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Mailed:
March 8, 2004

Paper No. 10
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

GTFM, Inc.
v.
Teresa Shaw Sheard

Opposition No. 91124582
to application Serial No. 78018171
filed on July 24, 2000

Peter J. Vranum of Janvey, Gordon, Herlands, Randloph & Cox,
LLP for GTFM, Inc.

Teresa Shaw Sheard, pro se.

Before Simms, Bottorff and Rogers, Administrative Trademark
Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark depicted below for goods identified in the
application (as amended) as "women's motorcycle clothing and

accessories, namely, shirts, sweatshirts, hats, biker cuffs, leather jackets and pants."¹



Opposer has opposed registration on the ground that applicant's mark, as applied to applicant's goods, so resembles opposer's previously-used and registered marks "F.U.B.U.", "FUBU and Design" and "FUBU JEANS" as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d). Opposer has pleaded (and proven the status and title of - see *infra*) the following registrations:

Registration No. 1,190,169,² which is of the mark depicted below

¹ Serial No. 78018171, filed July 24, 2000. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a). November 1, 1999 is alleged as the date of first use anywhere, and April 1, 2000 is alleged as the date of first use in commerce.

² Issued August 8, 1995. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

F.U.B.U.

Registration No. 2,068,058,³ which is of the mark depicted below



and Registration No. 2,068,059,⁴ which is of the mark depicted below



The goods identified in all three of opposer's pleaded registrations are "men's, women's and children's clothing, namely, sweatshirts, shirts, jeans, jackets, coats, sweatpants, slacks, suits, hats, headbands, visors, caps, dresses, shoes, sneakers, boots, wristbands, socks, t-shirts, belts, undergarments, neckties, dress shirts, collared shirts, rugby shirts, knit shirts, shorts and sandals."

³ Issued June 3, 1997. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

⁴ Issued June 3, 1997. Section 8 affidavit accepted; Section 15 affidavit acknowledged. The registration includes a disclaimer of the exclusive right to use JEANS apart from the mark as shown.

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Applicant filed an answer by which she denied the salient allegations of the notice of opposition.

At trial, opposer made of record the October 25, 2002 testimony deposition of its general counsel Lawrence P. Blenden,⁵ and exhibits thereto. Applicant submitted no testimony or evidence. Opposer filed a brief on the case, but applicant did not. No oral hearing was requested.

The following facts are established by the evidence of record. Opposer sells the goods identified in its registrations nationwide in a variety of retail trade channels, including large department stores, large chain stores, specialty stores, in seven of its own retail stores, and via the Internet. (Blenden Depo. at 9-10.) Opposer's 1999-2001 U.S. sales of apparel bearing its marks totaled in excess of \$500 million. (*Id.* at 15.)

Opposer's expenditures for advertising and promoting its brand over the last four to five years total in excess of sixteen million dollars. (*Id.* at 11.) Opposer advertises and promotes its products through television advertisements, print advertisements in magazines including Vibe, Source, GQ and Teen People, on billboards, in point-of-purchase displays and on posters which are given to consumers. Various celebrities such as sports figures,

⁵ Mr. Blenden testified that he manages the business and legal affairs of opposer, including trademark licensing, and that he is

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actors and musicians are paid to endorse and wear opposer's products. (*Id.* at 10-11, 14-15.) Opposer's print ads include ads dedicated to its women's apparel line. (Blenden Depo. Exh. 7-9).⁶ One of these ads (Exh. 7) depicts the FUBU mark in a stylized script which is similar to the stylized script in which applicant's mark is depicted.

Opposer also sponsors a stunt motorcycle team called the FUBU Riders, who wear opposer's branded-clothing and whose motorcycles are emblazoned with opposer's marks. The team performs at trade shows, fairs and other exhibitions around the country and is becoming "very widely recognized." (*Id.* at 13-14.) Opposer has introduced ("in the last year or two") a "motorcycle line" of clothing which includes "jeans, jeans jackets with pads." (*Id.* at 16.) One of opposer's print ads (Blenden Depo. Exh. 8) depicts a woman wearing these items, holding a motorcycle helmet with FUBU emblazoned across it, and standing in front of a motorcycle emblazoned with the FUBU mark in a stylized cursive script similar to that in which applicant's mark is depicted. Also, for the last two or three years, opposer has sold t-shirts with motorcycles depicted on them. (*Id.* at 16.) Citing

familiar with opposer's marketing and sales of its products and the company's profits. (Blenden Depo. at 7.)

⁶ Exhibits 7-9 are advertising mats, rather than the actual advertisements from the magazines. However, Mr. Blenden testified that the exhibits depict the advertisements as they appear in the magazines.

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these products, advertisements and promotional activities, Mr. Blenden testified that "people do connect FUBU with motorcycles. There's no question about it. And as the popularity of FUBU Riders continues, FUBU and motorcycles will be connected for a long, long time." (*Id.* at 16-17.)

Finally, Exhibit 2 to Mr. Blenden's deposition is opposer's Request for Admissions Nos. 1-14, to which applicant failed to respond.⁷ Pursuant to Fed. R. Civ. P. 36, applicant is deemed to have admitted, and it is conclusively established, that: applicant's goods and opposer's goods are "the same," "related," and "similar" (Nos. 1-3); the channels in which the parties advertise, promote and market their respective goods are overlapping (No. 4); the target consumers for applicant's and opposer's goods are overlapping (No. 5); the term "FUFU" is displayed on applicant's packaging and/or labels as the dominant term in applicant's mark (No. 7); FUFU and FUBU in the parties' respective marks have similar, if not the same, connotation (No. 8); FUFU and FUBU in the parties' respective marks are confusingly similar (No. 9); the commercial impression of applicant's mark is FUFU (No. 10); and the term VAROOM adds

⁷ Opposer's attorney introduced the Request for Admissions as Exhibit 2 to the deposition, and stated on the record that applicant had failed to respond thereto. This is an acceptable method of making such evidence of record. See *Lacoste Alligator S.A. v. Everlast World's Boxing Headquarters Corp.*, 204 USPQ 1012, 1015 n.7 (TTAB 1979); TBMP §714.10 (2d ed. June 2003).

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no distinctive nature or quality to applicant's mark (No. 11).

Opposer has proven that its pleaded registrations are subsisting and owned by opposer. (Blenden Depo. at 7-8, Exh. 4-6.) Therefore, we find that opposer has established its standing to oppose. See, e.g., *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Also, Section 2(d) priority is not in issue as to the goods identified in opposer's registrations. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We find that applicant's mark and opposer's marks are similar rather than dissimilar when viewed in their entireties in terms of appearance, sound, connotation and

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overall commercial impression. Applicant has admitted, and it therefore is conclusively established, that "FUFU" is the dominant feature in applicant's mark, that "FUFU" and "FUBU" have similar, if not the same, connotations and are confusingly similar, and that the presence in applicant's mark of the word "VAROOM" does not distinguish applicant's mark. Even without these admissions, we would find that the marks are confusingly similar. The term "FUFU" indeed dominates the commercial impression created by applicant's mark, because the word "varoom" and the image of the woman on the motorcycle are suggestive of applicant's goods.⁸ "FUFU" and "FUBU" differ by only one letter, and we find that they are similar in appearance and sound. Viewing the marks in their entirety, we find that the similarity between "FUFU" and "FUBU" in the respective marks outweighs any dissimilarity which results from the presence of the additional matter in applicant's mark.

Moreover, it is settled that where the applicant's goods are identical to the opposer's goods, as they are in this case (in part), and where the opposer's mark is a famous mark, as opposer's is in this case, the degree of

⁸ In this regard, we take judicial notice that "vroom" is defined as a slang term meaning "the loud roaring sound made by a motor vehicle, such as a race car or motorcycle, accelerated at high speed." Webster's II New Riverside University Dictionary (1988) at 1296. Although the word in applicant's mark is spelled "varoom" rather than "vroom," we find that the term would be viewed by purchasers as having the same suggestive meaning.

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similarity between the marks which is required to support a finding of likelihood of confusion declines. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applicant has admitted, and it therefore is conclusively established, that the goods identified in the application, i.e., "women's motorcycle clothing and accessories, namely, shirts, sweatshirts, hats, biker cuffs, leather jackets and pants," are similar, related to, or the same as the goods identified in opposer's registrations. We would find as much even without applicant's admissions. Although applicant's goods are described in the application as "motorcycle clothing," many of the particular goods appear to be normal items of apparel which are legally identical to the same items identified in opposer's registrations, i.e., shirts, sweatshirts, hats, and jackets. Moreover, the evidence shows that opposer has utilized a "motorcycle" theme in marketing its goods, a fact which further connects opposer's goods and applicant's goods.

We also find that to the extent that the parties' goods are legally identical, the trade channels and classes of purchasers for the goods also are legally identical. There are no restrictions or limitations in applicant's

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identification of goods, so we must presume that the goods are marketed in all normal trade channels and to all normal classes of purchasers for such goods. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Finally, we find that opposer's mark is a strong mark and indeed a famous mark, which is entitled to a broad scope of protection. Opposer's half-billion dollars in sales over the last two years attest to the strength and fame of opposer's mark, as do opposer's substantial expenditures for advertising and promoting its brand. Such fame plays a dominant role in our likelihood of confusion analysis. *See Bose Corp., supra.*

In summary, after careful consideration of the evidence in the record pertaining to the relevant du Pont likelihood of confusion factors, we conclude that a likelihood of confusion exists as between applicant's mark, as applied to the goods identified in the application, and opposer's various registered marks, and that opposer therefore has proven its Section 2(d) ground of opposition.

Decision: The opposition is sustained.