

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

Mailed:  
December 27, 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

GTFM, Inc.  
v.  
Guy R. Wilson, Jr.

Opposition No. 91170761  
to application Serial No. 78681938  
filed on July 29 2005

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

Guy R. Wilson *pro se*.

Before Zervas, Cataldo and Bergsman, Administrative  
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

On July 29, 2005, Guy R. Wilson filed an intent-to-use  
application for the mark FYBY FOR Y'ALL BY Y'ALL and  
design, shown below, for "silk screen painting on  
clothing," in Class 40 (Serial No. 78681938).



GTFM, Inc. filed an opposition to the registration of applicant's mark on the grounds of priority of use and likelihood of confusion and dilution. Opposer alleged that applicant's mark, when used in connection with applicant's services, so resembles opposer's FUBU marks for clothing as to be likely to cause confusion.<sup>1</sup> Opposer claimed ownership of the following FUBU registrations:

1. Registration No. 1910169 for the mark F.U.B.U., in block letters, for "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," in Class 25;<sup>2</sup>

2. Registration No. 2403324 for the mark FUBU, in typed drawing form, for "clothing, namely shirts, vests, sweaters, shoes, caps, bandanas, shorts, sweat shirts, pants, belts for clothing, socks, swimwear, jackets,

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<sup>1</sup> Although opposer alleged that the use and registration of applicant's FYBY mark will dilute the distinctive character of opposer's FUBU mark, it did not allege or prove that its FUBU mark became famous prior to the filing date of the application. In addition, opposer did not raise the dilution claim in its brief. In view of the foregoing, opposer is deemed to have waived its dilution claim, and we will give it no further consideration.

<sup>2</sup> Registration No. 1910169, issued August 8, 1995; Sections 8 and 15 affidavits accepted and acknowledged; first renewal.

rainwear, blouses, dresses, footwear, hosiery, scarves, hats, head bands, pajamas and sleepwear," in Class 25;<sup>3</sup>

3. Registration No. 2068058 for the mark FUBU and design, shown below, for "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," in Class 25;<sup>4</sup> and,



4. Registration No. 2068059 for the mark FUBU JEANS, shown below, for "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,

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<sup>3</sup> Registration No. 2403324, issued November 14, 2000; Sections 8 and 15 affidavits accepted and acknowledged.

<sup>4</sup> Registration No. 2068058, issued June 3, 1997, Sections 8 and 15 affidavits accepted and acknowledged; first renewal.

collared shirts, rugby shirts, knit shirts, shorts, and sandals," in Class 25.<sup>5</sup>



Only opposer filed a brief.

The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and the application file for applicant's mark. The record also includes the following testimony and evidence:

A. Opposer's evidence.

Opposer's evidence comprises the testimony deposition of Lawrence Blenden, opposer's general counsel, with attached exhibits. In his deposition, Mr. Blenden identified opposer's pleaded registrations referenced *supra*, and confirmed that they are owned by opposer and that they are valid and subsisting.<sup>6</sup>

B. Applicant's evidence.

Applicant did not introduce any testimony or evidence.

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<sup>5</sup> Registration No. 2068059, issued June 3, 1997; Sections 8 and 15 affidavits accepted and acknowledged.

<sup>6</sup> Blenden Deposition, pp. 8-10; Exhibits 3-6.

Standing

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, 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

goods and/or services. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Federated Foods, Inc. v. Fort Howard Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

A. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We turn first to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, *supra*. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). See also, *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988). In comparing the marks, we are mindful that the test 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 so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086

(Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

We find that dominant feature of applicant's mark is the letters FYBY.<sup>7</sup> Applicant's mark is a composite mark consisting of the words FOR Y'ALL BY Y'ALL located over the design element of the mark comprising the letters FYBY superimposed on the drawing of a Confederate flag. However, the letters FYBY form the dominant part of the mark because they cover the entire Confederate flag, and they are much larger than words FOR Y'ALL BY Y'ALL. In fact, letters are the feature that first grabs the viewers' attention. In addition, the letters FYBY mean FOR Y'ALL B'YALL. FOR Y'ALL B'YALL is "Southern slang for 'For You By You.'"<sup>8</sup> Because the acronym FYBY is the dominant element of applicant's mark, we accord that feature more weight in our comparison of the marks. *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751

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<sup>7</sup> Applicant concedes that FYBY is the dominant element of its mark. (Answer ¶6).

<sup>8</sup> Answer ¶2.

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(Fed. Cir. 1985) ("there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties").

Moreover, it is the acronym FYBY that will be recognized and used by purchasers as the primary means of source identification. In cases where a mark comprises both a word and a design, the word is normally accorded greater weight because purchasers will use the words to request the goods identified by the mark. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1554 (TTAB 2001); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1976).

Although the applicant's mark is highly stylized, the design of applicant's marks is not sufficient to distinguish it from opposer's Registration No. 2403324 for the mark FUBU in typed drawing form. If a mark (in either an application or a registration) is presented in standard characters, the owner of the mark is not limited to any particular depiction. The rights associated with a mark in standard characters reside in the wording (or other literal element, e.g., letters, numerals, punctuation) and not in any particular display. Therefore, an applicant cannot, by presenting its mark in special form, avoid likelihood of

confusion with a mark that is registered in standard characters because the registered marks presumably could be used in the same manner of display. *See, e.g., In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); *Sunnen Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744, 1751 (TTAB 1987); *In re Hester Industries, Inc.*, 231 USPQ 881, 883, n.6 (TTAB 1986).

In this case, both marks comprise an arbitrary combination of letters: FUBU and FYBY. The letters FUBU and FYBY are clearly discernable and trigger the initial impact of the marks. As discussed *supra*, it is not unrealistic to assume that consumers may not keep in mind the precise letters of the marks, and thus be able to differentiate FYBY from FUBU. To the extent that the marks are alike because they both have the same structure (*i.e.*, they begin with the letter "F" followed by a vowel, the letter "B," and then the initial vowel), and taking into account that the marks may be encountered by the same consumers, we find the similarities in the appearance of the marks outweigh the differences. Moreover, we must keep in mind that it is more difficult to remember a series of arbitrarily arranged letters than it is to remember words, figures, or phrases. *Weiss Associates, Inc. v. HRL*

*Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1841 (Fed. Cir. 1990); *Edison Brothers Stores v. Brutting E.B. Sports International*, 230 USPQ 530, 533 (TTAB 1986).

In addition, the marks engender similar meanings and commercial impressions. The record shows that opposer's mark FUBU stands for "For Us, By Us." However, according to Lawrence Blenden, FUBU "is also throughout the country understood by many customers and non-customers who know of the FUBU mark as having a secondary meaning of 'for you, by you.'"<sup>9</sup> Opposer's Exhibit 12 consists or excerpts from Internet articles or blogs in which the authors have explained that the FUBU trademark means "For You, By You."

TIPS: Urban Design and Advertising

Watch how the younger people dress, Popper said. Watch brands like Phat Farm, Nichi, FUBU ("for you by you) came out with a line of Fat Albert clothing, ("Hey, Hey, Hey!"), based on he old animated character voiced by Bill Cosby.

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Hip-Hop Style: What is Cool?

I think you need a little fashion update. Tommy Hilfiger is still in style. However, here in the south, the trend is FuBu, which means "for you by you."

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<sup>9</sup> Blenden Deposition, pp. 16-19; Exhibit 12.

In addition, Mr. Blenden testified about a song "Fatty Girl" produced by Universal Music and FUBU Records, LLC.

The song has the following lyrics:

I mean in them jeans, your shape is  
beautiful and I'm for you, by you, like  
FUBU.

An accompanying music video was produced and aired on Black Entertainment Television and MTV.<sup>10</sup>

Because FUBU is associated with the phrase "For You, By You," we find that its connotation is similar to the phrase "FOR Y'ALL BY Y'ALL" in applicant's mark.

Finally, the marks are similar in sound because they have the same rhythm and cadence when they are spoken, and they both feature the letters "F" and "B" in the same position.

In view of the foregoing, when we consider the marks as a whole, we find that the marks are similar in terms of appearance, sound, meaning and commercial impression.

B. The similarity or dissimilarity and nature of the goods; and,

C. The similarity or dissimilarity of established, likely-to-continue trade channels.

It is well settled that likelihood of confusion is determined on the basis of the goods as they are identified in the application and the cited registration. *Hewlett-*

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<sup>10</sup> Blenden Deposition, p. 19..

*Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976). We cannot read any limitations or restrictions into the description of goods and services. *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"); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983). If the application and/or opposer's registrations describe the goods and services broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the application and/or opposer's registrations encompass all the goods and/or services of the type described, that they move in same channels of trade normal for these goods and/or services, and that they are available to all classes of purchasers

for the described goods and/or services. *In re Linvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

Applicant describes his services as follows:

Applicant . . . is engaged in the Silk (sic) screening of designs onto T-shirts. The designs come from the general public, Silk (sic) screened onto T-shirts and offered back to the public for sale.<sup>11</sup>

Applicant has used and presently uses the mark "F.Y.B.Y." and design on T-shirts using the Silk (sic) screening process described."<sup>12</sup>

On the other hand, opposer's registrations describe the clothing products broadly and without limitation as to style, price, channels of trade or classes of purchasers. Consequently, the clothing identified in opposer's registrations may include t-shirts and sweatshirts with silkscreen designs sold to all potential consumers, including ordinary consumers. Also, applicant's description of services is without any restrictions or limitations, and applicant has stated in his answer that "[t]he designs come from the general public, Silk (sic) screened onto T-shirts and offered back to the public for sale."<sup>13</sup> Therefore, we consider applicant's silkscreen painting services as being available to all potential

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<sup>11</sup> Answer, ¶1.

<sup>12</sup> Answer, ¶2.

<sup>13</sup> Answer, ¶1.

consumers of clothing, including ordinary consumers. Accordingly, opposer's clothing products and applicant's services of silkscreen painting on clothing move in the same channels of trade and are sold to the same class of purchasers.

It is well settled that the goods and services of the applicant and the opposer do not have to be identical or directly competitive to support a finding that there is a likelihood of confusion. It is sufficient if the respective goods and services are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give rise to the mistaken belief that they emanate from or are associated with a single source. *In re Albert Trostel & Sons Co.*, *supra* at 1785; *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). In this case, applicant's silkscreen painting services are related to opposer's clothing products because clothing, particularly t-shirts and sweatshirts, often display designs that are created by the consumer, affixed by silkscreen, and then sold back to the same consumer. Accordingly, consumers encountering clothing and services identified by similar

marks could mistakenly believe that the goods and services emanate from a single source.

D. Balancing the factors.

In view of the similarities of the marks, the goods and services, and the channels of trade, we find that applicant's mark FYBY FOR Y'ALL BY Y'ALL and Design, when used in connection with "silk screen painting on clothing" so resembles opposer's FUBU marks for clothing as to be likely to cause confusion. To the extent that any doubt might exist as to whether a likelihood of confusion exists, we resolve such doubt against the applicant. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1998).

Decision: The opposition is sustained and registration to applicant is refused.