

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Hearing:
December 14, 2004

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Zanella Ltd.
v.
Saroyan Lumber Company

Opposition No. 91153249
to application Serial No. 76292052
filed on July 30, 2001

Stuart E. Benson, Mary Boney Denison and Michael H. Selter
of Manelli Denison & Selter for Zanella Ltd.

Charles H. Thomas of Cislo & Thomas for Saroyan Lumber
Company.

Before Quinn, Grendel¹ and Drost, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Saroyan Lumber Company to
register the mark ZANELLA for "wooden flooring."²

Zanella Ltd. opposed registration under Section 2(d) of

¹ Formerly Bottorff.

² Application Serial No. 76292052, filed July 30, 2001, asserting first use anywhere and first use in commerce on March 5, 2001. The application includes the following statement: "The English translation of the word 'ZANELLA' from Italian is 'gutter, ditch or basket.'"

the Trademark Act on the grounds of priority and likelihood of confusion. Opposer alleged that applicant's mark, when used in connection with applicant's goods, so resembles opposer's previously used and registered ZANELLA marks as to be likely to cause confusion.³ As the bases for its opposition, opposer pleaded the following registered marks: ZANELLA (standard character form) for "men's wearing apparel, namely raincoats, jackets, shirts, trousers, pants, [and] vests,"⁴ and "women's clothing, namely shorts, skirts, dresses, blouses, pants, jackets, coats, vests, scarves, hats, swimwear, raincoats, socks and underwear";⁵

Zanella

for "men's wearing apparel, namely raincoats, mantles, jackets, shirts, blouses, waistcoats, trousers, pants,

³ Opposer also alleged that the mark sought to be registered is primarily merely a surname and is proscribed under Section 2(e)(4). This claim was neither pursued at trial nor raised in the briefs. Thus, we treat the claim as waived by opposer.

⁴ Registration No. 1519894, issued January 10, 1989 under the provisions of Section 2(f); Section 8 affidavit accepted, Section 15 affidavit acknowledged.

⁵ Registration No. 1990695, issued August 6, 1996 under the provisions of Section 2(f); Section 8 affidavit accepted, Section 15 affidavit acknowledged.

socks, stockings, ties, scarves, hats, swimwear, vests and underwear";⁶

Zanella

for "women's clothing, namely shorts, skirts, dresses, blouses, pants, jackets, coats, vests, [and] raincoats";⁷ and



for "women's and men's clothing, namely, shorts, skirts, blouses, pants, jackets, coats, vests, scarves, hats, swimwear, raincoats, socks, underwear, mantles, shirts, waistcoats, trousers, stockings and ties."⁸

Applicant, in its answer, admitted the validity and subsistence of the pleaded registrations, but otherwise denied the salient allegations of likelihood of confusion.

⁶ Registration No. 1527003, issued February 28, 1989 under the provisions of Section 2(f); Section 8 affidavit accepted, Section 15 affidavit acknowledged.

⁷ Registration No. 1992385, issued August 13, 1996 under the provisions of Section 2(f); Section 8 affidavit accepted, Section 15 affidavit acknowledged.

⁸ Registration No. 2453062, issued May 22, 2001.

The record consists of the pleadings; the file of the involved application; status and title copies of opposer's pleaded registrations that accompanied the notice of opposition; trial testimony, with related exhibits, taken by each party; applicant's responses to opposer's discovery requests, excerpts from printed publications, excerpts of websites retrieved from the Internet,⁹ and official records, all introduced through opposer's notice of reliance; and opposer's responses to applicant's first requests for admissions made of record by way of applicant's notice of reliance. Both parties filed briefs on the case, and both parties were represented by counsel at an oral hearing before the Board.

The Parties

Opposer is an importer and seller of men's and women's upscale, high-end clothing made in Italy, and opposer has been selling its goods under the ZANELLA mark in the United States since 1975. "Zanella" is the surname of the founder of opposer's predecessor. The clothing is sold in stores such as Nordstrom, Saks Fifth Avenue and Neiman Marcus, as

⁹ The element of self-authentication normally cannot be presumed to be capable of being satisfied by information obtained and printed out from the Internet. Thus, materials retrieved from the Internet generally are not admissible by notice of reliance. TBMP §704.08 (2d ed. rev. 2004). In the present case, however, applicant did not object to the admissibility of this evidence and, moreover, applicant treated the evidence as if properly made of record. Accordingly, we deem the Internet evidence to be stipulated into the record, and we have considered it in reaching our decision.

Opposition No. 91153249

well as in specialty boutiques. Opposer's largest selling goods are men's trousers; the trousers are designed in about thirty different models to fit all body types. Retail prices for opposer's trousers for men start at \$250, and women's jackets at \$500. Opposer's retailers have stated that opposer's trousers are "very important" to their overall business. Opposer's sales and advertising figures have been deemed "confidential," so we are precluded from indicating the numbers here. Suffice it to say that in a recent five-year period, opposer's sales were in the hundreds of millions of dollars, and advertising expenditures were in the hundreds of thousands of dollars. The clothing is advertised in magazines such as "Elle" and "GQ" and in magazines of corporations such as Four Seasons and American Express. The clothing appears in the catalogs of retailers of opposer's clothing. Opposer has never expanded its product line beyond upscale clothing made in Italy, and opposer's president, Armando Di Natale, testified that opposer has never taken any steps to license its ZANELLA mark.

Applicant manufactures and sells semi-finished wood products from raw lumber, including hardwood flooring and wooden moldings. Beginning in March 2001, applicant began selling a line of distressed hardwood flooring under the mark ZANELLA. Applicant's wood flooring is sold through

Opposition No. 91153249

flooring distributors (50%), flooring trade showrooms (15%-20%), and at product centers of model homes (25%-30%) where purchasers of new homes choose their flooring. Applicant's hardwood flooring sold under the involved mark is more expensive than other types of flooring. Applicant's primary means of promoting its hardwood flooring is through its product catalog that is given to interested designers, architects and homeowners. Other than running an advertisement in a trade association magazine, applicant has not engaged in any advertising. Applicant uses Italian or Italian-sounding words to identify its various flooring colors (e.g., "Robusto"), and its product catalog includes a picture of an Italian city.

Priority

In view of opposer's ownership of valid and subsisting registrations, there is no issue regarding opposer's priority. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Thus, the only issue to decide herein is likelihood of confusion.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the 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). The relevant du Pont factors in the proceeding now before us are discussed below.

The Marks

Applicant's mark ZANELLA in standard character form is identical in all respects to the standard character versions of opposer's mark ZANELLA. Further, opposer's other three marks in special form are only minimally stylized, and are identical to applicant's mark insofar as the literal, dominant ZANELLA portion is concerned. Neither the stylization of these three marks, nor the additional design feature in the mark shown in Registration No. 1992385, serves to sufficiently distinguish any of these marks from the one sought to be registered. See *In re Chatham International Inc.*, 380 F.2d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988); and *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987).

The identity between the standard character marks of the parties, and the virtual identity between the parties' other marks, weighs in favor of opposer.

Fame

The fifth du Pont factor requires us to consider evidence of the fame of opposer's marks and, if established, fame plays a "dominant" role in determining likelihood of confusion. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d

1367, 63 USPQ2d 1303 (Fed. Cir. 2002); Recot Inc. v. M.C. Becton, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and Kenner Parker Toys, Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Opposer contends that it has developed a "substantial reputation" through extensive sales and advertising of goods under its mark, and that its ZANELLA mark is a "strong mark."

Given opposer's reputation, and its levels of sales and advertising expenditures, we find that opposer has established that its ZANELLA mark has acquired some public recognition; this recognition, however, is mainly confined to the limited segment of high-end trousers, and little else.

The fact that opposer's mark has acquired some public recognition weighs in opposer's favor in this case. We agree with applicant, however, and opposer does not contend otherwise,¹⁰ that the proofs fall short of establishing "fame" as contemplated under this du Pont factor.

Third-Party Use

The record is devoid of any third-party registrations

¹⁰ In its discussion of the du Pont factor of fame, opposer claims that its "ZANELLA mark is a strong mark." (Brief, p. 33). Applicant, in its brief, maintains that opposer's mark "is not famous." (Brief, p. 37). Opposer, in its reply brief, responds that its mark "is a strong mark in the field of high-end designer clothing." (Reply Brief, p. 7).

of the mark ZANELLA. Applicant introduced, however, as exhibits to the testimony of Kenneth Salmacia, applicant's information systems manager, excerpts of Internet web pages showing third-party uses of ZANELLA for a wide variety of goods and services. These goods and services range from motorcycles to manhole covers to bakeries. None of the uses involves clothing.

This evidence is entitled to scant probative weight. As opposer is quick to point out, uses of the same and/or similar marks for goods and services far removed from those involved herein are immaterial. *Conde Nast Publications, Inc. v. American Greetings Corp.*, 329 F.2d 1012, 141 USPQ 249, 252 (CCPA 1964). Even if these uses were relevant to the issue at hand, applicant also failed to furnish any evidence regarding the extent of use of the marks by these third parties. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973).

The absence of any relevant third-party uses favors opposer.

The Goods

Opposer's goods are men's and women's clothing while applicant's goods are wooden flooring. The crux of opposer's contention is that the goods are commercially related inasmuch as flooring is within opposer's natural

scope of expansion. Opposer summarizes its contentions as follows (Brief, p. 1):

Apparel and flooring can and do come from the same source. Apparel designers have long used their marks on goods, including fragrances, accessories, leather goods, and shoes. Many designers have now expanded into a variety of home furnishings, including bedding, china, linens, furniture, and all types of flooring, including rugs, carpets, ceramic, laminate, and hardwood flooring.

The expansion by apparel designers is a natural one. Apparel and flooring have important characteristics in common. Both are designed and sold based in part on aesthetic, emotional factors such as style, color, and texture. Both are expressions of one's personal image. In the marketing of their flooring products, many designers have aggressively conveyed to the public that their expansion into flooring products is a logical extension of their business and expertise.

Applicant counters by arguing that opposer "has throughout this proceeding attempted to shift the focus from its own use of the mark ZANELLA, to uses by other, much larger and more well-known entities of their respective brand names on different products." (Brief, p. 3).

According to applicant, opposer "seeks to obscure the very limited variety of goods upon which it uses its mark by relying extensively upon the broad range of products upon which third parties, such as Liz Claiborne, Laura Ashley,

Opposition No. 91153249

and Armani utilize their own very famous marks through licensing arrangements." (Brief, p. 43).

With respect to the goods, it is well established that the goods of the parties need not be similar or competitive, or even that they are offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

In comparing the goods, we initially note that where virtually identical marks are involved, as is the case here (at least in part), the lesser the degree of similarity between the parties' goods that is required to support a finding of likelihood of confusion. *In re Shell Oil Co.*,

Opposition No. 91153249

992 F.2d 1204, 26 USPQ2d 1687, 1688-1689 (Fed. Cir. 1993); Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1661 (TTAB 2002); and In re Opus One Inc., 60 USPQ2d 1812 (TTAB 2001).

There is no question that clothing and wooden flooring are not naturally related goods. As just noted, it is opposer's contention, however, that given the expansion of fashion designers into home furnishings, wooden flooring is within opposer's natural scope of expansion.

Under the doctrine of natural expansion, the first user of a mark in connection with particular goods possesses superior rights in the mark not only as against subsequent users of the same or similar mark for the same or similar goods, but also as against subsequent users of the same or similar mark for any goods which purchasers might reasonably expect to emanate from it in the normal expansion of its business under the mark.¹¹ See The May Department Stores

¹¹ In the opinion of Professor J. Thomas McCarthy, as expressed in McCarthy on Trademarks and Unfair Competition, §24:20 (4th ed. 2005), the theory of "natural expansion"

appears to be no more than a specific application of the familiar "related goods" test. The "natural expansion" thesis seems to be nothing more than an unnecessarily complicated application of the likelihood of confusion or source or sponsorship test to a particular factual situation. If the "intervening" use was likely to cause confusion, it was an infringement, and the senior user has the right to enjoin such use, whether it had in fact already expanded itself or not."

Opposition No. 91153249

Co. v. Prince, 200 USPQ 803 (TTAB 1978). This is so whether or not the first user of the mark has actually expanded its use of its mark, after the commencement of the commencement of the subsequent user's use, to goods which are the same as or closely related to those of the subsequent user. An expansion of market is "natural" if, at the time when the junior user began use, purchasers would have been likely to be confused as to source or as to sponsorship, affiliation or connection. The application of the doctrine "is strictly limited to those cases where the expansion, whether actual or potential, is 'natural,' that is, where the goods or services of the subsequent user, on the one hand, and the goods or services as to which the first user has prior use, on the other, are of such nature that purchasers would generally expect them to emanate from the same source."

Mason Engineering and Design Corporation v. Mateson Chemical Corporation, 225 USPQ 956, 962 (TTAB 1985). See J. Wiss & Sons Co. v. The W.E. Bassett Co., 462 F.2d 567, 174 USPQ 331 (CCPA 1972). Among the factors to be considered in determining whether a potential expansion is natural is whether other companies have expanded from one area to the other. See Mason Engineering and Design Corp. v. Mateson Chemical Corp., supra; and Central Soya Co., Inc. v. North American Plant Breeders, 212 USPQ 37 (TTAB 1981). See also

Opposition No. 91153249

J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, supra at §24:20 (4th ed. 2005).

We note, at the outset, that it is not "natural" for a clothing manufacturer to expand its business to wooden flooring. Clothing and wooden flooring are of such nature that purchasers would not generally expect them to emanate from the same source. It is apparent from opposer's testimony and evidence, however, that a different situation exists in the arena of famous or well-known designers and their famous name marks. The record shows that there is a growing trend for famous clothing designers to expand their famous name brands to product lines like home furnishings. The record includes several examples of apparel designers' crossing over to home furnishings. At first glance, opposer's basis of its natural scope of expansion argument is attractive. Upon closer consideration of the underlying evidence, however, we find that opposer's argument falls short when we specifically consider opposer's limited recognition, and its speculative prospects of expansion into hardwood flooring. That is to say, although it may be within a natural scope of expansion for a famous designer with a famous name to broaden his/her line from clothing to wooden flooring, such expansion by a clothing designer whose mark is not famous (and where the vast majority of sales

involves one item, namely men's trousers) would not be considered natural.

Opposer offered the testimony of Sherry Maysonave as an expert on "personal dress, personal image, communication skills and marketing of apparel." (Brief, p. 3). Ms. Maysonave testified about the well-known reputation of opposer's dress slacks for men. In her book "Casual Power-- How to Power Up Your Nonverbal Communication and Dress Down for Success, the author wrote: "Zanella offers the most impressive, comprehensive line of dress trousers in the world. Italian made, their line includes trousers that accommodate varying body types and style preferences."

In explaining her view regarding the relatedness of clothing and flooring sold under the names of fashion designers, Ms. Maysonave testified (pp. 41-42) as follows:

In your professional opinion, why have fashion designers expanded into home furnishings and flooring?

I think the home furnishings and flooring is one of the more natural extensions of an apparel brand and that being that home furnishings or [are] interior design, interiors are very much like the clothing we wear. It affects our image.

And home interior also is part of our personal image and it also involves fabrics and texture, color, design, line, a lot of the same design concepts that are used in apparel design.

Opposition No. 91153249

Ms. Maysonave testified that apparel and flooring have common characteristics, such as color, texture, appearance, and aesthetic design, and that both types of goods are purchased in part to make the owner or the owner's home look good. In essence, both apparel and flooring form part of a person's image. Ms. Maysonave went on to identify certain clothing designers who have expanded their product lines to home furnishings, including flooring products. More specifically, Ms. Maysonave identified thirty-two apparel designer name brands that are also being used on home furnishings, with a limited number used on flooring. Of the thirty-two fashion designer names, ten are being used in connection with flooring products (as, for example, rugs, carpets, or ceramic tile): Alexander Julian, Calvin Klein, Kathy Ireland, Laura Ashley, Liz Claiborne, Missoni, Roberto Cavalli, Ralph Lauren, Tommy Bahama, and Versace. Of these ten, only two designers also offer hardwood flooring under their names, namely Laura Ashley and Liz Claiborne. Two others, Alexander Julian and Kathy Ireland, sell laminate flooring, which can be made to look like hardwood flooring.

In the case of Liz Claiborne, the connection between her apparel design and her home design has been promoted in the following way in connection with flooring: "She Dresses You. Now She Can Dress Your Floors." and "Moving Fashion Onto Your Floor."

Although opposer has never sought to expand its brand beyond high-end clothing made in Italy, opposer points to other apparel designers in contending that it may at some future date likewise expand into home furnishings, including flooring.¹² Applicant, on the other hand, argues that opposer misses the mark by its ill-founded reliance on much larger companies that use more widely known designer name trademarks on a wide range of products: "the use by third parties of their famous marks across a wide spectrum of different goods, including both clothing and flooring, is irrelevant to Opposer's natural zone of expansion of its niche market."

Opposer's comparison of its ZANELLA mark with several famous designer name marks is, in our view, the proverbial "comparing apples and oranges." Although opposer would have us compare its business with the likes of Laura Ashley and Liz Claiborne, a closer look at the record shows that these designer names are far better known than ZANELLA. Ms. Maysonave testified that the Liz Claiborne name is "more well known, more readily known" than opposer's mark ZANELLA. She also indicated the same situation with Armani and Ralph Lauren. (dep., pp. 98-99). Mr. Di Natale testified that

¹² While Mr. Di Natale testified that opposer has never taken any steps to license its mark, he testified that "I don't want to give away my right to license my brand name in any field, in any category." (dep., p. 137). Opposer has received only one licensing request, one for neckties, which opposer turned down.

Opposition No. 91153249

"Giorgio Armani does almost everything," and acknowledged that Armani's business, which he indicated approaches \$1 billion, "is much larger than" opposer's business. (dep., p. 140). This testimony is buttressed by applicant's testimony of Jeff Levine; Mr. Levine is the owner of an advertising firm, and he has work experience in the wearing apparel industry. Mr. Levine was offered as an expert in marketing. He testified that designer names such as Armani, Liz Claiborne, Laura Ashley, Calvin Klein, Tommy Hilfiger and Tommy Bahama are "famous" names, and that each is "more expansive in their product offering, where [opposer] is not." (dep., pp. 37-38).

With respect to Liz Claiborne, opposer's evidence includes a reference to Liz Claiborne's annual sales' exceeding \$3 billion, and that the name is used in connection with a wide range of home furnishings. This is contrasted with opposer's substantially lower volume of sales, and lack of use of its mark on any home furnishing products, let alone wooden flooring. Further, according to Ms. Maysonave, opposer's clothing and Liz Claiborne's clothing appeal to different types of consumers. As applicant argues, "[w]hile it might make sense for a large \$3 billion licensing entity, such as Liz Claiborne, to sell both apparel and flooring, it would make no sense for a

vastly smaller, high end, niche market clothier, like Opposer, to do so." (Brief, pp. 29-30).

Mr. Levine, applicant's expert, took issue with opposer's expert about whether flooring would be a natural expansion for opposer. Mr. Levine maintains that such would not be a natural expansion, and that it is ill-founded to say otherwise based on huge, multibillion dollar corporations that extensively license their famous designer name marks on a multitude of products, including apparel and flooring. As Mr. Levine explained (pp. 49-50):

I think it is more of a natural progression, before moving into other categories, that you own your own category; and I think that after you own your own category, then you can consider moving into another direction.

Zanella, Limited--again, I think what she was referring to here, and I'll use Liz Claiborne as an example if I may--is that that--I mean they have licensed their name into a variety of other product lines; so it does make sense at some point, I guess, once you own that particular category, to move into another category. Where with Zanella, Limited, they're very niche focused, and I don't think it makes sense to move to the flooring category.

Clothing and wooden flooring are not naturally related, and opposer has neither expanded its use beyond clothing nor exhibited any intention to do so. In saying this, we hasten to add that opposer's lack of a present intent to expand use of its mark is not an overriding consideration. See Tuxedo

Opposition No. 91153249

Monopoly, Inc. v. General Mills Fun Group, Inc., 648 F.2d 1335, 209 USPQ 986 (CCPA 1981). Rather, it is the consuming public's perception of possible expansion of a product line that counts, and not whether that perception comports with the reality of senior user's actual plans. See Restatement (Third) of Unfair Competition, §21, comment j (1995). See also McCarthy on Trademarks and Unfair Competition, supra at §24:19.

The fact that famous fashion designers have lent their famous names to a wide range of products does not mean that all of the products they sell are related. Opposer has not met its burden of showing that a lesser known designer in a more limited clothing field, primarily known for men's trousers, would normally expand its less than famous name brand to wooden flooring, or that purchasers would generally expect such goods to emanate from the same source. Although famous designer names in the clothing field are frequently used on collateral items, the record fails to disclose a similar practice relative to lesser-known marks.

In sum, the record shows *only two* fashion designers who have expanded from clothing to wooden flooring, namely Liz Claiborne and Laura Ashley. These names, as shown by the testimony of record, are famous and far better known than opposer's name that enjoys only limited recognition. To allow opposer or other lesser-known fashion designers to

reserve their names for an entire universe of goods and services would be tantamount to a grant of a right in gross to the name.

The disparate nature of the goods, and the fact that any expansion by opposer from clothing to wooden flooring would not be natural, weigh in applicant's favor.

Trade Channels

In the absence of any limitations in the parties' identifications of goods, we must presume that the goods move through all reasonable trade channels for such goods. *Schieffelin & Co. v. Molson Companies Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989); *Morton-Norwich Products, Inc. v. N. Siperstein, Inc.*, 222 USPQ 735, 736 (TTAB 1984); and *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)["[W]here the goods in a cited registration are broadly described and there are no limitations in the identifications of goods as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers."].

The record shows that opposer's clothing is sold in high-end specialty stores and expensive department stores (such as Neiman Marcus and Saks Fifth Avenue that do not

Opposition No. 91153249

sell flooring). In contrast, applicant's hardwood flooring is sold through flooring distributors, model home centers and flooring trade showrooms.

Opposer also has introduced evidence showing that certain stores sell both clothing and home furnishings, and that some department stores, such as Bloomingdale's and Hecht's, sell both clothing and rugs and carpets. The record is devoid of evidence, however, that any stores sell both clothing and hardwood flooring. The record also includes evidence that clothing and flooring may be advertised in the same magazines. Opposer further introduced evidence showing that some fashion designers' websites on the Internet promote both the designers' wearing apparel as well as their home furnishings.

Based on the record, we find that clothing and hardwood flooring travel in disparate trade channels. The only potential overlap would be in mass merchandise department stores, but, even there, the record does not show offerings of hardwood flooring, only rugs and carpets. Thus, we cannot conclude that departments stores are a normal trade channel for hardwood flooring. In any event, in the case of department stores, the fact that a wide range of goods may be sold under the same roof does not automatically mean that the goods are related or that buyers are likely to ascribe a common source to the goods. See, e.g., Federated Foods,

Inc. v. Ft. Howard Paper Co., 54 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Simply put, opposer has failed to establish that there is a common or frequent overlap in trade channels. The different trade channels favor applicant.

Conditions of Sale and Classes of Purchasers

As indicated above, in the absence of limitations in the identifications of goods, we must presume that all potential customers would purchase the goods. Although both parties' goods are marketed as high-end, upscale items, and are directed to affluent consumers, the identifications of goods do not include any limitations as to price or quality, or classes of purchasers and, we must presume, therefore, that the goods include all types of men's and women's clothing, and all types of wooden flooring, not just of the high-end type. Whether we consider the parties' customers as discriminating or ordinary, there is an overlap in classes of purchasers. This factor favors opposer.

Actual Confusion

Opposer, in response to Request for Admission No. 5, admitted that it was not aware of any instances of actual confusion. However, opposer subsequently pointed to one instance of actual confusion during the time of contemporaneous use of the marks since 2001. Opposer asserts that "[a] purchaser of Applicant's Zanella wood

Opposition No. 91153249

flooring called Opposer with a question about how to match her flooring." (Brief, p. 34). In this connection, opposer, during its rebuttal testimony period, offered the testimony of one of its employees, Dominic Cicero, regarding a single misdirected telephone call.¹³

Applicant has indicated that it is unaware of any actual confusion among the consuming public.

We have considered opposer's testimony to the extent that it shows that one misdirected phone call occurred. When asked how the caller had ascertained opposer's phone number, the caller answered, according to Mr. Cicero, that "she had looked for Zanella on the Internet and had found us there." While opposer urges, not surprisingly, that the reason for the alleged confusion was the similarity between the marks, this contention is speculative; the caller's mistake is, at worst, tantamount to mixing up a trade name in a phone book, and nothing more. We would have preferred to hear testimony from the caller who then could have explained more fully the reason for her misdirected phone call. In the absence of any corroborating evidence about the caller, not to mention the fact that only one

¹³ Applicant initially objected to the testimony as improper rebuttal. Although we are inclined to agree with applicant on this point, applicant proceeded in its brief to discuss this factor on the merits. Likewise, we will consider the testimony as if properly taken.

misdirected call has been identified, we accord virtually no weight to this testimony.

Given the disparate nature of the goods, not to mention the difficulty in obtaining evidence of actual confusion, the lack of evidence relative thereto is not surprising. The applicable test under Section 2(d) is, in any event, likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983).

Accordingly, this factor is neutral.

Intent

Opposer, in a one-half page paragraph at the end of its brief (pp. 35-36), and again in a one-half page in its reply brief (p. 10), leveled a charge that applicant has failed to provide an explanation of how it conceived its ZANELLA mark and that, at the very least, applicant has failed to establish good faith in the selection of its mark. Opposer states that while applicant has failed to provide any explanation of its selection, applicant was apprised of opposer's marks in a trademark search report.

Contrary to opposer's contention, Mr. Salmacia provided a complete explanation regarding applicant's selection of the ZANELLA mark. Applicant thought it was advantageous from a marketing view to promote its new line of distressed hardwood flooring as having an "old world" look and feel,

Opposition No. 91153249

and that applicant originally decided upon the mark STRADELLA. One of applicant's employees considered that this mark had an unsavory connotation in that it sounded like "straddle," and this same employee suggested the present mark that happened to be her best friend's maiden name. After an informal poll of applicant's employees showed a slight preference for ZANELLA, applicant decided on this mark.

Applicant conducted at least two trademark searches during the time it was choosing its mark, and both reports apparently showed opposer's marks. Applicant and applicant's counsel, however, were of the view that there was no likelihood of confusion given the disparity between clothing and hardwood flooring. Applicant also conducted a search of the GOOGLE database; the results showed third-party uses of ZANELLA on other unrelated goods and services. See *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); and *The NASDAQ Stock Market, Inc. v. Antartica, S.R.L.*, 69 USPQ2d 1718 (TTAB 2005).

We find that the record shows no bad faith adoption by applicant of the mark ZANELLA for hardwood flooring. Accordingly, this factor is neutral.

Conclusion

The connection between opposer's clothing and applicant's wooden flooring is so tenuous that the public would not view the goods as having a common source, even when sold under identical marks. Based on the record before us, we see the likelihood of confusion claim asserted by opposer as amounting to only a speculative, theoretical possibility. Language by our primary reviewing court is helpful in resolving the likelihood of confusion controversy in this case:

We 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 Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), *citing* Witco Chemical Co. v. Whitfield Chemical Co., Inc., 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g* 153 USPQ 412 (TTAB 1967).

We have carefully considered all of the evidence pertaining to the relevant du Pont factors, as well as all of the parties' arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion), and we conclude that opposer has not proved its Section 2(d) claim of likelihood of confusion.

Decision: The opposition is dismissed.