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PRECEDENT OF THE  
T.T.A.B.

Mailed: December 14, 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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The B.V.D. Licensing Corporation  
v.  
Right Ascension, Inc.

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Opposition No. 91169355  
to application Serial No. 78505251  
filed on October 25, 2004

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Louis K. Ebling of Greenbaum Doll & McDonald PLLC for The  
B.V.D. Licensing Corporation.

Roy E. Leonard of Stonecipher, Cunningham, Beard & Schmitt  
for Right Ascension, Inc.

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Before Holtzman, Kuhlke and Walsh, Administrative Trademark  
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Right Ascension, Inc., seeks registration of  
the mark DVD EMPIRE (in standard character form) for goods  
identified in the application as "shirts" in International  
Class 25.<sup>1</sup>

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<sup>1</sup> Serial No. 78505251, filed October 24, 2004, alleging first use  
and use in commerce on December 1, 2003 under Section 1(a) of the  
Trademark Act, 15 U.S.C. §1051(a).

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Opposer, The B.V.D. Licensing Corporation, has opposed registration of applicant's mark on the ground that, as applied to applicant's goods, the mark so resembles opposer's previously used and registered B.V.D. and BVD marks, for underwear, t-shirts, shirts and shorts "as to be likely ... to cause confusion, to cause mistake, or to deceive within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d)." Notice of Opposition ¶ 11. In addition, opposer asserts a claim of dilution under Section 43(c) of the Trademark Act. However, inasmuch as opposer has not argued dilution in its brief, we have only considered the claim of priority of use and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant has filed an answer by which it has denied the salient allegations.


The evidence of record consists of the pleadings herein and the file of the opposed application. In addition, opposer submitted the following material under a notice of reliance: certified copies of six of opposer's pleaded registrations, which show that the registrations are subsisting and owned by opposer; excerpts from pages of various printed publications showing opposer's advertisements; dictionary excerpts; and an excerpt from a

printed publication on a brand survey.<sup>2</sup> Opposer did not take any testimony. Applicant did not take any testimony, file a notice of reliance or file a brief.


**PRIORITY AND LIKELIHOOD OF CONFUSION**

The pleaded registrations made of record, which are in full force and effect and are owned by opposer, are summarized as follows:<sup>3</sup>

Registration No. 49931 for the mark B.V.D. (in typed form) for "undershirts and under-drawers" in International Class 25, issued on February 27, 1906, renewed;

Registration No. 1506054 for the mark  for "men's and boy's underwear" in International Class 25, issued on September 27, 1988, Section 8 accepted and Section 15 acknowledged;

Registration No. 764348 for the mark B.V.D. (in typed form) for "men's and boy's t-shirts and underwear" in International Class 25, issued on February 4, 1964, renewed;

Registration No. 1506049 for the mark  for "men's and boy's underwear" in International Class 25, issued on September 27, 1988, Section 8 accepted and Section 15 acknowledged;

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<sup>2</sup> Opposer also submitted excerpts from opposer's catalogs, samples of opposer's brochures and a printout of a page from applicant's website. However, this is not proper subject matter for a notice of reliance. See *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33, 36 n. 10 (TTAB 1976) and *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998). In view thereof, we have not considered these exhibits. Original *Appalachian Artworks Inc. v. Streeter*, 3 USPQ2d 1717 n. 3 (TTAB 1987) (inasmuch as applicant did not submit evidence or file a brief, Board could not determine whether applicant treated it as being of record thus material improperly offered by notice of reliance not considered).

<sup>3</sup> Hereinafter we refer to the marks collectively as the "BVD marks."

Registration No. 367184 for the mark **B.V.D.** for  
"underwear, shirts, shorts and union suits" in  
International Class 25, issued May 3, 1939,  
renewed; and

Registration No. 546353 for the mark **B.V.D.** for  
"hose for men" in International Class 25, issued  
August 7, 1951, renewed.

Because opposer has made the pleaded registrations  
summarized above properly of record, opposer has established  
its standing to oppose registration of applicant's mark and  
its priority is not in issue. See *King Candy Co., Inc. v.*  
*Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108  
(CCPA 1974).

Our likelihood of confusion determination under Section  
2(d) is based on an analysis of all of the probative facts  
in evidence that are relevant to the factors set forth in *In*  
*re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ  
563 (CCPA 1973). See also, *In re Majestic Distilling Co.,*  
*Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Two  
key considerations are the similarities between the marks  
and the similarities between the goods. See *Federated*  
*Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192  
USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants*  
*Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).  
Another important factor, when presented, is the fame of the  
mark. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*

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Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

We begin with the factor of fame because fame "plays a 'dominant' role in the process of balancing the du Pont factors." *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

The record shows that opposer owns several registrations for the BVD marks for various undergarments and shirts and they have been continuously registered since 1906. Opposer has widely advertised its mark for many decades. See, e.g., BVD advertisements in "Everybody's Magazine" (1907); "The American Magazine" (1910); "Cosmopolitan" (June 1913); "The Saturday Evening Post" (1926); "Colliers" (June 1, 1935); "Daily News Record" (May 3, 1957); "Sports Illustrated" (1979); "Rolling Stone" (September 18, 1997); "Sporting News" (September 1, 2003); and "Sports Illustrated" (September 18, 2006). The BVD brand was recently ranked as the 35<sup>th</sup> most well-known menswear brand in 2005. See "DNR America's 50 Best-Known Men's Brands An Exclusive DNR Survey" (November 21, 2005). The BVD brand has also benefited from celebrity endorsements, including, Larry Hagman, Mario Andretti, Wilt Chamberlin, Chubby Checker, Orel Hersher and Milton Berle. The BVD mark appears in several dictionaries. See, e.g., Webster's New Collegiate Dictionary (1980) "B.V.D. -

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trademark - used for underwear"; Merriam-Webster's Collegiate Dictionary (11<sup>th</sup> ed. 2003) "BVD trademark - used for underwear"; The Random House Dictionary of the English Language (1973) "B.V.D. - Trademark a suit of men's underwear, esp. a pair of undershorts. Also BVDs."

Based on the record, we find that the evidence demonstrates that the BVD marks are famous for, at a minimum, men's underwear. We also note that the Federal Circuit and the Board have found the marks to be famous on prior occasions. See *The B.V.D. Licensing Corp. v. Body Action Design Inc.*, 6 USPQ2d 1719 (Fed. Cir. 1988); *The B.V.D. Licensing Corp. v. Florencio Rodriguez*, Opp. No. 91157529, Slip Op. (February 21, 2007). We note in particular that "[w]hen a trademark attains dictionary recognition as a part of the language, we take it to be reasonably famous." *The B.V.D. Licensing Corp. v. Body Action Design Inc.*, supra at 1722. Thus, given the wide latitude of protection afforded famous marks, we proceed with our analysis keeping this in mind. See *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

In considering the next factors, we have limited our determination of likelihood of confusion to the most relevant registrations, Registration Nos. 764348 for the mark B.V.D. (in typed form) for "men's and boy's t-shirts

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and underwear" and Registration No. 367184 for the stylized mark B.V.D. for "underwear, shirts, shorts and union suits."

With regard to the goods, the "shirts" identified in opposer's Registration No. 367184 are identical to applicant's "shirts" and the "t-shirts" identified in opposer's Registration No. 764348 could be encompassed by applicant's "shirts." "Shirts" is defined as "1. A garment for the upper part of the body, typically having a collar, sleeves, and a front opening. 2. An undershirt. 3. A nightshirt. The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2006).<sup>4</sup>

Considering the channels of trade and class of purchasers, because the goods are in part legally identical and otherwise closely related and because there are no limitations in either the registrations or the subject application, we must presume that applicant's and opposer's goods will be sold in the same channels of trade and will be bought by the same classes of purchasers. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

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<sup>4</sup> The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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In view of the above, the du Pont factors of the similarity of the goods, the channels of trade and class of purchasers favor a finding of likelihood of confusion.

With regard to the conditions of sale, these goods include general clothing items that would not be purchased with a great deal of care or require purchaser sophistication, which increases the likelihood of confusion. See *Recot*, supra, 54 USPQ2d at 1899 ("When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care") (citations omitted). Thus, this factor also favors opposer.

We now turn to consider the similarity or dissimilarity of the marks when compared in their entirety in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under this du Pont factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result. Moreover, where the goods are identical "the degree of similarity [between the marks] necessary to support a



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conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert. denied, 506 U.S. 1034 (1992).

In comparing the marks B.V.D. and DVD EMPIRE within the above-noted legal parameters and taking into account the fame of opposer's marks, we find the points of similarity outweigh the dissimilarities. ESSO Standard Oil Co. v. Sun Oil Co., 229 F.2d 37, 108 USPQ 161, 163 (D.C. Cir. 1956). We first observe that the term DVD is the dominant element in applicant's mark. It is the first word in the mark and, as opposer notes, EMPIRE has a certain laudatory quality to it inasmuch as it connotes a degree of supremacy, rendering it less influential as the source identifier in applicant's mark.<sup>5</sup> See In re National Data Corp., 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[T]here 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. Indeed, this type of analysis appears to be unavoidable").

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<sup>5</sup> Empire is defined as "Imperial or imperialistic sovereignty, domination, or control." The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2006). The word "Imperial" has been found to be laudatory. See Imperial Knife Associated Companies, Inc. v. Dalton, 153 USPQ 422, 423 (TTAB 1967).

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While the marks begin with different letters, B versus D, the last two letters are identical and B and D are visually similar and are somewhat phonetically similar. In addition, in considering the similarity of appearance with the stylized BVD mark, because applicant's mark is in standard character form, we must consider the possibility of it being presented in any reasonable form of display including the manner in which opposer's mark is displayed. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000).

As to connotation, both letter combinations are arbitrary in the context of the relevant goods. As noted by opposer, although the "letters DVD do have a recognized meaning with respect to electronics and recorded media ... applicant's letter combination DVD has no special meaning with respect to shirts." Br. p. 14. Used on a label inside a shirt, the letters DVD would have no particular meaning.

Further, a difference of one letter in a multiple-letter designation generally is not sufficient to distinguish between two otherwise identical letter combinations. See *Weiss Associates Inc. v. HRL Associates Inc.*, 14 USPQ2d 1840 (Fed. Cir. 1990); and *Alberto-Culver Co. v. F.D.C. Wholesale Corp.*, 16 USPQ2d 1597 (TTAB 1990) and cases cited therein. This is particularly true where the involved goods are subject to impulse purchasing and

further exacerbated here, due to the fame of opposer's marks.

Given the identical and closely related goods, trade channels, and class of purchasers, we find that the overall commercial impression engendered by each of these marks is such that the similarities outweigh the differences. Taking into consideration the fame of opposer's BVD marks, we conclude that the parties' marks are substantially similar.

Thus, considering the marks in their entireties, we conclude that the evidence of record as it pertains to the relevant du Pont factors supports a finding of a likelihood of confusion as between applicant's DVD EMPIRE mark and opposer's BVD marks, such that registration of applicant's mark is barred under Trademark Act Section 2(d). As noted above, applicant has not submitted any evidence, taken any testimony or presented any legal argument to rebut opposer's showing. To the extent we have any doubt, we must resolve that doubt in favor of opposer, the prior registrant. See *Hard Rock Cafe International (USA) Inc. v. Thomas D. Elsea*, 56 USPQ2d 1504, 1514 (TTAB 2000) and *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308, 311 (TTAB 1976).

**Decision:** The opposition is sustained as to opposer's claim of priority and likelihood of confusion under Section 2(d) of the Trademark Act.