

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Ermenegildo Zegna Corporation
v.
Samson G. Bekele

Opposition No. 91170493
to application Serial No. 78666031
filed on July 7, 2005

John M. Cone of Hitchcock Evert LLP for Ermenegildo Zegna Corporation

Thomas J. Tighe of Tighe & Associates for Samson G. Bekele.

Before Grendel, Walsh and Wellington,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Applicant, Samson G. Bekele, seeks registration of the mark JEGNA (in standard character form) for goods identified as "clothing namely, belts, night caps, hats, socks, athletic uniforms, night gowns, pajamas, night shirts, swimming wear, swimming caps, sports shirts, sweaters, jumpers, rain coats, coats, jackets, men's suits, pants, shirts, boots, jerseys, vests, polo shirts, foot wear,

dresses, scarves, blouses, head wear, and bandanas" in International Class 25.¹

Opposer, Ermenegildo Zegna Corporation, has opposed registration of applicant's mark on the ground that, as applied to applicant's goods, the mark so resembles opposer's previously used and registered marks ZEGNA and EREMENGILDO ZEGNA for "clothing and accessories", and in connection with retail stores, that it is likely to "cause confusion or to cause mistake or to deceive, and to thereby cause damage to opposer."² Opposer pleaded ownership of twenty-three registrations for the marks ZEGNA and ERMENGILDO ZEGNA covering various articles of clothing and apparel accessories, as well as retail store services featuring men's clothing, footwear and accessories.

Applicant filed an answer wherein he denied the salient allegations.

Before we discuss the evidence of record, we note that both parties apparently acted in accordance with the original trial schedule set forth in the Board's April 20,

¹ Serial No. 78666031, filed July 7, 2005, alleging a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b). The application contains a statement that the mark translates into English as hero, warrior or soldier.

² Opposer pleaded two other grounds for opposition, i.e., dilution and that applicant did not have a bona fide intent to use its mark in commerce at the time of filing of the application. However, in opposer's brief, it states that it is only pursuing the likelihood of confusion ground. Brief, p. 1. Accordingly, opposer has waived any pleaded claims other than likelihood of confusion.

2006 institution order. However, the Board rescheduled the discovery deadline and trial dates on October 17, 2006. Specifically, opposer filed status and title copies of its registrations under a notice of reliance on February 2, 2007, a date falling within its originally-scheduled testimony period, but before its rescheduled testimony period. Likewise, applicant filed a communication with exhibits on April 3, 2007, a date falling within his originally-scheduled testimony period, but before his rescheduled testimony period. Moreover, opposer filed a trial brief on July 17, 2007, also apparently based on the original trial schedule and in conjunction with Trademark Rule 2.128 (allowing plaintiff sixty days from the end of the rebuttal testimony period to file its trial brief). Nothing further was filed by the parties.

Because the issue of the aforementioned submissions being prematurely filed has not been raised by either party, any timeliness objections are waived. See TBMP § 707.04 (2d ed. rev. 2004) and authorities cited therein. Accordingly, we consider the submissions timely-filed.

Although we consider applicant's April 3, 2007 (untitled) submission to be timely-filed, opposer's motion (contained on p. 2 of its trial brief) to strike the submission with exhibits on other grounds is granted, in part, as well-taken and conceded. Trademark Rule 2.127. In

particular, we agree with opposer that the communication is not a notice of reliance and, in any event, the exhibits attached thereto (copies of printouts from various internet websites) are not self-authenticating and have not otherwise been authenticated. Trademark Rule 2.122(e); see also TBMP § 704.07 (2d ed. rev. 2004) [regarding the introduction into evidence of internet materials]. Accordingly, opposer's motion is granted to the extent that the exhibits attached to applicant's submission are stricken and the Board will not give consideration to any factual averments or arguments based on the exhibits. However, to the extent that the submission contains arguments not based on the exhibits, the Board construes the submission as a trial brief and, like opposer's trial brief, we will give consideration to the brief in spite of it being filed prematurely.

In view of the above, the only evidence of record on submission are the status and title copies of opposer's seventeen registrations, filed under opposer's notice of reliance.³ And, by rule, the record includes the pleadings and the file of the opposed application.

³ As noted, opposer pleaded ownership of twenty-three registrations. Of the seventeen registrations for which opposer filed status and title copies, twelve were pleaded by opposer, i.e., opposer did not plead ownership for five of the registrations for which it submitted status and title copies. As explained in this decision, we have focused our likelihood of confusion analysis with respect to two of opposer's registrations, namely, Registrations Nos. 2640485 and 1258643. Opposer pleaded these two registrations and provided status and title copies therefor.

We focus our likelihood of confusion analysis on the following two registrations, which are in full force and effect, owned by opposer:

Registration No. 1258643, for the mark ZEGNA (in typeset form) for "Shoes, Belts, Hats, Ties, Scarves, Robes, Suits, Sports Jackets, Topcoats, Overcoats, Raincoats, Leather Coats and Jackets, Car Coats, Slacks, Vests, Knit and Woven Shirts, Formal and Sport Shirts, Bathing Suits, Short Pants, Sweaters, Socks, Quilted Jackets and Coats, Long Pants, [Long and Short Woven and Knit Underwear,] Athletic Shorts, Sleeveless and Sleeved Knit and Woven Shirts, [Boxer Shorts, Waistbands,] Gloves, Balaklava, [Jumpsuits, Skirts and Blouses]" in International Class 25, issued on November 22, 1983, renewed (for ten years) in 2004; and

Registration No. 2640485, for the mark ZEGNA (in typeset form) for "retail stores and departments in retail stores featuring men's clothing, footwear and accessories" in International Class 35, issued on October 22, 2002, claiming dates of first use anywhere and in commerce on March 1, 2001;

Because opposer has made the two registrations summarized above properly of record, opposer has established its standing to oppose registration of applicant's mark and its priority is not in issue. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). We thus turn to the issue of likelihood of confusion between these two registered marks and applicant's mark.

Our likelihood of confusion determination under Trademark Act 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). 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 considerations are the similarities between the marks and the similarities 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).

We turn first to the similarity of the parties' goods and services. Here, the parties' identifications of goods list many of the same articles of clothing and accessories. For example, both Registration No. 1258643 and the subject application identify shirts, coats, swimwear, jackets, belts, hats, socks, athletic apparel, pants, and suits. Also, opposer's retail store services featuring men's clothing are closely related to applicant's goods inasmuch as, based on the record before us, we must assume that it is possible for applicant's clothing to be sold in opposer's stores.

Applicant argues that the parties' goods are sold to different classes of customers and through different trade channels. Brief, p. 1. However, neither opposer's nor

applicant's identifications of goods are restricted as to their trade channels or classes of purchasers. And, we must make our findings based on the goods as they are recited in the application and registrations, respectively. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639 (TTAB 1981). We must presume that the parties' goods are marketed in all of the normal trade channels for such goods, and that the goods are bought by the usual classes of purchasers. Accordingly, given that the parties' goods are, in part, identical and without restrictions, it is presumed that they move in the same trade channels to the same classes of purchasers.

In view of the nature of the parties' goods, i.e., fairly basic articles of clothing, the purchasers of the goods would include ordinary consumers, who would be expected to exercise the ordinary amount of care in their purchasing decisions. Further, several of the goods, which are common to both parties' identifications, are relatively inexpensive, e.g., belts, socks, and are capable of being purchased on impulse.

The du Pont factors of the similarity of the goods and trade channels, as well as the conditions under which and

buyers to whom sales are made, weigh in favor of a finding of likelihood of confusion.

We now turn our attention to the parties' marks. In considering the marks, we initially note that when they are used in connection with identical goods and/or services, as they are here, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Under this du Pont factor, we look to the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. The test 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 their overall commercial impressions that confusion as to the source of the goods/ services offered under the respective marks is likely to result. The focus is on the perception and recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. See *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

We find the marks at issue, ZEGNA and JEGNA, to be nearly identical in appearance -- the obvious, single difference being the first letter of the marks. There is also no evidence in the record as to whether there is a proper pronunciation for either mark. Thus, when a consumer encounters the marks, after pronouncing the first letter, the rest of the mark will sound the same depending on how the consumer chooses to pronounce "-EGNA." Consequently, the marks are not only visually very similar, but will also sound alike.

As to any connotations created by the respective marks, applicant argues that its mark is the transliteration of an Amharic (a language spoken in Ethiopia) word and "there is no limit on how many ways JEGNA can be translated. Warrior, teacher, influencer are just a few..." Brief, p. 4. However, there is no evidence in the record for us to draw the same conclusion. Likewise, there is no evidence that opposer's ZEGNA mark has any particular meaning. The Board has verified that neither term has a defined meaning in English.⁴

⁴ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). In searching for definitions of "Jegna" and "Zegna", the Board referenced The Merriam-Webster Online Dictionary which is based on the print version of *Merriam-Webster's Collegiate® Dictionary, Eleventh Edition*.

In view of the above, and with emphasis on the fact that the only distinguishing features of the marks are their initial letters, we conclude that the marks are highly similar in their appearance and sound. And there is nothing in the record for us to conclude that either mark creates a commercial impression or connotes a meaning to help distinguish them. Accordingly, as to similarity of the marks, this du Pont factor strongly favors opposer.

In sum, the marks are very similar, there is no evidence establishing that opposer's mark is weak or for any reason entitled to a narrow scope of protection, the involved goods are in part the same and otherwise closely related, and the goods must be presumed to be marketed to the same classes of end consumers. On the record, we find that confusion among consumers is likely.

Decision: The opposition is sustained.