This Opinion is a Precedent of the TTAB

Hearing: April 22, 2014 Mailed: January 30, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Nieves & Nieves LLC

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Serial No. 85179243

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Richard Mark Blank, counsel for Nieves & Nieves, LLC.

Suzanne Blane, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

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Before Bucher, Zervas and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Nieves & Nieves LLC ("Applicant") filed an intent-to-use application to register the mark PRINCESS KATE, in standard character form, for the following goods, as amended:

> Cosmetics; fragrances; perfumes; skin care, namely, moisturizer, facial wash, and cleanser; nail polish; personal care products, namely, shampoo, body wash, conditioner, soap, shower gel, in Class 3;
>
> Watches; cufflinks; key fobs of precious metals; jewelry; jewelry boxes, in Class 14;
>
> Pouches, namely, leather pouches, pouches for holding makeup, keys and other personal items; purses; handbags; pocketbooks; clutches; backpacks; book bags; sports bags; bum

> bags; wallets; duffel bags; garment bags for travel; tote bags; shoulder bags; luggage; sack packs, namely, drawstring bags used as backpacks; evening handbags; evening bags; fashion handbags; gentleman's handbags; handbags for ladies; handbags for men; leather handbags; coin purses; key fobs; makeup cases sold empty; lipstick cases sold empty; hand mirror cases of leather; leather key chains; accessories, namely, briefcases, attaché cases, in Class 18;
>
> Bedding, namely, bed sheets, pillow cases, blankets, down blankets, quilts, bed skirts, throw blankets, fitted sheets, pillow shams, bedspreads, bed covers, comforters, curtains, shower curtains; bed sheets; bath towels; towels, in Class 24; and
>
> Apparel, namely, shirts, pants, dresses, skirts, gowns, party dresses, thongs, suits, ties, knits in the nature of sweaters and scarves, sweaters, robes, underwear, pajamas, leggings, scarves, gloves, outerwear in the nature of raincoats jackets blazers and down jackets, intimates in the nature of pajamas panties hosiery robes and bras, hosiery, lingerie, underwear, socks, sleepwear, athletic uniforms, jackets, cloths in the nature of pants shirts vests and shorts, tops, coats, neckties, bowties, raincoats, winter coats, leather jackets, caps, hats, derbies, felt hats, leather caps; wristbands; headbands; masks in the nature of sleep masks; face masks; footwear, namely, athletic footwear, beach footwear, climbing footwear, flip flops, footwear for children, footwear for men, footwear for women, footwear for teens, footwear for men and women, dress footwear, pumps, high heel shoes, shoes, men's shoes, ladies shoes, work boots, hiking boots, snow boots, boots, sandals, sneakers, running shoes, slippers; belts; bibs not of paper; cloth diapers, in Class 25.

The application contains a statement that "the name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual."

The Trademark Examining Attorney refused to register Applicant's mark under Section 2(a) of the Trademark Act of 1946, 15 U.S.C. § 1052(a), on the ground that PRINCESS KATE falsely suggests a connection with Catherine, Duchess of Cambridge, also known as Kate Middleton. The Trademark Examining Attorney

also refused to register Applicant's mark under Section 2(c) of the Trademark Act, 15 U.S.C. § 1052(c), on the ground that PRINCESS KATE consists of a name identifying a particular living individual whose written consent to register the mark is not of record.

I. Preliminary Issue

Applicant attached evidence to both its main brief and its reply brief. The Trademark Examining Attorney did not object to the evidence attached to the main brief in her responsive brief, nor did she reference that material. At the oral hearing, the Trademark Examining Attorney objected to the evidence attached to the reply brief.

Trademark Rule 2.142(d) provides that the record should be complete prior to the filing of an appeal.

> (d) The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may request the Board to suspend the appeal and to remand the application for further examination.

Id.

> Exhibits attached to a brief that were not made of record during examination are untimely, and generally will not be considered. [Internal citations omitted]. However, if the examining attorney, in his or her brief, discusses the exhibits attached to the applicant's brief without objecting to them …, they will be deemed to have been stipulated into the record.

TBMP § 1203.02(e) (2014). *See also In re District of Columbia,* 101 USPQ2d 1588, 1591-92 (TTAB 2012) (third-party registrations submitted for first time with appeal

brief are not considered), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *In re Zanova Inc.*, 59 USPQ2d 1300, 1302 (TTAB 2001) ("By attempting to introduce evidence with its reply brief, applicant has effectively shielded this material from review and response by the Examining Attorney"; material submitted with reply brief not considered); *In re Styleclick.com Inc.,* 57 USPQ2d 1445, 1446 n.2 (TTAB 2000) (although the applicant had properly submitted copies of third-party registrations, additional registrations listed in applicant's brief, which were not commented on by Examining Attorney in her brief, were not considered); TMEP § 710.01(c) (2014) (the Board may consider evidence filed with an applicant's brief if the Examining Attorney does not object to the evidence *and* the examining attorney discusses the evidence or otherwise treats it as being of record).

Because the Examining Attorney did not treat the evidence attached to Applicant's brief or reply brief as being of record, we will not consider the evidence attached to these briefs if such evidence was not made of record during prosecution of the application.

II. Whether PRINCESS KATE Falsely Suggests a Connection with Kate Middleton?

To determine whether Applicant's PRINCESS KATE mark falsely suggests a connection with Kate Middleton under Section 2(a), the Board analyzes whether the evidence of record satisfies the following four-part test:

(1) Whether Applicant's mark PRINCESS KATE is the same as or a close approximation of Kate Middleton's previously used name or identity;

(2) Whether Applicant's mark PRINCESS KATE would be recognized as such by purchasers, in that the mark points uniquely and unmistakably to Kate Middleton;

(3) Whether Kate Middleton is not connected with the goods that will be sold by Applicant under its mark; and

(4) Whether Kate Middleton's name or identity is of sufficient fame or reputation that when Applicant's mark is used on Applicant's goods, a connection with Kate Middleton would be presumed.

See In re Pedersen, 109 USPQ2d 1185, 1188 (TTAB 2013); *In re Jackson Int'l Trading Co.,* 103 USPQ2d 1417, 1419 (TTAB 2012). *See also Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.,* 703 F.2d 1372, 217 USPQ 505, 509 (Fed. Cir. 1983) (hereinafter "*Notre Dame*"); *Bd. of Trs. of Univ. of Ala. v. Pitts*, 107 USPQ2d 2001, 2025 (TTAB 2013) (hereinafter "*Pitts*").

A. Whether Applicant's mark PRINCESS KATE is the same as or a close approximation of the name or identity of Kate Middleton?

Applicant argues that PRINCESS KATE is not a close approximation of Kate Middleton's previously-used name or identity because there is no evidence that Kate Middleton herself used PRINCESS KATE as her name or identity.[1] Specifically, Applicant contends as follows:

> Although PRINCESS KATE may be reasonably understood as referring to Kate Middleton, Duchess of Cambridge, by some persons, it is not a close approximation of her name because Kate Middleton is not a princess. Furthermore, Kate Middleton has also publicly expressed to the media on multiple

[1] Applicant's Brief, pp. 2-3.

> occasions that she will not be referred to as "Princess Kate" because she is simply not a princess and her proper title is "Duchess of Cambridge."[2]

We reject Applicant's interpretation of the first prong of the test as inappropriately narrowing the scope of Section 2(a). The creation of a false suggestion of a connection results from an applicant's use of something that is closely "associated with a particular personality or 'persona'" of someone other than the applicant. *Notre Dame*, 217 USPQ at 509; *see also Pitts*, 107 USPQ2d at 2024. The reason for the statutory prohibition is that the person identified loses the right to control his/her identity. *Notre Dame*, 217 USPQ at 509 ("There may be no likelihood of such confusion as to the source of goods even under a theory of 'sponsorship' or 'endorsement,' and, nevertheless, one's right of privacy, or the related right of publicity, may be violated.").

The statutory false suggestion of a connection refusal emerged from the right to privacy and right of publicity.

> Evolving out of the rights of privacy and publicity, the false suggestion of a connection under § 2(a) of the Trademark Act was intended to preclude registration of a mark which conflicts with another's rights, even though not founded on the familiar test of likelihood of confusion. [*Notre Dame* 217 USPQ at 509. An opposer may prevail on the false suggestion of a connection ground when its right to control the use of its identity is violated, even if the name claimed to be appropriated was never commercially exploited by the opposer as a trademark or in a manner analogous to trademark use. *See Notre Dame*, 703 F.2d at 1375, 217 USPQ at 508; *Buffett*, 226 USPQ at 429. *However, while a party's interest in its identity does not depend for its existence on the adoption and use of a technical trademark, a party must nevertheless have a protectable*

[2] Applicant's Brief, p. 2.

> *interest in a name (or its equivalent). Thus, we focus on the key factor in the false suggestion analysis for this case: whether applicants' mark is a close approximation of opposers' name or identity, i.e., a right in which opposers possess a protectable interest.*

Pitts, 107 USPQ2d at 2025 (emphasis supplied).

The right of publicity has developed to protect the commercial interest of celebrities in their identities. Under this right, the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity. If the celebrity's identity is commercially exploited without the consent of the celebrity, there has been an invasion of his/her right, regardless of whether his/her "name or likeness" is used. *Cf. Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 218 USPQ 1, 4 (6th Cir. 1983) (former late night television personality Johnny Carson's identity may be exploited even if his name or likeness is not used).

The evidence reflects that Kate Middleton is a celebrity. That means her identity has value which the § 2(a) false suggestion refusal is intended to protect. *See Notre Dame*, 217 USPQ at 509 ("It is a right of this nature [that is, the right to privacy or right to publicity], a right to control the use of one's identity, which the University also asserts under § 2(a)."). Therefore, it is the right of publicity basis for the false suggestion of a connection refusal that applies in this case.

The fact that Kate Middleton, the Duchess of Cambridge, has never used PRINCESS KATE as her name or identity does not obviate the false suggestion of a connection refusal. A term may be considered the identity of a person even if his or her name or likeness is not used. All that is required is that the mark sought to be registered clearly identifies a specific person (*i.e.,* Kate Middleton). Thus, in *Pitts,*

although neither the University of Alabama nor Coach Paul Bryant ever used HOUNDSTOOTH or HOUNDSTOOTH MAFIA as a trademark, trade name or any other type of identifier, the Board did not view that circumstance as automatically negating the issue of whether HOUNDSTOOTH MAFIA nevertheless created a false suggestion of a connection with Paul Bryant. 107 USPQ2d at 2025 ("Because 'houndstooth' and 'houndstooth mafia' are not the 'names' of either opposer or Coach Bryant, we consider whether applicants' mark [HOUNDSTOOTH MAFIA and design] is the same as or a close approximation of their 'identity.'"). *See also In re Urbano*, 51 USPQ2d 1776, 1779 (TTAB 1999) ("[W]hile the general public in the United States may or may not have seen the upcoming Olympic games referred to precisely as 'Sydney 2000,' we have no doubt that the general public in the United States would recognize this phrase as referring unambiguously to the upcoming Olympic Games in Sydney, Australia, in the year 2000.").

We take this opportunity to make explicit what was implicit in our prior decisions in *Pitts* and *In re Urbano*, 51 USPQ2d 1776 (TTAB 1999): the first prong of the false suggestion of a connection test inquires into whether applicant's mark is the same as or a close approximation of the name or identity of a particular person other than the applicant, whether or not the person actually "used" the name or identity himself or herself. *Notre Dame*, 217 USPQ at 509 ("[T]he initial and critical requirement is that the name (or an equivalent thereof) claimed to be appropriated by another must be unmistakably associated with a particular personality or 'persona.'"). Therefore, in this case, we examine the evidence of record to determine

whether it establishes that Applicant's mark PRINCESS KATE would be understood by the relevant public as identifying Kate Middleton.

The Trademark Examining Attorney submitted numerous examples of media coverage referring to Catherine, Duchess of Cambridge, also known as Kate Middleton, as a princess or as Princess Kate. The articles listed below are representative.

1. October 26, 2011 Office action.[3]

   The New York Post (May 27, 2011)

[3] Some of the articles the Trademark Examining Attorney put in the record came from newspapers and magazines located outside of the United States (e.g., Montrealgazette.com, The Mirror (London, England), and The Frontier Post (Pakistan)). We are cognizant that "[t]he probative value, if any, of foreign information sources must be evaluated on a case-by-case basis." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007). We find that the articles from non-U.S. publications have some probative value in this case, because it concerns the perception of the general U.S. public—the relevant consumers of the goods in the application—regarding the identity of a celebrity who lives and travels outside of the United States. We think it likely that United States consumers interested in information about Kate Middleton and her activities would consult available English-language information sources about her, regardless of the geographic location of the information source. We think this is particularly true of someone using the Internet for information, given that official U.S. government data shows that three-quarters of Americans use the Internet and a majority of those users go online for news information. We take judicial notice of the following recent official U.S. government publications concerning Internet use in the United States: (1) "Computer and Internet Use in the United States: 2013," U.S. Census Bureau (Nov. 2014), available on the www.census.gov website at the following link (last accessed 1/22/2015): http://www.census.gov/content/dam/Census/library/publications/2014/acs/acs-28.pdf, and (2) "Exploring the Digital Nation America's Emerging Online Experience," National Telecommunications and Information Administration and Economics and Statistics Administration (June 2013), available at the following link (last accessed 1/22/2015) http://www.ntia.doc.gov/files/ntia/publications/exploring_the_digital_nation_-_americas_emerging_online_experience.pdf. According to the Census Bureau report, 74.4% of U.S. households reported Internet use in 2013. According to the NTIA report, 56% of Internet users in 2011 went online to obtain news or other information, with 22% using the Internet as their primary information source. Although we find the non-U.S. articles in the record to have some probative value in this case, we add that our decision would be the same if we did not consider them.

The Pauper's Princess – Style Experts Say Kate's The Perfect Role Model As Recessionista; Cheap Kate

As newly minted princess Kate Middleton greeted Michele Obama in the ornate surroundings of Buckingham Palace Tuesday, it was hard to believe she was wearing a $340 dress from British retailer Reiss – a frock any commoner could buy.

* * *

"Kate is a princess of our times," says Zanna Roberts Rassi, senior fashion editor at Marie Claire. "She's more of a people's princess than Diana. Diana was understated, but she liked her labels. Kate's heralding this almost changing of the guard, from the stuffy royal family to this modern-day princess that we can all relate to."

Ventura County Star (California) (September 19, 2011)[4]

Princess Kate explores her own U.K. charity work

St. James Place on Sunday confirmed that Kate – now formally known as Catherine, Duchess of Cambridge – is spending the next few months exploring the charitable sector as she mulls what to make of her position as the top of British society. The move shows Princess Kate is following a family tradition championed by the late Princess Diana, her mother-in-law.

Celebrity News & Style website (celebritynewsandstyle.com) (June 28, 2011)

Princess Kate Middleton Wows Wimbledon in Tennis Whites

Princess Catherine, the Duchess of Cambridge, is becoming known as quite a fashion icon.

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[4] This Associated Press story from London was also posted on the Huffington Post website (huffingtonpost.com) on September 18, 2011.

Daily Glow website (dailyglow.com) (June 17, 2011)

Princess Kate Middleton Glowed at Queen's Birthday Celebration

* * *

The new princess has already established herself as a style icon that women and girls around the world emulate.

* * *

Given Princess Kate sported sun-kissed cheeks, that rosy look will probably appear everywhere this year.

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2. June 8, 2012 Office action

ABC News Transcript from *Good Morning America* (March 19, 2012)

Kate's Solo Turn;
Duchess Debuts at Podium

Robin Roberts: Now to Duchess Kate. A big day ahead for the young royal, making her first public speech. We have not heard much from Kate since she and William got engaged, but that all changes today. ABC's Nick Watt, of course, has the latest from London.

* * *

Nick Watt: Good morning, Robin. We are tenterhooks over here because our living doll, our beautiful Princess Kate, she's been a royal for nearly a year now, and we're gonna hear her speak for the first time in about 20 minutes. And the reason for those tenterhooks, we just wanna know what she sounds like.[5]

CNN Sunday Morning (April 29, 2012)

Highlight Prince William and Princess Kate mark their first anniversary.

New York Daily News (April 19, 2012)

[5] On January 9, 2012, as well, *Good Morning America* made a reference to "Princess Kate's" 30th birthday and on March 1, 2012, *Good Morning America* reported about "Princess Kate" making a public appearance with the Queen.

> It's Lin & Tim Time! Phenoms in mag's Top 100
>
> Jeremy Lin was a surprise addition to the Time 2012 Top 100, joining President Obama, actress Tilda Swinton, princess Kate Middleton and sister Pippa – and Jets quarterback Tim Tebow.

An undated excerpt from an ABC news transcript "Will & Kate's First Year" features a report from George Stephanopoulos, Robin Roberts, and Nick Watt that captures the essence of the first prong of the false suggestion of a connection test.[6]

> Nick Watt (ABC News)
>
> Since the wedding, it's increasingly embarrassing how much Kate and Will overshadow their seniors. We're marveling at Kate cutting through London gloom, umbrellaed by her boy-toy prince. He's six months younger. The Queen out and about today. Do we care? Not so much. Charles and Camilla? I'm not even sure where they are. This pair, top of tree.
>
> Victoria Arbiter (Royal Contributor)
>
> And when I look at their popularity in America, it's in a different vein. Kate is on the front cover of numerous magazines.
>
> Nick Watt (ABC News)
>
> The palace suits insists [sic] she's a duchess, not a princess, and they say we must call her Catherine, not Kate. Forget it, chaps. *Princess Kate, that's her handle and she wears it well.* (Emphasis added).

The evidence is sufficient to establish that the mark PRINCESS KATE is a close approximation of the identity of Kate Middleton, because American media uses the term PRINCESS KATE to identify Kate Middleton and, therefore, the American

[6] June 12, 2012, Office action. In her brief (page 12, unnumbered), the Trademark Examining Attorney referenced an "ABC-TV show televised April 27, 2012"; however, there is no identifying information on the transcript except that it was found in the Nexis database.

public is exposed to media reports identifying Kate Middleton as Princess Kate, regardless of whether Kate Middleton uses that moniker herself. *See Bd. of Trustees of the Univ. of Ala. v. BAMA-Werke Curt Baumann*, 231 USPQ 408 (TTAB 1986) ("BAMA" uniquely pointed to the identity of the University of Alabama even though the school had not adopted it as a trademark and had only sporadically referred to itself as BAMA, in large part due to the public's association of the term with the school).

Applicant argues that "[a]lthough PRINCESS KATE may be reasonably understood as referring to Kate Middleton, Duchess of Cambridge by some persons, it is not a close approximation of her name because Kate Middleton is not a princess."[7] To corroborate this argument, Applicant submitted excerpts from websites that properly refer to Kate Middleton as the Duchess of Cambridge (*e.g.*, The British Monarchy (royal.gov.uk), *The Washington Post* (washingtonpost.com), and *The Hollywood Reporter* (hollywoodreporter.com)).

We are not persuaded by this argument, as it runs counter to our discussion earlier of the proper scope of Section 2(a). We also find that the evidence submitted by the Applicant does not rebut the showing the Examining Attorney has made that the mark PRINCESS KATE is a close approximation of the identity of Kate Middleton. It does not matter that the proper moniker for this person is Catherine, Duchess of Cambridge, or even that some news reports refer to her correctly by this name and title. The number of media stories that refer to her as PRINCESS KATE

[7] Applicant's Brief, p. 2.

shows that the U.S. public associates the term PRINCESS KATE with Kate Middleton, and demonstrates that PRINCESS KATE is a close approximation of Kate Middleton's identity (*e.g.,* "Princess Kate, that's her handle and she wears it well," "Kate is a princess of our times," "newly minted princess Kate Middleton"), regardless of whether she is not, in fact, a princess. The excerpt from the Official Royal Wedding website (officialroyalwedding2011.org) submitted by Applicant has the headline shown below:[8]

Since Kate Middleton is married to a "prince," it is not surprising many Americans consider her to be a "princess."

The excerpt from *The Washington Post* website noted above is instructive.[9] The article posted on April 29, 2011 has the headline, "Duchess of Cambridge: Is Kate a Princess or not?" The article was written to explain why Kate Middleton is the Duchess of Cambridge, not Princess Kate. The article assumes that American

[8] April 26, 2012 response to Office action.

[9] December 6, 2012 response to Office action.

readers perceive Kate Middleton to be a princess.[10] In this case, we find that PRINCESS KATE is a close approximation of Kate Middleton's identity.

B. Whether Applicant's mark PRINCESS KATE would be recognized as a close approximation of Kate Middleton's identity by purchasers, in that the mark points uniquely and unmistakably to Kate Middleton?

Although there may have been other members of the many royal houses throughout history that were named Catherine and were referred to as "Princess Kate," there is no evidence in the record that there is or has been any other Princess Kate or that the name Princess Kate points to anyone other than Kate Middleton.

In addition, the goods and services themselves serve, if anything, to reinforce that the mark uniquely and unmistakably points to Kate Middleton. Applicant is seeking to register its mark for fashion products such as cosmetics, jewelry, handbags, bedding and clothing. The *Wikipedia* entry for Kate Middleton, Catherine, Duchess of Cambridge, reports that she "is admired for her fashion sense and has been placed on numerous 'best dressed' lists."[11] *See also* the above-noted media references to Kate Middleton as Princess Kate who is reported to be "The Perfect Role Model As Recessionista," a "Time 2012 Top 100," and a "fashion icon." These references further indicate that relevant purchasers of the identified goods will recognize PRINCESS KATE as pointing uniquely and unmistakably to Kate Middleton.

[10] *See also The Hollywood Reporter* website (hollywoodreporter.com) ("Kate Middleton Will Not Be Called Princess") attached to the December 6, 2012 response to Office action.

[11] October 26, 2011 Office action.

C. Whether Kate Middleton is connected with the goods that are sold or will be sold by Applicant under its mark?

Applicant acknowledges that Kate Middleton is not connected with the goods that are or will be sold by Applicant under the mark PRINCESS KATE, and that she has not consented to Applicant's use of her persona.[12]

D. Whether Kate Middleton's name or identity is of sufficient fame or reputation that when Applicant's mark PRINCESS KATE is used on Applicant's goods, a connection with Kate Middleton would be presumed?

The evidence shows that Kate Middleton is a member of the British Royal Family and, as such, she is the subject of great public interest in the United States and throughout the world. For example, during her pregnancy, Kate Middleton was the subject of intense media scrutiny. The following are representative samples of the media coverage Kate Middleton received during her pregnancy:

1. She has been on the cover of *People* magazine ("Kate's Baby Bump Diary!);[13]

2. She has been the feature of a KHOU television (Houston, Texas) video story ("New Views of Princess Kate's baby bump") and KGW.com (Portland, Oregon) slideshow ("Photos: Princess Kate and baby step out");[14] and

3. The *Tampa Bay Times* (May 18, 2013) reported on what Kate Middleton wore while pregnant ("Pregnant Princess Kate gets dotty").[15]

[12] Applicant's April 26, 2012 response to Office action.

[13] May 18, 2013 Office action.

[14] *Id.*

[15] *Id.*

"Applicant does not dispute that Catherine, Duchess of Cambridge, is a well-known figure, stemming from her well-publicized relationship with Prince William and her subsequent wedding."[16] "Also, the Applicant does not dispute the … claim that Kate Middleton's fame is not temporary."[17]

However, Applicant argues that Kate Middleton "is not involved in the fashion industry, and there is no evidence that the public would perceive such a connection because she does not endorse any products."[18] Applicant misconstrues the nature of our inquiry under this prong of the false suggestion of a connection analysis. We do not require proof that Kate Middleton is well-known for cosmetics, jewelry, handbags, bedding and clothing. Our inquiry is whether her renown is such that when the mark PRINCESS KATE is used in connection with those products, consumers will understand PRINCESS KATE as referring to Kate Middleton and that a connection with Kate Middleton, the Duchess of Cambridge, will be presumed. As the Board held in *In re Pedersen,* 109 USPQ2d 1185, 1202 (TTAB 2013):

> [T]he key is whether the name *per se* is unmistakably associated with a particular person or institution and, as used would point uniquely to the person or institution. In short, it is the combination of: (1) a name of sufficient fame or reputation and (2) its use on or in connection with particular goods or services, that would point uniquely to a particular person or institution. [Internal citation omitted]. Thus, our inquiry is whether consumers of medicinal herbal remedies would think only of the Lakota

[16] Applicant's Brief, p. 4.

[17] *Id.* at page 6.

[18] *Id.*

> tribes when the LAKOTA name is used on such goods. *Cf. Notre Dame*, 217 USPQ 509 ("'Notre Dame' is not a name solely associated with the University. It serves to identify a famous and sacred religious figure and is used in the names of churches dedicated to Notre Dame, such as the Cathedral of Notre Dame in Paris.").

The record before us amply demonstrates the fame of Kate Middleton who is routinely referred to in headlines in the U.S. popular press as "Princess Kate." Additionally, as we mentioned earlier, the evidence establishes that her reputation is in part as a fashion trendsetter, such that and is of such a nature that when Applicant's PRINCESS KATE mark is used on cosmetics, jewelry, handbags, bedding and clothing consumers will understand the mark to refer to Kate Middleton. We find that Kate Middleton's identity is of sufficient fame or reputation that when Applicant's mark PRINCESS KATE is used on Applicant's goods, a connection with Kate Middleton will be presumed.

E. Analyzing the factors.

Considering all of the evidence in the record before us, we find that (i) Applicant's proposed mark PRINCESS KATE is a close approximation of Kate Middleton's identity, (ii) the PRINCESS KATE mark points uniquely and unmistakably to Kate Middleton, (iii) Kate Middleton has no actual or commercial connection with Applicant, and (iv) Kate Middleton's identity is of sufficient fame or reputation that if Applicant's mark PRINCESS KATE were used in connection with the goods listed in the application, the relevant consuming public would presume a connection with Kate Middleton. Therefore, we find that Applicant's mark

PRINCESS KATE for the goods listed in the application falsely suggests a connection with Kate Middleton.

III. Whether the mark PRINCESS KATE identifies a particular living individual whose written consent to register the mark is not of record?

Section 2(c) of the Trademark Act, 15 U.S.C. § 1052(c) provides the following:

> No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

The purpose of requiring the consent of a living individual to the registration of his or her name, signature, or portrait is to protect rights of privacy and publicity that living persons have in the designations that identify them. *In re Hoefflin*, 97 USPQ2d 1174, 1176 (TTAB 2010); *Martin v. Carter Hawley Hale Stores, Inc.*, 206 USPQ 931, 933 (TTAB 1979) (Section 2(c) was designed "to protect one who, for valid reasons, could expect to suffer damage from another's trademark use of his name."). *See also Notre Dame*, 217 USPQ at 509 n.8; *Canovas v. Venezia 80 S.R.L.*, 220 USPQ at 661.

Whether consent to registration is required depends on whether the public would recognize and understand the mark as identifying a particular living individual. A consent is required only if the individual bearing the name in the mark will be associated with the mark as used on the goods or services, either because: (1) the person is so well known that the public would reasonably assume a

connection between the person and the goods or services; or (2) the individual is publicly connected with the business in which the mark is used. *See In re Hoefflin*, 97 USPQ2d at 1175-76; *Krause v. Krause Publ'ns, Inc.*, 76 USPQ2d 1904, 1909-10 (TTAB 2005); *In re Sauer*, 27 USPQ2d 1073, 1075 (TTAB 1993), *aff'd per curiam*, 26 F.3d 140 (Fed. Cir. 1994); *Carter Hawley Hale Stores*, 206 USPQ at 933.

For purposes of Section 2(c), a "name" does not have to be the full name of an individual. Section 2(c) applies not only to full names, but also first names, surnames, shortened names, pseudonyms, stage names, titles, or nicknames, if there is evidence *that the name identifies a specific living individual* who is publicly connected with the business in which the mark is used, or *who is so well known that such a connection would be assumed*. *See In re Hoefflin*, 97 USPQ2d at 1177-78 (holding registration of the marks OBAMA PAJAMA, OBAMA BAHAMA PAJAMAS, and BARACK'S JOCKS DRESS TO THE LEFT barred under Section 2(c) in the absence of consent to register, because they create a direct association with President Barack Obama); *Krause v. Krause Publ'ns, Inc.*, 76 USPQ2d at 1909 ("the mark KRAUSE PUBLICATIONS, although it includes only the surname of petitioner, would fall within the provisions of Section 2(c) if petitioner establishes that KRAUSE, as used on or in connection with the goods or services set forth in the involved registration, points uniquely to him 'as a particular living individual.'"); *In re Sauer,* 27 USPQ2d at 1074-75 (holding registration of a mark containing BO, used in connection with a sports ball, barred under Section 2(c) in the absence of consent to register, because BO is the nickname

of a well-known athlete and thus use of the mark would lead to the assumption that he was associated with the goods); *John Anthony, Inc. v. Fashions by John Anthony, Inc.,* 209 USPQ 517, 525 (TTAB 1980) ("when a name or pseudonym has come to be recognized in a certain field of business as identifying a particular living individual, the individual possesses a valuable property right in that name, and the courts will not allow the name to be appropriated or commercially exploited by another without his consent.").

In re Steak & Ale Rest. of Am., Inc., 185 USPQ 447, 448 (TTAB 1975) is particularly analogous to the present case. In that decision, the Board affirmed a Section 2(c) refusal of the mark PRINCE CHARLES because the wording identifies a particular well-known living individual whose consent was not of record. The Board reasoned that "the addition of a given name or a surname to the word 'PRINCE' could well serve as a name or 'nickname' for a particular living individual who could be identified and referred to in the various walks of life with this appellation." We find that this same logic applies to the mark PRINCESS KATE. *Cf. Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.,* 32 USPQ2d 1192, 1196 (TTAB 1994) (evidence shows that "Duca D'Aosta" is a title and does not refer "unequivocally to a particular living individual.").

While with lesser-known figures there may have to be evidence showing that the consuming public connects them with the manufacturing or marketing of the particular goods (or services) for which registration is sought, well-known individuals such as celebrities and world-famous political figures are entitled to the

protection of Section 2(c) without having to demonstrate a connection with the involved goods or services. *See In re Hoefflin*, 97 USPQ2d at 1177 (because Barack Obama is the President of the United States, the purchasing public will reasonably assume that marks consisting of the names BARACK and OBAMA identify President Barack Obama); *In re Masucci*, 179 USPQ 829, 830 (TTAB 1973) (in spite of any common law rights applicant may have, EISENHOWER for greeting cards was refused on the ground that it consisted of the name of the late President Eisenhower during the life of his widow, and application for registration was filed without her consent).

As we found in the previous section, PRINCESS KATE identifies Kate Middleton, whose identity is renowned. By any measure, she is a celebrity, and thus the name PRINCESS KATE points uniquely and unmistakably to Kate Middleton. Although Kate Middleton, the Duchess of Cambridge, does not use the name PRINCESS KATE, it has become a nickname used by the American public (and media) to identify her. We find that the mark PRINCESS KATE consists of the name of a particular living individual, namely, Kate Middleton, and because Kate Middleton has not consented to the use and registration of that name, the Section 2(c) refusal is affirmed.

Decision: The refusals to register under Sections 2(a) & (c) are affirmed.