Paper No. 10
HRW

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re L.C. Licensing, Inc.

Serial No. 75/132,969

David B. Kirschstein of Kirschstein, Ottinger, Isreal & Schiffmiller, P.C. for applicant.

Ann E. Sappenfield, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before Seeherman, Hohein and Wendel, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

L. C. Licensing, Inc. has filed an application to register the mark LIZSPORT for "perfume; cologne; body creams; body lotions; talcum powder; skin soap; toilet soap; bath gel; shower gel; and non-medicated bath salts."[1]

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[1] Ser. No. 75/132,969, filed July 11, 1996, based on a bona fide intent to use. Ownership is claimed of the following registrations:

No. 1,371,423 for the mark LIZ SPORT for "pants,

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the registered mark LIZ, in the stylized format reproduced below, for "perfumes; toilet waters; and beauty and toilet preparations, namely, makeup foundation, skin basis makeup, lipstick, eyelash mascara, blush, eyebrow pencils, skin oils, skin creams, skin milk, toilet soaps, nail varnish and polish, hair lotions, skin cleaning lotions."[2]

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skirts, culottes, one-piece suits, blouses, sweaters, T-shirts and jackets", issued Nov. 19, 1985;
No. 1,463,606 for the mark LIZSPORT and Design for "pants, skirts, culottes, jumpsuits, blouses, sweaters, T-shirts and jackets", issued Nov. 3, 1987;
No. 1,534,435 for the mark LIZSPORT for "shorts, dresses and hats," issued Apr. 11, 1989;
No. 1,736,582 for the mark LIZSPORT for "handbags", issued Dec. 1, 1992;
No. 1,751,840 for the mark LIZSPORT for "eyewear, namely, sunglasses", issued Feb. 9, 1993;
No. 1,768,101 for the mark LIZ SPORT for "footwear, namely, shoes, sneakers, sandals, slippers and boots", issued Apr. 27, 1993; and
No. 1,792,715 for the mark LIZSPORT ALL YOU REALLY NEED for "pants, shirts, culottes, jumpsuits, blouses, sweaters, T-shirts, jackets and shorts", issued Sept. 14, 1993.

[2] Reg. No. 1,169,797, issued Sept. 22, 1981, claiming first use dates of May 1970. Section 8 affidavit filed.

Applicant and the Examining Attorney have filed briefs,[3] but no request was made for an oral hearing.

In any determination of the likelihood of confusion, we look to the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), with particular attention being given to the factors most relevant to the case at hand.

Turning first to the similarity or dissimilarity of the goods involved in the present case, we must agree with the Examining Attorney that the application and registration include several identical goods, e.g., perfume, body lotion or cream, and toilet soap. If this were not enough in itself, the Examining Attorney has made of record copies of several third-party registrations to demonstrate the close relationship of the remaining goods of applicant to those of registrant, by showing that each of the third-party registrants has adopted a single mark for the various personal care products falling within both applicant's and registrant's recited goods. See In re

[3] The Examining Attorney has objected to the evidence which applicant has first submitted in connection with its brief, namely, copies of third-party registrations designated as Exhibits C and D. Inasmuch as this evidence was not made of record by applicant prior to filing of the appeal, the Board has given no consideration to Exhibits C and D or the arguments directed thereto. See Trademark Rule 2.142(d). Similarly, no consideration has been given to applicant's unsupported reference to the allowance of its pending application for a different mark.

Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993); In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467 (TTAB 1988). Thus, we readily conclude that the goods of the parties are in part the same and otherwise closely related, and, in fact, applicant has made no argument to the contrary.

In view of this similarity between the respective products, the goods must be deemed to travel in the same channels of trade, be purchased by the same consumers, and potentially be viewed in close proximity to each other. Furthermore, it is well accepted that when the goods are identical or otherwise closely related, the degree of similarity in the marks necessary to conclude that there will be the likelihood of confusion declines. See Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Taking this into consideration, we turn to the similarity or dissimilarity of the marks used on these identical, or closely related, fragrance and personal care products. The Examining Attorney takes the position that applicant's mark consists merely of the registered mark LIZ (stylized) and the highly suggestive term SPORT. Arguing that "LIZSPORT merely suggests a second, sporty line of LIZ personal care products", the Examining Attorney has made of record several registrations demonstrating adoption by a

single entity of a mark for a line of fragrances and personal care products and of the same mark plus the term "Sport" for a second line of similar products. For example, the combinations BILL BLASS and BILL BLASS SPORT, PACO RABANNE and PR SPORT de PACO RABANNE, and CANOE and CANOE SPORT have each been registered by a single entity for products of this type. The Examining Attorney has also made of record excerpts from three articles obtained from the Nexis database referring to fragrances in the "Sport line", and has pointed to evidence submitted by applicant with respect to the introduction of LIZSPORT as a woman's fragrance and CLAIBORNE SPORT as the man's version in an article entitled "Claiborne to Try the Sporting Life." (Women's Wear Daily, Mar. 1997).

Applicant, on the other hand, argues that its mark LIZSPORT cannot be likened to these other "Sport" marks because its mark is a unitary term. Furthermore, according to applicant, the present LIZSPORT mark would be recognized by consumers as an extension of the use by applicant's parent, Liz Claiborne, Inc., of the same "extremely well-known" mark for a line of apparel and accessories, including sunglasses and handbags. As previously noted, ownership of registrations for the mark as so used has been claimed by applicant in the present application. Applicant

contends that the refusal to register the present LIZSPORT mark in view of the registered LIZ mark, presented in what applicant claims to be a "distinctive" script, makes no sense, if consideration is given to the familiarity of the trade and the public at large with LIZSPORT products and with the prior expansion of use of the mark from apparel to accessories.

We find the evidence made of record by the Examining Attorney adequately establishes the practice in the fragrance field of designating a new "Sport" line, one adapted for use for more casual wear, by adding the word "Sport" to the prior known mark for the fragrance. Even applicant itself has done just this by the introduction of CLAIBORNE SPORT. For applicant to argue that the same analysis is not relevant to the mark LIZSPORT because it is a single word, and not LIZ SPORT, is putting form over substance. Whether unitary or two separate words, the commercial impression is the same, namely, that this is a "Sport" line fragrance. Since LIZ has already been registered for fragrances, consumers would be likely to assume that this new "Sport" line, that is, LIZSPORT, is associated with the LIZ fragrances. The script form used for the registered LIZ mark is not so distinguishing that presentation of LIZSPORT in a different type style would

detract from this association by purchasers. Moreover, applicant has applied for its mark in a typed drawing and thus is not restricted to any particular style, but rather could present its mark in a style very similar to registrant's. See Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983); Jockey International Inc. v. Mallory & Church Corp., 25 USPQ2d 1233 (TTAB 1992).

Applicant, however, insists that the only real association that would be made by consumers would be between the LIZSPORT mark as previously used and registered for apparel and accessories and the new fragrance and body care products bearing the same mark. The goods in the registrations, however, are limited to clothing items and such accessories as sunglasses and handbags. There are no fragrances, cosmetics, or body care products of any type.

Furthermore, although applicant argues that LIZSPORT is a "well-known" or even "famous" mark for clothing and accessories, even if applicant had submitted evidence of this alleged fame, which it has not, it would be immaterial here. Applicant cannot rely upon use and registration of the LIZSPORT mark in connection with different goods, namely, apparel and accessories, as a defense against the likelihood of confusion with the previously registered mark LIZ for fragrances and personal care products, when it is

seeking to register the LIZSPORT mark for the same goods as those listed in the cited registration. See Key Chemicals, Inc. v. Kelite Chemicals Corp., 464 F.2d 1040, 175 USPQ 99 (CCPA 1972). See also In re Sunmarks, Inc., 32 USPQ2d 1470 (TTAB 1994)[each application must be separately examined, even if applicant owns prior registrations for the identical mark for goods closely related to those in the application].

Accordingly, upon considering the marks LIZ (stylized) and LIZSPORT, when used upon the closely related and identical goods listed in the application and the cited registration, we find there is a likelihood of confusion on the part of the purchasing public as to the source of applicant's fragrances and body care products.

Decision: The refusal to register under Section 2(d) is affirmed.

E. J. Seeherman

G. D. Hohein

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board