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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sunton Enterprises Inc.

Serial No. 85253147

Howard A. MacCord, Jr. for Sunton Enterprises Inc.

Tricia Sonneborn, Trademark Examining Attorney, Law Office
110 (Chris A. F. Pedersen, Managing Attorney).

Before Seeherman, Cataldo and Wolfson, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Sunton Enterprises Inc. has appealed from the refusal of the trademark examining attorney to register the mark AY LAZZARO, in standard characters, for "handbags; trunks" in Class 18.¹ Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark so resembles the mark LAZZARO, in standard characters, registered for "handbags,

¹ Application Serial No. 85253147, filed February 28, 2011, based on Section 1(a) of the Trademark Act, and asserting first use and first use in commerce as early as July 1, 2010.

briefcases, briefcase-type portfolios, wallets" in Class 18² that, as used on applicant's identified goods, it is likely to cause confusion or mistake or to deceive.

We affirm the refusal.

Our determination of the issue of likelihood of confusion 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 & 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, 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).

Turning first to the goods, both the identification for applicant's application and the identification for the cited registration include "handbags." As a result, the goods are, in part, legally identical. Further, because

² Registration No. 3204972, issued February 6, 2007; Section 8 affidavit accepted; Section 15 affidavit acknowledged. The registration also includes "leather jackets, leather coats, pants and skirts" in Class 25, but this class of goods in the registration does not form the basis for the refusal.

the goods are legally identical, they are presumed to travel in the same channels of trade and be sold to the same classes of consumers. In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994). These two du Pont factors favor a finding of likelihood of confusion.³

We now consider the du Pont factor of the similarity of the marks, keeping in mind that "[w]hen marks would appear on virtually identical goods or services, the degree of similarity 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). Here, of course, the goods are in part legally identical. Further, in comparing the marks, we recognize that "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 Services Inc. v. Triumph Learning LLC, 668 F.3d 1356,

³ The examining attorney has also submitted evidence showing the relatedness of "trunks," identified in the application, and briefcases, handbags and wallets, identified in the cited registration. In view of the legal identity of "handbags," however, we need not recite the details of this evidence. See Tuxedo Monopoly, Inc. v. General Mills Fun Group, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application).

101 USPQ2d 1713, 1721 (Fed. Cir. 2012), quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007). Finally, we note the well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood 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 a consideration of the marks in their entireties. In *re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant's mark is AY LAZZARO; the cited mark is LAZARO. The LAZZARO portion of applicant's mark is nearly identical to the cited mark, differing only by an additional "Z" in applicant's mark. This additional letter, however, does not distinguish the marks in appearance, as it is buried in the middle of the term, next to another letter "Z." Consumers are not likely to note or remember this difference. Nor does it affect the pronunciation of LAZZARO/LAZARO. The real question is whether the additional element AY in applicant's mark is sufficient to distinguish the marks. In considering this question, we must examine the meaning or effect of AY in the mark. During the course of examination, the examining

attorney requested that applicant provide a translation of AY, noting that the English translation of the Spanish interjection "ay" is "oh." Applicant responded that the letters AY represent the initials of applicant's owner. Response filed November 29, 2011. As a result, the examining attorney withdrew the requirement for a translation.

In its brief, applicant states that "consumers do not know that AY stands for the initials of the applicant's owner," brief, p. 7, but later apparently contradicts the statement that consumers would not know that meaning by saying that AY references a particular individual and therefore that the mark conveys a "significantly different connotation from LAZARO." Id. at 11.

We agree that consumers are unlikely to view the letters AY in applicant's mark as referencing an individual named Au Yeung. However, because LAZZARO can be a surname (see webpage from House of Names.com website, listing "Lazzaro" as a spelling variation of the family name "Lazaro," submitted by applicant in its November 29, 2011 response to Office action), consumers may view AY LAZZARO as an individual's name, consisting of initials for the given names, followed by the surname. The manner in which the mark is depicted in the specimen, as reproduced below,

Ser. No. 85253147

with the A and Y in capital letters, followed by Lazzaro with an initial capital and then lower case, reinforces this impression.



It is also possible that, as the examining attorney originally thought, consumers will view AY as a Spanish word, so that the mark would be understood as "Oh Lazzaro." In either case, the name LAZZARO must be considered the dominant part of the mark, and be given more weight in the comparison of the marks. Merely because AY is the first part of the mark does not automatically make it dominant.

In either case, the name LAZZARO in applicant's mark will be perceived as a surname. Further, consumers who are familiar with the registrant's handbags sold under the mark LAZZARO are likely to view AY LAZZARO as a variation of the LAZZARO mark, either providing further information as to the initials of the individual with the surname LAZZARO, or as

an interjection emphasizing the name LAZZARO.⁴ As a result, the connotations and the commercial impressions of the marks are similar.

The du Pont factor of the similarity of the marks favors a finding of likelihood of confusion.

In reaching this conclusion, we have considered applicant's arguments regarding the strength of the cited registration, and specifically third-party use. In its brief, applicant states that with its response filed on November 29, 2011 it submitted evidence of websites showing LAZARO as a mark for wedding dresses and for a collection of handbags. However, the November 29, 2011 submission includes no such evidence. At best, there is a webpage identifying an individual named Lazaro Perez as a bridal collection designer, and a third-party registration for LAZARO for wedding gowns, listing "Jim Hjelm, a Private Collection, Inc." as the registrant. The third-party registration is not evidence of use of the mark, and the fact that there is a fashion designer name Lazaro Perez

⁴ We do not suggest that the registered mark should be considered primarily merely a surname. The registration issued on the Principal Register without resort to the provisions of Section 2(f). Further, the evidence of record in the current application shows that LAZARO can be a given name as well as a surname, a point that applicant acknowledges. However, when consumers who are aware of the registrant's mark see applicant's mark, because LAZZARO is used in applicant's mark in the manner of a surname, they will ascribe a surname significance to the cited mark.

does not show third-party use of a similar *mark* on similar goods. The sixth du Pont factor, i.e., the number and nature of similar marks in use on similar goods, must therefore be considered neutral.⁵

Applicant also points out that "to the extent that a customer is likely to exercise a high degree of care and/or sophistication when selecting goods or services, the less chance that confusion, mistake, or deception will occur between two or more competing marks." Brief, p. 13. We have no quarrel with applicant's statement of this principle. However, there is no evidence of record that shows that all handbags are expensive, or will be the subject of careful purchase, or be bought by sophisticated purchasers. On the contrary, handbags are items that are purchased and used by most women in the United States, including those that will exercise only a normal degree of care in making their purchases. Such purchasers are not likely to notice the presence or absence of an additional Z in LAZARO and LAZARRO. We accept that they will note the additional element AY in applicant's mark; however, consumers familiar with the cited mark LAZARO for handbags

⁵ We note that with its request for reconsideration, filed June 20, 2012, applicant stated that it was submitting evidence of third-party use, but no such evidence was actually submitted. The examining attorney pointed this out in the July 10, 2012 Office action denying the request for reconsideration, but applicant did not attempt to submit the evidence in response.

Ser. No. 85253147

are likely, when they see AY LAZZARO on handbags, to view this difference as a variation of the cited mark LAZZARO rather than as a mark indicating a different source for the goods. Therefore, any care that consumers exercise in purchasing the handbags is not sufficient, in view of the similarity of the marks and the legal identity of the goods, to obviate the likelihood of confusion.

Decision: The refusal of registration is affirmed.