

This Opinion is Not a
Precedent of the TTAB

Mailed: September 28, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Norková

Serial No. 79199465

Ing. Monika Norková, pro se.

Timothy Schimpf, Trademark Examining Attorney, Law Office 113,
Odette Bonnet, Managing Attorney.

Before Kuczma, Adlin, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Ing. Monika Norková (“Applicant”) filed a request for extension of protection of her International Registration No. 1326206 to the United States through registration on the Principal Register of the mark ZIPZAP in standard characters for “drying racks for laundry; clothes pegs,” in International Class 21.¹

¹ Application Serial No. 79199465 was filed on August 30, 2016 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141(a), on the basis of International Registration No. 1326206, which issued on August 30, 2016.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that it so resembles the registered mark ZIPZAP in standard characters for "scissors, in particular hair cutting scissors, manicure scissors, sheet-metal shears, poultry shears, cable scissors; tree pruning shears; nippers, nail nippers, cuticle nippers; files; utility knives and pliers," in International Class 8,² as to be likely, when used on or in connection with the goods identified in Applicant's application, to cause confusion, to cause mistake, or to deceive.

When the refusal was made final, the application was abandoned, but Applicant revived it, appealed the refusal, and requested reconsideration, which was denied. 4 TTABVue. Applicant and the Examining Attorney have filed briefs. We affirm the refusal to register.

I. Record on Appeal

The record on appeal contains the following:

1. Internet webpages showing the offering on the websites of various retailers of one or more of the goods identified in Applicant's application and one or more of the goods identified in the cited registration, made of record by the Examining Attorney,³ and Applicant;⁴

² Registration No. 3242723 issued on May 15, 2007 under Section 66(a) of the Trademark Act, and has been maintained through the filing of declarations of continued use under Section 71 of the Trademark Act, 15 U.S.C. § 1141k.

³ January 10, 2017 Office Action at 3-10; July 14, 2017 Office Action at 3-55.

⁴ June 23, 2017 Response to Office Action at 4-51.

2. A page from the OXFORD ENGLISH DICTIONARY (oxforddictionaries.com) showing that a search for the word “zipzap” yielded no results, made of record by the Examining Attorney;⁵
3. Internet webpages listing suppliers of clothes pegs, drying racks, and scissors, made of record by Applicant;⁶
4. A definition from the MERRIAM-WEBSTER dictionary (merriam-webster.com) of the term “clothes-peg,” made of record by the Examining Attorney;⁷ and
5. Third-party registrations of marks for one or more of the goods identified in Applicant’s application and one or more of the goods identified in the cited registration, made of record by the Examining Attorney.⁸

II. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under § 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). We consider each *du Pont* factor that is relevant and for which there is record evidence. *See, e.g., M2 Software, Inc. v. M2 Commc’ns, Inc.*,

⁵ January 10, 2017 Office Action at 11.

⁶ *Id.* at 52-75.

⁷ July 14, 2017 Office Action at 2.

⁸ *Id.* at 56-88.

450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015). Two key factors in every § 2(d) case are the similarity or dissimilarity of the marks and the similarity or dissimilarity of the goods, because the “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).

A. Similarity or Dissimilarity of the Marks

The first *du Pont* factor is “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Cliquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quotation omitted).

Applicant’s mark and the cited mark are identical in sound, appearance, connotation, and overall commercial impression, and Applicant does not claim

otherwise. There is no evidence in the record that ZIPZAP has any descriptive or suggestive significance as applied to Applicant's or the registrant's goods,⁹ or that the cited mark has been weakened by third-party use or registration. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135-37 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-76 (Fed. Cir. 2015). "[W]hen word marks are identical but neither suggestive nor descriptive of the goods associated with them, the first *DuPont* factor weighs heavily against the applicant." *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *accord In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017).

B. Similarity or Dissimilarity of the Goods, Channels of Trade, and Classes of Consumers

The second *du Pont* factor concerns the "similarity or dissimilarity and nature of the goods or services as described in an application or registration," *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014), while the third *du Pont* factor "considers '[t]he similarity or dissimilarity of established, likely-to-continue trade channels.'" *Id.* at 1161. Applicant effectively concedes the similarity of the channels of trade, 8 TTABVUE 4-7, and, as discussed below, the evidence shows that they are at least partially identical, so the

⁹ As noted above, the Examining Attorney made of record the results of a search for the word "zipzap" in the OXFORD ENGLISH DICTIONARY (US) (oxforddictionaries.com) showing no entry for that word. January 10, 2017 Office Action at 11.

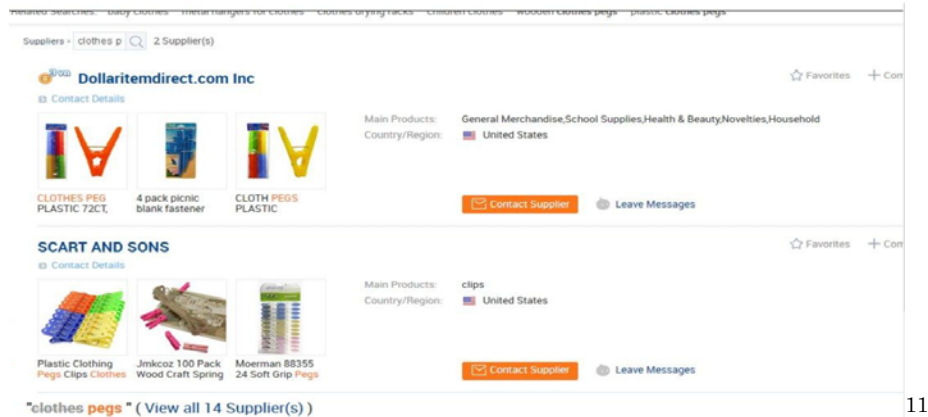
third *du Pont* factor supports a finding of a likelihood of confusion. We thus focus on the second factor.

As indicated, the analysis of this factor is premised on the identifications of goods in the application and in the cited registration. *Stone Lion*, 110 USPQ2d at 1161-63; *Octocom Sys., Inc. v. Houston Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018). The identified goods need not be identical or even competitive to find a likelihood of confusion. *See, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000). “[L]ikelihood of confusion can be found ‘if the respective goods are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs.*, 101 USPQ2d at 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).¹⁰

Because the subject marks are identical, “the degree of similarity between the goods that is required to support a likelihood of confusion declines.” *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff’d*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017) (citation omitted)). “It is only necessary that there be a ‘viable relationship between the goods’ to support a finding of likelihood of confusion.” *Id.* (quoting *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009)).

¹⁰ The refusal to register may be affirmed if there is a likelihood of confusion with respect to either of the goods identified in the application and any of the goods identified in the cited registration. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *FabFitFun*, 127 USPQ2d at 1672.

The goods identified in the application are “drying racks for laundry” and “clothes pegs.” Evidence made of record by Applicant shows that in the United States “clothes pegs” are synonymous with “clothespins”:



The goods identified in the cited registration are “scissors, in particular hair cutting scissors, manicure scissors, sheet-metal shears, poultry shears, cable scissors; tree pruning shears; nippers, nail nippers, cuticle nippers; files; utility knives and pliers.” The words “in particular” that follow the word “scissors” in the first clause in the identification limit those goods to the enumerated “hair cutting scissors, manicure scissors, sheet-metal shears, poultry shears, [and] cable scissors.” See TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) Section 1402.03(a) (Oct. 2017) (“The terms ‘namely,’ ‘consisting of,’ ‘particularly,’ and ‘in particular’ are definite and are preferred to set forth an identification that requires greater particularity”); cf. *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413 n.9 (TTAB 2018) (noting that “the word ‘primarily’ in the registrant’s identification is not the equivalent of the word

¹¹ June 23, 2017 Response to Office Action at 30.

‘namely’ in Applicant’s identification, and does not serve to specify the function of the [registrant’s software] application”).

The Examining Attorney argues that “Applicant’s laundry racks and clothes pegs are similar to the various scissors and pliers identified by registrant,” 10 TTABVUE 7, citing webpages from a number of retailers that he claims establish “that the same entity commonly manufactures the relevant goods and markets the goods under the same mark, and that the relevant goods are sold through the same channels of trade and used by the same classes of customers in the same fields of use.” *Id.* at 7-8. He also points to “a number of third-party marks registered for use in connection with the same or similar goods as those of both applicant and registrant in this case.” *Id.* at 8.

Applicant “is of the opinion that there is no likelihood of confusion because Registrant’s goods (scissors and pliers) and Applicant’s goods (laundry drying racks and clothes pegs) are so different that relevant consumers would not assume that they emanate from the same source.” 8 TTABVUE 4. She argues that the “evidence provided by the Examining Attorney of several large companies manufacturing and selling both Registrant’s goods and Applicant’s goods is not convincing.” *Id.* at 5. According to Applicant, “IKEA, OXO, the Container Store, HOME DEPOT, etc. are companies with large product port folios [sic] covering hundreds of goods. Even if the goods are sold through these channels, there is no evidence to suggest that consumers would be likely to confuse Registrant’s goods with Applicant’s goods.” *Id.* The issue, of course, “is not whether purchasers would confuse the goods, but whether there is

a likelihood of confusion as to the source of the goods,” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1188 (TTAB 2018), but Applicant further argues that “[t]here also isn’t strong evidence to suggest that Applicant’s goods and Registrant’s goods are viewed in a public [sic] as goods commonly manufactured by the same companies, so the consumers would not be confused as to the origin/source of the Applicant’s and registrant’s goods.” 8 TTABVUE 5-6. She claims that there is virtually no overlap between companies that produce the goods identified in the application and companies that produce the goods identified in the cited registration, *id.* at 6, and concludes that the “differences in goods (their purpose, use, production and supply) outweigh other factors, such as similarity of the marks, or similarity of the trade channels.” *Id.* at 7.

We turn first to the Examining Attorney’s third-party registration evidence.

Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may 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.

In re Aquamar, Inc., 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (quotation and citations omitted). The Examining Attorney made of record eight use-based, third-party registrations of marks for one of the goods identified in the application, and one or more of the goods identified in the cited registration.¹² Applicant acknowledges

¹² July 14, 2017 Office Action at 56-71, 75-89 (Registration No. 2157201 covering “scissors,” “combination pliers,” and “clothes drying racks;” Registration No. 3127353 covering “scissors” and “clothes drying racks;” Registration No. 3792273 covering “scissors” and “dryer racks,

these registrations,¹³ but argues that “this number is miniscule compared to trademarks registered for use in connection with Registrant’s goods only, or trademarks registered for use in connection with Applicant’s goods only (that is without overlap between Registrant’s goods and Applicant’s goods).” 8 TTABVUE 6. This argument is unavailing. Applicant cites no authority supporting the relevance of the comparison that she makes, and, in any event, there is no evidence regarding the number of registrations of marks for the separate goods.¹⁴ We find that the third-party registrations are probative of the relatedness of the goods. *Aquamar*, 115 USPQ2d at 1126 n.5.

Internet evidence showing the sale of the subject goods on the same websites may be more probative of relatedness. *Id.*; see also *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009). We must scrutinize such evidence closely, however, because the “law is that products should not be deemed related simply because they are sold in the same kinds of establishments.” *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) (citing *Federated Foods*, 192 USPQ at 29) (a

namely, clothes hanging dryer racks;” Registration No. 3876837 covering “scissors” and “clothes drying racks;” Registration No. 4489152 covering “pliers,” “scissors,” and “clothes drying racks;” Registration No. 4568856 covering “scissors” and “clothes drying racks;” Registration No. 4522720 covering “scissors for household use” and “clothes drying racks;” and Registration No. 4706390 covering “pruning scissors,” “pliers,” and “clothes racks, for drying”). The goods identified in these registrations as “scissors” and “scissors for household use” encompass one or more of the specific types of scissors identified in the cited registration.

¹³ In fact, she states that there “a few dozen trademarks, registered for use in connection with both Registrant’s goods and Applicant’s good [sic].” 8 TTABVUE 6.

¹⁴ The Board does not take judicial notice of third-party registrations. *In re Olin Corp.*, 122 USPQ2d 1322, 1335 n.22 (TTAB 2017) (citing *In re Jonathan Drew Inc.*, 97 USPQ2d 1640, 1644 n.11 (TTAB 2011)).

“wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer” and the “mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on *any* goods so displayed”). These brick-and-mortar world principles apply with equal force online. As Professor McCarthy puts it, the “argument that the goods are ‘related’ . . . because they are both marketed over the Internet . . . suffers from the same fallacy as the old ‘under the same roof’ argument.” 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:53.50 (5th ed. 2018).

The Examining Attorney made of record pages from the websites of quintessential “big box” retailers such as Target and Walmart, home and office supply stores such as IKEA, The Container Store, Oxo, Jam, Williams Sonoma, and Antique Farm House, and other retailers.¹⁵ Applicant made of record pages from the websites of The Home Depot, The Container Store, IKEA, alibaba.com, and thomasnet.com.¹⁶

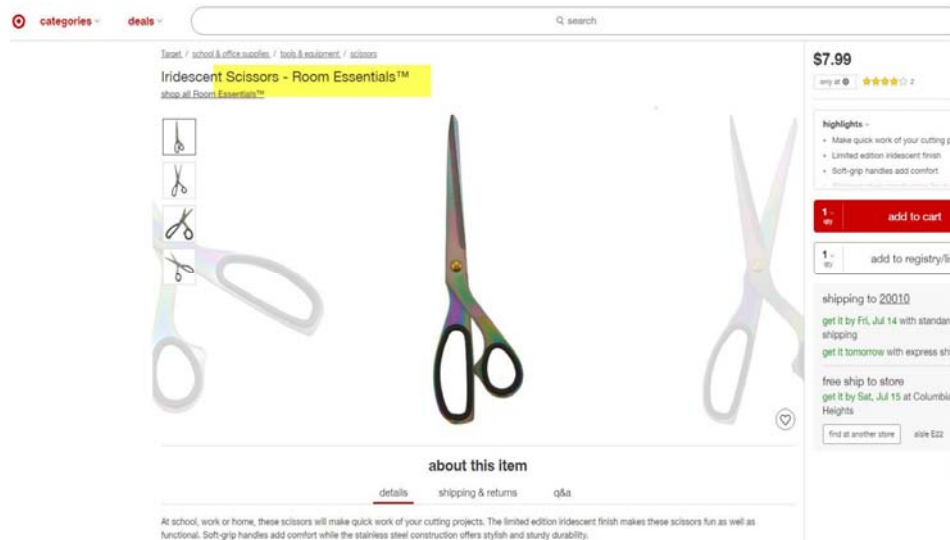
As noted above, the Examining Attorney argues that the online sale of the subject goods by retailers shows that those goods are “commonly manufactured by the same companies and sold in the same channels of trade.” 10 TTABVUE 7. All of the Internet evidence shows the online sale of the subject goods “in the same channels of trade,”

¹⁵ January 10, 2017 Office Action at 3-10, 13-15; July 14, 2017 Office Action at 3-55.

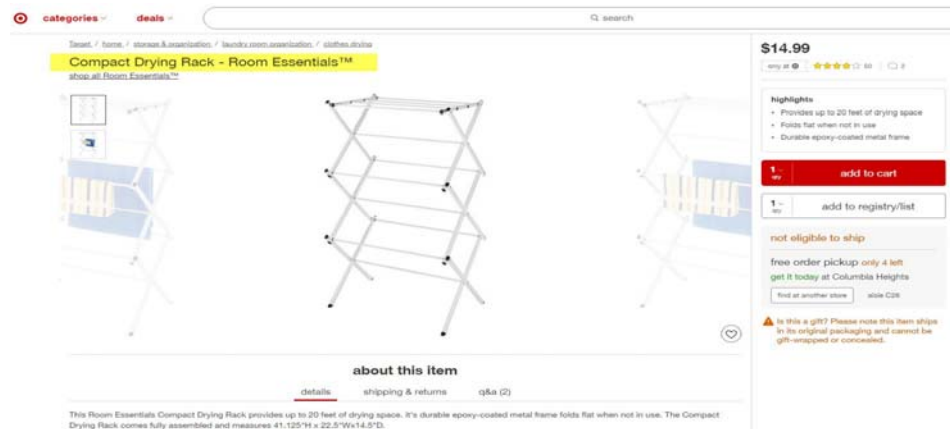
¹⁶ June 23, 2017 Response to Office Action at 4-75.

id., a point that Applicant does not dispute, and several of the websites show the sale of the subject goods under the same mark.

Target offers scissors, clothes drying racks, and clothespins under the mark “Room Essentials”:



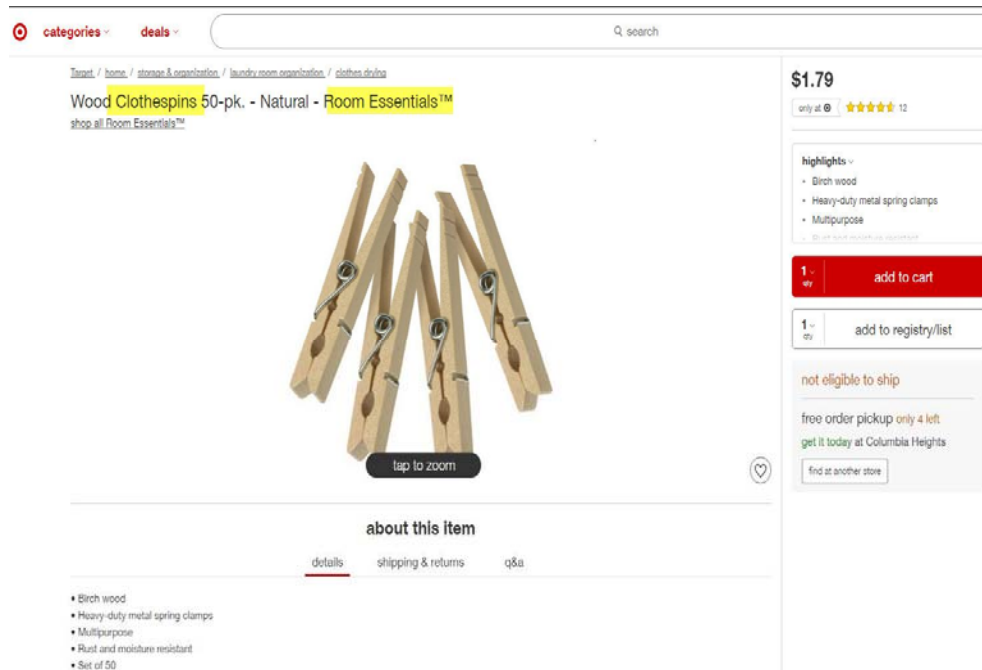
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¹⁷ July 14, 2017 Office Action at 16. These scissors are characterized as usable at “school, work or home,” and they could be used in the manner of one or more of the particular types of scissors identified in the cited registration.

¹⁸ *Id.* at 17-19.



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Walmart offers utility scissors, drying racks, and clothespins under the mark “Mainstays”:



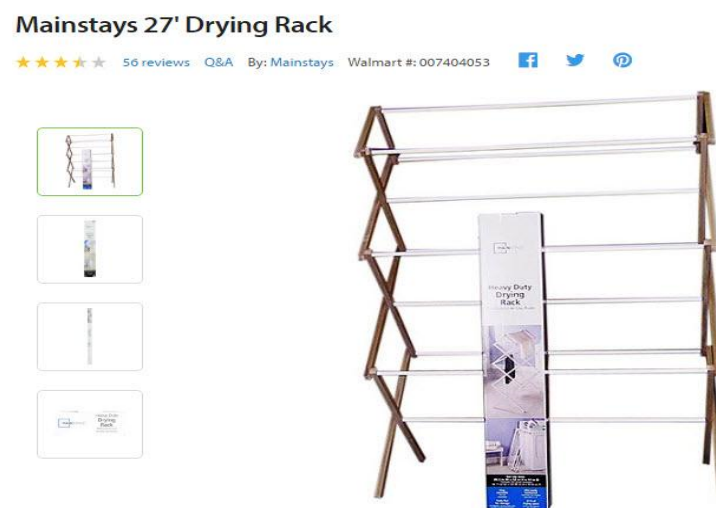
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¹⁹ *Id.* at 20.

²⁰ *Id.* at 28. “Utility scissors” could be used in the manner of one or more of the particular types of scissors identified in the cited registration.



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Oxo offers kitchen and herb scissors and folding clip dryer racks under the mark
Good Grips:

²¹ *Id.* at 34.

²² *Id.* at 40.



OXO
GOOD
GRIPS

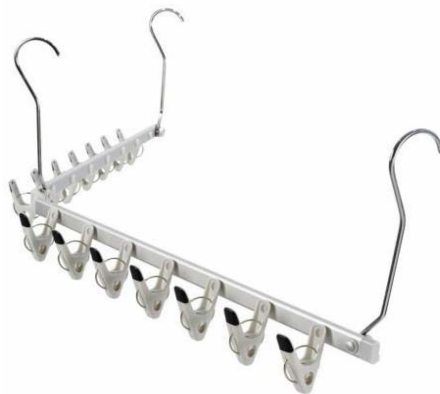
Kitchen And Herb Scissors

\$17.99

A handy kitchen must-have that's a cut above other scissors

Keep these Kitchen and Herb Scissors handy for cutting meat, veggies, twine and more. The soft handles feature cushioned pads to absorb pressure. The herb stripper above the handles removes fresh herbs from tough stems, and the micro-serrated blades separate for easy cleaning.

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OXO
GOOD
GRIPS

Folding Clip Dryer

\$21.99

Hang-dry in tight spaces with this convenient rail and hooks

Hang the Folding Clip Dryer from a shower rod (even a curved or corner rod) by its 3 secure hooks. The 14 non-slip clips keep clothes hanging on. Clips won't tangle, and are designed for fast and easy loading and unloading. The Folding Clip Dryer folds in half and snaps closed for compact storage.

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Williams Sonoma offers kitchen shears and clothes drying racks under its WILLIAMS SONOMA house mark for retail store services and its WILLIAMS SONOMA mark for kitchen shears:

²³ January 10, 2017 Office Action at 14.

²⁴ *Id.* at 10.

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²⁵ July 14, 2017 Office Action at 6.

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subject goods emanate from the same source under the same mark. Applicant does not directly dispute this, but rather argues that the subject goods are not offered together on the same webpages (and, presumably, in the same sections of stores), or “bought by the same consumers in the same fields of use,” and that there is no evidence that the same companies actually manufacture the goods. 8 TTABVUE 5-6. These arguments are unpersuasive.

The fact that the goods are not displayed together, either online or in brick-and-mortar world outlets, “does not gainsay a likelihood of confusion. The crucial question here is whether source confusion is likely. As to that, whether or not the goods are displayed close together or far apart in the same store is immaterial.” *Helen Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 n.10 (TTAB 1989) (citation omitted) (finding shoes and hair care products to be related).

With respect to the classes of consumers, the identifications of goods in the application and in the cited registration contain no restrictions or limitations, so we must presume that the goods are purchased by all ordinary purchasers for such goods. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). The identifications of the goods, and the record evidence of their sale through stores such as Walmart, Target, The Home Depot, Williams Sonoma, and IKEA, show that the goods may be used for various household and personal tasks such as grooming, doing laundry, preparing food, and making home repairs, and, accordingly, we infer that the goods are purchased by members of the general public who use the goods in their daily lives. The fact that the goods may not be purchased at the same time, or for the same “fields

of use,” does not establish that ordinary consumers would not view them as originating from the same source when sold under identical marks.

Finally, even assuming, as Applicant claims, 8 TTABVUE 6, that the subject goods are not manufactured by the same companies, the record shows that they are sold under the same marks, such as Mainstays, Room Essentials, and Good Grips, in what appear to be situations “when a dealer buys goods from a manufacturer and applies or has someone else apply the dealer’s own ‘merchant’s mark’ to the goods” *UVeritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242, 1250 (TTAB 2015). The use of the same merchants’ marks for the goods is probative of their relatedness.

Taken together, the Internet evidence and the third-party registrations are sufficient to establish at least a viable relationship between the goods. *Aquamar*, 115 USPQ2d at 1126 n.5; *Davey Prods.*, 92 USPQ2d at 1203; *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355-56 (TTAB 2015) (although five third-party registrations covering the subject goods were “limited in number,” they were probative of relatedness when “considered in conjunction with the Internet evidence” submitted by the examining attorney). The second *du Pont* factor supports a finding of a likelihood of confusion.

C. Conclusion

Each of the relevant *du Pont* factors considered supports a finding of a likelihood of confusion. The marks are identical, there is at least a viable relationship between the goods, and the channels of trade and classes of purchasers are at least partially the same. Applicant’s use of the ZIPZAP mark for the goods identified in the

application is likely to cause confusion with the identical ZIPZAP mark for the goods identified in the cited registration.

Decision: The refusal to register is affirmed.