

## US: TRADE MARKS



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## House mark distinguishes secondary mark

Fashion companies often use their distinctive house marks in conjunction with multiple secondary marks to serve as a single source identifier for their product lines. The house mark groups the multiple different product offerings under the solitary heading of a well-known brand. The inclusion of the house mark could play a pivotal role in determining whether a likelihood of confusion exists between two otherwise similar marks.

There is no blanket rule that says that the use of a house mark, even a well-known one, necessarily obviates a likelihood of confusion because every case of trade mark infringement requires a comparison of the marks at issue in their entirety. A junior user of a mark cannot overcome a likelihood of confusion by simply tacking on its house mark. Instead, the use of the house mark is but one factor considered by trade mark tribunals and courts in making a likelihood of confusion analysis.

In June, the US District Court for the Southern District of New York addressed this issue in a trade mark dispute between Kate Spade and Saturdays Surf. Saturday's Surf is the owner of a federal trade mark registration for the mark Saturday's Surf NYC and claims common law rights in the unregistered mark Saturdays. After receiving an allegation of infringement from Saturdays Surf, Kate Spade commenced litigation seeking a declaratory judgment that its Kate Spade Saturday brand does not infringe any rights belonging to Saturdays Surf which, itself, counter-claimed for trade mark infringement.

The Court conducted the standard likelihood of confusion analysis, weighing the various factors and found that there was no infringement. In doing so, the Court held that the "most persuasive difference" between the two marks was the inclusion of the Kate Spade

house mark in the Kate Spade Saturday composite mark. Specifically, the Court held that "the use of this famous house mark significantly reduces the potential for confusion". The Court even indicated that the inclusion of the house mark obviated Saturdays Surf's claims of reverse confusion (that the fame of the Kate Spade name would cause consumers to believe that Saturdays Surf is an infringer), holding that, in view of the fact that the Kate Spade name is "very much entrenched in the fashion marketplace as associated with women's products", it is unlikely that consumers would believe that Kate Spade "would license to or collaborate with a men's clothing company".

It is important to note that the fame of the Kate Spade house mark was not the only factor that the Court relied on in rejecting Saturday Surf's claim of infringement. The Court appeared to give extra weight to the impact of the house brand in view of its finding that that the term "Saturday" appeared to be diluted through extensive third-party use. Nonetheless, the case is instructive in that strong house marks can, in certain situations, be sufficient to distinguish between two otherwise similar marks.