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Mailed:
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Grendel

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

L.C. Licensing, Inc. and Liz Claiborne, Inc.
v.
CMR Industria e Comercia Ltda.

Opposition No. 91154354
to application Serial No. 76209351
filed on February 13, 2001

David B. Kirchstein of Kirchstein, Ottinger, Israel &
Schiffmi for L.C. Licensing, Inc. and Liz Claiborne, Inc.

Bruce L. Adams of Adams & Wilks for CMR Industria e Comercia
Ltda.

Before Seeherman, Grendel and Kuhlke, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant, CMR Industria e Comercia Ltda., seeks
registration of the mark depicted below



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for goods identified in the application as "pantyhose, lingerie, blouses and tops."¹ The application includes the following "description of mark" statement supplied by applicant at the Office's request: "The mark consists of a stylized depiction of the letters 'LZ'." (We shall have more to say about this description, *infra*.)

Opposers L.C. Licensing, Inc. and Liz Claiborne, Inc. have opposed registration of applicant's mark, on the ground that, as applied to applicant's goods, the mark so resembles various previously-registered "LIZ"-formative marks owned by opposers as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant filed an answer by which it denied the salient allegations of the notice of opposition.

The evidence of record includes the pleadings herein, the file of the opposed application, and status and title copies of eleven of opposers' pleaded registrations, which opposers submitted via notice of reliance. These registrations, all of which are in full force and effect and owned by opposer L.C. Licensing, Inc., are summarized as follows:

¹ Serial No. 76209351, filed February 13, 2001. The application is an intent-to-use application under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

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- Registration No. 1346383, which is of the mark **LIZWEAR** (in standard character form) for "clothing, namely, pants, shorts, skirts, blouses, sweaters, shirts, t-shirts, jerseys and jeans";

- Registration No. 1531982, which is of the mark **LIZWEAR** (in standard character form) for "handbags," and for "jeans and jean jackets, tank tops, dresses, hats, shoes, boots and sneakers";

- Registration No. 1463605, which is of the mark depicted below



for "pants, shorts, skirts, blouses, sweaters, shirts, t-shirts, jerseys and jeans";

- Registration No. 1371423, which is of the mark **LIZ SPORT** (in standard character form; SPORT disclaimed) for "pants, skirts, culottes, one-piece suits, blouses, sweaters, t-shirts and jackets";

- Registration No. 1463606, which is of the mark depicted below



for "pants, skirts, culottes, jumpsuits, blouses, sweaters, t-shirts and jackets";

- Registration No. 1534435, which is of the mark **LIZSPORT** (in standard character form) for "shorts, dresses and hats";

- Registration No. 1602413, which is of the mark **LIZ & CO.** (in standard character form; "& CO." disclaimed), for shirts, blouses, tank

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tops, pants, trousers, shorts, stirrup pants, dresses, rompers, sweatshirts, skirts, jackets, blazers, cardigans, vests, sweaters, jerseys, t-shirts, jeans, jumpsuits";

- Registration No. 2132747, which is of the mark **LIZGOLF** (in standard character form) for "shorts, skorts, pants, vests, jackets, windshirts, tops, polo shorts [sic], t-shirts, cardigans, jackets, sweaters, vests, sweatshirts";

- Registration No. 2469677, which is of the mark depicted below



for "shorts, skorts, skirts, pants, vests, jackets, windshirts, tops, t-shirts, cardigans, sweaters, vests and sweatshirts";

- Registration No. 2269882, which is of the mark **LIZWOOL** (in standard character form) for "coats"; and

- Registration No. 2377861, which is of the mark **LIZFLEX** (in standard character form) for "footwear of all kinds."

Applicant, in support of its second affirmative defense (i.e., that opposer's LIZ marks are weak and entitled to a narrow scope of protection), attached to its answer printouts, from the Office's database, of various third-party "LIZ" registrations. Although applicant failed to make these registrations of record at trial, opposer, in its brief on the case, has treated them as if they were of record. We therefore shall deem these registrations to have

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been stipulated into the record, and we shall discuss their probative value, *infra*.

Because opposers have made their pleaded registrations of record, and because their likelihood of confusion claim is not frivolous, we find that opposer has established its standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Additionally, because opposers have made their pleaded registrations of record, Section 2(d) priority is not an issue in this proceeding. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) 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 and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

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We find that the goods identified in applicant's application are in part legally identical to, and otherwise closely related to, the goods identified in opposer's various registrations. Given the absence of any restrictions or limitations in the parties' respective identifications of goods, we also find that the parties' respective goods would be marketed in the same trade channels and to the same classes of purchasers. We also find that the parties' respective goods are ordinary consumer items which would be purchased by ordinary consumers who would not necessarily exercise a great deal of care. Certainly pantyhose, one of the items identified in applicant's application, is an inexpensive item which could be purchased on impulse. These findings under the second, third and fourth *du Pont* factors all weigh significantly in opposers' favor in our likelihood of confusion analysis.

We turn next to the first *du Pont* factor, i.e., whether applicant's mark and opposers' marks are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial

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impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, in cases such as this, where the applicant's goods are (in part) identical to the opposer's goods, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

We find that the commercial impression of applicant's mark is the word or name "LIZ." This is so, notwithstanding applicant's "description of the mark" statement in the application which asserts that applicant's mark is a stylized depiction of the letters "LZ." The accuracy of that statement is belied by the presence of the dot in the

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middle of the mark, which purchasers readily would assume to belong to the letter "i". Due to the presence of the dot and the upturned letter "i" in the middle of applicant's mark, purchasers will view and understand applicant's mark not as the letters "LZ" but rather as the word or name "LIZ" depicted in script form.

We also find that the dominant feature of opposers' various marks (especially those marks which are depicted in standard character form) is the name "LIZ." The additional literal elements of opposers' marks are descriptive or generic words such as "WEAR" and "SPORT", attached as suffixes to the name "LIZ." Although several of opposers' marks are depicted in stylized form, the degree of stylization is not so pronounced as to detract from the dominance of the name "LIZ" in each of the marks.

In terms of appearance, we find that applicant's mark is similar rather than dissimilar to each of opposers' marks, especially those marks which are registered in standard character form. Applicant's mark is depicted in a stylized script form, but opposer's rights in its standard character marks would entitle opposer to use its marks in a similar script form. *See Cunningham v. Laser Golf Corp., supra.* Moreover, as discussed above, the dominant feature of both applicant's mark and opposers' marks is the name "LIZ." It is that name, and not the stylization of the

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respective marks, which would be utilized by purchasers to identify the source of the respective goods.

In terms of sound, we find that applicant's mark is similar to opposers' marks to the extent that applicant's mark, and the first syllables of opposers' marks, would be pronounced as the name "LIZ." The marks would not be pronounced identically, due to the presence in opposers' marks of the additional descriptive and generic wording. However, the dominant features of both parties' marks would be pronounced identically, i.e., "LIZ."

In terms of connotation and overall commercial impression, the parties' marks are similar rather than dissimilar because they all would be understood to refer to a person, "LIZ," who is the designer and/or the source of the goods sold under the marks.

As discussed above, the greater the degree of similarity between the parties' goods, the lesser the degree of similarity between the respective marks that is required to support a finding of likelihood of confusion. Given the legally identical and otherwise similar nature of the parties' goods in this case, we find that their respective marks are sufficiently similar that source confusion is likely to result from contemporaneous use of the marks on these goods.

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We turn finally to the third-party registrations of "LIZ" marks made of record by applicant. We note that these registrations are not probative evidence under the sixth *du Pont* likelihood of confusion factor ("the number and nature of similar marks in use on similar goods"), because they are not evidence that the marks depicted therein are in use or that they are familiar to purchasers. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

In summary, we find that the evidence of record as it pertains to the relevant *du Pont* factors clearly supports a finding of likelihood of confusion, and that registration of applicant's mark therefore is barred under Trademark Act Section 2(d).

Decision: The opposition is sustained.