

On My Mind Blog

How You May Succeed in Registering an Affinity Mark Despite Another's Identical Mark

09.21.2022 By [William M. Borchard](#)

The Zeta Tau Alpha Sorority, which dates back to 1898 and is popularly known as ZTA, was refused registration of ZTA for jewelry (claiming use since at least 1915) and clothing items (claiming use since at least 1940), despite its ownership of an existing 2001 registration of this mark for association services, because of a 2020 registration of ZTA for a variety of housewares and kitchen items owned by a Chinese company (claiming use since 2019). The Trademark Trial and Appeal Board (TTAB) affirmed this refusal. Why did this happen, and how can you avoid the same result?



Registrant's Specimen of Use



Applicant's Specimens of Use

In determining whether there was a likelihood of confusion as to the source of the goods displaying these identical marks, the TTAB focused on the similarity of the goods, channels of trade, and class of customers.

The Examining Attorney submitted internet evidence of third-party uses of a single mark or trade name to identify jewelry and clothing items as well as housewares and kitchen items (for example, LILLY PULITZER, LIFE IS GOOD, KATE SPADE, and PI BETA

PHI). Further, the Examining Attorney submitted fifteen active, use-based third-party registrations of a similar nature. The TTAB found this probative that goods of the Applicant and Registrant may emanate from the same source and thus are related for likelihood of confusion purposes.

The Applicant contended that there was simply too tenuous of a connection between sorority merchandise in the nature of clothing and jewelry, and common utilitarian housewares. The TTAB said this missed the point. The application did not identify the clothing and jewelry items as “sorority merchandise.” Also, neither the application nor cited registration contained limitations as to the channels of trade or classes of purchasers. Further, it was not necessary that the goods be similar, complementary or even competitive to support a finding of a likelihood of confusion since this record had more than enough evidence that consumers would be likely to believe the goods with the identical mark would come from the same source.

The Applicant described its mark as an “affinity mark”, citing several cases, including *Licensing Inc. v. Berman*, 86 USPQ2D 1883, 1889 (T.T.A.B. 2008), where the TTAB had taken judicial notice that the licensing of commercial trademarks on collateral products had become part of everyday life especially in relation to sorority insignias, among others. Nevertheless, the evidence in this case showed that some of the Registrant’s goods were the same types of goods sold under “affinity” marks, so consumers were likely to associate the goods of each entity with those of the other entity. There was no evidence supporting different consumers for the respective goods, and at least some of Applicant’s customers were part of the general consuming public for Registrant’s goods.

[In re Zeta Tau Alpha Sorority, Application No. 90090117 \(T.T.A.B. August 29, 2022\)](#)

Author’s Note: We have reported on a somewhat [similar case](#) -- with a different result -- regarding the simultaneous registrability of the mark THE for clothing items by The Ohio State University and by Marc Jacobs Trademarks, L.L.C. In that case, the marks and goods were identical, but the respective parties had amended their respective identifications of goods: Ohio State added “all of the foregoing being promoted, distributed, and sold through channels customary to the fields of sports and collegiate athletics,” and Marc Jacobs added “all of the foregoing being promoted, distributed, and sold through channels customary to the field of contemporary fashion.”

These cases suggest that the road to possible success may be for the applicant to limit the identification of its goods to specify that they are intended for those expressing affinity to the applicant and, if applicable, are sold in specific types of stores or websites. If a third party’s application or registration may be cited against the application, it may be necessary to get the third party also to amend its identification of goods to

differentiate its customers and sales outlets or possibly enter into a consent agreement with the applicant.

Even with such differentiation, the evidence presented in a specific case may strongly influence the result, which makes predictability difficult. In the ZTA case, there was strong evidence that various third parties used the single mark for both types of goods. In the THE case, there was strong evidence of the affinity significance of the mark as well as a consent agreement between the parties.

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