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June 28, 2007
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Barletta

Serial No. 78493111

Roger S. Thompson of Cohen, Pontani, Lieberman & Pavane for
Emillo Barletta.

Peter Cheng, Trademark Examining Attorney, Law Office 114 (K.
Margaret Le, Managing Attorney).

Before Hohein, Bergsman and Wellington, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Emillo Barletta has filed an application to register on
the Principal Register the mark "ZANZIBAR" and design, as shown
below,



for "clothing[,] namely[,] sweatshirts, men[']s, women[']s and
children's clothing, namely, pants, coats, hats, underwear,

outerwear, shirts, blouses and t-shirts" in International Class 25.¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to his goods, so resembles the mark "ZANZIBAR," which is registered on the Principal Register in standard character form for "footwear" in International Class 25,² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed and briefs have been filed. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.³

¹ Ser. No. 78493111, filed on October 1, 2004, which is based on an allegation of a bona fide intention to use such mark in commerce.

² Reg. No. 1,314,769, issued on January 15, 1985, which sets forth a date of first use of the mark anywhere and in commerce of February 10, 1984; renewed.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." 192 USPQ at 29.

Turning first to consideration of the goods at issue, applicant states in its brief the obvious fact that "the goods are different." Applicant acknowledges, however, that it is "[c]ertainly" the case with respect to clothing and footwear that "some stores sell both items," but asserts that "the same could be said of many different types of goods" and contends that "without the evidence to support" a finding of relatedness, "the Final Refusal cannot stand."

The Examining Attorney, on the other hand, properly notes in his brief that the goods at issue need not be identical or directly competitive in order for there to be a likelihood of confusion. Instead, it is sufficient that the respective goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 156, 223 USPQ 1289, 1290 (Fed. Cir. 1984); Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978); and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In view thereof, the Examining Attorney accurately points out in his brief that:

Throughout the course of this application's prosecution, the examining attorney had timely introduced evidence competent to show the relatedness of the respective goods, and certainly sufficient to establish *prima facie* such relatedness. This evidence of record

included [four use-based] third[-]party registrations [which, in each instance, set forth both items of clothing as well as "footwear" and/or "shoes"], websites of designers who design and market both clothing and footwear, websites of retail stores that sell both clothing and footwear under the stores' own brand names (e.g., [Liz Claiborne, Kenneth Cole, Gap and] J. Crew), as well as websites of retail stores that sell clothing and shoes designed and marketed under brand names of other parties (e.g., Target).

Moreover, we note a long line of authority holding that in instances involving both items of footwear and clothing which is worn as outerwear, such goods have generally been found to be so closely related that their sale under the same or substantially similar marks would be likely to cause confusion.⁴ In view thereof, the evidence of record is sufficient to establish that at a minimum applicant's outerwear clothing items and registrant's footwear are so related that the use of the same or

⁴ See, e.g., *General Shoe Corp. v. Lerner Bros. Mfg. Co., Inc.*, 254 F.2d 154, 117 USPQ 281, 283 (CCPA 1958) ["HOLIDAY" for men's outer shirts versus "HOLIDAY" for men's boots and shoes]; *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) ["ESSENTIALS" for women's pants, blouses, shorts and jackets versus "ESSENTIALS" for women's shoes]; *In re Apparel Ventures, Inc.*, 229 USPQ 225, 227 (TTAB 1986) ["SPARKS BY SASSAFRAS" for blouses, skirts and sweaters versus SPARKS for shoes, boots and slippers]; *In re Pix of America, Inc.*, 225 USPQ 691, 692 (TTAB 1985) ["NEWPORT" for outer shirts versus "NEWPORTS" for women's shoes]; *In re Alfred Dunhill Ltd.*, 224 USPQ 501, 504 (TTAB 1984) ["DUNHILL" for men's hosiery v. "DUNHILL" for shoes]; *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026 (TTAB 1984) ["BOOMERANG" and design for men's shirts versus "BOOMERANG" for athletic shoes]; *In re Tender Tootsies Ltd.*, 185 USPQ 627, 629 (TTAB 1975) ["TENDER TOOTSIES" for women's and children's shoes and slippers v. "TOOTSIE" for ladies' nylon hosiery]; *B. Rich's Sons, Inc. v. Frieda Originals, Inc.*, 176 USPQ 284, 285 (TTAB 1972) ["RICH'S CHEVY CHASERS" for shoes versus "FRIEDA'S CHEVY CHASE ORIGINALS" for women's knitwear, namely, dresses, suits, skirts and blouses]; and *U.S. Shoe Corp. v. Oxford Industries, Inc.*, 165 USPQ 86, 87 (TTAB 1970) ["COBBIES" for shoes versus "COBBIES BY COS COB" for women's and girls' shirt-shifts].

substantially similar marks in connection therewith is likely to cause confusion as to the source or sponsorship thereof.

Turning, then, to consideration of the marks at issue, applicant essentially rests the argument in his brief on the contention that while "[t]he literal portions of the two marks are identical, ... the mark here under consideration contains a significant design element, [consisting of] a large turtle that significantly overshadows the remainder of the design." In particular, applicant asserts that (*italics in original*):

The turtle is roughly ten times larger than the word ZANZIBAR. Where a design is so much larger and more "conspicuous" than the remainder of the mark, the *design* is the "dominant" portion of the mark. *Assn. Of Co-Operative Members, Inc. v. Farmland Ind., Inc.*, 216 U.S.P.Q. 361, 367 (5[th] Cir. 1982). A design component may serve to distinguish the mark from another's registered mark even where the composite mark completely contains the prior registered mark. *Id.* That is the case here.

When comparing the much larger design component of the [applicant's] mark, ... it is readily apparent that it is the more conspicuous portion of the composite mark. It is truly the "dominant" portion of the composite mark ... and it bears no resemblance whatsoever to the mark upon which the Examiner has relied.

The Examining Attorney, however, notes in his brief with respect to the case upon which applicant relies that he "does not agree that the relevant holding in that case is applicable to the instant appeal." Specifically, he distinguishes such case by arguing that (footnote omitted):

That case involved a mark consisting of the literal element CO-OP and a design element characterized by the [term] "double circle." The Court did indeed state that in light of

certain "considerations," it "cannot hold that" the literal element in that mark "is the dominant element ..." *Id.* at 367. However, it is imperative that these referenced "considerations" be distinguished from the present facts. There was sufficient evidentiary support in that case that the wording CO-OP is a "relatively 'weak' mark" in relation to the goods and services of the trademark owner as well as the applicable industry due to its widespread use. Further, there was evidence that the "double circle" design, by itself, had achieved a significant level of recognition among the relevant consuming public. *Id.* at 367. Neither of these two considerations is present in the instant appeal. In fact, there is no indication that the term ZANZIBAR is descriptive or "weak" and Applicant has submitted no evidence that its turtle design has achieved any level of notoriety with the relevant class of consumers. Inasmuch as there is no evidence of record in this appeal that might be probative towards either of these two referenced factors, Applicant's reliance on *Co-operative Members* is inappropriate and Applicant's characterization of its holding is inaccurate.

With respect to the fact that, as rendered in Applicant's drawing, the turtle design is markedly larger than the literal portion, it is worth noting that *Co-operative Members* actually articulates a rule that severely undercuts the Applicant's proposition that size equals dominance. The court therein had held that "visual dominance alone does not make an element dominant." *Id.* at 367. Therefore, Applicant's claim that the turtle design is "roughly ten times" the size of the wording ZANZIBAR is, without more, insufficient to establish the dominance of that design and indeed, for this issue, Applicant has submitted no further argument or evidence of substance aside from this assertion as to design size.

In addition to his contention that "[s]ize alone ... is not sufficient for a dominance finding," the Examining Attorney maintains that it is the literal term "ZANZIBAR" which

constitutes the dominant portion of applicant's "ZANZIBAR" and design mark. According to the Examining Attorney:

It is settled law that 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 used in calling for the goods *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co. [Inc.]*, 3 USPQ2d 1533 (TTAB 1987). The present case is not an exception to this rule. The examining attorney had considered Applicant's mark in its entirety and concluded by direct application of the rule above that the word portion, albeit no larger in size than the turtle design, had dominant source indicative capability. In light thereof, the examining attorney's determination that the literal portion ZANZIBAR is dominant should not be disturbed.

In consequence thereof, the Examining Attorney concludes that confusion is likely with registrant's "ZANZIBAR" mark, reasoning that (footnote omitted):

The dominant, strongest source indicative portion of Applicant's mark is thus identical to the cited mark, both being the word ZANZIBAR. A cardinal legal principle instructs then that in determining likelihood of confusion, "if the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences." TMEP §1207.01(b)(iii). Applied to the present case, and subject to the relatedness of the goods ..., this rule compels the finding that Applicant's mark is similar to the cited mark.

We need not determine, however, whether it is the turtle design or the word "ZANZIBAR" which singularly constitutes the dominant and distinguishing portion of applicant's "ZANZIBAR" and design mark in order to agree with the Examining Attorney that, when such mark is contemporaneously used with registrant's

"ZANZIBAR" mark in connection with, respectively, such closely related apparel as various outerwear clothing items and footwear, confusion as to the source of sponsorship of such goods is likely to occur. Plainly, in terms of its size alone, the turtle design in applicant's mark forms a prominent rather than "peripheral" portion thereof. Nonetheless, the turtle design is not so large that visually it essentially prevents or appreciably slows notice or perception of the word "ZANZIBAR" which appears underneath such design. Instead, it is clear that the word "ZANZIBAR," as the sole literal portion of applicant's mark, also constitutes a prominent portion of such mark, especially since it would typically be used by customers when calling for or otherwise referring to applicant's goods.⁵

In view thereof, and inasmuch as on this record, the term "ZANZIBAR" is not only identical in all respects to registrant's mark "ZANZIBAR" but, unlike the word "CO-OP" in the *Co-Operative Members* case relied upon by applicant, has not been shown to be merely descriptive or otherwise weak in terms of its source-indicative significance, the additional element in applicant's "ZANZIBAR" and design mark of what is proportionately a much larger turtle design is insufficient to preclude a likelihood of confusion. Considered in their entirety, applicant's "ZANZIBAR" and design mark and registrant's "ZANZIBAR" mark are substantially similar in sound, appearance, connotation and commercial impression.

⁵ See, e.g., *In re Appetito Provisions Co. Inc.*, supra at 1554); and *In re Drug Research Reports, Inc.*, 200 USPQ 554, 556 (TTAB 1978).

Accordingly, we conclude that consumers and prospective purchasers who are familiar or otherwise acquainted with registrant's "ZANZIBAR" mark for its "footwear" would be likely to believe, upon encountering applicant's substantially similar "ZANZIBAR" and design mark for, at a minimum, his outerwear clothing, "namely[,] sweatshirts, men[']s, women[']s and children's clothing, namely, pants, coats, hats, ... shirts, blouses and t-shirts," that such closely related goods emanate from, or are otherwise sponsored by or affiliated with, the same source. Customers, in particular, could reasonably believe that applicant's "ZANZIBAR" and design mark for various items of outerwear designates a new line of clothing from the same source as registrant's "ZANZIBAR" footwear.

Decision: The refusal under Section 2(d) is affirmed.