

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Bydesign**

Serial No. 75/084,212

Arthur L. Plevy of **Plevy & Associates** for applicant
Raul Cordova, Trademark Examining Attorney, Law Office 108
(**David Shallant**, Managing Attorney)

Before **Seeherman**, **Hairston** and **Bucher**, Administrative
Trademark Judges.

Opinion by **Bucher**, Administrative Trademark Judge:

Applicant, **Bydesign**, a Delaware corporation, has
filed an application for registration of the mark "**PASSI**"
for "clothing, namely ladies' sweaters, knit tops, and
dresses; ladies' fleece tops and bottoms; ladies' jackets
and rompers, ladies' knit and woven blouses and jerseys."¹

¹ Serial No. 75/084212, in International Class 25, filed
April 5, 1996, based on an allegation of a *bona fide* intention to
use the mark in commerce.

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's proposed mark, PASSI, when used on these clothing items, so resembles the registered mark, **PASSO**, as shown below, as applied to, *inter alia*, "clothing, namely, T-shirts, aprons and hats," as to be likely to cause confusion, or to cause mistake, or to deceive.²



Applicant has appealed the final refusal to register. Briefs have been filed but applicant did not request an oral hearing. We affirm the refusal to register.

Applicant asserts that the respective goods are unrelated and move in different channels of trade, and that the marks have different commercial impressions, pronunciations and meanings.

² Registration No. 1,375,820, issued on December 17, 1985. The registration sets forth a date of first use of March 5, 1985 and a date of first use in commerce of March 5, 1985; §8 affidavit accepted and §15 affidavit filed. In addition to the clothing items in Int. Class 25, this multiple-class registration also includes "Heat transfers or iron-on decals," in Int. Class 16.

The Trademark Examining Attorney contends that the goods of both parties are common items of apparel moving in the same channels of trade, with marks that are similar in appearance and sound.

In the course of rendering this decision, we have followed the guidance of *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973), which sets forth the factors which, if relevant, should be considered in determining likelihood of confusion.

There can be little question that the goods of the parties are closely related. Indeed, the T-shirts identified in the cited registration are similar to several items of applicant's identified clothing, such as women's sweaters, blouses and various tops.³

Applicant argues that since the registration includes iron-on decals, hats and aprons, then presumably registrant's goods move in different channels of trade from the "ordinary, day-to-day apparel items" listed in applicant's application. However, that argument ignores the fact that the registration lists T-shirts without any type of restriction. It is fundamental that likelihood of

³ See *In re M. Serman & Company, Inc.*, 223 USPQ 52 (TTAB 1984) [T-shirts closely related to sweaters and skirts].

confusion must be assessed on the basis of the goods as described in the trademark application and cited registration.⁴ T-shirts and knit tops, woven and knit blouses and jerseys, and the like, are all items that may be sold to the same class of consumers and in the same channels of trade, including women's clothing stores. Therefore, we must consider applicant's goods and those of the registrant to travel in the same channels of trade. Furthermore, applicant's and registrant's goods are the types of items that are purchased by members of the general public. Because of the nature of the items, such ordinary purchasers are not likely to exercise a great degree of care in their selection.

We turn then to the question of whether the marks involved herein are so similar that use thereof on the identified goods would be likely to generate confusion. In evaluating the similarity of the marks, the Board must examine the overall impression created by the marks, including a comparison of the appearance, sound and meaning of the marks, as well as the manner in which they are displayed. Under the sight, sound and connotation trilogy, we find that there is a likelihood of confusion.

⁴ Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

First, the Board notes that each mark comprises a single, five-letter word beginning with the identical four letters, "PASS-" and ending with a vowel. Given the composition of these two words, applicant's mark is much closer in overall appearance to registrant's mark than applicant would have us conclude.

While registrant's mark involves a somewhat stylized presentation, we find that such is not sufficient to distinguish the marks. Inasmuch as it is the word portion that is spoken, consumers would remember the word comprising registrant's mark rather than any stylization. Moreover, applicant has applied for the mark in the form of a typed drawing. A registration issuing in that format would enable applicant to use its mark in a stylized manner, including a stylization not unlike registrant's special form drawing.

The marks can also be pronounced similarly. Although neither is an English word, it is reasonable to conclude that because they share a similar structure - the letters P-A-S-S followed by a vowel -- they would be accorded a similar sound and cadence.⁵

⁵ Cf. *Beer Nuts, Inc. v. Clover Club Foods Co.*, 805 F.2d 920, 926, 231 USPQ 913, 916-917 (10th Cir. 1986) ("**BREW NUTS**" and "**BEER NUTS**" were held to be similar marks).

With respect to the connotations of the terms, the Trademark Examining Attorney has made of record an excerpt from an Italian dictionary that shows a definition of "PASSO" meaning "passage" or "step." There is no evidence of a meaning for "PASSI"; applicant indicates that it was selected because it is the surname⁶ of one of the officers of applicant corporation. In any event, we find that ordinary purchasers of these clothing items would not be familiar with the likely origins of these words as debated by the applicant and the Examining Attorney. The average consumer seeing these two unfamiliar words on clothing items would not ascribe a connotation to either mark. Accordingly, the Board concludes that most consumers would regard the marks as arbitrary, and would not distinguish them based upon their connotations.

Although we acknowledge that there are slight differences between the marks, consumers would neither note nor remember such differences. Under actual marketing conditions, consumers do not necessarily have the luxury of

⁶ The Trademark Examining Attorney never refused registration on the ground that applicant's mark is primarily merely a surname under §2(e)(4) of the Act, perhaps because applicant stated that it was a rare surname. In any event, that issue is not before us.

making side-by-side comparisons between marks and must rely upon their imperfect recollections.⁷

Applicant has argued that the cited mark is weak and therefore should be accorded a narrow scope of protection. It bases this argument on excerpts from some computer records taken from an unidentified source. In the Office action following this submission, the Trademark Examining Attorney objected to applicant's submission, stating that evidence of these registrations was not in the proper form. The Examining Attorney's objection is well taken.⁸ In order to make third party registrations of record, soft copies of the registrations or photocopies of the appropriate U.S. Patent and Trademark Office electronic printouts must be submitted.⁹

We should point out in passing that even if the registrations had properly been made of record, they would not alter our decision herein. We remain unpersuaded by applicant's attempt to portray "PASS-" formative marks as being weak in the clothing field. Not one of the third-party marks submitted by applicant (e.g., "PUNT, PASS AND

⁷ Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980).

⁸ In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983).

⁹ See, Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992).

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KICK," "PASSWORD," "PASSIONATE") is as similar to PASSO as is applicant's PASSI. While the two marks at issue in the instant case have very similar appearances, they look nothing at all like those marks where the word "PASS" is used in its ordinary English language meaning, or is used as the root of another ordinary English word

Accordingly, we find confusion to be likely between the mark "**PASSI**" for the women's clothing items recited in the instant application and the registered stylized mark, "**PASSO**" as applied to T-shirts, aprons and hats.

Decision: The refusal to register is affirmed.

E. J. Seeherman

P. T. Hairston

D. E. Bucher
Administrative Trademark
Judges, Trademark Trial and
Appeal Board