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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Body Culture, Inc. formerly Kit Yuk Eji Tai

Serial No. 78487664

Reese R. Halpern and Bruce E. Methven of Methven &
Associates for Body Culture, Inc.

Sung In, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Quinn, Bucher and Cataldo, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Body Culture, Inc. seeks registration on the Principal
Register of the mark **ABEBA** for goods identified in the
application, as amended, as follows:

"lingerie, bodysuits, pantyhose, boxer
shorts, swimsuits, swimming trunks,
nightwear, camisoles, shirts, sweaters,
dresses, pants, skirts, coats, jackets,
suits, bathing suits, scarves, belts, gloves,
hats, t-shirts, sweatshirts, jogging suits
and sweatpants" in International Class 25.¹

¹ Application Serial No. 78487664 was filed by Kit Yuk Eji Tai, a citizen of Hong Kong, on September 22, 2004, based upon applicant's allegation of a bona fide intention to use the mark in commerce. The assignment of this application to Body Culture, Inc., a Nevada corporation, is recorded with the Assignment Division of the United States Patent and Trademark Office at Reel 3100, Frame 0561.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this mark based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has found that applicant's mark, when used in connection with the identified goods, so resembles the following mark,



registered for "footwear," also in International Class 25,² as to be likely to cause confusion, to cause mistake or to deceive.

Applicant and the Trademark Examining Attorney filed briefs in the case, but applicant did not request an oral hearing. We affirm the refusal to register.

Applicant argues that it is in the business of selling women's clothing, excluding footwear. Furthermore, applicant argues that the record shows that registrant does not make general footwear, but manufactures only anti-static, skid-resistant "safety, protective and professional shoes" that are available only at specialized dealers.

By contrast, the Trademark Examining Attorney argues that the literal portions of both marks are identical in

² Reg. No. 2233656 issued to Abeva Spezialschuh-Ausstatter GmbH on March 23, 1999 based upon allegations of first use anywhere since at least as early as December 31, 1988 and first use in commerce since at least as early as July 28, 1997. Section 8 affidavit accepted and Section 15 affidavit acknowledged.

appearance, sound and meaning, that the goods of the applicant and the goods of the registrant are closely related, and that items of clothing and footwear are sold in the same channels of trade and marketed to the same groups of ordinary consumers.

Analysis: Likelihood of Confusion

Our determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The marks

We turn first to the du Pont factor focusing on the similarity of the marks in their entirety. See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In comparing the applicant's mark and the cited mark, the wording is identical, namely, ABEBBA. Therefore, the Trademark Examining Attorney argues, the literal portions of these marks are identical in appearance, sound and meaning.

Further, he argues that the slight stylization of the letters "A" in the registered mark does not obviate the similarity between the marks in this case. In re Shell Oil Company, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); and Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc., 526 F.2d 556, 188 USPQ 105 (CCPA 1975).

In its brief, applicant does not argue that there are any differences in the marks, so we assume this is a concession that the marks are similar. Certainly, we find the marks to be identical as to sound and connotation and nearly identical as to appearance and commercial impression, and this factor weighs heavily in favor of the Office's position.

The goods

Accordingly, we turn to the relationship of the goods as described in the application and cited registration. As noted above, the marks are nearly identical in every respect. With both registrant and applicant using a near-identical designation, "the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar." Amcor, Inc. v. Amcor Industries, Inc., 210 USPQ 70, 78 (TTAB 1981). See also In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed.

Cir. 1993) ["[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source."].

In order to support a holding of likelihood of confusion, it is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

Applicant's goods, as amended, do not contain any items of footwear. Nonetheless, as noted by the Trademark Examining Attorney, perhaps the item within applicant's listing of goods most closely related to footwear would be its pantyhose - arguably complementary items to footwear.

We agree with applicant that there is no *per se* rule that all items of wearing apparel are automatically related for purposes of determining likelihood of confusion under this du Pont factor. Arguing in favor of a case-by-case analysis of the particular facts and circumstances, applicant cites to a number of cases to make this point.

It is true that the Board held that the mark PLAYERS on men's underwear and shoes would not result in consumer confusion as to the source of the goods. See In re British Bulldog, Ltd., 224 USPQ 854 (TTAB 1984). However, the connotation of the term was deemed to be different as applied to the respective goods. According to the Board:

"PLAYERS" for shoes implies a fit, style, color and durability adapted to outdoor activities. "PLAYERS" for men's underwear implies something else, primarily indoors in nature.

In the instant case, however, ABEBA appears to be a fanciful or coined term - creating the same connotation for clothing as for footwear.

Applicant also cites to In re Shoe Works, Inc., 6 USPQ2d 1890 (TTAB 1988), where the Board found no likelihood of confusion between the use of PALM BAY for women's shoes and PALM BAY for shorts and pants. However, as noted by the Trademark Examining Attorney, the decision rested on a number of other facts and circumstances quite different from any in the instant case - most notably a logical and convincing consent agreement between the parties.

Finally, Applicant points to the holding of the court in H. Lubovsky, Inc. v. Esprit de Corp., 228 USPQ 814 (S.D.N.Y. 1986) where the use of ESPRIT on wearing apparel was

found not to infringe use of the same mark on shoes. As noted by the Trademark Examining Attorney, the Lubovsky Court found that a small senior mark owner who had used its mark on shoes failed to make out a cause of action for trademark infringement against a larger and much more renowned junior user in the field of women's and children's sportswear. However, our *ex parte* decisions on registrability generally do not have the factual records of an infringement action. Moreover, on the relevant Polaroid³ / du Pont factors, the court found that:

- (i) "Esprit" is laudatorily suggestive, and hence, not particularly strong;
- (ii) plaintiff's allegations are weakened by third-party uses as well as its own limited usage and promotion; and
- (iii) in this infringement action, the Court looked "to differences of presentation, of merchandise (shoes/clothes), of style, of clientele, of marketplace and of image."

The Court was clearly influenced by the defendant's fame as well as the fact that defendant's merchandise was targeted at "a youthful active modern sporty clientele," while plaintiff's shoes were marketed to older women seeking "traditional styles" of footwear. Nonetheless, as a general

³ Polaroid Corp. v. Polarad Electronics Corp., 287 F.2d 492, 128 USPQ 411 (2d Cir. 1961)

principle, the Court cited to two Second Circuit decisions⁴ leaving no "doubt there is proximity between women's shoes and women's sportswear." 228 USPQ at 818.

The Trademark Examining Attorney also cites to a long line of precedents from the Board and our primary reviewing Court finding many different types of apparel and footwear to be related:

... [T]he decisions in the clothing field have held many different types of apparel to be related under Section 2(d). Cambridge Rubber Co. v. Cluett, Peabody & Co., Inc., 286 F.2d 623, 128 USPQ 549 (CCPA 1961) [WINTER CARNIVAL for women's boots v. men's and boys' underwear]; Jockey Int'l, Inc. v. Mallory & Church Corp., 25 USPQ2d 1233 (TTAB 1992) [ELANCE for underwear v. ELAAN for neckties]; In re Melville Corp. 18 USPQ2d 1386 (TTAB 1991) [ESSENTIALS for women's pants, blouses, shorts and jackets v. women's shoes]; In re Pix of America, Inc., 225 USPQ 691 (TTAB 1985) [NEWPORTS for women's shoes v. NEWPORT for outer shirts]; In re Mercedes Slacks, Ltd., 213 USPQ 397 (TTAB 1982) [OMEGA for hosiery v. trousers]; In re Cook United, Inc., 185 USPQ 444 (TTAB 1975) [GRANADA for men's suits, coats, and trousers v. ladies' pantyhose and hosiery]; Esquire Sportswear Mfg. Co. v. Genesco Inc., 141 USPQ 400 (TTAB 1964) [SLEEX for brassieres and girdles v. slacks for men and young men].

The Trademark Examining Attorney contends that although the goods of applicant and registrant are not identical, the type of clothing items manufactured by applicant are

⁴ Avon Shoe Co. v. David Crystal, Inc., 279 F.2d 607, 612, 125 USPQ 607, 612 (2nd Cir. 1960) and Mushroom Makers Inc. v. R. G. Barry Corp., 580 F.2d 44, 47-48, 199 USPQ 65, 67 (2nd Cir. 1978).

commonly marketed and sold in the same channels of trade and to the same groups of ordinary consumers as are the type of footwear sold by registrant. Further, he submitted five third-party registrations to demonstrate that manufacturers of the types of clothing items marketed by applicant also produce footwear as identified in the cited registration:

COVINGTON

for "clothing, namely, shirts, tops, sweaters, shorts, pants, jumpers, skirts, overalls, vests, jackets, coats, night gowns, pajamas, robes, socks, gloves and scarves; headwear, namely, caps and hats; footwear, namely shoes, pumps and boots" in International Class 25;⁵



for "clothing, namely, jeans, pants, overalls, shortalls, shorts, tops, shirts, vests, sport shirts, sweaters, jackets, coats, headwear, footwear, underwear, brassieres, socks, dresses, skirts, jumpers and belts" in International Class 25;⁶

FTB

for "clothing, namely, tops and bottoms, jackets; coats; warm-up suits; sweat suits; sweat pants; sweatshirts; sweaters; blazers, vests; pants; trousers; slacks, shorts; underwear; thermal underwear; swimwear; loungewear; headwear, namely, ear warmers, ear muffs, headbands and hats; gloves; mittens, scarves; wristbands; skiwear; tights; foul weather gear; beach wear; unitards; body suits; fishing vests and waders; sleepwear; robes; caftans; neckwear; overalls; overcoats; pantsuits; suits; suit coats; rainwear; sashes; belts, shawls; socks; and footwear, namely, shoes, boots, and sandals" in International Class 25;⁷

TV ONE

for "clothing, namely, t-shirts, polo shirts, sports shirts, golf shirts, athletic jerseys, sweatshirts, hats, shorts, bandanas, bathing suits, bathrobes, beachwear. belts. jackets. coats. socks. footwear.

⁵ Registration No. 2804694 issued to Sears, Roebuck and Co. on January 13, 2004 under Section 2(f) of the Act based upon a claim of first use anywhere and first use in commerce at least as early as July 2002.

⁶ Registration No. 2877188 issued to Sears Brands, LLC on August 24, 2004 based upon a claim of first use anywhere and first use in commerce at least as early as March 1, 2003.

⁷ Registration No. 2890258 issued to Gray Matter Holdings, LLC on September 28, 2004 based upon a claim of first use anywhere and first use in commerce at least as early as December 2002.

sweaters, dresses, gym shorts, ear muffs, neckwear, pajamas, pants, skiwear, slacks, sun visors, baseball caps, caps, suspenders, turtlenecks, underclothes, vests, warm-up suits, headwear, gloves, costumes" in International Class 25;⁸ and

REDBACK

for "footwear and clothing, namely, boots, shoes, inner soles for footwear, belts, tee shirts, suspenders and socks" in International Class 25.⁹

We find that these third-party registrations have probative value to the extent that they serve to suggest that the goods listed therein, namely clothing items, on the one hand, and footwear, on the other hand, are of a kind that may emanate from a single source. In re Infinity Broadcasting Corp. of Dallas, 60 USPQ2d 1214, 1218 (TTAB 2001), citing In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); and In re Mucky Duck Mustard Co., Inc., 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988). Combined with earlier precedents, we find this evidence to be sufficient to conclude that there is a relationship between clothing and footwear such that consumers would assume that both emanated from a single source if sold under substantially identical marks.

In addition to arguing that its application does not include footwear, and that footwear and clothing items are

⁸ Registration No. 2929759 issued to TV ONE, LLC on March 1, 2005 based upon a claim of first use anywhere and first use in commerce at least as early as October 2003.

⁹ Registration No. 2954862 issued to Redback Boots USA on September 28, 2004 based upon a claim of first use anywhere and first use in commerce at least as early as October 14, 1996. This registration also included "bags, namely tote bags and tool bags sold empty" in International Class 18.

not necessarily related, applicant has also made of record extrinsic evidence, i.e., web pages taken from registrant's website, demonstrating that registrant is not manufacturing ordinary footwear, in an attempt to limit registrant's identification of goods:

According to the owner's website at <http://www.abeba.com/Englisch/index2.php> the owner of the mark is a manufacturer of "safety, protective and professional shoes." See Exhibit B for a copy of the owner's website description of their shoes. The owner's website further describes the shoes as "anti-static shoes or ESD shoes [that] can play an important part in keeping static electricity in check" and skid-resistant shoes. See Exhibit C for a copy of the owner's website description of their anti-static shoes. See Exhibit D for a copy of the owner's website description of their skid-resistant shoes. It does not appear that the owner manufactures any products other than "safety, protective and professional shoes."

...

Appellant "is not now and never will be in the business of selling safety, protective and professional shoes."

Applicant also cites to registrant's website where it states: "Our products are only available at specialised dealers for professional shoes."

Applicant argues that the Trademark Examining Attorney, in finding that applicant's goods are related to registrant's goods, has improperly ignored this extrinsic evidence regarding the nature of registrant's actual goods - evidence which, according to applicant, demonstrates that

applicant's goods are distinguishable from and unrelated to registrant's goods. We disagree.

Merely because the goods identified in the cited registration are described broadly, the Board may not consider extrinsic evidence as to the nature of the registrant's actual goods when making its likelihood of confusion determination. Rather, the rule is that the likelihood of confusion determination must be made on the basis of the goods as identified in the application and the registration, rather than on the basis of what the evidence might show the applicant's or registrant's actual goods to be. See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Accordingly, the extrinsic evidence proffered by applicant regarding the nature and scope of the goods actually marketed by registrant is irrelevant and can be given no consideration.

Channels of Trade

Likewise, we reject applicant's contentions that applicant's goods will necessarily move in different trade channels than registrant's goods. Because no trade channel limitations have been included in either applicant's identification of goods or in registrant's identification of goods, we must presume that applicant and registrant are

entitled to offer their goods in all normal trade channels for such goods, and to all normal classes of customers for such goods. See In re Elbaum, 211 USPQ 639 (TTAB 1981).

Conclusion

In conclusion, we find that these marks are identical as to sound and connotation and nearly identical as to appearance and commercial impression; that footwear is related to items of clothing; and that we must presume that these types of goods will move through the same channels of trade to the same classes of ordinary consumers.

Decision: The refusal to register under Section 2(d) of the Lanham Act is hereby affirmed.