

US

TTAB rules no likelihood of confusion between designer surnames

Katten Muchin Rosenman

New York



Karen Artz Ash and Bret J Danow

In *Royal Chain, Inc. v Mansur Gavriel LLC*, the Trademark Trial and Appeal Board (TTAB) evaluated whether a likelihood of confusion existed between marks sharing a common surname for complementary fashion products.

Royal Chain had filed a notice of opposition against Mansur Gavriel's trade mark application for the mark MANSUR GAVRIEL (consisting of the two surnames of its founders) covering "handbags; tote bags; purses; wallets" claiming that the MANSUR GAVRIEL mark resembled its registered PHILLIP GAVRIEL mark covering jewellery and was therefore likely to cause confusion.

During the proceeding, Royal Chain's pleaded registration for the PHILLIP GAVRIEL mark was cancelled due to its failure to carry out the necessary maintenance filing in a timely manner. As a result, the Board held that Royal Chain was not entitled to rely on any of the statutory presumptions conferred by the ownership of a trade mark registration and the issue of priority was determined based on Royal Chain's common law use of the PHILLIP GAVRIEL mark rather than the presumptions accorded to its registration. Royal Chain was not able to meet its burden of proving priority of use by a preponderance of the evidence and the Board dismissed the opposition. For purposes of completeness, however, the Board did address the issue of a likelihood of confusion between the marks.

In assessing whether a likelihood of confusion existed between the PHILLIP GAVRIEL mark for jewellery, on the one hand, and the MANSUR GAVRIEL mark for handbags, on the other, the Board found that evidence existed to show that jewellery and handbags are accessories to a women's fashion ensemble and, as such, they are complementary

products and consumers encountering such products under similar marks are likely to believe that they emanate from a single source. Although the Board found the products to be complementary and potentially offered through the same channels of trade to the same classes of consumers, based on the evidence, the Board ultimately determined that there was no likelihood of confusion between the marks.

The Board was not persuaded by Royal Chain's proffered evidence of actual confusion. Though Royal Chain asserted that various trade show attendees and buyers inquired as to whether there was an affiliation or relationship between PHILLIP GAVRIEL and MANSUR GAVRIEL, the Board held that "inquiries as to corporate affiliations is not evidence of actual confusion because, without more, they indicate that these persons were aware that the companies at issue were two different entities." This absence of actual confusion over the approximately five years that the marks were both in use did, in the opinion of the Board, "suggest that the likelihood of confusion is only a remote possibility with little probability of occurring."

Mansur Gavriel submitted evidence to show the coexistence of companies using common surnames for clothing and accessories. The Board drew several inferences from this evidence, namely:

1. There is no per se rule that marks consisting of identical surnames and different given names are likely to cause confusion;
2. The USPTO has registered marks with identical surnames and different given names in the field of clothing and clothing accessories; and
3. A number of different trade mark owners have accepted, over a long period of time, that various marks with identical surnames and different common names can be used and registered side-by-side without causing confusion provided that there are differences between the marks and goods in the field of clothing and clothing accessories.

Accordingly, the Board found that there was no likelihood of confusion between

the marks. This decision is particularly instructive for companies in the fashion industry which often use and seek to register a designer's name or a combination of designers' names as a trade mark.

Katten Muchin Rosenman LLP represented Mansur Gavriel in this proceeding.