

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

Mailed:  
April 4, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

\_\_\_\_\_  
**Trademark Trial and Appeal Board**  
\_\_\_\_\_

In re Allegro Multimedia, Inc.  
\_\_\_\_\_

Serial No. 78832702  
\_\_\_\_\_

Maria Crimi Speth of Jaburg & Wilk, P.C. for Allegro  
Multimedia, Inc.

Hannah M. Fisher, Trademark Examining Attorney, Law Office  
111 (Craig D. Taylor, Managing Attorney)

\_\_\_\_\_  
Before Walters, Bergsman and Wellington , Administrative  
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Allegro Multimedia, Inc. filed an intent to use  
application for the mark WIZARD TUNES, in standard  
character format, for "on-line retail store services  
featuring downloadable pre-recorded music and video"  
(Serial No. 78832702). Applicant disclaimed the exclusive  
right to use the word "tunes."

The Trademark Examining Attorney finally refused  
registration under Section 2(d) of the Trademark Act of  
1946, 15 U.S.C. §1052(d), on the ground that applicant's

Serial No. 78832702

mark, when used in connection with applicant's services, is likely to cause confusion with the mark THE WIZ, in typed drawing form, for "retail store services in the fields of consumer electronics and accessories, computer hardware and software, pre-recorded movies and music and household appliances."<sup>1</sup>

Our determination of likelihood of confusion 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 or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard 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").

---

<sup>1</sup> Registration No. 1893461, issued May 9, 1995; Sections 8 and 15 affidavits accepted and acknowledged; renewed.

B. The similarity of the marks in their entireties in terms of appearance, sound, meaning, and connotation.

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that 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 so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v.*

Serial No. 78832702

*Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980);  
*Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108  
(TTAB 1975).<sup>2</sup>

We begin our analysis of the marks by noting that although likelihood of confusion must be determined by analyzing the marks in their entireties, "there 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." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In this regard, the word "Wiz" is the dominant portion of the registered mark, THE WIZ. "The" is a definite article. When it is used before a noun (e.g., The Wiz), it denotes a particular person or thing.<sup>3</sup> In this case, "The" has no trademark significance because it functions only as a term of reference (i.e., it simply emphasizes the "Wiz"). See *In re The Place Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2005) (the definite article THE is not

---

<sup>2</sup> Accordingly, applicant's argument that the average consumer would not see the mark WIZARD TUNES and confuse it with THE WIZ is not the appropriate test for determining whether marks are similar. (Applicant's Brief, p. 4).

<sup>3</sup> The Random House Dictionary of the English Language (Unabridged), p. 1965 (2<sup>nd</sup> ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Serial No. 78832702

distinctive, and it adds no source indicating significance to the mark as a whole); *In re Computer Store, Inc.*, 211 USPQ 72, 73 (TTAB 1981) (the definite article "the" is of no consequence to the mark's registrability).

With respect to applicant's mark, the word "Wizard" is the dominant part of the mark WIZARD TUNES because the word "tunes" is descriptive when used in connection with music. The Examining Attorney submitted dictionary definitions that defined the word "tunes" as music.<sup>4</sup> Moreover, applicant disclaimed the exclusive right to use the word "tunes" in response to the requirement for a disclaimer because the word "tunes" is merely descriptive of "the music related goods sold by applicant."<sup>5</sup> Disclaimed matter is often "less significant in creating the mark's commercial impression." *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001). See also *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight

---

<sup>4</sup> [www.dictionary.com](http://www.dictionary.com); *Cambridge Dictionaries Online* (<http://dictionary.cambridge.org>) attached to the July 16, 2006 Office Action.

<sup>5</sup> July 16, 2006 Office Action.

in reaching a conclusion on the likelihood of confusion'").

The significance of the word "Wizard" as the dominant element of applicant's mark is further reinforced by its location as the first word of the mark. *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*, *supra* (upon encountering the marks, consumers must first notice the identical lead word).

In comparing the marks, we note that the term "Wiz" is an abbreviation of the word "Wizard."<sup>6</sup> "[W]e cannot ignore the propensity of consumers to often shorten trademarks." *Big M. Inc. v. United States Shoe Corp.*, 228 USPQ 614, 616 (TTAB 1985). See also *In re Abcor Development Corp.*, 588

---

<sup>6</sup> AF Acronym Finder ([www.acronymfinder.com](http://www.acronymfinder.com)); The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2000) from [www.dictionary.com](http://www.dictionary.com) attached to the July 16, 2006 Office Action; Cambridge Dictionaries Online (<http://dictionary.cambridge.org>); Random House Unabridged Dictionary (1997) attached to the February 8, 2007 Office Action.

Serial No. 78832702

F.2d 811, 200 USPQ 215, 219 (Rich, J., concurring) ("the users of language have a universal habit of shortening full names - from haste or laziness or just economy of words. Examples are: automobile to auto, telephone to phone, necktie to tie, gasoline service station to gas station"). See also *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1333 (TTAB 1992) ("companies are frequently called by shortened names, such as Penney's for J.C. Penney's, Sears for Sears and Roebuck (even before it officially changed its name to Sears alone), Ward's for Montgomery Ward's, and Bloomies for Bloomingdale's"). Accordingly, "Wiz" and "Wizard" have the same meaning and they engender the same commercial impression (e.g., a magician).

Applicant argued that "'THE WIZ' may be a reference to the book and movie *The Wizard of Oz*, the movie and musical *The Wiz*, or to an individual who contains a particular skill set at some activity (i.e., 'a wiz kid')." <sup>7</sup> Even if applicant's argument is correct, it does not change the fact that the word "Wizard" and its abbreviation, "Wiz," are interchangeable.

---

<sup>7</sup> Applicant's Brief, p. 5).

In terms of appearance and sound, we find that the marks look and sound similar because of the presence of the presence of the word "Wiz" in both marks. The marks are not identical in appearance and sound because of the differences between the word "Wizard" and its abbreviation "Wiz," and the addition of the word "Tunes" to applicant's mark. However, on balance, we find that the overall commercial impressions of the marks are substantially similar.

Comparing the marks in their entireties in terms of appearance, sound, connotation and commercial impression, we find that applicant's mark is similar to the cited registration.

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

In an *ex parte* appeal, likelihood of confusion is determined on the basis of the goods as they are identified in the application and the cited registration. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976). *See also Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the

Serial No. 78832702

identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

In addition, it is well settled that it is not necessary that the services of the applicant and the services of the registrant be similar or even competitive to support a finding of likelihood of confusion. Likelihood of confusion may be found if the respective goods and services are related in some manner and/or if the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under conditions that could give rise to the mistaken belief that they emanate from the same source. *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1469 (TTAB 1988); *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-596 (TTAB 1978).

In this case, applicant is seeking to register its mark for "on-line retail store services featuring downloadable pre-recorded music and video," and the registered mark is for "retail store services in the fields of consumer electronics and accessories, computer hardware and software, pre-recorded movies and music and household

appliances." Accordingly, applicant is selling pre-recorded music and videos online while the registrant is selling pre-recorded music and movies through "brick and mortar" stores.<sup>8</sup>

In order to show that online and "brick and mortar" retail services are related, the Examining Attorney submitted excerpts from the Borders Group website and the Barnes & Noble website.<sup>9</sup> The Borders Group's website described the company's sales of books, music, and movies through both its "superstores" and online shopping through [www.borders.com](http://www.borders.com). The Barnes & Noble website references both standard retail store services ("Find Your Local B&N Store") and online sales of books and music. While there is no evidence that either Borders or Barnes & Noble are selling downloadable music or videos, they both render "brick and mortar" and online retail sales services in the field of music and videos.

The primary difference between the services of the applicant and the services of the registrant is the medium

---

<sup>8</sup> The fact that some of goods sold by the registrant are identical or closely related to the products sold by the applicant is sufficient to support a finding of likelihood of confusion. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application).

<sup>9</sup> February 8, 2007 Office Action.

Serial No. 78832702

through which the music and videos are transferred (e.g., videos, CD-ROMs, and DVDs, on the one hand, and downloadable works, on the other). Under these circumstances, we find that consumers would mistakenly believe that the sale of downloadable music and videos and the sale music and videos on tangible media under the same or similar marks emanate from the same source, and therefore the services are related.

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

Neither the Examining Attorney, nor the applicant, submitted any evidence regarding channels of trade or classes of consumers. However, because there are no restrictions in the description of services in the application or cited registration, we may presume that registrant's "retail store services in the fields of consumer electronics and accessories, computer hardware and software, pre-recorded movies and music and household appliances" and applicant's "on-line retail store services featuring downloadable pre-recorded music and video" may be sold to the same classes of consumers. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 16 USPQ2d at 1787; *Venture Out*

Serial No. 78832702

*Properties LLC v. Wynn Resorts holding LLC*, 81 USPQ2d 1887, 1894 (TTAB 2007); *In re Elbaum*, 211 USPQ at 640.

Applicant argued, however, that "there is a vast difference in the consumer who makes a purchase from a website such as iTunes and the consumer who goes and buys a CD at Best Buy. The technological chasm between the two types of recordings - digital and physical - leads to a vast difference in the consumer which uses each type of product."<sup>10</sup> This argument is not persuasive. First, applicant has not submitted any evidence to support it. Second, there is nothing about the essential characteristics of these services and the products sold through them that dictate the present trade channels or classes of consumers will remain static. The trade practices of the parties can be changed when economics or other factors dictate a need for such change. *Plus Products v. Redken Laboratories, Inc.*, 199 USPQ 111, 115 (TTAB 1978); *The Wella Corporation v. California Concept Corp.*, 194 USPQ 419, 421 (TTAB 1977). Assuming that the registrant is not currently selling downloadable music and videos, there is nothing prohibiting it from expanding into

---

<sup>10</sup> Applicant's Brief, p. 7.

Serial No. 78832702

that method of distribution at such time as the economics makes it profitable for the registrant to so expand.

D. Balancing the factors.

In view of the similarities of the marks, the similarity and nature of the services, and the similarity of the classes of consumers, we find that applicant's use of the mark WIZARD TUNES for "on-line retail store services featuring downloadable pre-recorded music and video" is likely to cause confusion with the mark THE WIZ for "retail store services in the fields of consumer electronics and accessories, computer hardware and software, pre-recorded movies and music and household appliances."

Decision: The refusal to register is affirmed.