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SEPT 23, 97

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

B.U.M. International, Inc.
v.
Jeff L. Kaplan

Opposition No. 98,027
to application Serial No. 74/498,791
filed on March 10, 1994

Bruce R. Greene and Cynthia E. Fruchtman of Richman,
Lawrence, Mann, Greene, Chizever, Friedman & Phillips for
opposer

Jeff L. Kaplan, pro se

Before Sams, Cissel and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

B.U.M. International, Inc. filed its opposition to the
application of Jeff L. Kaplan to register the mark B.U.M.
SYSTEMS "BUYING USED MUSIC" for "retail store services in
the field of used compact discs, CD-ROM, audio, visual and
computer related items."¹

¹ Application Serial No. 74/498,791, filed March 10, 1994, based upon
use of the mark in commerce in connection with the identified services
alleging first use and first use in commerce as of November 1, 1990.

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's services, so resembles opposer's previously used and registered mark, as shown below,



for "clothing, namely, pants, shirts, sweatshirts, shorts, t-shirts, tank tops, overalls, jackets, sweatpants and cardigans"² as to be likely to cause confusion under Section 2(d) of the Trademark Act. Opposer asserts, further, that, while the above-identified mark is opposer's primary mark, opposer owns additional trademark registrations which contain the word B.U.M.³ and opposer has registered its

² Registration No. 1,430,327, issued February 24, 1987, to Derek A. Federman. [Renewed for a term of twenty years; Section 15 acknowledged.] Record title to the registration is in opposer's name.

³ Opposer lists the following registrations: Nos. 1,763,731 and 1,794,343 (AQUA B.U.M.); Nos. 1,712,713 and 1,803,738 (BABY B.U.M.); No. 1,753,290 (BASEBALL B.U.M.); No. 1,768,116 (BIG B.U.M.); No. 1,665,480 (B.U.M. BLUES); No. 1,805,374 (B.U.M. FOOTWEAR); No. 1,805,373 (BUM FOR MEN); No. 1,533,267 (B.U.M. GEAR GENUINE BY B.U.M. EQUIPMENT); No. 1,724,691 (B.U.M. AROUND); No. 1,613,951 (B.U.M. IT); No. 1,802,774 (B.U.M. KICKS); No. 1,810,074 (B.U.M. KIDS); No. 1,751,943 (B.U.M. RUNNER); No. 1,794,325 (B.U.M. SPORT); No. 1,808,516 (B.U.M. SPORTS EQUIPMENT); No. 1,751,940 (CYCLE B.U.M.); No. 1,751,936 (GENTLEMAN B.U.M.); No. 1,765,300 (JUMPIN B.U.M.); No. 1,766,772 (LI'L B.U.M.); No. 1,823,768 (LITTLE B.U.M.); No. 1,765,299 (MARATHON B.U.M.); No. 1,746,459 (MUSCLE B.U.M.); No. 1,757,674 (OCEAN B.U.M.); No. 1,746,455 (RACQUET B.U.M.); No. 1,746,454 (ROLLER B.U.M.); No. 1,757,675 (SEA B.U.M.); No. 1,737,405 (SKI B.U.M.); No. 1,794,336 (SOCCER B.U.M.); No. 1,796,627 (SURF B.U.M.); No. 1,751,941 (VOLLEY B.U.M.); and No. 1,751,944 (WORKOUT B.U.M.). While these registrations were not made of record properly by opposer, applicant admits, in his answer, the truth of opposer's statement of ownership of these registrations. However, as

primary mark in connection with a wide variety of goods;⁴ that opposer has been "using, advertising and promoting its various trademarks which include the mark B.U.M. and B.U.M. EQUIPMENT . . . continuously in commerce since 1987"; that opposer has spent "substantial time, effort and sums of money to enhance the reputation of its numerous trademarks so that, regardless of format, "any merchandise" bearing the words B.U.M. EQUIPMENT will be recognized by consumers as emanating from opposer; that the notoriety of opposer's B.U.M. EQUIPMENT and related B.U.M. marks "extends well beyond the field of apparel"; and that "applicant became aware of opposer's substantial use of the trademark B.U.M. EQUIPMENT in connection with the sale of items of apparel

opposer has not provided any other information about these registrations, in particular, the goods identified in the registrations, we find that this evidence establishes only that opposer owns registrations for variations of the B.U.M. marks, as noted herein. This evidence does not establish in this record the nature or scope of the goods for which such marks are registered or that such marks are in use.

⁴ Of record are two registrations, in addition to the primary pleaded registration, for the mark B.U.M. EQUIPMENT and design. Registration No. 1,765,172, issued April 13, 1993, for "retaining bands for eyeglasses and sunglasses, sunglass floater to prevent sunglasses from sinking in water and life preservers" in Class 9; "vehicle license plate covers" in Class 12; "watches" in Class 14; "luggage, ski bags, boot bags, and cases for carrying lip balm sold empty; umbrellas" in Class 18; "beach chairs" in Class 20; "plastic water bottles for household use and plastic or foam insulated can and bottle coolers for household use" in Class 21; "towels" in Class 24; "socks, shoes, gloves, scarves and sun visors" in Class 25; and "saucer shaped toy for throwing and catching" in Class 28. The registration indicates dates of first use and first use in commerce of December 4, 1992, in connection with goods identified in Classes 9, 12, 14, 20, 24, 25 and 28; and of November 13, 1992, in connection with goods identified in Classes 18 and 21. Registration No. 1,697,485 issued on June 30, 1992, for "sunglasses and sunglass cases" in Class 9; "stickers" in Class 16; "backpacks, fanny packs, tote bags, brief cases and wallets" in Class 18; "non-metal key chains" in Class 20; "caps and sun caps" in Class 25; and "hair ties" in Class 26. The registration indicates dates of first use and first use in commerce in connection with the identified goods of May 1, 1991.

and other merchandise sold in retail stores throughout the United States" and "sought to trade on the substantial goodwill and trademark recognition created by opposer."⁵

Applicant, in his answer, denied the salient allegations of the likelihood of confusion claim. However, in his answer, applicant admitted that opposer owns and for many years has used the trademark B.U.M. EQUIPMENT and other identified variations thereto which include the word B.U.M.; and, in his brief, applicant admitted that "opposer has shown strength and weight in the leisure clothing industry."

The Record

The record consists of the pleadings; the file of the involved application; title and status copies of opposer's pleaded Registrations Nos. 1,430,327; 1,697,485; and 1,765,172; and the testimony deposition of Morton Forshpan, opposer's chairman and CEO, with accompanying exhibits.

Applicant submitted no testimony or other evidence. Both parties filed briefs on the case.⁶

⁵ Also in its notice of opposition, opposer alleges that "[o]n May 13, 1994, opposer's attorneys directed a letter to a corporation named B.U.M. Systems, Inc. in Boca Raton, Florida (which opposer alleges . . . to be owned and controlled by applicant) advising it of the potential infringement of its corporate name with opposer's trademark"; and attaches a copy of this letter to its notice of opposition. Applicant, in his answer, denies receipt of this letter. However, opposer did not make this letter properly of record during its testimony period and, further, there is no subsequent reference to this letter in the record so that its relevance to the issues before us is not clear. Thus, we give no consideration to this letter and opposer's allegations in relation thereto.

⁶ Applicant submitted a brief prematurely on November 12, 1996, which, per order of the Board, dated December 31, 1996, has been given no consideration herein. Rather, applicant's properly submitted brief of January 27, 1997, has been considered herein.

Analysis

In view of applicant's admissions and the certified copies in the record of opposer's three registrations for the mark B.U.M. EQUIPMENT, there is no issue as to opposer's priority with respect to the mark B.U.M. EQUIPMENT. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

We turn then to the question of likelihood of confusion. Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

As there is little evidence bearing on the other factors enumerated in the *duPont* case, the key considerations in this case are the similarities between the goods, the similarities between the marks and the reputation, or fame, of opposer's mark. We consider, first, the similarities between the goods of the parties. Opposer's evidence establishes that its mark, B.U.M. EQUIPMENT, is registered in connection with clothing and a number of related items; that this mark is used in connection with clothing, particularly casual clothing; and that opposer's primary business is the production of men's

and women's clothing which is sold in department stores, such as Macy's, J.C. Penny's and Sears, and in outlet stores, such as Cammies. We find that the majority of the non-clothing items identified in the aforementioned registrations are goods that are closely related to clothing, including accessories such as sunglasses and glasses-related items, watches, hair ties, shoes, gloves, scarves and sun-visors, as well as the various identified types of packs, bags and wallets. The other identified items, such as stickers, key chains, license plate covers, beach chairs, water bottles and coolers, towels and a throw-toy, are related to clothing to the extent that all of these goods are relatively low-cost consumer goods that may be sold by opposer as promotional items in connection with its mark which is primarily used in connection with clothing.

On the other hand, the services identified in the application herein are retail store services in the field of used compact discs, CD-ROM, audio, visual and computer related items. Not only do applicant's proposed services appear on their face to be vastly different from both opposer's clothing business and the other goods identified in opposer's registrations, but the record contains absolutely no evidence establishing any connection between opposer's goods and the services identified in the application. Further, the record contains no evidence

indicating that applicant's services might be within the scope of natural expansion of opposer's business.

Considering, next, the marks, we must base our determination on a comparison of the marks in their entireties. However, we are guided, equally, by the well-established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "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." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Applicant's and opposer's marks share the term B.U.M. The record contains no evidence in support of applicant's contentions that the B.U.M. portion of opposer's mark is suggestive of the casual style of clothing identified thereby. Rather, the record supports the conclusion that, in connection with clothing and related items and accessories, B.U.M. is an arbitrary term. Further, regarding opposer's mark, B.U.M. EQUIPMENT, EQUIPMENT is suggestive of clothing and accessories, thus, B.U.M. is likely to be perceived as the dominant portion of the mark. This perception is likely to be reinforced by the numerous other registrations owned by opposer for various marks containing the term B.U.M.

We do not find the marks herein to be confusingly similar simply because applicant's mark contains the term B.U.M., which has been found to be the arbitrary and dominant portion of opposer's mark. Rather, we must look at both marks in their entireties to determine whether the marks engender similar overall commercial impressions. The B.U.M. portion of applicant's mark is clearly an acronym for the portion of applicant's mark, BUYING USED MUSIC. In this context, the phrase B.U.M. SYSTEMS in applicant's mark is suggestive of an aspect of applicant's retail store services, namely that such services establish a "system" by which consumers may buy and, perhaps, sell "used music" in the form of used compact discs, etc. Thus, B.U.M. is not an arbitrary term as it appears in applicant's mark. We find this factor to be a significant difference between the parties' marks such that they do not convey similar overall commercial impressions. Rather, we find that when opposer's and applicant's marks are considered in their entireties, they engender distinctly different overall commercial impressions. The differences in the overall commercial impressions of the parties' marks are reinforced when the marks are considered in connection with the vastly different goods and services of applicant and opposer.

With regard to the reputation of opposer's mark, we previously noted applicant's admission that opposer's mark,

B.U.M. EQUIPMENT, is a "strong" mark in connection with leisure clothing. Further, we find that the record supports the conclusion that opposer's mark, B.U.M. EQUIPMENT, is famous in connection with clothing, particularly in the category of casual clothing.⁷ Opposer's chairman and CEO, Morton Forshpan, testified that for all goods bearing the B.U.M. trademarks, opposer's sales volume for the five-year period prior to his testimony in July, 1996, was approximately \$1.2 billion retail or \$700 million wholesale; that opposer's advertising includes celebrity athlete sponsors such as Oscar de la Hoya, Larry Holmes and Willy Galt and sports teams such as the L.A. Kings and the L.A. Clippers; that a trade publication about legendary trademarks identifies opposer's clothing mark, B.U.M. EQUIPMENT, as one such mark;⁸ and that, in 1993, J. C. Penny conducted a survey that rated opposer's mark, B.U.M. EQUIPMENT, as one of the most recognizable clothing brands, second only to Levis. The record also includes a copy of an article in *Women's Wear Daily*, November, 1995, stating that a survey of the top ten recognizable brands in the United States ranked opposer's mark, B.U.M. EQUIPMENT, as number 3 in the "young/contemporary" category.

⁷ While opposer has made of record two registrations for its mark, B.U.M. EQUIPMENT, for non-clothing items, the record contains no evidence regarding use of the mark in connection therewith or that the fame of opposer's mark extends beyond the clothing field.

⁸ While the referenced article is included as an exhibit to Mr. Forshpan's testimony, the copy submitted is entirely illegible. Thus,

In view of the fame of opposer's mark, B.U.M. EQUIPMENT, in the clothing field, opposer may preclude the subsequent registration of the same or similar mark in connection with the same or similar goods or services, as well as in connection with any goods or services which might reasonably be assumed to emanate from it in the natural expansion of its business under the mark. However, notwithstanding the fame of opposer's mark, opposer is not entitled to preclude the subsequent registration of the same or similar mark in connection with any and all goods and services including those completely unrelated to the goods of opposer. To do otherwise would be to bestow upon opposer a right in gross which is contrary to Section 2(d) and to the recognized principle of trademark law that ownership of a mark does not create a "monopoly" therein. *Amica Mutual Insurance Company v. R.H. Cosmetics Corp.*, 204 USPQ 155 (TTAB 1979) and cases cited therein; *Penthouse International, Ltd. v. Dyn Electronics, Inc.*, 196 USPQ 251 (TTAB 1977).

In the case before us, not only have we found that the marks of the parties convey different overall commercial impressions as applied to the respective goods, but we have found that the goods and services of the parties are vastly different, and that applicant's services are not within the

only Mr. Forshpan's statements in this regard have been considered

scope of natural expansion of opposer's business under its mark. Thus, opposer has not met its burden of proof in showing that confusion is likely. Based on the very sparse record before us, we see the likelihood of confusion claim asserted by opposer as amounting to only a speculative, theoretical possibility. Language by our primary reviewing court is helpful in resolving the likelihood of confusion controversy in this case:

We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed Cir. 1992), citing *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), aff'g 153 USPQ 412 (TTAB 1967). Simply put, a consumer familiar with opposer's mark, B.U.M. EQUIPMENT, and other B.U.M. marks in connection with apparel and miscellaneous related items and accessories is not likely to believe, upon encountering applicant's mark B.U.M. SYSTEMS "BUYING USED MUSIC" in connection with applicant's identified retail store services, that the goods and services originate or are associated with the same entity.

herein.

Decision: The opposition is dismissed.

J. D. Sams

R. F. Cissel

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board