UNITED STATES: TTAB Addresses Registrability of Individual Name
Contributor: Robert P. Felber, Jr., Waller Lansden Dortch & Davis, LLP, Nashville, Tennessee; Verifier: Kevin W. Grierson, Willecox & Savage, P.C., Norfolk, Virginia. Both are members of the INTA Bulletin Law & Practice—Americas Subcommittee

In a precedential decision, the U.S. Patent and Trademark Office’s Trademark Trial and Appeal Board (TTAB) affirmed the refusal of registration for the mark SAM EDELMAN, for luggage, handbags, wallets, tote bags and similar goods in Class 18, on the grounds that the applied-for mark was likely to be confused with the prior-registered trademark EDELMAN, for wallets, handbags, traveling bags, luggage trunks and similar products in Class 18. In re SL&E Training Stable, Inc., Serial No. 78806669 (T.T.A.B. Sept. 4, 2008).

The applicant argued that there was no likelihood of confusion because of the strong public policy in favor of allowing individuals to use their personal names. The TTAB found no such policy. That Sam Edelman was the name of an individual did not give the applicant an unfettered right to use that name if it conflicted with a previously registered mark. The TTAB applied the traditional likelihood of confusion analysis, taking into account the similarity of the marks and the goods.

Several of the goods listed in the SAM EDELMAN application were found to be identical to the goods listed in the EDELMAN registration. Identical goods are presumed to be provided through the same channels of trade to the same classes of consumers. In comparing the marks, the TTAB found that the surname was the dominant and most prominent portion of both marks. Given the similarities between the goods and the marks, the TTAB found a likelihood of confusion. The applicant’s ownership of a prior registration for the mark SAM EDELMAN in Class 25 for footwear did not prevent the TTAB from refusing registration of the same mark in Class 18.

Also unconvincing was the applicant’s argument that its principal, Sam Edelman, is renowned in the fashion industry. The TTAB found that not only was the applicant’s submission of newspaper articles insufficient to prove that Mr. Edelman was well known but the applicant failed to show how his widespread recognition in the fashion industry would diminish the likelihood of confusion of the applied-for mark with a registered trademark.