

**THIS DECISION IS NOT A  
PRECEDENT OF THE T.T.A.B.**

Mailed: August 24, 2011

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

Mansell Construction Ltd.

v.

Susan Lu

Opposition No. 91184771  
to application Serial No. 77219548  
filed on June 29, 2007

James Michael Faier of Faier & Faier P.C. for Mansell  
Construction Ltd.

Bradley M. Stohry of Ice Miller L.L.P. for Susan Lu

Before Walters, Bergsman, and Wolfson, Administrative  
Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Susan Lu ("applicant") filed an intent-to-use  
application for the mark BEND SPORT COUTURE and design,  
shown below:

**BEND**  
SPORT COUTURE

for various items of "clothing,"<sup>1</sup> in Class 25. No claim is made to the exclusive right to use "SPORT COUTURE" apart from the mark as shown.

Mansell Construction Ltd. ("opposer") has opposed the registration of applicant's mark on the grounds of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d).<sup>2</sup>

Specifically, opposer alleges prior use of the marks BENDY and BENDYGIRL for women's sports clothing, and that it is the owner of applications for the marks BENDY (Serial Nos. 78342438 and 78529144) and BENDYGIRL (Serial No. 78342445), for various goods and services, including clothing.

Opposer further alleges that applicant's mark so resembles

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<sup>1</sup>Application Serial No. 77219548; for "Clothing, namely, pants, shirts, t-shirts, tank tops, tuniques, shorts, skirts, blouses, slacks, jackets, parkas, coats, dresses, bathing suits, sweaters, sweat shirts, neck scarves, ties, hosiery, socks and slippers; footwear; headgear, namely, head bands, caps, hats and head scarves; leather and imitation leather clothing, namely, coats, parkas, jackets, blouses, skirts, t-shirts, tank tops, shorts, pants, shirts, tuniques, footwear, slippers, head bands, caps, hats and head scarves, sweat shirts and scarves; fur clothing, namely, t-shirts, tuniques, sweaters, sweat shirts, jackets, coats, fur hats and fur scarves; undergarments, namely, underwear, bras, support bras and jog bras; gloves; belts; textile nappies."

<sup>2</sup> In addition, opposer alleged that applicant's mark is disparaging and falsely suggests a connection with opposer under Trademark Act § 2(a), 15 U.S.C. § 1052(a); and that applicant's mark is merely descriptive under Trademark Act § 2(e)(1), 15 U.S.C. § 1052(e)(1). Opposer did not pursue these claims at trial or present arguments with regard thereto in its brief. Accordingly, they are deemed waived. See *SmithKline Beecham Corp. v. Omnisource DDS, LLC*, 97 USPQ2d 1300, 1301 n. 2 (TTAB 2010).

opposer's marks as to be likely to cause confusion. Both opposer's application for the mark BENDY that includes Class 25 and its application for the mark BENDYGIRL were filed on December 17, 2003 based in part on opposer's intent to use the marks in commerce.<sup>3</sup> In addition, opposer filed its applications with claims to filing date priority under Section 44(d) based on applications filed in the United Kingdom on December 16, 2003. The United Kingdom applications subsequently issued and opposer has retained Section 44(e) as a filing basis.

Applicant denied the salient allegations in the notice of opposition. After trial, both sides filed trial briefs and opposer filed a reply brief.

#### The Record

By rule, the record includes applicant's application file and the pleadings. Trademark Rule 2.122(b), 37 CFR §2.122(b).

The parties stipulated to admit "true and correct" copies of the following into evidence:<sup>4</sup>

1. A definition of "bendy" from [www.dictionary.com](http://www.dictionary.com);

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<sup>3</sup>Inasmuch as Serial No. 78529144 for the mark BENDY for goods in Classes 28 and 35 covers goods that are less similar to applicant's goods than those of Serial No. 78342438, we will concentrate our discussion of the issue of likelihood of confusion on the marks most similar to that of applicant, namely, opposer's mark BENDY in Class 25 and BENDYGIRL in Class 25.

<sup>4</sup> Stipulation filed April 15, 2010.

2. Application file histories for opposer's trademark applications, Serial Nos. 78342438 (BENDY); 78343445 (BENDYGIRL); 78529144 (BENDY); and 77009000 (for BENDY and design);<sup>5</sup>

3. Print-outs from applicant's website (www.bendsportcouture.com) and opposer's website (www.bendy.com/indexold);

4. Copies of "photographs and publications of a sample of opposer's goods using the mark BENDY";

5. Opposer's U.K. trademark registrations for BENDY and BENDYGIRL;

6. Opposer's responses to applicant's interrogatories;

7. Opposer's responses to applicant's first set of requests for production of documents; and

8. Applicant's responses to opposer's first set of interrogatories and requests for production of documents.

Opposer also introduced the testimony deposition on written questions of Ian Mansell, its director and owner, with attached exhibits.

Applicant introduced, under notice of reliance, copies of documents identified in the parties' stipulation (which

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<sup>5</sup>Application Serial No. 77009000 was not pleaded in the notice of opposition and has no bearing on our decision.

duplicate those submitted by opposer), a copy of "the UK Intellectual Property Office's records relating to UK Trademark No. M900775 that applicant obtained for the mark BEND SPORTS COUTURE," and copies of third-party registrations for marks in the clothing class that include the word "bend."

#### Standing

The evidence shows that opposer has used its marks in the United States, and its likelihood of confusion claim is not frivolous. In addition, while opposer's trademark applications for the marks BENDY and BENDYGIRL have not yet registered, its applications are senior to applicant's application and provide opposer with an earlier constructive use date than the constructive use date applicant's application provides to applicant. See the discussion below.

This is sufficient to demonstrate that opposer has a real interest in this proceeding and a reasonable belief that it would be damaged by registration of applicant's mark. Therefore, opposer has standing. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

### Priority

To establish priority on a likelihood of confusion claim brought under Trademark Act Section 2(d), a party must prove that, vis-à-vis the other party, it owns "a mark or trade name previously used in the United States ... and not abandoned..." Trademark Act § 2, 15 U.S.C. § 1052. A party may establish its own prior proprietary rights in a mark through ownership of a prior registration, actual use, or through use analogous to trademark use, such as use in advertising brochures, trade publications, catalogues, newspaper advertisements and Internet web sites, which create a public awareness of the designation as a trademark identifying the party as a source. See Trademark Act §§ 2(d) and 45, 15 U.S.C. §§ 1052(d) and 1127; *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), *vacating Pactel Teletrac v. T.A.B. Systems*, 32 USPQ2d 1668 (TTAB 1994); and *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). Priority is an issue in this case because opposer does not own an existing registration upon which it can rely for purposes of a Section 2(d) likelihood of confusion analysis. *Cf. King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Applicant is entitled to rely upon a presumption of use of her mark BEND SPORT COUTURE for clothing articles as of June 29, 2007, the filing date of her application for registration. Applicant may also rely on use analogous to trademark use to prove her priority. *Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251 (TTAB 1995). However, based on our review of the evidence, applicant has not shown actual use or use analogous to trademark use prior to the June 29, 2007 filing date of her application.

Applicant submitted, under notice of reliance and pursuant to the parties' stipulation, a copy of a document entitled "Sales Analysis by Retail Product" for items sold to "Cornelia Spa" in New York. While the document includes the field: "date range: 12/11/2006 - 1/11/2008," the earliest date that can be ascribed to any listed item is January 11, 2008, because none of the listed items include actual sales dates. Thus, applicant has not shown that she used her mark prior to June 29, 2007. See *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 USPQ 597, 598 n.5 (TTAB 1982) (documentary evidence showed first use in 1977, the month and day were unknown, therefore, the Board could not presume any date earlier than the last day of the proved period). See also *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 911 n.22 (TTAB 1985)

(evidence established first use in 1968-1969, therefore December 31, 1969 is date of first use).

As to applicant's pre-sales activity, the parties have supplied, pursuant to their stipulation, "print outs from applicant's website at [www.bendsportcouture.com](http://www.bendsportcouture.com)."<sup>6</sup> The earliest of these is Exhibit 6.9.5, dated November 7, 2006. The print out, however, does not show use of the mark. The only other print out that bears a date, Exhibit 6.1, is a copy of pages from the magazine Elle, dated "Mars 2007."<sup>7</sup> Although the goods appear on the Elle pages together with pricing information, the trademark does not appear. In addition, applicant identified three advertisements that were sent to approximately 10 U.S. retailers; in answer to opposer's Interrogatory No. 5, she states that one of the advertisements was distributed "beginning May 18, 2007."<sup>8</sup>

Taken cumulatively, these print outs and advertisement do not show that the public would have become aware of applicant's mark in any meaningful way and are clearly insufficient pre-sales use to qualify as use analogous to trademark use. See *T.A.B. Systems*, 37 USPQ2d at 1881 ("Such an 'analogous use' opposition can succeed, however,

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<sup>6</sup>Stipulation to Admit Materials into Evidence, paragraph 9.

<sup>7</sup> There is possibly a day of the month included in the date, but it is too small to be legible.

<sup>8</sup> Applicant's Response to Opposer's First Set of Interrogatories and Requests for Production of Documents, p. 6.



only where the analogous use is of such a nature and extent as to create public identification of the target term with the opposer's product or service.").The earliest date upon which applicant is entitled to rely for priority purposes is the filing date of her application, contingent upon its registration.

Given these findings, opposer's burden is to prove by a preponderance of evidence that it used its mark in the United States prior to June 29, 2007. Because applicant has not alleged that opposer has abandoned its mark, opposer need not show continuous use. *See West Florida Seafood Inc. v. Jet Restaurant, Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1665 (Fed. Cir. 1994) ("The governing statute does not speak of 'continuous use,' but rather of whether the mark or trade name has been '*previously used* in the United States by another *and not abandoned.*'" (emphasis in original)).

A. PRIORITY BASED ON OPPOSER'S APPLICATIONS.

Because the effective filing dates of opposer's applications for the marks BENDY and BENDYGIRL (12/16/03) pre-date applicant's filing date of June 29, 2007, opposer is entitled to rely upon the filing dates for priority purposes, contingent upon the ultimate issuance of a registration of at least one of its pleaded applications.

As we explained in *Larami Corp. v. Talk to Me Programs Inc.*:

Finally, we want to emphasize that, although in *Zirco*<sup>9</sup> (as in the case now before us) it was the applicant for registration -- that is, the party in the position of defendant -- who sought to rely on the constructive use provisions of Section 7(c) to defeat the opposer's priority claim, a party in the position of opposer may, likewise, rely on the constructive use provisions of Section 7(c) to establish its priority for purposes of Section 2(d). An opposer may rely on Section 7(c) to establish priority if it owns a registration for the mark it is asserting under Section 2(d) or if it has filed an application for registration of that mark. We might put the matter more simply by saying that in proceedings before the Board the constructive use provisions of Section 7(c) may be used both defensively and offensively. (Of course, as we have noted, Section 7(c) provides that any judgment entered in favor of a party relying on constructive use - - whether that party is in the position of plaintiff or defendant in a Board proceeding -- is contingent upon the ultimate issuance of a registration to that party.)

*Larami Corp. v. Talk to Me Programs Inc.*, 36 USPQ2d 1840, 1845 n.7 (TTAB 1995); see also, *Continental Specialties Corp. v. Continental Connector Corp.*, 192 USPQ 449, 451 (TTAB 1976) (opposer's reliance for priority on filing date of its own pending application is not evidence of proof of use until it matures into a registration).

B. PRIORITY BASED ON OPPOSER'S FIRST USE OF ITS MARKS.

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<sup>9</sup>*Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991).

Should none of opposer's pleaded applications issue to registration, opposer will have to rely upon actual prior use of its marks in the United States for priority. In this regard, opposer may show either actual prior use of its marks or rely upon "use analogous to trademark use," which use must be not only prior to the earliest date upon which applicant may rely, but which must also have been sufficient to create a public awareness of the marks prior to such date. See *Herbko Intern., Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1320, 209 USPQ 40, 43 (CCPA 1981).

To this end, opposer's witness, Mr. Mansell, testified that "we the opposers have provided documentary evidence to these proceedings that our reliance on first in use [sic] in the U.S. is on an eBay account with a start date of ... 4 March 2006..."<sup>10</sup> Upon review of Mr. Mansell's testimony, the March 4, 2006 date is only established as the date opposer opened its eBay account, and not a date of first use of the mark:

Q: What motivated you to decide to authorize filing of this opposition?

A: ... How is it that the Applicant has even stated on their interrogatory that they had a first-in-use in

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<sup>10</sup>Mansell Dep., p. 36.

the United States on the exact same day as I registered my eBay account to get some U.S. in-use activity? Refer Exhibit 400 Interrogatory Question 7, swimwear by Applicant first-in-use 4 March 2006 versus the Opposer showing the opening of an eBay account 4 March 2006 and stating that only sales prior to opposition in the U.S. have been made through that account.<sup>11</sup>

Mr. Mansell does not describe opposer's alleged use of either of its marks on eBay. Instead, opposer refers to responses it submitted to applicant's first set of interrogatories and requests for production of documents as evidence of such sales. Specifically, Mr. Mansell refers to opposer's responses to Interrogatory No. 1.

Interrogatory No. 1 asks opposer to "describe in detail any actual use of Opposer's mark in the United States..." In response, opposer identifies eBay sales:

Initial physical test stock advertised as physically buyable from all persons in the United States from March 2006 via EBay. These were offered worldwide for sale with specific shipping reference to North and South America.

. . .

Of winning buyers that we located in the United States were [sic] in States such as Zip codes: IL 61073, MI 49071, TX 77065, NC 27565, AL 35976, AZ 85042, AZ 85301. Generally UK buyers tended to buy garments that were listed primarily to achieve US sales. Total US dollar sales less than \$1,000 USD.

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<sup>11</sup>Mansell Dep., pp. 41-42.

Although opposer states that sales were made to seven specific zip codes in the United States, the only evidence opposer supplies to support the statement are copies of 3 packing slips showing what appear to be sales that were made to U.S. customers.<sup>12</sup> The first, to zip code 35976 in Alabama, took place May 15, 2008, and thus has no relevance to the issue of priority. The second packing slip shows a delivery of a "bendy T-like bench-pink-size-12-(initial tester T)," to zip code 61073 in Illinois for "£2.51 GBP." The packing slip is undated. The third packing slip that identifies a U.S. customer shows a delivery of a "BENDY™ - Designer T BNWT (6 US) (8-10UK)" to zip code 85301 in Arizona, for "\$5.06 USD." This packing slip is also undated.

Opposer's document production also included a copy of a webpage from "eBay.co.uk" showing that a BENDYGIRL shirt was won at auction for "£3.20."<sup>13</sup> The webpage shows the auction ended on March 7, 2006. However, there is no indication as to who the buyer was, or whether he or she was located in the United States or elsewhere. While not conclusive on the question of whether the buyer was located in the United States or not, Mr. Mansell testified that

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<sup>12</sup>These documents were attached as "Plaintiff's exhibit 350" to opposer's notice of reliance.

<sup>13</sup>Plaintiff's exhibit 375 to opposer's notice of reliance.

"[g]enerally UK buyers tended to buy garments that were listed primarily to achieve US sales."<sup>14</sup> Moreover, the website is shown as <http://cgi.ebay.co.uk>, which appears to identify a U.K. website; the record does not establish that this website was available to buyers in the U.S. No one from the United States may have actually viewed this webpage.

Additionally, opposer produced undated color photocopies of models wearing shirts with the mark BENDY across the front; undated copies of the shirts themselves bearing the mark BENDY and Design on hangtags; undated copies of web pages described as on-line "feedback from buyers" (locations of buyers unknown); an undated copy of a page from opposer's website that shows only a model wearing a shirt marked BENDY on the front, London's Big Ben in the background, a flag design and the words "BendyGirl Fashion & Fitness;" a copy of an invoice from eBay Europe S.a.r.l. to opposer dated 15 August 2007 that lists payments opposer has made to eBay; copies of websites allegedly showing third-party use of "bendy" in a descriptive manner; and additional copies of websites bearing dates that post-date

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<sup>14</sup>Opposer's response to Interrogatory No. 1.

applicant's filing date.<sup>15</sup> Finally, there is a copy of a document entitled "Customer Status," which appears to be a record of invoices from and payments to "Continental Clothing Company Ltd." by opposer. Opposer identifies this document as a "requisition list from our UK supplier."<sup>16</sup> None of these show a date prior to the date upon which applicant may rely for its date of first use.

While the oral testimony of a single witness may suffice in proving priority, it must be sufficiently probative, not be characterized by contradictions, inconsistencies or indefiniteness, and carry a conviction of accuracy and applicability. *Powermatics, Inc. v. Glebe Roofing Products Co.*, 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965); and *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1108-09 (TTAB 2007). Moreover, just as oral testimony is strengthened by documentary evidence which corroborates the dates of use, it is weakened by documentary evidence which raises doubts as to the dates. Here, opposer's testimony and evidence is indefinite and ambiguous. We find that the earliest date of actual use upon which opposer may rely is May 15, 2008, the date of

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<sup>15</sup>The documents listed in this paragraph were attached as "Plaintiff's exhibit 350" and "Plaintiff's exhibit 375" to opposer's notice of reliance.

<sup>16</sup> Opposer's Responses to Applicant's First Set of Requests for Production of Documents, p. 9.

the sale to a customer in Alabama, which is after the filing date of applicant's application.

C. OPPOSER'S PRIORITY BASED ON USE ANALOGOUS TO TRADEMARK USE.

We next consider whether opposer has shown that it can claim priority on the basis of any use analogous to trademark use. Before a prior use can become an analogous use sufficient to create proprietary rights, a party must show that such prior use was sufficient to create an association in the minds of the purchasing public between the mark and the goods. *Malcolm Nicol & Co. v. Witco Corp.*, 881 F.2d 1063, 11 USPQ2d 1638 (Fed. Cir. 1989). We infer the fact of identification of the mark with the party on the basis of indirect evidence regarding the party's use of the word or phrase in advertising brochures, catalogs, newspaper ads, and articles in newspapers and trade publications. *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1882 (Fed. Cir. 1996). In addition, the "tacking" theory, under which use analogous to trademark use operates, requires that actual technical trademark use must follow within a commercially reasonable period of time. *Dyneer Corp.* 37 USPQ2d at 1256; *Evans Chemetics, Inc. v. Chemetics International Ltd.*, 207 USPQ 695, 700 (TTAB 1980).



As proof of analogous use, Mr. Mansell identifies Exhibit 7.1 as a "splash page or index page or front cover of our initial website," and describes its public introduction: "I think that was about May or June or some time around there in 2005 or maybe a bit earlier that specific page we put up. Maybe April 2005."<sup>17</sup> While Exhibit 7.1 (the splash page) shows the mark BENDYGIRL and a model wearing a t-shirt with the word "bendy" across the front, the splash page does not include a date, and given the fact that elsewhere in his testimony Mr. Mansell stated that United States sales were a result only of eBay advertising which was not launched until March 2006, it is unclear whether the splash page, even if circulated in the United States, resulted in sales in the U.S. By itself, it is insufficient to show priority through use analogous to trademark use.

Mr. Mansell also identifies Exhibits 20.1, 20.2 and 20.3 as the front and back of an "advertising mailer"<sup>18</sup> but does not provide the date the mailer was mailed to any prospective customers, the address for any recipients, or the number of such customers. The Exhibits themselves are undated and do not show to whom they were addressed. Even

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<sup>17</sup>Mansell Dep., p. 27.

<sup>18</sup> Mansell Dep., p. 25. The testimony is unclear as to whether there were two such mailers, or only one.

taken together with the splash page, opposer has not shown use analogous to trademark use.

Finally, opposer identifies "domain names" and eBay advertisement "upgrades [that] tended to attract around 100 or more specific garment page detailed views"<sup>19</sup> prior to June 29, 2007. The record does not identify eBay advertisement upgrades. With respect to the domain name registrations, opposer identified them in response to applicants' Interrogatory No. 1, as follows:

Domain names: URL's attached to the internet.  
BENDY.COM since 20 Nov 2000. BENDYGIRL.COM 27  
February 2003. BENDYGIRLS 29 March 2005.

Opposer introduced evidence of registration of only one website, bendy.com. However, the date of creation of that website cannot be determined from the registration document. Moreover, none of the evidence submitted by opposer shows any of its domain names being used as trademarks. Domain names that function merely as addresses are not registrable as trademarks. *See In re Eilberg*, 49 USPQ2d 1955, 1957 (TTAB 1998) (mark that "merely indicates the location on the Internet where applicant's Web site appears" does not function as a service mark).

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<sup>19</sup>Opposer's Response To Applicant's First Set Of Interrogatories, p. 5.

In sum, we find that opposer has not used its mark prior to June 29, 2007 in a manner analogous to trademark use. Opposer's use of its mark prior to applicant's filing date was not sufficient to create an association between the marks and the goods in the mind of the relevant purchasing public.

In conclusion, opposer may rely upon the filing dates of its applications as constructive use dates, contingent upon registration. If one of opposer's applications issues, then opposer has priority. The effective filing dates of Application Serial No. 78342438, for the mark BENDY including Class 25, and Application Serial No. 78342445 for the mark BENDYGIRL including Class 25, are December 16, 2003. Should either application issue, then opposer's constructive use date will be December 16, 2003. Should Application Serial No. 78529144 for the mark BENDY in Classes 28 and 35 issue, then opposer's constructive use date will be December 8, 2004. If none of opposer's applications issues, then applicant has priority, based on the filing date of her application, contingent upon her application issuing to registration. We now turn to whether there is a likelihood of confusion between the marks.

## Likelihood of Confusion

Our determination under Section 2(d) is based on 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, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks”).

### A. The strength of opposer’s mark.

We begin our determination by evaluating the strength of opposer’s BENDY and BENDYGIRL marks. Applicant asserts that the term “bend” (and by implication “bendy”) is weak when used in the clothing field.<sup>20</sup> In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself and its

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<sup>20</sup>Applicant’s Brief, p. 14.

commercial strength, based on the marketplace recognition value of the mark. See *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); 2 *J. Thomas McCarthy*, *McCarthy on Trademarks and Unfair Competition* § 11:83 (4th ed.) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”)

We first address the strength of opposer’s marks in terms of their inherent nature. The record includes dictionary definitions of both “bend” and “bendy” that show a connection between the mark and the quality of flexibility.<sup>21</sup> The definitions, however, do not show a connection between the quality of flexibility and clothing. Opposer’s witness, Mr. Mansell, describes applicant’s website (Ex. 9 to his deposition) as including the following statement from applicant: “BEND by definition means flexibility. The clothing literally needs to stretch

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<sup>21</sup> Opposer submitted a print-out from dictionary.com, giving a definition of “bendy” as “tending to bend; flexible or resilient” and of “bend” as “to force (an object, esp. a long or thin one) from a straight form into a curved or angular one.” Opposer’s Notice of Reliance, Exhibit 3.2; Opposer’s response to Applicant’s Request For Production Of Documents.

into the positions and styles you ask of it.”<sup>22</sup>While applicant may intend to draw a connection between the word “bendy” and clothing, there is nothing in the record that shows that consumers have been educated by her statement to think of stretchable clothing as “bend” or “bendy” clothing. Later in his testimony, Mr. Mansell describes a news article from 2008 titled “Madonna Busts A Bendy Yoga Move For Louis Vuitton Ad” that states: “Madonna shows off her flexibility in a bendy pose for Louis Vuitton’s Spring 2009 campaign.”<sup>23</sup>Again, the record does not support a conclusion that this reference educated the public to consider “bendy” as a descriptor for clothing. To further this end, applicant has submitted copies of 17 third-party applications or registrations for marks containing the term “bend” for various items of clothing. We consider these 11 registrations and 6 applications as part of our determination of whether “bendy” is inherently weak.

Prior to registration, a pending application has “no probative value other than as evidence that the application was filed.” *Edwards Lifesciences Corp. v. Vigilanz Corp.*, 94 USPQ2d 1399, 1403 n.4 (TTAB 2010), citing *In re Phillips Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

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<sup>22</sup>Mansell Dep., p. 28.

<sup>23</sup> Id.

Thus, we give no further consideration to the pending applications. As for the 11 registrations, they have limited probative value. None include the term "bendy" and only six use the term "bend." Of the six marks that use the term "bend," the closest in meaning to the idea of flexibility are BEND OVER and BEND (stylized so that the "D" is comprised of the design of a woman bent in the shape of the letter). The connotation of "bend over" does not suggest flexible clothing. The registration for BEND (stylized) is registered for fabric and not for clothing.

Accordingly, we do not view the third-party registrations as establishing that opposer's mark is inherently weak. To the contrary, nothing in the record has established that either term, "bend" or "bendy," describe an aspect, or feature, of clothing or that clothing is referred to descriptively as being bendy, bendable, or having a bend. Along the Abercrombie & Fitch<sup>24</sup> spectrum of distinctiveness of marks, opposer's marks BENDY and BENDYGIRL would be considered at least suggestive, if not arbitrary, in connection with clothing.

With respect to the market strength of opposer's mark, opposer has not shown that its mark is commercially strong.

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<sup>24</sup>See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 764 (2d Cir. 1976) (identifying four different categories of terms with respect to trademark protection: generic, descriptive, suggestive, and arbitrary or fanciful).

Opposer admits that its U.S. sales have not exceeded \$1,000"<sup>25</sup> and has submitted evidence of sales of less than \$25.00. Opposer claims advertising expenses "in excess of \$50,000",<sup>26</sup> but such figures include expenses unrelated to the promotion of either the BENDY or BENDYGIRL trademark. Suffice it to say, opposer fails to establish that its sales or marketing activity has created an enhanced level of customer recognition of its marks. Moreover, the third-party registrations have little probative value in determining the market strength of opposer's marks because applicant has not shown that any of the third-party marks are in use on a commercial scale or that the public has become familiar with them. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) ("The purchasing public is not aware of registrations reposing in the Patent Office ...") *See also In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983) ("absent evidence of actual use of the marks subject of the third-party registrations, they are entitled to little weight on the question of likelihood of confusion.")

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<sup>25</sup> Mansell Dep., p. 48.

<sup>26</sup> Mansell Dep., p. 51.



Accordingly, while BENDY and BENDYGIRL may be considered inherently strong, the evidence does not support a conclusion that the marks are commercially strong.

B. The similarity or dissimilarity and nature of the goods described in parties' applications.

The goods are identical in-part. Both applicant and opposer are seeking to register their mark for, *inter alia*, pants, shirts, t-shirts, tank tops, shorts, skirts, blouses, jackets, parkas, coats, dresses, bathing suits, sweaters, sweat shirts, hosiery, socks and footwear. Thus, opposer's marks BENDY and BENDYGIRL in Class 25 and applicant's mark BEND SPORT COUTURE in Class 25 cover similar goods.

C. The similarity or dissimilarity of likely-to-continue trade channels and classes of consumers.

Because opposer does not own a registration for the mark, we consider the channels of trade and classes of purchasers of opposer as shown by the evidence it has presented. As for applicant, because there are no restrictions or limitations in the application, we presume that applicant's goods are sold through all the normal and usual trade channels for such goods and that they are sold to all the usual purchasers of such goods. Thus, we must consider that applicant's normal channels of trade are not limited to only those she has identified, i.e., "specialty

shops, gyms, upscale department stores, and spas,"<sup>27</sup> but include any normal channels of trade such as clothing stores, mass merchandisers and sales via the Internet through eBay. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987)

Mr. Mansell testified that opposer's "key market" is "the whole United States"<sup>28</sup> and that he has sold his goods on-line through eBay. His targeted customers are "women foremost, with girls and babies secondary."<sup>29</sup> Applicant's targeted customers are also women.<sup>30</sup> Applicant and opposer's trade channels and classes of consumers overlap.

D. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the

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<sup>27</sup> Applicant's response to Interrogatory No. 6.

<sup>28</sup> Mansell Dep., p. 12.

<sup>29</sup> Id.

<sup>30</sup> Applicant's Response to Interrogatory No. 8.

marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). The test 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 impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Also, in comparing the marks, we are mindful that where, as here, the goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007).

1.) BENDY vs. BEND SPORT COUTURE

While the marks must be compared in their entireties when analyzing their similarity or dissimilarity, there is nothing improper in stating that for rational reasons, more or less weight has been given to a particular feature of a mark. *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). We may thus accord greater weight to the literal element "bend" and less regard to the stylization of the mark. In this regard, we note the display of applicant's mark is not so distinctive as to distinguish it from opposer's marks. Similarly, the words "SPORT COUTURE," which have been disclaimed and are descriptive, are entitled to less weight in our analysis. *See Barbara's Bakery, Inc. v. Barbara Landesman*, 82 USPQ2d 1283, 1288 (TTAB 2007); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993).

The significance of the word "Bend" as the dominant element of applicant's mark is further reinforced by its location as the first part of the mark. *See Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"); *see also Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689,

1692 (Fed. Cir. 2005) ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word).

In view of the foregoing, we find that the dominant element BEND in applicant's mark is similar in terms of appearance and sound to opposer's mark BENDY. Moreover, the marks have essentially the same meaning. Dictionary definitions provided by opposer for "bend" and "bendy" show that both connote "flexibility." Given the fact that the word "BEND" is the dominant element of applicant's composite mark and a variation thereof, i.e., BENDY, is the entirety of opposer's mark, we find that applicant's mark is similar to opposer's mark BENDY including Class 25 in terms of appearance, sound, meaning and commercial impression.

2.) BENDYGIRL vs. BEND SPORT COUTURE

Applicant's mark is similar overall to opposer's mark BENDYGIRL in sight, sound, meaning and commercial impression. Both marks start with the same four letters, which gives them a similar appearance; in opposer's mark,

"bendy" and "girl" naturally separate into two distinguishable words, making the first term of each mark the virtually identical word "bend" or "bendy." These first identical four letters of each mark (forming the word "bend") are more likely to be remembered by consumers than the remainder of the mark. See *Hercules Incorporated v. National Starch and Chemical Corporation*, 223 USPQ 1244, 1246 (TTAB 1984) ("In the case before us, considering the marks NATROL and NATROSOL in their entireties, the clearly dominant aspect of both marks is that the first four letters and the final two are the same."); see also *Presto Products*, 9 USPQ2d at 1897.

In pronunciation, both marks are comprised of three syllables, giving them a similar cadence and inflection. The connotation of "flexibility," based on the dictionary definitions of "bend" and "bendy," is enhanced with respect to the mark BENDYGIRL. The evidence shows a "bendy girl" would be understood as referring to someone who is flexible. See *supra*, "Madonna shows off her flexibility in a bendy pose for Louis Vuitton's Spring 2009 campaign,"<sup>31</sup> and applicant's statement, "BEND by definition means flexibility. The clothing literally needs to stretch into

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<sup>31</sup> Id.

the positions and styles you ask of it.”<sup>32</sup>Both marks, BENDYGIRL and BEND SPORT COUTURE, suggest flexibility.

Considering the marks in their entireties, as we must do in evaluating their overall similarities and dissimilarities, we bear in mind that “it is a fundamental tenet of our trademark law that exact similitude is not required to conclude that two marks are confusingly similar.” *Hercules Incorporated*, 223 USPQ at 1246. Here, the similarities of the marks, particularly in appearance and connotation, outweigh their differences. We find that applicant’s mark is similar to opposer’s mark BENDYGIRL in terms of appearance, sound, meaning and commercial impression.

E. Balancing the factors.

In view of the fact that the mark BEND SPORT COUTURE is similar to the marks BENDY and BENDYGIRL and the goods are in-part identical, and because the goods are considered to move in overlapping channels of trade and be available to the same classes of consumers, we find that applicant’s registration of the mark BEND SPORT COUTURE is likely to cause confusion with opposer’s marks BENDY and BENDYGIRL for clothing (Class 25).

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<sup>32</sup>Mansell Dep., p. 28.

**DECISION:** The opposition is sustained with respect to opposer's mark BENDY in Class 25 (application Serial No. 78342438) and opposer's mark BENDYGIRL (Ser. No. 78342445) *contingent* upon their registration.

When opposer's marks have registered (or become abandoned), opposer should promptly inform the Board, so that appropriate action may be taken to terminate this proceeding.

The time of filing an appeal or for commencing a civil action will run from the date of the present decision. See Trademark Rules 2.129(d) and 2.145.