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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sara Lee Corporation  
v.  
Amine Mahmoud

Opposition No. 91162134  
to application Serial No. 75419909  
filed on January 20, 1998

William M. Bryner of Kilpatrick Stockton LLP for Sara Lee Corporation.

Donald L. Dennison of Dennison Schultz Dougherty & MacDonald for Amine Mahmoud.

Before Grendel, Mermelstein and Bergsman, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Amine Mahmoud, applicant herein, seeks registration on the Principal Register of the mark LEGSTICK (in standard character form).<sup>1</sup> The goods identified in the application

<sup>1</sup> Serial No. 75419909, filed on January 20, 1998. The application is based on applicant's asserted bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b), and on applicant's ownership of Canadian

include "hosiery, panty hose," in Class 25.<sup>2</sup>

Sara Lee Corporation, opposer herein, has opposed registration of applicant's mark in Class 25.<sup>3</sup> As its

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Registration No. TMA540476, which arose from an application filed in Canada on July 21, 1997. Trademark Act Sections 44(d) and(e), 15 U.S.C. §1126(d) and (e).

<sup>2</sup> In the application, applicant also seeks registration of the mark for various Class 3 goods. Opposer has not opposed registration as to Class 3. Therefore, upon conclusion of this proceeding the application shall proceed to issuance of a Notice of Allowance as to Class 3.

<sup>3</sup> The Class 25 identification of goods in the application includes numerous clothing items other than the "hosiery, panty hose" which obviously are the subject of opposer's Section 2(d) claim in this case. Because (as discussed *infra*) opposer has established its Section 2(d) ground of opposition as to any of the Class 25 goods identified in the application (in this case "hosiery, panty hose") the opposition will be sustained and registration to applicant will be refused as to Class 25 in its entirety. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981); *Baseball America v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1848 n.9 (TTAB 2004). For reference, the complete list of Class 25 goods in the application is:

Hosiery, panty hose; men's women's and children's clothing namely, jeans, skirts, blouses, shirts, coats, overalls, shorts, ponchos, capes, cardigans, pants, jump-suits, culottes, jerseys, tunics, blazers, saris, outerwear, namely, coats, vests, parkas, sweaters, uniforms, overcoats, raincoats, wind-resistant jackets, ski vests, ski pants, anoraks and pullovers; swimwear, namely, bathing suits, halter tops, beach pants, bikinis, bathing suit cover-ups, swim trunks, beach coats and dresses; evening wear, namely, formal dresses, ballroom gowns, formal jackets, cocktail dresses, evening belts, evening shorts, cocktail suits, namely, coordinating jacket and shirt or jacket and pants outfits, bustiers, maternity dresses, suits, ascots, tuxedos, dinner jackets, cummerbunds, bow ties, formal shirts and slacks; underwear, namely corsets, girdles, camisoles; jogging bras, slips, body shirts, tank tops, brassieres, garter belts, leggings, underpants, petticoats, dusters, aprons, woolen vests, smocks, Bermuda shorts, sleepwear, namely, pajamas, T-shirts, long johns, night shirts, night gowns, and robes; casual shirts, polo shirts, kimonos; sportswear, namely, riding pants, golf pants, track suits, jogging suits and gym suits; neckwear, namely,

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ground of opposition, opposer alleges that applicant's mark, as applied to the "hosiery, panty hose" identified in the application, so resembles opposer's mark L'EGGS and variations thereof, previously used and registered by opposer in connection with various clothing items including hosiery and panty hose, as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).<sup>4</sup>

Applicant answered the notice of opposition by denying the salient allegations thereof.<sup>5</sup>

Opposer presented evidence at trial; applicant did not. Opposer filed a trial brief; applicant did not.

After careful consideration of all of the evidence of record, we sustain the opposition as to Class 25.

The evidence of record consists of the file of applicant's involved application; the pleadings herein; opposer's three notices of reliance on, respectively, its pleaded registrations, on printed publications, and on official records; the testimony deposition of opposer's vice-president and general manager Romaine Sargent and

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mufflers, collars, scarves and dickies, hats, belts, slippers and shower caps.

<sup>4</sup> In the notice of opposition, opposer also alleged a dilution claim. However, opposer presented no argument in its brief on such claim, and we shall give it no further consideration.

<sup>5</sup> Applicant's answer also included several affirmative defenses which applicant has failed to prove. We give them no consideration.

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exhibits thereto (Sargent Depo.); and the testimony deposition of opposer's survey expert Dr. Thomas DuPont (DuPont Depo.) and exhibits thereto. As noted above, applicant submitted no evidence.

Opposer has made of record status and title copies of eighteen registrations of various marks which consist of or include the designation L'EGGS, establishing that the registrations are in force and owned by opposer. (Opposer's Notice of Reliance #1.) The most significant of these registrations for purposes of our analysis and decision in this case is Reg. No. 0891626 (the '626 registration), which is of the mark L'EGGS (in standard character form) for "ladies' hosiery and panty hose." This mark is the most similar to applicant's mark, and we therefore will base our analysis and decision in this case on the '626 registration.<sup>6</sup>

Because opposer's registration is of record, we find that opposer has established its standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000);

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<sup>6</sup> The additional marks covered in opposer's seventeen other extant registrations include L'EGGS (stylized), NOTHING BEATS A GREAT PAIR OF L'EGGS, LITTLE L'EGGS, L'EGGS CLASSICS, L'EGGSWEAR, GIVE YOUR CREATIVE SPIRIT L'EGGS, BARE L'EGGS, L'EGGS CARE, NOTHING BEATS A GREAT PAIR OF L'EGGS...PANTIES, GIRL L'EGGS and MY L'EGGS. Opposer has not alleged, has not proven, and has not argued that these marks have been used in such a way as to comprise a family of L'EGGS marks. See, e.g., *J&J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991).

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*Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Moreover, because opposer's registration is of record, Section 2(d) priority is not an issue in this case as to the mark and goods covered by said registration. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We find, first, that the goods identified in applicant's application as "hosiery and panty hose" are legally identical to the "hosiery" and "panty hose" identified in opposer's registration. The second *du Pont* factor therefore weighs in favor of a finding of likelihood of confusion.

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There are no restrictions or limitations in the parties' respective identifications of goods, and we therefore find that the parties' identical goods are or would be marketed in the same trade channels and to the same classes of purchasers. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). The third *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Hosiery and pantyhose retail at prices between one dollar and five dollars. (Sargent Depo. at 27-28.) They can be purchased on impulse and without much care or deliberation. (*Id.*) They are ordinary consumer items purchased by ordinary consumers. We find that these purchasing conditions support a finding of likelihood of confusion, and that the fourth *du Pont* factor weighs in opposer's favor.

The fifth *du Pont* evidentiary factor requires us to consider evidence of the fame of opposer's mark, and to give great weight to such evidence if it exists. *See Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the *DuPont* factors," *Recot*, 214 F.3d

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at 1327, 54 USPQ2d at 1456 [sic - 1897], and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.*

*Bose Corp. v. QSC Audio Products Inc.*, *supra*, 63 USPQ2d at 1305.

Based on the undisputed evidence of record in this case, we find that opposer's mark is famous for purposes of the fifth *du Pont* factor. Summarized briefly, the evidence establishes that opposer has used the mark on hosiery and related products for over thirty-five years. (Sargent Depo. at 24-25, 36-47.) Opposer's L'EGGS products are sold nationwide at over 40,000 retailers, including food stores, drug stores and mass merchandisers. (*Id.* at 25, 100.) Opposer's sales of its L'EGGS products over the years have totaled \$12 billion, including \$205 million in 2005 alone. (*Id.* at 32-33.) In 2005, opposer's L'EGGS products had a 57% share of the market for sheer hosiery in the United States. (*Id.* at 103-104.) Opposer has spent \$2 billion in advertising and promoting its L'EGGS products. (*Id.* at 62.) Such advertising includes television commercials aired on prime time and daytime television (*id.* at 51-52), print

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advertising in popular magazines and newspapers (*id.* at 54-55, 80-85), and sponsorship of prominent events such as the 1994 Winter Olympics and the 1996 Summer Olympics (*id.* at 79). Opposer's L'EGGS mark and products have been the subject of hundreds of unsolicited magazine and newspaper articles. (Opposer's Notice of Reliance #3.) A 2004 consumer awareness survey commissioned by opposer reveals that opposer's L'EGGS brand has a 34% unaided brand awareness and an 87% aided brand awareness, leading all other hosiery brands by a wide margin. The "Fairchild Report" published by Women's Wear Daily every two years, which measures consumer awareness of apparel brands, has ranked opposer's L'EGGS brand among the top three apparel brands in each report since 1993. (Sargent Depo. at 105-109.)

This evidence establishes that opposer's L'EGGS mark is a famous mark, and we find that it therefore is entitled to a very broad scope of protection. Pursuant to the case law authorities cited and quoted above, such fame is entitled to heavy and indeed dominant weight in our likelihood of confusion analysis. The fifth *du Pont* factor strongly supports a finding of likelihood of confusion.<sup>7</sup>

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<sup>7</sup> Further with respect to the strength of opposer's mark in the marketplace, we note that there is no evidence showing third-party use of similar marks on similar goods. The sixth *du Pont* factor therefore is neutral. This factor certainly does not weigh in applicant's favor.

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We turn finally to the first *du Pont* factor, which requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra*. The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Additionally, in cases such as this where the applicant's goods are identical to the opposer's goods, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). Likewise, in cases such as this where the opposer's mark is famous and thus entitled to a very wide scope of protection, the degree of similarity between the marks which is necessary to support a finding of

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likelihood of confusion is diminished. See *Kenner Parker Toys, supra*, 963 F.2d at 353, 22 USPQ2d at 1456 (“[a] strong mark ... casts a long shadow which competitors must avoid”); see also *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1091, 1094 (Fed. Cir. 1989), quoting *Planter’s Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962) (there is “no excuse for even approaching the well-known trademark of a competitor...”)

Applying these principles in the present case, we find that the marks obviously are dissimilar in terms of appearance, sound, connotation and commercial impression to the extent that applicant’s mark includes the word STICK. However, we also find that the marks are somewhat similar in terms of appearance, sound, connotation and commercial impression to the extent that opposer’s mark consists of a misspelling of the word “legs” and applicant’s mark begins with the singular version of that word, i.e., the word “leg.” Obviously, “legs” and “leg” are fairly suggestive as applied to hosiery and panty hose, but any such inherent suggestiveness of opposer’s mark is mitigated by and must be considered in conjunction with the exceedingly high degree of fame the mark has achieved. On balance, we find that the similarity between the marks which results from the presence in both marks of the word “leg” or a variation thereof

outweighs the dissimilarities in the marks and that, overall, the marks are similar.<sup>8</sup> It is a close question, but we find that the first *du Pont* factor weighs in opposer's favor.

The evidence of record includes the testimony deposition (DuPont Depo.) of opposer's survey expert, Dr. Thomas DuPont, regarding an "Eveready"<sup>9</sup> shopping mall intercept survey he conducted for opposer in October 2005 (opposer's Exh. No. 30).

Based on his testimony and the statement of his expert qualifications contained in the survey report, we find that Dr. DuPont is qualified to give expert testimony regarding the survey. (DuPont Depo. at 7-12; opposer's Exh. No. 30 at 9-12.)<sup>10</sup> We further find that the construction and methodology of the survey are consistent with those accepted by the Board in other cases. *See, e.g., Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741 (TTAB 2006); *Ava*

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<sup>8</sup> Our finding that the marks are similar overall due to the presence of "leg" or a variation thereof in each mark is corroborated by, and to the extent that, opposer's survey (discussed *infra*) found that 14.1% of survey respondents (a) believed that "L'eggs" is the source of LEGSTICK hosiery and (b) specifically identified the presence of "leg" in the LEGSTICK mark as the reason for their belief.

<sup>9</sup> *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 188 USPQ 623 (7<sup>th</sup> Cir. 1976), *cert. denied*, 429 U.S. 830, 191 USPQ 416 (1976).

<sup>10</sup> We note as well that during Dr. DuPont's deposition, applicant's counsel stipulated on the record that Dr. DuPont is qualified as a survey expert. (DuPont Depo. at 12.)

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*Enterprises Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783 (TTAB 2006); and *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995). The construction and methodology of the survey are unchallenged by applicant in this case in any event. The results of the survey, and Dr. DuPont's analysis and testimony regarding the results, are uncontradicted.

Survey respondents in the test group (199 women age 18 and older from around the country) were shown a stimulus card which displayed "LEGSTICK" in large letters above the words "HOSIERY, PANTYHOSE AND CLOTHING FOR MEN, WOMEN AND CHILDREN," which were displayed in smaller letters. Respondents were told "This is the name of a brand of hosiery, pantyhose and clothing for men, women and children. Please look at it and give it back to me when you are finished." They then were asked "First, what company do you think puts out the brand indicated on that card?" When properly adjusted for "noise," 17.7% of survey respondents (39 of 199) responded that LEGSTICK hosiery, pantyhose and clothing was put out by "L'EGGS." The thirty-nine survey respondents who had responded "L'EGGS" then were asked the follow-up question "Why do you think that?" Twenty-eight of them (14.1% of the full 199 respondents) specified that it was because of the presence of the word "legs" or "leg" in the LEGSTICK name.

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We agree with Dr. DuPont's conclusion (opposer's Exh. No. 30 at 6) that these survey results, which show that 17.7% of survey respondents believed that LEGSTICK hosiery is "put out by L'eggs," constitute probative evidence which supports a finding of likelihood of confusion. The 17.7% figure is well within the range of percentages that have been found in other cases to be sufficient to support a finding of likelihood of confusion. See *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445 (TTAB 1986); see also the cases listed in 3 J.T. McCarthy, McCarthy on Trademarks and Unfair Competition at §32.54 (4<sup>th</sup> ed. 2005). The fact that twenty-eight of the thirty-nine respondents who believed that "L'eggs" is the source of LEGSTICK hosiery specifically identified the presence of "legs" or "leg" in the LEGSTICK mark as the reason for their belief further supports a finding of likelihood of confusion. See *Ava Enterprises Inc. v. Audio Boss USA Inc.*, *supra*, 77 USPQ2d at 1787.

Balancing all of the *du Pont* factors for which there is evidence of record, and taking into account the corroborative value of opposer's survey evidence, we find that a likelihood of confusion exists. All of the factors except the first (especially the identical nature of the parties' goods and the great fame of opposer's mark) weigh heavily in favor of a finding of likelihood of confusion.

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Indeed, they weigh so heavily in opposer's favor that the only way we could ultimately conclude that there is no likelihood of confusion would be if we were to find, in applicant's favor, that applicant's mark is so utterly dissimilar to opposer's mark that the first *du Pont* factor outweighs all of the other factors in our likelihood of confusion analysis. See, e.g., *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). We cannot reach such a conclusion in this case, especially given the results of opposer's survey.

Instead, we conclude that applicant's LEGSTICK mark is sufficiently similar to opposer's famous L'EGGS mark that source confusion is likely to result from use of the two marks on the parties' identical goods. In reaching this conclusion, we note again that there is "no excuse for even approaching the well-known trademark of a competitor ... and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous." *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, *supra*. See also *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In*

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*re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223  
USPQ 1289 (Fed. Cir. 1984).

Decision: The opposition to registration of applicant's mark as to Class 25 is sustained. The application shall proceed to issuance of a notice of allowance as to Class 3.