

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
July 29, 2008
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Swat.Fame, Inc.

Serial No. 78753730

William A. Finkelstein of Dreier Stein & Kahan for
Swat.Fame, Inc.

Katherine Stoides, Trademark Examining Attorney, Law Office
101 (Ronald R. Sussman, Managing Attorney).

Before Hohein, Bucher and Bergsman, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Swat.Fame, Inc. seeks registration on the Principal
Register of the mark **BU FROM MALIBU** (*in standard character
format*) for goods identified in the application, as amended,
as follows:

"clothing, namely, jeans, pants, slacks, trousers,
gauchos, capris, bottoms, shorts, Bermuda shorts,
coveralls, overalls, skirts, miniskirts, dresses,
jumpsuits, tops, blouses, halter tops, tank tops,
cardigans, jerseys, t-shirts, shirts, knit shirts, polo
shirts, sweaters, turtlenecks, vests, sweatshirts,
sweatpants, boxer shorts, underwear, socks, suits,
sport coats, blazers, coats, jackets, raincoats,
overcoats, and headwear" in International Class 25.¹

¹ Application Serial No. 78753730 was filed on November 14,
2005 based upon applicant's allegation of a *bona fide* intention
to use the mark in commerce. No claim is made to the exclusive
right to use the word "Malibu" apart from the mark as shown.

This case is now before the board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has found that applicant's mark, if used in connection with the identified goods, so resembles the following mark:



registered in connection with "clothing, namely t-shirts, shorts, sweatshirts, sweaters," also in International Class 25,² as to be likely to cause confusion, to cause mistake or to deceive.

² Registration No. 1558080 issued to Baylor University on September 26, 1989; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

The Trademark Examining Attorney and applicant have filed briefs in the case. We affirm the refusal to register.

In arguing for registrability, applicant contends that the Trademark Examining Attorney's position is riddled with errors based on her improperly dissecting applicant's mark and discounting the word, Malibu; that the cited collegiate athletic mark, owned by Baylor University for items of casual, college clothing, is by its very nature, targeted to a limited group of consumers; that the marks are quite dissimilar in appearance, sound and meaning, and evoke significantly different commercial impressions in prospective purchasers; that applicant's goods and the prior registrant's goods travel in different channels of trade, to knowledgeable and discerning prospective purchasers; and that the cited mark is very weak because of the existence of a plethora of marks with similar components, thus restricting the cited mark to a narrow scope of protection.

By contrast, the Trademark Examining Attorney argues that a likelihood of confusion exists because these are confusingly similar marks that will be used on goods that are, in part, identical and otherwise are closely-related, and that presumably, these goods will move in the same channels of trade.

Likelihood of Confusion

We turn then to a consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on this issue. See *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 this case, applicant and the Trademark Examining Attorney have focused exclusively on the two key considerations in any likelihood of confusion analysis, namely, the similarities between the marks and the relationship 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).

The Goods

We turn first to a consideration of the goods identified in the application and the cited registration. As seen above, the goods in the cited registration are identified as "clothing, namely t-shirts, shorts, sweatshirts, sweaters." Applicant's identification of goods

likewise includes shorts, t-shirts, sweaters and sweatshirts. On its face, this reflects a clear overlap in the identified goods. In order to affirm a refusal, it is only necessary that we find likelihood of confusion with respect to at least one item in each class of applicant's goods. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) ["[L]ikelihood of confusion must be found if the public, being familiar with [opposer's] use of **MONOPOLY** for board games and seeing the mark on any item that comes within the description of goods set forth by appellant in its application ..."].

Nonetheless, applicant argues that its goods are quite different, and hence easily distinguishable, from those offered by registrant. Applicant contends that it "designs and produces high-end, unique, fashion-oriented clothing" while registrant's goods are not-so-fashionable t-shirts, shorts, sweatshirts and sweaters targeted to college students. Indeed, the pages of applicant's website introduced into the record show trendy, designer clothing marketed through high-end department stores. Applicant would have us conclude that the competitive distance between its goods and registrant's goods is significant enough to lessen the likelihood of confusion. *McGregor-Doniger Inc.*

v. Drizzle Inc., 599 F.2d 1126 (2d Cir. 1979) [**DRIZZLE** for fashionable women's coats held not to be confusingly similar to **DRIZZLER** for men's golf jackets].

However, we must consider the cited registrant's goods as they are described in the registration, and we cannot read limitations into the items of clothing listed therein. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). Merely because the registrant is Baylor University, we are not permitted to presume that this merchandise will be low-end, casual apparel sold to college students in Waco, Texas. Thus, with regard to this critical *du Pont* factor, we find that the goods are in part identical, favoring a finding of likelihood of confusion herein.

Channels of Trade and Conditions of Sale

Moreover, inasmuch as there are no limitations as to the channels of trade or class of purchasers in the registration, it is presumed that the registration encompasses all goods of the type described, that they move in all channels of trade normal for those 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). Likewise, even in the event we should find ourselves persuaded by the apparent contrasts that applicant ascribes to the real-world conditions of sale, such is irrelevant in applying the *du Pont* factors as applied by our primary reviewing Court. Applicant argues that both applicant's and registrant's respective customers are discerning and knowledgeable about these contrasting goods, and will know immediately which goods are being offered by applicant and which by Baylor University:

" ... A customer of Baylor merchandise has very specific and targeted expectation of what he or she wants and where to buy it. It is inconceivable that any such customer would be confused upon encountering Applicant's merchandise sold under the BU FROM MALIBU mark in a department store. Girls in their teens looking for trendy, high-end sportswear who happen to be at a store near the Baylor campus are simply not going to believe that a 'BU' sweatshirt in dark green and gold with an interlocking B and U is a 'BU FROM MALIBU' product, nor is it what they want to purchase. Likewise, a Baylor alumna seeing expensive sportswear for her teenage daughter in an upscale mall in Dallas simply is not going to confuse it with that Baylor sweatshirt she wore on campus twenty years earlier."

Applicant's brief at 14.

However, we are bound to presume that t-shirts and sweatshirts are inexpensive items purchased without a great deal of care, rather than assuming that the relevant

customers are knowledgeable and discerning purchasers who would exercise care and deliberation. Furthermore, applicant's own website, screen prints of which were made part of the record by applicant, show that applicant's jeans are targeted to "the younger college girl" who, among other things, is looking for "affordability."³

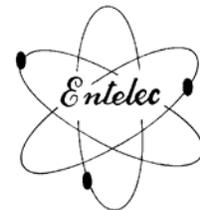
Accordingly, the related *du Pont* factors focused on trade channels and conditions of sale also support a likelihood of confusion determination.

The Marks

We turn now to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and 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 also bear in mind that "[w]hen marks would appear on virtually identical goods or services, the degree of similarity [of the marks] 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, 1701 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994).

³ Applicant's reply of July 20, 2007, at 48
<< <http://www.bu-malibu.com> >>

Certainly, no trademark owner can guarantee that the public will pronounce its mark perfectly. *Frances Denney, Inc. v. ViVe Parfums Ltd.*, 190 USPQ 302 (TTAB 1976) [**ViVe** and fleur de lis design for perfume products are likely to cause confusion with **VIVA** cosmetic products]; *Nina Ricci S.A.R.L. v. Haymaker Sports, Inc.*, 134 USPQ 26 (TTAB 1962) [applicant's **RICCI OF HAYMAKER** is confusingly similar to opposer's **NINA RICCI** and **RICCI**]; *In re Electrons, Inc.*, 144 USPQ 442 (TTAB 1964) [applicant's **Di-EI-Trol** is confusingly similar to registrant's **DIALTRON**]; *In re Energy Telecommunications & Electrical Association*, 222 USPQ 350 (TTAB 1983) [**INTELECT** likely to be confused with the **ENTELEC** design shown at right:



As to overall sound, depending upon how applicant's mark is pronounced, it will entail six or seven syllables, compared with registrant's two spoken letters. This dissimilarity cannot be denied. On the other hand, we are not persuaded by applicant's argument that registrant's mark will be sounded out as two letters, B-U, while applicant's will be pronounced "Boo." While applicant contends that "Boo" is a common slang reference to Malibu, drawn from the final syllable of the city of Malibu and rhyming therewith, applicant failed to substantiate this assertion of a known slang reference (e.g., by putting in a affidavit to that

effect in the record, along with supporting examples of such usage in the popular media).

In any event, the analysis is not whether the marks can be distinguished when compared side-by-side. Rather, we must determine whether the marks are sufficiently similar that there is a likelihood of confusion as to source and, in making this determination, we must consider the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). As indicated above, in this case, the average purchasers are all purchasers of clothing, including "the younger college girl" who is looking for "affordability." Further, while it is correct that we must view the mark in its entirety, *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992), it is also well settled that "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 750-51 (Fed. Cir. 1985).

As to appearance, inasmuch as applicant seeks registration of its mark in a standard character format, presumably this would be broad enough to encompass the interlocking, collegiate-style lettering used by registrant. Although applicant argues that students, fans and alumni of Baylor University seeking out its licensed collegiate merchandise will have a well-defined expectation of such goods, we certainly cannot presume from this registration that registrant's mark (not lined for color herein) will always be shown, for example, using school colors of "dark green and gold," as suggested by applicant.

As to connotation, applicant argues that among the Valley girls who recognize the shorthand, BU, its composite mark "evokes an image of California, sun, surf, relaxation, and celebrities." By contrast, applicant points out that registrant's two-letter mark will readily be understood as the initials of a Texas university, and therefore will convey an image of that institution to the mind of prospective consumers.

While one who reviews the federal trademark register knows that the cited BU stylized mark is owned by Baylor University, we cannot be sure that prospective consumers will immediately understand that registrant's BU mark identifies Baylor University (as opposed to Brandeis,

Boston, Butler, Bucknell, Bradley or Brown Universities, for that matter). Hence, as to connotation, we have to assume in both cases that consumers may well see the letters BU as an arbitrary source-indicator for items of apparel.

As to commercial impression, as was noted by the Trademark Examining Attorney, the letters B-U dominate the marks of both applicant and registrant, inasmuch as (1) applicant has disclaimed the word "Malibu";⁴ (2) consumers are predisposed to focus more on the first word, prefix or syllable of a trademark; and (3) applicant's actual use clearly establishes that the letters B-U dominate the mark in size and location.⁵



Consequently, we find that applicant's mark is quite similar in connotation and commercial impression when compared with registrant's cited mark, such that it outweighs any dissimilarity in sound and appearance between

⁴ While the Trademark Examining Attorney cannot ignore a disclaimed portion of a mark and must view marks in their entirety, one feature of a mark may be more significant in creating a commercial impression. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986). Disclaimed matter is typically less significant or less dominant.

⁵ << <http://www.bu-malibu.com> >>

applicant's mark and registrant's mark. Thus, with regard to this critical *du Pont* factor, we find that the marks are similar, favoring a finding of a likelihood of confusion.

The number and nature of similar marks

We turn next to the number and nature of similar marks registered for similar goods. Applicant takes the position that the cited prior registrant's mark is weak and entitled to a narrow scope of protection.

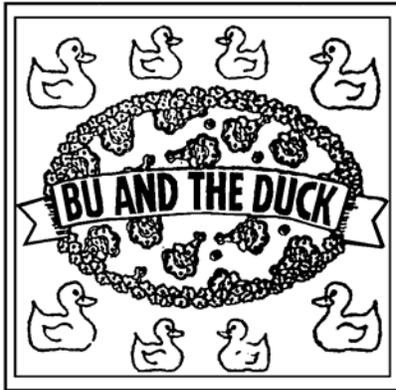
Applicant has placed into the record nine third-party registrations having some variation on the combined letters B and U, and their phonetic equivalents registered in connection with items of apparel -- all of which issued subsequent to the registration of the cited mark:

2BU	for "vests, jackets, tank tops, T-shirts, sweatshirts" in International Class 25; ⁶
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⁶ Registration No. 1711858 issued on September 1, 1992; renewed.

B A S I C
B/U
UTILITIES

for "clothing; namely, pants, tops, hats, socks sweaters, shorts pants" in International Class 25;⁷



for "children's wearing apparel and accessories, namely, anoraks, baby bunting, bathing suits, beachwear and cover-ups, headwear, cloth bibs, blazers, underwear, blouses, bodysuits, booties, boots, sweaters, cloth diapers, coats, creepers, dresses, jeans, dusters, footwear, jackets, jumpers, kilts, hosiery, knickers, leggings, leotards, lingerie, pants, pinafores, playsuits, polo shirts, ponchos, vests, robes, rompers, scarves, shorts, skirts, slacks, slippers, snowsuits, stockings, suits, suspenders, t-shirts, tank tops, tights and tunics" in International Class 25;⁸

⁷ Registration No. 1809837 issued on December 7, 1993; renewed.

⁸ Registration No. 2232058 issued on March 16, 1999; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.



for "clothing, namely shirts, pants, shorts, and headwear" in International Class 25;⁹

BU JIN

for "clothing, namely skirts, jackets, vests, trousers, pants, belts, shirts, coats, sportswear, sweatshirts" in International Class 25;¹⁰

BU SELF

for "clothing, namely t-shirts, caps and sweatshirts" in International Class 25;¹¹

U-KAN-B-U

for "clothing, namely, shirts, tops, sweaters, shorts, pants, vests, jackets, neckwear, robes, pajamas, underwear, socks, belts, and headwear" in International Class 25;¹²

DA BU

for "clothing, namely, T shirts, sweatshirts, jackets, jerseys, shorts, caps, hats" in International Class 25;¹³ and

⁹ Registration No. 2293583 issued on November 16, 1999 for BU-YA BROTHERS UNITING YOUNG ACHIEVERS and design; Section 8 affidavit (six-year) accepted.

¹⁰ Registration No. 2310307 issued on January 25, 2000; Section 8 affidavit (six-year) accepted. The English translation of BU JIN is "a person of the warrior spirit."

¹¹ Registration No. 2600111 issued on July 30, 2002.

¹² Registration No. 2724298 issued on June 10, 2003.

¹³ Registration No. 3004456 issued to joint owners living in Malibu, CA, on October 4, 2005.



for "swim wear" in International Class 25.¹⁴

According to applicant, this represents a "crowded" trademark field - that this coexistence means that the United States Patent and Trademark Office has clearly taken the position that a plurality of parties can coexist with very similar marks for quite similar items of apparel without causing a likelihood of confusion. Applicant argues that this demonstrates the relative weakness of a mark and the consequent limited scope of protection to be afforded such marks. *American Steel Foundries v. Robertson*, 269 U.S. 372, 46 S.Ct. 160, 70 L.Ed. 317 (1926) [the ubiquity of the word "Simplex" in marks has forced the public to find other ways to distinguish among marks using that word]; *Western Publishing Co. v. Rose Art Industries, Inc.*, 15 USPQ2d 1545 (2d Cir. 1990); *General Mills Inc. v. Kellogg Co.*, 3 USPQ2d 1442 (8th Cir. 1987); *Sun Banks of Florida Inc. v. Sun*

¹⁴ Registration No. 3337207 issued to Joseph F. Hawkins III on November 13, 2007 (the "Hawkins Mark").

Federal Savings & Loan Ass'n, 211 USPQ 844 (5th Cir. 1981);
In re The Lucky Co., 209 USPQ 422 (TTAB 1980).

While third party registrations are not evidence of use of the marks shown therein, they may be considered as tending to show that a registered mark may be a "weak" mark, thus resulting in narrowing an opposer's rights therein. On the other hand, the majority of these third-party marks have different connotations from registrant's mark, such as the fact that the initialism B-U often has the meaning of "**Be You**" (e.g., **2BU, BU SELF, U-KAN-B-U**), or the initialism itself suggests another meaning in the context of the composite marks (e.g., **BASIC U**TILITIES, **B**ROTHERS **U**NITING)

Applicant makes special mention of the "Hawkins mark," which application for swimwear was passed to publication without citation. Applicant argues that it is "inconsistent, illogical and inequitable" for the Trademark Examining Attorney to refuse the involved mark based on an alleged likelihood of confusion with the cited mark, when, for example, the United States Patent and Trademark Office allowed the Hawkins mark to register in connection with apparel in Class 25.

A handwritten logo consisting of the letters 'B' and 'U' in a stylized, bold, cursive font. The 'B' is on the left and the 'U' is on the right, with a small 'i' above the 'U'. A vertical dashed line is positioned to the left of the logo.

To the extent that the Hawkins mark is close to the cited mark, we note that prior decisions and actions of other Trademark Examining Attorneys in registering different

marks are without evidentiary value and are not binding upon the Office. Each case is decided on its own facts, and each mark stands on its own merits. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (CCPA 1973); *In re International Taste, Inc.*, 53 USPQ2d 1604 (TTAB 2000); *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re Consolidated Foods Corp.*, 200 USPQ 477 (TTAB 1978).

All things considered, we find this to be a neutral factor in our determination of likelihood of confusion.

While applicant has repeatedly referred to the fact that the cited mark is Baylor University's collegiate logo (e.g., when discussing *du Pont* factors such as similarity of the mark, relatedness of the goods, trade channels and level of care in purchasing), we find that this connection is definitely *not* determinative of the outcome herein.



Conclusion

In summary, we find that applicant's goods are in part identical to registrant's goods, the goods are presumed to move in the same channels of trade to the same classes of ordinary consumers, that the marks are confusingly similar,

especially as to connotation and commercial impression, and finally, that the cited mark is not weak.

Decision: The refusal to register this mark under Section 2(d) of the Lanham Act is hereby affirmed.