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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gibson Guitar Corp.

Serial No. 85127067

Andrea E. Bates of Bates & Bates LLC, for Gibson Guitar Corp.

Alex Seong Keam, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Quinn, Holtzman, and Ritchie, Administrative Trademark
Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Gibson Guitar Corp. ("applicant") filed an application to register the mark FIREBIRD X, in standard character form, for goods identified as "guitars," in International Class 15.¹ The Trademark Examining Attorney refused registration of applicant's

¹ Serial No. 85127067, filed September 10, 2010, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), claiming a bona fide intent to use the mark in commerce.

mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the registered mark FIREBIRD, in typed drawing form, for "electric audio equipment, namely, musical instrument sound processors comprising one or more of the following components, namely, amplifiers, equalizers, and speakers," in International Class 9,² that when used on or in connection with applicant's identified goods, it is likely to cause confusion or mistake or to deceive.

Upon final refusal of registration, applicant filed a timely appeal. Both applicant and the examining attorney filed briefs, and applicant filed a reply brief. For the reasons discussed herein, the Board affirms the refusal to register.

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a 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 goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry

² Registration No. 2757284, issued August 26, 2003. Sections 8 and 15 affidavits accepted and acknowledged.

mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks"). We discuss each of the *du Pont* factors as to which applicant or the examining attorney submitted argument or evidence.

The Marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. The mark in the cited registration consists entirely of the word FIREBIRD. This appears to be arbitrary for the goods identified therein.

Applicant's mark incorporates in full the term FIREBIRD, and merely adds the additional term X. Applicant argues that the additional X, as a Roman numeral, will indicate to consumers that its guitars are the tenth in a line of guitars. It is the general rule that adding a term to an arbitrary mark does not make it less confusing. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Cola-Cola Bottling Co. v. Joseph E. Seagrams & Sons, Inc.*, 526 F.2d 556 188 USPQ 105 (CCPA 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) (THE LILLY and LILLI ANN); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER IMAGE" AND "CREST CAREER IMAGES"); *In re Riddle*, 225 USPQ 630 (TTAB 1985)

("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE"). We find it most likely that consumers will expect FIREBIRD X to indicate a "tenth" addition to applicant's product line sold under applicant's already registered mark.³

In the July 15, 2011 response to office action, applicant stated that: "A Google search of the term 'firebird' results in over 9,870,000 results. The term is related to cars, restaurants, computer databases, music, computer search engines, etc. (See Exhibit 'W')." To the extent applicant is arguing that the term "FIREBIRD" is actually highly suggestive of the goods at issue, applicant's Ex. W presented only three pages of Google results in support of this argument, and they are too truncated to be understandable.

We find that, viewing the marks in their entirety, the marks are highly similar in sight, sound, connotation and commercial impression. Accordingly, we find this *du Pont* factor to weigh strongly in favor of finding a likelihood of consumer confusion.

³ That applicant may also be using the FIREBIRD mark itself for other goods is not, and cannot be part of our analysis in this ex parte proceeding.

The Goods and Channels of Trade

In determinining the similarity or dissimilarity of the goods, we note that the more similar the marks at issue, the less similar the goods or services need to be for the Board to find a likelihood of confusion. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). Where the marks are the same, or nearly so, it is only necessary that there be a viable relationship between the goods or services to support a finding of likelihood of confusion. *In re Concordia Int'l Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983). Goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that the goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used or intended to be used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

Applicant's identified goods are "guitars," while the cited registration includes "electric audio equipment, namely, musical instrument sound processors comprising one or more of the following components, namely, amplifiers, equalizers, and

speakers." The examining attorney has submitted dozens of copies of use-based, third-party registrations covering goods of the type in both the application and the cited registration, including some that were filed by applicant's own attorney. Examples are Registration No. 0887812 ("guitars" and "amplifiers," "speakers"); Registration No. 3549266 ("guitars" and "amplifiers"); Registration No. 3721006 ("guitars" and "amplifiers"); Registration No. 3668886 ("guitars" and "audio amplifiers", "audio speakers"); Registration No. 3865402 ("guitars" and "amplifiers"); Registration No. 2849699 ("guitars" and "amplifiers"); Registration No. 2931726 ("guitars" and "amplifiers"); Registration No. 3134906 ("guitars" and "amplifiers"); Registration No. 3492741 ("guitars" and "amplifiers"); and Registration No. 1957393 ("electric guitars," "acoustic guitars" and "amplifiers for electric guitars). Copies of use-based, third-party registrations may serve to suggest that the goods are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993).

Additionally, there is nothing in the recital of goods in either the cited registration or the application that limits either registrant's or applicant's channels of trade. In the absence of specific limitations in the registration, we must presume that registrant's goods will travel in all normal and

usual channels of trade and methods of distribution. *Squirtco v. Tomy Corporation*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). See *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992) (because there are no limitations as to channels of trade or classes of purchasers in either the application or the cited registration, it is presumed that the registration and the application move in all channels of trade normal for those services, and that the services are available to all classes of purchasers for the listed services). Since there are no limitations on the channels of trade in applicant's identification of goods either, we must make the same presumption with regard to applicant's goods. In other words, there is nothing that prevents registrant's amplifiers and speakers from being sold in the same channels of trade and to the same classes of consumers that purchase applicant's guitars, once they are available for purchase (and vice versa). To further demonstrate that these goods are likely to be sold together, the examining attorney submitted web evidence of businesses that sell both types of goods.

The Guitar Center - Buy New & Used Guitars and Amplifiers at The Guitar Center. Attached to the February 3, 2001 Office Action, p42. www.hotfrog.com.

Peavey Electronics Corp.: Manufacturer of acoustic, bass and electric guitars, guitar and bass amps, drums, as well as M/D/keyboard. Attached to the February 3, 2001 Office Action, p53. www.business.com.

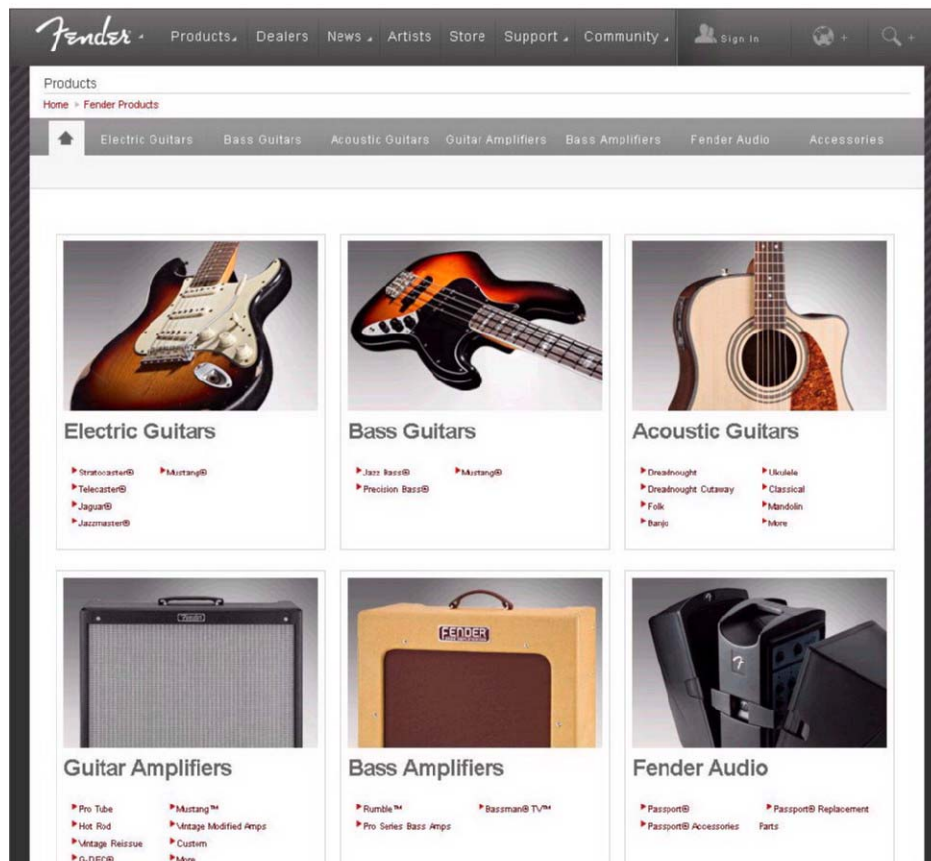
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Samson Technologies Corp.: Syosset, New York based manufacturer of wireless products, amplifiers, equalizers, racklight/power distribution systems, microphones, Brownsville Guitars and Armoured Cables. Attached to the February 3, 2001 Office Action, p54. www.business.com.

Musician's Tech Central: Alvarez handmade guitars; Auerswald Instruments Basses and guitars; Carvin Guitars and equipment; Blues Pearl Amplifiers. Attached to the February 3, 2001 Office Action, p P57-63. www.musicianstechcentral.com.

American Musical Supply:- selling guitars and amps featured on same page. Attached to July 28, 2011 Office Action, P14. www.americanmusical.com.

<http://www.fender.com/products> 07/28/2011 03:04:21 PM



Accordingly, we find that the goods are related and complementary, and the channels of trade would be the same or similar, and these *du Pont* factors also weigh in favor of finding a likelihood of consumer confusion.

Consumer Sophistication

Applicant urges us to consider consumer sophistication. In this regard, applicant has submitted evidence of the high prices of its own guitars. We note that we are bound by the description of goods in the application and the cited registration. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("[t]he authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the 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." [citations omitted]). Thus, we cannot resort to such extrinsic evidence to restrict the prices of applicant's or registrant's goods. See *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). We must presume that both

applicant's guitars and registrant's amplifiers, equalizers, and speakers, would be sold at all the usual prices for such goods, which may include relatively inexpensive products sold to average consumers.

Furthermore, we note that with highly similar marks identifying related goods, even a careful, sophisticated consumer of these goods is not likely to note the differences in the marks. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 948-949 (Fed. Cir. 2000). Furthermore, careful purchasers who do notice the difference in the marks will not ascribe it to differences in the source of the goods, but will see the marks as variations of each other, pointing to a single source.

Accordingly, this *du Pont* factor is neutral.

The Strength or Fame of the Cited Mark

Applicant argues that the mark in the cited registration is not famous, while its own line of marks "has achieved a significant level of fame." (appl's brief at 8). This brings up a situation of reverse confusion, which is no less a problem. We still must resolve doubt for the senior user of the mark, which in an *ex parte* proceeding is presumed to be the one who registered first (particularly as, we note, applicant has filed an intent-to-use application). *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re*

Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Accordingly, this *du Pont* factor is neutral.

Conclusion

In summary, we have carefully considered all of the evidence and arguments of record relevant to the pertinent *du Pont* likelihood of confusion factors. We conclude that with highly similar marks with similar connotations used on similar and complementary goods, travelling through the same or similar channels of trade, even if we consider some amount of sophistication of the consumers, there is a likelihood of confusion between applicant's mark FIREBIRD X for "guitars" and the registered mark FIREBIRD for "electric audio equipment, namely, musical instrument sound processors comprising one or more of the following components, namely, amplifiers, equalizers, and speakers."

Decision: The refusal to register is affirmed.