

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Oral Hearing Held: September 29, 2021

Mailed: April 13, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Industria de Diseno Textil, S.A. (Inditex, S.A.)

v.

Benzara Inc.

Opposition Nos. 91242880 (parent) and 91246000¹

Ross Q. Panko of Arent Fox LLP,
for Industria de Diseno Textil, S.A. (Inditex, S.A.)

Anthony M. Verna III of Verna Law PC,
for Benzara Inc.

Before Zervas, Lynch, and Pologeorgis,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Benzara Inc. (“Applicant”) filed two applications, namely, application Serial Nos. 87691792 and 87830596, each seeking to register on the Principal Register the

¹ Opposition No. 91242860 was consolidated with Opposition No. 91246000 by Board order dated August 25, 2017. *See* 13 TTABVUE in Opposition No. 91242880. Accordingly, we decide each opposition in this single decision. *See* Fed. R. Civ. P. 42(a). Unless otherwise specified, all TTABVUE citations in this decision reference the docket in the parent case, i.e., Opposition No. 91242880.

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standard character mark BENZARA. The identification of goods in application Serial No. 87691792 solely identifies “furniture” in International Class 20.² Application Serial No. 87830596 identifies “Leather accessory boxes for jewelry; Jewelry cases not of precious metal; Wooden jewelry boxes; Statues primarily of precious metal and also including glass” in International Class 14 and “Desktop statuary made of ceramics; Serving Trays; Candle Holders; Cake Stands; Napkin holders; Serving bowls; Toilet tissue holders” in International Class 21.³

Industria de Diseno Textil, S.A. (Inditex, S.A.) (“Opposer”) opposes the registration of Applicant’s BENZARA mark in each application on the grounds of (1) likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); and (2) dilution by blurring and tarnishment under Section 43(c) of the Trademark Act; 15 U.S.C. § 1125(c).⁴ In support of its asserted claims, Opposer has pleaded ownership of the following registrations for the standard character marks ZARA and ZARA HOME:⁵

² Filed on November 20, 2017, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming January 1, 2010 as the date of first use and January 7, 2012 as the date of first use in commerce. This application is subject to Opposition No. 91242880. This application does not include a translation statement.

³ Filed on March 12, 2018, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming January 1, 2010 as the date of first use and January 7, 2012 as the date of first use in commerce for each class of goods. This application is subject to Opposition No. 91246000. The application includes the following translation statement: “The English translation of ‘BENZARA’ in the mark is ‘gypsy’ or ‘warrior’.”

⁴ See Opposer’s Notice of Opposition, 2 TTABVue in both Opposition Nos. 91242880 and 91246000.

⁵ All of Opposer’s pleaded registrations include the following translation statement: “The English translation of ‘ZARA’ is ‘maize’ or ‘Indian corn’.”

<u>Reg. No.</u>	<u>Mark</u>	<u>Relevant Goods/Services</u>
1922163 ⁶	ZARA	Accessories, namely, belts, neckwear, scarves, shawls, headwear, gloves, hosiery, in Class 25.
2603674 ⁷	ZARA	Furniture; wooden and plastic storage and decorative boxes; straw and wooden baskets, in Class 20.
2956372 ⁸	ZARA	Fabrics and textile products composed of natural and synthetic fibers, namely, bath towels; and bed and table linens, in Class 24.
2987219 ⁹	ZARA HOME (HOME disclaimed)	Various clothing items, in Class 25; jewelry boxes not of metal, in Class 20; decorative porcelain and earthenware in the nature of statuary, figurines, ornaments, plates, vases and bowls, in Class 21.
4030529 ¹⁰	ZARA	Jewelry cases, in Class 14; figurines of wood, wax, plaster or plastic, in Class 20; statues and statuettes of porcelain, earthenware or glass and bowls, in Class 21.
4586706 ¹¹	ZARA HOME	Online retail store services available

⁶ Issued September 26, 1995; renewed.

⁷ Issued August 6, 2002; renewed.

⁸ Issued May 31, 2005; renewed.

⁹ Issued August 23, 2005; renewed.

¹⁰ Issued September 27, 2011; renewed.

¹¹ Issued on August 19, 2014; renewed.

<u>Reg. No.</u>	<u>Mark</u>	<u>Relevant Goods/Services</u>
	(HOME disclaimed)	through other electronic means, all featuring clothing and fashion accessories, footwear, personal care products, paper products and stationery products, luggage, leather goods and bags, textiles and home furnishings, toys, housewares, and hardware, in Class 35.
5614476 ¹²	ZARA	Jewelry and jewelry cases, in Class 14; furniture, in Class 20; serving trays and napkin holders, in Class 21.

In each of its answers to the notices of opposition, Applicant denied the salient allegations asserted therein.¹³ Additionally, Applicant asserted various amplifications to its denials, i.e., the marks are spelled and pronounced differently and have differing commercial impressions, the goods are radically different, etc.¹⁴ Because they are not true affirmative defenses, we do not address them as such. *The Mars Generation, Inc. v. Carson*, 2021 USPQ2d 1057, at *4 (TTAB 2021); *see also DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *1 (TTAB 2020) (mere amplifications of the applicant’s denials not considered as separate affirmative defenses).

¹² Issued November 27, 2018.

¹³ *See* Applicant’s Answers, 5 TTABVUE in both Opposition Nos. 91242880 and 91246000.

¹⁴ *Id.*

I. The Record

The record includes the pleadings in each opposition and, pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's involved application files. The record also includes the evidence summarized below.

A. Opposer's Evidence

1. Testimony Declaration of Dilip Patel ("Patel Decl."), President of Zara USA, Inc. ("Opposer's U.S. subsidiary"),¹⁵ and the following accompanying exhibits: (a) status and title copies of Opposer's pleaded registrations; (b) images of the wide variety of products sold by Opposer under its pleaded marks; (c) various advertisements of goods sold by Opposer under its pleaded marks; (d) copies of Opposer's catalogs of goods sold under Opposer's pleaded marks; (e) screenshots from Opposer's Twitter, Facebook, Instagram, YouTube and Pinterest pages; (f) copies of news articles purportedly concerning the popularity of Opposer's websites and social media pages; (g) copies of brand ranking reports concerning Opposer's ZARA brand; (h) copies of unsolicited media coverage of Opposer's goods under its pleaded marks; (i) copies of articles concerning celebrities wearing and discussing Opposer's ZARA clothing goods; (j) copies of articles discussing Opposer's purportedly successful partnerships with Joe Malone London and Smeg S.p.A; (k) copies of press coverage regarding Opposer's charitable efforts; (l) copies of Board decisions of proceedings brought by Opposer against third parties purportedly demonstrating Opposer's policing efforts of its pleaded marks; (m) copies of settlement agreements with the aforementioned third parties; and (n) copy of Opposer's cease and desist letter to Applicant.
2. Opposer's Notice of Reliance on the following: (a) status and title copy of Opposer's pleaded registrations for its ZARA and ZARA HOME marks;¹⁶ (b) printouts from the PTO TESS website and

¹⁵ 24 TTABVUE (unredacted version); 25 TTABVUE (redacted version); 25-29 TTABVUE (accompanying exhibits); 38 TTABVUE (bulky exhibits).

¹⁶ 30 TTABVUE. It was unnecessary for Opposer to resubmit status and title copies of its pleaded registrations under its notice of reliance when it already had submitted them as exhibits to Mr. Patel's testimony declaration. The Board discourages the practice of the

the Board's TTABVUE website showing notices of opposition filed by Opposer to enforce its rights in its ZARA and ZARA HOME marks;¹⁷ (c) Applicant's response to Opposer's First Set of Interrogatories, First set of Requests for Admission, and pages from the discovery deposition of Applicant's 30(b)(6) deponent;¹⁸ printouts from various websites and news articles to demonstrate Opposer's priority of use, relatedness of the goods at issue, use of its pleaded marks, and purported fame of its pleaded;¹⁹

3. Opposer's Rebuttal Notice of Reliance on various websites and periodicals to demonstrate (a) the relatedness of the parties' goods, (b) services offered under Opposer's pleaded marks, and (c) products sold under Opposer's pleaded marks.²⁰

B. Applicant's Evidence

1. Notice of reliance on the following: (a) status and title copies of its involved applications;²¹ (b) Applicant's interrogatory and documents requests and Opposer's responses thereto;²² (c) numerous screenshots from Applicant's www.benzara.com website, as well as various screenshots from third-party retail websites;²³ (d) Google search results for the term "benzara";²⁴ and (e) various documents produced by Opposer pursuant to Applicant's document requests.²⁵

submission of duplicative evidence. *See e.g., ITC Entm't Group Ltd. v. Nintendo of Am. Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (filing duplicative submissions is a waste of time and resources, and is a burden on the Board).

¹⁷ 31 TTABVUE.

¹⁸ 32 TTABVUE.

¹⁹ 33-35 TTABVUE.

²⁰ 52 TTABVUE.

²¹ 41 TTABVUE. It was unnecessary for Applicant to submit status and title copies of its involved applications because they are automatically of record under Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b).

²² 42 TTABVUE.

²³ 43 TTABVUE.

²⁴ 44 TTABVUE.

²⁵ 45, 48 and 51 TTABVUE (includes redacted documents); 46-47, 50 TTABVUE; 49 TTABVUE (filed under seal as confidential).

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Applicant did not submit any testimony.

We note that some of the evidence proffered by the parties has been designated confidential and filed under seal. We have discussed only in general terms the relevant evidence submitted under seal, if necessary and appropriate. However, to the extent either party has improperly designated testimony and evidence as confidential, we have disregarded the confidential designation when appropriate. Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g) (“[t]he Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.”); *see also Kohler Co. v. Honda Giken K.K.*, 125 USPQ2d 1468, 1475 (TTAB 2017) (citing *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1416 n.21 (TTAB 2016)); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014).

We additionally note that the parties have submitted under notice of reliance printouts from various websites. Although admissible for what they show on their face, *see* Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2), these webpages also contain hearsay that may not be relied upon for the truth of the matters asserted unless supported by testimony or other evidence. Fed. R. Evid. 801(c); *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1038 (TTAB 2018); *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1039-40 (TTAB 2010); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 704.08(b) (2021) (“The probative value of Internet documents is limited. They can be used to

demonstrate what the documents show on their face. However, documents obtained through the Internet may not be used to demonstrate the truth of what has been printed.”).

II. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action, formerly referred to as “standing” by the Federal Circuit and the Board, is an element of the plaintiff’s case in every inter partes case.²⁶ See *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020), *reh’g en banc denied* 981 F.3d 1083, 2020 USPQ2d 11438 (Fed. Cir. 2020), *cert. denied*, __ S.Ct. __, 2021 WL 4507693 (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Corcamore*, 2020 USPQ2d 11277 at *4. See also *Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982); *Spanishtown Enters.*, 2020 USPQ2d 11388, at *1.

²⁶ Even though we now refer to standing as entitlement to a statutory cause of action, our prior decisions and those of the Federal Circuit interpreting “standing” under §§ 1063 and 1064 of the Trademark Act remain applicable. See *Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

Because Opposer's pleaded registrations are of record, Opposer has met the requirements for establishing a statutory cause of action to oppose Applicant's involved applications. *See N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015) (citing *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000)). These registrations form the basis for a likelihood of confusion claim under 15 U.S.C. § 1052(d) that is not wholly without merit.²⁷ *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). *See also Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727-28 (Fed. Cir. 2012). Applicant does not dispute Opposer's entitlement to a statutory cause of action in either opposition of this consolidated case.

III. Section 2(d) Claim – Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). To prevail on its Section 2(d) claim, Opposer must prove, by a

²⁷ Because Opposer has established its entitlement to a statutory cause of action for its asserted likelihood of confusion claim, it automatically has established its entitlement to assert its dilution by blurring and tarnishment claims. *See A&H Sportswear Co. v. Yedor*, 2019 USPQ2d 111513, at *3 (TTAB 2019) (“Having demonstrated standing on this ground, Opposer may assert any other valid basis for refusal.”); *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009) (“If an opposer can show standing as to one ground, it has the right to assert any other ground as well.”).

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preponderance of the evidence, that it has priority in the use of its pleaded marks and that use of Applicant's mark is likely to cause confusion, mistake, or deception as to the source or sponsorship of Applicant's identified goods. *Cunningham*, 55 USPQ2d at 1848.

A. Priority

Because Opposer's pleaded registrations for the standard character marks ZARA and ZARA HOME are of record, priority is not an issue with respect to the goods and services identified these pleaded registrations. *See Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108,110 (CCPA 1974)).

B. Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (*DuPont*). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor for which there is evidence and argument of record. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26

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USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”).

1. Similarity of the Goods

We first address the second *DuPont* likelihood of confusion factor focusing on the comparison of the goods identified in Applicant’s applications vis-à-vis the goods identified in Opposer’s pleaded registrations. *See e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The identity of certain goods within the identifications means that no more is necessary to demonstrate a finding of similarity of goods to support a likelihood of confusion. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 938-39 (Fed. Cir. 1983) (holding that a single good from among several may sustain a finding of likelihood of confusion); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 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 or services in the application).

Here, Opposer’s pleaded Registration Nos. 2603674 and 5614476, each for the standard character mark ZARA, list, among other things, “furniture,” which is identical to the goods identified in Applicant’s involved application Serial No. 8769172. Similarly, Opposer’s pleaded Registration No. 5614476 lists, inter alia, “serving trays,” “napkin holders,” and “toilet roll holders” in Class 21 which are also

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identified in Applicant's involved application Serial No. 87830596. Additionally, Opposer's pleaded Registration Nos. 4030529 and 5614476, each for the standard character mark ZARA, list, among other things, "jewelry cases" in Class 14 which is sufficiently broad enough to encompass "Leather accessory boxes for jewelry; Jewelry cases not of precious metal; Wooden jewelry boxes" identified in Applicant's application Serial No. 87830596. Finally, "statues and statuettes of porcelain, earthenware or glass" listed in Opposer's pleaded Registration No. 4030529 are, in part, identical to "Statues primarily of precious metal and also including glass" identified in Applicant's application Serial No. 87830596.

Thus, the parties' goods are legally identical in part. Therefore, the second *DuPont* factor strongly favors a finding of likelihood of confusion.

2. Similarity of Trade Channels/Classes of Purchasers

The third *DuPont* factor considers "[t]he similarity or dissimilarity of established, likely-to-continue trade channels." *DuPont*, 177 USPQ at 567. Here, there are no trade channel or class of purchaser limitations in either Applicant's identifications of goods or Opposer's identifications of goods set forth in its pleaded registrations. Thus, because Opposer's and Applicant's goods are legally identical in part, we presume that Opposer's goods and Applicant's goods travel through identical channels of trade and are offered to same normal potential purchasers for such goods. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018), *aff'd mem.*, (No. 18-2236)

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(Fed. Cir. September 13, 2019) (“Because the services described in the application and the cited registration are identical, we presume that the channels of trade and classes of purchasers are the same.”).

Thus, the third *DuPont* factor also weighs heavily in favor of a finding of likelihood of confusion.

3. Strength of Opposer’s ZARA and ZARA HOME Marks

“In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition.” *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017) (citing *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014)); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”).

a. Conceptual Strength

With regard to the conceptual strength of Opposer’s ZARA and ZARA HOME marks, we note that Opposer’s pleaded registrations for these marks were issued on the Principal Register without a showing of acquired distinctiveness under Section 2(f) of the Trademark Act. Accordingly, because no challenge to the lack of inherent distinctiveness of Opposer’s ZARA and ZARA HOME has been lodged by Applicant, we find Opposer’s ZARA and ZARA HOME marks, when viewed in their entirety, are inherently distinctive and, therefore, they should be entitled to the normal scope of protection accorded inherently distinctive marks.

The Federal Circuit, however, has held that if there is evidence that a mark, or an element of a mark, is commonly adopted by many different registrants in a particular field, that may indicate that the common element has some non-source identifying significance which undermines its conceptual strength as an indicator of a single source. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ ... that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak’”) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)).

Here, there are no third-party registrations of record for marks that comprise, in whole or in part, Opposer’s ZARA and ZARA HOME marks for goods identical or similar to those listed in Opposer’s pleaded registrations. Thus, there is no evidence to demonstrate that Opposer’s pleaded marks are conceptually weak; rather, we find that Opposer’s pleaded ZARA and ZARA HOME marks are conceptually strong.

b. Commercial Strength of Opposer’s ZARA and ZARA HOME Marks

Opposer argues that its ZARA marks are famous and commercially strong.²⁸ Commercial strength “may be measured indirectly by the volume of sales and

²⁸ Opposer’s Trial Brief, pp. 18-19; 29 TTABVUE 25-26.

advertising expenditures in connection with the [goods or] services sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the [goods or] services identified by the mark []; and the general reputation of the [goods or] services.” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017).

i. Fame – 5th DuPont Factor

The fifth *DuPont* factor (fame) examines the extent to which the public perceives the mark as indicating a single source of origin. *DuPont*, 177 USPQ at 567. A famous or commercially strong mark is one that has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1172 (TTAB 2011) (fame or commercial strength is “based on the marketplace recognition value of the mark.”). “Fame of an opposer’s mark, if it exists, plays a ‘dominant role in the process of balancing the DuPont factors.’” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). Famous marks enjoy a “wide latitude of legal protection since they are more likely to be remembered and associated in the public mind than weaker marks.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ.2d 1689, 1694 (Fed. Cir. 2005).

Fame, in the likelihood of confusion context, “varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 22 USPQ2d 1733, 1734 (Fed. Cir. 2017). In view of the extreme deference that is accorded a famous mark in terms of the wide latitude of legal protection it

receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to prove it clearly. *North Face Apparel Corp. v. Sanyang Indus. Co. Ltd.*, 116 USPQ2d 1217, 1226 (TTAB 2015). It is important to note that fame for likelihood of confusion purposes and fame for dilution purposes are distinct concepts. *See Palm Bay Imps.*, 73 USPQ2d at 1692. Unlike for dilution, fame for likelihood of confusion purposes does not require the opposer to show fame among every segment of the U.S. population. Rather, fame for likelihood of confusion purposes arises as long as a “significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Id.* at 1694.

We further note that “[a]ll courts agree that ‘stronger’ marks are given ‘stronger’ protection -- protection over a wider range of related products and services and variations on visual and aural format.” *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) (“A strong mark ... casts a long shadow which competitors must avoid. ... Thus, the Lanham Act’s tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark’s fame increases, the Act’s tolerance for similarities in competing marks falls.”); 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:73 (5th ed. Sept. 2021).

To demonstrate the fame or commercial strength of its ZARA and ZARA HOME marks in connection with the goods and services listed in its pleaded registrations, Opposer submitted a variety of evidence. The evidence of record shows:

- that since 1989, Opposer has continuously and exclusively used its

ZARA mark in U.S. commerce.²⁹

- In 2003, Opposer launched its ZARA HOME brand in Spain. In 2007, www.zarahome.com became Opposer's first online store. In October 2012, Opposer expanded its use of www.zarahome.com to offer ZARA HOME products to consumers in the United States.³⁰
- Opposer's U.S. sales of goods sold under its ZARA marks between the years 2014 and 2019, the details of which are confidential, have been quite significant and impressive.³¹
- From 2014-2018, Opposer's advertising expenditures worldwide for the goods sold under its ZARA mark have been sizable, but its global advertising expenditures for its ZARA HOME mark were not as substantial.³²
- Opposer sells its products under the ZARA marks through its ZARA brick-and mortar stores, through the websites www.zara.com/us, www.zarahome.com/us, and www.instagram.com/zara/, through the ZARA and ZARA HOME mobile phone applications, and through other authorized sellers. All of Opposer's ZARA stores, and its ZARA and ZARA HOME websites and mobile apps prominently display the

²⁹ Patel Decl., ¶ 12 (redacted version); (25 TTABVUE 5).

³⁰ *Id.* at ¶ 14 (redacted version); (25 TTABVUE 5).

³¹ *Id.* at ¶ 18 (confidential version) (24 TTABVUE 7).

³² *Id.* at ¶ 24 (confidential version) (24 TTABVUE 8).

ZARA Marks.³³

- Opposer has received unsolicited accolades from general news publications, i.e., articles in the New York Times Magazine and Forbes describe the ZARA brand as the “World’s Largest Fashion Retailer” and one of the “World’s Most Valuable Brands, respectively.³⁴ Products sold under the ZARA HOME mark have also been featured in Architectural Digest, which described a ZARA HOME campaign as “stunning.”³⁵ Fashion Network calls ZARA a “giant” in fast-fashion, and Business Insider declared ZARA “one of the best-known and most successful fashion brands in the world.”³⁶
- Industry reports have ranked the ZARA brand among the most valuable, namely, in 2017, the ZARA brand ranked No. 42 in BrandZ’s Top 100 Most Valuable Global Brands and No. 24 in Interbrand’s Best Global Brands, and in those reports ZARA was also ranked as the No. 2 apparel brand in the world.³⁷
- In 2019, Opposer’s www.zara.com website received more than

³³ *Id.* at ¶ 19 (redacted version) (25 TTABVUE 7).

³⁴ *Id.* at ¶ 37 and accompanying Exh. 8 (redacted version) (25 TTABVUE 10 and 28 TTABVUE 43-44 and 107-115).

³⁵ *Id.*

³⁶ *Id.* ¶¶ 36-37 & accompanying Exh. 7-8 (redacted version) (24 TTABVUE and 28 TTABVUE 51, 69-70, 107).

³⁷ *Id.* at ¶ 36 and accompanying Exhibit 7 (redacted version) (25 TTABVUE 10 and 28 TTABVUE 2-102).

2,326,923,838 unique visits, and its www.zarahome.com website received more than 2,146,848 unique visits.³⁸

- Opposer’s www.zara.com website has been recognized as one of the most valuable visited e-commerce sites.³⁹
- Opposer distributes ZARA and ZARA HOME electronic catalogues to consumers on a seasonal basis, via a newsletter. Currently, the ZARA newsletter is distributed to approximately 1,175,900 U.S. consumers and the ZARA HOME newsletter is distributed to more than 95,000 U.S. consumers.⁴⁰
- In 2019, there were approximately 1,432,822 downloads of Opposer’s ZARA mobile application in the United States.
- As of September 2020, the ZARA Instagram page had approximately 40.5 million followers, the ZARA Facebook page had more than 28 million “likes” and “follows,” the ZARA Twitter page had approximately 1.3 million followers; the ZARA Pinterest page had approximately 1 million followers;
- As of September 2020, there were approximately 6.1 million followers on ZARA HOME’s Instagram page, and more than 2.6 million “likes” and “follows” on its Facebook page;

³⁸ *Id.* at ¶ 24 (redacted version) (25 TTABVUE).

³⁹ *Id.* at ¶ 35 and accompanying Exh. 6 (redacted version) (25 TTABVUE and 27 TTABVUE 399)).

⁴⁰ *Id.* at ¶ 28 (redacted version) (25 TTABVUE 8-9).

- Opposer’s social media pages for the ZARA and ZARA HOME brands has been recognized in numerous independent media reports, i.e., ZARA is described as one of the “best brands on Instagram,” the third highest “apparel brand[] with the most Facebook fans” as of February 2018, and the sixth highest fashion brand by number of Instagram followers as of December 2017.⁴¹
- Many celebrities have been photographed in, or in connection with, ZARA apparel, including singer and actress Selena Gomez; actresses Katie Holmes, Sienna Miller and January Jones; models Bella Hadid and Emily Ratjkowski; First Lady Melania Trump; Duchess of Cambridge Kate Middleton and her sister, Pippa Middleton; Queen Letizia Rocasolano of Spain; and fashion designer Olivia Palermo.⁴²

Opposer argues that the foregoing sales, brand rankings, advertising, and promotional and publicity clearly demonstrate that Opposer’s ZARA marks are famous.

Viewing Opposer’s commercial strength evidence in its totality, we make the following observations. We initially note that the length of time Opposer has used its ZARA and ZARA HOME marks in U.S. commerce for the goods and services listed in its pleaded registrations, standing alone, is insufficient to establish that its marks have achieved such commercial renown that it may be considered a very strong mark.

⁴¹ *Id.* at ¶ 36 and accompanying Exhs. 6-7 (27 TTABVUE 377-409 and 28 TTABVUE 2-41).

⁴² *Id.* at ¶ 38 and accompanying Exh. 9 (redacted version) (25 TTABVUE 10 and 28 TTABVUE 126-399).

We next note that while Opposer's U.S. sales numbers are quite impressive, Opposer failed to delineate which sales are attributed to its fashion/clothing line offered under its pleaded ZARA mark versus which sales are attributed to the furniture and home furnishings sold under its pleaded ZARA HOME mark. Similarly, Opposer failed to identify how many dollars were spent on U.S. advertising for its ZARA fashion line and its ZARA HOME furniture and home furnishings in the United States; instead, Opposer merely provided its worldwide advertising figures. Without this breakdown in U.S. sales and U.S. advertising figures, it is difficult to ascertain the consumer exposure of Opposer's ZARA and ZARA HOME marks individually in the United States. Additionally, although the record demonstrates that Opposer has had extensive traffic on its social media platforms, Opposer failed to identify how many of those visits, "likes," "follows," and retweets are by U.S. consumers. As such, this evidence has diminished value because it is likely that non-U.S. consumers are included in the total number of social media traffic, particularly in light of the fact that Opposer has a global brand.

That being said, we note that the record demonstrates that Opposer's ZARA brand for its clothing line has received a tremendous amount of unsolicited accolades and has been named a top clothing brand by the industry. Additionally, Opposer's mobile application for its ZARA clothing line has been downloaded by over a million U.S. customers.

Based on the totality of the evidence submitted by Opposer, we find that Opposer has demonstrated that its ZARA mark has attained significant commercial success

and renown when used in association with its clothing and fashion line. In contrast, however, we find, on this record, that Opposer's ZARA HOME mark used in connection with its home furnishings has attained a modest amount of commercial strength or renown.

ii. Similar Marks on Similar Goods – 6th *DuPont* Factor

We next address the sixth *DuPont* factor, the number and nature of similar marks in use on similar goods. *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1033 (TTAB 2016). Because there is no evidence of record showing third-party use of marks identical or similar to Opposer's pleaded marks for goods similar to those of Opposer, the sixth *DuPont* factor is neutral in our likelihood of confusion analysis.⁴³

In sum, we find, based on the record, that although Opposer's ZARA mark has obtained significant commercial success and renown with respect to Opposer's clothing line, the evidence only demonstrates that the fame of the ZARA mark falls on the strong end of the fame spectrum, but not on the very strong end of the spectrum, for likelihood of confusion purposes. We additionally find that Opposer's ZARA HOME mark for its furniture and home furnishings has attained only a modest level of commercial renown and success.

4. Similarity of the Marks

We next consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay*

⁴³ Applicant's Notice of Reliance, Exhs. 101-122; 20 TTABVUE 12-101.

Imports, Inc., 73 USPQ2d at 1691. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d at 1746 (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. Sept. 13, 2019)). “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.” *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (quoting *Coach Servs.*, 101 USPQ2d at 1721).

Because this factor is based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, there is nothing improper in assigning more or less weight to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Nat’l Data*, 224 USPQ at 751.

Opposer’s marks subject to its pleaded registrations are ZARA and ZARA HOME in standard characters. Applicant’s involved mark is BENZARA also in standard characters. We initially find that consumers will focus more on the ZARA portion of

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Opposer's pleaded ZARA HOME mark as the source-indicator for the goods and services listed in Opposer's ZARA HOME registrations. This especially holds true since the inclusion of the descriptive, if not generic, and disclaimed wording HOME in Opposer's ZARA HOME mark would be perceived by relevant consumers as less significant or less dominant when viewing the this mark. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP § 1207.01(b)(viii). Moreover, the first part of a mark is most likely to be impressed upon the mind of a purchaser and remembered when making purchasing decisions. *See Palm Bay Imps.*, 73 USPQ2d at 1692.

Here, Applicant has appropriated the entirety of Opposer's ZARA mark, as well as the dominant portion of Opposer's ZARA HOME mark, as part of its own mark. Likelihood of confusion is often found where the entirety of one mark is incorporated within another. *See Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL LANCER confusingly similar to BENGAL); *Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT confusingly similar to CONCEPT); *Johnson Publ'g Co. v. Int'l Dev. Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY confusingly similar to EBONY DRUM for cosmetic products); *In re Denisi*, 225 USPQ 624, 626 (TTAB 1985) (PERRY'S PIZZA confusingly similar to PERRY'S for restaurants); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (MACHO COMBOS confusingly similar to MACHO).

We further note that while Applicant's mark begins with the prefix "BEN," and while we acknowledge, as previously noted, that it is often said that the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered when making purchasing decisions, see *Palm Bay Imps.*, 73 USPQ2d at 1692, the mere addition of a prefix to an already existing mark, as is the case here, may be insufficient to avoid a finding of likelihood of confusion. See, e.g., *Caterpillar Tractor Co. v. Gehl Co.*, 177 USPQ 343, 344–45 (TTAB 1973) (HYDRA-CAT and CAT confusingly similar where applicant incorporated the entirety of opposer's CAT mark and added the prefix "HYDRA"); *Dap, Inc. v. Canfor Ltd.*, 182 USPQ 626, 628 (TTAB 1974) (HI-DAP and DAP confusingly similar where applicant wholly incorporated the opposer's mark "DAP" and merely added the prefix "HI"); *Unimed, Inc. v. Warner-Lambert Pharm. Co.*, 151 USPQ 434, 434–35 (TTAB 1966) (URALGIC and ALGIC confusingly similar where the applicant wholly incorporated the registrant's "ALGIC" mark and added the prefix "UR").

Applicant argues that the marks have differing connotations and overall commercial impressions sufficient to avoid a finding of likelihood of confusion.⁴⁴ To

⁴⁴ Applicant's Trial Brief, p. 11 (55 TTABVUE 12). Applicant also argues that BENZARA identifies a certain historical nomadic trading tribe who may have origins in the Mewar region of what is now Rajasthan, India. In support of this argument, Applicant submitted a hyperlink to a Wiktionary article. *Id.* This evidence, however, cannot be considered because it was untimely submitted with Applicant's brief. See *Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at *2 (TTAB 2020) (exhibits attached to brief not considered); *Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1116 (TTAB 2009) ("Evidence submitted outside of the trial periods - including that attached to briefs - is untimely, and will not be considered.") (quoting *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008)). Even if this evidence were timely submitted at trial, a the submission of a hyperlink alone is not sufficient to make the contents of the website of record. *In re HSB Solomon*

that end, we acknowledge that Opposer has provided a translation statement of its ZARA mark to mean “maize” or “Indian corn,” and Applicant has provided a translation statement of the term BENZARA in one of its involved applications to mean ‘gypsy’ or ‘warrior.’ However, neither party provided evidence that consumers would be familiar with the languages from which these purported foreign terms are translated. In any event, as with disclaimers and descriptions of the mark set forth in an application, relevant consumers would almost certainly be unaware of the translation statement of record, and would not be influenced by that fact in their understanding of either Opposer’s or Applicant’s marks. *Cf. Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1355 (Fed. Cir. 2004) (“confusion is evaluated from the perspective of the purchasing public, which is not aware that certain words or phrases have been disclaimed” in a registration); *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at *11 n.38 (TTAB 2020) (“consumers are unaware of the descriptions [of the mark set forth in applications]”). We additionally note that neither of the parties’ respective marks has any meaning in English and would be perceived as arbitrary terms by English speakers.

Further, because Applicant’s applied-for mark is displayed in standard characters, likelihood of confusion could arise if Applicant’s mark is displayed in a manner that emphasizes the “ZARA” portion of it, such as displaying the “BEN”

Assocs., LLC, 102 USPQ2d 1269, 1274 (TTAB 2012) (“a reference to a website's internet address is not sufficient to make the content of that website or any pages from that website of record”).

portion of its mark in a color, size or font that gives it less prominence than the “ZARA” portion of its mark.⁴⁵ Quite simply, we find that the marks are similar, particularly taking into account “the recollection of the average customer, who retains a general rather than specific impression of marks,” *i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018), and the fact that the “marks ‘must be considered . . . in light of the fallibility of human memory’ and ‘not on the basis of side-by-side comparison.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977)).

In sum, while we have not overlooked the wording HOME in one of Opposer’s pleaded marks or the prefix “BEN” in Applicant’s mark, we nonetheless find that marks are more similar than dissimilar, particularly in light of the commercial and conceptual strength of Opposer’s pleaded ZARA mark. Thus, the first *DuPont* factor favors a finding of likelihood of confusion.

⁴⁵ While we must consider any stylization, color or font display of Applicant’s proposed standard character mark in our likelihood of confusion analysis, we do note that the record shows that Applicant uses its BENZARA mark in the following manner:



. See Applicant’s Notice of Reliance, Exhs. 1-32 (43 TTABVUE 12-30). Clearly, Applicant is emphasizing the two letter “a”s in the “zara” suffix of its mark by displaying those letters in a two color tone manner. As such, it would be reasonable for a relevant consumer to be drawn to the “zara” suffix portion of Applicant’s mark.

5. Sophistication of Consumers

“The fourth *DuPont* factor considers ‘[t]he conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *Stone Lion*, 110 USPQ2d at 1162 (quoting *DuPont*, 177 USPQ at 567). Applicant argues that the consumers of both Opposer’s and Applicant’s home furnishings and furniture exercise a high degree of care demonstrated by a careful comparison and evaluation with other products in the field.⁴⁶ Applicant also argues that the furniture products of Opposer and Applicant are expensive and, therefore, purchasers of these goods are likely to be sophisticated and are not likely to purchase these goods based on impulse.⁴⁷

First, there is no evidence that the consumers of the goods sold under Opposer’s and Applicant’s marks are sophisticated. Such lack of evidence militates against giving weight to purchaser sophistication factor. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991) (“no evidence to suggest that purchasers of ... [involved] goods are any more sophisticated than purchasers of any other retail goods.”). Second, as noted above, there are no restrictions as to class of purchasers or price points in either Opposer’s or Applicant’s identification of goods. Thus, we cannot resort to extrinsic evidence pointed to by Applicant to restrict the price of Opposer’s or Applicant’s goods. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the

⁴⁶ Applicant’s Trial Brief, pp. 13-14 (55 TTABVUE 14-15).

⁴⁷ *Id.*

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application or registration). In this regard, we note that furniture is a product purchased by ordinary consumers in all income levels with varying degrees of sophistication. As such, we must consider the least sophisticated consumers, which here will include general consumers of furniture and other home furnishings. *See Stone Lion*, 110 USPQ2d at 1163 (affirming that TTAB properly considered all potential purchasers for recited services, including both sophisticated and unsophisticated investors, since precedent requires consumer care for likelihood-of-confusion decision be based “on the least sophisticated potential purchasers”).

Thus, the fourth *DuPont* factor is neutral.

6. Nature and Extent of Any Actual Confusion/Length of Time During and Conditions Under Which There Has Been Concurrent Use Without Evidence of Actual Confusion.

We next turn to the seventh *DuPont* factor (nature and extent of any actual confusion) and the related eighth *DuPont* factor (extent of the opportunity for actual confusion), raised by Applicant in its trial brief.⁴⁸

No evidence of actual confusion was submitted. The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period of time in the same markets as those served by Opposer under its mark. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative,

⁴⁸ *Id.* at pp. 16-17 (55 TTABVUE 18-19).

there must have been a reasonable opportunity for confusion to have occurred. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“[T]he absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring”).

Here, Applicant has not submitted any evidence demonstrating the length of time Applicant has used its BENZARA mark in commerce⁴⁹ or the amount of sales or advertising of its identified goods. Thus, it is impossible to ascertain the extent of consumer exposure or recognition of Applicant’s mark so as to make a determination whether any real opportunity for actual confusion to have occurred.

Accordingly, we find the seventh and eighth *DuPont* factors to be neutral.

⁴⁹ Applicant is not entitled to rely on the dates of use alleged in its applications, but rather such dates must be proven. Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e); *UMG Recordings, Inc. v. O'Rourke*, 92 USPQ2d 1042, 1047 (TTAB 2009) (dates of use not evidence); *Lasek & Miller Associates v. Rubin*, 201 USPQ 831, 833 n.3 (TTAB 1978) (petitioner’s application is proof only of filing, not of any facts alleged in the application). Additionally, although Applicant contends that there has been a period of four years of concurrent use with no actual confusion, see Applicant’s Brief, p. 16 (55 TTABVUE 18), this is mere argument and does not constitute evidence of the extent of Applicant’s use of its involved mark. See *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (“Attorney argument is no substitute for evidence.”) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)); see also *United States Playing Card Co. v. Harbro LLC*, 81 USPQ2d 1537, 1542 (TTAB 2006) (Board must base its decision on the evidence of record, and not on mere argument of counsel).

7. Market Interface

Applicant argues that Opposer has not shown any market interface between Opposer's marks and Applicant's mark.⁵⁰ It appears that Applicant may have a misunderstanding as to the nature of the *DuPont* factor regarding market interface.

The tenth *DuPont* factor requires us to consider evidence pertaining to the "market interface" between the parties, including evidence of any past dealings between the parties which might be indicative of a lack of confusion in the present case. Most decisions involving this factor address an agreement between the parties that evinces their business-driven conclusion and belief that there is no likelihood of confusion, and weighs heavily in favor of a finding that confusion is not likely. *In re Opus One Inc.*, 60 USPQ2d 1812, 1820 (TTAB 2001); *see also Bongrain Int'l (Am.) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1 USPQ2d 1775, 1778 (Fed. Cir. 1987) ("[I]n trademark cases involving agreements reflecting parties' views on the likelihood of confusion in the marketplace, ... such agreements may, depending on the circumstances, carry great weight ..."). *Compare The Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1641 (TTAB 2007) ("Applicant has not explained how the agreement "negates" the likelihood of confusion and we do not find that it does.").

Here, there is no evidence of record concerning any agreement between the parties which may be indicative of a lack of confusion. In other words, there is no evidence of any type of understanding or arrangement between the parties that demonstrates that confusion is not likely to result from the contemporaneous use of the parties'

⁵⁰ Applicant's Appeal Brief, pp. 16-17 (55 TTABVUE 18-19).

respective marks in commerce. Thus, we find the market interface *DuPont* factor to be neutral.

8. Applicant's Right to Exclude Others from Using its Mark

The eleventh *DuPont* factor considers any evidence that Applicant has a right to exclude third parties from using its mark. Because Applicant has not provided any information about the advertising and sales of its goods sold under its BENZARA mark, and because there is no evidence that Applicant has successfully asserted its rights so as to “exclude” third parties from using its mark,⁵¹ this *DuPont* factor also is neutral. *See, e.g., DeVivo*, 2020 USPQ2d 10153, at *15 (citing *McDonald's Corp. v. McSweet LLC*, 112 USPQ2d 1268, 1284-85 (TTAB 2014) (“Applicant’s sales figures and Applicant’s advertising and promotional expenditures are not sufficient to establish an appreciable level of consumer recognition.”) (internal citation omitted)).

IV. Conclusion

We have considered all of the parties’ arguments and evidence of record, and all relevant *DuPont* factors. We find that the marks at issue are similar, especially in light of the conceptual and commercial strength of Opposer’s ZARA mark; that Opposer’s goods are legally identical in part to Applicant’s goods; that they would move in overlapping trade channels; and that they are offered to the same or overlapping classes of purchasers. We thus find that Opposer has established by a preponderance of the evidence that Applicant’s BENZARA mark for its identified

⁵¹ In fact, Applicant has admitted that it has not had a chance to exclude others from use of its involved BENZARA mark. *See* Applicant’s Brief, p. 17 (55 TTABVUE 18).

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goods so resembles Opposer's ZARA and ZARA HOME marks for its goods as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

In view of our finding that there is a likelihood of confusion between Opposer's ZARA and ZARA HOME marks and Applicant's BENZARA mark, we need not reach the merits of Opposer's remaining pleaded claim of dilution by blurring or tarnishment. *See Multisorb Techs., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013) ("Like the federal courts, the Board has generally used its discretion to decide only those claims necessary to enter judgment and dispose of the case. . . [T]he Board's determination of registrability does not require, in every instance, decision on every pleaded claim.").

Decision: The oppositions are sustained as to the likelihood of confusion claim under Section 2(d) of the Trademark Act with regard to both of Applicant's involved applications and, therefore, registration to Applicant is refused.