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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kep Enterprises, Inc.

Serial Nos. 76579936 and 76587623

Jill M. Pietrini of Manatt Phelps & Phillips, LLP for Kep Enterprises, Inc.

Anthony M. Rinker, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

Before Bucher, Mermelstein and Wellington, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Kep Enterprises, Inc., dba Zola Hats and Knitwear, seeks registration on the Principal Register of the mark **ZOLA** (*in standard character format*), and for the special form mark shown below:



for goods identified in the application, as amended, as follows:

"clothing, namely, t-shirts, shorts, pants, sweatshirts, sweatpants, bandannas, scarves, aprons, jackets, jean jackets, tank tops, vests, neckties, hockey jerseys, soccer jerseys, fashion knit shirts, button-down shirts, basketball jerseys, long sleeve t-shirts, sweaters, baseball jerseys, baby doll t-shirts, polo shirts, wind resistant jackets, muscle t-shirts, baby rompers, toddler t-shirts, mock turtleneck sweaters, mock turtleneck shirts, track pants, ponchos, and hooded shirts; headwear; and footwear" in International Class 25.¹

These cases are before the Board on appeal from the final refusals of the Trademark Examining Attorney to register these marks based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has found that Kep Enterprises' marks, when used in connection with the identified goods, so resemble the following marks, both owned by the same entity:

ZOLA ICE for "clothing for use by women, namely – dresses, coats, skirts, pants, shirts, blouses, jackets, suits, and nightshirts" in International Class 25;² and

¹ Application Serial No. 76579936 [ZOLA and design] was filed on March 8, 2004 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. Similarly, application Serial No. 76587623 [the word ZOLA alone] was filed on April 16, 2004 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

² Registration No. 2660314 issued on December 10, 2002 based upon an application filed on August 9, 2000 later claiming first use anywhere and first use in commerce at least as early as January 2001.

ZOLA EVENING	for "blazers, blouses, camisoles, halter tops, jackets, pants, scarves, shawls, shirts, skirts, slacks, stoles, suits, and T-shirts" in International Class 25. ³
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as to be likely to cause confusion, to cause mistake or to deceive.

Applicant and the Trademark Examining Attorney have fully briefed the issues in these cases. At the request of the Trademark Examining Attorney, these two appeals have been consolidated. We affirm the refusals to register.

Applicant contends that there is no likelihood of confusion given the differences in the marks, the nature and purpose of the respective goods, and the consumers to whom the goods are marketed, as well as the weakness of the word "Zola" in the field of apparel and accessories.

By contrast, the Trademark Examining Attorney argues that as the first word in the cited marks, the word "Zola" is the dominant term of the registered marks. Moreover, he contends that the word "Zola" is highly distinctive because the term is arbitrary for clothing. Hence, Kep Enterprises has adopted for its marks an arbitrary term spelled identically to that of the registered marks. The Trademark

³ Registration No. 2737161 issued on July 15, 2003 based upon an application filed on October 19, 1999 later claiming first use anywhere and first use in commerce at least as early as January 6, 2000.

Examining Attorney points out that Kep Enterprises' listed goods include some of the same goods identified by Registrant, and that Applicant cannot restrict the scope of protection afforded to the cited registrations by extrinsic evidence that Registrant specializes in formal wear. He contends that the Board must presume that these respective goods will move through the same channels of trade to the same ordinary consumers. Finally, the Trademark Examining Attorney argues that Applicant's limited showing of third-party use of the term "Zola" on various websites does not demonstrate the weakness of the word "Zola" in the cited marks.

Likelihood of Confusion

We turn then to a consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the relationship between the goods and/or services. *See Federated Foods,*

Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The marks

We turn first to the *du Pont* factor that focuses on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

In making this determination, our focus should be placed on the recollection of the average consumer who normally retains a general rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

While we must consider the marks in their entireties, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) [CASH MANAGEMENT ACCOUNT found confusingly similar to THE CASH MANAGEMENT EXCHANGE].

The Trademark Examining Attorney has taken the position that in addition to being totally arbitrary for clothing, the word "Zola" is the dominant feature in Registrant's marks inasmuch as the first word, prefix, or syllable in a mark is typically the dominant portion. *Presto Products v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895 (TTAB 1988) ("[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions involving the services of the Applicant and Registrant.).

Applicant argues that "the first of two words is dominant" rule was rejected" in at least one cited District Court case.⁴ (Applicant's reply brief at 2) As noted by a leading trademark commentator, "it is impossible to make any generalized statement as to whether the beginning or end of a mark is more important when one or the other is used by another seller."⁵ Nonetheless, we agree with the Trademark Examining Attorney that the Board has often found the first word to be dominant. This conclusion is especially warranted in the case where that first word appears, on its face, to be highly distinctive, as is the name "Zola" for

⁴ *Mr. Travel, Inc. v. V.I.P. Travel Svc., Inc.*, 268 F. Supp. 958 (N.D. Ill. 1966), *affd*, 385 F.2d 420 (7th Cir. 1967).

⁵ 3 J. Thomas McCarthy, *McCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 23:45 (4th ed. 2004).

clothing and accessories.⁶ Even Applicant admits that each of the second words in the cited marks, "Evening" and "Ice," may be suggestive of registrant's evening wear and formal wear. (Applicant's appeal brief, at 5) This too supports the conclusion that from the standpoint of distinctiveness, "Zola" is the most important component of Registrant's cited marks.

As to differences in appearance, it is true, as Applicant contends, that its application Serial No. 76579936 has some stylization. However, when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be



⁶ The three cases discussed at length by applicant do not compel a different result. In *Consolidated Cigar Corp. v. R.J. Reynolds Tobacco Co.*, 491 F.2d 1265, 181 USPQ 44 (CCPA 1973), the Court of Customs and Patent Appeals did not find clear error in the Board's finding that the connotation of DUTCH APPLE for smoking tobacco was distinctly different from DUTCH MASTERS for cigars. In *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998), the Court of Appeals for the Federal Circuit did not find clear error in the Board's finding that CRYSTAL CREEK for wine was not likely to cause confusion with CRISTAL for champagne, primarily because of the difference in the marks. In fact, this case is often cited for the proposition that a single du Pont factor may be dispositive in a likelihood of confusion analysis, and that where the marks are sufficiently dissimilar, there may be no likelihood of confusion despite the presence of overlapping goods and trade channels. And in *Conagra, Inc. v. George A. Hormel, & Co.*, 990 F.2d 368, 26 USPQ2d 1316 (8th Cir. 1993), the Eighth Circuit did not find clear error in the District Court's finding that HEALTHY SELECTIONS sounded significantly different from HEALTHY CHOICE, and that the plaintiff's HEALTHY CHOICE mark was descriptive and hence entitled to a narrow scope of protection.

used in calling for the goods. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); and *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976). Furthermore, this design feature is nothing more than a circle around the word "Zola."

Hence, despite these obvious differences in the sound and appearance of the respective marks, we find that when compared in their entireties, they have similar connotations and convey a similar commercial impression.

The number and nature of similar marks in use on similar goods.

In its requests for reconsideration, Applicant attempted to show from website entries that "the mark ZOLA is commonly used in the apparel industry, which indicates that the word ZOLA is diluted and weak." (Applicant's brief at 10) The Trademark Examining Attorney retorted that Applicant's website evidence fails to demonstrate that the word "Zola" in Registrant's marks is so weak as to displace the rights of the Registrant against subsequent applications for a similar mark for related goods. *Palm Bay Imports, Inc.*, 73 USPQ2d at 1693-94.

Applicant submitted the following eight websites as examples of the appearance of the word "Zola" in connection with apparel:

Zola, Inc., Zen Over Los Angeles, a.k.a. designer, Marissa Harris, Los Angeles, CA 90014, <http://www.zolainc.com> (visited by applicant on March 28, 2006);

Zola Keller, Florida's largest Selection of Special Occasion wear: Gowns • Cocktail • Bridal • Pageant, Ft. Lauderdale and Bonita Springs/Naples, Florida, <http://www.zolakeller.com/> (visited by applicant on March 28, 2006);

Zola Jones Designs, Chicago, IL, handcrafted by Jason Lopez, limited quantity, <http://www.zolajones.com/> (visited by applicant on March 28, 2006);

Ellie Shoes: Wholesaler of Sexy Shoes and Sexy Boots, 1" Knee High Boots (Mens Size), *Item Number: 125-ZOLA*, http://www.ellieshoes.com/showcase/ProductDetail.asp?div=KNEEHIGH&dpt=&ctg=&PROD_CD=125%2DZOLA (visited by applicant on March 28, 2006);

Zola Clog, limited production collections by artisan Calleen Cordero, Metallic Pewter leather on matching wooden sole with jewels and studs, available in pewter in sizes 7 and 10, \$360.⁰⁰, Homefrocks, 611 Old Santa Fe Trail, Santa Fe, NM, 87505, 505-986-5800 homefrocks@homefrocks.com (visited by applicant on March 28, 2006);

"ZOLA SHOES, Toronto, Canada ... about the size of a tiny studio ..." <http://www.fashionjunkie.com/> (visited by applicant on March 28, 2006);

"A date in Bishop Arts District has shop appeal" " ... Zola's Everyday Vintage upscale resale clothing shop was like taking a trip back to before I was born ... DALLAS MORNING NEWS, March 27, 2004 March 27, 2004 available at <http://www.ifsandbutts.com/> (visited by applicant on March 28, 2006); and

TEAM TRAVESIA ZOLA - Spanish bicycle jersey manufactured in Columbia naming competitive biking team

<http://www.bikejerseys.com/> (visited by applicant on March 28, 2006).

The sum total of these websites hardly reaches the level of *de minimis* use. On the face of these web pages, we see sites that are the alter egos of a single, new designer, we see words like "limited quantities" and "limited production," notice that one is a Canadian store "about the size of a tiny studio" while another is a dated store for second-hand clothing, one site markets a Spanish bicycle jersey manufactured in Columbia promoting a biking team, while in one, the letters "Z-O-L-A" are used as part of an "item number." Even a quick perusal of these websites suggests that the reach of these sites, if not their staying power, seems quite limited. By their nature, it is hard to believe most of these terms have been well promoted or that they would be recognized by consumers. We certainly cannot conclude from these third-party uses that customers have become so conditioned by a plethora of "Zola" marks that they are now educated to distinguish between different "Zola" marks on the bases of minute distinctions.

Hence, even viewed in the best light for Applicant, this *du Pont* factor is neutral.

The Goods

Applicant argues that while its goods will involve clothing, footwear and headwear targeted to members of the general public, Registrant's clothing is specifically geared to formal wear, evening wear or wedding dresses. However, we agree with the Trademark Examining Attorney that likelihood of confusion is determined on the basis of the goods as they are identified in the application and the registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). Both Applicant and Registrant have identified identical goods such as pants, shirts and T-shirts without further limitation. The items that are not overlapping are closely related. Accordingly, this *du Pont* factor favors a finding of likelihood of confusion.

Trade channels and Classes of Purchasers

As to the two related *du Pont* factors of the similarity of established, likely-to-continue trade channels and the conditions under which and buyers to whom sales are made, we also must presume that the registration encompasses all goods of the type described, that they move in all normal channels of trade and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Conclusion

When compared in their entireties, Applicant's marks have similar connotations and convey similar commercial impressions to Registrant's two cited marks. The respective goods are overlapping and otherwise related, and presumptively will move in the same channels of trade to the same groups of ordinary consumers. Applicant has failed to demonstrate that customers have been educated to distinguish between different "Zola" marks on the bases of minute distinctions. Hence, we find a likelihood of confusion herein.

Decision: We affirm the refusals to register based upon Section 2(d) of the Lanham Act.