

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Blair Corporation and Blair LLC
v.
Tami T. Fassinger

Opposition Nos. 91166414 and 91171088
to application Serial No. 76541910
filed on August 21, 2003

Laura C. Gustafson of Pillsbury Winthrop Shaw Pittman LLP
for Blair Corporation and Blair LLC.

Melissa M. Allen of Melissa M. Allen, P.A. for Tami T.
Fassinger.

Before Quinn, Drost and Bergsman, Administrative Trademark
Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Tami T. Fassinger ("applicant") filed an intent-to-use
application for the mark MALLORY VALERIE BLAIR, in standard
character form, for goods ultimately identified as follows:

Jewelry; plastic necklaces; plastic bracelets; plastic
rings, in Class 14;

Series of fictional books for children; stationery;
note pads; paper goods, namely, art paper, craft paper
and drawing paper; stickers, in Class 16;

Purses, in Class 18;

Clothing for children, namely, t-shirts, dresses, pajamas, underwear, socks; children's halloween costumes; fabric head bands; headbands, bandanas, in Class 25;

Hair accessories, namely, twisters, claw clips, snap clips, hair bands, plastic barrettes, hair bows, in Class 26; and,

Dolls; stuffed dolls; rubber dolls; rag dolls; plastic dolls; paper dolls; plush toys; doll clothing and doll accessories sold as a unit therewith; puzzles, in Class 28.

Applicant identified MALLORY VALERIE BLAIR as a fictitious name.

Blair LLC, fka Blair Holdings, Inc., and its exclusive licensee Blair Corporation ("opposers"), a wholly-owned subsidiary of Blair LLC, opposed the registration of applicant's mark on the grounds of priority and likelihood of confusion and dilution.¹ Specifically, opposers alleged prior use and ownership of the federally-registered marks BLAIR, BLAIR BOUTIQUE, BLAIR PLUS and JOHN BLAIR for a wide variety of goods and services, including jewelry, clothing, giftware and retail and mail order services in connection with such products. In addition, opposers alleged that its BLAIR marks became famous prior to the filing date of applicant's application and that therefore applicant's mark

¹ Blair Holdings, Inc., an original opposer, was converted to a limited liability company from a corporation and changed its name to Blair LLC. On May 21, 2008, opposers filed a motion, with consent, to change the caption of the proceeding to substitute Blair LLC for Blair Holdings, Inc. The motion is granted.

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MALLORY VALERIE BLAIR is likely to cause confusion and dilution with opposers' marks.²

Applicant denied the essential allegations in the notices of opposition.

The Record

By rule, the record includes applicant's application file and the pleadings. Trademark Rule 2.122(b), 37 CFR §2.122(b). In addition, the parties agreed to submit their testimony and evidence through stipulations of facts and exhibits filed by both parties. As part of their exhibits, both parties included the discovery deposition of applicant without any exhibits, except the Thomson & Thomson search report, referenced in the deposition. Finally, opposers' stipulation was missing Exhibits 8-47, 61-62, 66-84, 91, 96, and 114. However, because of the description of the exhibits in the stipulation of facts, the failure of applicant to object to opposers' characterization of their exhibits, and the narrow parameters under which we consider the goods and services at issue, the missing exhibits would not have changed our decision in this case.

² As discussed below, opposers claimed for the first time in their brief that applicant did not have a *bona fide* intent to use her mark at the time she filed her application. That issue was tried by implied consent.

Standing

Opposers introduced certified copies of their pleaded registrations prepared by the U.S. Patent and Trademark Office showing their current status and title. Because opposers have properly made their pleaded registrations of record, opposers have established their standing.

Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

Because opposers' pleaded registrations are of record, Section 2(d) priority is not an issue in this case. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In instances where opposers relied on their common law rights, we have discussed the evidence establishing opposers' priority.

Applicant's Bona Fide Intent To Use Her Mark

Relying on statements made by applicant during her deposition, opposers argue the unpleaded claim that applicant's application is void *ab initio* because applicant did not have a *bona fide* intention to use her mark in commerce on the products as of the filing date of her application. Applicant did not object to opposer's

questions on this subject during her deposition and she did not raise an objection in her brief to opposers' argument on this issue. Moreover, applicant addressed this issue on the merits in her brief. Thus, we find that the issue of applicant's *bona fide* intent to use her mark was tried by the parties with applicant's implied consent. The notices of opposition are deemed amended under Fed. R. Civ. P. 15(b) to conform to the evidence and to assert the claim.

The parties stipulated to the following facts:

Applicant's intention has been that, in connection with getting her book published, and the "Mallory Valerie Blair" character and story known, that she would then create a series of products related to the character and story;³

Applicant has a *bona fide* good faith "intention" to use the Applicant's mark on all of the goods included in her application;⁴ and,

Notwithstanding her efforts to obtain a publishing deal as set forth above in Paragraph No. 16 above, Applicant at this time has a good faith *bona fide* intention to use the mark in each class and for each good for which she had sought registration, but given the prospective nature of the use, she has not actually used the mark on the goods identified in her application.⁵

³ Stipulation of facts filed by applicant, ¶10.

⁴ Stipulation of facts filed by applicant, ¶15.

⁵ Stipulation of facts filed by applicant, ¶17.

Despite stipulating to applicant's *bona fide* intention to use her mark in commerce, opposers argue that applicant did not have a *bona fide* intent to use the mark when she filed her application.⁶ Opposers contend that applicant's core business objective is to publish a series of children's books entitled MALLORY VALERIE BLAIR and that "at best [she] has a contingent secondary intent to use her mark for the claimed goods."⁷ (Emphasis in the original).

Q. Do you right now, sitting here today, have a bona fide intent to use everything in your trademark application other than the series of books?

A. I have an intent to use those categories, assuming that the book is launched successfully.

Q. And that's all dependent upon the successful launch of the book, correct?

A. That line of products is all tied to the successful launch of a book, a character in a book.⁸

⁶ In their Reply Brief, opposers argue that because applicant had made certain stipulations, she was estopped from contradicting them. According to opposers, "You cannot stipulate to facts then parse them to death or wish them away." (Opposers' Reply Brief, pp. 1-2). For some unexplained reason, opposers contend that even though they stipulated to applicant's *bona fide* intent to use her mark in commerce, that fact is not binding on opposers and they may challenge the validity of the stipulation. Suffice it to say, opposers are bound by the stipulation of facts. In any event, because the parties have argued the issue on the merits in their briefs, we will decide the issue on the merits.

⁷ Opposers' Brief, p. 12.

⁸ Fassinger Dep., pp. 178-179.

In addition, opposers point out that applicant has no definite plan for marketing the other products because she is concentrating on getting her book published and therefore, she has no product mock-ups, no packaging or tags featuring the mark, or any other documents corroborating applicant's intent to use the mark MALLORY VALERIE BLAIR.⁹

On the other hand, applicant asserts that opposers have mischaracterized applicant's testimony to mean that she has no intention to use her MALLORY VALERIE BLAIR mark with any products other than her literary work. Applicant contends that she has clearly testified that her plan is to first sell her series of books, and the literary character MALLORY VALERIE BLAIR, followed by the marketing of the associated products identified in her application.¹⁰

Q. And once they are published [the MALLORY VALERIE BLAIR books], you would hope that there would be clothes for children with the Mallory Valerie Blair character on it, right?

A. That's speculative, certainly, but it would be my reasons behind applying for the thorough (sic) merchandising copyright.

Q. Trademark?

A. Trademark, thank you.

Q. And you would expect that, if successful, you would have the

⁹ Opposers' Brief, pp. 12-13.

¹⁰ Applicant's Brief, pp. 11-14

Mallory Valerie Blair name on clothes, correct?

A. My intention would be to have some Mallory Valerie Blair products which might include clothes. It would be, I guess, speculative or undetermined whether her whole name would appear on such items or not.

Q. But the character would be known as Mallory Valerie Blair?

A. The character. And the character's (sic) definitely Mallory Valerie Blair, and the products tie into the character very much.

Q. And tie into the name, correct?

A. To the name Mallory Valerie Blair.

Q. So could you envision the tag on the T-shirt or sweat shirt saying Mallory Valerie Blair Collection?

A. Could I envision that, Yes. Is that a definite plan? No.

Q. What's the definite plan with regard to the clothes that you've applied for on your trademark application?

A. There is no definite plan at this stage. And I want to reiterate, I'm concentrating on getting a book deal to create the character. And until the character's known, these other categories [of products] don't make logical sense.¹¹

* * *

Q. Based on your trademark application, what would you hope would happen?

¹¹ Fassinger Dep., pp. 60-62.

A. My hope and my wildest dreams would be that that first book goes into a second printing very quickly, that they quickly ask me to put my finishing touches on the other books in that series . . . and that if I was able to get their brand out about the Mallory Valerie Blair character, that I would figure out a channel to go into these other categories. And that may be something that was done through the book publisher, so I can only speculate based on what that contract might be or not be.¹²

* * *

Q. But you've also filed a trademark application based on the name Mallory Valerie Blair, and that's for clothes, right? Your trademark application?

A. The trademark would include clothing related to the character in the story that would appeal to people who like the character.

Q. And the clothes would relate to the trademark Mallory Valerie Blair, right?

A. The clothes would relate to the trademark and to the character Mallory Valerie Blair.

Q. Right now it seems fairly speculative, so let me ask you this question: Do you have a bona fide intent, besides the children's books, to market and offer these other goods, besides the books in your trademark application?

Q. I intend to use all of these or I would not have gone through the

¹² Fassinger Dep., pp. 77-78.

trouble to do what I've done, but it's all intent at this point.

A. But you've certainly tried to sell your book and the name and the idea to at least four publishers, right?

Q. And that is what I intend to continue to do, is to start with trying to get this character known through a book.¹³

* * *

Q. So until you have a book deal you don't have any plans to use a Mallory Valerie Blair trademark for jewelry and the other classes that you have applied for, correct?

A. I don't currently have any plans to do anything without first trying to get a book deal because, again, the products are tied to a character and a story.¹⁴

* * *

Q. So you've never put the Mallory Valerie Blair name on any type of clothing or accessories, right?

A. I have not. That's just an intent to use that category because this is all based on getting a story and a character known for children.

Q. So right now everything, other than the series of books, is a speculative intent and not an actual intent, correct?

A. I intend to be able to use these categories once I get success with the book, and I do intend to that, yes.¹⁵

¹³ Fassinger Dep., p. 89-90

¹⁴ Fassinger Dep., p. 115.

¹⁵ Fassinger Dep. 118-119.

Applicant further explained that MALLORY VALERIE BLAIR is a character in applicant's story whose hair changes color with her moods.¹⁶ Applicant envisions that girls would use their MALLORY VALERIE BLAIR stationery, clothes, jewelry, etc. to reflect their moods (e.g., "If they're happy, they would use their yellow stationery; if they're sad, they'd use their blue stationery; if they're angry, they'd use their red, and so forth").¹⁷

"As the various reports and other legislative history regarding the Trademark Law Revision Act of 1988 make clear, it was the intent of Congress in enacting Section 1(b) that the bona fide requirement thereof focus on an objective good-faith test to establish that an applicant's intent is genuine." *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1506 (TTAB 1993). An applicant's bona fide intention to use a mark must reflect an intention that is firm, though it may be contingent on the outcome of an event (that is, market research or product testing)." *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d at 1506 n.7.

Trademark Rule 2.89, 37 CFR §2.89, provides several specific examples of efforts to make use of a mark sufficient to support a request for an extension of time to

¹⁶ Stipulation of facts filed by applicant, ¶4.

¹⁷ *Fassinger Dep.*, pp. 63-71.

file a statement of use. These examples are illustrative of efforts that support an applicant's *bona fide* intention to use a mark and are applicable in this case. "Those efforts may include product or service research or development, market research, manufacturing activities, promotional activities, steps to acquire distributors, steps to obtain governmental approval or other similar activities." In this case, applicant has undertaken steps to acquire manufacturing capabilities and promotional activities (*i.e.*, publishing her book) so that the MALLORY VALERIE BLAIR character becomes a desirable "brand" or character that can be marketed on jewelry, clothing, hair accessories and toys.

In view of the foregoing, we find that applicant's testimony pertaining to the formulation and implementation of her plan to market the products listed in her application is credible. We are further persuaded that, despite the lack of a corroborating business plan or other documents, applicant has a real and legitimate intention to use the mark MALLORY VALERIE BLAIR on all of the products listed in her application.¹⁸

¹⁸ The fact that opposers have stipulated to applicant's *bona fide* intent to use the mark MALLORY VALERIE BLAIR in connection with all the goods listed in the application is further support for our finding.

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 issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. Whether opposers' BLAIR marks are famous?

This *du Pont* factor requires us to consider the fame of opposers' marks. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the mark at issue, "by the length of time those indicia of commercial awareness have been evident," widespread critical assessments and notice by independent sources of the products identified by the mark, as well as

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the general reputation of the products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309.

Opposers have been rendering retail and mail order services under the BLAIR mark and selling products bearing the BLAIR mark since the 1920's.¹⁹ Those products include clothing, clothing accessories, including purses, giftwares, including dolls, and home furnishings.²⁰ From 2000 - 2005, sales of goods and services attributable to opposers' BLAIR trademarks have ranged from a low of \$457,000,000 to a high of \$582,000,000.²¹

Opposers advertise and promote their products and services through the mail, the Internet, and magazines and newspapers.²² Opposers' website at www.blair.com has had millions of visitors each year (e.g., 7,131,000 in 2002, 11,461,000 in 2003, 11,975,000 in 2004, 14,086,000 in 2005,

¹⁹ Stipulation of facts filed by opposer, ¶26.

²⁰ Stipulation of facts filed by opposer, ¶7.

²¹ Stipulation of facts filed by opposer, ¶7.

²² Stipulation of facts filed by opposer, ¶14.

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and 13,718,000 through October in 2006).²³ Opposers "distribute[s], via mail or ad placements, on average approximately One Hundred Million BLAIR catalogs, mailers, and print media inserts each month, for an annual total since 2000 of about 1.3 Billion separate mailings per year." (Emphasis in the original).²⁴ Opposers' "apparel is also regularly advertised in widely circulated periodical publications such as Woman's Day, National Enquirer, NewsAmerica National Examiner, Modern Maturity, Valassis and others. . . . Weekly and monthly circulations of these publications are in the millions."²⁵ As a result, opposers' advertising and marketing expenses between 2000 and 2006 for goods and services featuring opposers' BLAIR marks have exceeded \$100,000,000 per year.

Although opposers have not placed their sales and advertising figures in context, the sheer numbers alone display consumer awareness of opposers' retail and mail order sales services in two ways: the extensive sales illustrate the vast number of purchases that have been made by consumers and the extensive advertising demonstrates that the public has been bombarded with opposers' advertising and marketing efforts. Accordingly for purposes of determining likelihood of confusion, we find that opposers' BLAIR mark

²³ Stipulation of facts filed by opposer, ¶13.

²⁴ Stipulation of facts filed by opposer, ¶15.

²⁵ Stipulation of facts filed by opposer, ¶20.

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is famous for opposers' retail and mail order services. However, the evidence is not sufficient to establish that any particular BLAIR mark is famous for any particular product.

B. The similarity or dissimilarity and nature of the goods and services as described in the application and registrations at issue.

The issue in an opposition is the right of the applicant to register the mark for the goods identified in the application. "The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed". *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 UPSQ2d 1001, 1004 (Fed. Cir. 2002).

As the Court of Customs and Patent Appeals, the predecessor of our reviewing court, explained in *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981):

Here, appellant seeks to register the word MONOPOLY as its mark without any restrictions reflecting the facts in its actual use which it argues on this

appeal prevent likelihood of confusion.
We cannot take such facts into
consideration unless set forth in its
application.

Likewise, we must consider the goods as set forth in applicant's application without considering her testimony that these products are intended to be sold in connection with a children's story. Because there are no restrictions or limitations in applicant's description of goods, we must presume that the listed products include all types of jewelry, children's clothing, hair accessories, and dolls and puzzles, not just the type that applicant intends to market. *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

1. Class 14.

Applicant is seeking to register the mark MALLORY VALERIE BLAIR for jewelry, plastic necklaces, plastic bracelets, and plastic rings. Opposers have registered the mark BLAIR for jewelry.²⁶ In addition the parties have stipulated that opposers sell costume jewelry.²⁷ The goods of the parties are in part identical and applicant's plastic bracelets, necklaces and rings are otherwise related to opposer's jewelry.

²⁶ Registration No. 2008690, issued October 15, 1996; Sections 8 and 15 affidavits accepted and acknowledged; renewed.

²⁷ Stipulation of facts filed by opposers, ¶27.

2. Class 16.

Applicant is seeking to register the mark MALLORY VALERIE BLAIR for a series of fictional books for children, stationery, note pads, paper goods, namely, art paper, craft paper and drawing paper, and stickers. Opposers' BLAIR retail stores sell books, office items, gift wrap, and craft items.²⁸ In addition, opposers have registered the mark BLAIR for "mail order and retail store services in the field of giftwares."²⁹ "Giftware" is defined as "wares or goods suitable for gifts," and therefore applicant's products in Class 16 falls within the definition of giftware.³⁰ However, the books, office items, gift wrap, and craft items that opposers sell are third-party merchandise.³¹ In this regard, opposers argue that "the services of selling a product is closely related to the product itself."³² In other words, opposers contend that because they sell books, office items, gift wrap and craft items, their mail order

²⁸ Stipulation of facts filed by opposers, ¶27.

²⁹ Registration No. 2134847, issued February 3, 1998, Sections 8 and 15 affidavits accepted and acknowledged. Subsequent to the close of their testimony period, opposers renewed the registration. In case there is any question regarding opposers' priority with respect to the goods in Class 16, opposers' Exhibit 97 establishes their sales of books, office items, gift wrap and craft items as early as 2002. Applicant filed its application on August 21, 2003.

³⁰ Webster's Third New International Dictionary of the English Language (Unabridged), p. 956 (1993). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

³¹ Stipulation of facts filed by opposers, Exhibit 97.

³² Opposers' Brief, p. 29.

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and retail store services are related to applicant's series of fictional books, stationery, note pads, paper goods, namely, art paper, craft paper and drawing paper, and stickers.

Retail store and mail order services and the goods that may be sold through those services are related goods and services for the purpose of determining likelihood of confusion. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1983); *In re Thomas*, 79 USPQ2d 1021, 1023 (TTAB 2006); *Steelcase, Inc. v. Steelcare, Inc.*, 219 USPQ 433, 435. (TTAB 1983). Consumers are apt to assume that a well-known retail store and mail order house bearing the same or a confusingly similar name as applied to the products sold therein emanate from a single source. However, the mere fact that an applicant's goods are of a type sold in opposers' outlet is, in itself, insufficient to support a holding of likelihood of confusion if we ultimately find that the marks are dissimilar.

3. Class 18.

Applicant is seeking to register the mark MALLORY VALERIE BLAIR for purses. Opposers sell purses through their BLAIR retail store services and mail order services.³³

³³ Stipulation of facts filed by opposers, ¶¶7, 11, 16, 22, and 47.

Because opposers do not have a registration for purses or the retail sale of purses, they must rely on their common law use of the BLAIR mark to prove priority. In this regard, the excerpts from opposers catalogs, bearing the mark BLAIR, from 2000-2003³⁴ prove that opposers were offering to sell purses prior to the filing date of applicant's application (August 21, 2003).

Opposers argue that because they place the BLAIR mark on every box and package they ship, opposers make trademark use, as well as service mark use of BLAIR in connection with purses. We do not agree. Opposers' exhibits show that opposers sell the purses of other manufacturers (e.g., Easy Street and 220 Hickory). Accordingly, consumers are not going to perceive opposers as the source of the product bearing third-party trademarks because the products are placed in a shipping box or package displaying the BLAIR mark after purchase. Consumers will, however, perceive opposers as the source of the retail store or mail order services. In other words, consumers will view the purse as one bought from BLAIR, but not a BLAIR brand purse. See *In re The Pennsylvania Fashion Factory, Inc.*, 588 F.2d 1343, 200 USPQ 140,142 (CCPA 1978), *aff'g* 198 USPQ 568 (TTAB 1978) ("the mere fact that appellant's goods are placed in bags (bearing the words sought to be registered) during a

³⁴ Stipulation of facts filed opposers, Exhibits 105-108.

particular phase of the transportation process does not, ipso facto, establish trademark usage of those words”).

Nevertheless, as indicated above, for purposes of determining likelihood of confusion, consumers are apt to believe that there is some sort of association or affiliation between a well-known retail store and mail order house bearing the same or a confusingly similar name as applied to the products sold therein.

4. Class 25.

Applicant is seeking to register the mark MALLORY VALERIE BLAIR for children's clothing, namely, t-shirts, dresses, pajamas, underwear, socks, children's halloween costumes, fabric headbands, headbands, and bandanas. The parties have stipulated that opposers' sell children's clothes³⁵ and that “[a]dults routinely shop for and purchase clothing for children from the same sources and stores that sell clothing for adults.³⁶ In addition, opposers have registered the following marks:

- a. JOHN BLAIR for men's and boys' outer shirts;³⁷
- b. JOHN BLAIR for men's and boys' outer shirts, sweaters, sport jackets, casual jackets and blazers;³⁸

³⁵ Stipulation of facts filed by opposers, ¶27.

³⁶ Stipulation of facts filed by opposers, ¶47.

³⁷ Registration No. 0790047, issued May 25, 1965; Sections 8 and 15 affidavits accepted and acknowledged; second renewal.

³⁸ Registration No. 0910968, issued April 6, 1971; Sections 8 and 15 affidavits accepted and acknowledged; second renewal.

- c. BLAIR for mail order services in the field of men's and women's apparel;³⁹
- d. BLAIR for retail store services in the field of men's and women's apparel;⁴⁰
- e. BLAIR BOUTIQUE for women's apparel, namely, jackets, skirts, pants, blouses and tops;⁴¹ and,
- f. BLAIR for mail order services in the field of apparel.⁴²

In view of the foregoing, we find that the parties use their marks to identify identical items of clothing.

5. Class 26.

Applicant is seeking to register its mark MALLORY VALERIE BLAIR for hair accessories, namely, twisters, claw clips, snap clips, hair bands, plastic barrettes, and hair bows. Opposers sell hair accessory kits comprising barrettes and bobby pins.⁴³ Opposers assert that hair accessories may be characterized as jewelry, and therefore we can rely on opposers' registration for the mark BLAIR for jewelry to establish its priority.⁴⁴

³⁹ Registration No. 1563972, issued October 31, 1989; Sections 8 and 15 affidavits accepted and acknowledged.

⁴⁰ Registration No. 1624256, issued November 20, 1990; Sections 8 and 15 accepted and acknowledged; renewed.

⁴¹ Registration No. 1626066, issued December 4, 1990; Sections 8 and 15 affidavits accepted and acknowledged; renewed.

⁴² Registration No. 2061091, issued May 13, 1997; Sections 8 and 15 affidavits accepted and acknowledged; renewed.

⁴³ Stipulation of facts filed by opposers, Exhibit 63 (excerpts from opposers website dated February 21, 2007).

⁴⁴ See footnote 26. As explained more fully below, we agree with opposers to the extent that applicant's hair accessories and opposers' jewelry may be related products, but because they are in different international classes, we will not consider them to be identical. See *In re RSI Systems, LLC*, ___ USPQ2d ___ (TTAB September 29, 2008).

To support its contention that hair accessories may be characterized as jewelry, opposers reference excerpts from the Amazon.com website that offers the sale of gold and sterling silver hair combs, crystal hair clips and ponytail holders, onyx barrettes, and topaz hair clips.⁴⁵ These products were identified as jewelry by Amazon.com even though they performed the same function as hair accessories.

In addition, "jewelry" is defined as "ornamental pieces (as rings, necklaces, bracelets) made of materials that may or may not be precious (gold, silver, glass, plastic) often set with genuine or imitation gems and worn for personal for personal adornment."⁴⁶ Applicant's description of goods comprising hair accessories would include items that are very similar to items of jewelry that are worn in a person's hair for personal adornment. Accordingly, we find that applicant's hair accessories and opposers' jewelry are related and that opposers' may rely on their jewelry registration to establish their priority.

6. Class 28.

Applicant is seeking to register its mark for dolls, stuffed dolls, rubber dolls, rag dolls, plastic dolls, paper

⁴⁵ Stipulation of facts filed by opposers, Exhibit 113. Opposers failed to include Exhibit 114, excerpts from the Alibaba.com website purporting to show hair accessories sold as jewelry items.

⁴⁶ Webster's Third New International Dictionary of the English Language (Unabridged), p. 1215 (1993).

dolls, plush toys, doll clothing and doll accessories sold as a unit therewith and puzzles. The parties have stipulated that opposers sell dolls through their retail store and mail order services⁴⁷ since at least as early as 2002.⁴⁸ As indicated above, consumers are apt to believe that there is some sort of association or affiliation between a well-known retail store and mail order house bearing the same or a confusingly similar name as applied to the products sold therein.

C. The similarity or dissimilarity of likely-to-continue trade channels.

Because there are no limitations as to channels of trade or classes of purchasers in either the application or the registrations, it is presumed that the registrations and the application encompass all of the goods and services of the type described in the description of goods and services, that the goods and services so identified move in all channels of trade normal for those goods and services, and that the products are available to all classes of purchasers for the listed products and services. *See In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). Even the products of opposers that are not directly listed in federal registrations would be sold in retail stores and through

⁴⁷ Stipulation of facts filed by opposers, ¶7

⁴⁸ Stipulation of facts filed by opposers, ¶97. *See also* Exhibits 98 and 99 (advertisements for dolls and toys from 1997 and 1998).

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mail order services available to applicant's potential customers.

D. The similarity of the marks in their entirety in terms of appearance, sound, meaning, and connotation.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that the test 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 so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston*,

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Inc., 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Finally, we must keep in mind that when, as here, the opposers' BLAIR trademark is famous for retail and mail order services, it is entitled to a broad scope of protection or exclusivity of use.

When an opposer's trademark is a strong famous mark, it can never be "of little consequence". The fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name.

Specialty Brands, Inc. v. Coffee Bean Distribs., Inc., 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984).

In terms of appearance and sound, we find that the marks are similar to the extent that the marks of the parties share the surname BLAIR. The given name MALLORY VALERIE modifies the name BLAIR and reinforces the impression that BLAIR is a surname. Thus, in accord with considerable case law, the given name MALLORY VALERIE does not alter the commercial impression of the mark. *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (JOSE GASPARGOLD is similar to GASPARGOLD'S ALE); *Nina Ricci, S.A.R.L. v. E.T.F. Enterprises, Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) (VITTORIO RICCI is similar to NINA RICCI); *Somerset Distilling Inc. v. Speymelt Whiskey Distributors Ltd.*, 14

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UPSQ2d 1539, 1542 (TTAB 1989) (JAS. GORDON and design is similar is GORDON'S); *In re Leslie Hennessy, Jr.*, 226 USPQ 274, 276 (TTAB 1985) (LESLIE HENNESSY SELECTION is similar to HENNESSY); *Seligman & Latz, Inc. v. Merit Mercantile Corporation*, 222 USPQ 720, 722 (TTAB 1984) (ARPEL is similar to ADRIEN ARPEL); *Monocraft, Inc. v. Leading Jewelers Guild*, 173 USPQ 506, 508 (TTAB 1972) (PAUL MONET and design is similar to MONET).

In light of the fame of opposers' BLAIR mark, applicant's use of the full name MALLORY VALERIE BLAIR may be perceived as a more specific identification of an individual named "Blair." Therefore, the addition of the given name MALLORY VALERIE is not sufficient to distinguish the marks.

E. Balancing the factors.

As indicated above, when the opposers' BLAIR trademark is strong and famous, it can never be of "little consequence". *Specialty Brands v. Coffee Bean Distributors*, 223 USPQ at 1284 ("The fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name"). Therefore, famous trademarks are entitled to a broad scope of protection or exclusivity of use. In view of the facts that the marks of the parties are similar, that applicant's goods and opposers' goods and services are related, and that

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we must presume that the goods and services of the parties move in similar channels of trade and are offered to the same consumers, opposers have shown that there is a likelihood of confusion. In reaching this decision, we note 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.*, 12 USPQ2d at 1904, quoting *Planter's Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962).

Because we have found that there is a likelihood of confusion, we do not reach the issue of dilution.

Decision: The opposition is sustained and registration to applicant is refused.