5/2/01

**THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.**

Paper No. 47
EWH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Biflex International, Inc.
v.
Superflex S.A. de C.V.

Opposition No. 106,617
to application Serial No. 74/731,144
filed on September 19, 1995.

David B. Kirschstein of Kirschstein, Ottinger, Israel & Schiffmiller, P.C. for Biflex International, Inc.

John M. Rannells of Baker & Rannells for Superflex S.A. de C.V.

Before Hanak, Chapman and Bucher, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Superflex S.A. de C.V. (applicant) seeks to register BERLINA in typed drawing form for “underwear, namely, panties, bras, camisoles, robes, shirts, sleepwear and loungewear.” The intent-to-use application was filed on September 19, 1995.

Biflex International, Inc. (opposer) filed a notice of opposition alleging that long prior to September 19, 1995, it both used and registered the mark BERLEI for women’s intimate apparel, including brassieres. Continuing, opposer

further alleged that the contemporaneous use of the mark BERLINA by applicant and of the mark BERLEI by opposer for goods which, in part, are identical is likely to result in confusion, mistake and deception. While the notice of opposition did not make specific reference to Section 2(d) of the Trademark Act, it is clear that this is the basis for the opposition.

Applicant filed an answer which denied the pertinent allegations of the notice of opposition. Both parties made of record evidence and filed briefs. Neither party requested a hearing.

Both parties are in agreement as to what constitutes the record in this proceeding. Opposer summarizes the record at pages 2 and 3 of its brief. Applicant summarizes the record at pages 1-3 of its brief. The parties are also in agreement that, as stated by applicant at pages 1 and 3 of its brief, “there are no objections of record to any of the evidence submitted by either party.”

In addition, applicant concedes at page 1 of its brief that “priority is not an issue.” It rests with opposer. In this regard we note that opposer has properly made of record a certified status and title copy of its Registration Number

268,459 for the mark BERLEI depicted in typed drawing form for “corsets and brassieres.” This registration issued on March 18, 1930 with a claimed first use date of October 1917.

Thus, the only issue before this Board is whether there is a likelihood of confusion resulting from the contemporaneous use of opposer’s mark and applicant’s mark. In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the goods and the similarities of the marks. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

Considering first the goods, they are, in part, absolutely identical. Applicant seeks to register its mark BERLINA for, among other goods, bras. Opposer’s registration for its mark BERLEI includes brassieres. Applicant has never argued that the words “bras” and “brassieres” are not synonyms. Moreover, the word “brassiere” is defined as meaning “same as bra.” Webster’s

New World Dictionary (1975).

Considering next the marks, we note at the outset that when the goods of the parties are identical as is the case here, "the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). This is particularly true when not only are the goods identical, but in addition they are inexpensive items (such as bras) purchased by ordinary consumers exercising limited care. See Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984) and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Turning to a consideration of the marks, we note that marks are compared in terms of visual appearance, pronunciation and meaning or connotation. In terms of visual appearance, we find that the two marks are very similar. In both marks, the first four letters (BERL) are absolutely identical. Moreover, the letter "I" appears as one of the final two letters in opposer's mark and as one of the final three letters in applicant's mark.

In terms of pronunciation, applicant argues that to persons familiar with Latin based languages such as Spanish, Italian or Portuguese or that to persons familiar with Germanic language pronunciations “the two marks are readily distinguishable in pronunciation.” (Applicant’s brief pages 5-7). We do not understand applicant’s reasoning. The question before us is how the two marks will be pronounced in English. In this regard, applicant acknowledges “the general rule that there simply is no correct or proper pronunciation of trademarks in English and that this case is no exception.” (Applicant’s brief page 8). Applicant is absolutely correct. It is long been recognized that “there is no correct pronunciation of a trademark.” In re Belgrade Shoe, 411 F.2d 1352, 162 USPQ 227 (CCPA 1967).

We accept opposer’s argument that the last two letters of its mark BERLEI would typically be pronounced with the sound of “ee.” Moreover, we accept opposer’s argument that the letter “I” in applicant’s mark BERLINA would likewise be pronounced with the sound of “ee.” Applicant has contended, as will be discussed at greater length later, that Berlina is a feminine given name and a surname. See applicant’s brief page 9. Indeed, applicant’s director of operations

testified that while in the United States, he “met a girl whose name was Berlina,” and this is how applicant’s mark was derived. (Gonzalez deposition page 8). Assuming for the sake of argument the correctness of applicant’s position that its mark BERLINA would be perceived as a feminine name, then it follows in English that the “I” in applicant’s mark would be pronounced with the sound of “ee” just as the letter “I” in the following feminine names is pronounced with the sound of “ee”: Nina, Tina, Christina and Sabrina.

In short, given the fact that there is no correct pronunciation of a trademark, one reasonable manner of pronouncing opposer’s mark is as BERLEE and one reasonable manner of pronouncing applicant’s mark is BERLEENA. When so pronounced, the two marks are quite similar in that the only difference is that applicant’s mark has the final NA sound.

Finally, in terms of meaning or connotation, opposer and applicant agree that opposer’s mark BERLEI is a coined term which has no meaning in English. (Applicant’s brief page 10; opposer’s brief page 6). As for applicant’s mark BERLINA, we note that during the application process applicant stated in a paper dated March 26, 1996 the following: “The applicant submits that BERLINA has no

significance in the relevant trade or industry. Also, it has no meaning in any foreign language." In a paper dated December 20, 1996 applicant stated that Berlina is a "given feminine name."

Now, however, applicant argues that BERLINA is a given name and a surname; that BERLINA also engenders an association with the German city of Berlin; and that BERLINA refers to a "sedan style of automobile" or a "saloon car." (Applicant's brief page 9). We find applicant's arguments to be unpersuasive. This Board has consulted numerous dictionaries and has found no listing for the word "berlina." The words "berline" and "berlin" are defined as "a limousine with a glass window between the front and rear seats." The American Heritage Dictionary for the English Language (1992). We seriously doubt that all but an insignificant number of American consumers would understand the meanings of these obscure words "berline" or "berlin." Moreover, we do not believe that most Americans would recognize BERLINA as a feminine name, nor would they recognize BERLINA as referring to the world famous city of Berlin. In short, both applicant's mark and opposer's mark are, to the vast majority of Americans, arbitrary in nature.

In other words, consumers would not be able to distinguish the two marks based on the fact that one mark has a certain meaning (or no meaning) and the other mark has another meaning.

Overall, we find that the marks are very similar in terms of visual appearance and pronunciation, and that further the vast majority of Americans would not be able to distinguish the two marks based on differences in meaning or connotation.

Given the fact that the marks are used on identical inexpensive consumer goods which are purchased with minimal care, we find that the two marks are similar enough such that their use is likely to result in confusion.

Finally, we would like to address three arguments raised by applicant. First, applicant argues that the record is devoid of any evidence of actual confusion. This is correct. However, two points deserve to be mentioned. First, evidence of actual confusion is extremely hard to come by, and evidence of actual confusion is not a prerequisite to a finding of likelihood of confusion. Second, opposer has shown that its United States sales of all of its BERLINA products for the three year period from

1996 to 1998 come to less than $10 million. In addition, applicant has argued that its sales "vastly exceed the sales of opposer's products under opposer's mark during the same period." (Applicant's brief page 14). However, applicant has failed to show the total sales of all brands of bras in the United States, not to mention the sales of all brands of other products on which opposer has used its BERLINA mark. It is our opinion that applicant's sales figures are, in terms of the United States market, fairly insignificant and that applicant has acknowledged that opposer's sales are even more insignificant. In short, it would appear that there has been a very minimal chance for actual confusion to have occurred.

Second, applicant argues at page 15 of its brief that "there is no evidence of wrongful intent on the part of the applicant." This is true. However, it is clear that wrongful intent is not necessary for a finding of likelihood of confusion. 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 23:107 (4th ed. 2000).

Finally, applicant argues that the mere list of 43 purported third-party registrations and applications for various items of apparel wherein the marks begin with the

formatives BER, BUR, BERL or BURL "are relevant when evaluating likelihood of confusion." According to applicant, "consumers, being accustomed to such uses, are conditioned to distinguish between names by minor differences." (Applicant's brief page 16 emphasis added).

Applicant's argument is factually and legally deficient. It is factually deficient because most of the marks on applicant's list of purported registrations and applications are extremely far removed from the marks at issue here in terms of visual appearance and pronunciation. Some of the marks which applicant has listed are as follows: ANNE MARIE BERETTA; BERKSHIRE; MICHELLE BERGERON M and MORTON BERNARD. Applicant's argument is legally deficient because third-party registrations and applications do not establish that the marks have been used, and they certainly do not establish that the marks have been used to such an extent so as to condition the public to distinguish between marks with minor differences. See Smith Bros. Mfg. Co. v. Stone Mfg. Co., 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973).

Decision: The opposition is sustained.