 11 |
| <i>General Mills, Inc. v. Kellogg Co.</i> , 824 F.2d 622 3 U.S.P.Q.2d 1442 (8th Cir. 1987) | 14 |
| <i>In re Gyulay</i> , 820 F.2d 1216 (Fed. Cir. 1987)..... | 21 |
| <i>Harlem Wizards Entm't. Basketball, Inc. v. NBA Props., Inc.</i> , 952 F. Supp. 1084 (D.N.J. 1997) | 20 |
| <i>In re Hearst Corp.</i> , 982 F.2d 493 (Fed. Cir. 1992)..... | 8 |
| <i>Horos v. Locol, LLC</i> , 2015 WL 12656946 (C.D. Cal. Feb. 11, 2015)..... | 14 |
| <i>Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.</i> , 797 F.3d 1363 (Fed. Cir. 2015)..... | 10 |
| <i>Keebler Co. v. Murray Bakery Prods.</i> , 866 F.2d 1386 (Fed. Cir. 1989)..... | 16 |
| <i>Kellogg Co. v. Pack'em</i> , 21 USPQ2d at 1142 | 16 |
| <i>In Re L.A. Brands, LLC</i> , 86310904, 2016 WL 7385754 (Trademark Tr. & App. Bd. Nov. 28, 2016)..... | 11 |
| <i>Lang v. Ret. Living Publ'g Co., Inc.</i> , 949 F.2d 576 (2d Cir.1991)..... | 9 |
| <i>In re MBNA America Bank N.A.</i> , 340 F.3d 1328, 67 USPQ2d 1778 (Fed. Cir. 2003) | 21 |
| <i>Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772</i> , 396 F.3d 1369 (Fed. Cir. 2005)..... | 17 |
| <i>Parfums de Coeur Ltd. v. Lazarus</i> , 83 USPQ2d 1012 (TTAB 2007) | 9, 10 |

| | |
|--|-----------|
| <i>In re Remacle</i> , 66 USPQ2d 1222 (TTAB 2002) | 21 |
| <i>Steve’s Ice Cream v. Steve’s Famous Hot Dogs</i> , 3 USPQ2d 1477 (TTAB 1987) | 9, 10, 12 |
| <i>Stouffer Corp. v. Health Valley Nat. Foods Inc.</i> , 1 USPQ2d 1900 (TTAB 1986), aff’d, 831 F.2d 306 (Fed. Cir 1987) | 16 |
| <i>Tao Licensing, LLC v. Bender Consulting Ltd.</i> , 125 USPQ2d 1043 (TTAB 2017) | 17 |
| <i>In re Tennis in the Round, Inc.</i> , 199 USPQ 496 (TTAB 1978) | 21 |
| <i>Therma-scan, Inc. v. Thermoscan, Inc.</i> , 295 F.3d 623 (6th Cir. 2002) | 19 |
| <i>In Re Togas House of Textiles LLC</i> , No. 88977677, 2021 WL 4100159 (TTAB Aug. 17, 2021) | 13 |
| <i>In Re Yz Enterprises, Inc.</i> , No. 75/262,976, 2000 WL 1125563 (TTAB July 28, 2000)..... | 21 |
| Other Authorities | |
| <i>J. Thomas McCarthy, 2 McCarthy on Trademarks and Unfair Competition</i> § 11:88 (4th ed. 2001) | 17 |

PROCEDURAL HISTORY

Applicant / Appellant Saint George Atelier LLC (“Applicant”) filed U.S. Application Serial No. 98044168 (hereinafter, the “Application,” “Applicant’s Mark” or “Proposed Mark”) on June 15, 2023. Examining Attorney Eddie Nolasco Arias issued a Non-final Office Action on March 8, 2024. Applicant timely submitted its Response to the Non-Final Office Action on April 3, 2024, addressing each refusal and all of the Examiner’s arguments in support thereof. A Final Office Action was issued six days later on April 9, 2024, maintaining the Examiner’s 2(d) refusal and disclaimer requirement. Applicant timely filed a Notice of Appeal on July 8, 2024.

I. APPLICANT’S EVIDENCE

Applicant’s Evidence of record is appended hereto as Appendix A and cited herein. Applicant’s Evidence is contained within Applicant’s April 3, 2024, Response to Office Action (hereinafter “Applicant’s Evidence”). Citations to Applicant’s Evidence include page numbers found in the aforementioned document as shown in TSDR.

II. EXAMINING ATTORNEY’S EVIDENCE

The Examiner’s Evidence of record is appended hereto as Appendix B.

III. STATEMENT OF THE ISSUES

Whether Applicant’s Mark is likely to cause confusion with the Cited Mark, and whether Applicant’s Mark requires disclaimer of the word “Atelier” therein.

IV. FACTUAL BACKGROUND

Applicant’s Mark is the standard character mark SAINT GEORGE ATELIER, for “[c]lothing, namely, shirts, pants, tee shirts, sweaters, sweatshirts, sweatpants, socks, shoes, sneakers, boots, sandals, jackets, coats, vests, hats and caps,” in International Class 025, and “[o]n-line retail store services featuring clothing,” in International Class 035. The Examiner’s 2(d) refusal in the Final Office Action rests on the Cited Mark. The Cited Mark is the composite mark

reproduced below containing a stylized design of a dragon in combination with the literal element ST. GEORGE.

The Cited Mark is registered in International Class 025 for “[c]lothing, namely, t-shirts, tank tops, sweatshirts, and sweatpants.” Appendix A at 1-2. Notably, the description provided by the Cited Mark’s listed owner to the United States Patent and Trademark Office “USPTO” in its application was “a winged dragon viewed from its left side with its tongue sticking out underneath the words ‘ST. GEORGE’ in capital lettering arched so as to surround [sic] the top half of the dragon.” Applicant’s Evidence at 1. Relevant to this appeal, the Cited Mark’s design search code is 04.05.01 for “dragons; griffons.” Applicant’s Evidence at 2. The listed owner is YYGM, SA of Lugano, Switzerland. *Id.* It appears that YYGM is doing business as Brandy Melville. *Id.* It also appears that YYGM is not using the Cited Mark, and instead is using a variation thereof as shown below that includes the word LONDON, further making confusion unlikely. *Id.*

V. ARGUMENT

A. There is No Likelihood of Confusion

1. Differences in the Marks

Under *DuPont*, marks are compared for similarity or dissimilarity in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). When evaluating the likelihood of confusion, the marks involved are considered in their entireties. *In re Hearst Corp.*, 982 F.2d 493 (Fed. Cir. 1992). A likelihood of confusion means that confusion is probable. The mere possibility that there might be confusion, based on an analysis of the relevant factors, is not a basis for a refusal under the statute which refers to the likelihood of confusion. *Bongrain International (American) Corporation v. Delice de France*, 811 F.2d 1479 (Fed. Cir. 1987).

2. The Marks Look Completely Different

Applicant's Mark and the Cited Mark have significantly different appearances. Importantly, it is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356 (Fed. Cir. 2012).

This is particularly true, in cases like this with the Cited Mark, where stylized and composite marks create different commercial impressions. *See e.g., Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375 (Fed. Cir. 1998); *Lang v. Ret. Living Publ'g Co., Inc.*, 949 F.2d 576, 583 (2d Cir.1991); *In re Electrolyte Lab'ys, Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990); *CDOC, Inc. v. Liberty Bankers Life Ins. Co.*, 844 Fed. Appx. 357, 361 (Fed. Cir. 2021).

While marks must be considered in their entireties, it is entirely appropriate to give greater importance to the more prominent and/or distinctive elements in the marks. *In re Covalinski*, 113 USPQ2d 1166, 1168 (TTAB 2014). Accordingly greater weight can be given to a component of a composite mark that is prominently displayed

Here, the design element of the Cited Mark is by far the dominant feature of that mark because the design catches the viewer's eye first and engages the viewer before the viewer looks at any word. *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007) (“[a]s a result, the design is very noticeable and has the effect of catching the eye and engaging the viewer before the viewer looks at the word BODYMAN”) (emphasis added); *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477, 1478-79 (TTAB 1987) (no likelihood of confusion between STEVE'S for restaurant services and STEVE'S (in typed characters) for ice cream, holding that “[e]ven with the word ‘STEVE’S’ appearing above the hot dog figures, applicant's mark is distinguishable from

the registered mark of opposer, which is simply the word ‘STEVE’S’ in block letter form.”) (emphasis added).

This holds true for the design element in the Cited Mark which features a prominent dragon design. And this dominant feature, as discussed below, drives the commercial impression of the mark. As courts including the Federal Circuit and this Board have consistently held—greater weight can be given to a design component of a composite mark that is prominently displayed. *See, e.g., Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363 (Fed. Cir. 2015). Indeed, courts and this Board have found design elements similar to the design element in the Cited Mark as the dominate feature of that mark.

By way of example, in *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007), the board held that the prominently displayed design of a torso wearing a cape was the dominant element of the composite mark because the engages the viewer before the viewer looks at any word. *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007) (“As a result, the design is very noticeable and has the effect of catching the eye and engaging the viewer before the viewer looks at the word BODYMAN”) (emphasis added); *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 USPQ2d 1477, 1478-79 (TTAB 1987). *Steve’s Ice Cream* is a particularly instructive Board decision here because, like the Cited Mark at hand, the mark in Steve’s has a highly distinctive design appearing below the literal element and includes curved lettering above the design.



Id. (“[t]he highly stylized depiction of humanized frankfurters, prancing arm in arm to musical notes, creates a distinctive commercial impression. Even with the word ‘STEVE'S’ appearing

above the hot dog figures, applicant's mark is distinguishable from the registered mark of opposer, which is simply the word 'STEVE'S' in block letter form.") (emphasis added).

The same is true here and the same decision should follow. The Cited Mark's design element is prominently displayed and is the center point of the mark and thus stands out to the viewer, namely the highly distinctive and eye catching dragon. The design is undisputedly the central focus of the mark regardless of the text above the design.



The stylized design of this composite mark therefore dominates over the text. *See, e.g., Crystal Corp. v. Manhattan Chem. Mfg. Co.*, 75 F.2d 506, 508 (C.C.P.A. 1935) (“but, after all, that representation is the most noticeable feature of the mark and seems to us to be the dominating feature”); *Franciscan Vineyards, Inc. v. Domaines Pinnacle, Inc.*, 2013 WL 5820844, at *4 (TTAB Oct. 16, 2013) (“The descriptive significance of the term “domaine,” coupled with the relatively larger size and center placement of the term PINNACLE in relation thereto, make PINNACLE the dominant element in applicant’s mark.”) (emphasis added); *Arrowpoint Capital Corp. v. Arrowpoint Asset Mgmt., LLC*, 2014 WL 2123572, at *5 (D. Del. May 20, 2014) (“In contrast, the AAM Logo uses a large chevron surrounded by parallel lines to create its dominant feature, which is prominently placed in the center of the mark.”) (emphasis added); *In Re L.A. Brands, LLC*, 86310904, 2016 WL 7385754, at *6 (Trademark Tr. & App. Bd. Nov. 28, 2016) (“‘1776’, stacked vertically, is the dominant component of the mark. That dominant component at the very center of the mark is emphasized by its surrounding design elements.”)

Again, the Cited Mark has the highly distinctive design of a large dragon that is in the center and middle of that mark—that immediately engages the viewer’s eye—before ever looking at the literal element. The design element is therefore, under controlling authority, the dominant feature of the Cited Mark which as discussed *infra*, creates an entirely separate commercial impression.

Importantly, the use of curved text for the literal element, as set forth in Registrant’s description of the mark, underscores that the literal element is merely complimenting the dominant design feature—and is not itself the central or dominant feature of the mark. This is, again, similar to the *Steve’s Ice Cream* mark above where STEVES is displayed in curved text.

In the Final Office Action, the Examiner cites the general proposition that “the fact that registrant’s mark contains a design does not change the overall commercial impression for purposes of Section 2(d),” and “although marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed.” Final Office Action at 3.

But the Examiner’s Final Office Action overlooks the fact that Cited Mark includes a design element which is indisputably the dominant feature as supported by the aforementioned controlling authority. To be clear, “[i]n the likelihood of confusion analysis, there is no general rule as to whether letters or designs will dominate in a composite mark.” *In re Electrolyte Laboratories, Inc.*, 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990).

Indeed, the Examiner’s argument ignores an important exception which controls in this case. *See Ceccato v. Manifattura Lane Gaetano Marzotto & Fugli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994) (“As a general rule, design elements of a mark are of lesser import, because it is the word

portion of a mark, rather than any design feature, unless highly distinctive, which is more likely to be remembered and relied upon by customers in calling for the goods.”) (emphasis added). The Examiner’s conclusion also contravenes the cited authority discussing the import of design elements that first catch a viewer’s eye and is a central feature of the mark and overlooks the fact that the Cited Mark’s design elements does exactly that here.

The Board’s decision in *In re Togas* is instructive to this appeal. The Board held that “Applicant’s combination mark has a strikingly different design,” and “in addition to a stylized word portion, the design includes a large rectangular swatch with distinctive stitches along the perimeter of the rectangular swatch...the stitches are indicative of sewing on a swatch and convey an impression of swatches being stitched together...” *In Re Togas House of Textiles LLC*, No. 88977677, 2021 WL 4100159, at *3 (TTAB Aug. 17, 2021). Accordingly, the Board found “that unique design of the applied-for mark with a word portion including 4 words renders Applicant’s mark highly dissimilar in appearance from Registrant’s mark,” and that the “average purchaser will highly likely retain an impression of the distinctive features of the design of Applicant’s mark.”

Id.

The marks at issue in this decision are reproduced below and appear far more similar than the marks at issue in this case.



Not only do the marks look different because of the Cited Mark’s distinctive design that is the dominant feature, but the literal elements are also completely different. In fact, the only shared term among the literal elements is the common name GEORGE. This cannot support a 2(d) refusal.

3. The Marks Also Sound Different

Applicant's Mark and the Cited Mark also sound different. *See, e.g., Rational Intell.*, 2023 WL 3918266, at *21 (as to the analysis of Spin & Go and Spin & Gold, holding that “while there is some overlap (the presence of the terms ‘SPIN &’, overall the marks are more dissimilar than similar, look and sound different, and convey very different meanings and commercial impressions. Confusion is therefore unlikely.”). Courts measure the “sound” and “auditory impressions” of a mark by examining the number of words and syllables employed. *See, e.g., A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 217 (3d Cir. 2000). Here both the number of words are different. Applicant's Mark has 3 words and 6 syllables. The Cited Mark, in contrast, has 2 words and 2 syllables. The Examiner's rebuttal in the Final Office Action that “[b]oth marks begin phonetically identical terms,” does not outweigh the substantial differences in overall sound and overall syllables. Final Office Action at 3. Instead, the Examiner is simply viewing the marks in piecemeal fashion which contravenes controlling law.

Indeed, in similar cases, courts and the Board have found such differences sufficient to support a finding of no likelihood of confusion. *See, e.g., Horos v. Locol, LLC*, 2015 WL 12656946, at *7 (C.D. Cal. Feb. 11, 2015)

4. The Marks Have Completely Different Meanings and Commercial Impressions

The use of similar, even dominant, elements in common does not necessarily mean that two marks are similar. *See General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 687 3 U.S.P.Q.2d 1442 (8th Cir. 1987) (holding defendant's OATMEAL RAISIN CRISP did not infringe plaintiff's APPLE RAISIN CRISP trademark when evaluating the total effect conveyed by both marks). Evaluating the similarity of appearance between trademarks is really nothing more than a subjective eyeball test to consider the overall impression of the mark as a whole—as opposed to

comparing individual features of the marks. *See Exxon Corp. v. Texas Motor Exchange, Inc.*, 628 F.2d 500 (5th Cir. 1980).

Here, in the Final Office Action, the Examiner suggests that Applicant's Mark "is confusingly similar to the registered mark...[b]oth marks begin phonetically identical terms, which means that the marks initially sound and appear similar," and "in the context of the respective clothing goods and services, the marks create a similar commercial impression of a saint named George." Final Office Action at 3. But, as a threshold matter, the portion of the mark identified by Examiner, ST. GEORGE, is inherently weak as it appears in registrations for similar goods and/or services as explained in detail in Section 5 *infra*. Beyond the third-party use of ST. GEORGE that makes that term weak, the Examiner further errs by impermissibly viewing both Applicant's and the Cited Mark in piecemeal fashion—not in their entirety—and by ignoring the import of other parts of those marks on their commercial impression.

Here again, the Cited Mark contains a highly distinctive design element of a winged dragon that serves as the mark's dominant feature. This dominant feature forms the basis of the meaning and commercial impression of the Cited Mark. As shown in Applicant's Evidence, dragons carry very distinct meanings and symbolism. They often connote strength. Applicant's Evidence at 9-11. Dragons also connote one who is formidable or combative. Applicant's Evidence at 9-11. These meanings form the commercial impression of the Cited Mark—which is completely different than the commercial impression of Applicant's Mark discussed below.

In contrast to the Cited Mark, Applicant's Mark does not have a dragon—or any other design feature. Applicant's Mark, SAINT GEORGE ATELIER, when viewed in its entirety and not impermissibly dissected in piecemeal fashion, includes the important and dominant term

ATELIER. Atelier is a workshop, which creates an entirely different meaning and commercial impression. Applicant's Evidence at 11.

The Board and courts throughout the country—including binding Federal Circuit decisions—have routinely found no likelihood of confusion when, like here, marks had different meaning and commercial impressions despite having some shared terms. *See, e.g., Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1461 (Fed. Cir. 1998) (affirming Board dismissal of opposition based on dissimilarity of the marks CRISTAL and CRYSTAL CREEK); *Kellogg Co. v. Pack'em*, 21 USPQ2d at 1142 (affirming Board dismissal of opposition based on dissimilarity of the marks FROOTEE ICE and elephant design and FRUIT LOOPS); *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386 (Fed. Cir. 1989) (affirming Board dismissal of opposition based on dissimilarity of the marks PECAN SANDIES and PECAN SHORTEES in commercial impression); *Stouffer Corp. v. Health Valley Nat. Foods Inc.*, 1 USPQ2d 1900, 1906 (TTAB 1986), *aff'd*, 831 F.2d 306 (Fed. Cir. 1987) (“while the fame of opposer's mark and the identity of the parties' goods and their channels of trade tend to favor opposer's case, we are not persuaded that these circumstances are sufficient to refuse registration to applicant in view of our finding that LEAN CUISINE and LEAN LIVING, applied to the goods herein are not confusingly similar in sound, appearance or commercial impression”); *Rational Intell. Holdings Ltd.*, No. 91268260, 2023 WL 3918266, at *21 (May 31, 2023) (“While there is some overlap (the presence of the terms “SPIN &”, overall the marks are more dissimilar than similar, look and sound different, and convey very different meanings and commercial impressions. Confusion is therefore unlikely.”)

Accordingly, there can be no likelihood of confusion based on these completely different meanings and commercial impressions of the marks. The limited and conclusory arguments

suggesting shared commercial impressions set forth in the Final Office Action does not change this fact and does not support the 2(d) refusal.

5. Third-Party Use of Similar Marks on Similar Goods Belies Confusion

The Final Office Action's finding of a likelihood of confusion is also fully refuted by the number of similar third-party marks in use on similar goods and services. Evidence of third-party use of similar marks on similar goods and services is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369 (Fed. Cir. 2005). "Third-party registration evidence that does not equate to proof of third-party use may bear on conceptual weakness if a term is commonly registered for similar goods or services." *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1075 (TTAB 2017). These registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used with respect to the goods or services at issue that it leads to the conclusion that the mark or portion thereof is relatively weak.

Evidence of third-party use of similar marks for similar services "can show that customers have been educated to distinguish between different marks on the basis of minute distinctions." *Id.* (citation omitted). Extensive evidence of third-party use and registration is "powerful on its face." *Id.*, 116 USPQ2d at 1136; *see also J. Thomas McCarthy, 2 McCarthy on Trademarks and Unfair Competition* § 11:88 (4th ed. 2001) (hereinafter *McCarthy on Trademarks*). Here, the Examiner's 2(d) refusal in the Final Office Action rests on the term GEORGE and the terms ST. and SAINT. But Applicant's evidence identifies similar marks for similar goods and services all of which include the words ST. GEORGE, SAINT GEORGE OR GEORGE for Classes 25 and 35. This includes previously registered marks that have since become abandoned for lack of maintenance. Applicant's Evidence at 11-20.

The Examiner attempts to rebut Applicant's evidence here, noting that a few of the cited marks—as acknowledged in Applicant's Response—include abandoned registrations and stating that “a cancelled or expired registration is ‘only evidence that the registration issued and it does not carry any of the legal presumptions under [Trademark Act] Section 7(b),’ such as the presumption that the registration is valid, owned by the registrant, and that the registrant has the exclusive right to use the mark in commerce in connection with the goods and/or services specified in the registration certificate.” Final Office Action at 4-5. But Applicant does not cite those abandoned marks for any reason other than showing that the registrations issued—and accordingly, were part of a register full of marks similar to the Cited Mark. The fact that they are no longer live due to maintenance failure is of no consequence to this argument. While the Examiner concludes the rebuttal with the statement “[t]hus, these third-party registrations have little, if any, probative value with respect to the registrability,” the Examiner tellingly cites no authority to support such conclusion. Final Office Action at 4-5.

Lastly, the Examiner argues that the active third party registrations cited by Applicant have different commercial impressions. Final Office Action at 5 (“[o]f the remaining marks cited by the applicant, ALLYN SAINT GEORGE AMERICAN SPORT...it is readily apparent that each mark looks, sounds, and have different commercial impressions to applicant's mark as well as registrant's ST. GEORGE mark...[w]ith regard to the registered mark ALLYN SAINT GEORGE AMERICAN SPORT, the mark's commercial impression is that of a person named Allyn Saint George as opposed to simply a Saint named George. Similarly, the mark GEORGE has a commercial impression of a regular person (as opposed to a saint or a full name) named George.” But this is a tenuous argument. Certainly, placement of the word ALLYN before SAINT GEORGE is less distinguishable than a giant winged dragon below an entirely different word ST. This

argument also, again, ignores the commercial impression formed by that unique and dominate design element.

6. Differences in Goods and Services

In addition to the clear differences in the Marks' appearance, sound, meaning and commercial impressions, and aside from the vast third party of similar marks, there is also a difference in the respective goods and services. In the 2(d) analysis, goods and services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71 (Fed. Cir. 2012). This relatedness of the goods factor compares the goods and services in the application with the goods and services in the registration. In considering the similarity of the goods and services offered under two marks, the inquiry must focus on the relation of the goods and services in the minds of consumers.

Confusion is not necessarily likely simply because the goods or services can be described as being in the same category or field. *Therma-scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623 (6th Cir. 2002). Indeed, “[g]oods [and services] may fall under the same general product category but operate in distinct niches,” thereby avoiding confusion. *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, 269 F.3d 270, 288 (3d Cir. 2001) (emphasis added).

Goods may fall under the same general product category but operate in distinct niches as is the case here. When two products are part of distinct sectors of a broad product category, they can be sufficiently unrelated that consumers are not likely to assume the products originate from the same mark. *See, e.g., Commerce Nat 'l Ins. Servs., Inc.*, 214 F.3d at 441 (holding marks held by company operating in banking industry and company operating in insurance industry did not create consumer confusion because the two companies were involved in distinct highly regulated

industries); *Harlem Wizards Entm't. Basketball, Inc. v. NBA Props., Inc.*, 952 F. Supp. 1084, 1096 (D.N.J. 1997) (finding no product similarity between professional competitive basketball team and "show basketball" team).

Here, the customers for Applicant and Registrant are in vastly different niches. Registrant appears to be using a related unregistered mark—and not the Cited Mark—for woman's basics and intimate wear. Applicant's Evidence at 20. In contrast, Applicant's Mark is used in connection with an online store that sells bags and clothing, as well as certain clothing. Registrant and Applicant operate in distinct niches and there will be no likelihood of confusion between the marks.

The Final Office Action does not address Applicant's argument on the distinct niches of the Applicant and Registrant. Instead, the Examiner cites to additional websites suggesting that "the same entity commonly manufactures, produces, or provides the relevant goods and/or services and markets the goods and/or services under the same mark." Final Office Action at 6. But neither this evidence, nor the Final Office Action addresses the arguments of Applicant's Response and the clear fact that there are distinct niches that refute a finding of confusion here.

B. Examiner's Disclaimer Should Not Be Required

The Examiner has also issued a disclaimer requirement for the literal element ATELIER, suggesting that the term "is merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods and/or services." Office Action at 5.

A term is "merely descriptive" within the meaning of Section 2(e)(1) if it "immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297 (Fed. Cir. 2012) (emphasis added). "On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates,

the term is suggestive rather than merely descriptive.” *In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978).

A term is only descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the products or services it identifies. *In re Gyulay*, 820 F.2d 1216 (Fed. Cir. 1987); *In Re Yz Enterprises, Inc.*, No. 75/262,976, 2000 WL 1125563, at *2 (TTAB July 28, 2000). Simply put, the operative question is whether someone who knows what the products or services are will understand the mark immediately to convey information about them. *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003).

The perception of the relevant purchasing public sets the standard for determining descriptiveness. A mark is only descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service. On the other hand, if a mark requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods or services, then the mark is suggestive—not descriptive. *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). Thus, if a consumer requires some additional cognition to connect the mark with a quality, feature, function, or characteristic of the goods or services, the mark cannot be descriptive. *In Re Dune Med. Devices Ltd.*, No. 77377330, 2011 WL 1495445, at *5 (TTAB Mar. 31, 2011).

Whether a particular term is merely descriptive is determined in relation to the goods or services for which registration is sought and the context in which the term is used. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). The term at issue here, ATELIER, does not immediately convey the requisite quality, feature, function or characteristics of the Recited Services. Atelier means

workshop. *See supra*. That term does not immediately define anything about the Applicant's goods or services. For this reason alone, Applicant's Mark is not descriptive.

The Examiner's descriptive refusal in the Final Office Action rests solely on the following argument: "[t]he attached evidence from Merriam-Webster Dictionary shows this wording means "workshop," and "[t]hus, the wording merely describes applicant's goods and/or services because it immediately describes applicant's goods and services, in that applicant's workshop provides and sells clothing.""). But the Final Office Action does not offer any actual evidence supporting the required showing that ATELIER immediately informs a consumer quality, feature, function or characteristics of the Recited Goods or Services. It is unclear from the Final Office Action, and remains unclear, how the term ATELIER immediately informs consumers of a quality, feature, function or characteristics of either: (1) Clothing, namely, shirts, pants, tee shirts, sweaters, sweatshirts, sweatpants, socks, shoes, sneakers, boots, sandals, jackets, coats, vests, hats and caps; or (2) On-line retail store services featuring clothing. The Final Office Action itself confirms that one requires imagination, thought, and perception to take the subject term ATELIER and arrive at the qualities or characteristics of the goods and services. Indeed, the Final Office Action states "[t]hus, the wording merely describes applicant's goods and/or services because it immediately describes applicant's goods and services, in that applicant's workshop provides and sells clothing." Final Office Action at 5 (emphasis added).

But there is no evidence to demonstrate that ATELIER immediately informs consumers that "Applicant's workshop provides and sells clothing." Moreover, the Examiner is factually incorrect as the Applicant does not have a workshop. And last but not least, a workshop is diametrically opposed to Class 035 for online retail stores featuring clothing. Simply put, an online store is not a workshop. Because consumers here require some additional cognition to subject term

with the mark with a quality, feature, function, or characteristic of the goods or services, the mark cannot be descriptive and no disclaimer is needed. Notably, the Examiner does not address any of Applicant's arguments set forth in its Response in the Final Office Action. Instead, the Final Office Action simply repeats the same arguments as set forth in the Non-Final Office Action. Accordingly, the Examiner should be limited to those conclusory and unsupported arguments on appeal.

VI. CONCLUSION

Because Applicant's Mark and the Cited Mark look and sound completely different—and have different meanings and create significantly different commercial impressions, the marks are not likely to cause confusion. Further, the Applicant's Mark and Cited Mark are directed towards different customers in different niches. And the vast third party use of similar marks on similar goods further weighs against a 2(d) refusal. Lastly, because the term ATELIER is not descriptive of the Recited Goods and Services, a disclaimer is not needed. Applicant respectfully requests that the final refusal of the Examiner Attorney be reversed, and the Application be remanded for allowance and publication.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that copies of Applicant / Appellant's Opening Appeal Brief and all accompanying documents and materials were served on the below-listed Examining Attorney of record via ESTTA filing on this 6th day of September 2024:

Counsel for Plaintiff

Eddie Nolasco Arias
Examining Attorney
United States Patent and Trademark Office
LAW OFFICE 116
(571) 270-0943
Kenneth.NolascoArias@uspto.gov

Dated: September 6, 2024

/s/ Lucian C. Chen

Lucian C. Chen, Esq.
Todd M. Noshier, Esq.
MANDELBAUM BARRETT PC
3 Becker Farm Road, Suite 105
Roseland, New Jersey 07068
Phone: 973-736-4600
Fax: 973-325-7467

APPENDIX A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

April 3, 2024

Eddie Nolasco Arias
Examining Attorney
Law Office 116
United States Patent and Trademark Office

RE: Serial No: 98044168

Applicant: Saint George Atelier LLC
Mark: SAINT GEORGE ATELIER (standard characters)
Non-final Office Action of March 8, 2023

APPLICANT’S RESPONSE TO OFFICE ACTION

I. Factual Background

The following is the response of Applicant Saint George Atelier LLC (“Applicant”) to the Nonfinal Office Action (“Office Action”) dated March 8, 2023 by Examining Attorney Eddie Nolasco Arias. The Examining Attorney has identified the following issues concerning Applicant’s proposed mark under Serial No. 98044168 (“Applicant’s Mark” or “Proposed Mark”):

The Examining Attorney has refused registration of the proposed mark pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the grounds that the mark is likely to be confused with the marks in Registration No. 6489343 (hereinafter the “Cited Registration” or “Cited Mark”) which is discussed below.

The Examining Attorney has also issued a disclaimer requirement, suggesting that the literal element ATELIER “is merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of applicant’s goods and/or services.”

Applicant respectfully disagrees with both findings as set forth below.

Cited Mark

Cited U.S. Registration No. 6489343 (the “Cited Mark”) is the composite mark reproduced below containing a highly distinct stylized design of a dragon and the literal element ST. GEORGE for “[c]lothing, namely, t-shirts, tank tops, sweatshirts, and sweatpants,” in International Class 025. The mark description provided by the Cited Mark’s listed owner is “a winged dragon viewed from its left side with its tongue sticking out underneath the words ‘ST. GEORGE’ in capital lettering arched so as to surround [sic] the top half of the dragon.” See https://tsdr.uspto.gov/#caseNumber=90071785&caseSearchType=US_APPLICATION&caseType=DEFAULT&searchType=statusSearch.



The Cited Mark's design search code is 04.05.01 for "dragons; griffons." Id. The listed owner is YYGM, SA of Lugano, Switzerland. It appears that YYGM is doing business as Brandy Melville. *See, e.g.*, <https://cdn.ca9.uscourts.gov/datastore/opinions/2023/07/24/21-56150.pdf>. It also appears that YYGM is not using the Cited Mark, and instead is using a variation thereof as shown below that includes the word LONDON, further marking confusion unlikely. *See, e.g.*, https://us.brandymelville.com/products/rosa-st-george-sweatshorts?_pos=1&_sid=1d2bc5665&_ss=r

Applicant's Mark

Applicant's U.S. Application Ser. No. 98044168 (the "Applicant's Mark") is the standard character mark for SAINT GEORGE ATELIER, reproduced below, for "[c]lothing, namely, shirts, pants, tee shirts, sweaters, sweatshirts, sweatpants, socks, shoes, sneakers, boots, sandals, jackets, coats, vests, hats and caps," in International Class 025, and "[o]n-line retail store services featuring clothing," in International Class 035.



As explained in detail below, because the Applicant's Mark and Registrant's Mark, *inter alia*, do not appear and sound alike, have different meanings and create significantly different commercial impressions and travel in different trade channels geared towards different consumers, there is no likelihood of confusion. Moreover, given the evidence of third-party use of similar marks on similar goods and services, the Cited Mark is relatively weak and entitled to only a narrow scope of protection for the purpose of the Examiner's 2(d) refusal.

As for the disclaimer requirement, a disclaimer here is contrary to controlling authority because the literal element ATELIER does not immediately inform a consumer of the quality, feature, function or characteristics of the Recited Goods and Services (hereinafter "Recited Services") as described in detail below. Indeed, the Examiner's evidence itself acknowledges that a consumer would need at least some amount of imagination, thought, or perception to make the purported connection between Applicant's Mark and the Recited Services.

Applicant therefore respectfully disagrees with the findings of the Office Action and requests that the Examining Attorney reconsider the statutory refusal and allow registration of Applicant's mark.

II. ARGUMENT Part 1 – No Likelihood of Confusion

A. Differences in the Marks

Under *DuPont*, marks are compared for similarity or dissimilarity in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). When evaluating the likelihood of confusion, the marks involved are considered in their entireties. (*In re Hearst Corp.*, 982 F.2d 493, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992).) "Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight." *Id.* A likelihood of confusion means that confusion is probable. The mere possibility that there might be confusion, based on an analysis of the relevant factors, is not a basis for a refusal under the statute which refers to the likelihood of confusion. *Bongrain International (American) Corporation v. Delice de France*, 811 F.2d 1479, 1 U.S.P.Q.2d 1775 (Fed. Cir. 1987).

B. The Marks Look Completely Different

Applicant's Mark and the Cited Marks have significantly different appearances.

Importantly, it is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356 (Fed. Cir. 2012).

This is particularly true, in cases like this with the Cited Mark, where stylized and composite marks create different commercial impressions. *See e.g., Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375 (Fed. Cir. 1998) (finding that despite the fact the marks were used for the same class of goods and that the goods traveled in the same trade channels and were purchased by the same or similar customers, the mark CRISTAL for champagne and the mark CRYSTAL CREEK for wine differed in appearance, sound, significance, and commercial impression); *Lang v. Ret. Living Publ'g Co., Inc.*, 949 F.2d 576, 583 (2d Cir. 1991) (products using identical terms were nonetheless dissimilar because products' overall appearance conveyed different "general impression" to public); *Major League Baseball Props. v. Opening Day Prods.*, 385 F.Supp.2d 256, 266 (S.D.N.Y. 2005) (degree of similarity between marks was low where both products used phrase "opening day" but logos and other depictions "convey[ed] a different impression" to the public); *In re Electrolyte Lab 'ys, Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990) ("More dominant features will, of course, weigh heavier in the overall impression of a mark."); *see also CDOC, Inc. v. Liberty Bankers Life Ins. Co.*, 844 Fed. Appx. 357, 361 (Fed. Cir. 2021).

While marks must be considered in their entirety, it is entirely appropriate to accord greater importance to the **more prominent and/or distinctive elements in the marks**. *In re Covalinski*, 113 USPQ2d 1166, 1168 (TTAB 2014); *see also In re Nat'l Data Corp.*, 753 F.2d 1056 (Fed. Cir. 1985) ("[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety."). Accordingly greater weight can be given to a component of a composite mark that is prominently displayed *See, e.g., Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363 (Fed. Cir. 2015).

Here, the design element of the Cited Mark is by far the dominant features of that mark because the design catches the viewer's eye and engages the viewer before the viewer looks at the word. *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007) ("As a result, the design is very noticeable and has the effect of catching the eye and engaging the viewer before the viewer looks at the word BODYMAN") (emphasis added). *See also Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477, 1478-79 (TTAB 1987) (no likelihood of confusion between STEVE'S for restaurant services and STEVE'S (in typed characters) for ice cream; "Even with the word 'STEVE'S' appearing above the hot dog figures, applicant's mark is distinguishable from the registered mark of opposer, which is simply the word 'STEVE'S' in block letter form."). This holds true for each of the design elements in the Cited Marks, including the non-Latin characters, the intersecting lines and the double-helix DNA graphic on the top right. And those dominant features, as discussed below, drive the commercial impression of the marks.

As courts including the Federal Circuit and the Board have consistently held—greater weight can be given to a design component of a composite mark that is prominently displayed. *See, e.g., Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363 (Fed. Cir. 2015). In cases like this, both courts and Board have found design elements similar to the design element in the Cited Mark as the dominate feature of that mark. *See, e.g., Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). Further instances are provided below.

By way of example, in *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007), the board held that the prominently displayed design of a torso wearing a cape was the dominant element of the composite mark because the engages the viewer before the viewer looks at the word. *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007) (“As a result, the design is very noticeable and has the effect of catching the eye and engaging the viewer before the viewer looks at the word BODYMAN”) (emphasis added). *See also Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 USPQ2d 1477, 1478-79 (TTAB 1987) (no likelihood of confusion between STEVE’S for restaurant services and STEVE’S (in typed characters) for ice cream; “Even with the word ‘STEVE’S’ appearing above the hot dog figures, applicant’s mark is distinguishable from the registered mark of opposer, which is simply the word ‘STEVE’S’ in block letter form.”).

Steve’s Ice Cream is a particularly instructive Board decision here because, like the Cited Mark at hand, the mark in Steve’s has a highly distinctive design appearing below the literal element and includes curved lettering above the design.



Id. (“[t]he highly stylized depiction of humanized frankfurters, prancing arm in arm to musical notes, creates a distinctive commercial impression. Even with the word ‘STEVE’S’ appearing

above the hot dog figures, applicant's mark is distinguishable from the registered mark of opposer, which is simply the word 'STEVE'S' in block letter form.”).

Here, the Cited Mark’s design element is prominently displayed and is the center point of the mark and thus stands out to the viewer, namely the highly distinctive and eye catching dragon. The design is undisputedly the central focus of the mark.

Therefore, the stylized design of this composite mark therefore dominates over the text. *See, e.g., Crystal Corp. v. Manhattan Chem. Mfg. Co.*, 75 F.2d 506, 508 (C.C.P.A. 1935) (“but, after all, that representation is the most noticeable feature of the mark and seems to us to be the dominating feature”); *Franciscan Vineyards, Inc. v. Domaines Pinnacle, Inc.*, 2013 WL 5820844, at *4 (Trademark Tr. & App. Bd. Oct. 16, 2013), *aff’d sub nom. In re Franciscan Vineyards, Inc.*, 593 Fed. Appx. 997 (Fed. Cir. 2014) (“The descriptive significance of the term “domaine,” coupled with the relatively larger size and center placement of the term PINNACLE in relation thereto, make PINNACLE the dominant element in applicant’s mark.”) (emphasis added); *Arrowpoint Capital Corp. v. Arrowpoint Asset Mgmt., LLC*, 2014 WL 2123572, at *5 (D. Del. May 20, 2014) (“In contrast, the AAM Logo uses a large chevron surrounded by parallel lines to create its dominant feature, which is prominently placed in the center of the mark.”) (emphasis added); *In Re L.A. Brands, LLC*, 86310904, 2016 WL 7385754, at *6 (Trademark Tr. & App. Bd. Nov. 28, 2016) (“‘1776’, stacked vertically, is the dominant component of the mark. That dominant component at the very center of the mark is emphasized by its surrounding design elements.”)

The Cited Mark reproduced again below, has the highly distinctive design of a large dragon that is in the center and middle of that mark—that immediately engages the viewer’s eye—before ever looking at the literal element. The design element is therefore, under the controlling authority above, the dominant feature of the Cited Mark which as discussed *infra*, creates an entirely separate commercial impression.



Notably, the use of curved text for the literal element, as set forth in Registrant’s description of the mark, underscores that the literal element is merely complimenting the dominant design feature—and is not itself the central or dominant feature of the mark. This is, again, similar to the *Steve’s Ice Cream* mark above where STEVES is displayed in curved text. **This dominant and unique feature of a winged dragon significantly distinguishes the Applicant’s Mark from the Cited Mark.**

The Examiner cites the general proposition that “the fact that registrant’s mark contains a design does not change the overall commercial impression for purposes of Section 2(d),” and “although marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed.” Office Action at 3.

But the Examiner overlooks the fact that Cited Mark includes a design element which is the indisputably the dominant feature of the mark as supported by the aforementioned and controlling authority. Significantly, “[i]n the likelihood of confusion analysis, there is no general rule as to whether letters or designs will dominate in a composite mark.” *In re Electrolyte Laboratories, Inc.*, 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990); *Red Bull GmbH, No. 91204861 91210860*, 2013 WL 11247286, at *3 (TTAB Dec. 19, 2013); *Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1940 (TTAB 2013). Indeed, the Examiner’s argument leaves out an important exception which controls in this case. *See Ceccato v. Manifattura Lane Gaetano Marzotto & Fugli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994) (“As a general rule, design elements of a mark are of lesser import, because it is the word portion of a mark, rather than any design feature, **unless highly distinctive, which is more likely to be remembered and relied upon by customers in calling for the goods.**”) (emphasis added). The Examiner’s conclusion also contravenes the above cited authority discussing the import of design elements that first catch a viewer’s eye, is a central feature of the mark, and overlooks the fact that the Cited Mark’s design elements do the very same thing here.

Here, the Board’s decision in *In re Togas* is instructive. The Board held that “Applicant’s combination mark has a strikingly different design,” and “in addition to a stylized word portion, the design includes a large rectangular swatch with distinctive stiches along the perimeter of the rectangular swatch...the stiches are indicative of sewing on a swatch and convey an impression of swatches being stitched together...” *In Re Togas House of Textiles LLC*, No. 88977677, 2021 WL 4100159, at *3 (TTAB Aug. 17, 2021). Accordingly, the Board found “that unique design of the applied-for mark with a word portion including 4 words renders Applicant’s mark highly dissimilar in appearance from Registrant’s mark,” and that the “average purchaser will highly likely retain an impression of the distinctive features of the design of Applicant’s mark.” *Id.* The marks at issue in this decision are reproduced below and appear more similar than the marks at issue in this case.



TOGA

Not only do the marks look different because of the Cited Mark's distinctive design that is the dominant feature of that mark, but the literal elements are also completely different.

ST. GEORGE

SAINT GEORGE ATELIER

In fact the only shared term among the literal elements is the common name GEORGE. This cannot support a 2(d) refusal.

C. The Marks Also Sound Different

Applicant's Mark and the Cited Mark also sound different. *See, e.g., Rational Intell.*, 2023 WL 3918266, at *21 (as to the analysis of Spin & Go and Spin & Gold, holding that "while there is some overlap (the presence of the terms 'SPIN &', overall the marks are more dissimilar than similar, look and sound different, and convey very different meanings and commercial impressions. Confusion is therefore unlikely.").

Courts measure the "sound" and "auditory impressions" of a mark by examining the number of words and syllables employed. *See, e.g., A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 217 (3d Cir. 2000). **Here both the number of words and syllables are different.**

In similar cases, courts have found such differences sufficient to support a finding of no likelihood of confusion. *Horos v. Locol, LLC*, 2015 WL 12656946, at *7 (C.D. Cal. Feb. 11, 2015) ("the overall impression given by the marks is different. The first syllable is identical in sound, but the similarities stop there. "Loco'l" continues after the first syllable into a long "ohl" sound similar to that found at the end of alcohol compounds like ethanol or methanol. By contrast, "Locali" goes up to an "ah" sound and adds an additional, abrupt syllable: "li.").

This is especially true—like here—when any shared portion of the mark are, like here with the common name GEORGE, frequently found in third party use. *In Re Panavision, Inc.*, 183 U.S.P.Q. (BNA) ¶ 557 (T.T.A.B. Sept. 12, 1974) ("It appears to us that, if the addition of different suffixes to the highly suggestive term "ULTRA" is sufficient to distinguish one such mark from the other so as to preclude a likelihood of confusion, then the omission of a suffix or a prefix may also be sufficient to avoid a likelihood of confusion."); *In Re Nycomed Amersham Plc*, No. 5, 2002 WL 732137, at *2 (Apr. 23, 2002) ("in view of this highly suggestive nature of the prefix TOMO, we find the addition of the suffixes -JET and -SCAN adequate to make the marks TOMOJET and TOMOSCAN distinguishable one from the other. The marks as a whole differ in appearance and

sound.”); *Medi-Flex, Inc. v. Nice-Pak Products, Inc.*, 422 F.Supp.2d 1242, (D. Kan. 2006) (no likelihood of confusion found between CHLORAPREP and CHLORASCRUB where both marks were used for an antimicrobial solution used by medical professionals); *The Barash Co., Inc. v. Vitafoam Ltd.*, 155 U.S.P.Q. (BNA) ¶ 267 (T.T.A.B. Aug. 21, 1967) (“Considering the suggestiveness of “VITA” and the differences between the suffix portion of the marks here involved, it is concluded that there would be no likelihood of confusion or mistake when respondent's mark is applied to its goods.”).

D. The Marks Have Completely Different Meanings and Commercial Impressions

The use of similar, even dominant, elements in common does not necessarily mean that two marks are similar. *See General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 687 3 U.S.P.Q.2d 1442 (8th Cir. 1987) (holding defendant's OATMEAL RAISIN CRISP did not infringe plaintiff's APPLE RAISIN CRISP trademark when evaluating the total effect conveyed by both marks). Evaluating the similarity of appearance between trademarks is really nothing more than a subjective “eyeball” test to consider the overall impression of the mark as a whole, as opposed to comparing individual features of the marks. *See Exxon Corp. v. Texas Motor Exchange, Inc.*, 628 F.2d 500 (5th Cir. 1980).

Here, the Examiner suggests that Applicant's Mark “is confusingly similar to the registered mark...Both marks begin phonetically identical terms, which means that the marks initially sound and appear similar,” and “in the context of the respective clothing goods and services, the marks create a similar commercial impression of a saint named George.” Office Action at 3.

As a threshold matter, the portion of the mark identified by Examiner, ST. GEORGE, is inherently weak as it appears in registrations for similar goods and/or services as explained in detail in Section E *infra*.

Beyond the third-party use of ST. GEORGE that makes that term weak, Examiner errs by impermissible viewing both Applicant's and the Cited Marks piecemeal fashion—not in their entirety—and by ignoring the import of other parts of those Marks on their commercial impression.

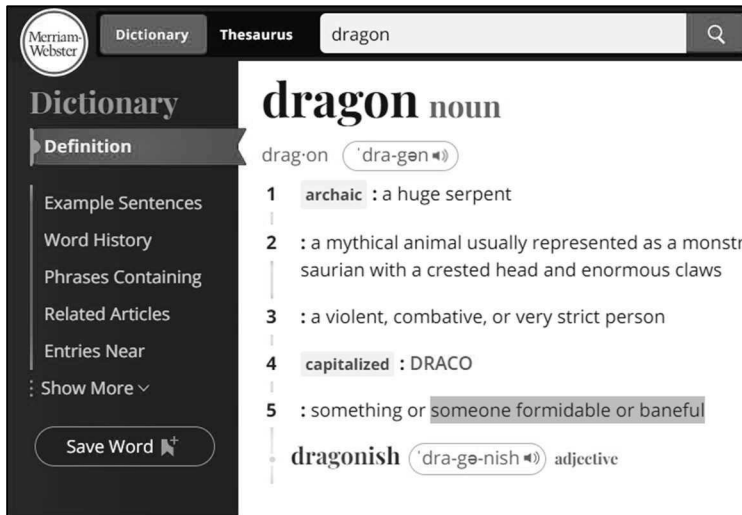
Here, the Cited Mark contains a highly distinctive design element that serves as the mark's dominant feature. This dominant feature thus forms the basis of the meaning and commercial impression of the Cited Mark. As shown in the evidence below, dragons carry very distinct meanings and symbolism. *See, e.g.*, <https://en.wikipedia.org/wiki/Dragon>.

They often connote strength.

Dragons are a big deal in Chinese culture. Whereas in the West dragons are often depicted as winged, fire-breathing monsters, the Chinese dragon, or the *loong*, is a symbol of strength and magnanimity. The mythical being is so revered that it snagged a spot as the only fictional creature in the Chinese Zodiac's divine roster. And the imagery pervades society today—whether in boats, dances, or the stars.

<https://time.com/6691804/china-dragons-symbolism-history-significance-new-year/>

Dragons also connote one who is formidable or combative.



<https://www.merriam-webster.com/dictionary/dragon>

These meanings form the commercial impression of the Cited Mark—which is completely different than the commercial impression of Applicant’s Mark discussed below.

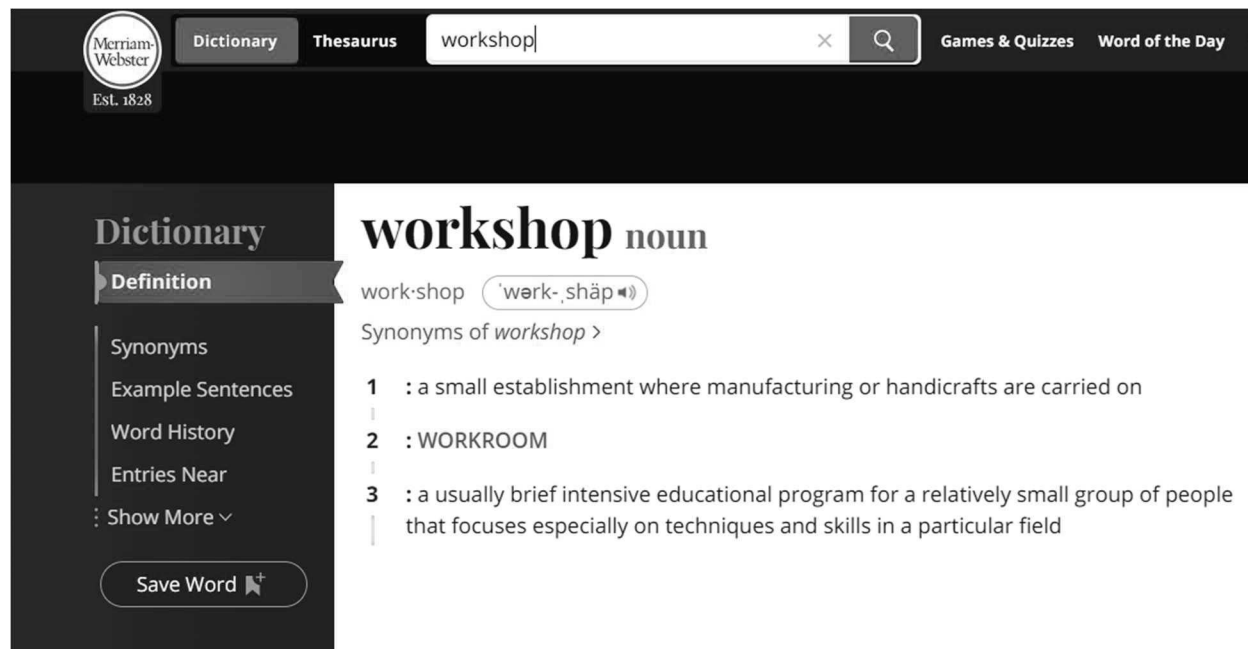
In sharp contrast to the Cited Mark, Applicant’s Mark does not have a Dragon—or any other design feature.

Applicant’s Mark, SAINT GEORGE ATELIER, when viewed in its entirety and not impermissibly dissected in piecemeal fashion includes the important and dominant term ATELIER. Atelier is a workshop.



<https://www.merriam-webster.com/dictionary/atelier>

Applicant’s Mark, therefore, has a commercial impression relating to and involving a workshop—which does not refer to Applicant’s workshop—which does not exist—but instead is sought to represent the quality of Applicant’s brand. Indeed, the definition of ‘workshop’ represents the essence of Applicant’s brand and its workshop quality.



<https://www.merriam-webster.com/dictionary/workshop>

As shown above, ‘workshop’ means, *inter alia*, a small group of people that focuses especially on techniques and skills in a particular field. *Id.* Applicant’s goods are being designed of workshop quality. Removing this word from the 2(d) analysis is not only improper under controlling authority, but also removes the essence of what the Applicant’s company is about which involved an entirely different commercial impression than that of Registrant.

The Board and courts throughout the country—including binding Federal Circuit decisions—have routinely found no likelihood of confusion when, like here, marks had different meaning and commercial impressions despite having some shared terms. *See, e.g., Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1461 (Fed. Cir. 1998) (affirming Board dismissal of opposition based on dissimilarity of the marks CRISTAL and CRYSTAL CREEK); *Kellogg Co. v. Pack'em*, 21 USPQ2d at 1142 (affirming Board dismissal of opposition based on dissimilarity of the marks FROOTEE ICE and elephant design and FRUIT LOOPS); *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386 (Fed. Cir. 1989) (affirming Board dismissal of opposition based on dissimilarity of the marks PECAN SANDIES and PECAN SHORTEES in commercial impression); *Stouffer Corp. v. Health Valley Nat. Foods Inc.*, 1 USPQ2d 1900, 1906 (TTAB 1986), *aff'd*, 831 F.2d 306 (Fed. Cir 1987) (“while the fame of opposer's mark and the identity of the parties' goods and their channels of trade tend to favor opposer’s case, we are not persuaded that these circumstances are sufficient to refuse registration to applicant in view of our finding that

LEAN CUISINE and LEAN LIVING, applied to the goods herein are not confusingly similar in sound, appearance or commercial impression”); *Rational Intell. Holdings Ltd.*, No. 91268260, 2023 WL 3918266, at *21 (May 31, 2023) (“While there is some overlap (the presence of the terms “SPIN &”, overall the marks are more dissimilar than similar, look and sound different, and convey very different meanings and commercial impressions. Confusion is therefore unlikely.”)

Accordingly, there can be no likelihood of confusion based on these completely different meanings and commercial impressions of the marks.

E. Third-Party Use of Similar Marks on Similar Goods Belies Confusion

The Office Action’s finding of a likelihood of confusion is also fully refuted by the number of similar third-party marks in use on similar goods and services.

Evidence of third-party use of similar marks on similar goods and services is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection. *Spireon v. Flex*, 2023 USPQ2d 737, at *4 (the sixth DuPont factor “is a measure of the extent to which other marks weaken the assessed mark”) (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369 (Fed. Cir. 2005)).

“Third-party registration evidence that does not equate to proof of third-party use may bear on conceptual weakness if a term is commonly registered for similar goods or services.” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1075 (TTAB 2017). These registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used with respect to the goods or services at issue that it leads to the conclusion that the mark or portion thereof is relatively weak. *See, e.g., Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363 (Fed. Cir. 2015). Evidence of third-party use of similar marks for similar services “can show that customers have been educated to distinguish between different marks on the basis of minute distinctions.” *Id.* (citation omitted). Extensive evidence of third-party use and registration is “powerful on its face.” *Id.*, 116 USPQ2d at 1136; *see also J. Thomas McCarthy, 2 McCarthy on Trademarks and Unfair Competition* § 11:88 (4th ed. 2001) (hereinafter McCarthy on Trademarks); *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030 (TTAB 2016) (weakness found based on actual uses of ROSE-formative marks for similar services, similar third-party registrations, expert testimony and other evidence regarding the common nature of ROSE-formative marks in the industry, and testimony by opposer that it did not vigorously enforce its mark); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996) (multiple sources of use corroborate that third-party use is extensive); *Anthony’s Pizza & Pasta Int’l Inc. v. Anthony’s Pizza Holding Co.*, 95 USPQ2d 1271, 1278 (TTAB 2009).

Here, the Examiner’s 2(d) refusal ostensibly rests on the term GEORGE and the terms ST. and SAINT. But Applicant hereby identifies similar marks for similar goods and services all of which include the words ST. GEORGE, SAINT GEORGE OR GEORGE for Classes 25 and 35. This includes previously registered marks that have since become abandoned for lack of maintenance.

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,084,817

United States Patent and Trademark Office

Registered July 29, 1997

**TRADEMARK
PRINCIPAL REGISTER**

ALLYN SAINT GEORGE AMERICAN SPORT

ALLYN ST. GEORGE INTERNATIONAL, INC.
(NEW JERSEY CORPORATION)
110 LAIRD ROAD
COLTS NECK, NJ 07722

FOR: MEN'S APPAREL, NAMELY, SUITS,
SPORT COATS, SLACKS, SHIRTS, IN CLASS 25
(U.S. CLS. 22 AND 39).

FIRST USE 4-7-1997; IN COMMERCE
4-7-1997.

OWNER OF U.S. REG. NOS. 1,120,592,
1,789,462, AND OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "AMERICAN SPORT", APART
FROM THE MARK AS SHOWN.

THE NAME, "ALLYN SAINT GEORGE", IS
THE SOBRIQUET OF "GEORGE ALLYN", A
LIVING INDIVIDUAL WHOSE CONSENT IS
OF RECORD.

SN 75-028,902, FILED 12-4-1995.

ANGELA M. MICHELI, EXAMINING ATTOR-
NEY

<https://tsdr.uspto.gov/documentviewer?caseId=sn75028902&docId=ORC20070308094418&linkId=17#docIndex=16&page=1>

United States of America
United States Patent and Trademark Office

GEORGE

Reg. No. 5,932,203

Wal-Mart Stores Inc. (DELAWARE CORPORATION)
702 Sw 8th Street

Registered Dec. 10, 2019

Bentonville, ARKANSAS 72716

Int. Cl.: 14

CLASS 14: Watches

Trademark

FIRST USE 5-00-2019; IN COMMERCE 5-00-2019

Principal Register

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

SER. NO. 86-651,975, FILED 06-04-2015

<https://tsdr.uspto.gov/documentviewer?caseId=sn86651975&docId=ORC20191127145230&linkId=1#docIndex=0&page=1>

Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office

Reg. No. 1,240,416

Registered May 31, 1983

TRADEMARK
Principal Register



Allyn St. George International, Inc. (New Jersey
corporation)
19 Collingwood Rd.
Marlboro, N.J. 07746

For: NECKWEAR, in CLASS 25 (U.S. Cl. 39).
First use May 10, 1979; in commerce Jul. 25, 1979.
Owner of U.S. Reg. No. 1,120,592.

Ser. No. 274,216, filed Aug. 13, 1980.

MARY COYLE, Examining Attorney

Canceled for failure to comply with maintenance.

<https://tsdr.uspto.gov/documentviewer?caseId=sn73274216&docId=ORC20051202154248&linkId=1#docIndex=0&page=1>

Int. Cl.: 18

Prior U.S. Cls.: 3 and 13

United States Patent and Trademark Office

Reg. No. 1,243,655

Registered Jun. 28, 1983

TRADEMARK
Principal Register

ST. GEORGE

Allyn St. George International, Inc. (New Jersey
corporation)
19 Collingwood Rd.
Marlboro, N.J. 07746

For: LEATHER GOODS—NAMELY, WAL-
LETS AND KEY CASES, in CLASS 18 (U.S. Cls. 3
and 13).

First use May 1981; in commerce Aug. 1981.

Owner of U.S. Reg. Nos. 1,120,592, 1,198,823 and
others.

Ser. No. 359,990, filed Apr. 15, 1982.

MARY COYLE, Examining Attorney

Canceled for failure to comply with maintenance.

<https://tsdr.uspto.gov/documentviewer?caseId=sn73359990&docId=ORC20051203065824&linkId=1#docIndex=0&page=1>

United States of America

United States Patent and Trademark Office



Reg. No. 4,273,544

Registered Jan. 8, 2013

Int. Cl.: 25

TRADEMARK

PRINCIPAL REGISTER

SAINT GEORGE ABBO, LLC (DELAWARE LIMITED LIABILITY COMPANY)
SUITE 200
1000 5TH STREET
MIAMI, FL 33139

FOR: MEN'S AND WOMEN'S FOOTWEAR; MEN'S AND WOMEN'S APPAREL, NAMELY, SHIRTS, PANTS, SKIRTS, SWEATERS, SHORTS, SLEEPWEAR AND SWIMSUITS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 10-0-2011; IN COMMERCE 10-0-2011.

THE MARK CONSISTS OF THE FIGURE OF A MOUNTED KNIGHT WITH A SHIELD SLAYING A DRAGON, ALL WITHIN CONCENTRIC CIRCLES CONSISTING OF BROKEN LINES WHEREIN THE WORDS "SAINT GEORGE ABBO" AND TWO STARS APPEAR IN THE SPACE BETWEEN THE TWO CIRCLES.

SN 85-978,159, FILED 10-17-2011.

JAMES LOVELACE, EXAMINING ATTORNEY



Canceled for failure to comply with maintenance.

<https://tsdr.uspto.gov/documentviewer?caseId=sn85978159&docId=ORC20130108010729&linkId=2#docIndex=1&page=1>

Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office

Reg. No. 1,789,462
Registered Aug. 24, 1993

**TRADEMARK
PRINCIPAL REGISTER**



ALLYN ST. GEORGE INTERNATIONAL, INC.
(NEW JERSEY CORPORATION)
110 LAIRD ROAD
COLTS NECK, NJ 07722

FOR: MEN'S TAILORED CLOTHING;
NAMELY, SUITS, SPORT COATS AND
SLACKS, IN CLASS 25 (U.S. CL. 39).

FIRST USE 1-8-1991; IN COMMERCE
1-8-1991.

OWNER OF U.S. REG. NOS. 1,120,592, 1,356,762
AND OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "AMERICAN COUTURE",
APART FROM THE MARK AS SHOWN.

THE DRAWING OF THE MARK IS LINED
FOR THE COLOR YELLOW.

"ALLYN SAINT GEORGE" DOES NOT
IDENTIFY A PARTICULAR LIVING INDIVID-
UAL.

SER. NO. 74-216,200, FILED 10-28-1991.

MICHAEL HICKS, EXAMINING ATTORNEY

Canceled for failure to comply with maintenance.

<https://tsdr.uspto.gov/documentviewer?caseId=sn74216200&docId=ORC20070917112153&linkId=10#docIndex=9&page=1>

Int. Cl.: 25

Prior U.S. Cl.: 22

United States Patent Office

Reg. No. 1,052,676
Registered Nov. 9, 1976

TRADEMARK
Principal Register



San GIORGIO

Calzaturificio "San Giorgio" di Bittante S.a.S. (Italian
limited partnership)
Coste di Maser, Treviso, Italy

For: SKI BOOTS, in CLASS 22 (INT. CL. 25).

The English translation of the Italian words "San Giorgio" is "Saint George." The drawing is not lined for color. The horizontal lines appear merely as part of the design.

Priority claimed under Sec. 44(d) on Italian application filed Apr. 15, 1971; Reg. No. 253,220, dated Aug. 4, 1971.

Ser. No. 400,632, filed Aug. 20, 1971.

Canceled for failure to comply with maintenance.

<https://tsdr.uspto.gov/documentviewer?caseId=sn72400682&docId=ORC20051122123903&linkId=1#docIndex=0&page=1>

Int. Cls.: 14, 18, 25 and 28

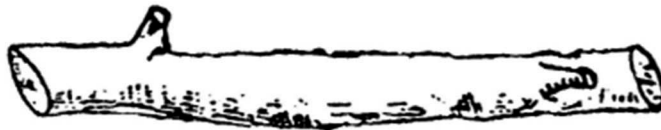
Prior U.S. Cls.: 1, 2, 3, 22, 23, 27, 28, 38, 39, 41
and 50

United States Patent and Trademark Office

Reg. No. 1,940,544

Registered Dec. 12, 1995

**TRADEMARK
PRINCIPAL REGISTER**



G E O R G E

GEORGE COMPANY, THE (PARTNERSHIP)
3315 SACRAMENTO STREET, # 608
SAN FRANCISCO, CA 94118

FOR: PET COLLAR MEDALLIONS AND
CHARMS, IN CLASS 14 (U.S. CLS. 2, 27, 28 AND
50).

FIRST USE 10-1-1991; IN COMMERCE
10-1-1991.

FOR: PET COLLARS, PET CUSHIONS,
ANIMAL CARRIERS, AND PET CLOTHING,
NAMELY HATS, T-SHIRTS, JACKETS AND
RAINCOATS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22
AND 41).

FIRST USE 10-1-1991; IN COMMERCE
10-1-1991.

FOR: CLOTHING FOR PEOPLE, NAMELY
HATS, T-SHIRTS, JACKETS AND RAINCOATS,
IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 10-1-1991; IN COMMERCE
10-1-1991.

FOR: PET TOYS, IN CLASS 28 (U.S. CLS. 22,
23, 38 AND 50).

FIRST USE 10-1-1991; IN COMMERCE
10-1-1991.

SER. NO. 74-521,763, FILED 5-2-1994.

THOMAS V. SHAW, EXAMINING ATTORNEY

Canceled for failure to comply with maintenance.

<https://tsdr.uspto.gov/documentviewer?caseId=sn74521763&docId=ORC20070614090057&linkId=10#docIndex=9&page=1>

F. Differences in Goods, Services and Respective Trade Channels and Consumers

Beyond the differences in the Marks' appearance, sound, meaning and commercial impressions, and aside from the vast third party of similar marks, there is also a difference in the respective goods and services.

In the 2(d) analysis, goods and services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71 (Fed. Cir. 2012). This “relatedness of the goods” factor compares the goods and services in the application with the goods and services in the registration. *Morrow*, 708 at 1581 (Fed. Cir. 1983). In considering the similarity of the goods and services offered under two marks, the inquiry must focus on the relation of the goods and services in the minds of consumers. (*Packard Press, Inc. v. HewlettPackard, Inc.*, 227 F.3d 1352, 1358 (Fed. Cir. 2000).

Confusion is not necessarily likely simply because the goods or services can be described as being in the same category or field. *Therma-scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623 (6th Cir. 2002). Indeed, “[g]oods [and services] may fall under the same general product category but operate in **distinct niches**,” thereby avoiding confusion. *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, 269 F.3d 270, 288 (3d Cir. 2001) (emphasis added).

Goods may fall under the same general product category but operate in distinct niches as is the case here. When two products are part of distinct sectors of a broad product category, they can be sufficiently unrelated that consumers are not likely to assume the products originate from the same mark. *See, e.g., Commerce Nat'l Ins. Servs., Inc.*, 214 F.3d at 441 (holding marks held by company operating in banking industry and company operating in insurance industry did not create consumer confusion because the two companies were involved in distinct highly regulated industries); *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206–07 (1st Cir.1983) (finding no product similarity in medical technology sold to different departments in hospital because “ ‘the hospital community’ is not a homogeneous whole, but is composed of separate departments with diverse purchasing requirements, which, in effect, constitute different markets for the parties’ respective products.”); *Harlem Wizards Entm't. Basketball, Inc. v. NBA Props., Inc.*, 952 F. Supp. 1084, 1096 (D.N.J. 1997) (finding no product similarity between professional competitive basketball team and “show basketball” team).

Here, the customers for Applicant and Registrant are in vastly different niches.

Registrant appears to be using a related unregistered mark—and not the Cited Mark—for woman's basics and intimate wear. *See* <https://us.brandymelville.com/>

In contrast, Applicant's Mark is used in connection with an online store that sells bags and clothing, as well as certain clothing.

Registrant and Applicant operate in distinct niches and there will be no likelihood of confusion between the marks.

III. ARGUMENT Part 2 – A Disclaimer Should Not Be Required

The Examiner has also issued a disclaimer requirement for the literal element ATELIER, suggesting that the term “is merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of applicant’s goods and/or services.” Office Action at 5.

A term is “merely descriptive” within the meaning of Section 2(e)(1) if it “immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297 (Fed. Cir. 2012) (emphasis added). “On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.” *In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978); *see also In re Shutts*, 217 USPQ 363, 364-65 (TTAB 1983); *In re Universal Water Sys., Inc.*, 209 USPQ 165, 166 (TTAB 1980).

A term is only descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the products or services it identifies. *In re Gyulay*, 820 F.2d 1216 (Fed. Cir. 1987); *In Re Yz Enterprises, Inc.*, No. 75/262,976, 2000 WL 1125563, at *2 (TTAB July 28, 2000) (“because BRANTREATS does not immediately describe the nature of applicant's goods, it is not merely descriptive thereof.”). Simply put, the operative question is whether someone who knows what the products or services are will understand the mark immediately to convey information about them. *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003).

The perception of the relevant purchasing public sets the standard for determining descriptiveness. A mark is only descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service. On the other hand, if a mark requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods or services, then the mark is suggestive—not descriptive. *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). Thus, if a consumer requires some additional cognition to connect the mark with a quality, feature, function, or characteristic of the goods or services, the mark cannot be descriptive. *In Re Dune Med. Devices Ltd.*, No. 77377330, 2011 WL 1495445, at *5 (TTAB Mar. 31, 2011) (“applicant appears to have coined a somewhat nebulous term whose meaning would not be grasped without some cogitation...[t]hat is, when viewed in connection with applicant's goods, we find that MARGINPROBE does not immediately evoke a descriptive function or characteristic of the product.”). *Id.*; *In Re Elkay Plastics Co., Inc.*, No. 88573025, 2021 WL 252689, at *2 (TTAB Jan. 8, 2021). Whether a particular term is merely descriptive is determined in relation to the goods or services for which registration is sought and the context in which the term is used. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002).

The portion at issue of Applicant’s Literal Element, ATELIER, does not immediately convey the requisite quality, feature, function or characteristics of the Recited Services. For this reason alone, Applicant’s Mark is not descriptive.

The Examiner’s descriptive refusal rests solely on the following argument: “[t]he attached evidence from Merriam-Webster Dictionary shows this wording means "workshop,” and “[t]hus, the wording merely describes applicant’s goods and/or services because it immediately describes applicant's goods and services, in that applicant's workshop provides and sells clothing.”).

But the Office Action does not offer any actual evidence supporting the required showing that ATELIER immediately informs a consumer quality, feature, function or characteristics of the Recited Services.

Here, the Recited Services of Applicant’s Mark are:

| | |
|---|--------------------------------|
| For: Clothing, namely, shirts, pants, tee shirts, sweaters, sweatshirts, sweatpants, socks, shoes, sneakers, boots, sandals, jackets, coats, vests, hats and caps | |
| International Class(es): 025 - Primary Class | U.S Class(es): 022, 039 |
| Class Status: ACTIVE | |
| Basis: 1(a) | |
| First Use: Mar. 22, 2023 | Use in Commerce: Apr. 02, 2023 |
| For: On-line retail store services featuring clothing | |
| International Class(es): 035 - Primary Class | U.S Class(es): 100, 101, 102 |
| Class Status: ACTIVE | |
| Basis: 1(a) | |
| First Use: Mar. 22, 2023 | Use in Commerce: Apr. 02, 2023 |

It is unclear from the Office Action, and remains unclear, how the term ATELIER immediately informs consumers of a quality, feature, function or characteristics of either: (1) Clothing, namely, shirts, pants, tee shirts, sweaters, sweatshirts, sweatpants, socks, shoes, sneakers, boots, sandals, jackets, coats, vests, hats and caps; or (2) On-line retail store services featuring clothing.

The Office Action itself confirms that one requires imagination, thought, and perception to take the subject term ATELIER and arrive at the qualities or characteristics of the goods and services. Indeed, the Office Action states “[t]hus, the wording merely describes applicant’s goods and/or services because it immediately describes applicant's goods and services, **in that applicant's workshop provides and sells clothing.**” Office Action at 5 (emphasis added).

As a threshold matter, there is no evidence to demonstrate that ATELIER immediately informs consumers that “Applicant’s workshop provides and sells clothing.”

Moreover, the Examiner is factually incorrect as the Applicant does not have a workshop. CITE.

And last but not least, a workshop is diametrically opposed to Class 035 for online retail stores featuring clothing. Simply put, an online store is not a workshop.

Because consumers here require some additional cognition to subject term with the mark with a quality, feature, function, or characteristic of the goods or services, the mark cannot be descriptive and no disclaimer is needed.

Notably, the PTO has previously allowed numerous marks proceed to registration without having to disclaimer ATELIER or allowing a mark having only the word ATELIER to register.¹

United States of America
United States Patent and Trademark Office

Lotus Atelier

Reg. No. 7,130,244

Registered Aug. 08, 2023

Int. Cl.: 35

Service Mark

Principal Register

Lotus Atelier, LLC (MASSACHUSETTS LIMITED LIABILITY COMPANY)
80 Lexington Rd
Lincoln, MASSACHUSETTS 01773

CLASS 35: On-line retail store services featuring home decor

FIRST USE 9-1-2021; IN COMMERCE 10-1-2021

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

SER. NO. 97-334,250, FILED 03-28-2022

¹ Applicant is prepared to supplement with even further evidence of such registrations as needed.

United States of America
United States Patent and Trademark Office

CHEFS ATELIER

Reg. No. 6,434,854

Registered Jul. 27, 2021

Int. Cl.: 21

Trademark

Principal Register

Ross Stores, Inc. (DELAWARE CORPORATION)
5130 Hacienda Drive
Dublin, CALIFORNIA 94568

CLASS 21: Mortar and pestle for kitchen use; citrus squeezers; citrus juicers, namely, lemon squeezers; ice cube trays; potato ricers; dinnerware, namely, plates, bowls; pot holders; oven mitts

FIRST USE 2-00-2016; IN COMMERCE 2-00-2016

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

SER. NO. 87-888,628, FILED 04-23-2018

<https://tsdr.uspto.gov/documentviewer?caseId=sn87888628&docId=ORC20210711032909&linkId=1#docIndex=0&page=1>

United States of America

United States Patent and Trademark Office

BRAND ATELIER

Reg. No. 5,892,217

Registered Oct. 22, 2019

Int. Cl.: 35, 45

Service Mark

Principal Register

Brand Atelier, LLC (TENNESSEE LIMITED LIABILITY COMPANY)
5120 Dale Ewing Road
Franklin, TENNESSEE 370640700

CLASS 35: Marketing consulting, and brand imagery consulting and management services

FIRST USE 5-1-2018; IN COMMERCE 5-1-2018

CLASS 45: Consulting in the field of intellectual property licensing

FIRST USE 5-1-2018; IN COMMERCE 5-1-2018

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

No claim is made to the exclusive right to use the following apart from the mark as shown:
"BRAND"

SER. NO. 87-908,089, FILED 05-04-2018

<https://tsdr.uspto.gov/documentviewer?caseId=sn87908089&docId=ORC20191006034504&linkId=1#docIndex=0&page=1>

United States of America
United States Patent and Trademark Office

ATELIER

Reg. No. 4,306,461

Registered Mar. 19, 2013

Int. Cl.: 27

TRADEMARK

PRINCIPAL REGISTER

STANTON CARPET CORP. (NEW YORK CORPORATION)
211 ROBBINS LANE
SYOSSET, NY 11791

FOR: CARPETS AND RUGS, IN CLASS 27 (U.S. CLS. 19, 20, 37, 42 AND 50).

FIRST USE 8-24-2012; IN COMMERCE 8-30-2012.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 2,661,319.

SN 85-517,694, FILED 1-17-2012.

IRA J. GOODSID, EXAMINING ATTORNEY



Lisa Stuart
Acting Director of the United States Patent and Trademark Office

<https://tsdr.uspto.gov/documentviewer?caseId=sn85517694&docId=ORC20130319003725&linkId=11#docIndex=10&page=1>

United States of America
United States Patent and Trademark Office

Atelier Cuisine

Reg. No. 6,374,639

Registered Jun. 01, 2021

Int. Cl.: 29

Trademark

Principal Register

Creative Culinary Concepts, Inc (CALIFORNIA CORPORATION)
512 30th Street
Newport Beach, CALIFORNIA 92663

CLASS 29: Sauces; Salad dressing; Spices; Chutney; Marinades; Bakery desserts; Dry seasoning mixes for gravy, stews, sauces, dressings, broths, stocks and soups

FIRST USE 2-1-2021; IN COMMERCE 2-1-2021

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

No claim is made to the exclusive right to use the following apart from the mark as shown: "CUISINE"

SER. NO. 90-075,053, FILED 07-27-2020

<https://tsdr.uspto.gov/documentviewer?caseId=sn90075053&docId=ORC20210516045537&linkId=1#docIndex=0&page=1>

United States of America

United States Patent and Trademark Office

Atelier Cologne

Reg. No. 5,410,803

L'Oreal (FRANCE société anonyme (sa))
14 Rue Royale

Registered Feb. 27, 2018

Paris, FRANCE 75008

Int. Cl.: 3, 4

CLASS 3: perfumery products namely, perfumes, toilet waters, perfumed milks and gels for the body and face, perfumed hand creams, non-medicated soaps

Trademark

FIRST USE 1-1-2010; IN COMMERCE 1-1-2010

Principal Register

CLASS 4: candles and scented candles

FIRST USE 1-1-2010; IN COMMERCE 1-1-2010

The mark consists of the wording "ATELIER COLOGNE" in stylized form.

OWNER OF U.S. REG. NO. 3945981

No claim is made to the exclusive right to use the following apart from the mark as shown:
"COLONGE"

SEC.2(F)

SER. NO. 87-408,193, FILED 04-12-2017

<https://tsdr.uspto.gov/documentviewer?caseId=sn87408193&docId=ORC20180211023506&linkId=2#docIndex=1&page=1>

United States of America
United States Patent and Trademark Office

Atelier Health

Reg. No. 6,391,298
Registered Jun. 15, 2021
Int. Cl.: 5
Trademark
Principal Register

Atelier Health Solutions (NEW YORK LIMITED LIABILITY COMPANY)
437 Tennyson Drive
Second Floor
Staten Island, PENNSYLVANIA 10312

CLASS 5: Disinfecting wipes

FIRST USE 3-1-2021; IN COMMERCE 3-1-2021

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

No claim is made to the exclusive right to use the following apart from the mark as shown: "HEALTH"

SER. NO. 90-111,425, FILED 08-13-2020

<https://tsdr.uspto.gov/documentviewer?caseId=sn90111425&docId=ORC20210530050439&linkId=1#docIndex=0&page=1>

United States of America

United States Patent and Trademark Office

CHEFS ATELIER

Reg. No. 5,292,574

Registered Sep. 19, 2017

Int. Cl.: 9

Trademark

Principal Register

Ross Stores, Inc. (DELAWARE CORPORATION)
5130 Hacienda Drive
Dublin, CA 94568

CLASS 9: Measuring cups

FIRST USE 11-00-2015; IN COMMERCE 11-00-2015

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

SER. NO. 87-133,580, FILED 08-10-2016
APRIL ANNE HESIK, EXAMINING ATTORNEY

<https://tsdr.uspto.gov/documentviewer?caseId=sn87133580&docId=ORC20170905012434&linkId=5#docIndex=4&page=1>

United States of America

United States Patent and Trademark Office

CHEFS ATELIER

Reg. No. 6,428,660

Registered Jul. 20, 2021

Int. Cl.: 24

Trademark

Principal Register

Ross Stores, Inc. (DELAWARE CORPORATION)
5130 Hacienda Drive
Dublin, CALIFORNIA 94568

CLASS 24: kitchen towels

FIRST USE 11-00-2017; IN COMMERCE 11-00-2017

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

SER. NO. 88-011,662, FILED 06-22-2018

<https://tsdr.uspto.gov/documentviewer?caseId=sn88011662&docId=ORC20210704040958&linkId=1#docIndex=0&page=1>

United States of America

United States Patent and Trademark Office

Atelier Series

Reg. No. 3,754,198 B&M Noble Co. (CALIFORNIA CORPORATION)
8480 Miralani Drive
Registered Mar. 02, 2010 San Diego, CALIFORNIA 92126
Corrected Apr. 10, 2018 CLASS 19: Flooring; namely, engineered and solid hardwood flooring
Int. Cl.: 19 FIRST USE 6-1-2008; IN COMMERCE 6-1-2008
Trademark THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR
Principal Register No claim is made to the exclusive right to use the following apart from the mark as shown:
"SERIES"
SER. NO. 77-772,324, FILED 07-01-2009

<https://tsdr.uspto.gov/documentviewer?caseId=sn77772324&docId=URC20180325060055&linkId=6#docIndex=5&page=1>

IV. CONCLUSION

Because Applicant's Mark and the Cited Mark look and sound completely different—and have different meanings and create significantly different commercial impressions, the marks are not likely to cause confusion. Further, the Applicant's Mark and Cited Mark are directed towards different customers in different niches. And the third party use of similar marks on similar goods further weighs against a 2(d) refusal. Lastly, because the term ATELIER is not descriptive of the Recited Goods and Services, a disclaimer is not needed. For the reasons set forth above, Applicant respectfully requests that the Examiner withdraw the refusals.

APPENDIX B

For brevity the Office Actions are produced without attachments. The full records are available at TSDR

To: Todd Noshier(tnoshier@mblawfirm.com)
Subject: U.S. Trademark Application Serial No. 98044168 - SAINT GEORGE ATELIER - - 223051891499
Sent: March 08, 2024 11:37:24 AM EST
Sent As: tmng.notices@uspto.gov

Attachments

6489343

screenshot-www-merriam-webster-com-dictionary-atelier-17099139035421

United States Patent and Trademark Office (USPTO) Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 98044168

Mark: SAINT GEORGE ATELIER

Correspondence Address:

Todd Noshier
Mandelbaum Barrett PC
570 Lexington Avenue, 21st Floor
New York NY 10022
United States

Applicant: SAINT GEORGE ATELIER LLC

Reference/Docket No. 223051891499

Correspondence Email Address: tnoshier@mblawfirm.com

NONFINAL OFFICE ACTION

Response deadline. File a response to this nonfinal Office action within three months of the “Issue date” below to avoid abandonment of the application. Review the Office action and respond using one of the links to the appropriate electronic forms in the “How to respond” section below.

Request an extension. For a fee, applicant may request one three-month extension of the response deadline prior to filing a response. The request must be filed within three months of the “Issue date” below. If the extension request is granted, the USPTO must receive applicant’s response to this letter within six months of the “Issue date” to avoid abandonment of the application.

Issue date: March 8, 2024

Introduction

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

Summary of Issues

- Section 2(d) - Likelihood of Confusion Refusal
- Disclaimer Required

Section 2(d) - Likelihood of Confusion Refusal

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 6489343. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

Applicant has applied to register the mark SAINT GEORGE ATELIER in standard characters for:

International Class 025: Clothing, namely, shirts, pants, tee shirts, sweaters, sweatshirts, sweatpants, socks, shoes, sneakers, boots, sandals, jackets, coats, vests, hats and caps

International Class 035: On-line retail store services featuring clothing

Registrant’s mark is ST. GEORGE with a design for “Clothing, namely, t-shirts, tank tops, sweatshirts, and sweatpants” in International Class 025.

Similarity of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321,

110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

Here, applicant’s mark, SAINT GEORGE ATELIER, is confusingly similar to the registered mark, ST. GEORGE. Both marks begin phonetically identical terms, which means that the marks initially sound and appear similar. Moreover, in the context of the respective clothing goods and services, the marks create a similar commercial impression of a saint named George.

The fact applicant's mark also contains additional wording does not diminish the confusing nature of the marks. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). Matter that is descriptive of or generic for a party’s goods and/or services is typically less significant or less dominant in relation to other wording in a mark. *See Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)).

In the present case, the wording ATELIER in the applied-for mark is merely descriptive of or generic for applicant’s goods and/or services and applicant is required to disclaim the wording (see discussion below). Thus, this wording is less significant in terms of affecting the mark’s commercial impression, and renders the wording SAINT GEORGE the more dominant element of the mark. Thus, because the dominant element in applicant's mark is phonetically equivalent to the entirety of registrant's mark, the marks create an overall similar commercial impression.

Further, the fact that registrant's mark contains a design does not change the overall commercial impression for purposes of Section 2(d). When evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods and/or services. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983)); *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *41 (TTAB 2022) (quoting *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *31 (TTAB 2021)); TMEP §1207.01(c)(ii). Thus, although marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Because the marks look and sound similar and create the same commercial impression, the marks are considered similar for likelihood of confusion purposes.

Relatedness of the Goods and/or Services

The goods and/or services are compared to determine whether they are similar, commercially related,

or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

The compared goods and/or services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i); *see Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *44 (TTAB 2022) (quoting *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006)).

Here, applicant’s goods and/or services, “Clothing, namely, shirts, pants, tee shirts, sweaters, sweatshirts, sweatpants, socks, shoes, sneakers, boots, sandals, jackets, coats, vests, hats and caps” and “On-line retail store services featuring clothing” are closely related to registrant’s goods and/or services, “Clothing, namely, t-shirts, tank tops, sweatshirts, and sweatpants.”

As an initial matter regarding applicant's "Clothing, namely, shirts, pants, tee shirts, sweaters, sweatshirts, sweatpants, socks, shoes, sneakers, boots, sandals, jackets, coats, vests, hats and caps" and registrant's "Clothing, namely, t-shirts, tank tops, sweatshirts, and sweatpants", decisions regarding likelihood of confusion in the clothing field have found many different types of apparel to be related. *Cambridge Rubber Co. v. Cluett, Peabody & Co.*, 286 F.2d 623, 624, 128 USPQ 549, 550 (C.C.P.A. 1961) (women’s boots related to men’s and boys’ underwear); *Gen. Shoe Corp. v. Hollywood-Maxwell Co.*, 277 F.2d 169, 169-70, 125 USPQ2d 443, 443-4 (C.C.P.A. 1960) (shoes and hosiery related to brassieres); *In re Embiid*, 2021 USPQ2d 577, at *29-30 (TTAB 2021) (shoes related to shirts and sweat shirts); *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1236 (TTAB 1992) (underwear related to neckties); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (women’s pants, blouses, shorts and jackets related to women’s shoes); *In re Pix of Am., Inc.*, 225 USPQ 691, 691-92 (TTAB 1985) (women’s shoes related to outer shirts); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 398-99 (TTAB 1982) (hosiery related to trousers); *In re Cook United, Inc.*, 185 USPQ 444, 445 (TTAB 1975) (men’s suits, coats, and trousers related to ladies’ pantyhose and hosiery); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400, 404 (TTAB 1964) (brassieres and girdles related to slacks for men and young men).

In comparing the remaining services that are neither identical nor legally identical, the following goods are similar in kind, complementary, or interrelated: On-line retail store services featuring clothing

As to these services in the application, it is not necessary to prove relatedness as to each activity listed in the description of services in International Class 035 in this application. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any service encompassed by the identification in a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (C.C.P.A. 1981); *see In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015); *Apple Comput. v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

Accordingly, the goods and/or services are considered related for purposes of the likelihood of confusion analysis.

Conclusion

Because the marks are similar and the goods and/or services are related, there is a likelihood of confusion as to the source of applicant's goods and/or services, and registration is refused pursuant to Section 2(d) of the Trademark Act.

Response Options to Refusals

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Disclaimer Required

Applicant must disclaim the wording "ATELIER" because it is merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods and/or services. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); TMEP §§1213, 1213.03(a).

The attached evidence from *Merriam-Webster Dictionary* shows this wording means "workshop". Thus, the wording merely describes applicant's goods and/or services because it immediately describes applicant's goods and services, in that applicant's workshop provides and sells clothing.

Applicant may respond to this issue by submitting a disclaimer in the following format:

No claim is made to the exclusive right to use "ATELIER" apart from the mark as shown.

For an overview of disclaimers and instructions on how to provide one using the Trademark Electronic Application System (TEAS), see the Disclaimer webpage.

Response Guidelines

Response guidelines. For this application to proceed, applicant must explicitly address each refusal and/or requirement in this Office action. For a refusal, applicant may provide written arguments and evidence against the refusal, and may have other response options if specified above. For a requirement, applicant should set forth the changes or statements. Please see the Responding to Office Actions webpage for more information and tips on responding.

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. *See* TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

How to respond. File a **response form to this nonfinal Office action** or file a **request form for an extension of time to file a response**.

/Eddie Nolasco Arias/
Eddie Nolasco Arias
Examining Attorney
LO-116 -- Law Office 116
(571) 270-0943
Kenneth.Nolasco-Arias@uspto.gov

RESPONSE GUIDANCE

- **Missing the deadline for responding to this letter will cause the application to abandon.** A response or extension request must be received by the USPTO before 11:59 p.m. **Eastern Time** of the last day of the response deadline. Trademark Electronic Application System (TEAS) system availability could affect an applicant's ability to timely respond. For help resolving technical issues with TEAS, email TEAS@uspto.gov.
- **Responses signed by an unauthorized party** are not accepted and can **cause the application to abandon**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant. If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find contact information for the supervisor** of the office or unit listed in the signature block.

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on March 8, 2024 for
U.S. Trademark Application Serial No. 98044168

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action to avoid your application abandoning. Follow the steps below.

- (1) **Read the Office action.** This email is NOT the Office action.
- (2) **Respond to the Office action by the deadline** using the Trademark Electronic Application System (TEAS). Your response, or extension request, must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response deadline. Otherwise, your application will be abandoned. See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO website, the application process, the status of your application, and whether there are outstanding deadlines to the Trademark Assistance Center (TAC).

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

GENERAL GUIDANCE

- **Check the status of your application periodically** in the Trademark Status & Document Retrieval (TSDR) database to avoid missing critical deadlines.
- **Update your correspondence email address** to ensure you receive important USPTO notices about your application.
- **Beware of trademark-related scams.** Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. Verify the correspondence originated from us by using your serial number in our database, TSDR, to confirm that it appears under the “Documents” tab, or contact the Trademark Assistance Center.
- **Hiring a U.S.-licensed attorney.** If you do not have an attorney and are not required to

have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.

To: Lucian C. Chen(lchen@mblawfirm.com)
Subject: U.S. Trademark Application Serial No. 98044168 - SAINT GEORGE ATELIER - - 223051891499
Sent: April 09, 2024 03:04:32 PM EDT
Sent As: tmng.notices@uspto.gov

Attachments

screenshot-www-nike-com-w-womens-clothing-5e1x6z6ymx6-17126874282511
screenshot-www-reebok-com-c-200000003-men-clothing-17126875039731
screenshot-www-asos-com-us-men-17126875637461
screenshot-www-underarmour-com-en-us-c-mens-clothing-tops-17126876275851
screenshot-www-underarmour-com-en-us-c-mens-clothing-bottoms-17126876680811
screenshot-en-wiktionary-org-wiki-atelier-17126880979081
screenshot-www-atelierboutiques-com-service-about-17126889898051
screenshot-www-atelier-ndigo-com-pages-about-us-17126891135161
screenshot-ateliermaree-com-about-17126893692091

**United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application**

U.S. Application Serial No. 98044168

Mark: SAINT GEORGE ATELIER

Correspondence Address:

Lucian C. Chen
Mandelbaum Barrett PC
570 Lexington Avenue, 21st Floor
New York NY 10022
United States

Applicant: SAINT GEORGE ATELIER LLC

Reference/Docket No. 223051891499

Correspondence Email Address: lchen@mblawfirm.com

FINAL OFFICE ACTION

Response deadline. File a request for reconsideration of this final Office action and/or a timely appeal to the Trademark Trial and Appeal Board (TTAB) within three months of the "Issue date" below to avoid abandonment of the application. Review the Office action and respond using one of the links below to the appropriate electronic forms in the "How to respond" section below.

Request an extension. For a fee, applicant may request one three-month extension of the response deadline prior to filing a response and/or an appeal. The request must be filed within three months of the “Issue date” below. If the extension request is granted, the USPTO must receive applicant's response and/or appeal within six months of the “Issue date” to avoid abandonment of the application.

Issue date: April 9, 2024

Introduction

This Office action is in response to applicant’s communication filed on April 3, 2024.

In a previous Office action(s) dated March 8, 2024,, the trademark examining attorney refused registration of the applied-for mark based on the following: Trademark Act Section 2(d) for a likelihood of confusion with a registered mark, failure to show the applied-for mark in use in commerce with any of the specified goods. In addition, applicant was required to satisfy the following requirement(s): Disclaimer Required.

Further, the trademark examining attorney maintains and now makes FINAL the refusal(s) and/or requirement(s) in the summary of issues below. *See* 37 C.F.R. §2.63(b); TMEP §714.04.

Summary of Issues Made Final That Applicant Must Address:

- Section 2(d) - Likelihood of Confusion Refusal
- Disclaimer Required

Section 2(d) - Likelihood of Confusion Refusal

This refusal is maintained and now made FINAL.

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 6489343. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the previously attached registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d

1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

Applicant has applied to register the mark SAINT GEORGE ATELIER in standard characters for:

International Class 025: Clothing, namely, shirts, pants, tee shirts, sweaters, sweatshirts, sweatpants, socks, shoes, sneakers, boots, sandals, jackets, coats, vests, hats and caps

International Class 035: On-line retail store services featuring clothing

Registrant’s mark is ST. GEORGE with a design for “Clothing, namely, t-shirts, tank tops, sweatshirts, and sweatpants” in International Class 025.

Similarity of the Marks

In its response among other things, applicant argues that the applied-for mark and the registered mark look completely different pointing to the fact that the registered mark does not contain the term "ATELIER" and contains a design element. This argument is unpersuasive for the following reasons.

Marks are compared in their entirety for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

Here, applicant’s mark, SAINT GEORGE ATELIER, is confusingly similar to the registered mark, ST. GEORGE. Both marks begin phonetically identical terms, which means that the marks initially sound and appear similar. Moreover, in the context of the respective clothing goods and services, the marks create a similar commercial impression of a saint named George.

The fact applicant's mark also contains additional wording does not diminish the confusing nature of the marks. Although marks are compared in their entirety, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). Matter that is descriptive of or generic for a party’s goods and/or services is typically less significant or less dominant in relation to other wording in a mark. *See Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)).

In the present case, the wording ATELIER in the applied-for mark is merely descriptive of or generic for applicant’s goods and/or services and applicant is required to disclaim the wording (see discussion below). Thus, this wording is less significant in terms of affecting the mark’s commercial impression, and renders the wording SAINT GEORGE the more dominant element of the mark. Thus, because the dominant element in applicant's mark is phonetically equivalent to the entirety of registrant's mark, the

marks create an overall similar commercial impression.

Further, the fact that registrant's mark contains a design does not change the overall commercial impression for purposes of Section 2(d). When evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods and/or services. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983)); *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *41 (TTAB 2022) (quoting *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *31 (TTAB 2021)); TMEP §1207.01(c)(ii). Thus, although marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Lastly, incorporating the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). *See Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977) (holding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (holding BENGAL LANCER and design and BENGAL confusingly similar); *Double Coin Holdings, Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *6-7 (TTAB 2019) (holding ROAD WARRIOR and WARRIOR (stylized) confusingly similar); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1090 (TTAB 2016) (holding JAWS DEVOUR YOUR HUNGER and JAWS confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part.

Because the marks look and sound similar and create the same commercial impression, the marks are considered similar for likelihood of confusion purposes.

Third-Party Use

Applicant also argues that the likelihood of confusion is refuted by the number of similar third-party marks in use on similar goods and services.

As an initial matter, third-party registrations are entitled to little weight on the issue of confusing similarity because the registrations are “not evidence that the registered marks are actually in use or that the public is familiar with them.” *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1167 n.5 (TTAB 2013) (citing *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)); *see* TMEP §1207.01(d)(iii). Moreover, the existence on the register of other seemingly similar marks does not provide a basis for registrability of the applied-for mark. *See Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, at *9 (TTAB 2020) (quoting *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973)).

Further, of the eight registrations that applicant points to all but two (ALLYN SAINT GEORGE AMERICAN SPORT (Reg.2084817) and GEORGE (Reg. 5932203)) are cancelled. However, a cancelled or expired registration is “only evidence that the registration issued and it does not carry any of the legal presumptions under [Trademark Act] Section 7(b),” such as the presumption that the registration is valid, owned by the registrant, and that the registrant has the exclusive right to use the

mark in commerce in connection with the goods and/or services specified in the registration certificate. *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *Bond v. Taylor*, 119 USPQ2d 1049, 1054-55 (TTAB 2016); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1264 (TTAB 2011)), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019)); *see Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 1248, 178 USPQ 46, 47 (C.C.P.A. 1973) (statutory benefits of registration disappear when the registration is cancelled); TBMP §1208.02; TMEP §1207.01(d)(iii), (d)(iv). Nor does a cancelled or expired registration provide constructive notice under Section 22, in which registration serves as constructive notice to the public of a registrant's ownership of a mark. *See Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 1566, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“[A] canceled registration does not provide constructive notice of anything.”).

Additionally, the registered marks ALLYN SAINT GEORGE AMERICAN SPORT (Reg.2084817) and GEORGE (Reg. 5932203) hold little weight with regard to showing the weakness of the cited 2(d) mark and applicant's mark as they have different commercial impressions, look and sound different, and the registered mark GEORGE is used in connection with "watches" in Class 014 not clothing or retail store clothing services.

Thus, these third-party registrations have little, if any, probative value with respect to the registrability of applicant's mark.

Relatedness of the Goods and/or Services

In its response applicant argues that applicant's goods and/or services and the registered marks are in different niches for purposes of 2(d) analysis. This argument is unpersuasive for the following reasons.

The goods and/or services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

The compared goods and/or services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i); *see Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *44 (TTAB 2022) (quoting *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006)).

Here, applicant's goods and/or services, “Clothing, namely, shirts, pants, tee shirts, sweaters, sweatshirts, sweatpants, socks, shoes, sneakers, boots, sandals, jackets, coats, vests, hats and caps” and “On-line retail store services featuring clothing” are closely related to registrant's goods and/or services, “Clothing, namely, t-shirts, tank tops, sweatshirts, and sweatpants.”

As an initial matter regarding applicant's "Clothing, namely, shirts, pants, tee shirts, sweaters, sweatshirts, sweatpants, socks, shoes, sneakers, boots, sandals, jackets, coats, vests, hats and caps" and registrant's "Clothing, namely, t-shirts, tank tops, sweatshirts, and sweatpants", decisions regarding

likelihood of confusion in the clothing field have found many different types of apparel to be related. *Cambridge Rubber Co. v. Cluett, Peabody & Co.*, 286 F.2d 623, 624, 128 USPQ 549, 550 (C.C.P.A. 1961) (women's boots related to men's and boys' underwear); *Gen. Shoe Corp. v. Hollywood-Maxwell Co.*, 277 F.2d 169, 169-70, 125 USPQ2d 443, 443-4 (C.C.P.A. 1960) (shoes and hosiery related to brassieres); *In re Embiid*, 2021 USPQ2d 577, at *29-30 (TTAB 2021) (shoes related to shirts and sweat shirts); *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1236 (TTAB 1992) (underwear related to neckties); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (women's pants, blouses, shorts and jackets related to women's shoes); *In re Pix of Am., Inc.*, 225 USPQ 691, 691-92 (TTAB 1985) (women's shoes related to outer shirts); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 398-99 (TTAB 1982) (hosiery related to trousers); *In re Cook United, Inc.*, 185 USPQ 444, 445 (TTAB 1975) (men's suits, coats, and trousers related to ladies' pantyhose and hosiery); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400, 404 (TTAB 1964) (brassieres and girdles related to slacks for men and young men).

In comparing the remaining services that are neither identical nor legally identical, the following goods are similar in kind, complementary, or interrelated: On-line retail store services featuring clothing

As to these services in the application, it is not necessary to prove relatedness as to each activity listed in the description of services in International Class 035 in this application. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any service encompassed by the identification in a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (C.C.P.A. 1981); see *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015); *Apple Comput. v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

Further, the attached Internet evidence, consisting of *Nike*, *Reebok*, *Asos*, and *Under Armour*, establishes that the same entity commonly manufactures, produces, or provides the relevant goods and/or services and markets the goods and/or services under the same mark. Specifically the evidence shows that the same entity provides a variety of clothing as well as an online retail store services that features clothing.

Thus, applicant's and registrant's goods and/or services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Actual Use

Applicant also argues that registrant appears to be using a related unregistered mark for woman's clothing. This argument is also unpersuasive.

Determining likelihood of confusion is based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

Trade Channels

Neither the application nor the registration(s) contains any limitations regarding trade channels for the goods and therefore it is assumed that registrant's and applicant's goods are sold everywhere that is normal for such items, i.e., clothing and department stores. Thus, it can also be assumed that the same classes of purchasers shop for these items and that consumers are accustomed to seeing them sold under

the same or similar marks. *See Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); TMEP §1207.01(a)(iii).

Conclusion

Because the marks are similar and the goods and/or services are related, there is a likelihood of confusion as to the source of applicant's goods and/or services, and the refusal pursuant to Section 2(d) of the Trademark Act is now made FINAL.

Disclaimer Required

Applicant also argues that a disclaimer of the term "ATELIER" should not be required. Respectfully, the examining attorney disagrees for the following reasons and makes this requirement FINAL.

Applicant must disclaim the wording "ATELIER" because it is merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods and/or services. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); TMEP §§1213, 1213.03(a).

The previously attached evidence from *Merriam-Webster Dictionary* shows this wording means "workshop". Also see the attached internet evidence from *Wiktionary* that defines ATELIER as "workshop, studio; in particular in relation to artistic activities, the production of clothing or engineering". Further, the attached third party internet evidence from *Atelier Boutique*, *Atelier Ndigo*, and *Atelier Maree*, shows that this term is commonly used in the relevant industry to refer a provider of clothing. Thus, the wording merely describes applicant's goods and/or services because it immediately describes applicant's goods and services, in that applicant's workshop provides and sells clothing.

Applicant may respond to this issue by submitting a disclaimer in the following format:

No claim is made to the exclusive right to use "ATELIER" apart from the mark as shown.

For an overview of disclaimers and instructions on how to provide one using the Trademark Electronic Application System (TEAS), see the Disclaimer webpage.

Response Guidelines

How to respond. File a request form for reconsideration of this final Office action that fully resolves all outstanding requirements and/or refusals and/or file a timely appeal form to the Trademark Trial and Appeal Board with the required fee(s). Alternatively, applicant may file a request form for an extension of time to file a response for a fee.

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. *See* TMEP §§705.02, 709.06.