

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Purl NYC, LLC

v.

Ellen Rodgers

Opposition No. 91167331
to application Serial No. 76579542
filed on March 3, 2004

Jodi Sax, Esq. for Purl NYC, LLC.

James R. Menker of Smith, Gambrell & Russell, LLP for Ellen Rodgers.

Before Seeherman, Holtzman and Drost, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Purl NYC, LLC has opposed the application of Ellen Rodgers (an individual) to register PURL DIVA, in standard character form, with the word PURL disclaimed, as a mark for "retail store services, namely, a yarn shop featuring yarn, fibers, sewing and knitting accessories and materials, knitting and sewing kits, knitting books, knitting magazines, knitting videos, patterns, knitting needles,

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crochet hooks, knitting tools and equipment, sewing tools and equipment, spinning tools and equipment, weaving tools and equipment, felting tools and equipment, clothing, blankets and toys.”¹

The opposition is based on the ground of likelihood of confusion. Specifically, opposer has alleged that it has been using the marks PURL and PURL SOHO in commerce since at least as early as June 2002; that it has four pending applications for the marks PURL and PURL SOHO, including applications for these marks in Class 35 for retail, mail order and catalog services and online retail services which feature yarn, knitting supplies and merchandise, and related items; that opposer has written a best-selling knitting book, is the subject of myriad articles and books on knitting, expends significant amounts on advertising annually, has a presence at all of the top knitting events in the country, and grosses over \$1 million per year in sales.

Applicant has denied the allegations of the notice of opposition in her answer.

Before discussing what is in the record, we note that the parties stipulated that testimony could be submitted in

¹ Application Serial No. 76579542, filed March 3, 2004, based on Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b) (intent-to-use). The application originally included services in Class 41, but applicant moved to divide the application, and the motion was granted by the Board on October 25, 2007.

the form of affidavits. The parties have also raised a number of objections and filed motions to strike. The Board considered the motions to strike in a 14-page order that issued on October 25, 2007, and we will not revisit them here. As for the objections, opposer raised a number of objections at pp. 31-33 of its trial brief to specific statements or paragraphs in the affidavits submitted by applicant. We regard the objections as being, for the most part, overly technical or based on a misreading of trademark law. We will not burden this opinion with an exhaustive discussion of each objection, but overrule them for the following reasons:

Objection 1. Applicant's evidence that she has registered various domain names is relevant as evidence of her business efforts.

Objection 2. Opposer has objected to applicant's statement that none of her customers has confused her business or name with opposer's business. Opposer argues that applicant has not established that she has asked every single one of her customers, and that she has no personal knowledge of the state of mind of all her customers. Opposer is unduly parsing the statement. A fair reading of the testimony is that no customer has indicated any confusion with regard to opposer, and we regard it as such.

Objection 3. Paragraphs 17, 18, 19 and 23 of Ellen Rodger's affidavit reflect the results of searches applicant did on the Internet and other sources, while Paragraph 5 of Kerstin Glick's affidavit lists yarn shops, knitting blogs, books

and magazines she has encountered that have "pur" in their names. Such evidence is relevant to the strength of opposer's mark, whether or not the stores are using the mark "in commerce" or used the mark prior to opposer's use.

Objection 4. Opposer objects to evidence that "purl" is the name of a stitch in knitting because it "is general knowledge and not contested." Opposer claims that because of this the "evidentiary offering here is also redundant, a waste of time and is a needless presentation of cumulative evidence." However, there is no stipulation in the record that "purl" is a stitch, and without proof, the Board would have to take judicial notice of the meaning of the word.

Objection 5. Applicant's concluding reasons in her affidavit as to why she believes confusion is not likely, while entitled to little probative value, is not redundant. As for the mention of a logo, while she cannot rely on her logo because it is not part of the mark for which registraton is sought, the mention is so brief and is so tangential to the paragraph as a whole that we have considered the entire paragraph for whatever probative value it may have.

Objection 6. Opposer objects to the "cookie cutter" language used in the affidavits of applicant's 16 witnesses. We find it ironic that opposer should complain of "cookie cutter" language in view of the fact that the affidavits submitted by opposer as rebuttal testimony also have "cookie cutter" language. As for the substance of the statements, they are relevant as to the strength of opposer's mark, regardless of whether the third parties used their "PURL" names prior to opposer's use or are using the marks in commerce.

Objection 7. Opposer objects, on the basis of relevance, prejudice, lack of personal knowledge and speculation, to the statements made by applicant's various witnesses that they "would not be confused into thinking two yarn stores are related or connected simply because they both use the term 'purl' in the names of the stores." Opposer claims that "these affiants have no basis for contending that they would not be confused just because, ostensibly, they haven't been confused yet." We consider these statements as reflecting the witnesses' views relating to the weight they would give to the word "purl" in a trademark for a yarn store. This information is relevant, and certainly within their personal knowledge. As for the claim that the probative value of the statements is outweighed by their prejudicial effect, Board proceedings are not tried before a jury, and the Board not only has seen these statements in ruling on the objection, but does not view them as prejudicial in any event.

Applicant, too, has raised objections to opposer's evidence. Specifically, applicant objects to the rebuttal testimony submitted by opposer as not constituting proper rebuttal because it should properly have been part of opposer's case-in-chief. Opposer has responded that this evidence is in response to applicant's evidence 1) contesting the distinctiveness of opposer's marks; 2) challenging opposer's position in the industry; and 3) denying that yarn is subject to impulse purchases. Opposer also asserts that the appropriate remedy for applicant, if she had a problem with the evidence, was to

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file a motion to strike within 20 days of receipt of the evidence, and that to allow applicant to now seek to exclude the evidence would be improper and highly prejudicial to opposer.

With regard to the latter point, it is acceptable for an applicant to object, in its brief, to rebuttal testimony on the basis that it is improper. If rebuttal testimony should have been properly submitted as part of the opposer's case-in-chief, the applicant's delaying until the filing of its brief cannot be prejudicial because the opposer cannot cure the defect. As to the substantive points, some of the rebuttal evidence submitted by opposer goes to the distinctiveness of its mark. One of the claims applicant made in her brief is that opposer's mark PURL is merely descriptive, and therefore that opposer cannot demonstrate that it has any trademark rights at all. Applicant is correct that opposer must show that it acquired trademark rights prior to applicant's use or constructive use of her mark, since opposer's claim of likelihood of confusion is based on its common law rights. See *Otto Roth & Company, Inc. v. Universal Foods Corp.*, 209 USPQ 40 (CCPA 1981). However, an opposer must be apprised, prior to trial, that there is a question as to whether its claimed trademark is not distinctive, and applicant did not assert this in her answer to the notice of opposition or in any other paper

filed prior to the opening of opposer's testimony period. Accordingly, the Board will not consider whether opposer's mark is descriptive, but will treat it as inherently distinctive.² In view thereof, applicant's evidence as to the descriptiveness of opposer's mark has not been considered, and consequently opposer's rebuttal testimony regarding the inherent or acquired distinctiveness of its mark is irrelevant, and will not be considered either.

The other purposes for which the rebuttal testimony has been submitted is, as noted, to rebut applicant's evidence challenging opposer's "position in the industry and denying that yarn is subject to impulse purchases." Reply brief, p. 10. We note that the affidavits also give the witnesses' opinion on whether there is a likelihood of confusion. Opposer's attorney, who is also a rebuttal witness, has testified regarding a so-called survey she conducted, and which she submitted as an exhibit to her affidavit. This survey concerned, inter alia, whether the survey respondents confused applicant's mark with opposer's. Opposer has also used the results of the survey to support its argument that its PURL mark is famous.

We consider all of this evidence, which go to the factors of the fame of opposer's mark, the conditions of

² We must still assess the strength of the mark in the likelihood of confusion analysis.

purchase, and whether consumers are confused, to be properly part of opposer's case-in-chief. The fact that opposer is attempting to make of record a survey as part of rebuttal testimony highlights how unfair it would be to treat this evidence as proper rebuttal. It is obvious from the trademark cases involving surveys that no survey is perfect, and that problems with surveys can range from minor to so major that they make the survey of no probative value whatsoever. Allowing a plaintiff to wait until the rebuttal period to submit survey results would deprive the defendant of an opportunity to challenge the methodology or results of the survey by the testimony of its own witnesses, or to submit a survey countering the evidence of the plaintiff's survey. Opposer itself recognizes that it is "well established that challenges to survey methodology go to the weight given the survey, not its admissibility," reply brief, p. 11, but if opposer were permitted to submit a survey as part of its rebuttal testimony, applicant would not have the opportunity to challenge the survey methodology with the testimony of its own witnesses. Applicant's objections to the rebuttal testimony are well taken, and none of the rebuttal testimony has been considered.³

³ Aside from the survey evidence, the affidavit of opposer's attorney introduces evidence that had previously been introduced by the affidavit of Ms. Hoverson, which was timely filed during opposer's testimony period. Those exhibits are already of record.

Applicant has also objected to our consideration of opposer's applications, stating that these applications were not properly made of record because opposer did not submit copies of the actual applications, but instead proffered only printouts from the USPTO's TESS database. Applicant is correct that, at the time of the testimony periods in this proceeding, a party could not make its own registration (or application) of record merely by submitting, under a notice of reliance, a copy of the TESS printout.⁴ However, opposer did not merely submit the TESS copies of its claimed applications with a notice of reliance; rather, these copies formed an exhibit to the affidavit of Ms. Hoverson. Ms. Hoverson testified as follows:

With respect to the testimony about conditions of purchase, opposer's witness, Ms. Hoverson, testified during opposer's opening testimony period that "It is well established (ask any knitter) that yarn is an impulse purchase." ¶ 12. Applicant's evidence regarding this du Pont factor was apparently submitted in response to that testimony. All but one of the affidavits of the non-party witnesses submitted by applicant contain the identical statement, "I am very careful and deliberate in purchasing yarn and other knitting supplies," and the rebuttal affidavits of opposer's non-party witnesses (with the exception of opposer's attorney) all include the statement, "I am of the opinion that many yarn purchases are impulse purchases." Whether or not the purchase of yarn is an impulse purchase or a careful purchase is not determined by the sheer number of witness who say one thing or the other. Further, the application is not for "yarn," but for retail store services featuring the purchase of yarn. Therefore, even if we were to have considered opposer's rebuttal testimony on this point, it would not affect our decision herein.

⁴ The trademark rules were subsequently amended, effective November 1, 2007, to allow a plaintiff to make its pleaded registration of record by submitting a current printout of information from the electronic database records of the USPTO showing the current status and title of the registrations. Trademark Rule 2.120(d)(1).

...Applicant has applied for a mark for virtually identical goods and services as has PURL. See Exhibit "E", attached hereto and incorporated herein by this reference, showing Applicant's Purl Diva Mark, and Opposer's PURL and PURLSOHO Marks, the subject of this Opposition. PURL also has subsequent, additional pending marks, consisting of PURL BEE, PURL PATCHWORK and PURL (Design), which are also attached as part of Exhibit "F" and incorporated herein by this reference.

¶ 7.

Although rather inartfully put,⁵ we consider this statement to be sufficient to show that opposer is the owner of the applications shown in the exhibit.⁶ However, this testimony is not sufficient to show that the applications are still active. As a result, the applications are not of record herein. We should add that, even if the applications were of record, they would have no effect on our decision. Opposer cannot rely on the dates of use recited in the applications to show use of the respective marks on those dates. Because a use-based application requires use only as of the date the application is filed, any use prior to the

⁵ In view of the fact that the testimony was provided by affidavit, and therefore the statements could be carefully crafted and reviewed, we are surprised at the lack of precision of the language in the affidavit.

⁶ We note that one of the applications lists opposer per se as the owner (Serial No. 78604369 for PURL for services), while the other applications list the applicant as "Purl NYC, LLC Joelle Hoverson, USA Member; Jennifer Hoverson, USA, Member." We deem this ownership listing to convey that opposer is the applicant, and the Joelle and Jennifer Hoverson are "members" of opposer. Again, we are surprised that Ms. Hoverson's affidavit did not mention, let alone explain, this discrepancy.

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filing date must be proved by testimony or other evidence as to when such use actually occurred. The mere recitation by a witness of the dates of use as they appear in an application, without testimony that the dates recited in fact represent the actual use of the mark, is insufficient to prove use on those dates.

Applicant has also criticized some of the evidence submitted by opposer. The criticism is not technically an objection to our considering the evidence, but goes more to the weight to be accorded it, and we will therefore discuss it, as appropriate, in our analysis.

Finally, although not specifically raised by opposer, we note that some of the evidence submitted by applicant pursuant to her notice of reliance may not be made of record in this manner. Because opposer listed only the evidence it made of record in its description of the record, and did not discuss these portions of applicant's notice of reliance, we cannot say that opposer treated this material as being of record. Accordingly, we have not considered Exhibits 20-31, consisting of webpages from the site www.manta.com, and Exhibits 32-37, taken from the website <http://smallbusiness.dnb.com>. These webpages constitute neither printed publications nor official records. See Trademark Rule 2.122(e); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998).

The record, thus, includes the pleadings; the file of the opposed application; the affidavit, with exhibits, of opposer's witness Joelle Hoverson; the affidavit, with exhibits, of applicant, Ellen Rodgers; the affidavits of applicant's witnesses Debra H. Foster, Jennnifer Zemienieski, Linnea Hartsuyker, Lisa Daehlin, Melissa Walters, Annabelle Verhoye, Alison Green Will, Rachel C. Ambrose, Cherylyn R. Brubaker, Laurie Ovadia, Peggy L. Shelly, Stacy S. Kim, Mary Ahn, Cristina Post, Kerstin Glick and Jennifer Lynne Pauk; and certain printed publications and official records, submitted by applicant under notice of reliance.

The case has been fully briefed. The Board previously granted applicant's motion to strike the "rebuttal affidavit" of opposer's attorney, Jodi Sax, dated June 25, 2007, which was filed along with opposer's reply brief. Needless to say, any argument in the reply brief that was based on the affidavit and accompanying exhibits has also been disregarded.

Findings of Fact

Opposer's evidence which is properly of record consists solely of the affidavit of Joelle Hoverson, who has stated both that she is "an owner/member of [opposer]," ¶ 1, and that "I own the yarn store PURL in Soho, New York." She has also referred to PURL as "my yarn store." ¶ 2. We reconcile

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these statements by viewing Ms. Hoverson's ownership of the yarn store as being through her ownership of opposer. As a result, we make a finding of fact that opposer is the owner of the yarn store PURL, which is located in the Soho area of New York City. The store sells yarn, knitting supplies, books, patterns and notions. It opened for business in August 2002 and the mark PURL has been used in connection with the business since that date. Opposer also has a retail website at purlsoho.com. In February 2005 opposer opened a second store in Soho, a fabric store called PURL PATCHWORK, and opposer has an online journal for fiber artists and crafters called THE PURL BEE.

Ms. Hoverson has written a book, Last Minute Knitted Gifts, which was published in 2004, but it is not clear from the testimony whether opposer owns the rights to it, or Ms. Hoverson does as an individual. In its notice of opposition opposer alleged that *it* had written the book.

Applicant is the owner of Harpswell Harmony, LLC, through which she operates a retail yarn shop in Brunswick, Maine under the mark PURL DIVA that sells yarn and knitting/crochet accessories and provides classes in knitting. She chose the name because, as pronounced in Maine, it sounds like "pearl diver," and therefore is a play on that term. On June 17, 2006 applicant formally opened the PURL DIVA yarn shop.

Standing

Opposer has established its standing by its evidence that it operates a yarn shop under the name PURL. *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). Applicant has argued that opposer has not shown its standing because it has not proved its allegations that applicant's mark is likely to cause confusion with its PURL mark. However, the case applicant cited for this point, *Boswell v. Mavety Media Group Ltd*, 52 USPQ2d 1600 (TTAB 1999), does not stand for the proposition that an opposer must prove its ground for opposition to establish standing, only that it must prove the allegations of its standing. Opposer has done so.

Priority

Opposer does not have any registrations, and therefore priority is in issue. Compare, *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Further, opposer has not properly made its applications of record, and in any event could not rely on them to establish priority because they have filing dates subsequent to the filing date of applicant's application. Accordingly, opposer must rely on its common law rights and must prove it acquired trademark rights prior to applicant's use/constructive use. See *Otto Roth & Company, Inc. v.*

Universal Foods Corp., supra. Opposer's mark, although highly suggestive for a yarn store (whether a bricks and mortar store or an online store), is inherently distinctive, and therefore opposer acquired rights in PURL as a mark for a retail yarn store as of the time it began using it.

The evidence of record shows that opposer began using PURL as a mark for a retail yarn store in August 2002, and therefore opposer obtained rights in PURL for retail yarn store services as of that date.⁷ As far as any use of PURL for online store services, the testimony of opposer's witness is not clear because she has used "PURL" interchangeably to refer to opposer, the trademark, and the retail yarn store. There is no definite statement in her affidavit that opposer has used PURL as a trademark for online store services. The only evidence we have that may pertain to such use is an advertisement, described infra, which shows PURL in script form, with the words "shop online." Even if we were to regard this advertisement as

⁷ In her brief applicant points out that opposer failed to supply documentary evidence in support of Ms. Hoverson's testimony that opposer first used the mark PURL in August 2002. However, while documentary evidence may be necessary when testimony is unclear or contradictory, here Ms. Hoverson's statements as read in the context of the affidavit are sufficient to show that the mark PURL was used as a mark for opposer's retail yarn store as of August 2002, and therefore no supporting documentary evidence is required. In any event, opposer has submitted as an exhibit an excerpt from a publication dated August 29, 2002 that mentions the store PURL. See "Time Out New York," Exhibit B to Hoverson affidavit. This exhibit serves to corroborate Ms. Hoverson's testimony that the PURL mark was in use for retail store services as of August 2002.

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sufficient evidence that opposer renders online retail store services under the mark, the earliest date we can ascribe to such usage is February 2005, based on the fact that opposer's store PURL PATCHWORK is mentioned in the ad, and opposer did not open that store until then. This date is subsequent to the filing date of applicant's application.

As for the trademark PURLSOHO, which opposer has also claimed as a mark, the record is unclear about trademark use of this term. Ms Hoverson states in her affidavit that opposer "has been using ...its PURLSOHO mark in interstate commerce since November 2002," ¶ 8, but she does not identify the goods or services in connection with which this mark has been used.⁸ Unfortunately opposer has not submitted as exhibits either pictures of its mark as used in connection with its retail store services or a copy of what appears on its website from which we can determine whether opposer has made use of the mark PURLSOHO for such services.

⁸ In fact, the testimony that we do have raises more questions about what the goods or services might be than it answers. For example, opposer stated in its reply brief that the November 2002 date given in the affidavit was in error, and that November 2002 was the date of first use and September 1, 2003 was the date of first use in commerce. If the mark were being used for online retail store services we do not understand why opposer is making a distinction between first use and first use in commerce; if the mark is being used for opposer's retail store services offered at its New York City location, again we do not understand why opposer is making this distinction in the dates, since opposer, according to Ms. Hoverson's affidavit, was making use of the mark PURL in interstate commerce in connection with retail store services since August 2002, and therefore the retail store was operating in commerce as of that date.

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Because it is opposer's burden to establish that it has common law rights, we cannot accept vague statements in place of such proof. In short, the record does not reflect for what goods or services the mark PURLSOHO is or has been used.⁹ A mere statement that the mark has been used, without any indication of the goods or services with which the mark has been used, is insufficient for us to find that opposer has obtained trademark rights in PURLSOHO, since a trademark, ipso facto, must be used to identify particular goods or services.

The only documentary evidence we have of opposer's trademark use of any mark is an advertisement which Ms. Hoverson states has appeared in "Vogue Knitting," "Interweave Knits" and "Interweave Crochet." This advertisement shows the word "purl" in cursive font, below which are the words "shop online," centered within a "wreath" made of skeins of yarn, with the words "purlsoho.com" appearing in large letters below the wreath. Below that, in smaller type, are the words "visit our shops!" with the name "Purl" and its address in New York, and "Purl Patchwork" with its address. We do not view this

⁹ Needless to say, we cannot look to the services identified in opposer's pending application for PURLSOHO to ascertain its services. First, the application was not properly made of record and second, for the same reason that the dates of use recited in an application cannot be accepted as proof that the mark was used on those dates, the identification of goods or services in the

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as use of the trademark PURLSOHO, although it appears to be use of "purlsoho.com." However, opposer has not claimed that "purlsoho.com" is a trademark, and has identified it only as a web address for its website. In addition, as noted above, this advertisement includes a reference to opposer's shop PURL PATCHWORK, which Ms. Hoverson stated opened in February 2005, subsequent to the March 3, 2004 filing date of applicant's application. Therefore, it is not evidence of pre-2005 use of any of the marks shown therein.

Accordingly, we find that opposer has not established trademark rights in PURLSOHO per se for any goods or services, and therefore it cannot show priority of use through any common law rights for the mark PURLSOHO.¹⁰

Opposer has also made reference to the marks PATCHWORK and PURL BEE. The applications for these marks were not pleaded in the notice of opposition, nor do we find that the issue of likelihood of confusion with respect to these marks was tried, such that we could consider the pleadings amended

application is not proof that the mark was used on in or connection with those goods or services on the listed dates.

¹⁰ Several months after final briefing of this case, opposer filed a motion to amend its pleading to assert ownership of a registration for PURLSOHO, which had issued (after briefing was completed) from opposer's pleaded application. The Board denied this motion on October 25, 2007, and therefore the registration is not of record, nor have we considered the registration or any rights which opposer may have obtained by virtue of it. However, our finding that opposer has not established priority for PURLSOHO does not affect the ultimate result in this opposition, since PURL DIVA is more similar to PURL than it is to PURL SOHO.

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pursuant to Rule 15(b) of the Federal Rules of Civil Procedure. Although in opposer's reply brief opposer states that applicant has not addressed opposer's subsequently filed marks PURL PATCHWORK and PURL BEE, p. 15, in Ms. Hoverson's affidavit she states that opposer's PURL and PURLSOHO marks are "the subject of this Opposition." ¶ 3.¹¹ Also, in its main brief opposer addresses the issue of likelihood of confusion only with respect to the two pleaded marks. The very statement of issues as recited in that brief is "Whether Applicant's proposed PURL DIVA mark so resembles Opposer's PURL and PURL DIVA [sic] marks as to be likely to cause confusion as to source or origin in violation of section 2(d) of the Lanham Act, 15 U.S.C. section 1052(d)." p. 6. Thus, we do not consider any likelihood of confusion claim that opposer may have based on the marks PURL PATCHWORK and PURL BEE. We also point out that, in any event, opposer has not established priority of use of these marks. There is no evidence that opposer began using the marks prior to the March 3, 2004 filing date of applicant's application; on the contrary, Ms Hoverson's affidavit states that the store PURL PATCHWORK opened in February 2005.

¹¹ Indeed, in the next sentence of paragraph three, Ms. Hoverson states that opposer has subsequent additional pending marks, PURL BEE, PURL PATCHWORK and PURL (design), and the clear implication is that these marks are not the basis for opposer's bringing the opposition.

As for applicant, the record shows that applicant did not make actual use of her mark until 2006; therefore, the earliest date on which she is entitled to rely is March 3, 2004, the filing date (and constructive use date) of her application.¹² Because opposer has established that it made use of PURL for retail yarn store services as of August 2002, opposer has established its priority with respect to this mark for these services.

Likelihood of confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

Because the only mark for which opposer has established priority is PURL for retail yarn store services, we confine our discussion on the issue of likelihood of confusion to whether applicant's mark for her identified services is

¹² Opposer has argued that applicant cannot rely on her filing date as her constructive use date until her application issues into a registration. This is not a correct statement of the case law. See *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993) (to prevail on a [Section 2(d)] claim, [opposer] must plead and prove that it has a proprietary interest in [its mark] and that the interest was obtained prior to the filing date of applicant's intent-to-use application); see also, *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1172, n.5 (TTAB 2001).

likely to cause confusion with PURL for retail yarn store services.¹³

Opposer contends that its mark PURL is famous. We therefore begin our analysis with the factor of fame because this factor plays a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

According to Ms. Hoverson's affidavit, "PURL sells in excess of One Million Dollars per year in merchandise."

¶ 3. Applicant has criticized this figure as being vague and unsubstantiated by any documentary evidence. We agree that the figure is rather vague, and even on its face it raises questions for us. For example, if we view the statement as indicating annual sales of \$1 million per year for each year that opposer was in business, we find it somewhat odd that opposer had a similar level of sales during its first year as a start-up operation, and in 2005 when it had opened a second store. Obviously, if opposer's statement refers to sales of \$1 million for the most recent year or two that opposer was operating, that has an impact on the determination of whether the mark is famous. However, even if we accept the \$1 million annual sales

¹³ The issue of whether opposer has a family of marks was neither pleaded nor argued by opposer.

figure, it is not clear from Ms. Hoverson's affidavit what portion of these sales is attributed to opposer's retail store services under the mark PURL, what portion is attributed to sales made through opposer's website, what portion is made under the mark PURL PATCHWORK or even what portion is attributed to Ms. Hoverson's books, assuming that opposer is the owner of any rights to the book and profits from its sales.¹⁴ The fact that, according to Ms. Hoverson's testimony, opposer's website, purlsoho.com, receives 4,000 visitors per day, and that it has a mailing list of over 16,000 customers from all over the world from its website alone, suggests that a significant portion of opposer's \$1 million annual sales could have been made through the website. However, because opposer did not submit any pages from its website, and there is no testimony as to what marks appear on the website, we cannot consider the evidence regarding website "hits" to have any probative value with respect to the fame of the trademark PURL.

Opposer also spends "in excess of \$40,000 per year in advertising." ¶ 3. Again, we cannot determine from Ms. Hoverson's affidavit how the advertising is broken down among opposer's various business ventures. Based on the exhibit showing the advertising (described in our discussion

¹⁴ Some of this confusion is caused by the fact that in her affidavit Ms. Hoverson has chosen to identify both opposer and the yarn store as "PURL."

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of priority), the ad appears to be primarily for opposer's on-line sales. Also, Ms. Hoverson testified that this ad has appeared "in every issue of Vogue Knitting, Interweave Knits and Interweave Crochet." ¶ 3. However, in view of Ms. Hoverson's testimony that PURL PATCHWORK did not open until February 2005, and the advertisement tells viewers to visit the Purl Patchwork shop, this advertisement could not have appeared in every issue of these publications since the PURL store opened.

Ms. Hoverson testified that opposer's store PURL has been written up in various magazines in the United States and abroad.¹⁵ Publicity in foreign publications, without evidence of circulation in the United States, does not demonstrate fame of the mark in the United States. *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2ds 1400, 1405 (TTAB 1998). As a result, we give the articles that appeared in the UK publication "Rowan Knitting and Crochet," the Australian publications "Qantas" and "Get Creative" and the two Korean magazines, written in Korean, no probative value. There are five articles from U.S. publications: a two-page article about Ms. Hoverson and PURL in "The Oprah Magazine"; a one-paragraph mention of the PURL store in

¹⁵ Again opposer has used the term "PURL" without making a distinction between opposer itself and its retail store called PURL, but from the exhibits showing the write-ups we conclude that the references are to the store.

"Time Out New York"; a three-quarter page photo and text about Ms. Hoverson and her shop PURL, also featuring a stocking kit available at the store in "Lucky"; a listing of the store in the "Zagat Survey" of "New York City Shopping"; and one paragraph, with the heading "Purl," in "City."¹⁶ In addition, the book The Martha Rules, 10 Essentials for Achieving Success As you Start, Build, or Manage a Business, by Martha Stewart, has three pages devoted to Joelle Hoverson, which talks about how she went about starting her store, "Purl." The store has also been mentioned in celebrity magazines and websites. "In Touch Weekly" has a photo with the text that Kate Hudson and Uma Thurman "ran into each other at the knitting shop Purl in New York." "Life & Style Weekly" has a photo with two lines of text stating that Kate Hudson "inspected the yarns on offer at the knitting shop Purl in NYC's Soho on April 7." "Celebrity Living" has a two-page spread with photos of Uma Thurman and Kate Hudson, and text mentioning that both shop at Purl, and quoting "Purl owner Joelle Hoverson." A box of text has the prominent title "Cool Tools from Purl in NYC." The website Eonline has, in the column "The Awful Truth," a brief mention at the end of the article that Drew Barrymore

¹⁶ Ms. Hoverson's affidavit also references a mention in "The Wall Street Journal," but the copy of the exhibit that was submitted is so blurred that we cannot make out any of the text. Accordingly, we have given it no probative value. *Hard Rock Cafe Licensing Corp. v. Elsea*, supra at 1405, n.13.

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popped into Purl. Ms. Hoverson has also appeared on Martha Stewart's television program, "Martha," and opposer's stores PURL and PURL PATCHWORK have been mentioned. And Ms. Hoverson's book, "Last Minute Knitted Gifts," mentions Purl on the flyleaves of both the front and back cover, as well as in the preface. This book had sold 60,000 copies as of the time Ms. Hoverson signed her affidavit in October 2006.

Finally, we note that several of the affidavits submitted by applicant, from people who knit, state that they are familiar with PURL in New York/Soho.

On the basis of the record before us, we cannot find that PURL is a famous mark for retail yarn store services. As noted, because of the lack of clarity of the testimony, we cannot view the figures of \$1 million per year in sales and \$40,000 in advertising as referring only to sales under the trademark PURL, and advertising for only the mark PURL. Even if, arguendo, these were the sales and advertising figures for the PURL trademark for retail yarn store services, these sales have occurred over a very limited time (four years). Further, we have no context for these figures, in terms of knowing whether the sales and advertising figures are extremely high for retail yarn store businesses. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002) ("Consequently, some context in which to place raw

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statistics [raw numbers of product sales and advertising expenses] is reasonable"). Although in its brief opposer makes the statement that its \$40,000 per year adverting expenditures are "a huge amounts [sic] for an independent boutique yarn store," p. 8, the characterization of this amount is not supported by any evidence. We can only say that opposer's sales and advertising figures do not approach those in other cases in which marks were found to be famous. See the following figures, as quoted in *Bose Corp. v. QSC Audio Products Inc.*, supra at 63 USPQ2d 1306:

Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc., 889 F.2d 1070, 1072, 12 USPQ2d 1901, 1902 (Fed. Cir. 1989) (NINA RICCI for perfume, clothing and accessories: \$200 million in sales, over \$37 million in advertising over 27 years); Kimberly-Clark Corp. v. H. Douglas Enter., Ltd., 774 F.2d 1144, 1146-47, 227 USPQ 541, 542 (Fed. Cir. 1985) (HUGGIES for diapers: over \$300 million in sales over 9 years, \$15 million in advertising in one year); Specialty Brands Inc. v. Coffee Bean Distribs., Inc., 748 F.2d 669, 674-75, 223 USPQ 1281, 1284 (Fed. Cir. 1984) (SPICE ISLANDS for teas, spices and seasonings: \$25 million annually in sales for spices, \$12 million between 1959 and 1981 for tea, "several million" in advertising, in use for 40 years); Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1567-68, 218 USPQ 390, 392-93 (Fed. Cir. 1983) (GIANT FOOD for supermarket services and food products: sales over \$1 billion in one year, "considerable amounts of money" in advertising, 45 years use); DuPont, 476 F.2d at 1361, 177 USPQ at 567; Planters Nut & Chocolate Co. v. Crown Nut Co., 305 F.2d 916, 917-18, 134 USPQ 504, 506

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(CCPA 1962) (MR. PEANUT DESIGN for nuts and nut products: \$350 million in sales, \$10 million in advertising over 10 years).

Nor does the evidence of the references to the PURL store in the various publications and the television program demonstrate fame of the mark. Many can best be described as passing references that are not likely to be noted or remembered by readers. The focus of many of the articles, as well as the feature in The Martha Rules, is on Ms. Hoverson herself and her efforts to open a business, rather than on the trademark for that business. In sum, although the store and its trademark have received some publicity, and some of the knitters who submitted declarations on behalf of applicant are aware of the store, this evidence is not sufficient for us to conclude that PURL is a famous mark for retail yarn store services.

In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of a plaintiff asserting that its mark is famous to clearly prove it. *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1819 (TTAB 2005). Opposer has simply failed to show that in this case.

On the other hand, there is no denying that PURL is a highly suggestive mark for a retail yarn store, as "purl" is

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one of the main stitches in knitting and the word is also used as the verb form to indicate knitting with this stitch.¹⁷ Opposer acknowledges that "purl" "has the generally understood meaning of relating to knitting." Brief, p. 24.

Further, applicant has submitted evidence that many yarn stores, whether traditional bricks and mortar stores or online, use the term "PURL" or variations thereof in their trademarks. Applicant's witnesses (identified as people who knit), testified about various yarn stores with "purl" or a variation thereof in their marks, including Knit Purl in Oregon, Purly Gates in Georgia, Purls in Arizona, Cultured Purl in Pennsylvania, Knit-n-Purl in Michigan and Stitch, Piece 'n Purl in Ohio. Lorna's Laces, which opposer has identified as a supplier of its yarns, lists (in addition to opposer) in its directory of retailers carrying their yarns, Cozy Knit & Purl in Colorado, Knit2Purl2 in Delaware, Knit-N-Purl in Michigan, Purl by the Sea in New York, Purls in Arizona, Cultured Purls in Washington, Knit-N Purl in Tennessee, Stitch, Piece 'N Purl, Inc. in Ohio and String of Purls in Nebraska. Exhibit 55 to Rodgers affidavit. The online SweaterBabe.com yarn shop directory lists, along with

¹⁷ The American Heritage Dictionary of the English Language, 4th ed. © 2000. "Purl: n. 1. Inversion of a knit stitch; purl stitch. v. (transitive) 1. To knit (yarn) with a purl stitch. (intransitive) 1. To do knitting with a purl stitch." Exhibit 5 of applicant's notice of reliance.

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many of the stores set forth above, Knit One, Purl Two in Rhode Island, Purl's Yarn Emporium in North Carolina, Sakonnet Purls in Rhode Island, Knit-N-Purl in New York, Gifted Purl in Illinois and Knit, Purl and Co. in California. Exhibit 36 to Rodgers affidavit. Another online yarn shop directory, The Daily Knitter, Rodgers exhibit 35, lists Purls The Yarn Studio in Iowa, Black Purl in Wisconsin, Purls and Girls in California, Sewpurlatives in Georgia, Knit And Purl in New Jersey, Rita's Knit One Purl Two in New York, Knit One 'Purl One in California, Knit N Purl in Indiana, Purls From Heaven in New York, and Knit 1 Purl 2 in Virginia, along with many of those listed in the SweaterBabe.com directory and applicant's witnesses' affidavits. The online superpages.com telephone directory lists Purls & Girls in Turlock, CA (Rodgers exhibit 22) and Purls From Heaven in Cedarhurst, NY (Rodgers exhibit 26), while insider pages.com lists Genuine Purl in Chattanooga, TN (Rodgers exhibit 25) and AllPages. Com lists Knit Purl & Co in Tarzana, CA (Rodgers Exhibit 30).

In addition, applicant has made of record webpages from many online retail yarn stores, including String of Purls, with a street address in Omaha, Nebraska (Rodgers exhibit 5); Stitch, Piece 'n Purl with an address in Ohio (Rodgers exhibit 8); Knit Purl, with a street address in Portland, Oregon (Rodgers exhibit 9); as well as webpages from bricks

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and mortar yarn stores, e.g., Purls of Yarn in Pleasantville, NY (Rodgers exhibit 7); Knit, Purl & Beyond, LLC in New Hampshire (Rodgers exhibit 14); Purl Garden in Georgia (Rodgers exhibit 28) and Bead & Purl in Rhinebeck, NY (Rodgers exhibit 31).

Opposer has claimed that the evidence of third-party use has no relevance and has "little probative value, as the information in and of itself does not show that these stores are using the mark in commerce in any particular way, have used the mark prior to PURL, or that the public is familiar with the use of the word 'purl' in the names of these stores." Reply brief, p. 14. However, evidence on the du Pont factor of third-party use certainly is relevant to the determination of likelihood of confusion. Further, the affidavits of applicant's non-party witnesses show that these witnesses are familiar with the marks recited in their affidavits, and the listings in various directories and the website evidence of online retail yarn stores show valid service mark use. All of this evidence is sufficient for us to conclude that people who buy yarn from retail or online retail yarn stores are likely to have been exposed to third-party marks containing the word PURL. Whether or not these third-party uses were prior to opposer's use, or were used in commerce, is irrelevant to our consideration of this du Pont factor. We are not determining whether their rights

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are superior to opposer's, or whether they have met the necessary "use in commerce" requirement to obtain a registration; we consider this evidence in order to determine whether there have been so many third-party uses of the term PURL for yarn stores that consumers will distinguish among them by looking to other elements in the marks.

The highly suggestive meaning of "purl," and the number of yarn stores that use "purl" in their marks, demonstrates that the term "purl" is not entitled to a broad scope of protection, and that consumers are able to differentiate among various "purl" yarn stores by looking to other elements in the marks. See *King Candy Company v. Eunice King's Kitchen, Inc.*, supra.

With this in mind, we consider applicant's mark PURL DIVA vis-à-vis opposer's mark PURL. Obviously, both marks contain the word PURL, and to that extent there are similarities in appearance and pronunciation. However, applicant's mark is not merely the word PURL, but is PURL DIVA. As previously discussed, PURL is a highly suggestive term, and the mere presence in two marks of a common, highly suggestive portion is usually insufficient to support a finding of likelihood of confusion. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F. 2d 915, 189 USPQ 693 (CCPA 1976). Instead, consumers will look to the arbitrary word DIVA in

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applicant's mark as a distinguishing element, and this word is therefore entitled to greater weight in the likelihood of confusion analysis. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety). Further, PURL DIVA has a very different connotation from PURL alone. Applicant has explained that in Maine, where her store is located, PURL DIVA would be pronounced the same as "pearl diver," and therefore her mark has a double entendre which would be readily recognized. In this connection, the third-party uses made of record by applicant show that other yarn stores have capitalized on the fact that "purl" and "pearl" sound the same, and have adopted marks in which "purl" has such a connotation. See, e.g., *Purly Gates*, *Cultured Purl*, *Purl by the Sea* and *String of Purls*. Even if applicant's mark were to be pronounced as "dee-va," the connotation is of a woman who knits (purls) who is "admired, glamorous or distinguished." In this connection, we take judicial notice of the definition of "diva" as meaning "an admired, glamorous or distinguished

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woman.”¹⁸ In either case, the connotation of PURL DIVA is very different from the connotation of PURL per se. Further, these overall differences in appearance and pronunciation, and most particularly in connotation, result in the marks conveying very different commercial impressions.

Because of the differences in the marks, and the limited scope of protection to be accorded to opposer’s mark in view of its highly suggestive nature, we find that opposer has failed to prove its pleaded ground of likelihood of confusion. Although all du Pont factors on which there is evidence must be considered, different factors may play a greater or lesser role in any given case. See *In re E.I. du Pont de Nemours & Co.*, supra, *Kellogg Co. v. Pack’em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). The factors of the differences in the marks, the weakness of opposer’s mark due to the highly suggestive nature of the word PURL, and the third-party uses of PURL marks for yarn store services outweigh the fact that opposer’s and applicant’s retail store services must be

¹⁸ The New Oxford American Dictionary, 2d ed. © 2005. The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

deemed to be legally identical, and to be rendered in the same channels of trade to the same classes of consumers.¹⁹

We have also considered opposer's argument that yarn is purchased on impulse and without care. However, applicant is seeking registration of her mark for retail yarn store services, not for yarn per se, and opposer is claiming trademark rights in a mark used for retail yarn store services. Thus, the fact that yarn is relatively inexpensive or is an impulse purchase is beside the point. The question is not whether someone standing in a yarn store might confuse the trademarks for different skeins of yarn displayed next to each other because he or she would just "grab" a skein without closely examining the trademark. We must consider the conditions of purchase as they pertain to consumers availing themselves of the services at issue-- retail yarn store services. Opposer has taken the position that there is a "knitting community," brief, p. 15, peopled by consumers who are avid knitters. Such knitters will know the shops that they wish to patronize, and are likely to be discriminating about choosing a store because they are concerned about selection, help, service and the like. Even if the decision to buy yarn is made on impulse, they

¹⁹ We are aware that opposer's retail store services are rendered from a bricks and mortar facility in New York, and applicant's retail store is located in Maine. However, because applicant is not seeking a concurrent use registration, we cannot treat the services as having any geographic separation.

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will be aware of the trademark of the store which they enter to purchase the yarn. These avid knitters, as shown by the affidavits submitted by applicant, are aware of third-party yarn stores that have the word "purl" in their trademarks, and will not assume a connection between applicant and opposer simply because both parties use marks with this word. Even if we assume that consumers of the parties' services include more casual knitters, who will visit a yarn store on a more occasional basis, they are still likely to note the name of the store which they are patronizing. And, as we discussed in our comparison of the marks, even less sophisticated consumers will not confuse PURL and PURL DIVA merely because both marks contain the highly suggestive term "purl."

Finally, opposer has asserted that there is evidence of actual confusion. However, there is no evidence of record that shows such confusion.²⁰ Accordingly, we regard this du Pont factor as neutral.

In conclusion, we find that because of the highly suggestive nature of opposer's mark, the evidence of third-party use of marks containing the word PURL or a variation thereof for retail and online retail yarn stores, and the differences in opposer's mark and applicant's mark, applicant's mark PURL DIVA for retail yarn store services is

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not likely to cause confusion with opposer's mark PURL, despite the fact that the services are the same, and will be rendered in the same channels of trade to the same classes of consumers.

Decision: The opposition is dismissed.

²⁰ As indicated supra, the survey which opposer relies on to show purported actual confusion has not been considered.