

This Opinion Is Not a  
Precedent of the TTAB

Mailed: March 31, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Chris Combs*  
*v.*  
*Willie Sonley*  
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Opposition No. 91235814  
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Alan S. Clarke of Taylor English Duma LLP for Chris Combs.

Christopher J. Day of Day Law Firm for Willie Sonley.  
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Before Thurmon, Deputy Chief Judge, Bergsman and Wellington, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Willie Sonley (Applicant) seeks registration on the Principal Register of the mark BOOTYMAXX, in standard character form, for “vitamins,” in Class 5.<sup>1</sup>

Chris Combs (Opposer) filed a Notice of Opposition against the registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles Opposer’s previously used mark

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<sup>1</sup> Application Serial No. 87299184, filed January 12, 2017, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use anywhere and first use in commerce as of March 3, 2016.

BOOTY MAX for “non-pornographic videos of women shaking and moving their derrieres (‘booty’)” as to be likely to cause confusion. In addition, Opposer alleges that he has been operating a website called ‘bootymaxtv’ since at least August 2010” posting the above-noted videos.

Applicant denied the salient allegations in the Notice of Opposition.

Only Opposer introduced testimony and evidence. Both parties filed briefs.

#### I. The record

The record includes the pleadings, and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the subject application.

Opposer introduced his testimony declaration and amended testimony declaration with exhibits.<sup>2</sup>

#### II. Introduction

Opposer testified that he “uses and has utilized the name ‘BOOTYMAX’ as part of [his] BOOTYMAXTV website to identify [his] business name for the services [he] offers on [his] website currently and at least as early as August 31, 2010.”<sup>3</sup> Opposer authenticated screenshots of his website including a screenshot from November 2010.<sup>4</sup> In addition, Opposer authenticated the screenshot of his website BOOTYMAXTV, reproduced below, which Opposer posted on January 22, 2015.<sup>5</sup>

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<sup>2</sup> 14, 15 and 18 TTABVUE.

<sup>3</sup> Opposer’s Amended Aff. ¶2 (18 TTABVUE 7). *See also* Opposer’s Aff. ¶2 (15 TTABVUE 3).

<sup>4</sup> Opposer’s Amended Aff. ¶3 and Exhibits 5-11 (18 TTABVUE 7 and 28-57).

<sup>5</sup> Opposer’s Aff. ¶3 and Exhibit 3 (15 TTABVUE 3 and 14 TTABVUE 10).



### III. Standing

Standing is a threshold issue in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). To establish standing in an opposition or cancellation proceeding, a plaintiff must prove that it has a “real interest” in the proceeding and a “reasonable” basis for its belief of damage. *See Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d

1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982).

Opposer testified that he has posted a website called BOOTYMAXTV to identify his services. Based on the exhibits attached to his affidavits, Opposer provides videos of women displaying their derrieres. Based on this testimony, Opposer has failed to prove his standing because there is no testimony or evidence to establish Opposer has a reasonable belief that the registration of Applicant's mark will damage him.

Opposer argues that he has a real interest and personal stake in the proceeding because he has shown prior use of a similar mark.<sup>6</sup> While Opposer's prior use may show an interest in the mark, as noted above, it fails to prove that he has a reasonable belief that the registration of Applicant's mark will damage Opposer. Opposer did not prove that it filed an application for BOOTYMAX or BOOTYMAXTV and the USPTO refused to register Opposer's mark because of Applicant's application, nor did Opposer testify that he believed that there is a likelihood of confusion between the parties' marks when used on or in connection with the respective goods and services. It is not enough that Opposer plead that the registration of Applicant's mark will damage Opposer, Opposer must prove that he believes the registration of Applicant's mark will damage Opposer. *See Lipton Indus.*, 213 USPQ at 189 ("The facts regarding standing, we hold, are part of a petitioner's case and must be affirmatively proved."). This, Opposer did not do.

The opposition is dismissed.

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<sup>6</sup> Opposer's Brief, pp. 10-12 (19 TTABVUE 12-14).

For purposes of completeness, we address the issue of priority and likelihood of confusion.

#### IV. Priority

Because Applicant did not introduce any testimony or other evidence, Applicant must rely on his application filing date, January 12, 2017, for priority. *Westrex Corp. v. New Sensor Corp.*, 83 USPQ2d 1215, 1217 (TTAB 2007) (Granting applicant summary judgment: “In order for applicant to prevail ..., it must demonstrate ... that opposer did not make actual use or analogous trademark use ... prior to ... the filing date of applicant’s intent to use application ... and ... the filing date of applicant’s use application ....”); *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840, 1845 n. 7 (TTAB 1995) (“[I]n proceedings before the Board[,] the constructive use provisions of [Trademark Act] Section 7(c) may be used both defensively and offensively” to establish priority).

As noted above, Opposer testified that he “uses and has utilized the name ‘BOOTYMAX’ as part of [his] BOOTYMAXTV website to identify [his] business name for the services [he] offers on [his] website currently and at least as early as August 31, 2010.”<sup>7</sup> He supported his testimony by screenshots of his website displaying the mark BOOTYMAXTV prior to the filing date of Applicant’s application. Opposer did not introduce any testimony supporting the date of first use either BOOTYMAX or BOOTYMAXTV or any other goods or services.

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<sup>7</sup> Opposer’s Amended Aff. ¶2 (18 TTABVUE 7). *See also* Opposer’s Aff. ¶2 (15 TTABVUE 3).

We find that Opposer used the mark BOOTYMAXTV prior to any date on which Applicant may rely. There is no evidence that Opposer uses BOOTYMAX as a standalone mark. Based on the evidence of record, Opposer uses BOOTYMAX as part of BOOTYMAXTV for “non-pornographic videos of women shaking and moving their derrieres (‘booty’).”

#### V. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019), quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997), quoting *DuPont*, 177 USPQ at 567. “Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)); see also *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). “Each case must be decided on its

own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. Similarity or dissimilarity of the marks.

We now turn first to the *DuPont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong*, 127 USPQ2d at 1801 (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)). See also *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992).

Applicant is seeking to register the mark BOOTYMAXX and Opposer is using the mark BOOTYMAXTV. Because the marks share the term “Bootymax,” they are similar in appearance, sound, connotation and commercial impression. The only differences between the marks is Opposer’s addition of the term “TV” and Applicant’s use of an additional letter “X.”

Consumers are unlikely to distinguish any differences between the marks because of Applicant’s use of an additional letter “X,” assuming consumers even notice the difference. Slight differences in marks do not normally create dissimilar marks. *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985) (“Moreover, although there are certain differences between the [marks’ CAYNA and CANA] appearance, namely, the inclusion of the letter ‘Y’ and the design feature in applicant’s mark, there are also obvious similarities between them. Considering the similarities between the



marks in sound and appearance, and taking into account the normal fallibility of human memory over a period of time (a factor that becomes important if a purchaser encounters one of these products and some weeks, months, or even years later comes across the other), we believe that the marks create substantially similar commercial impressions.”). *See also Mag Instr. Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1714-15 (TTAB 2010) (difference of a single letter does not suffice to distinguish MAG STAR from MAXSTAR); *Parfums de Couer Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007) (BODYMAN and design for a television series not confusingly similar to BOD MAN and BOD for fragrances); *U.S. Mineral Prods. Co. v. GAF Corp.*, 197 USPQ 301, 306 (TTAB 1977) (“‘AFCO’ and ‘CAFCO,’ which differ only as to the letter ‘C’ in USM’s mark, are substantially similar in appearance and sound”); *In re Bear Brand Hosiery Co.*, 194 USPQ 444, 445 (TTAB 1977) (“The mark of the applicant, ‘KIKS’ and the cited mark ‘KIKI’ differ only in the terminal letter of each mark. While differing in sound, the marks are similar in appearance and have a somewhat similar connotation.”).

In addition, considering Opposer’s use of the highly suggestive term “TV” in its mark BOOTYMAXTV when used in connection with posting videos, consumers are likely to focus on the term BOOTYMAX. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”); *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 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 Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *Presto Prods. Inc. v. Nice-Pak Prods., 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”). There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Finally, because Opposer’s mark BOOTYMAXTV incorporates the entirety of Applicant’s mark BOOTYMAXX, albeit without the addition of the extra “X,” the similarity of the marks is increased. *See Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660 (TTAB 2014) (applicant’s mark PRECISION is similar to opposer’s mark PRECISION DISTRIBUTION CONTROL) (citing *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant’s mark ML is similar to registrant’s mark ML MARK LEES). *See also Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967) (THE LILLY as a mark for women's dresses is likely to be confused with LILLI ANN for women's apparel including dresses); *In re U.S. Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (CAREER IMAGE

for women's clothing stores and women's clothing likely to cause confusion with CREST CAREER IMAGES for uniforms including items of women's clothing). In *U.S. Shoe*, the Board observed, “Applicant’s mark would appear to prospective purchasers to be a shortened form of registrant’s mark.” 229 USPQ at 709.

We find that the marks are similar in their entirety in terms of appearance, sound, connotation and commercial impression.

B. The similarity or dissimilarity and nature of the goods and services.

Applicant is seeking to register its mark for vitamins. Opposer uses its mark in connection with posting videos of women’s derrieres. There is no testimony or other evidence proving vitamins and posting videos of women’s derrieres are related. Opposer argues, to the contrary, that Applicant’s website advertises the sale of “Natural Butt Enhancements Supplements” as “cream and pills ‘to tone, lift and enhance your booty,’” with further marketing materials associating these goods with “get[ting] a bigger butt.”<sup>8</sup>

However, the website is probative only for what the website shows on its face. *See Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) (Internet documents proffered through a notice of reliance are admissible only to show what has been printed, not the truth of what has been printed). In this regard, Opposer did not authentic that Applicant is owner of the website and, therefore, we cannot

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<sup>8</sup> Opposer’s Brief, p. 15 (19 TTABVUE 17) (citing Opposer’s Amended Aff. Exhibit 16 (18 TTABVUE 83)).

consider it for what Opposer proposes.<sup>9</sup> Even assuming that Applicant is the owner of the website, Opposer did not prove that consumers would associate the source of vitamins specializing in enhancing one's butt with the source of online videos featuring women's derrieres. In other words, there is no testimony or evidence regarding how consumers of videos displaying women's derrieres and consumers of vitamins perceive the goods and services. It is simply not enough to argue that Applicant's vitamins and Opposer's videos involve women's derrieres. *See In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) ("Although vodka and wine may both be described generally as 'alcoholic beverages,' this is insufficient to establish that applicant's and registrant's goods are related.") (citing *Gen. Elec. Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 694 (TTAB 1977) (to prove that goods are related, it is not enough to find one term that may generically describe the goods); *Elec. Data Sys. Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1463 (TTAB 1991) ("[T]he issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both, or whether both can be classified under the same general category.").

We find that Opposer failed to prove the Opposer's services and Applicant's vitamins are related.

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<sup>9</sup> The results from the ICANN WHOIS screenshot for the URL "bootymaxx.com" does not show any connection with Applicant. Opposer's Amended Aff. Exhibit 15 (18 TTABVUE 77).

C. Established, likely-to-continue channels of trade and classes of consumers.

Opposer did not introduce any testimony or evidence regarding its channels of trade (i.e., how and to whom Opposer sells or distributes his services), nor did Opposer introduce any testimony or evidence regarding Applicant's channels of trade (i.e., how to whom Applicant sells and distributes his vitamins).

We find that Opposer failed to prove that the parties' offer their goods and services in the same channels of trade to the same classes of consumers.

D. Conclusion.

Although the marks are similar, Opposer failed to prove that the parties' goods and services are related or that they may be offered in the channels of trade to consumers in a manner whereby confusion is likely. Opposer failed to prove that the same consumers will encounter the marks under circumstances likely to give rise to the mistaken belief that the goods and services emanate from the same source. Therefore, we find that Applicant's mark BOOTYMAXX for "vitamins" is not likely to cause confusion with Opposer's previously used mark BOOTYMAXXTV for "non-pornographic videos of women shaking and moving their derrieres ('booty')."

**Decision:** The opposition is dismissed.