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7 **UNITED STATES DISTRICT COURT**
8 **CENTRAL DISTRICT OF CALIFORNIA**
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10 KATE SPADE LLC,) Case No. CV 22-4392 FMO (SSCx)
11 Plaintiff,)
12 v.) **ORDER RE: MOTION FOR PARTIAL**
13 WOLV, INC.,) **SUMMARY JUDGMENT**
14 Defendant.)
15 _____)

16 Having reviewed and considered all the briefing filed with respect to Kate Spade LLC’s
17 (“plaintiff” or “Spade”) Motion for Partial Summary Judgment (Dkt. 59, “Motion”), the court finds
18 that oral argument is not necessary to resolve the Motion, see Fed. R. Civ. P. 78(b); Local Rule
19 7-15; Willis v. Pac. Mar. Ass’n, 244 F.3d 675, 684 n. 2 (9th Cir. 2001), and concludes as follows.

20 **BACKGROUND**¹

21 Spade is a life and style company that offers at least 20 product categories in the United
22 States, including watches, jewelry, and apparel. (See Dkt. 68, Joint Statement of Uncontroverted
23 Facts (“SUF”) at P2). It first registered the word mark, KATE SPADE (“Word Mark”), in 1997.
24 (See id. at P3). It also owns and uses the word mark, KATE SPADE NEW YORK (“New York
25 Word Mark”) (“Word Mark” and “New York Word Mark” collectively referred to as the “Word
26 _____

27 ¹ To the extent the court relies on any objected to evidence, those objections are overruled.
28 Capitalization, quotation and alteration marks, and emphasis in record citations may be altered
without notation.

1 Marks”). (See id. at P5). Spade’s domestic business consists of direct-to-consumer sales via its
2 website and more than 200 retail stores across the United States. (See id. at P76 & P79). Spade
3 also advertises its products through several channels, including social media platforms, (see id.
4 at P57, 60-64), and in national publications. (See id. at P103). Spade also promotes its brand
5 through licensing partnerships, including partnerships for watches. (See id. at P39 - P40).

6 On November 4, 2017, defendant Wolv Inc. (“Wolv” or “defendant”) applied to register the
7 following mark (“Wolv Mark”):



13 (See Dkt. 59-6, Exh. B). Defendant filed its application on an intent-to-use basis in connection with
14 wrist watches, (see Dkt. 68, SUF at P99), and in any color or combination of colors. (See id. at
15 P100). Plaintiff filed an opposition to Wolv’s application. (See id. at P101); (Dkt. 59-7, Exh. C).
16 On April 25, 2022, the Trademark Trial and Appeal Board (“TTAB”) issued a decision dismissing
17 plaintiff’s opposition. See Kate Spade LLC v. Wolv, Inc., (“Spade”), 2022 WL 1237459 (T.T.A.B.
18 2022).

19 On September 13, 2022, Spade filed the operative First Amended Complaint (“FAC”),
20 seeking review of the TTAB’s decision. (See Dkt. 26, FAC at ¶¶ 44-45). Plaintiff now seeks
21 summary judgment on the basis that defendant’s mark is likely to cause confusion with various
22 trademarks owned by Spade, and, specifically the following marks:

- 23 1. The “Kate Spade Mark”:



1
2 2. The “Spade Mark”:



8 3. The “Spade Flower”:



13 (See Dkt. 67, Parties’ Joint Briefing (“Jt. Br.”) at 2-3); (Dkt. 59-36, Exh. M); (the “Spade Mark” and
14 “Spade Flower” together shall be referred to as the “Spade Design Marks”); (the “Kate Spade
15 Mark,” “Spade Design Marks,” and “Word Marks” together shall be referred to as the “Spade
16 Marks”). Plaintiff uses the Kate Spade Mark and the Spade Design Marks in connection with,
17 among other things, jewelry and watches. (See Dkt. 68, SUF at P5 - P8, P14). Spade has used
18 the Spade Mark – or other design marks – in connection with the Word Mark since 2011. (See
19 id. at P12).

20 **LEGAL STANDARD**

21 Rule 56(a) of the Federal Rules of Civil Procedure authorizes the granting of summary
22 judgment “if the movant shows that there is no genuine dispute as to any material fact and the
23 movant is entitled to judgment as a matter of law.” The standard for granting a motion for
24 summary judgment is essentially the same as for granting a directed verdict. See Anderson v.
25 Liberty Lobby, Inc., 477 U.S. 242, 250, 106 S.Ct. 2505, 2511 (1986). Judgment must be entered
26 “if, under the governing law, there can be but one reasonable conclusion as to the verdict.” Id.

27 The moving party has the initial burden of identifying relevant portions of the record that
28 demonstrate the absence of a fact or facts necessary for one or more essential elements of each

1 cause of action upon which the moving party seeks judgment. See Celotex Corp. v. Catrett, 477
2 U.S. 317, 323, 106 S.Ct. 2548, 2553 (1986). If the moving party fails to carry its initial burden of
3 production, “the nonmoving party has no obligation to produce anything.” Nissan Fire & Marine
4 Ins. Co., Ltd. v. Fritz Cos., Inc., 210 F.3d 1099, 1102-03 (9th Cir. 2000).

5 If the moving party has sustained its burden, the burden then shifts to the nonmovant to
6 identify specific facts, drawn from materials in the file, that demonstrate that there is a dispute as
7 to material facts on the elements that the moving party has contested. See Celotex, 477 U.S. at
8 324, 106 S.Ct. at 2553; Anderson, 477 U.S. at 256, 106 S.Ct. at 2514 (A party opposing a properly
9 supported motion for summary judgment “must set forth specific facts showing that there is a
10 genuine issue for trial.”)² A factual dispute is material only if it affects the outcome of the litigation
11 and requires a trial to resolve the parties’ differing versions of the truth. SEC v. Seaboard Corp.,
12 677 F.2d 1301, 1306 (9th Cir. 1982). Summary judgment must be granted for the moving party
13 if the nonmoving party “fails to make a showing sufficient to establish the existence of an element
14 essential to that party’s case, and on which that party will bear the burden of proof at trial.”
15 Celotex, 477 U.S. at 322, 106 S.Ct. at 2552; see Anderson, 477 U.S. at 252, 106 S.Ct. at 2512
16 (parties bear the same substantive burden of proof as would apply at a trial on the merits).

17 In determining whether a triable issue of material fact exists, the evidence must be
18 considered in the light most favorable to the nonmoving party. See Barlow v. Ground, 943 F.2d
19 1132, 1134 (9th Cir. 1991). However, summary judgment cannot be avoided by relying solely on
20 “conclusory allegations [in] an affidavit.” Lujan v. Nat’l Wildlife Fed’n, 497 U.S. 871, 888, 110 S.Ct.
21 3177, 3188 (1990); see also Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586,
22 106 S.Ct. 1348, 1356 (1986) (more than a “metaphysical doubt” is required to establish a genuine
23 issue of material fact). “The mere existence of a scintilla of evidence in support of the plaintiff’s
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26 ² “In determining any motion for summary judgment or partial summary judgment, the Court
27 may assume that the material facts as claimed and adequately supported by the moving party are
28 admitted to exist without controversy except to the extent that such material facts are (a) included
in the Statement of Genuine Disputes and (b) controverted by declaration or other written evidence
filed in opposition to the motion.” Local Rule 56-4.

1 position” is insufficient to survive summary judgment; “there must be evidence on which the [fact
2 finder] could reasonably find for the plaintiff.” Anderson, 477 U.S. at 252, 106 S.Ct. at 2512.

3 DISCUSSION

4 To prevail on a petition to cancel registration of a trademark under § 2(d) of the Lanham
5 Act, a plaintiff must show: (1) priority and (2) likelihood of confusion. See Cunningham v. Laser
6 Golf Corp., 222 F.3d 943, 945 (Fed. Cir. 2000). The court conducts a de novo review of the
7 TTAB’s factual and legal conclusions as to each element. See StonCor Grp., Inc. v. Specialty
8 Coatings, Inc., 759 F.3d 1327, 1331 (Fed. Cir. 2014) (“We review the Board’s . . . legal conclusion
9 of likelihood of confusion de novo.”); Garan, Inc. v. Manimal, LLC, 2022 WL 225060, *3 (D. Or.
10 2022) (“[B]ecause of the presentation of new evidence . . . this Court will review any new evidence
11 as well as the administrative record of the TTAB de novo.”).

12 I. PRIORITY OF REGISTRATION.

13 Plaintiff has shown – and defendant does not contest – priority as to all of the subject
14 marks. (See Dkt. 67, Jt. Br. at 13); see also GN Resound A/S v. Callpod, Inc., 2013 WL 1190651,
15 *5 (N.D. Cal. 2013) (when plaintiff failed to oppose a motion as to a particular issue, “the Court
16 construes as a concession that this claim element [is not satisfied.]”); see, e.g., Hall v. Mortg.
17 Investors Grp., 2011 WL 4374995, *5 (E.D. Cal. 2011) (“Plaintiff does not oppose Defendants’
18 arguments regarding the statute of limitations in his Opposition. Plaintiff’s failure to oppose . . . on
19 this basis serves as a concession[.]”). Accordingly, the court considers whether the Wolv Mark
20 is likely to cause confusion with plaintiff’s Spade Marks.

21 II. LIKELIHOOD OF CONFUSION.

22 “[T]he TTAB evaluates likelihood of confusion by applying some or all of the 13 factors set
23 out in In re E.I. DuPont DeNemours & Co., 476 F.2d 1357 (CCPA 1973).” B & B Hardware, Inc.
24 v. Hargis Indus., Inc., 575 U.S. 138, 144, 135 S.Ct. 1293, 1301 (2015). These are:

- 25 (1) [t]he similarity or dissimilarity of the marks in their entireties as to
26 appearance, sound, connotation and commercial impression[;] (2) [t]he
27 similarity or dissimilarity and nature of the goods or services as described in
28 an application or registration or in connection with which a prior mark is in

1 use[;] (3) [t]he similarity or dissimilarity of established, likely-to-continue trade
2 channels[;] (4) [t]he conditions under which and buyers to whom, sales are
3 made, i.e., “impulse” vs. careful, sophisticated purchasing[;] (5) [t]he fame of
4 the prior mark[;] (6) [t]he number and nature of similar marks in use on similar
5 goods[;] (7) [t]he nature and extent of any actual confusion[;] (8) [t]he length
6 of time during and conditions under which there has been concurrent use
7 without evidence of actual confusion[;] (9) [t]he variety of goods on which a
8 mark is or is not used[;] (10) [t]he market interface between the applicant and
9 the owner of the prior mark[;] (11) [t]he extent to which applicant has a right
10 to exclude others from use of its mark on its goods[;] (12) [t]he extent of
11 potential confusion, i.e., whether de minimis or substantial[; and] (13) [a]ny
12 other established fact probative of the effect of use.

13 DuPont, 476 F.2d at 1361. “Not all of the DuPont factors are necessarily relevant or of equal
14 weight in a given case, and any one of the factors may control a particular case.” Citigroup Inc.
15 v. Cap. City Bank Grp., Inc., 637 F.3d 1344, 1355 (Fed. Cir. 2011) (internal quotation marks
16 omitted).

17 Here, the parties’ briefing focuses on the fame of the subject marks, the channels of trade
18 and classes of consumers, the sophistication of the consumers, and the similarity of the marks.
19 (See Dkt. 67, Jt. Br. at 15-27). Accordingly, the court considers each of these factors in turn.

20 A. Fame of the Prior Marks.

21 “The fame of the registered mark plays a dominant role in the DuPont analysis, as famous
22 marks enjoy a wide latitude of legal protection.” Coach Servs. Inc. v. Triumph Learning LLC, 668
23 F.3d 1356, 1366-67 (Fed. Cir. 2012) (internal quotation marks omitted). Fame for a likelihood of
24 confusion analysis “varies along a spectrum from very strong to very weak.” In re Coors Brewing
25 Co., 343 F.3d 1340, 1345 (Fed. Cir. 2003). A mark’s fame “may be measured indirectly, among
26 other things, by the volume of sales and advertising expenditures of the goods traveling under the
27 mark, and by the length of time those indicia of commercial awareness have been evident.” Bose
28 Corp. v. QSC Audio Prods., Inc., 293 F.3d 1367, 1371 (Fed. Cir. 2002). Other relevant factors in

1 the fame analysis include the “length of use of the mark, market share, brand awareness, licensing
2 activities, and variety of goods bearing the mark.” Coach Servs, 668 F.3d at 1367.

3 To support its position that the Spade Marks are famous, plaintiff points to, among other
4 things, Spade’s general marketing expenditures, customer numbers – including the number of
5 visitors to its retail stores and website – and net sales. (See Dkt. 67, Jt. Br. at 16-18). Here, the
6 evidence is undisputed that the Spade Marks are well known and recognizable among the general
7 public.³ Defendant, however, points out that almost none of plaintiff’s evidence is particularized
8 to the sale of wrist watches, which is the product category at issue. (See id. at 18-19). According
9 to defendant, evidence of commercial use of a mark across a wide range of product categories
10 is not sufficient to establish a mark’s fame; instead, a mark’s fame must be demonstrated within
11 the specific product category at issue. (See id.). Plaintiff counters that “extensive use of a mark
12 across a wide range of goods and services serves to strengthen, rather than undercut, the fame
13 of a mark.” (Dkt. 71, Plaintiff Kate Spade LLC’s Supplemental Brief on Plaintiff’s Motion for Partial
14 Summary Judgment (“Supp.”) at 2).

15 The fame analysis is intended to ensure that a “mark’s fame and the consumer’s trust in
16 that symbol . . . are [not] subject to exploitation by free riders.” Kenner Parker Toys, 963 F.2d at
17 353. Plaintiff’s “argument that fame of a mark for one product . . . transfer[s] to other products,”
18 (see Dkt. 71, Supp. at 3), makes some sense. In other words, purchasers may still be confused
19 by the presence of a mark that bears similarity to a famous mark for an unrelated product type.
20 See Recot, Inc. v. Becton, 214 F.3d 1322, 1327 (Fed. Cir. 2000) (a mark’s fame “applies with
21 equal force when evaluating the likelihood of confusion between marks that are used with goods
22 that are not closely related, because the fame of a mark may also affect the likelihood that
23 consumers will be confused when purchasing these products”).

24
25 ³ It is also uncontested that plaintiff’s marks are arbitrary, (see, generally, Dkt. 67, Jt. Br. at 15-
26 19, 26-27); Nautilus Grp., Inc. v. Icon Health & Fitness, Inc., 372 F.3d 1330, 1340 (Fed. Cir. 2004)
27 (defining an arbitrary mark as a “known word used in an unexpected or uncommon way” and
28 observing that such marks are typically strong), which reinforces the importance of the marks’
fame. See Kenner Parker Toys Inc. v. Rose Art Indus., Inc., 963 F.2d 350, 352 (Fed. Cir. 1992)
 (“[F]ame of the prior mark[] plays a dominant role in cases featuring a famous or strong mark.
Famous or strong marks enjoy a wide latitude of legal protection.”).

1 Still, defendant’s argument has force. The relevant inquiry is whether purchasers of the
2 particular product type at issue are likely to be confused by the presence of a mark that resembles
3 a famous mark. See Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC, 857 F.3d 1323,
4 1325 (Fed. Cir. 2017) (“In examination of . . . fame, the applicable viewpoint is that of the relevant
5 market. . . . A mark’s renown within a specific product market is the proper standard.”) (internal
6 quotation marks, citation, and alteration mark omitted); see, e.g., Trek Bicycle Corp. v. Isaacs,
7 2023 WL 7649542, *5 (Fed. Cir. 2023) (“Trek has failed to show that the Board’s findings on fame
8 and commercial strength with respect to the identified goods are not supported by substantial
9 evidence.”) (emphasis added); Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp., 954 F.2d 713,
10 716 (Fed. Cir. 1992) (holding that purchaser confusion is the “primary focus” and, in the case of
11 goods and services that are sold, “the inquiry generally will turn on whether actual or potential
12 ‘purchasers’ are confused”). Thus, in some cases, “a general public awareness standard does
13 not adequately reflect the mark’s fame amongst the purchasing public.” Palm Bay Imports, Inc.
14 v. Veuve Clicquot Ponsardin Maison Fondée en 1772, 396 F.3d 1369, 1375 (Fed. Cir. 2005)⁴; see
15 Trek, 2023 WL 7649542, at *5 (affirming TTAB’s finding that a mark’s fame did not extend to the
16 products at issue and holding that the TTAB did not err by faulting plaintiff for failing to provide
17 sufficient evidence that plaintiff’s mark was famous and commercially strong “with respect to the
18 identified goods”). The upshot of these various holdings is that, although evidence of a mark’s
19 general fame for unrelated product categories may be relevant, the weight of such evidence is
20 greater where plaintiff establishes some nexus between the products for which a mark is famous
21 and the product types at issue. See Palm Bay, 396 F.3d at 1375. Here, plaintiff makes no such
22 argument, (see, generally, Dkt. 67, Jt. Br. at 15-18), and thus the court gives little weight to its
23 general evidence of fame.

24
25 ⁴ Plaintiff’s attempt to distinguish this and defendant’s other cases, (see Dkt. 71, Supp. at 2-3),
26 is unpersuasive. Palm Bay, which was decided five years after Recot, held that “the proper legal
27 standard for evaluating the fame of a mark under the fifth DuPont factor is the class of customers
28 and potential customers of a product or service, and not the general public.” Palm Bay, 396 F.3d
at 1375; see Trek, 2023 WL 7649542, at *4-5 (affirming TTAB’s conclusion that “the evidence
does not support a finding that TREK is famous for the types of goods identified in the subject
applications.”) (internal quotation marks and alteration omitted).

1 Further, although plaintiff produced some evidence relating to its sale of watches, (see Dkt.
2 68, SUF at P26 & P56), it has not, as defendant points out, (see Dkt. 67, Jt. Br. at 19), provided
3 information that compares its sales figures to figures from other watch brands; nor did plaintiff
4 provide any information regarding how many people purchased its watches or looked at them
5 online. (See, generally, id. at 15-18); (Dkt. 68, SUF). These deficiencies are significant, for “raw
6 numbers alone in today’s world may be misleading” because, for example, “[a] tiny percentage of
7 the market share for the product or a small share of advertising revenues for the product market
8 could undermine the weight given to the figures for assessment of fame[.]” even if the raw
9 numbers for sales or marketing expenditures are large. See Bose Corp., 293 F.3d at 1375. In
10 other words, plaintiff – who bears the burden, see Hoover Co. v. Royal Appliance Mfg. Co., 238
11 F.3d 1357, 1360 (Fed. Cir. 2001) (“[T]he opposer bears the burden of establishing that the
12 applicant does not have the right to register its mark.”) – must provide “some context in which to
13 place raw statistics[.]” Bose Corp., 293 F.3d at 1375; see, e.g., Trek, 2023 WL 7649542, at *5
14 (“For example, the Board noted that Trek’s evidence of marketing expenditures was not broken
15 down by product and did not appear to be for only clothing and bags. . . . Accordingly, Trek has
16 failed to show that the Board’s findings on fame and commercial strength with respect to the
17 identified goods are not supported by substantial evidence.”) (internal quotation and alteration
18 marks omitted). That plaintiff has not done so lessens the weight of its evidence as to the fame
19 of the Spade Marks with respect to the product type at issue.

20 Under the circumstances here, the court finds that plaintiff has demonstrated only that the
21 Spade Marks are weakly famous with respect to the identified product type. See Coach Servs.,
22 668 F.3d at 1367 (“Fame for purposes of likelihood of confusion is a matter of degree that varies
23 along a spectrum from very strong to very weak.”) (internal quotation marks omitted). Thus, this
24 factor weighs slightly in favor of a likelihood of confusion.

25 B. Channels of Trade and Classes of Consumers.

26 With respect to “[t]he similarity or dissimilarity and nature of the goods or services” and
27 “[t]he similarity or dissimilarity of established, likely-to-continue trade channels[.]” DuPont, 476
28 F.2d at 1361, plaintiff argues that “the goods are identical and travel in the same channels of

1 trade[.]” (Dkt. 67, Jt. Br. at 20). Defendant does not contest this point. (See, generally, id. at 19-
2 26-27); see GN Resound A/S, 2013 WL 1190651, at *5 (when plaintiff failed to oppose a motion
3 as to a particular issue, “the Court construes as a concession that this claim element [is not
4 satisfied.]”). Thus, these factors weigh in favor of finding a likelihood of confusion.

5 C. Sophistication of the Consumers.

6 “In analyzing the degree of care that a consumer might exercise in purchasing the parties’
7 goods, the question is whether a reasonably prudent consumer would take the time to distinguish
8 between the two product lines.” Survivor Media, Inc. v. Survivor Prods., 406 F.3d 625, 634 (9th
9 Cir. 2005) (internal quotation marks omitted). “Confusion is less likely where buyers exercise care
10 and precision in their purchases, such as for expensive or sophisticated items.” Multi Time
11 Machine, Inc. v. Amazon.com, Inc., 804 F.3d 930, 937 (9th Cir. 2015) (internal quotation marks
12 omitted); see Moroccanoil, Inc. v. Moroccan Gold, LLC, 2008 WL 11411416, *6 (C.D. Cal. 2008)
13 (“Courts have found that the ordinary purchaser presumably takes more care in purchasing
14 ‘expensive’ items that she buys infrequently, than in buying everyday, relatively inexpensive
15 items.”). In addition, “[w]here the relevant buyer class is composed solely of professional or
16 commercial purchasers, it is reasonable to set a higher standard of care than exists for
17 consumers.” YKK Corp. v. Jungwoo Zipper Co., Ltd., 213 F.Supp.2d 1195, 1205 (C.D. Cal. 2002)
18 (internal citation omitted), abrogation on other grounds recognized in DenimXworks Inc. v. J.L.J.,
19 Inc., 2010 WL 11596164, *3 n. 3 (C.D. Cal. 2010); see, e.g., Walter v. Mattel, Inc., 31 F.Supp.2d
20 751, 761 (C.D. Cal. 1998), aff’d, 210 F.3d 1108 (9th Cir. 2000) (“Because Plaintiff’s illustration
21 services usually costs hundreds or thousands of dollars and are purchased by sophisticated
22 commercial art buyers as part of their job responsibilities, purchasers of her services are likely to
23 take greater care in selecting her services.”).

24 Plaintiff argues that the court must presume that “the parties’ watches include even
25 inexpensive items that may be purchased on impulse” because the identifications are not limited.
26 (Dkt. 67, Jt. Br. at 27). Defendant contends that the court should not credit plaintiff’s argument
27 because “Spade does not argue, nor does its evidence indicate, that any of its own watches are
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1 low-priced and subject to impulse buying or that its own customers, for any of its wrist watch
2 models, exercise less purchasing care.” (Id.).

3 The likelihood of confusion analysis must be undertaken “on the basis of the goods and
4 services as they are identified” in a mark’s registration or application. See In Re Opus One, Inc.,
5 60 U.S.P.Q.2d 1812, *6 (T.T.A.B. 2001). In the absence of identifications to the contrary, the court
6 must presume that the subject goods include inexpensive products. See, e.g., id. (“Applicant’s
7 ‘restaurant services’ . . . must be presumed to encompass inexpensive or moderately-priced
8 restaurant services, and registrant’s ‘wine’ must be presumed to encompass inexpensive or
9 moderately-priced wine. In view thereof, applicant’s arguments regarding the high cost of its
10 actual restaurant services and of registrant’s actual wine, and the resulting carefulness and
11 sophistication of the purchasers, miss the mark.”); CBS Inc. v. Morrow, 708 F.2d 1579, 1581 (Fed.
12 Cir. 1983) (“[T]he issue must be resolved . . . in the absence of specific limitations in the
13 application and registration, on consideration of the normal and usual channels of trade and
14 methods of distribution.”); Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP, 746 F.3d 1317, 1325
15 (Fed. Cir. 2014) (“Although the services recited in the application also encompass sophisticated
16 investors, Board precedent requires the decision to be based on the least sophisticated potential
17 purchasers.”) (internal quotation marks omitted). Thus, even if there were evidence that plaintiff’s
18 marks are used only in connection with expensive wrist watches, such evidence would not
19 undermine a likelihood of confusion finding.

20 D. Similarity or Dissimilarity of the Marks.

21 Finally, the court considers the “similarity or dissimilarity of the marks in their entirety as
22 to appearance, sound, connotation and commercial impression.” DuPont, 476 F.2d at 1361. It
23 is improper to dissect a mark, as the mark must be considered in its entirety. See In re Shell Oil
24 Co., 992 F.2d 1204, 1206 (Fed. Cir. 1993) (“The marks are considered in their entirety, words
25 and design.”); Sports Auth. Mich., Inc. v. PC Auth., Inc., 63 U.S.P.Q.2d 1782, 1792 (T.T.A.B.
26 2002) (same). “On the other hand, in articulating reasons for reaching a conclusion on the issue
27 of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has
28 been given to a particular feature of a mark, provided the ultimate conclusion rests on

1 consideration of the marks in their entireties. Indeed, this type of analysis appears to be
2 unavoidable.” In re Nat’l Data Corp., 753 F.2d 1056, 1058 (Fed. Cir. 1985) (footnote omitted);
3 Leading Jewelers Guild, Inc. v. Ljow Holdings, LLC, 82 U.S.P.Q.2d 1901, *5 (T.T.A.B. 2007)
4 (“[O]ne feature of a mark may be more significant than another, and it is not improper to give more
5 weight to this dominant feature in determining the commercial impression created by the mark.”).
6 Thus, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the
7 marks are sufficiently similar . . . such that persons who encounter the marks would be likely to
8 assume a connection between the parties.” Coach Servs., 668 F.3d at 1368 (internal quotation
9 marks omitted).

10 Where, as here, “marks would appear on virtually identical goods or services, the degree
11 of similarity necessary to support a conclusion of likely confusion declines.” Century 21 Real
12 Estate v. Century Life of Am., 970 F.2d 874, 877 (Fed. Cir. 1992). Also, because the Spade
13 Marks are arbitrary and weakly famous, the degree of similarity needed for a likelihood of
14 confusion finding is further reduced. See Kenner Parker Toys, 963 F.2d at 353. Finally, the court
15 notes “the fallibility of memory over a period of time” and that the “average” purchaser “normally
16 retains a general rather than a specific impression of trademarks.” Sealed Air Corp. v. Scott Paper
17 Co., 190 USPQ 106, *3 (T.T.A.B. 1975).

18 Here, the court focuses its analysis on the similarities and dissimilarities between the Spade
19 Mark and Kate Spade Mark as compared to the Wolv Mark. The Spade Mark and Kate Spade
20 Mark are the marks that are most similar to the Wolv Mark. Thus, if there is no likelihood of
21 confusion between either of those marks and the Wolv Mark, it follows that there is no likelihood
22 of confusion between the Wolv Mark and the other Spade Marks. See, e.g., In Re St. Julian Wine
23 Co., Inc., 2020 WL 2788005, *4 (T.T.A.B. 2020) (“We will concentrate on the composite marks
24 shown in [the registrations]. If a likelihood of confusion is found as to these registrations, it is
25 unnecessary to consider the other cited registrations. Conversely, if a likelihood of confusion is
26 not found as to the marks in these registrations, we would not find it as to the marks in the other
27 cited registrations.”); In Re Max Cap. Grp. Ltd., 93 U.S.P.Q.2d 1243, *2 (T.T.A.B. 2010) (“[I]f
28 confusion is likely between those marks, there is no need for us to consider the likelihood of

1 confusion with the cited mark for MAX with the dot design, while if there is no likelihood of
2 confusion between applicant's mark and MAX in typed form, then there would be no likelihood of
3 confusion with the MAX and dot design mark.”).

4 With respect to appearance, see Recot, 214 F.3d at 1329, the marks are dissimilar. That
5 is, although the Wolv Mark, Spade Mark, and Kate Spade Mark all include a design element
6 whose outline looks like a spade from a deck of playing cards, (see Dkt. 59-6, Exh. B); (Dkt. 59-36,
7 Exh. M), the Spade Mark is solid black, as is the Kate Spade Mark’s design element. (See Dkt.
8 59-36, Exh. M). By contrast, the top-half of the design element of the Wolv Mark is not filled in
9 and, instead, has a stylized “W” in the center. (See Dkt. 59-6, Exh. B).

10 The word elements are also dissimilar. The Wolv Mark prominently features the word
11 WOLV in capital letters, and the first letter of WOLV is stylized such that the first letter of the word
12 resembles two intersecting “V” letters. (See Dkt. 59-6, Exh. B). The stylized “W” in the center of
13 the Wolv Mark reinforces the importance of the mark’s word element, particularly given the stylized
14 “W” at the beginning of the word WOLV, and further distinguishes the Wolv Mark’s design element
15 from the Spade Mark and the Kate Spade Mark’s design element. (Id.).

16 It is well-settled that, “[i]n the case of a composite mark containing both words and a
17 design, the verbal portion of the mark is the one most likely to indicate the origin of the goods to
18 which it is affixed.” In re Viterra Inc., 671 F.3d 1358, 1362 (Fed. Cir. 2012) (internal quotation
19 marks omitted); CBS Inc., 708 F.2d at 1581-82 (same). This is so because “the literal component
20 of brand names likely will appear alone when used in text and will be spoken when requested by
21 consumers.” Viterra, 671 F.3d at 1366; see In re Dakin’s Miniatures, Inc., 59 USPQ2d 1593, *3
22 (T.T.A.B. 1999) (“In the case of marks which consist of words and a design, the words are
23 normally accorded greater weight because they would be used by purchasers to request the
24 goods.”). Put differently, a customer who seeks out a particular brand is likely to repeat the words
25 contained in a composite mark’s word element, rather than describe the design element of such
26 a mark. See Viterra, 671 F.3d at 1366 (“[T]he verbal portion of a word and design mark likely will
27 be the dominant portion . . . given that the literal component of brand names likely will appear
28 alone when used in text and will be spoken when requested by consumers.”) (citation omitted).

1 This case is no exception. Here, the word WOLV is the dominant portion of the Wolv Mark. (See
2 Dkt. 59-6, Exh. B). In other words, an average purchaser who wishes to buy one of defendant's
3 products would ask for a "Wolv watch," not a "stylized, black-outlined, playing-card-spade with the
4 letter 'W' inside of its watch" or a "spade watch." See L.C. Licensing, Inc. v. Cary Berman, 86
5 U.S.P.Q.2d 1883, *3 (T.T.A.B. 2008) ("[I]t is well settled that if a mark comprises both a word and
6 a design, then the word is normally accorded greater weight because it would be used by
7 purchasers to request the goods."); Jean Patou, Inc. v. Aristocrat Prod. Corp., 202 U.S.P.Q. 130,
8 *3 (T.T.A.B. 1979) ("[T]he emphasis must be on the recollection of the average purchaser, who
9 normally retains a general rather than a specific impression of trademarks.").

10 Plaintiff asserts that the TTAB "erroneously viewed WOLV to be the 'prominent' and
11 'dominant element'" of the Wolv Mark. (Dkt. 67, Jt. Br. at 24). According to plaintiff, the design
12 portion should dominate because "the design portion is well known to consumers[.]" (Id.). In
13 support of its argument, plaintiff relies on two cases – Lacoste Alligator S.A. v. Maxoly, Inc.
14 ("Maxoly"), 91 USPQ2d 1594 (T.T.A.B. 2009) and Lacoste Alligator S.A. v. S. Smocked Co.
15 ("Smocked"), 2021 WL 3771890 (T.T.A.B. 2021) – one of which it claims is "directly on point."
16 (See Dkt 67, Jt. Br. at 24). But neither case supports the proposition for which plaintiff cites the
17 cases. Although both cases found that the addition of a word element to a design mark did not
18 distinguish the marks at issue, see Maxoly, 91 USPQ2d 1594 at *5-6; Smocked, 2021 WL
19 3771890, at *7-8, neither case articulated a rule that word portions of composite marks cannot
20 dominate even where the marks also contain a well-known design element. Nor do any of
21 plaintiff's remaining cases suggest the existence of such a rule; the courts in those cases found
22 that, under their particular facts, the addition of a word element to a design mark did not
23 sufficiently distinguish the marks. See, e.g., Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller,
24 477 F.2d 586, 587-88 (C.C.P.A. 1973) (finding that where design elements were sufficiently
25 similar, the addition of a word element did not foreclose a conclusion that "the overall commercial
26 impression created by appellee's mark is sufficiently similar to that created by appellant's mark");
27 Philip Morris, Inc. v. Rembrandt Tobacco Corp. (Overseas) Ltd., 185 U.S.P.Q. 823 (T.T.A.B. 1975)
28 (finding that, in light of the particular facts at issue, marks were likely to cause confusion even in

1 light of a word element). None held that they were bound to find as much based on the rule
2 plaintiff proposes. See id. For example, in In Re Sloppy Joe's Int'l, Inc., 43 U.S.P.Q.2d 1350
3 (T.T.A.B. 1997), the TTAB conducted a fact-specific analysis and found that, based on the
4 “prominence of the design element, and the fact that it is a recognizable portrait of a well known
5 person, Ernest Hemingway[,]” it was not appropriate to treat the word portion of the composite
6 mark as dominant because, “[a]s used on the specimens of record . . . the Hemingway portrait is
7 especially eye-catching.” Id. at *6 (emphasis added).

8 Here, the word WOLV, not the design element, dominates the Wolv Mark. (See Dkt. 59-6,
9 Exh. B). In other words, and “in light of the fallibility of memory[,]” In re St. Helena Hosp., 774 F.3d
10 747, 751 (Fed. Cir. 2014) (internal quotation marks omitted), the court is persuaded that the
11 average consumer would recall the word WOLV and not the stylized design element. Moreover,
12 with respect to commercial impression, see Palm Bay, 396 F.3d at 1371, although the goods at
13 issue appear to be sold in the same commercial context, the dissimilarity of the Wolv Mark’s word
14 element greatly outweighs any structural similarity. Cf., e.g., In re Detroit Athletic Co., 903 F.3d
15 1297, 1303 (Fed. Cir. 2018) (“[I]n view of the marks’ structural similarity, the lead words are their
16 dominant portion and are likely to make the greatest impression on consumers.”). This is the case
17 even when the court considers that the marks “appear on virtually identical goods or services,”
18 Century 21, 970 F.2d at 877, and the Spade Marks’ fame – though only weakly famous –
19 “magnifie[s] the significance of the[] similarities.” Kenner Parker Toys, 963 F.2d at 355.

20 With respect to sound, see Recot, 214 F.3d at 1329, there is no dispute that the Wolv Mark
21 and the Kate Spade Mark are dissimilar. (See, generally, Dkt. 67, Jt. Br. at 20-27). The word
22 element of the Wolv Mark, WOLV, is pronounced like the word “wolves.” (See id. at 26). The
23 word element of the Kate Spade Mark does not share any words that sound similar, see, e.g.
24 Spireon, Inc. v. Flex Ltd., 71 F.4th 1355, 1366 (Fed. Cir. 2023) (“FLEX PULSE is quite different
25 from FL FLEX in appearance and sound.”); nor do the Wolv Mark and Kate Spade Mark share any
26 other phonetic similarities like cadence or number of syllables. Cf., e.g., In re Nat’l Data Corp.,
27 753 F.2d at 1060 (finding similarity between CASH MANAGEMENT ACCOUNT and THE CASH

1 MANAGEMENT EXCHANGE because they “are, in large part, identical in sound and appearance
2 and have a general similarity in cadence”).

3 Finally, there is little similarity of connotation. See Recot, 214 F.3d at 1329. Plaintiff asserts
4 that, with respect to the Kate Spade Mark and the Wolv Mark, “the spade is juxtaposed above the
5 word mark, creating similarity in the . . . commercial connotation between the marks.” (Dkt. 67,
6 Jt. Br. at 26). Plaintiff, however, does not explain what it believes the design elements connote.
7 (See, generally, id.). In any event, to whatever extent the design elements can be said to connote
8 anything at all, such similarity is minimal at best. Further, as defendant notes, the word element
9 of the Wolv Mark does not “connote[] anything similar to Kate Spade. Wolv is a truncated plural
10 of wolf, an animal. Kate Spade is a human name. Kate Spade New York is a human name next
11 to a city.” (Dkt. 67, Jt. Br. at 26). In short, the similarity or dissimilarity factor weighs strongly
12 against a likelihood of confusion finding.

13 E. Summary of DuPont Factors.

14 The court finds that plaintiff’s marks are arbitrary and only weakly famous, see supra at
15 II.A., apply to identical goods, see supra at II.B., and are not sold to sophisticated consumers.
16 See supra at II.C.. But “[n]ot all of the DuPont factors are necessarily relevant or of equal weight
17 in a given case, and any one of the factors may control a particular case.” Citigroup, 637 F.3d at
18 1355 (internal quotation marks omitted). Here, although the factors discussed above weigh in
19 favor (some only slightly) of a finding of likelihood of confusion, see supra at II.A.-C., the court is
20 persuaded that those factors are firmly outweighed by the court’s finding regarding the similarity
21 or dissimilarity of the marks. See Citigroup, 637 F.3d at 1355 (courts “may find a single factor
22 dispositive”). That is, having considered the “similarity or dissimilarity of the marks in their
23 entireties as to appearance, sound, connotation and commercial impression[,]” DuPont, 476 F.2d
24 at 1361, and eschewed any “side-by-side comparison[,]” Coach Servs., 668 F.3d at 1368, the
25 court is persuaded that the marks are so dissimilar that no “persons who encounter the marks
26 would be likely to assume a connection between the parties.” Id.

27 *///*

