

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hsieh

Serial No. 78367205

Joseph H. Taddeo, Esq. for Ming-Shan Hsieh.

Anthony M. Rinker, Trademark Examining Attorney, Law Office
102 (Karen M. Strzyz, Managing Attorney).

Before Quinn, Taylor and Bergsman, Administrative Trademark
Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Ming-Shan Hsieh ("applicant") filed an intent-to-use
registration for the mark P. Mauriat and design, shown
below, for "musical instruments," in Class 15.



P. Mauriat

The Trademark Examining Attorney refused registration under Section 2(a) of the Trademark Act of 1946, 15 U.S.C. §1052(a), on the ground that the mark falsely suggests a connection with Paul Mauriat, "a widely known composer and musician from the 1960's."¹ The Examining Attorney submitted the following evidence to support the refusal:

1. The Paul Mauriat entries in the *Space Age Musicmaker* (spaceagepop.com) and Wikipedia websites identifying Paul Mauriat as "the last big star of the space age pop era, given his success with 'Love is Blue' and its accompanying album, *Blooming Hits* and his essentially traditional easy listening approach to 1960's pop hits." In addition, his 1961 melody "Chariot" was given English lyrics, renamed "I Will Follow Him," and became a hit for Little Peggy March.

2. Evidence that recordings by Paul Mauriat are still available. See the Paul Mauriat discography at yahoo.com, the Paul Mauriat instrumental collection on the JD Hay's Crooners website at angelfire.com, and Paul Mauriat Music at <http://fa.la/music-paul-mauriat.asp>.

3. Excerpts from applicant's website featuring photographs of Paul Mauriat and outlining applicant's plan

¹ Paul Mauriat died November 6, 2006.

to sell a line of musical instruments based on Paul Mauriat's lifestyle. (www.pmauriatmusic.com).²

4. The Wikipedia entry for P.Mauriat (not Paul Mauriat) identifying P.Mauriat as "a saxophone manufacturing company based in Taiwan."

According to the "brand concept" page on the company's website, the company was named after French conductor/composer Paul Mauriat in order to associate the company with Mauriat's music and lifestyle. Its products bear the inscription "P.Mauriat PARIS."³

Section 2(a) of the Trademark Act of 1946, 15 U.S.C. §1052(a), provides, in relevant part, that "[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it - (a) consists of or comprises . . . matter which may . . . falsely suggest a connection with persons living or dead."

Following our principal reviewing court's decision in *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir.

² On December 26, 2007, applicant submitted a declaration from Alex Hsieh, the owner of P.Mauriat, a saxophone manufacturing company located in Taiwan, and owner of the pmauriatmusic.com website authorizing applicant to use and register the mark at issue. For purposes of our analysis, we will consider P.Mauriat and applicant to be related companies.

³ We have quoted this excerpt from Wikipedia to show how the authors of the Wikipedia entry perceived applicant's website.

Serial No. 78367205

1983), *aff'g* 213 USPQ 594 (TTAB 1982), the Board utilizes the following four-part test to determine whether a false suggestion of a connection has been established:

1. The mark is the same as, or a close approximation of, the name of or identity previously used by another person;

2. The mark would be recognized as such because it points uniquely and unmistakably to that person;

3. The person named by the mark is not connected with the activities performed by the applicant under the mark; and,


4. The prior user's name or identity is of sufficient fame or reputation that a connection with such person would be presumed when applicant's mark is used on applicant's goods.

In re MC MC S.r.l., ___ USPQ2d ___ (Serial No. 79022561, TTAB September 26, 2008); *In re White*, 80 USPQ2d 1654, 1658 (TTAB 2006); *In re Wielinski*, 49 USPQ2d 1754, 1757 (TTAB 1998); *In re Sloppy Joe's Int'l Inc.*, 43 USPQ2d 1350, 1353 (TTAB 1997).⁴

⁴ Applicant's assertion, in his reply brief, that likelihood of confusion is a condition precedent to finding a false suggestion of a connection was rejected by the Federal Circuit in *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 217 USPQ at 509.

As a preliminary matter, applicant raises, for the first time in his brief, the issue of whether a Section 2(a) refusal applies to a deceased individual when there is no longer anyone entitled to assert a proprietary right.⁵ However, in his April 17, 2008 motion for an extension of time to file a reply brief, applicant explained that he needed additional time to complete negotiations with Mme. Irene Mauriat, the widow and heir of Paul Mauriat, for her consent to the use and registration of the mark sought to be registered. Suffice it to say, there is no basis for applicant to contend that a Section 2(a) false suggestion of a connection refusal does not apply because Paul Mauriat has no heirs.

A. Whether applicant's mark is a close approximation of the name Paul Mauriat?


As indicated above, applicant is seeking to register the mark  that the Examining Attorney asserts is a close approximation of the name Paul Mauriat. Applicant argues that because the dominant element of his mark is the design of the treble clef followed by script lettering, consumers would not perceive the mark as pointing to a specific individual.⁶ However, an applicant cannot overcome

⁵ Applicant's Brief, p. 5.

⁶ Applicant's Brief, pp. 3-4.

a refusal based on a false suggestion of a connection merely by adding a design element to a name or by omitting one or more elements. *In re White*, 80 USPQ2d at 1658; *In re North American Free Trade Association*, 43 USPQ2d 1282, 1285 (TTAB 1997). In this case, we are not persuaded by applicant's arguments because the treble clef design forms the letter "P," and the commercial impression engendered by applicant's mark is P. MAURIAT which is a close approximation of the name Paul Mauriat.

B. Whether applicant's mark points uniquely and unmistakably to Paul Mauriat?

As to whether  points uniquely and unmistakably to Paul Mauriat, applicant contends that "[a] reasonable consumer would not purchase a musical instrument based on an assumed connection with Paul Mauriat, because if that consumer is sufficiently informed to be aware of Paul Mauriat, then the consumer would know that Paul Mauriat does not sell musical instruments."⁷ On the other hand, applicant's website features photographs of Paul Mauriat and his stated branding concept to promote a line of instruments based on Paul Mauriat's lifestyle. Applicant's use of Paul Mauriat's image and his intent to

⁷ Applicant's Brief, p. 5.

sell a line of musical instruments based on Paul Mauriat's lifestyle is strong evidence that his mark points uniquely and unmistakably to Paul Mauriat. Indeed, it is hard to imagine any evidence more persuasive of that fact.

C. Whether Paul Mauriat is connected with applicant's musical instruments?

Paul Mauriat has no connection with applicant's business.⁸

D. Whether Paul Mauriat's name or reputation is sufficiently famous that a connection with Paul Mauriat would be presume when applicant's mark is used on applicant's goods?

The excerpts from the Space Age Music and Wikipedia websites are sufficient to establish the fame or renown of Paul Mauriat for purposes of proving that applicant's mark falsely suggests a connection with Paul Mauriat. Moreover, based on applicant's use of Paul Mauriat's image in his website and his plans to sell a line of musical instruments based on Paul Mauriat's lifestyle, we may draw an inference that applicant intends to create a connection with Paul Mauriat. *Cf L.C. Licensing, Inc. v. Cary Berman*, ___ USPQ2d ___ (Opposition No. 91162330, TTAB March 28, 2008) (applicant adopted its mark with the intent to trade off of opposer's mark and such bad faith is evidence that

⁸ Applicant's Brief, p. 4.

Serial No. 78367205

confusion is likely because an inference is drawn from applicant's expectation of confusion).

In view of the facts that applicant's mark is a close approximation of the name Paul Mauriat, that applicant's mark points uniquely and unmistakably to Paul Mauriat, that Paul Mauriat has no connection with applicant's business, and Paul Mauriat is sufficiently famous that a connection with Paul Mauriat would be presumed if applicant's mark were used in connection with musical instruments, we find that applicant's mark falsely suggests a connection with Paul Mauriat.

Decision: The refusal to register is affirmed.