

**THIS OPINION IS NOT A
PRECEDENT OF
THE TTAB**

Mailed: March 12, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nessim

Serial No. 78524236

Efrain Brito of Arent Fox LLP for Azoubel Araha Nessim.

Kristina Morris, Trademark Examining Attorney, Law Office
116 (Michael W. Baird, Managing Attorney).

Before Seeherman, Quinn and Taylor, Administrative
Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Azoubel Araha Nessim has filed an application to
register the mark shown below



for goods ultimately identified as "women's swimwear,
namely, bikinis and swimsuits."¹ Applicant disclaimed the

¹ Application Serial No. 78524236, filed November 30, 2004, and
alleging applicant's bona fide intention to use the mark in
commerce.

term SWIMWEAR and entered the following description and translation of the mark into the application record: "The mark consists of a black rectangle with an intersecting zigzag line design in the upper center portion over the word ZINGARA." The application contains the statement, "[t]he foreign wording in the mark translates into English as 'gypsy woman'."

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered marks ZENGARA for "men's footwear; namely, shoes and boots"²; and ANTONIO ZENGARA for "men's footwear; namely, shoes and boots,"³ as to be likely to cause confusion. The registrations are owned by the same entity.

When the refusals were made final, applicant appealed. Both applicant and the examining attorney filed appeal briefs. As discussed below, we reverse the refusals to register.

² Registration No. 1813813, registered December 28, 1993, renewed. The registration includes the following statement: "The trademark 'ZENGARA' is fanciful and is not the surname of any known living individual."

³ Registration No. 1822864, registered February 22, 1994, renewed. The registration includes the following statement: "The trademark 'ANTONIO ZENGARA' is fanciful and is not the name of any known living individual."

Before turning to the merits of the likelihood of confusion issue, we discuss an evidentiary matter. The examining attorney, citing 37 C.F.R. §2.142(d), has objected to the introduction into the record of Exhibits A and B attached to applicant's appeal brief and Exhibits A and B attached to applicant's supplemental appeal brief. 37 C.F.R. § 2.142(d) provides, in part, that "[t]he record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed." With respect to the examining attorney's objection to the exhibits attached to applicant's supplemental brief, applicant contends that this evidence was timely submitted. Specifically, applicant maintains that this evidence was submitted in response to a new refusal to register.

A review of the record herein reveals that after the filing of the appeal herein, the Board construed an earlier-filed proposed amendment as a request for reconsideration and remanded the application to the examining attorney for consideration of the proposed amendment. The examining attorney thereafter issued an Office action wherein she accepted the amendment to the

identification of goods. However, the examining attorney advised applicant that the amendment would not obviate the refusal to register. The examining attorney attached to her Office action copies of web pages to support her position that there was still a likelihood of confusion. In responding to a request for reconsideration, an examining attorney may submit new evidence. TBMP Section 1207.04 (2d ed. rev. 2004). Further, the action by the examining attorney denying the request for reconsideration was not a new refusal. Rather, the examining attorney maintained the existing 2(d) refusal. Therefore, we will not consider the exhibits attached to applicant's supplemental appeal brief. As for the exhibits attached to applicant's original brief, as noted above, subsequent to the filing of the appeal brief, the application was remanded to the examining attorney for her consideration of the proposed amendment. During that time, the examining attorney had an opportunity to review the exhibits attached to the original brief and respond to them. Under the circumstances, we will consider the exhibits attached to the appeal brief.

We now turn to the merits of the appeal. Applicant argues that when the marks are viewed in their entirety, his mark differs from those of the cited registrations in

sound, appearance, meaning and connotation. Applicant particularly argues that differences in connotation, his mark meaning "gypsy woman" whereas the registered marks refer to an "individual designer" (real or fictitious), weigh against any likelihood that the marks will be confused. (Brief at p. 7). Applicant also argues that the goods for the cited marks and applicant's mark are neither complementary nor competitive and that they travel in different channels of trade and are sold to highly sophisticated buyers in different markets.

In support of his position that the refusal be reversed, applicant, with his first request for reconsideration, submitted excerpts from his website and from websites featuring registrant's footwear, and a Wikipedia⁴ entry for the term "Zingara."⁵ According to Wikipedia, "Zingara" is "Italian for The Gypsy, The Gypsy Girl." "La Zingara" is also an opera by Gaetano Donizetti.

⁴ There is no issue as to the accuracy of the Wikipedia information relied on by applicant, and so we have considered this evidence. See *In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1032 (TTAB 2007).

⁵ Applicant also submitted an excerpt from www.zingara.co.za for "madame ZINGARA." Not only does the website reference a South African establishment, but the relevance of this evidence is unclear and it has little, if any, probative value.

The examining attorney maintains that the overall commercial impression of applicant's mark and the cited marks created by their highly similar sound and appearance creates a likelihood of confusion for the average consumer. The examining attorney also contends that "[b]ecause consumers are accustomed to seeing the same types of goods as those offered by applicant and registrant emanating from a single source, they are likely to believe that these goods [in this appeal], marketed under highly similar marks, emanate from a single source." (Brief at p. 11). The examining attorney introduced excerpts of websites in support of her contention that the goods are related. She also made of record copies of third-party registrations that she maintains show that the same entity has adopted the same mark for the types of goods involved in this appeal.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Each of these factors may, from case to case, play a dominant role. *du Pont*, 476 F.2d at 1361,

177 USPQ at 567. The marks themselves are very similar. In particular, the dominant portion of applicant's mark, ZINGARA SWIMWEAR and design, is ZINGARA, as the generic term "swimwear" and the zigzag line design are subordinate in nature. Likewise, the term ZENGARA is the dominant portion of the cited mark ANTONIO ZENGARA, given that "Antonio" is a common first name. Thus, applicant's mark is substantially similar to the cited marks in appearance, sound and overall commercial impression, and the potential differences in connotation are not likely to be known by many consumers. Despite this, in this case we think the similarity or dissimilarity and nature of the goods play the dominant role in our analysis.

We now consider the goods as identified in the application and the cited registrations. We also point out that there is no per se rule governing likelihood of confusion in cases involving clothing items, but rather each case is to be determined on its own particular facts and circumstances. See, e.g., *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) and cases cited therein. In support of her contention that the goods are related, the examining attorney submitted copies of various use-based third-party registrations which show that various trademark owners have adopted a single mark for goods of

the kind that are identified in both applicant's application and the cited registrations, i.e., swimwear and footwear.⁶ Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993). In addition, the examining attorney submitted web pages showing men's shoes and women's swimwear marketed under the same mark. We accept these third-party registrations and the web pages as suggesting that women's swimwear and men's footwear may be manufactured by or originate from the same producer.

With regard to the channels of trade and classes of purchasers, applicant argues that there is no likelihood of confusion because his goods and the goods listed in the cited registrations are sold in different channels of trade and are sold to different consumers. Applicant argues that his "mark is to be used [on goods sold] at boutiques and e-commerce sites dedicated to women's swimwear products" and "essentially travel in very narrow

⁶ The examining attorney submitted copies of sixteen registrations. We note that five of the registrations have no probative value because they do not include both swimwear and footwear.

and restricted channels of trade targeting women looking for beachwear and swimwear for the summer or vacations" (Reply brief at p. 5), while the goods sold under the cited registered marks "are narrowly targeted towards men looking for dress shoes and boots" and "essentially travel in very narrow and restricted channels of trade targeting businessmen in look [sic] for business attire and shoes." (Brief at p. 8).

As the examining attorney observed, neither the application nor the cited registrations are in any way restricted as to channels of trade. It is therefore presumed that the goods identified in the application and the cited registrations move in all normal channels of trade. In re Elbaum, 211 USPQ 639 (TTAB 1981). Because of these presumptions, we conclude that both applicant's swimwear and registrant's footwear are sold at department stores, specialty stores and over the Internet to members of the general public.

Even as we draw these conclusions, we nevertheless recognize that our threshold inquiry is not whether both applicant's goods and registrant's goods are sold in the same stores or over the Internet to members of the general public, but whether applicant's and registrant's goods will be encountered by the same purchasers under

circumstances that would give rise to a mistaken belief that they emanate from the same source. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and the cases cited therein. In that regard, there is no evidence in the record to support the examining attorney's contention that registrant's footwear and applicant's swimwear would be encountered by the same purchasers. Men's shoes and women's swimwear ordinarily would be displayed in different sections of a department store and are neither complementary nor companion items. Moreover, while some clothing items, e.g., sweaters and shirts, are often purchased for the opposite sex as a gift, both applicant's and registrant's goods are of a type that would be personally selected by the ultimate wearer because of the need to try on both swimwear and footwear to ensure a proper fit.

Put simply, based on the record before us, we perceive the examining attorney's view of likelihood of confusion as being only a speculative, theoretical possibility, particularly in light of the personal nature of the goods. As stated by our primary reviewing court, "[w]e are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the

commercial world, with which the trademark laws deal.”
Electronic Design & Sales Inc. v. Electronic Date Systems
Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391, (Fed. Cir.
1991), quoting from Witco Chemical Co. v. Whitfield
Chemical Co., Inc. 418 F.2d 1403, 1405, 165 USPQ 43, 44-45
(CCPA 1969), aff’g 153 USPQ 412 (TTAB 1967).

In sum, while applicant’s mark ZINGARA SWIMWEAR is
substantially similar to registrant’s marks ZENGARA and
ANTONIO ZENGARA, we are not persuaded, on this record,
that purchasers of registrant’s men’s footwear, namely
shoes and boots, would encounter applicant’s women’s
swimwear under circumstances that would lead them to
believe that they emanate from a common source.

Decision: The refusals to register under Section
2(d) of the Trademark Act are reversed as to both
Registration No. 1813813 and Registration No. 1822864.