

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB MARCH 8,00

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Lucky Brand Dungarees, Inc.

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Serial No. 75/271,746

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Gary J. Nelson of Christie, Parker & Hale, LLP for Lucky  
Brand Dungarees, Inc.

Katherine Stoides, Trademark Examining Attorney, Law Office  
109 (Ronald Sussman, Managing Attorney)

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Before Seeherman, Bucher and Holtzman, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Lucky Brand Dungarees, Inc. has applied to register  
the mark LUCKY BRAND and design, as shown below, for the  
following goods:<sup>1</sup>

cologne, perfume, eau de parfume [sic],  
body lotion, shower gel, body soap,  
aftershave moisturizer, moisturizing  
shave cream, personal deodorant, bath

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<sup>1</sup> Application Serial No. 75/271,746, filed April 9, 1997, based  
on an asserted bona fide intention to use the mark in commerce.

salts, bath oil, exfoliating body cream, sunscreen, non-medicated foot cream, hand cream, body powder/talc, hair shampoo, hair conditioner, hair styling gel, non-medicated lip balm, lipstick, nail polish, toothpaste face/soap, face/wash/cleanser, face toners, face/night cream, face/day cream, eyecream and candles.

Exclusive rights to the word BRAND have been disclaimed.



Registration was finally refused by the Trademark Examining Attorney pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), in view of two registrations for LUCKY, owned by two separate entities.

LG Chemical Co., Ltd. owns a registration for LUCKY in the stylized form shown below. It is registered for "skin soaps, laundry detergent, hair shampoo, hair rinse, perfume, cologne, non-medicated skin moisturizing and cleansing lotions, non-medicated hair tonics, dentifrice."<sup>2</sup>

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<sup>2</sup> Registration No. 1,794,551, issued September 28, 1993. The registration originally issued in 6 classes, but when the registrant filed its Section 8 affidavit, it deleted all classes but Class 3. The Section 8 affidavit was accepted with respect to the goods in Class 3. The Examining Attorney also made final a refusal of registration based on a second registration, for LUCKY and design, owned by the original owner of Registration No. 1,794,551. That registration was cancelled for failure to file a

# LUCKY

The second registration is owned by Lucky Stores, Inc. for LUCKY in stylized lettering, as shown below, for "cotton puffs for cosmetic purposes, sponges used for cosmetic purposes, nail polish remover, sun block preparations, sun screen preparations, body oil, skin lotions, petroleum jelly for cosmetic purposes, all-purpose cotton swabs for personal use, personal deodorants, hair shampoo, hair conditioners, mouthwash, tooth paste, denture cleaning preparations, and hydrogen peroxide for use on the hair, all sold in retail grocery stores and supermarkets operated or owned by applicant or an affiliate of applicant."<sup>3</sup>

The word "Lucky" is written in a stylized, cursive font. The letters are thick and black, with a slightly irregular, hand-drawn appearance. The 'L' is particularly large and prominent, and the 'y' has a long, sweeping tail.

Applicant has appealed. The appeal has been fully briefed, but an oral hearing was not requested.

We turn first to the refusal based on LG Chemical Co.'s registration. In any likelihood of confusion analysis, two key considerations are the similarities

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Section 8 affidavit, and therefore with her brief the Examining Attorney withdrew that reference.

<sup>3</sup> Registration No. 2,014,684, issued November 12, 1996.

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between the marks and the similarities between the goods. **Federated Food, Inc. v. Fort Howard Paper Co.**, 554 F.2d 1098, 192 USPQ 24 (CCPA 1976). Applicant's and the registrant's goods are, in part, identical. For example, applicant's identified body soap and face soap are encompassed by registrant's identified skin soaps, applicant's hand cream, aftershave moisturizer, face/night cream, face/day cream, eyecream and face/wash/cleanser are included within registrant's non-medicated skin moisturizing and cleansing lotions; and both parties' identifications include hair shampoo, perfume, cologne and toothpaste. Because neither applicant's nor the registrant's goods are restricted as to channels of trade, we must deem them to travel in the same channels of trade, and to be sold to the same classes of consumers which, in the case of the identified products, would be the general public.

We turn next to a consideration of the marks, keeping in mind that when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). The verbal elements of the marks are virtually the same, since the

additional element BRAND in applicant's mark is without trademark significance. Because consumers seeing or hearing applicant's mark are not likely to attach any source-indicating significance to it, it is not a sufficient basis on which they would distinguish the marks. As applicant points out, its mark has a large visual element, namely a four-leaf clover. However, this design reinforces the significance of the word LUCKY because a four-leaf clover is "an omen of good luck." In this connection, the Board grants the Examining Attorney's request and has taken judicial notice of the definition from The American Heritage Dictionary of the English Language, 3d ed. © 1992, submitted by the Examining Attorney with her brief.<sup>4</sup> The Board is not persuaded by applicant's arguments that the design has the connotation of "Ireland, St. Patrick's Day, Leprechaun, etc." Reply brief, p. 5. Applicant has not submitted any evidence in support of this position and, in fact, it is contradicted by the dictionary definition of "shamrock" which defines the national emblem of Ireland as a three-leaf clover.<sup>5</sup> In

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<sup>4</sup> 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).

<sup>5</sup> "Shamrock: Any of several plants, such as a clover or wood sorrel, having compound leaves with three small leaflets, considered the national emblem of Ireland." The American

any event, when the design is viewed in connection with the words LUCKY BRAND, we have no doubt that it is the meaning of a good luck omen that the design would convey.

Applicant relies on the case of **First International Services Corp. v. Chuckles Inc.**, 5 USPQ2d 1628 (TTAB 1988) in support of its position that the design is the dominant element of its mark. We find the cases to be distinguishable. In First International, the Board found that the squiggle design, rather than the word SUKESHA, presented the dominant commercial impression. However, in that case the goods were hair care products. The Board pointed out that not only were the goods of a type that would be taken from a shelf and not called for by name, but also that the squiggle design appeared in different colors to differentiate the type of product, such that the design took on a more significant role.

In the present case, on the other hand, applicant's goods include items which are not necessarily taken by consumers off a shelf. For example, perfume, a potentially expensive item, may be kept behind a counter, so that a customer would have to request it by name. Further, perfume is the type of item that may be the subject of

"word-of-mouth" recommendation, e.g., one may comment on the scent a friend is wearing, and ask what the brand is.

When the marks are compared in their entireties, we find that they convey the same commercial impressions and that, if applicant were to use its mark on goods identical to or closely related to the registrant's goods, confusion would be likely.

In making this determination, we have considered applicant's argument that the cited mark has a narrow scope of protection. Applicant bases this argument on its assertion that at the time applicant filed its application there were eight "LUCKY" marks registered for cosmetic products. It is noted that three of these registrations had been cited against applicant's application, and another is owned by Lucky, Ltd., the same company to which the cited registration issued. Thus, there are only five third-party marks referenced by applicant. Although these various registrations for marks containing the word "LUCKY" show that "lucky" has some significance in connection with cosmetics products, applicant's mark is far more similar to the cited mark than the other registrations are. We also point out that, as opposed to applicant's mark, the third-party marks all have additional verbal elements, such that

they are far more different from the cited mark than is applicant's mark.

Applicant also relies on the prominent use of a four-leaf clover design on, and in the advertising of, its various clothing products "to show the importance of this design to applicant." Reply brief, p. 4. In this connection, applicant has made of record various clothing items in which there is a repeated four-leaf clover design on the inside of its jeans pockets, and on its boxer shorts. However, whatever may be applicant's intentions in terms of the impression it wishes to convey by its mark, there is no indication in the record that applicant has yet used its mark on cosmetics products,<sup>6</sup> which are the goods identified in the application. Further, the mark for which applicant has applied is not just a four-leaf clover design, but is a composite mark in which the word LUCKY is shown in relatively large letters. Our decision, thus, must be based on a consideration of the commercial impression of the applied-for mark vis-à-vis the cited mark and when we consider the marks in their entireties, we find that the addition of the four-leaf clover design and the

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<sup>6</sup> As noted previously, this application was based on an asserted intention to use the mark in commerce. Applicant has not filed an amendment to allege use of the mark.



word BRAND in applicant's mark is not sufficient to avoid the likelihood of confusion when these mark are used on identical goods.

Finally, although we have limited our discussion to the points discussed by applicant and the Examining Attorney, we have, in reaching our decision, considered 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).

This brings us to the refusal based on Lucky Stores, Inc.'s registration. The registrant's goods, as identified, are restricted to sale in "retail grocery stores and supermarkets operated or owned by applicant or an affiliate of applicant." Because of this restriction, we find that confusion is not likely between Lucky Stores' use of its mark and applicant's use of its mark, despite the fact that the goods are in part identical. Simply put, consumers who encounter the registrant's goods in its stores will recognize that they are house brand products, and are not likely to believe, when they encounter applicant's goods sold elsewhere, that the goods emanate from the same source.

The concurring opinion disagrees with this conclusion, stating, among other points, that there is no evidence that

the registrant's mark identifies its house brand of products. Whether or not the retail grocery stores and supermarkets operated or owned by applicant or an affiliate of applicant use the trade name "Lucky" (an assumption supported by the ownership of this registration by Lucky Stores, Inc.), the fact is that the registrant's goods are restricted as to channels of trade, in that the only stores in which they are sold are grocery stores and supermarkets which are owned or operated by the registrant or its affiliates. This would appear, by definition, to be use of the mark as a house brand. In any event, consumers will not encounter these goods in department stores or drugstores or even in other companies' grocery stores.

Further, the third-party registrations do indicate that the term LUCKY has a suggestive significance with respect to cosmetic products, such that we cannot treat the registrant's mark as a strong mark.

Accordingly, we find that confusion is not likely between applicant's mark and Lucky Stores, Inc.'s registered mark.

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Decision: The refusal of registration is reversed with respect to Registration No. 2,014,684 and affirmed with respect to Registration No. 1,794,551.

E. J. Seeherman

D. E. Bucher  
Administrative Trademark Judges  
Trademark Trial and Appeal Board

Holtzman, T. E., concurring in part and dissenting in part.

I concur in the decision affirming the refusal to register as to Registration No. 1,794,551. However, I respectfully dissent from the decision to reverse the refusal with respect to Registration No. 2,014,684. Despite the substantial similarity in the marks (applicant's mark is LUCKY BRAND and design; registrant's mark is LUCKY) and the fact that the respective goods are in part identical (both including sunscreen, deodorant, shampoo and hair conditioner) the majority concludes that a restriction in the registrant's identification of goods as to the particular stores in which those goods may be sold is sufficient to avoid the likelihood of confusion. I disagree with this conclusion.

The majority's decision is based on a number of assumptions which are not supported by the record. The majority assumes that LUCKY identifies registrant's house brand of products. The majority assumes that registrant's grocery stores and supermarkets operate under the name "Lucky" so that products sold under that label would be recognized by purchasers as a house brand. "House" brands of grocery and drugstore items are not always the same as the store name. For example, SELECT brand is sold in

Safeway, HEIDI products are sold in Giant, and RICHFOOD products are sold in Shoppers Food Warehouse. The majority assumes that "affiliated" stores operate under the same name as registrant's own stores. The majority assumes that house-branded goods from supermarkets or grocery stores in general are never sold elsewhere and that purchasers of these goods are aware of that fact.

Even if the above assumptions were supported by the record, I find that the restriction to this registrant's identification of goods is not sufficient to avoid a likelihood of confusion. First, the restriction does not delineate different channels of trade. Goods such as those of applicant and registrant are typically sold in grocery stores and drug stores. The fact that registrant's goods are sold only in grocery stores of a certain name does not mean that the channels of trade differ, only that the names of the stores differ.

Moreover, while purchasers may not encounter these products in proximity to each other and at the very same stores, they could still believe that there is a common source for both. It must be remembered that these are inexpensive products, subject to impulse purchase, by the same classes of customers, at the same types of stores. It is well settled that purchasers of such items are held to a

lesser standard of purchasing care and are more likely to be confused as to the source of the goods. See Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984).

Purchasers may only recall the name of the product, not necessarily the name of the store where they may have previously purchased it. A consumer who has purchased registrant's LUCKY shampoo, for example, who then sees applicant's LUCKY BRAND shampoo in a grocery or drug store may well believe that applicant's shampoo is produced by the same entity that produced the LUCKY shampoo the consumer has at home. Customers of registrant's "Lucky" grocery stores may also patronize drug stores or department stores or even other grocery stores where they may find applicant's LUCKY BRAND shampoo and because of the near identity of the marks, think that the same entity produced these goods. As stated by our reviewing court in Aircraft Radio Corporation v. ARC Sound Limited, 169 USPQ 490 (CCPA 1971):

Confusion as to source requires only that the product of one producer be thought to be that of another. Such a mistake may well be likely even when the outlets are different if the respective products, as here, have characteristics which suggest that they may come from the same producer and the identical mark is used by both parties.

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Because of the identity of some of the goods and the close similarity of the marks, and resolving, as we must, all doubt in favor of the prior user and registrant, I would also affirm the refusal as to this registration.

T. E. Holtzman  
Administrative Trademark Judge  
Trademark Trial and Appeal Board