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Mailed: 5/30/2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Russell

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Serial No. 78170148

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Steven R. Gustavson of Baker Botts for Gordon C. Russell.

April Rademacher, Trademark Examining Attorney, Law Office  
102 (Thomas V. Shaw, Managing Attorney).

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Before Quinn, Hohein and Cataldo, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Gordon C. Russell to register the mark IN THE PINK for "retail store services featuring clothing, namely, blouses, shorts and pants, swimsuits, dresses, shirts, tops and sweaters."<sup>1</sup>

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as used in connection with applicant's

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<sup>1</sup> Application Serial No. 78170148, filed October 2, 2002, based on first use anywhere and first use in commerce on December 7, 2000.

services, so resembles the previously registered mark IN THE PINK for "handbags" as to be likely to cause confusion.<sup>2</sup>

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs.<sup>3</sup>

The examining attorney maintains that the marks are identical in all respects and, moreover, the cited mark is arbitrary. In considering the third-party registrations of IN THE PINK marks submitted by applicant, the examining attorney points out that none of the marks covers goods related to the fashion and clothing fields. Thus, the examining attorney argues, registrant's mark is strong and entitled to a wide scope of protection. Regarding the goods and services, the examining attorney argues that applicant's retail store services featuring clothing are related to registrant's handbags. In connection with her argument, the examining attorney submitted several use-based third-party registrations as evidence suggesting that the goods and services listed therein, namely handbags and retail clothing store services, are of a type that may emanate from a single source under a single mark. The examining attorney also submitted screen shots of third-

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<sup>2</sup> Registration No. 2552696, issued March 26, 2002.

<sup>3</sup> Applicant originally requested an oral hearing, but the request subsequently was withdrawn.

party websites in an attempt to show that the same clothing retailer offers both handbags and clothing, and that retailers frequently sell clothing and accessories under their own brand name, which also happens to be the mark used to identify the retail services themselves.

Applicant contends that the involved marks employ a popular and widely used figure of speech, and that the marks are used in connection with goods and services with which consumers will not automatically assume any connection. Insofar as the marks are concerned, applicant asserts that the cited mark has limited strength; in this contention, applicant submitted six third-party registrations of IN THE PINK marks for various goods and services. As to the goods and services, applicant does not dispute that third-party registrations have been obtained for marks covering both retail store services and handbags; applicant further acknowledges that any given number of clothing items can be worn while carrying a handbag, and that handbags and clothing items can be and often are sold in the same stores. Nonetheless, applicant argues, these facts do not establish that applicant's retail clothing store services and registrant's handbags are "complementary or companion items," and that the differences between applicant's services and registrant's goods outweigh any

similarities. Applicant submitted several third-party registrations showing that a wide variety of goods and/or services may emanate from the same source under the same mark; according to applicant, the evidence shows that virtually any two goods and/or services may originate from the same source. Applicant argues that the mere listing of any two items (goods and/or services) in a registration does not necessarily mean, in the context of today's marketplace, that those goods and/or services are commercially related.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first turn to consider the marks. The IN THE PINK marks involved herein are identical in sound and appearance. Further, although applicant contends that the phrase "in the pink" may have a meaning in common language,<sup>4</sup> the mark is arbitrary when used in connection with the involved goods and services. In addition to having an identical meaning, the marks convey the same overall commercial impression.

In considering the involved marks, we have taken into account the six third-party registrations of IN THE PINK marks. The registrations cover the following goods or services: dolls and doll clothing; household latex gloves; pet treats; glass art; a classified section of an aviation newspaper; and organizing and conducting events to raise money for breast cancer research and local community breast health awareness programs. This evidence is of limited probative value. Firstly, the registrations are not evidence of use of the marks shown therein and they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of similar marks in the marketplace. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks*,

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<sup>4</sup> In this connection, applicant failed to submit a dictionary listing or any other evidence to show the meaning of this phrase.

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Inc. v. Franklin Mint Corp., 216 USPQ 989 (TTAB 1982).

Secondly, and more significantly, the registrations cover a variety of goods or services, none of which are even remotely related to retail clothing store services and/or handbags. See Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735, 1740 (TTAB 1991), *aff'd unpub.*, (Appeal No. 92-1086, Federal Circuit, June 5, 1992).

In sum, the marks are identical in all respects. In addition, the mark IN THE PINK is arbitrary as used in the context of registrant's handbags. Use of identical marks (especially when, as here, the registered mark is arbitrary) is a fact which "weighs heavily against applicant." In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984); see also In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

We next turn to a consideration of the goods and services. We note, at the outset of considering this du Pont factor, that the greater the degree of similarity between applicant's mark and the cited registered mark, the lesser the degree of similarity between applicant's goods and/or services and registrant's goods and/or services that is required to support a finding of likelihood of confusion. In re Opus One Inc., 60 USPQ2d 1812, 1815 (TTAB

2001). If the marks are the same, as in this case, it is only necessary that there be a viable relationship between the goods and/or services in order to support a finding of likelihood of confusion. In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983).

Applicant has acknowledged, as noted above, that there are third-party registrations covering both handbags and retail clothing store services; that handbags and clothing are used together; and that handbags and clothing often are sold in the same stores. It is applicant's position, however, that given the realities of the marketplace, consumers will not automatically assume a connection between the sources of the respective goods and services.

Contrary to applicant's arguments, the evidence of record suggests that consumers will assume a common source upon encountering the same arbitrary mark for retail clothing store services and handbags. The examining attorney introduced several use-based third-party registrations showing that each entity adopted the same mark for both handbags and retail clothing store services. Third-party registrations that individually cover different items and that are based on use in commerce serve to suggest that the listed goods and/or services are of a type that may emanate from a single source. See In re Albert

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Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993); and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467 (TTAB 1988).

The examining attorney also introduced screen shots from the on-line retail websites of Ann Taylor, Ralph Lauren, Banana Republic and J. Crew. This evidence shows that these retailers offer retail services through which consumers may purchase clothing and handbags, and that all goods and services are offered under the respective marks mentioned.

We find that the examining attorney's evidence establishes that there is a viable relationship between retail clothing store services and handbags. The evidence suggests that consumers have been exposed to retail clothing store services, as well as to handbags and clothing, emanating from the same source under the same mark.

Applicant would have us conclude that, in today's marketplace, the reality is virtually any two goods and/or services may originate from the same source. Indeed, the third-party registrations submitted by applicant show that each registrant has applied a single mark to handbags and, in addition, to a wide range of products and services, some of which, admittedly, are not commercially related to handbags. We agree with applicant's point that the mere

fact that any two goods and/or services are listed in a registration does not necessarily mean that they are related.

There is, however, a relatedness between handbags and clothing, as well as between handbags and retail clothing store services, that may not exist with some of the other items covered in these registrations. It is common knowledge that handbags are fashion accessories, and are frequently chosen to complement a clothing outfit. It also is common knowledge (and as suggested by the evidence of record) that handbags are sold in retail clothing stores, and that handbags and retail clothing store services are offered by the same entity under the same mark. As the Federal Circuit stated in *Recot, Inc. v. M.C. Becton*, 214 F.3d 1332, 54 USPQ2d 1895, 1898 (Fed. Cir. 2000), "even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis." See also *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.2d 1367, 63 USPQ2d 1303, 1309-10 (Fed Cir. 2002) ["Hence the products as described in the pertinent registrations are not the same. But they are related as required by du Pont."]; and

Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ["even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services."]. Further, handbags are bought by, and retail clothing store services rendered to, the same classes of purchasers. These consumers include ordinary consumers who would not necessarily exercise a great deal of care in their purchasing decisions.

We conclude that consumers familiar with registrant's handbags sold under its arbitrary mark IN THE PINK would be likely to believe, upon encountering applicant's retail clothing store services rendered under the identical mark, that the goods and services originated with or are somehow associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., supra.

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