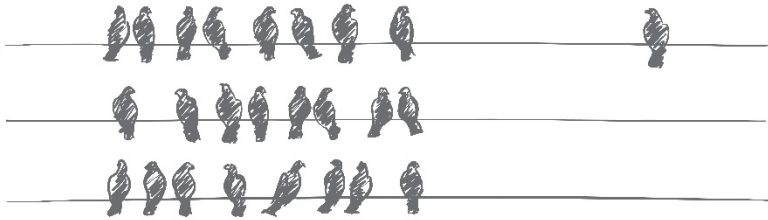


## ON MY MIND BLOG

### Choosing a Mark in a Crowded Field is Good and Bad

12.7.2021 By [Justin I. Karasick](#)



Garan Services Corp. filed an intent to use application to register MATCH STUDIO in plain lettering for “clothing, namely tops and bottoms.” It disclaimed the exclusive right to use the word “STUDIO” apart from the mark as a whole. The Examining Attorney refused registration on the ground that there would be a likelihood of confusion with the existing registered mark MATCH for “clothing . . . woven bottoms and tops . . . .” Garan appealed to the Trademark Trial and Appeal Board (TTAB).

The TTAB reversed this refusal in a nonprecedential decision stating that each case must be decided on its own facts and the differences are often subtle ones.

The respective goods were legally identical in part, so the TTAB presumed that the channels of trade and classes of purchasers were the same, and noted that the degree of similarity between the marks to find a likelihood of confusion need not be as great as where there is a recognizable disparity between the goods.

However, upon considering Applicant’s evidence consisting of a dictionary definition, 55 third-party registrations for marks comprising the word “match” for clothing products, and a number of similar third-party websites, the TTAB concluded that the term MATCH is highly suggestive in connection with clothing (that is, that clothing products should complement, enhance or “match” each other). The TTAB decided that, under these circumstances, marks that are highly suggestive and in a crowded field are accorded a narrow scope of protection.

In this case, the TTAB found that registrant's MATCH mark engendered the commercial impression of harmonization or coordination, whereas Garan's MATCH STUDIO mark engendered the commercial impression of a center for clothing design. Furthermore, because the word "match" is highly suggestive as applied to clothing, the words "match" and "studio" should both be considered of equal weight, regardless of the disclaimer of the exclusive right to use the word 'studio.'

So the TTAB found that differences in the marks were sufficient that they could be registered simultaneously, even for identical goods.

**Author's Note:** If you choose to adopt a mark that similar to many other marks because it is highly suggestive in relation to the goods or services, there is good news and bad news.

The good news is that a small difference in your mark probably will suffice to permit coexistence for purposes of simultaneous registration and non-infringement.

The bad news is that the scope of protection given to your mark will be narrow so that a competitor may be able to register and use a highly similar mark.

**[In re Garan Services Corp.](#), Application No. 88674888 (T.T.A.B. November 3, 2021).**

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