

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

Mailed: September 8, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Dooney & Bourke, Inc.
v.
La Vani, Inc.

Opposition No. 91175950
to Application No. 76584390
filed on April 1, 2004

Robert Laplaca of Levett Rockwood for Dooney & Bourke, Inc.
Susan B. Flohr of Blank Rome for La Vani, Inc.

Before Quinn, Walters and Grendel, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Dooney & Bourke, Inc. filed its opposition to the application of La Vani, Inc. to register the mark shown below for "leather and imitations of leather articles, namely, trunks and traveling bags, brief cases, back packs, hand bags, shopping bags, wallets, purses, key case and key chains," in International Class 18.¹

¹ Application Serial No. 76584390, filed April 1, 2004, alleging dates of first use and first use in commerce as of August 2003.



As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods so resembles opposer's previously used and registered mark shown below as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

Registration No. 2771012 [registered October 7, 2003, with a claim of acquired distinctiveness under Section 2(f)]

Mark:



Goods:

- "eyeglass cases, camera cases, binocular cases, mobile phone holsters, compact disc cases," in International Class 9;
- "personal organizers, checkbook wallets, checkbook covers, checkbook holders," in International Class 16; and
- "wallets, purses, coin purses, clutches, handbags, shoulder bags, shoulder straps, tote bags, backpacks, luggage, suitcases, trunks, empty cosmetics cases, leather key cases, leather key fobs, fanny packs," in International Class 18.

Applicant, in its answer, denied the salient allegations of the claim.

The record consists of the pleadings; the file of the involved application; certified status and title copies of Registration Nos. 2771012 and 3000026; and a copy of a

response to an Office action with an affidavit of Carolyn Donahue from the file of Registration No. 2771012, excerpts from various publications, and copies of foreign registration certificates owned by opposer, all made of record by opposer's notice of reliance. Only opposer filed a brief on the case.

Opposer's Registration No. 3000026 was not pleaded in its notice of opposition and, thus, has been given no consideration. The foreign registration certificates, while properly of record, are of no probative value. Opposer did not obtain from applicant a stipulation to the submission of testimony by affidavit, but opposer submitted the affidavit of its employee. This is not the appropriate means for submission of testimony in an inter partes proceeding and, thus, this affidavit has not been considered. See Trademark Rule 2.123, 37 CFR §2.123.

Because opposer has properly made its pleaded registration of record, 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). Moreover, because opposer's pleaded registration is of record, Section 2(d) priority is not an issue in this case as to the mark and goods covered by said registration. *See*

King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 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). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

With respect to the goods of the parties, we observe that there is a substantial overlap in the goods identified in the application and in the pleaded registration. Both parties' identifications of goods include the identically-

worded "trunks," "hand bags" and "key cases." Applicant's "traveling bags" encompass opposer's "luggage" and "suitcases." Thus, it is unnecessary to consider whether or to what extent the remaining goods are overlapping or related. This *du Pont* factor weighs strongly in opposer's favor.

Further, both opposer's and applicant's identifications of goods are broadly worded, without any limitations as to channels of trade or classes of purchasers. We must presume that the goods of applicant and opposer are sold in all of the normal channels of trade to all of the usual purchasers for goods and services of the type identified. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In other words, we conclude that the channels of trade and class of purchasers of the parties' identical and overlapping goods are the same. These factors also weigh in opposer's favor.

Turning to the marks, we note that while we must base our determination on a comparison of the marks in their entirety, we are guided, equally, by the well established principle that, in articulating reasons for reaching a conclusion on the issue 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, provided the ultimate conclusion rests on consideration of

the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Both marks consist of two interlocking letters, with a "D" as the first letter and the second letter appearing interlocked, below and to the right of the "D." Further, the second "D" in opposer's mark and the "B" in applicant's mark both consist of a straight stroke on the left and either one or two similarly curved lines to the right. 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 terms of their overall commercial impressions that confusion as to the source of the goods or services 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). We conclude that the overall commercial impressions of these two marks is substantially similar. Thus, this factor also weighs in opposer's favor.

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark and registrant's mark, their contemporaneous use on the same and overlapping goods involved in this case is likely to

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cause confusion as to the source or sponsorship of such goods.

Decision: The opposition is sustained.