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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BumBum Bacana Bodywear Corp.

Serial No. 78454842

Daniel S. Polley of Daniel S Polley, P.A. for BumBum Bacana Bodywear Corp.

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Before Bucher, Zervas and Cataldo, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On July 22, 2004, BumBum Bacana Bodywear Corp. ("applicant") filed an application to register the mark



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on the Principal Register for goods ultimately identified as "pants, shirts, jackets, capris, tops, shorts, skirts, [and] unitards, sold in gyms, health clubs, and sportswear stores" in International Class 25. The literal element of the mark claimed by applicant is BUMBUM BACANA. Applicant has claimed dates of first use anywhere and first use in commerce on April 1, 2003. Also, applicant has entered a statement into the record providing that the foreign wording in the mark translates into English as "cool."

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the previously registered mark BACANA (in standard character form) for "beachwear, shoes and swim wear" in International Class 25.¹ The registration includes the following statement: "The English translation of the word BACANA is 'cool,' as in the American English slang, with the meaning 'very good,' 'excellent,' or 'fashionable.'"

Applicant has appealed the final refusal of its application. Both applicant and the examining attorney have filed briefs. As discussed below, the refusal to register is affirmed.

¹ Registration No. 3056439, issued January 31, 2006.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first address the *du Pont* factor regarding the similarity or dissimilarity of the goods as identified in the application and in the cited registration. Registrant's identification of goods includes "beachwear", which is broadly defined in *The Random House Dictionary of the English Language* (2d ed. unabridged 1987) as "clothing for wear at a beach, swimming pool, or the like."² Applicant's identification of goods includes for its clothing items the trade channel limitation "sold in gyms, health clubs and sportswear stores." Although applicant

² We take judicial notice of this definition. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (the Board may take judicial notice of dictionary definitions).

argues that registrant's goods would not be sold in "gyms, health clubs and sportswear stores," we disagree and find that at a minimum, t-shirts, tops and shorts which are suitable "for wear at a beach" would also be sold in "gyms, health clubs, and sportswear stores." Thus, we find that some of applicant's goods are encompassed within registrant's "beachwear," even if sold in gyms, health clubs and sportswear stores.

As to applicant's remaining goods, i.e., pants, jackets, capris, skirts and unitards sold in gyms, health clubs and sportswear stores, we find that they are sufficiently similar or related to registrant's goods. Applicant's goods consist of clothing items sold in gyms, health clubs and sportswear stores. They hence are suited to the sporting and fitness fields. Registrant's "shoes" are not limited to particular types of shoes, and necessarily include athletic shoes that could be sold in gyms, health clubs and sportswear stores. Thus, applicant's pants, jackets, capris, skirts and unitards are likely to be sold next to registrant's athletic shoes, in gyms, health clubs and sportswear stores. Moreover, the Board has found athletic shoes to be related to athletic clothing. *See Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992) (court affirmed

Board's holding of likelihood of confusion between Kangaroo (and design) for clothing, namely, athletic shoes, sweatsuits and athletic shirts and KANGOL (and design) for golf shirts having collars). See also *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991) (stylized ESSENTIALS for women's shoes v. ESSENTIALS for women's clothing, namely, pants, blouses, shorts and jackets).

Thus, because applicant's goods are encompassed within or related to registrant's goods, we resolve the *du Pont* factor regarding the similarity or dissimilarity of the goods against applicant.

With respect to the *du Pont* factor regarding trade channels, we note that registrant's identification of goods is not limited to particular trade channels. Our determination of the issue of likelihood of confusion must be made on the basis of the goods as they are identified in the involved registration; because there are no trade channel limitations in the identification, we presume that the registration encompasses all goods of the nature and type described, and that the identified goods move in all channels of trade that would be normal for such goods, and that they are available to all classes of purchasers for the described goods. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Accordingly, we find that applicant's goods sold in gyms, health clubs and sportswear stores travel in the same trade channels as those of registrant's goods which would be sold in gyms, health clubs and sportswear stores. This certainly would be the case with respect to applicant's shorts, tops and t-shirts, which are encompassed within registrant's identification of goods. The *du Pont* factor regarding trade channels weighs in favor of finding a likelihood of confusion.

We turn next to the *du Pont* factor regarding the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra*. The test, under this *du Pont* factor, 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 impression that confusion as to the source of the goods 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). Finally, in cases such as this, where some of applicant's goods are

encompassed within some of the goods identified in the cited registration, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

We initially turn to applicant's main arguments regarding the marks. First, applicant has argued that registrant's mark must be considered highly suggestive in view of the translation of BACANA as "cool," "very good," "excellent" or "fashionable." Brief at p. 3. We are not convinced that U.S. consumers would translate BACANA; there is no evidence in the record showing the number of persons in the United States who understand Portuguese, and particularly Portuguese slang words.³ Rather, we find that U.S. consumers will likely consider BACANA as merely a

³ If BACANA in registrant's mark should be translated, so should BACANA in applicant's mark. We question, however, whether applicant would want U.S. consumers to translate its mark. "Bumbum" is a Portuguese slang expression for "bum," i.e., "buttocks." See Portuguese definition of the English word "bum" and English definition of the Portuguese word "bumbum" in the online version of *Collins Portuguese Dictionary* located at credoreference.com, of which we also take judicial notice. "Bacana" is translated in *A Portuguese English Dictionary*, Stanford Univ. Press, (1958) as "(adj., slang) smart, elegant; first-rate, 'tops.'" (We have also taken judicial notice of this definition of "bacana.") "Bacana" evidently is a slang expression in Portuguese. Thus, applying the dictionary definitions, one translation of applicant's entire mark could be "first rate buttocks."

foreign sounding term which is arbitrary in the context of the goods. See *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245 (TTAB 1987) ("To the majority of consumers in the United States who do not understand Spanish, the term would not be understood but would convey a vague Spanish connotation").

Second, applicant has argued that "the BumBum portion of Applicant's word mark is the more distinctive portion and the portion of Applicant's mark having the most source identifying significance" because BUMBUM is positioned above BACANA and in larger lettering than BACANA. Brief at p 3. We disagree. BACANA is not in such smaller letters or in a location where it has significantly less prominence in applicant's mark in comparison to BUMBUM. Given the overall design of the mark, consumers could easily perceive BACANA as a house mark or a primary mark, similar to POLO or PERRY ELLIS, with BUMBUM identifying a particular line of clothing, e.g., sportswear. See *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988) (the addition of matter such as a house mark, primary mark or other material to one of two otherwise similar marks, will not necessarily be sufficient to distinguish the marks as a whole). Thus, while BACANA is in smaller lettering than BUMBUM and positioned underneath BUMBUM, BACANA still

plays a significant role in forming the overall appearance and commercial impression of applicant's mark.⁴

When we consider applicant's mark as a whole, with the foregoing in mind, we find the marks to be similar in sound and appearance, due to the shared term BACANA. Although the marks are not identical in appearance and sound due to the presence of BUMBUM in applicant's mark, that point of dissimilarity does not suffice to overcome the similarity in appearance and sound which results from the presence of BACANA in both marks. The addition of BUMBUM to registrant's mark does not impart any special meaning to applicant's mark and hence does not distinguish the connotation of applicant's mark from that of the cited registered mark. In terms of overall commercial impression, we find the marks to be similar too because they both include the term BACANA, which, as indicated above, has no significance to U.S. purchasers other than as a foreign sounding term.

⁴ The oval background in applicant's mark would likely be considered a background element which adds little to the overall commercial impression of the mark. Plain geometric designs are generally not seen by consumers as particularly distinctive elements. *In re Anton/Bauer Inc.*, 7 USPQ2d 1380, 1381 (TTAB 1988) ("In particular, common geometric shapes such as circles, ovals, triangles, diamonds and stars, when used as backgrounds for the display of word or letter marks, are not regarded as trademarks for the goods to which they are applied absent evidence of distinctiveness of the design alone").

Thus, in viewing the marks in their entireties, we find that they are similar rather than dissimilar. They certainly are sufficiently similar that confusion is likely to result if the marks are used on legally identical goods traveling in the same trade channels, as they are/do in this case. See *Century 21 Real Estate Corp. v. Century Life of America*, supra. The first *du Pont* factor therefore weighs in favor of a finding of likelihood of confusion.

In short, we find that the marks are similar, and that the goods and trade channels are legally identical. Based on these findings under the relevant *du Pont* factors, we conclude that a likelihood of confusion exists. Applicant's arguments to the contrary are not persuasive.

Decision: The refusal to register under Section 2(d) is affirmed.