

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Mailed: March 6, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re B YOU Productions, LLC

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Serial No. 78678426

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David L. Odom of Akin Gump Strauss Hauer & Feld LLP for B  
YOU Productions, LLC.

David Collier, Trademark Examining Attorney, Law Office 104  
(Chris Doninger, Managing Attorney).

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Before Seeherman, Rogers and Cataldo,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by B YOU Productions LLC to register on the Principal Register the mark BYOU in standard character form for the following goods, as amended: "clothing, namely fitness and athletic clothing for young women, namely, yoga pants; fitness tank tops; athletic bra tops; fitness bras; athletic socks; athletic footwear, athletic shoes; athletic shorts; bandanas; wristbands, headbands; sweat pants, sweat shirts; swimwear;

light weight cotton shorts, light weight cotton shirts; sports tank tops" in International Class 25.<sup>1</sup>

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as used on or in connection with its goods, so resembles the mark NOW B YOU, previously registered on the Principal Register in typed or standard character form for "clothing, namely, T-shirts, sweaters, tops, hats, socks, slacks, jeans, shorts, sport shirts and outerwear, namely, coats and jackets; and clothing accessories, namely, belts and scarves" in International Class 25,<sup>2</sup> as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs on the issue under appeal.

#### **Likelihood of Confusion**

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

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<sup>1</sup> Application Serial No. 78678426 was filed on July 26, 2005, based upon applicant's assertion of its bona fide intent to use the mark in commerce on or in connection with the goods.

<sup>2</sup> Registration No. 2803905 issued on January 13, 2004.

1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (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, 27 (CCPA 1976).

The Goods and Their Channels of Trade

We begin by considering the second and third *du Pont* factors, namely, the relatedness of the goods and their channels of trade. As a preliminary matter, we note that applicant, in its brief, seeks to clarify that the limiting language "clothing, namely fitness and athletic clothing for young women, namely," applies to all of the goods subsequently listed in the identification, and not only to "yoga pants" by virtue of the location of the semi-colons separating the other goods. In the alternative, applicant proposes "to amend its goods description to remove the semi-colons, if Applicant's argument here is found insufficient" (brief, p. 5). We find that, as identified, the limiting language at the beginning of applicant's goods applies to all of the items of clothing recited thereafter. In consequence thereof, applicant's request in the

alternative to amend its identification of goods is moot, and will not be considered further.

In determining the issue of likelihood of confusion in ex parte cases, the Board must compare applicant's goods as set forth in its application with the goods as set forth in the cited registration. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Where the goods in the cited registration and/or application are broadly identified as to their nature and type (as is the case herein with respect to the cited registration), such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. *Id.* See also *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the

particular channels of trade or the class of purchasers to which the sales of goods are directed."); and *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.")

In the present case, applicant's goods are identified as:

clothing, namely fitness and athletic clothing for young women, namely, yoga pants; fitness tank tops; athletic bra tops; fitness bras; athletic socks; athletic footwear, athletic shoes; athletic shorts; bandanas; wristbands, headbands; sweat pants, sweat shirts; swimwear; light weight cotton shorts, light weight cotton shirts; sports tank tops,

and registrant's goods are identified as:

clothing, namely, T-shirts, sweaters, tops, hats, socks, slacks, jeans, shorts, sport shirts and outerwear, namely, coats and jackets; and clothing accessories, namely, belts and scarves.

In accordance with the above authorities, we must presume that registrant's goods include not only general-purpose clothing that may be worn by men, women or children, but that such goods also include fitness and athletic clothing for young women. That is to say, registrant's broadly identified clothing items are presumed to encompass applicant's clothing items intended to be worn by young women engaged in fitness and athletic activities. See *In*

*re Elbaum, supra.* Thus, we are not persuaded by applicant's assertion that the limitation of its identified goods to fitness and athletic wear for young women serves to decrease a likelihood of confusion as to the source of the goods.

In particular, we find that registrant's "tops," "shorts" and "socks" are identified broadly enough to include applicant's more narrowly identified "fitness tank tops and sports tank tops;" "athletic shorts, and lightweight cotton shorts;" and "athletic socks." Again, because there are no restrictions as to the intended uses or consumers of registrant's various items of clothing, they must be presumed to include such items suitable for use by young women engaged in fitness and athletic. *Id.*

In addition, the examining attorney has made of record a number of use-based third-party registrations which show that various entities have adopted a single mark for goods that are identified in both applicant's application and the cited registration. *See, for example:* Registration No. 2965490 for BODY ALIVE and design for athletic shorts, athletic tops, bra tops, jackets, T-shirts and socks; Registration No. 3092628 for the mark FINDYOURPATH for athletic footwear, athletic shoes, wristbands, headbands, sweatpants, athletic socks, t-shirts, socks, shorts, sport

**Ser No. 78678426**

shirts, and tops; and Registration No. 3116870 for the mark DBX for "pants, shorts, sweaters, athletic shorts, t-shirts, jackets, and athletic shoes." Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993); and *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

As a result of the foregoing, we find that registrant's goods encompass in part and are otherwise related to those of applicant. Accordingly, the *du Pont* factors concerning the relatedness of the goods as well as their trade channels favor a finding of likelihood of confusion.

#### The Marks

We turn then to the first *du Pont* factor, i.e., whether applicant's mark and registrant's mark are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We note initially that the test

under the first *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 or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). We further note that under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. See *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980).

In this case, applicant's mark, BYOU in standard character form, is similar to the registered mark, NOW B YOU, also in typed or standard character form, in that registrant's mark encompasses that of applicant. Specifically, the B YOU portion of registrant's mark is nearly identical to applicant's mark BYOU. The only differences between the marks are the presence of the additional word NOW and the space between B and YOU in registrant's mark. The additional space in registrant's

mark between B and YOU has a minimal effect on the appearance and no effect on the sound thereof. As a result, the term NOW in registrant's mark is the only term unique to either mark. That is to say, NOW is the only element of registrant's mark that is entirely dissimilar from the elements comprising applicant's mark, aside from the above-noted space which is insufficient to create a distinct commercial impression. The presence or absence of the word NOW is insufficient to distinguish the marks. Consumers who are familiar with the mark, NOW B YOU, used in connection with registrant's goods, and then see the mark BYOU used in connection with applicant's goods, are likely to assume that the owner of the mark NOW B YOU has simply deleted NOW when using the mark in connection with fitness and athletic clothing for young women. In other words, consumers are likely to view the marks as variations of each other, but indicating a single source. Thus, we find that the similarities in appearance between BYOU and NOW B YOU outweigh the differences.

With regard to sound, it is well settled that there "is no correct pronunciation of a trademark, and it obviously is not possible for a trademark owner to control how purchasers will vocalize its mark." See *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698,

1701 (TTAB 2006). Applicant's mark could reasonably be pronounced either as the initials "B-Y-O-U" or as the words "be you." Registrant's mark could reasonably be pronounced either as the words "now be you" or possibly a combination of words and initials such as "now B-Y-O-U." We note, however, that regardless of whether the respective marks are pronounced as words, initials, or a combination thereof, the mark BYOU would sound highly similar to NOW B YOU when the marks are spoken.

Further, to the extent that the marks have recognizable connotations, applicant's mark suggests "be you" and that of registrant suggests "now be you." Thus, both marks connote that the goods identified thereby allow the wearer to express one's individuality or, in other words, to be one's self. Thus, we find that the marks are highly similar in terms of connotation, and when taken in their entireties, convey highly similar commercial impressions. See *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) ("the PTO may reject an application ex parte solely because of similarity in meaning of the mark sought to be registered with a previously registered mark").

Applicant contends that the examining attorney improperly dissected its mark in analyzing the similarities

between it and the mark in the cited registration. However, and as noted above, we find that when the marks are viewed in their entirety the similarities in appearance, sound, connotation and commercial impression outweigh the differences. See *Palm Bay Imports, Inc. v. Veuve Clicquot, supra*. As such, applicant's arguments regarding the asserted dissection of its mark are unavailing.

Thus, the marks, taken as a whole, are highly similar in appearance, sound, connotation and commercial impression. Accordingly, this *du Pont* factor also favors a finding of likelihood of confusion.

Strength of Registrant's Mark

Finally, applicant argues that registrant's mark is weak and entitled to a limited scope of protection. In support of this contention, applicant has made of record printed copies of the following third-party registrations taken from the United States Patent and Trademark Office's (USPTO) Trademark Applications and Registrations Retrieval (TARR) database, all for various items of clothing:  
Registration No. 1793739 for the mark JUST BE YOU

Registration No. 2469193 for the mark



Ser No. 78678426

Registration No. 2428612 for the mark **Be. You<sup>#</sup> (k)**

Registration No. 3218255 for the mark



Registration No. 3302219 for the mark BE YOU. BE TRUE.

In addition, applicant has made of record printed copies of search results from the Google Internet search engine of its search for the term "be you."

The Google search engine results are of very limited probative value. First, the term "be you" appears almost exclusively in the context of other wording, and not as a trademark. Examples such as: "Sucks To Be You;" "Revamped Google tools let you be you;" "It Had to Be You;" and "Why Can't I Be You?" are typical of the larger contexts in which the term "be you" typically appears. In addition, the search summaries themselves are truncated to such an extent that it is difficult to tell the goods or services with which the terms are used. However, it is clear from the limited context that most of the search results concern goods and services unrelated to the goods at issue herein.

Similarly, applicant's evidence of five third-party registrations is entitled to limited probative value.<sup>3</sup> The registrations are not evidence of use of the marks shown therein. As a result, they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of the same or similar marks in the marketplace. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982). Thus, while applicant's proffered third-party registrations may indicate that the USPTO has registered a number of "BE YOU" formative marks in relation to various clothing items, such evidence fails to establish that the consuming public has been exposed to third-party use of similar marks on similar goods, such that consumers would distinguish applicant's mark from the cited mark based on the very minor differences between them. Third-party registrations may be used in the manner of dictionary definitions, to show that a term has a certain significance in a particular field.

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<sup>3</sup> Applicant's evidence also included a copy of the registration cited herein, as well as Registration No. 2384824, which subsequently was cancelled on June 16, 2007. A cancelled registration is not evidence of anything except that it issued. See TBMP §704.03(b) (2d ed. rev. 2004) and cases cited therein. See also *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002).

The registrations made of record by applicant show that the concept of dressing like or being oneself has a positive connotation in the clothing field. However, even if we were to conclude, based on applicant's evidence, that registrant's mark is entitled to a more narrow scope of protection than a totally arbitrary mark, the scope is still broad enough to prevent the registration of a highly similar mark for goods that are in part identical to the goods identified in the cited registration. *See In re Farah Manufacturing Co., Inc.*, 435 F.2d 594, 168 USPQ 277, 278 (CCPA 1971).

Summary

In light of the foregoing, we conclude that consumers familiar with registrant's goods sold under its above-referenced mark would be likely to believe, upon encountering applicant's goods rendered under its mark, that the goods originate with or are associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *See In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's*

**Ser No. 78678426**

*Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289  
(Fed. Cir. 1984).

Decision: The refusal of registration is affirmed.