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This Opinion Is Not a
Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Michael Stars, Inc.
v.
Michael Starr

Opposition No. 91164989
to application Serial No. 78371911
filed on February 22, 2004

Willmore F. Holbrow and Stacie J. Sundquist of Blakely,
Sokoloff, Taylor & Zafman LLP for Michael Stars, Inc.

Howard D. Leib, Esq. for Michael Starr.

Before Rogers, Taylor and Wellington, Administrative
Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Applicant Michael Starr (defendant), has filed applications to register the marks MICHAEL STAR and MICHAEL STARR, both for watches, clocks and jewelry. Both applications are involved in oppositions filed by opposer Michael Stars, Inc. (plaintiff), with the former application involved in this case and the latter involved in a separate opposition suspended pending disposition of this case.¹

¹ Opposition no. 91170316; application serial no. 78646346.

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Applicant asserted in his involved application first use of the MICHAEL STAR mark on December 1, 2002, and first use of that mark in commerce on December 15, 2003. Both dates are prior to the February 22, 2004 filing date of the application.

In its notice of opposition, opposer asserted two claims, specifically, (1) its prior use and registration of MICHAEL STARS and the asserted likelihood of confusion among consumers that will result from concurrent use of opposer's and applicant's respective marks ("likelihood of confusion"), and (2) that applicant's mark will dilute the distinctive quality of opposer's famous mark ("dilution"). The notice of opposition pleads ownership by opposer of two registrations for MICHAEL STARS. One is Registration No. 2332061 and covers "clothing, namely, hats, tops and bottoms," and the other is Registration No. 2722456 and covers "retail store services featuring clothing and related accessories." The first of these two registrations claims ownership of a third registration, No. 1488585, for MICHAEL STARS for "clothing, namely, t-shirts, shirts and polo shirts." Registration No. 2332061 shows the mark in the stylized form shown below, while the other two registrations cover the mark in "typed" form (the former reference to what the Office now refers to as "standard character" form). All

three registrations contain the statement that MICHAEL STARS is not the name of or does not identify a living individual.

Michael Stars

Opposer has also made the following assertions regarding its priority and claimed common law rights: "Long prior to" applicant's filing of his application, opposer "has widely and extensively used and promoted its famous mark MICHAEL STARS in connection with a variety of products and services, including without limitation, clothing, perfume and retail services." Opposition, ¶1; and "Opposer has also made significant common law use of MICHAEL STARS in connection with other products and services, and is likely to continue to expand into related areas." Opposition, ¶2.

Applicant filed his answer in this case without, it appears, assistance of counsel.² Perhaps as a result, the answer is not directly responsive to the allegations in opposer's notice of opposition. Applicant did include in his answer various allegations that can only be read to assert that he is personally and widely known in the field

² Applicant has since retained counsel. Counsel filed the answer in the other opposition proceeding and represented applicant during discovery, trial and briefing of this case.

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of watches, that adoption and use of the involved MICHAEL STAR mark represents a natural expansion of his company's growth, and that there would be a likelihood of confusion if any other party were to register a mark similar to MICHAEL STAR in Class 14 for watches and jewelry. Answer, paragraphs 1, 3-5, 9 and 11. The latter is not, however, an admission of opposer's allegation of likelihood of confusion, as opposer has not based its opposition on use or registration of its MICHAEL STARS mark for watches or jewelry. Nor has opposer argued that the informal nature of applicant's answer resulted in admission by applicant of particular allegations in the notice of opposition, due to applicant's failure to explicitly deny them.

Based on the overall conduct of this case, it is clear that applicant has, throughout, expected opposer to prove its case. As applicant has not pleaded any affirmative defenses or counterclaims, the only issues presented by the case are opposer's pleaded grounds of likelihood of confusion and dilution. If opposer is to prevail it must be because the record created in this case supports at least one of these grounds.

In essence, the pleadings present contrasting views of which party has the right to expand its business by using MICHAEL STARS (opposer) or MICHAEL STAR (applicant) in the field of watches. Opposer asserts that its mark is already

in use for other goods and services and its expansion of that use to watches is in the normal course of its business. Applicant, on the other hand, asserts that he is already in the watch field, albeit using other marks, but his personal renown in the field means his expansion of the marks he uses to include his name, less the ultimate letter "R" in STARR, has been a natural expansion for his business.

The Record

The record includes the file of the opposed application, the pleadings, a testimony deposition taken by opposer of Michael Starr, a testimony deposition taken by opposer of Simon Cohen, opposer's president, a "Joint Stipulation of Agreed Facts" filed by opposer, a "Joint Stipulation of Agreed Testimony" filed by applicant, a second "Joint Stipulation of Agreed Facts" filed by applicant, and a rebuttal notice of reliance filed by opposer. Opposer's exhibits, numbering from 1 through 63, were introduced in various quantities with its evidentiary submissions. Applicant's exhibits 1 through 38 were introduced with its two evidentiary submissions.

Neither party has included in its brief any objections to the evidence of the other; and, as noted, some of the evidence was introduced by stipulation. To be sure, the parties disagree as to the probative value of the evidence of record, but there are no objections raised during the

taking of testimony that were maintained in the briefs. Accordingly, any objections asserted during the taking of testimony have been waived.

Findings of Fact

Because the parties have stipulated to certain facts and to entry of the testimony of applicant's counsel regarding certain searches he performed of USPTO electronic records, we begin our findings of fact by noting the stipulated facts (findings of fact 1-20, below). That a particular fact has been stipulated does not preclude presentation of arguments by the parties as to the weight to be accorded such fact; nor does it require the Board to accord the fact any more weight than it otherwise would be due. See *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) ("the facts and documents so stipulated by the parties have been considered for their probative value"), *Sunnen Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744, 1746 n.9 (TTAB 1987).

In each of the following stipulations regarding what the parties agree could be found on the Internet or in USPTO records, the search results are those that were available at the time of trial.

(1) The following marks are used on or for, and in the marketing of, both watches and clothing items, according to materials found on the Internet: JUICY, GUESS, PAUL FRANK,

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TOMMY BAHAMA, KENNETH COLE, GUCCI, POLO, TIMBERLAND, ANNE KLEIN, CALVIN KLEIN, BENNETON, TOMMY HILFIGER, ARMANI, CHRISTIAN DIOR, DIESEL, DKNY, BURBERRY, J LO by Jennifer Lopez, BABY PHAT, NIKE, and HUGO BOSS.

(2) The following marks are registered with the USPTO in international Classes 14 and 25, for watches and clothing, respectively: JUICY, GUESS, PAUL FRANK, TOMMY BAHAMA, KENNETH COLE, GUCCI, POLO, TIMBERLAND, ANNE KLEIN, CALVIN KLEIN, BENNETON, TOMMY HILFIGER, GIORGIO ARMANI, CHRISTIAN DIOR, DIESEL, DKNY, BURBERRY, J. LO by JENNIFER LOPEZ, BABY PHAT, NIKE, and HUGO BOSS.

(3) The following marks are the subjects of multiple registrations at the USPTO (with the stipulated number of registrations set forth for each mark): ANNE KLEIN (12), ARMANI (10), BABY PHAT (13), BENNETON (9), BURBERRY (9), CALVIN KLEIN (12), CHRISTIAN DIOR (7), DEISEL (3), DKNY (10), GUCCI (9), GUESS (6), HUGO BOSS (5), J LO (4), JUICY (4), KENNETH COLE (12), NIKE (5), PAUL FRANK (5), POLO (5), TIMBERLAND (7), TOMMY HILFIGER (13), TOMMY BAHAMA (14), and VINCE (2).

(4) The mark VINCE is used in commerce for clothing in international Class 25, and has a pending application in Class 14 for watches.

(5) The mark C&C CALIFORNIA is used in commerce for clothing in International Class 25, and has a pending application in

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Class 14 for watches. There is one registration incorporating the term.

(6) There are in the USPTO database 43 registrations or applications based on use of the applied for mark in commerce, "for the following professional sports franchises and events logos and trademarks," each of which includes watches in the identification of goods: SUPERBOWL, NFL, MAVERICKS, ST LOUIS RAMS, ATLANTA FALCONS, DENVER BRONCOS, TORONTO BLUE JAYS, MINNESOTA TWINS, CINCINNATI REDS, MILWAUKEE BREWERS, KANSAS CITY ROYALS, PIRATES, WORLD WRESTLING FEDERATION, SEATTLE SEAHAWKS, SAN DIEGO CHARGERS, BALTIMORE RAVENS, INDIANAPOLIS MOTOR SPEEDWAY, TAMPA BAY BUCCANEERS, YANKEES, DETROIT TIGERS, BOSTON RED SOX, DODGERS, ASTROS, BALTIMORE ORIOLES, PROFESSIONAL HOCKEY PLAYERS' ASSOCIATION, PROFESSIONAL BASEBALL - THE MINOR LEAGUES, NBA, PHILLIES, MONTREAL EXPOS, SAN ANTONIO SPURS, ROCKIES, SEATTLE MARINERS, UNITED STATES POLO ASSOCIATION, MLS - MAJOR LEAGUE SOCCER, MIGHTY DUCKS, US OPEN, WORLD CUP, ALL AMERICAN GIRLS PROFESSIONAL BASEBALL LEAGUE, AMERICA'S CUP, UNITED STATES TEAM ROPING CHAMPIONSHIPS, WCW WORLD CHAMPIONSHIP WRESTLING, RED HAWKS, and MIAMI HEAT.

(7) There are in the USPTO database 19 registrations "for the following automotive vehicle brands," each of which includes watches in the identifications of goods: HARLEY DAVIDSON MOTOR CYCLES, MERCEDES BENZ, JAGUAR, ALFA ROMEO,

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[PORSCHE DESIGN], LAMBORGHINI, FERRARI, CORVETTE, AUDI SPORT, [VOLKSWAGEN], MINI COOPER, PONTIAC, BUICK, FORD, TRIUMPH MOTORCYCLES, EDSEL, HUMVEE, MAZDA, and VOLVO.

(8) In the USPTO database applicant's counsel found "14,178 live registrations and/or applications for marks listing 'watches' among their goods."

(9) The USPTO database includes "222,103 records ... for marks listing 'shirt' among their goods."

(10) The USPTO database includes "4,785 records ... for marks listing both 'shirt' and 'beverage' among their goods."

(11) The USPTO database includes "1,632 records ... for marks listing both 'shirt' and 'automobile' among their goods."

(12) The USPTO database includes "849 records ... for marks listing both 'shirt' and 'cereal' among their goods."

(13) The USPTO database includes "8,824 records ... for marks listing both 'shirt' and 'pencil' among their goods."

(14) The USPTO database includes "330 records ... for marks listing both 'shirt' and 'shovel' among their goods."

(15) The USPTO database includes "1,308 records ... for marks listing both 'shirt' and 'candle' among their goods."

(16) The USPTO database includes "1,645 records ... for marks listing both 'shirt' and 'candy' among their goods."

(17) The USPTO database includes "664 records ... for marks listing both 'shirt' and 'stapler' among their goods."

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(18) The USPTO database includes "49 records ... for marks listing both 'shirt' and 'dirt' among their goods."

(19) The USPTO database includes "82 records ... for marks listing both 'watches' among their goods and 'university' in the mark."

(20) The USPTO database includes "28 records ... for marks listing both 'watches' among their goods and 'college' in the mark."

Stipulated facts 1-7 are supported by many hundreds of pages of reprints of Internet pages and plain copies of USPTO registration or application records. Stipulated facts 8-20 are supported by reprints of the lists of results retrieved from the searches by applicant's counsel of USPTO records. Apart from showing when counsel's various searches were conducted and what search terms were used, the lists include only application serial numbers and/or registration numbers, in most (but not all) instances the mark in the related record, and an indication whether the application or registration is "live" or "dead." In other words, the retrieved records include both pending and abandoned applications and both issued and cancelled registrations. Further, the records do not actually show the identifications of goods, so there is no illustration of the context within which the searched-for terms appear.

We also make the following findings of fact, based on the testimony depositions of Michael Starr and Simon Cohen, and related exhibits:

(21) Applicant did not seek "an opinion of counsel" before using his involved mark.³

(22) Applicant promotes and sells MICHAEL STAR watches through his company Too Stars, Inc.⁴

(23) Applicant received its first order for MICHAEL STAR watches October 4, 2004 from Spencer Gifts.⁵

(24) As of September 29, 2005, applicant had sold, in wholesale value, \$60,520 worth of MICHAEL STAR watches. The retail value of such watches is approximately three times greater.⁶ Applicant has not sold any MICHAEL STAR jewelry or clocks.⁷

(25) Of his various marks for watches, applicant has used one, DINGBAT LAND, on handbags, too. And applicant has manufactured handbags and watches for ten years and sold both products to the same buyers for resale.⁸

(26) There are brands used for clothing products and watches.⁹

³ Starr testimony dep., p. 26.

⁴ Starr testimony dep., pp. 29-30.

⁵ Starr testimony dep., p. 19.

⁶ Starr testimony dep., pp. 16, 18, 64.

⁷ Starr testimony dep., pp. 22, 26.

⁸ Starr testimony dep., pp. 40, 42-43, 66.

⁹ Starr testimony dep., pp. 44-52, 66.

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(27) Opposer's registrations for MICHAEL STARS in typed form (No. 2722456) and in a stylized script (No. 2744166), both for "retail store services featuring clothing and related accessories" are valid and owned by opposer.¹⁰

(28) Opposer's registrations for MICHAEL STARS in typed form for "clothing, namely, t-shirts, shirts, and polo shirts" (No. 1488585) and in a stylized script for "clothing, namely, hats, tops and bottoms" (No. 2332061) are valid and owned by opposer.¹¹

(29) Opposer's registration for MIKEY STARS in typed form for "clothing, namely, tops, bottoms and hats" (No. 2393643) is valid and owned by opposer.¹²

(30) Opposer has sold caps, hats, t-shirts, and other women's clothing items, as well as lip balm, fragrance, body lotion, bags, purses, candles, clutches, and luggage tags.¹³

(31) Opposer has been selling clothing items the longest, starting with t-shirts in 1986 and adding other clothing items at various times in the ensuing twenty years. Maternity clothing was added in 2003 and children's clothing in 2006.¹⁴ Its sales of non-clothing items commenced in 2002 or later, depending on the item.¹⁵

¹⁰ Cohen testimony dep., p. 8 and exh. 5.

¹¹ Id.

¹² Id.

¹³ Cohen testimony dep., p. 10 and exh. 6.

¹⁴ Cohen testimony dep., exh. 11 (M000181 and M000172).

¹⁵ Cohen testimony dep., p. 10.

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(32) Opposer's goods are sold in specialty stores, some major department stores and in four of opposer's own stores, located in southern California.¹⁶ Opposer has sold through the Nordstrom's department store for 20 years.¹⁷ Opposer opened its first two stores in 2003 and 2004, another in late 2005 and its fourth in 2006.¹⁸

(33) Opposer's gross revenue for all products increased steadily from approximately \$10 million in 1998 to nearly \$50 million in 2006, with the majority from clothing sales.¹⁹

(34) Opposer advertises in numerous regional and national magazines, and its advertising expenditures were \$700,000 in 2000, \$1.2 million in 2005, and \$1.6 million in 2006.²⁰ Opposer also gains notice through its support of many charities and events.²¹

(35) Opposer's women's clothing items are frequently utilized in photo shoots and editorial pieces in national and regional magazines focusing on fashion and style.²² Numerous female celebrities have worn opposer's clothing,

¹⁶ Cohen testimony dep., p. 9.

¹⁷ Cohen testimony dep., p. 15 and exh. 12.

¹⁸ Cohen testimony dep., exh. 11 (M000181 and M000172).

¹⁹ Cohen testimony dep., pp. 11 and 24, exh. 11 (M000172 "shipped nearly two million T-shirts in 2005 ... At \$18 a pop wholesale, that adds up to about \$36 million.").

²⁰ Cohen testimony dep., p. 12 and exh. 7.

²¹ Cohen testimony dep., p. 16 and exh. 14.

²² Cohen testimony dep., p. 13-14 and exhs. 8 and 9.

and numerous television and film actresses have worn opposer's clothing in films and on television.²³

(36) Opposer is a very successful producer of tanks, tees and other shirts, in a mid-price range, with a focus on fit and lots of choices of styles and colors.²⁴

(37) Opposer is a closely-held family business and opposer has been discerning in its consideration of expansion options. While sunglasses, jewelry and watches have been discussed, none have yet been marketed under the mark.²⁵

²³ Cohen testimony dep., p. 15-16, exh. 9 (pages M000233, M000239, and M000907-08), exh. 11 (M000950 and M000871-72) and exh. 13.

²⁴ Cohen testimony, exh. 9 (M000168 - "More than 100 styles and colors of the trademark tanks and tees are showcased in the ultramodern boutique."), (M000942 - "Michael Stars is so into T's that the LA-based company unveils 200 styles in 25 colors every season."), (M000907-08 - "[Cheryl Hines's] favorite shopping haunt is the low-key Michael Stars store on Santa Monica's Montana Avenue, where she stocks up on her biggest fashion obsession: soft, comfortable tees." "I do wear Michael Stars tees on the show, so I guess you'd have to say I have a lot in common with my TV character!" says Cheryl.), (M000937 - "Things Every Girl Needs ... in June ... 6 The Perfect T-Shirt A good tee goes with everything. It's cute, dressy and low-key all at the same time, and you feel good in it. What we love: anything by Michael Stars..."); exh. 10 (M000133 - "Enjoy a beautiful canvas tote with any purchase of 2 or more tees. ... www.michaelstars.com 877.STAR.TEE."); exh. 11 (M000244 - "We've been around for 18 years, so for a T-shirt company to be around that long is like a dinosaur." [interview of Simon Cohen, "Family business turns T-shirts into high fashion," The Beach Reporter, April 7, 2005]), (M000211 - "T-shirt junkies know to head to Michael Stars".) (M000950 - "The contemporary T-shirt company, based in Los Angeles, has stuck with its formula for success: a versatile style that can be worn to yoga, under a suit, or out for a dinner date."), and (M000871 - "At local clothing company, red-hot fashion T-shirts take a ... starring role" "Just last year, the company sold nearly 2 million T-shirts and its product was spotted on actresses in 'Alias,' the 'Gilmore Girls' and 'Kill Bill.'").

²⁵ Cohen testimony dep., pp. 17, 19-21, exh. 11 (pages M000244, M000192, M000181, and M000172).

Opposer's Claim under Section 2(d)

Standing and Priority

Opposer's witness, Simon Cohen, has testified to opposer's ownership of, and the validity of, five registrations. In addition, opposer has relied on those registrations in its brief at final hearing. We note, however, that only two of these registrations were pleaded in the notice of opposition. Nonetheless, applicant did not object to the Cohen testimony or challenge opposer's reliance on unpleaded registrations in its brief.²⁶ Accordingly, we have considered all of the registrations. See Fed. R. Civ. P. 15(b); see also, *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1789 (TTAB 2001) (unpleaded registration properly proved at trial considered because defendant made no objection). We add, however, that even if we only considered the two registrations that were both pleaded and proven at trial our decision would be the same, both as to opposer's standing and as to opposer's claim of likelihood of confusion, because those two registrations cover both opposer's clothing items and its retail store services, and the other registrations are somewhat duplicative.

²⁶ In his brief, applicant's statement of the case asserts that there are "no facts in dispute." While the briefs actually belie the statement, it does not appear that applicant disputes the existence of or validity of any of opposer's registrations.

There is no dispute that each of the parties has had applications pending before the USPTO suspended because of prior filings by the other. In addition, opposer's evidence shows some degree of expansion of its business in recent years. At this point, we note the trend solely in regard to the question of whether opposer has proven its standing in this case. Opposer's registrations, its suspended application²⁷, and its testimony concerning expansion of its business all support the conclusion that opposer has proven its standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Because there is no question regarding opposer's ownership of, and the validity of, opposer's registrations for its MICHAEL STARS mark (in typed and stylized form), there is no issue as to priority as to the goods and services identified in those registrations. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Opposer, however, also relies on its

²⁷ By rebuttal notice of reliance, opposer put into the record evidence that its application to register MICHAEL STARS BAR for retail services featuring clothing was suspended by the examining attorney because of the prior filing of, inter alia, applicant's involved application. Applicant argues that this evidence "is irrelevant to this proceeding" and is not evidence that the examining attorney determined that there is a likelihood of confusion between opposer's applied-for mark and applicant's involved mark. We agree the evidence is not evidence of likelihood of confusion; but it does support opposer's standing.

common law rights, and applicant, although not specifically arguing that he has priority, has advanced arguments that, at their core, are tantamount to a claim of priority. For example, applicant asserts that one of the issues in the case is whether "Michael Starr's lengthy activity and high recognition in the watch industry preclude [opposer] from using the mark 'Michael Stars' on goods in and related to that product line." Brief, p. 8. Applicant also argues that if opposer "were to enter the watch market, it would cause consumer and industry confusion. [Opposer] would also be in violation of [applicant's] rights under section 43A of the Lanham Act." Brief, pp. 19-20. Finally, in addressing opposer's expansion of trade argument, i.e., that it is natural for opposer to expand use of its mark to watches, applicant argues that we must focus on 2002, "when Starr commenced use of his 'Michael Star' mark," rather than the time of trial. Accordingly, notwithstanding the proof of opposer's registrations, we briefly consider the question of priority.

Opposer's evidence shows that it has never used its MICHAEL STARS mark for watches. While it has a pending intent to use application for the mark for "jewelry and watches," Cohen testimony dep., exh. 16, the filing date of that application is subsequent to the filing date of

applicant's involved application. Opposer has not provided sufficient or even definite evidence of its priority of use of MICHAEL STAR for non-clothing items.²⁸ At best, opposer's evidence regarding non-clothing items shows a recent trend of opposer to slightly expand beyond its longstanding clothing business. Therefore, any actual priority on which opposer may rely stems from its use of its mark on clothing items and for its retail services.

As for applicant's priority date, applicant testified he ran a watch company called "Star Design, Incorporated" from the late 1980s until 1991. Starr testimony dep. pp. 10-11. Applicant started a watch company in 2001 known as Too Stars, Inc. Starr testimony dep. pp. 14-15. Applicant testified he has been selling watches for 20 years, has become "famous in the watch business," that experienced watch buyers know him, and "all those people that bought [his] watches know of [him]" because he handles his own customer service calls. Starr testimony dep. pp. 32-33. Starr's application asserts first use of the MICHAEL STAR mark for watches, clocks and jewelry as of December 1, 2002, and first use of the mark in commerce as of December 15,

²⁸ Opposer's president was asked "Q. ... If you can, identify when you first began selling some of these products. A. ...fragrance, body lotion, '03, '04, '05; candles, purses, clutches, bags, probably '02, '03." Cohen testimony dep. p. 10. This is not definite testimony. There was no testimony as to units sold, value or how and where such products were sold.

2003. As noted in the finding of facts, applicant's first sale of watches was October 4, 2004.

Any use by applicant of the trade name or mark Star Design has long since been abandoned. Applicant's testimony about the Too Stars company name and applicant's own name, Michael Starr, was not accompanied by any specifics showing or explaining how and where either was used. The testimony is scarcely more than a bald assertion of trade name use of these designations. We do not find the testimony compelling evidence of prior use of either designation in a manner analogous to trademark use or in any way that would be sufficient to establish applicant's priority. Moreover, any use of Too Stars as a trade or company name would not establish priority of use of either the involved MICHAEL STAR mark or applicant's own name, Michael Starr. Nor does the Starr testimony provide adequate support for either of the dates of use asserted in the involved application.²⁹ We therefore conclude that the earliest date on which applicant may rely is the filing date of its involved application, February 22, 2004. In sum, notwithstanding the parties' arguments about actual priority of use of their respective marks, priority is not at issue in this case since opposer has not proven prior common law rights as to goods other than those listed in its pleaded and proven registrations

²⁹ See findings of fact 23 and 24.

and since applicant has not shown that it is entitled to claim a date of use prior to the filing date of his application.

Likelihood of Confusion

We now turn to the question of likelihood of confusion. Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004) (listing the thirteen *DuPont* factors); see also, *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

In any analysis of likelihood of confusion, key considerations are the similarities or differences of the marks and the similarities or differences in the respective goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

1. Fame and Scope of Protection for Opposer's Mark

Before considering the similarity of the marks, involved goods and services and any other *DuPont* factors for which probative evidence may be of record, we consider the question of fame, for the fame of opposer's mark, if

established by the record, would be a critical factor. See *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (The "fame of the prior mark, when present, plays a 'dominant' role in the process of balancing the *du Pont* factors" and famous marks therefore "enjoy a wide latitude of legal protection"). We do not, however, find opposer to have proven that it has a famous mark entitled to "a wide latitude of legal protection." We have no direct evidence of fame, such as survey evidence or customer declarations. We have only indirect evidence, i.e., sales and advertising figures. Although \$50 million in annual sales, primarily of clothing, clearly signifies that opposer's business is a successful one, it does not follow as a matter of course that opposer's mark is famous. Turning from sales volume to advertising and promotion, the evidence does not specify what opposer's advertising expenditures have bought, apart from ads in local and national magazines; and many of the "editorial" placements of opposer's clothing items in such magazines are accompanied by the smallest of fine print indicating opposer as the source of such items. While opposer considers it significant that celebrities and actresses wear its clothing on television and in films, it is not at all clear from the record that opposer is routinely recognized in any way as the source of such clothing.

We presume that the clothing industry in the United States is rather large, clothing being both a staple and a fashion item, but the record does not reveal how significant opposer's presence is in the industry. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002) ("Raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, but raw numbers alone in today's world may be misleading. ... Consequently, some context in which to place raw statistics is reasonable."). Cf. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005) (The record supporting a finding of fame for VEUVE CLICQUOT for champagne showed, inter alia, that it was the second leading brand of champagne in United States and, in one survey, the "most ordered" wine in the sparkling wine category; that it was available in 8,000 restaurants nationwide, in liquor stores, wine stores and other retail locations; and advertising and promotion in magazines, on radio, through in-store displays, and wine-tasting events). Nor is there any evidence of record that reveals whether opposer's advertising and editorial placements have had an impact on sales or whether its sales are due to other reasons, such as the quality of its products and a limited but loyal customer base. In short, we find opposer's mark to have strength

among purchasers of women's shirts and tops, but we cannot rule, on this record, that the mark is famous.

A point somewhat related to fame, and which is the focus of some arguments by the parties, is the question whether opposer's mark is to be accorded the protection of a "designer's mark," or, as opposer has put it, the mark of a "lifestyle company."³⁰ Applicant asserts that opposer is attempting to obtain broader protection for its mark than it would otherwise be entitled to, by claiming that its mark is the equivalent of the mark of a fashion designer. Brief, pp. 23-24. Opposer is somewhat equivocal on the point, questioning whether designer's marks are in "a special category" but asserting that, if they are, then opposer's mark qualifies as such a mark. Reply brief, pp. 2-7.

The cases discussed in the parties' briefs do not establish that a broader scope of protection is routinely accorded to the mark of a "designer." Rather, many of the cases show only that famous marks of well-known designers are often licensed for a wide-range of products and thus consumers may assume a relationship between disparate goods and services marketed under such marks. See, e.g., *Nina Ricci, S.A.R.L. v. E.T.F. Enterprises, Inc.*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989), wherein the Federal Circuit

³⁰ Opposer's brief, p. 7; see also, Cohen testimony dep., pp. 20-22.

noted "increasing sales in many lines under opposer's marks" and fame of marks; and *Nina Ricci, S.A.R.L. v. ETF Enterprises, Inc.*, 203 USPQ 947 (TTAB 1979), which discusses the fame and renown and extensive licensing of the "couturier house ... established as a French corporation in 1932," and which subsequently became a manufacturer of many apparel items, accessory items, perfumes and other fragrance items, rev'd in part, *E.T.F. Enterprises, Inc. v. Nina Ricci, S.A.R.L.*, 523 F.Supp. 1147, 213 USPQ 517 (S.D.N.Y. 1981). See also, *Polo Fashions, Inc. v. La Loren, Inc.*, 224 USPQ 509 (TTAB 1984), which includes a discussion of Polo's licensing activities and Ralph Lauren's control over designs for products and over advertising, packaging and marketing strategy for such products.

It would appear that designer's marks, if they are entitled to a broad scope of protection under the law, earn such protection through the celebrity status of the designer or the acquired fame of the designer's marks, and therefore such marks become attractive assets for broad but controlled licensing. In this case, Michael Stars is a company, not an individual designer carrying the status of celebrity. Nor has the mark obtained any significant fame. Accordingly, opposer's MICHAEL STARS mark is not entitled to the scope of protection to be accorded a famous mark, but it is a strong

mark nonetheless with likely recognition among purchasers of women's clothing.

2. Comparison of the Marks

Turning then to a comparison of the involved marks, there can scarcely be a question that MICHAEL STARS and MICHAEL STAR are virtually identical in appearance, sound, connotation and overall commercial impression. While applicant contends that opposer most often uses the stylized version of its mark, brief, p. 22, the argument is unavailing. Opposer has registrations for its marks in both stylized and typed form, and the record shows use in various forms.

When marks being compared are identical this is a fact that "weighs heavily against applicant." *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Even when the marks have slight differences but are identical in many respects, the factor will weigh heavily against the applicant. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) ("The identity of words, connotation, and commercial impression weighs heavily against the applicant."); *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718, 1729 (TTAB 1998) ("marks are identical in sound and virtually identical in the visual and connotative impressions they create, a factor that weighs heavily against applicant").

3. Comparison of the Goods and Services

As for the involved goods and services, applicant's identified goods are watches, clocks and jewelry, while the goods and services identified in opposer's registrations are the clothing items "hats, tops and bottoms" and "t-shirts, shirts and polo shirts" as well as "retail store services featuring clothing and related accessories."³¹ Applicant's goods and opposer's hats, shirts, tops and bottoms are goods distinctly different in type. When the goods of the parties are, as in this case, specifically different, the opposer must show that the respective goods have some viable relation or that they are marketed or promoted under circumstances and conditions that could bring them to the attention of the same purchasers or prospective customers in a manner that would cause reasonable consumers to assume, because of the parties' marks, that the respective goods share a common source or sponsorship. See, e.g., *Amcors, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981). Further, when the marks in question are substantially identical, as they are here, their contemporaneous use can lead to the assumption that there is a common source "even when [the] goods or services are not competitive or intrinsically related." *Shell Oil*, 26 USPQ2d at 1689.

³¹ We do not compare to applicant's goods the non-clothing items on which opposer has used its mark, but which are not listed in its registrations. As we have already noted, opposer's evidence fails to establish its priority of use in regard to such goods.

Thus, when "marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion." *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

While it may be surmised that, for the fashion conscious, jewelry and watches may be coordinated with clothing, there is nothing in the record on the subject. Thus, we cannot conclude that these particular goods are so complementary that one would, for example, shop for a watch with one's tops or bottoms in mind. Nor can we conclude that opposer's retail store services are related to applicant's identified goods, for opposer has not put any evidence in the record to establish the extent to which retail clothing stores may market watches or jewelry. There is no evidence that opposer has sold such items in its stores; and we decline to theorize about the unlikely possibility that opposer might choose to sell applicant's MICHAEL STAR watches in opposer's MICHAEL STARS retail clothing stores and thereby create a likelihood of confusion. Finally, there is no evidence that owners of retail clothing stores routinely sell watches under the marks of their stores, in stores not their own. In short, the record does not show that the goods and services covered

by opposer's registrations compete with or are complementary to applicant's identified goods. That conclusion, however, does not end our comparison of the goods and services.

The parties have stipulated that there are numerous marks registered for, and used in the marketplace for, both clothing items and watches. See findings of fact 1 and 2. In addition, two stipulated users of marks for clothing have applications pending to register the marks for watches. Findings of fact 4 and 5. Of the numerous marks registered for and used for both clothing items and watches, some are marks of designers, while others appear simply to be brands that have been successfully used for a variety of goods. In addition, applicant testified that he was aware that marks are used for both watches and clothing.

We conclude that opposer's clothing items and applicant's watches, at least, are related for likelihood of confusion purposes. Though we have not found opposer's mark to be famous, it has developed a degree of renown and strength. Further, although its evidence of use of the mark for items other than those covered by its registrations is very limited, it is evidence of expansion, so that in its own stores opposer's customers would be exposed to opposer's mark on various products. Such individuals, when subsequently encountering applicant's watches in separate retailers, would be likely to assume a relationship of some

kind. Similarly, consumers who have purchased MICHAEL STARS clothing items in specialty stores or department stores would also assume a relationship between the source of such clothing and the source of a MICHAEL STAR watch.

4. Channels of Trade, Classes of Consumers

The record shows that opposer utilizes various trade channels, specifically, the Internet, specialty stores, department stores, and its own stores. In short, it utilizes many typical channels of trade for clothing items; and its registrations are not limited to particular channels of trade. Its primary class of customers is women.

However, opposer's registrations for its marks for clothing items are not limited to clothing items for women and must be read to include hats, tops, bottoms, shirts, t-shirts and polo shirts for all classes of consumers, including men, women and children. See *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corporation*, 565 F.2d 683, 196 USPQ 1, 2 (C.C.P.A. 1977) ("Opposer's rights are not tied to its current business practices, which may change at any time. It's rights are as broad as its registration...").

Similarly, whatever limited channels of trade applicant may utilize, or whatever limited classes of consumers its watches may appeal to, are immaterial, as applicant's identification is not restricted in any way. See *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661

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(TTAB 2002) ("We must presume that applicant's goods include all types of road maps, and not just the types of road maps applicant actually markets under the mark at this time.").

For our purposes, we assume that applicant's watches and jewelry can be marketed online, through specialty stores and department stores, and to men, women and children.

Therefore, for the likelihood of confusion analysis, we must assume that opposer's clothing items and applicant's watches and jewelry items include items for all possible consumers and may travel in any typical channels of trade for such items. *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007).

5. Conditions Under Which and Buyers to Whom Sales are Made

This is the *DuPont* factor that considers whether purchases of the involved goods may be made on impulse or with less deliberation by purchasers, or following careful consideration of the goods by discriminating purchasers. Again, because the identifications are not limited, we must assume that opposer's clothing items and applicant's watches and jewelry include even inexpensive items that may be purchased on impulse as, for example, because the purchaser simply likes the look of the item.

6. Number and Nature of Similar Marks in Use

There is no evidence of record that shows MICHAEL STARS or MICHAEL STAR, or even variations of these, in use by third-parties.

7. Actual Confusion; Length of Concurrent Use

There is no evidence in the record of actual confusion. This is not, however, particularly significant, as applicant's sales have been rather limited. Moreover, the test is likelihood of confusion and it is not necessary for actual confusion to be present before the Board can find a likelihood of confusion to exist. See *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983). Further, we disagree with applicant's contention that there has been a period of five years of concurrent use without actual confusion. As noted earlier, the record does not support applicant's claimed first use and applicant is entitled, at best, to rely on the filing date of his application. The period of concurrent use is much shorter than applicant contends.

8. Does Any Right of Applicant to Exclude Others from Use of His Mark Trump Any Right of Opposer to Expand Use of its Mark?

One *DuPont* factor is the extent to which the applicant may have a right to exclude others from use of his mark for

his goods.³² The natural expansion rights of an opposer are not a listed *DuPont* factor, but certainly may be considered in the overall *DuPont* analysis, which allows for consideration of other established facts probative of the effect of use. Accordingly we consider in tandem applicant's right to exclude and opposer's natural expansion rights.

An individual does not have an unqualified right to use of or registration of his own name as a trademark. *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 21 USPQ2d 1824 (9th Cir. 1992), *Peter Luger Inc. v. Silver Star Meats Inc.*, 63 USPQ2d 1555 (W.D. Pa. 2002); Cf. *Martin v. Carter Hawley Hale Stores, Inc.*, 206 USPQ 931 (TTAB 1979) (individual opposer unable to prevent registration of his name by a corporation as a product mark). The record does

³² In its brief, applicant relies on Sections 2(c) and 43(a) of the Trademark Act to support a claimed right to exclude others from using MICHAEL STAR. Brief, p. 35. Opposer argues that reliance on these sections of the statute is misplaced. Rebuttal brief, p. 14. While we agree that Section 43(a) is inapposite and that the Section 2(c) argument is more properly considered as a claim which applicant might later make against opposer's application to register MICHAEL STARS for watches, we accept the argument's invocation of Section 2(c) as merely an attempt to demonstrate why, under this *DuPont* factor, applicant believes he has a right to exclude others from use of the mark MICHAEL STAR. However, we do not agree with applicant's conclusion that any presumptive right he may have to exclude others from using his name, "Michael Starr," for watches would necessarily extend to MICHAEL STAR or MICHAEL STARS. In this regard, we agree with opposer that applicant's reliance on *Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269, 1274 (TTAB 1999), is misplaced. That case only holds that the protection of Section 2(c) extends to an individual's full name, surname, or nickname. It does not hold that such protection covers misspellings of a name or phonetic equivalents of a name.

not support applicant's claim that his own name, "Michael Starr," has been used as a trade name or in any way that would make the purchasing public aware of the name, so that adoption of the involved mark could be tacked onto or be considered a natural consequence of any such use. Nor does the record support applicant's claim that commercial purchasers of watches for later retail sale would recognize MICHAEL STAR on watches as an indication of source in applicant, for applicant testified that his watches are marketed under the Too Stars name. Even if recognition of applicant by commercial purchasers had been shown by probative evidence, it would not alter the fact that the purchasing public would not recognize MICHAEL STAR as indicating a watch from applicant, for there is no evidence of record that ultimate purchasers of watches are familiar with applicant's name.³³ On this record, any right of applicant to exclude others from using MICHAEL STAR is extremely limited and would stem from applicant's limited actual use of the mark. We must balance this against opposer's asserted right to continue expansion of the goods sold under its mark and the stipulated evidence that shows numerous instances in which the same mark is used for, and registered for, both clothing and watches.

³³ We do not find credible applicant's testimony that he has personally provided telephone customer service to millions of purchasers of his watches.

As applicant has observed, brief, p. 21, "a trademark owner cannot by the normal expansion of its business extend the use or registration of its mark to distinctly different goods or services not comprehended by its previous use or registration where the result could be a conflict with valuable intervening rights established by another through extensive use and/or registration of the same or similar mark for like or similar goods or services." *American Stock Exchange, Inc. v. American Express Company*, 207 USPQ 356, 364 (TTAB 1980). In this case, opposer's expansion to the distinctly different goods of watches would not be comprehended by its previous use or registration. On the other hand, such expansion appears entirely natural based on the stipulated facts in the record. We do not find compelling applicant's argument, brief, pp. 24-25, that other evidence shows many USPTO records for marks that include both "shirts" and various other wildly disparate terms and therefore the evidence showing clothing and watches to be related should be discounted. Applicant did not put in the record the actual records and, as previously noted, we have no context in which to weigh them. While we have no doubt that a ubiquitous clothing item such as a t-shirt may appear in many registration records that also list very different goods, it does not follow that it would not be a natural expansion for opposer to utilize its mark

for clothing, accessories and, later, watches, especially given the evidence that others have done just that. In addition, opposer's expansion would not conflict with intervening rights established through "extensive use." As noted, applicant's use of the involved mark for watches has been rather limited.

Applicant argues, brief, p. 21, that opposer's natural expansion rights must be assessed as of 2002, when applicant first began using his mark for watches. First, as we have repeatedly noted, the record does not support use by applicant of his mark in 2002 or even as of the dates of use claimed in his application. Second, applicant's reliance on the *Viking Boat*³⁴ case is misplaced. In that case, the applicant had been using its mark for nine years before the opposer expanded use of its mark and came into conflict with the applicant; and the record did not show that it would have been natural for opposer to expand into applicant's field at the time applicant entered. *Id.* at 303. In the present case, in contrast, it is clear that it would have been natural for opposer to expand its business into watches even prior to the filing date of applicant's involved application.

9. Nature of the Involved Marks

³⁴ *Viking Boat Co., Inc. v. Viking Camper Supply, Inc.*, 191 USPQ 297 (TTAB 1976).

Opposer's mark is a house mark, registered and/or used for clothing items, retail store services, and, more recently, related non-clothing items. Applicant's mark is only one of various product marks he has used and/or registered for watches.

10. Other Probative Facts

Though applicant lives in and opposer conducts its business out of California, applicant testified he was not aware of opposer until the opposition. Further, there is no evidence of bad faith adoption by applicant. Nonetheless, while applicant has previously registered other trademarks, he engaged in no search or investigation prior to adopting the MICHAEL STAR mark for watches. Given his admitted knowledge that the same mark may be used for both clothing and watches, applicant assumed a certain amount of risk in adopting his mark without any investigation.

11. Balancing the *DuPont* Factors

We find this to be a close case, because applicant has actually used its mark for watches, although not as early as claimed and in a rather limited manner, while opposer has only evidenced an intent to do so. But applicant has no guaranteed right to expand his collection of marks to include his name merely because it is his name or because he has been in the watch business for many years. Opposer's mark, while not presently famous, is strong and apparently

growing stronger, and has been used for an increasing range of products. Thus, any qualified right applicant might have had to change course after many years in the business without using his name as a mark and to begin use of a variant of his name, must be contrasted with the demonstrated strength of opposer's mark at the time applicant, without doing any search or investigation, decided to adopt a mark virtually identical to that of opposer. Further, as demonstrated by the stipulated evidence, consumers would expect clothing items and watches bearing indistinguishable marks to come from the same source, or have common sponsorship. Under these circumstances, there is a likelihood of confusion.

Opposer's Dilution Claim

Having established its standing to bring its claim under Section 2(d), opposer faces no independent requirement to prove standing for its dilution claim. However, opposer's dilution claim fails for two reasons. First, the fame that must attach to a mark for it to be eligible for protection under the dilution provisions of the Trademark Act is greater than that which qualifies a mark as famous for the *DuPont* analysis of likelihood of confusion. *Palm Bay Imports*, 73 USPQ2d at 1694 ("Fame for likelihood of confusion purposes and fame for dilution purposes, however, are distinct concepts."). See also, *Toro Co. v. ToroHead*

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Inc., 61 USPQ2d 1164, 1170 (TTAB 2001). We have already ruled that opposer's mark does not have *DuPont* analysis fame, and it follows that it does not have the fame necessary for a dilution claim. Second, opposer has presented only argument and not evidence on the issue of whether blurring or tarnishment is likely to result.

Conclusion

Opposer's dilution claim is dismissed. The opposition, however, is sustained because there is a likelihood of confusion and opposer has proven its claim under Section 2(d).