

This Opinion is not a
Precedent of the TTAB

Mailed: November 30, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re SF MODE
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Serial No. 79118868
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Jeffrey P. Thennisch of Ingrassia Fisher & Lorenz,
for SF MODE.

Kelly Trusilo, Trademark Examining Attorney, Law Office 107,
J. Leslie Bishop, Managing Attorney.

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Before Seeherman, Wellington and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

SF MODE (“Applicant”) seeks registration on the Principal Register of the mark

WANDERLUST (in standard characters) for the following goods and services:

Pre-recorded disks, tapes, and compact disks featuring music, musical performances, and fitness, wellness, and recreational content; Audio devices, namely, MP3 players; Audiovisual devices, namely, CD players and DVD players; Sound, video, and data recordings in the form of disks featuring music, musical performances, entertainment performances, comedy performances, documentaries, films, fitness and wellness programs, civic, socially beneficial, and recreational programs; Apparatus for recording sounds; Blank magnetic recording media, namely, sound recording disks and optical disks, and audio-video compact disks in International Class 9;

Entertainment services in the nature of live musical concerts, live musical performances, plays, comedy routines, fitness, wellness, entertainment, civic, social, and recreational performances; Discotheque services; night club services; providing online non-downloadable electronic publications in the nature of reviews in the field of music, cultural exhibitions, current affairs, political topics, fitness, wellness, social, civic, and recreational activities; providing amusement arcade services; game services provided on-line from a computer network; publication of books or periodicals; Leisure services, namely, organization of cultural exhibitions, musical performances, providing karaoke services; Music-halls; Organization of balls; Organization of sports competitions for entertainment; Organization of shows, namely, fashion shows, fitness shows, wellness shows; party planning; Theater productions; Operation of movie theaters; Operation of concert halls, night clubs; organization of art work exhibitions for cultural purposes; Cinematographic film projection; Organization of concerts; Organization of conferences in the field of music, cultural exhibitions, current affairs, political topics, fitness, wellness, social, civic, and recreational activities in International Class 41; and

Providing food and drink; Food and drink catering; Providing temporary housing accommodation, bar services in International Class 43.¹

The Trademark Examining Attorney has refused registration of Applicant's mark as to all three classes under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that it so resembles the marks in Registration Nos. 3880423, 3880519 and 4092974 that if it is used in connection with Applicant's identified goods and services, it would be likely to cause confusion or mistake, or to deceive.² All three of the cited registrations are for the word mark WANDERLUST in standard character form. All three are on the Principal Register, and are owned by Wanderlust Festival, LLC.

Registration No. 3880519 for WANDERLUST is for:

¹ Application Serial No. 79118868 was filed on August 16, 2012, under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f, requesting extension of protection for International Registration No. 1131630.

² Office Action of July 10, 2014.

Audio and video recordings featuring entertainment in the nature of music, lectures on fitness, exercise, yoga and music, interviews on fitness, exercise, yoga and music, or fitness, exercise and yoga instruction, all of which relate to a festival featuring these activities, in International Class 9.³

Registration No. 3880423 for WANDERLUST is for:

Arranging and conducting nightclub entertainment events; Concert booking; Conducting entertainment exhibitions in the nature of live music festivals; Entertainment, namely, live music concerts in International Class 41.⁴

And Registration No. 4092974 for WANDERLUST is for:

Production of streaming video and website development in the fields of yoga, music, and entertainment; providing an on-line computer database in the fields of music, yoga and entertainment; educational services, providing instruction, studios, conferences, workshops, professional trainings and retreats in the fields of yoga, meditation, spiritual attunement, exercise and aerobic fitness, diet and nutrition, stress management and relaxation, outdoor recreation, holistic health care, preventative health care, alternative health care, therapeutic massage and alternative healing; electronic publishing services, namely, publishing of online works of others featuring user-created text, audio, video, and graphics; providing on-line journals and web logs featuring user-created content in the fields of music, yoga, and entertainment in International Class 41;

Computer services, namely, providing a database and facilities for interactive discussion groups featuring information in the fields of music, yoga and entertainment via a global computer network; computer services in the nature of customized web pages featuring user-defined information, personal profiles and information; providing temporary use of non-downloadable software applications for classifieds, virtual community, social networking, photo sharing, and transmission of photographic images in International Class 42; and

Online social networking services in International Class 45.⁵

³ Registration No. 3880519 issued on November 23, 2010.

⁴ Registration No. 3880423 issued on November 23, 2010.

⁵ Registration No. 4092974 issued on January 31, 2012.

When the refusal was made final, Applicant appealed and requested reconsideration.⁶ After the Examining Attorney denied the request for reconsideration,⁷ the appeal was resumed.⁸ We affirm the refusal to register.

I. Applicable Law

Applicant's Section 66(a) application is subject to the same examination standards as any other application for registration on the Principal Register. 15 U.S.C. § 1141h(a)(1). Trademark Manual of Examining Procedure (TMEP) § 1904.02(a) (Oct. 2015). If the proposed mark is not registrable on the Principal Register, the extension of protection must be refused. 15 U.S.C. §1141h(a)(4).

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. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *In re Majestic Distilling Co. Inc.*, 315 F.3d 1311, 1314-15, 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 goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). *See also In re i.am.symbolic, LLC*, 116 USPQ2d 1406, 1409 (TTAB 2015).

⁶ 1 TTABVUE, 4 TTABVUE.

⁷ 5-8 TTABVUE.

⁸ 9 TTABVUE.

II. Analysis.

A. Comparison of the marks.

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant's mark to the cited registered marks when they are viewed in their entireties in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 (TTAB 2013).

Here, the applied-for mark, WANDERLUST, is identical to those in the three cited registrations. They are the same in sight, sound, meaning, and overall commercial impression. *See Palm Bay Imports*, 73 USPQ2d at 1692. Because the three registered WANDERLUST marks are in standard characters, they may be depicted in any font size, style or color that Applicant might adopt for its applied-for mark, which is also in standard characters. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909-11 (Fed. Cir. 2012); *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011); *In re Strategic Partners Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012). There is no suggestion that the marks are pronounced differently, and it is admitted that “wanderlust” is a commonly-defined dictionary term connoting “a strong desire for or impulse to wander or travel and explore the world,” a “strong longing for or impulse toward wandering,”

“a strong wish to travel,” and “a great desire to travel and rove about.”⁹ Given the similarities of the goods and services, as discussed below, we conclude that the marks, as used on the respective goods and services, convey the same connotation and the same overall commercial impression. *See Palm Bay Imports*, 73 USPQ2d at 1692.

Accordingly, the identity between the marks is a *DuPont* factor that “weighs heavily in favor of a finding of likelihood of confusion.” *i.am.symbolic*, 116 USPQ2d at 1411. *Accord Midwest Gaming & Entm’t*, 106 USPQ2d at 1165 (“In short, we find that the marks are identical. This finding under the first *DuPont* factor strongly supports a conclusion that a likelihood of confusion exists.”); *Davey Prods.*, 92 USPQ2d at 1202 (“[W]e find that applicant's DAVEY mark and the cited registered DAVEY mark are identical in terms of appearance, sound, connotation and commercial impression. We find that the first *du Pont* factor weighs heavily in favor of a finding of likelihood of confusion.”).

B. Comparison of Goods and Services; Trade Channels.

The next step in our analysis is to compare the goods and services identified in Applicant’s application with the goods and services identified in the cited registrations. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See*

⁹ June 18, 2013 Response to Office Action; July 10, 2014 Office Action, quoting *Merriam-Webster’s online dictionary*, 11th edition, macmillandictionary.com, collinsdictionary.com.

also, *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

As the similarity between marks increases, the similarity of goods and services needed to support a finding of likelihood of confusion declines. See *In re C. H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015). The first two *DuPont* factors become inversely proportional, so where, as here, the marks are identical, the need to find similarity in goods or services declines even further. “[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source.” *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1697, 1689 (Fed. Cir. 1993).

Applicant’s Class 9 goods are, in part, legally identical to the goods identified in Registration No. 3880519; the Application’s “Pre-recorded disks, tapes, and compact disks featuring music” are encompassed by the registration’s broadly worded “Audio and video recordings featuring entertainment in the nature of music ... all of which relate to a festival featuring these activities.” Applicant’s Class 42 “Entertainment services in the nature of live musical concerts” are identical to Registrant’s “Entertainment, namely, live music concerts” in Registration No. 3880423.

Applicant contends that the goods and services it identifies in its application differ from those in Registration Nos. 3880423 and 3880519, which are limited to goods and services provided at a “festival”--i.e., a discrete and temporal event

having a specified focus.¹⁰ As the Examining Attorney correctly observes, however, that limitation does not cure the overlap between Applicant's and Registrant's goods and services.¹¹ The application includes, *inter alia*, "Entertainment services in the nature of *live* musical concerts, [and] *live* musical performances," (emphasis added). These are entertainment services of the sort one could encounter at a festival. Similarly, the audio and video recordings identified in the application include recordings of "musical performances," which could occur at a festival. It is common knowledge that performances at live music festivals may be the subject of audio and video recordings.

Moreover, while Registration No. 3880423 includes "Conducting entertainment exhibitions in the nature of live music festivals;" the term "festival" only modifies that quoted category of services, not the adjoining categories, which are separated from it by semicolons. *Midwest Gaming & Entm't*, 106 USPQ2d at 1166n.4 ("[A]s the Office's practice as set forth in the TMEP provides, the semicolon in the cited registration's identification of services serves to separate the different services.") (citations omitted). *See* TMEP § 1402.01(a) ("Semicolons should generally be used to separate distinct categories of goods or services within a single class."). Thus, the identification of "entertainment, namely, live music concerts," is not limited by the

¹⁰ 10 TTABVUE 8, Applicant's Appeal Brief at p. 7, quoting the *Merriam-Webster* online dictionary, Exhibit A to Applicant's Appeal Brief. Although evidence submitted for the first time with an appeal brief will normally not be considered, see Trademark Rule 2.142(d), the Board exercises its discretion to take notice of the dictionary definition. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

¹¹ Examiner's Statement, 12 TTABVUE 8-9.

reference to “live music festivals” in the listing for conducting entertainment exhibitions.

Because the goods and services are identical in part as to Reg. Nos. 3880519 and 3880423, we must presume that these goods and services travel in the same channels of trade to the same classes of consumers. *See In re Viterra Inc.*, 101 USPQ2d at 1908 (even though there was no evidence regarding channels of trade and classes of purchasers, the Board was entitled to rely on the legal presumption that identical goods travel in the same channels of trade to the same classes of purchasers in determining likelihood of confusion).

Applicant contends that there is no overlap with its goods and services in International Class 43, consisting of “Providing food and drink; Food and drink catering; Providing temporary housing accommodation, bar Services....”¹² But the Examining Attorney adduced Internet screenshots of websites from a variety of music and entertainment festivals, showing that festival services and food and drink services at the festivals are offered under the same mark.¹³ For example, the World Food and Music Festival offers “cuisine from around the world” from a number of different vendors, the Del Ray Music Festival dubs itself “a celebration of local music, food and community,” and Lollapalooza features “three dozen awesome food vendors chosen by its culinary director.”¹⁴ Applicant’s identification of services in Class 43 contains no limitation of channels of trade preventing Applicant from

¹² 10 TTABVUE 9-10, Applicant’s Appeal Brief, pp. 8-9.

¹³ See Examining Attorney’s March 10, 2015 Response to Request for Reconsideration.

¹⁴ *Id.*

offering these services at live music festivals and music concerts, i.e., the venues where Registrant's services are offered. And since the marks are identical, this viable relationship between the respective services supports a finding of likelihood of confusion. *See i.am.symbolic, LLC*, 116 USPQ2d at 1411; *Davey Prods.*, 92 USPQ2d at 1202.

Therefore, the second and third *DuPont* factors weigh in favor of finding a likelihood of confusion.

C. Sophistication of the Consumers.

Next we consider the conditions under which the services are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers, the fourth *DuPont* factor. Purchaser sophistication or degree of care may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay Imports*, 73 USPQ2d at 1695.

Applicant argues that because Registrant's Wanderlust Festival "takes place in a finite, fixed, or discrete time period," and is "highly-regulated and requires permits, licenses, etc. for the provision and sale of any such goods and services," Registrant's customers, having a "reasonably focused need" or a "specific purpose," would tend to make sophisticated and careful purchasing decisions, thereby reducing the likelihood of confusion.¹⁵ "Applicant submits that this situation is not

¹⁵ 10 TTABVUE 23-26, Applicant's Appeal Brief, pp. 22-25.

unlike other well-known events or festivals, such as fans of The Grateful Dead musical group planning to attend specific concert performances of the band at discrete venues. [S]uch consumers would exercise this type of discriminating consumer process to ensure that they purchased tickets to attend their desired show or event - as opposed to ‘any band concert.’¹⁶

This analogy is not particularly apt, as the Wanderlust Festivals feature a number of performers at each festival, not just one group.¹⁷ Moreover, even if the decision to purchase a ticket or attend Registrant’s festival was made with some deliberation, the same customer, encountering a recording featuring musical performances under the *identical* mark as the festival entertainment services, is likely to assume that it emanates from the same source. The same is true for Applicant’s entertainment services in Class 41; these services are legally identical to the Registrant’s services and are sold under the identical mark. In such circumstances, even a careful purchaser is likely to be confused. *See i.am.symbolic, LLC*, 116 USPQ2d at 1413 (identity of marks and relatedness of goods sold thereunder outweigh asserted purchaser sophistication). As for the food and drink services, such services, as identified, would include the sale of very inexpensive items, such as soft drinks, which are the subject of impulse purchases.

Purchasers of recordings, entertainment services in the nature of musical performances, and food and beverage services are the public at large. Even if that

¹⁶ 10 TTABVUE 24-25, Applicant’s Appeal Brief, pp. 23-24.

¹⁷ *See* Office Action of July 10, 2014.

public were to include dedicated fans, as Applicant argues, that does not mean that all consumers of these goods and services are equally knowledgeable. *See Stone Lion*, 110 USPQ2d at 1163 (Board precedent requires the decision to be based on the least sophisticated potential purchasers). Moreover, “being knowledgeable and/or sophisticated in a particular field does not necessarily endow one with knowledge and sophistication in connection with the use of trademarks. ... Nor does it guarantee knowledge of the range of products of the parties with whom one is dealing.” *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988) (citing *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983)).

As a result, this *DuPont* factor favors a finding of likelihood of confusion.

D. Third-Party Registrations.

Applicant argues that, “WANDERLUST is a relatively weak mark that has been adopted, registered, and used by many third parties for a variety of goods and services.”¹⁸

Evidence of third parties’ registration and use of similar marks bears on the strength or weakness of a registrant’s mark. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). It is relevant to the strength of a registered mark in two ways: conceptually and commercially. First, if there is evidence that a mark, or an element of a mark, is commonly adopted by many different registrants, that may indicate that the common element has some

¹⁸ Applicant’s Appeal Brief, p.9, 10 TTABVUE 10.

significance that undermines its conceptual strength as an indicator of a single source. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ ... that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak”)(quoting 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 11:90 (4th ed. 2015)), *quoted in Juice Generation*, 115 USPQ2d at 1674).

Second, if a mark, or an element of a mark, is used extensively in commerce by a number of third parties, that would tend to undermine its commercial strength, as a presumption arises that the consuming public has become familiar with a multiplicity of the same or similar marks, and can now distinguish them based on minor differences. *Id. See Palm Bay Imports*, 73 USPQ2d 1693; *C. H. Hanson*, 116 USPQ2d at 1353 (citing *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) and *Carl Karcher Enters. Inc. v. Stars Rests. Corp.*, 35 USPQ2d 1125, 1130-31 (TTAB 1995)). “The weaker [a registrant’s] mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Juice Generation*, 115 USPQ2d at 1674.

Applicant did not submit any evidence of actual third-party use of similar

marks. Rather, Applicant cites nine third-party registrations and applications for marks containing the word WANDERLUST, for use in connection with various goods and services, from footwear to accent pillows to beer to cosmetics.¹⁹ With respect to the applications, they are only evidence that they were filed, and have no probative value to show that Registrant's mark is weak. Of the five registrations Applicant cites, two have been cancelled.²⁰ The remaining three are for unrelated goods and services,²¹ and the record is devoid of evidence of their use. *See Palm Bay Imports*, 73 USPQ2d 1693; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)("[T]he issue is likelihood of confusion, and on the facts herein more is required than a showing of the existence of various marks."); *Midwest Gaming*, 106 USPQ2d at 1167 n.5. Applicant thus fails to demonstrate either common registration or use of WANDERLUST marks by third parties for the goods and services at issue herein. This factor is therefore neutral.

E. Balancing the Factors.

Taking into account the totality of the evidence of record, we find that Applicant's applied-for word mark, WANDERLUST, in standard characters, is identical to the three registered marks. Applicant's identified goods and services in all three classes significantly overlap those identified in the cited registrations; they are identical in part as to the goods and services in Registration Nos. 3880423 and

¹⁹ 10 TTABVUE 17, Applicant's Appeal Brief, p. 16.

²⁰ Reg. Nos. 3526235; 3511635.

²¹ Reg. Nos. 1961144, (WANDERLUST for footwear); 4295609 (POETIC WANDERLUST for accent pillows); 3825752 (WANDERLUST for brand imagery, advertising and consulting services).

3880519, and related as to Registration No. 4092974. Even if festival-goers exercised some deliberation in purchasing tickets to attend Registrant's festival, that would not obviate the likelihood of confusion engendered by the identity of Applicant's WANDERLUST mark on related goods and services. And Applicant's references to third-party registrations fails to demonstrate that the registered marks are weak. To the extent that there are any other relevant *DuPont* factors, we treat them as neutral.

On balance, we find that Applicant's applied-for mark WANDERLUST, in all three classes of goods and services, is likely to cause confusion with the cited registrations under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

Decision: The Section 2(d) refusal to register Applicant's mark WANDERLUST is affirmed.