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Mailed: August 30, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Metropolitan Trading Co.

Serial No. 76208111

Peter M. de Jonge and Nathan S. Winesett of Thorpe North & Western for Metropolitan Trading Co.

William H. Dawe III, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

Before Walters, Drost and Cataldo, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Metropolitan Trading Co. has filed an application to register on the Principal Register the mark ZODIAC for "clothing, excluding T-shirts; namely; neckties, boas, braces; collars, cuffs; pants, trousers; coats, suits, overcoats, blazers, jerseys, jackets, shorts, bermudas; sweaters, shawls; headwear," in International Class 25.¹

¹ Serial No. 76208111, filed February 9, 2001, based on an allegation of a bona fide intention to use the mark in commerce.

Serial No. 76208111

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark is likely to cause confusion with the registered marks shown below²:

Registration No. 1486193 for the mark shown below for "shoes," in International Class 25³:

A handwritten mark in cursive script that reads "Zodiac". The letter 'Z' is large and loops around the 'o'. The word ends with a long, sweeping underline that extends to the right.

Registration No. 1936302 for the mark ZODIAC for "footwear, namely shoes, boots, clogs, sandals," in International Class 25.⁴

Registration No. 2594860 for the mark shown below for "footwear," in International Class 25⁵:

A stylized, blocky, uppercase font of the word "ZODIAC". The letters are white and set against a solid black rectangular background. The font has a slightly jagged or pixelated appearance.

² The three cited registrations were all owned by the same entity, Bennett Footwear Group LLC; however, the assignment records of the USPTO show recent assignments of only two of these registrations to Brown Shoe Company, Inc. We cannot determine herein if this is an error in recordation or if, in fact, one of the registrations is now owned by a different entity from the other two registrations. Regardless, we have considered the registrations as a group and our analysis of the issue of likelihood of confusion remains the same.

³ This registration issued on April 26, 1988, to Encore Shoe Corporation and was subsequently assigned to Bennett Footwear Group LLC (Section 8 declaration (six-year) accepted; Section 15 declaration acknowledged).

⁴ This registration issued on November 21, 1995, to Bennett Footwear Group LLC and was recently assigned to Brown Shoe Company, Inc. (Renewed; Section 15 declaration acknowledged). Upon renewal, "clothing, namely, T-shirts" was deleted from the identification of goods.

⁵ This registration issued on July 16, 2002 to Bennett Footwear Group LLC and was recently assigned to Brown Shoe Company, Inc.

Applicant has appealed and filed a brief, but did not request an oral hearing. The examining attorney has also filed a brief.

The examining attorney contends that ZODIAC is not a weak mark for clothing and footwear; and that applicant's mark ZODIAC is identical to the standard character mark ZODIAC in cited Registration No. 1936302 and is essentially the same as the marks in the other two cited registrations, stating that the stylizations therein are minimal and of little consequence in the commercial impressions of the marks. Regarding the goods, the examining attorney cites a number of cases in which footwear has been found to be related to various clothing items, and contends that the third-party registrations he has submitted for marks identifying both footwear and items of clothing identical to those in the application support the conclusion that the goods herein may emanate from a single source. He argues, further, that the channels of trade for the respective goods are the same.

Applicant contends that the respective goods are quite different, stating that applicant provides formal menswear, excluding footwear; that registrant is solely in the footwear business; and that the trade channels for the respective goods are different because, even if applicant's clothing and registrant's footwear are sold in department

stores, such items would be sold in different departments physically removed from each other. Regarding the marks, applicant contends that ZODIAC is a commonly used, weak mark, referring to evidence applicant submitted of third-party business names including the term ZODIAC across a broad range of goods and services.⁶ Applicant also submitted evidence from registrant's website to demonstrate that registrant's business pertains only to shoes; and an excerpt from a third-party website showing use of the term ZODIAC for medical and industrial gloves.⁷

Our determination under Section 2(d) is 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. *See 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 Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in

⁶ Applicant submitted with its brief additional evidence in the form of third-party registrations and excerpts from Internet websites. Trademark Rule 2.142(d) provides that the record in an application should be complete prior to the filing of an appeal. While the examining attorney did not expressly object to this evidence, he also did not address the evidence. Therefore, we have given no consideration to this additional evidence improperly filed after appeal.

⁷ Applicant also submitted copies of invoices showing its sales in countries other than the United States. This evidence is irrelevant to our determination of registrability in the United States and has not been considered.

the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We turn, first, to a determination of whether applicant's mark and the registered marks, when viewed in their entireties, are similar in terms of 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 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). 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).

In the case before us, applicant's mark is identical to the mark ZODIAC in standard character form in Registration No. 1936303 and to the word portion of the additionally cited two registrations. Registration No. 1486193 is a stylized script form of the word ZODIAC and Registration No. 2594860 is also a stylized script form of the word ZODIAC within a simple black rectangle. Clearly, the sound and connotation of these marks is identical. The design elements of the marks in the two cited registrations are of minimal significance such that the overall commercial impressions of these two marks and applicant's mark are substantially similar.

Applicant does not argue otherwise, but contends that ZODIAC is a weak mark. As the examining attorney has pointed out, the evidence submitted by applicant in support of this contention appears to pertain to businesses in diverse fields unrelated to either clothing or footwear. And we do not consider applicant's submission of one medical supply company's offering of medical and industrial gloves to render the term ZODIAC a weak mark in the clothing and footwear fields. Rather, based on the evidence in this record, ZODIAC, which is an arbitrary term in connection with the goods involved herein, would appear to be a strong mark for such goods. Therefore, we conclude that

applicant's mark is identical or substantially similar to the cited registered marks.

Turning to consider the goods or services involved in this case, we note that when the marks at issue are the same or nearly so, the goods in question do not have to be identical to find that confusion is likely. As we stated in *In re Concordia International Forwarding Corp.*, 222 USPQ 352, 356 (TTAB 1983), ". . . the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion." It is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

Further, while applicant has made several assertions about the actual nature of its goods and registrant's goods, the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

There is certainly no per se rule governing likelihood of confusion in cases involving footwear and the identified clothing items. The fact that both applicant and the examining attorney have cited cases involving the same or similar goods in support of their respective positions demonstrates the important principle that each case must be decided on its own set of facts. The record herein includes specific evidence of ten third-party marks registered for goods including both footwear and one or more of the identified clothing items.⁸ Although third-party registrations which cover a number of differing goods and/or

⁸ All of the third-party registrations in the record include allegations of use in commerce.

services, and which are based on use in commerce, are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, such registrations nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). It is very likely that purchasers would purchase both the identified clothing items and shoes together and wear such purchases together. We find the third-party registrations adequate to establish that the goods involved in this case may come from a single source.

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, ZODIAC, and registrant's marks, ZODIAC and ZODIAC and design, their contemporaneous use on the goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Decision: The refusal under Section 2(d) of the Act is affirmed.