

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB
TEH/cbg

9/23/99

Opposition No. 104,381

Bodywaves, Inc.

v.

Stephen Malouf

Before Simms, Cissel and Holtzman, Administrative Trademark
Judges.

By the Board.

Applicant has applied to register the mark MY
BOYFRIEND'S T for the following goods: "clothing, namely,
T-shirts, sleepshirts and skirts, pajamas, boxers, shirts."
The application, Serial No. 75/022,478, was filed November
20, 1995, based on applicant's assertion of a bona fide
intention to use the mark in commerce under Trademark Act
Section 1(b), 15 U.S.C. §1051(b). Applicant has disclaimed
the letter "T."

Opposer filed a timely notice of opposition, alleging,
as the ground for opposition, priority of use and
likelihood of confusion under Trademark Act Section 2(d),
15 U.S.C. §1052(d). Specifically, opposer alleges that it
has been in the business of designing and manufacturing

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clothing since 1986; that it continuously has used the mark MY BOYFRIEND in interstate commerce in connection with clothing articles since October 30, 1986; and that confusion would be likely to result from applicant's use of MY BOYFRIEND'S T on the goods identified in his application. Opposer also alleges that it filed an application to register MY BOYFRIEND, which has been suspended due to a potential likelihood of confusion with MY BOYFRIEND'S T, the mark at issue herein.

Applicant has filed an answer in which he denies the salient allegations of opposer's notice of opposition. In addition, applicant has affirmatively asserted that "[o]pposer has not used the mark applied for, or any similar mark in interstate commerce"; that "[o]pposer has never used the name outside of local commerce"; that "[i]f opposer has used any similar mark to the one applied for, it has been abandoned"; that "opposer has not used [the] mark applied for on a continuous basis"; and that "opposer has failed to continuously use [the] mark in commerce."

This case now comes up on opposer's motion for summary judgment on its Section 2(d) claim. The parties have fully briefed the motion.¹

In the motion for summary judgment, opposer argues that there are no genuine issues of material fact with respect to priority and likelihood of confusion. Opposer maintains that it has priority by virtue of its use of the mark dating to 1986. Opposer further contends that the involved marks are similar in appearance, sound, and meaning, and that the involved goods are identical and are sold to the same class of purchasers.²

As evidence in support of its motion, opposer submitted portions of applicant's responses to opposer's interrogatories and document requests, including examples of applicant's use of the mark MY BOYFRIEND'S T on the identified goods, such as labels and hang tags, and the declaration of Andy Su, opposer's president, attesting to, *inter alia*, the continuous use of MY BOYFRIEND since 1986.

¹ We note that applicant's response to the summary judgment motion was not timely filed. However, in the interest of justice, and since it is the policy of the law to decide cases on their merits, we have considered applicant's response in making our decision.

² Opposer also states that it owned a registration for the mark MY BOYFRIEND (U.S. Registration No. 1,502,308) for blouses, skirts, pants, shorts and dresses, which was cancelled for failure to timely file an affidavit of continuing use.

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In opposition to this motion, applicant argues that he has priority because he filed his application for MY BOYFRIEND'S T on November 20, 1995, and began to use the mark in commerce on December 2, 1996, while opposer filed its application to register MY BOYFRIEND on April 8, 1996. Applicant also argues that "[s]ince Applicant has gone through the legal channels to obtain the mark MY BOYFRIEND'S T, Opposer should not be granted a motion for summary judgment." Applicant further argues that there is no likelihood of confusion because the goods are different, that his goods consist of a "men's inspired comfort and leisure clothing collection for women who like to borrow such items from their boyfriend's wardrobe," and that:

[s]uch product follows strong marketing strategies and do [sic] not in any way or form follow unethical copying of any other label or product line already bearing a similar name. Stephen Malouf immediately sought to protect this trade name, recognizing the strength of the product which is now currently used in commerce. . . . Opposer does not produce a similar product as claimed. We do not make leggings, blouses, dresses; the average man does not wear such an item. We manufacture clothing that is men's inspired; something you borrow from your boyfriend. There is no confusion in the marketplace as claimed.

In support of his arguments, applicant submitted: a copy of opposer's responses to applicant's interrogatories and document requests; a copy of the filing receipt and notice of publication for MY BOYFRIEND'S T; copies of several invoices for sales of clothing items under the mark

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MY BOYFRIEND'S T, dating to December 1, 1996; a copy of a portion of a computer search report that lists only applicant's mark and opposer's mark; and a copy of opposer's application to re-register MY BOYFRIEND, including a drawing page, a copy of a specimen, which appears to be a label, and the Office Action suspending opposer's application.

Summary judgment is appropriate when the record shows that there is no genuine issue of material fact and that the moving party is entitled to judgment as a matter of law. Rule 56(c). A dispute as to a material fact issue is genuine only if a reasonable fact finder viewing the entire record could resolve the dispute in favor of the nonmoving party. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). In deciding a motion for summary judgment, the Board must view the evidence in the light most favorable to the nonmovant and must draw all reasonable inferences from underlying facts in favor of the nonmovant. *Id.*

The party seeking summary judgment bears the initial burden of informing the Board of the basis for its motion and identifying those portions of the record which it believes demonstrate the absence of a genuine issue of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317,

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106 S. Ct. 2548 (1986). When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely disputed facts which must be resolved at trial. The nonmoving party may not rest on mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record, or produce additional affidavit evidence showing the existence of a genuine issue of material fact for trial. If the nonmoving party does not so respond, summary judgment, if appropriate, shall be entered in the moving party's favor. Rule 56(e).

In this case, we believe that opposer has carried its burden of showing *prima facie* the absence of any genuine issue of material fact, and its entitlement to judgment as a matter of law. Applicant has not presented any affidavit or other evidence showing the existence of a genuinely disputed fact issue for trial, but rather has argued the merits of the likelihood of confusion issue. We do not find applicant's arguments persuasive.

First, there is no genuine issue of material fact as to opposer's priority.³ For purposes of establishing priority in this type of proceeding, an opposer will prevail if it can establish use prior to the filing date of the applicant's intent-to-use application, or prior to the earliest date of use on which the applicant is entitled to rely. The fact that applicant filed his application before opposer filed its application is not determinative where, as here, opposer has shown earlier use.

In this case, Mr. Su avers in his declaration that opposer first used the mark MY BOYFRIEND on October 30, 1986. In addition, the exhibits that Mr. Su introduced are sufficient to establish opposer's use of the mark MY BOYFRIEND well before the date on which applicant filed his intent-to-use application, and before applicant's claimed date of first use. Specifically, exhibit B to the Su

³ In this regard, we note that applicant has not asserted any of his affirmative defenses in response to the summary judgment motion, nor would such affirmative defenses have been sufficient to raise genuine issues as to priority. Even if we were to assume that opposer had abandoned the mark between 1988 and 1991, opposer's 1991 use date is still earlier than any date to which applicant has attested, and opposer has provided uncontroverted evidence of continued use. Moreover, it is irrelevant whether opposer's prior use was strictly intrastate in nature. While interstate use is a prerequisite to obtaining a federal registration, opposer may prevail in an opposition proceeding upon a showing of priority of use in any geographic area of the United States. See *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477 (TTAB 1998).

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declaration includes numerous invoices that clearly show opposer's use of the mark MY BOYFRIEND for articles of clothing in 1987, 1988, and 1991-1997. On the other hand, in response to opposer's interrogatory No. 7, applicant avers that his first use of the mark MY BOYFRIEND'S T on clothing was December 2, 1996. As the December 2, 1996 date is after applicant's 1995 filing date, applicant is entitled to rely on his earlier filing date for purposes of priority, rather than this later actual use date. However, opposer's first use of its mark predates even applicant's 1995 filing date. Accordingly, opposer has established its prior right to use the mark MY BOYFRIEND as a matter of law.

We find that opposer also has carried its burden of establishing that no genuine issues of material fact remain and that it is entitled to judgment as a matter of law on the issue of likelihood of confusion. In reaching our decision, we have carefully considered the relevant likelihood of confusion factors enumerated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

First, there is no genuine issue of material fact as to the similarity of the parties' goods. We are not

persuaded by applicant's arguments that his goods are distinguishable from opposer's goods. As noted above, applicant has identified his goods as: "clothing, namely, T-shirts, sleep shirts and skirts, pajamas, boxers, [and] shirts." Opposer has identified its goods as: "clothing; namely blouses, skirts, pants, shorts and dresses." The respective goods include an identical item (skirts) as well as other highly related clothing items.

It is not even necessary that the goods be identical in order to find a likelihood of confusion. Rather, it is sufficient that the goods are related in some manner that consumers encountering them under their respective marks are likely to assume that the goods originate from the same source or that there is some association between the sources. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). Further, the decisions in this field have held many different types of apparel related under Section 2(d). See, e.g., *In re M. Serman & Co., Inc.*, 223 USPQ 52 (TTAB 1984) ("CITY WOMAN" for blouses vs. "CITY GIRL" for, *inter alia*, shirts, skirts, and T-shirts); *Varsity Pajamas, Inc. v. Schackne*, 143 USPQ 428 (TTAB 1964) ("VARSITY HOUSE" for, *inter alia*, T-shirts

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vs. "VARSITY" for, *inter alia*, underwear, pajamas and nightshirts); *In re M. H. Raab-Meyerhoff Co.*, 171 USPQ 172 (TTAB 1971) ("RT" for shirts for men, women and boys vs. "RT" for, *inter alia*, skirts, shorts and blouses for women and girls); *Tudor Square Sportswear, Inc. v. Pop-Op Corp.*, 160 USPQ 50 (TTAB 1968)("CHEETAH" and a fanciful representation of a cheetah for belts, skirts, hats and pants vs. "CHEETAHS" for ladies' pants); *Ex parte Julette Originals*, 69 USPQ 178 (Comm'r Pat. 1946)("JULETTE" for dresses vs. "JULIETTE" for sleeping garments for men, women and children.)

Moreover, the nature and scope of an applicant's goods must be determined on the basis of the goods identified in the application. *See, e.g., Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). Applicant's identification of goods contains no limitations as to the trade channels through which and the classes of purchasers to whom applicant's goods are offered. Therefore, we must presume that applicant's goods are offered in all normal trade channels and to all classes of purchasers, including those to whom opposer's goods are offered. *See Canadian Imperial Bank of Commerce, supra.*

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Second, applicant has failed to identify any genuine dispute as to the similarity of the parties' marks which would require resolution at trial. In this vein, although we recognize that the marks are to be viewed in their entireties, one portion of a mark may be considered more prominent in determining similarity. See *Giant Food, Inc. v. National Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Disclaimed matter typically is less significant or less dominant. See *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

As noted above, applicant has disclaimed the letter "T" apart from the mark as shown. Accordingly, and because "T" is a descriptive or generic part of applicant's mark, the words MY BOYFRIEND'S comprise the dominant portion of applicant's mark. Viewing the marks in their entireties, as we must, we find that the marks MY BOYFRIEND'S T and MY BOYFRIEND create highly similar commercial impressions.

Further, neither party is limited to using their respective marks in any particular form. In this regard, the evidence of record shows that applicant and opposer do, in fact, use their marks in a similar manner on labels and hang tags. Opposer's specimen of use, which seems to be a

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label, and examples of applicant's hang tags and labels, have been reproduced below.

Opposer's specimen of use appears as follows:

Applicant's hang tags and labels appear as follows:

(hang tag)

(label)

Both parties place the word MY above and to the left side of the word BOYFRIEND or BOYFRIEND'S, the words appear in all capital letters, and the fonts are similar. In addition, applicant uses a stylized design of a T-shirt to represent the letter "T" in its mark. The T-shirt design is placed below the words MY BOYFRIEND'S. Such placement

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and usage may create the impression that applicant's mark is MY BOYFRIEND'S, rather than MY BOYFRIEND'S T.

Accordingly, we find that there is no genuine issue of material fact with respect to the similarity or dissimilarity of the parties' marks in their entireties in terms of appearance, sound, connotation and commercial impression.

Because there are no genuinely disputed factual issues which require trial for their resolution, because the undisputed facts of record establish, as a matter of law, that opposer is entitled to judgment on its Section 2(d) claim, and because applicant has not established a valid defense to that claim, we grant opposer's motion for summary judgment. See Fed. R. Civ. P. 56(c).

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Judgment is hereby entered against applicant, the opposition is sustained and registration to applicant is refused.

R. L. Simms

R. F. Cissel

T. E. Holtzman
Administrative Trademark Judges
Trademark Trial and Appeal Board