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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Stephen L. Theard

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Serial No. 85719385

Dana B. Robinson of TechLaw LLP for Stephen L. Theard.

Alec Powers, Law Office 101 (Ronald R. Sussman, Managing Attorney).

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Before Bucher, Wolfson, and Hightower, Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On September 4, 2012, applicant Stephen L. Theard applied to register the mark SUN SOUL ORCHESTRA, in standard characters, for goods in International Class 9 identified after amendment as:

Audiovisual recordings featuring musical performances by a musical group; phonorecords featuring music by a musical group; downloaded audio and video recordings of the music of a musical group; downloadable ring tones and graphics of a musical group; Video magazine recorded on electronic media featuring music by a musical group.¹

“Orchestra” was disclaimed in response to the examining attorney’s requirement.

¹ Application Serial No. 85719385, based on a bona fide intention to use the mark in commerce pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Registration has been refused pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground of a likelihood of confusion with the mark SOUL SUN, in standard characters, for:

- “pre-recorded videos featuring music, film, images, moving motion images and static images; pre-recorded phonograph records featuring music, film, images, moving motion images and static images; pre-recorded audio tapes featuring music, film, images, moving motion images and static images; pre-recorded audio cassettes featuring music, film, images, moving motion images and static images; pre-recorded compact discs featuring music, film, images, moving motion images and static images; pre-recorded digital versatile discs(DVDs)featuring music, film, images, moving motion images and static images; pre-recorded data carriers for audio or visual entertainment featuring music, film, images, moving motion images and static images; none of the aforesaid goods being or relating to computer hardware, computer software, computer firmware, computer peripherals or any goods similar to computer hardware, computer software, computer firmware, computer peripherals or related goods in this class,” in International Class 9; and
- “provision of recording studio facilities, provision of live and pre-recorded musical concerts, music recording services; provision of entertainment in the form of live and pre-recorded musical concerts, non-downloadable films featuring music entertainment, non-downloadable documentaries featuring music entertainment and talks about music entertainment,” in International Class 41.²

Applicant timely appealed. Both applicant and the examining attorney filed appeal briefs.

Analysis

Our determination under Section 2(d) is based on an analysis of all 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

² Registration No. 4366651, issued July 16, 2013 pursuant to Section 44(e) of the Trademark Act.

(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 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 evidence or argument.

A. Similarity of the Marks

We first consider the *du Pont* likelihood of confusion factor focusing on “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “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.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, we cannot dissect the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, __ F.3d __,

110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, 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 a consideration of the marks in their entirety. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant’s mark is SUN SOUL ORCHESTRA, with the descriptive term “orchestra” disclaimed. The cited mark is SOUL SUN. Descriptive or generic matter may have less significance in creating a mark’s commercial impression and little weight in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 224 USPQ at 752). Applicant points out that its mark “immediately informs the relevant consumer that the Applicant is an ‘Orchestra’ of practicing musicians.”³ Although the three-syllable term “orchestra” distinguishes the sound and appearance of the marks somewhat, we find that this highly descriptive term is less significant in association with applicant’s goods, and that the dominant part of applicant’s mark is the distinctive phrase SUN SOUL.

³ Appeal Brief at 7.

Applicant's mark thus incorporates as its dominant portion the cited registered mark in its entirety, merely transposing the terms "sun" and "soul."

Likelihood of confusion has been found where the entirety of one mark is incorporated within another. *See, e.g., Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design for men's cologne, hair spray, conditioner and shampoo likely to cause confusion with CONCEPT for cold permanent wave lotion and neutralizer). We find that the transposition of the terms in the marks SOUL SUN and SUN SOUL ORCHESTRA does not change their overall commercial impression. *See, e.g., In re Nationwide Indus. Inc.*, 6 USPQ2d 1882 (TTAB 1988) (RUST BUSTER confusingly similar to BUST RUST); *In re General Tire & Rubber Co.*, 213 USPQ 870 (TTAB 1982) (SPRINT STEEL RADIAL confusingly similar to RADIAL SPRINT).

For these reasons, we find that applicant's mark SUN SOUL ORCHESTRA is confusingly similar in meaning and overall commercial impression to the cited mark SOUL SUN. The first *du Pont* factor therefore weighs in favor of a likelihood of confusion between the cited mark and applicant's mark.

B. Similarity of the Goods and Channels of Trade

We next address the similarity of the goods and channels of trade, the second and third *du Pont* factors. The goods and services need not be identical or even competitive in order to support a finding of a likelihood of confusion. Rather, it is enough that the goods and 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 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 the respective goods and services. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *Schering Corp. v. Alza Corp.*, 207 USPQ 504, 507 (TTAB 1980).

The application includes goods that are highly similar or identical to goods identified in the cited registration, as shown in the following chart:

Applicant's Selected Goods	Registrant's Selected Goods
"phonorecords featuring music by a musical group"	"pre-recorded phonograph records featuring music, film, images, moving motion images and static images"
"audiovisual recordings featuring musical performances by a musical group"	pre-recorded videos, audio tapes, audio cassettes, compact discs, and digital versatile discs (DVDs), all "featuring music, film, images, moving motion images and static images"

We find that registrant's "pre-recorded phonograph records featuring music . . ." are essentially identical to applicant's "phonorecords featuring music by a musical group." In addition, registrant's pre-recorded videos, audio tapes, audio cassettes, compact discs, and DVDs "featuring music" encompass applicant's "audiovisual recordings featuring musical performances by a musical group."

Because the goods described in the application are legally identical in part to the goods in the cited registration, we presume that the channels of trade and classes of purchasers are the same. *American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011). *See also In re*

Viterra Inc., 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion).

Applicant argues that its goods and channels of trade are distinguishable from registrant's because it "offers goods related to only one source, the band 'Sun Soul Orchestra,'" described in the application as records and audiovisual recordings of "a musical group."⁴ We find this to be a distinction without a difference because the goods identified in the prior registration also may include recordings of music played by "a musical group." We are bound by the identifications as written in the application and cited registration and cannot limit the goods to what any evidence shows them to be. *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764-65 (TTAB 1986). Moreover, the cited registration constitutes "prima facie evidence . . . of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate." Trademark Act Section 7(b).

Accordingly, in our likelihood of confusion analysis, our findings under the second and third *du Pont* factors support a finding of likely confusion.

C. Consumer Sophistication and Degree of Care

Finally, we address applicant's argument under the fourth *du Pont* factor that consumers of both registrant's recording services and applicant's recordings will exercise a high degree of care.⁵ There is no evidentiary support for this argument, but assuming it to be true, "even consumers who exercise a higher degree

⁴ Appeal Brief at 8 (emphasis added in brief to description of goods).

⁵ Appeal Brief at 9-11.

of care are not necessarily knowledgeable regarding the trademarks at issue, and therefore immune from source confusion.” *Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1552 (TTAB 2012). *See also In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (“Human memories even of discriminating purchasers . . . are not infallible.”) (quotation omitted). We find that the fourth *du Pont* factor does not outweigh the likelihood of confusion created by highly similar marks for musical recordings, considering that applicant’s goods are likely to be inexpensive and are legally identical to goods identified in the cited registration.

Conclusion

For the foregoing reasons, we find that the relevant *du Pont* factors weigh in favor of a finding of likelihood of confusion between applicant’s mark SUN SOUL ORCHESTRA and the cited registered mark SOUL SUN in association with applicant’s goods.

Decision: The refusal to register under Section 2(d) is affirmed.