

This Opinion is not a
Precedent of the TTAB

Mailed: June 5, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Innertemple Music LLC
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Serial No. 85810152
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Thomas Carulli of Kaplan Massamillo & Andrews
for Innertemple Music LLC.

Ellen Awrich, Trademark Examining Attorney, Law Office 116,
Michael W. Baird, Managing Attorney.

—
Before Seeherman, Kuhlke and Wellington,
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Innertemple Music LLC has appealed from the Trademark Examining Attorney's final refusal to register the mark SHAKTI THARA (in standard characters) on the Principal Register for services identified as "entertainment services in the nature of live musical performances by a singer of pop music."¹ The application includes the statement that the name "shown in the mark identifies

¹ Application Serial No. 85810152, filed December 24, 2012, asserting first use at least as early as April 1, 2010 and first use in commerce at least as early as August 7, 2012.

Thara Thangavelu dba SHAKTI THARA, whose consent to register is made of record.”

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the mark SHAKTI (typed drawing, equivalent of standard characters), registered for the following goods, that as used in connection with Applicant’s services it is likely to cause confusion or mistake or to deceive:

Compact discs, downloadable audio recordings featuring music and which may be accompanied by printed text and images, namely, booklets, brochures, tray cards, and inserts concerning the music contained in the aforementioned goods sold therewith as a unit. (Class 9).

The registration includes the statement, “The foreign wording in the mark translates into English as ‘the dynamic energy of a Hindu god personified as his female consort or more generally as the active energy force of the universe.’”²

² Registration No. 2633837, issued October 15, 2002; Section 8 affidavit accepted; Section 15 affidavit acknowledged; renewed. Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R. § 2.52, was amended to replace the term “typed” drawing with “standard character” drawing. A mark depicted as a typed drawing is the legal equivalent of a standard character mark. *See In re Brack*, 114 USPQ2d 1338, 1339 n.2 (TTAB 2015). The registration as originally issued had the identification “pre-recorded phonograph records, audio cassette tapes, video cassette tapes, compact discs, CD-ROMs, downloadable audio and video recordings featuring music and which may be accompanied by printed text and images, namely, booklets, brochures, tray cards, and inserts concerning the music contained in the aforementioned goods sold therewith as a unit.” Pre-recorded phonograph records, audio cassette tapes, video cassette tapes and CD-ROMs were cancelled from the registration either at the time the Section 8 affidavit was filed or the registration was renewed. The deletion explains the somewhat awkward language used to identify the remaining goods, and it is clear that “pre-recorded” still modifies the remaining items.

The Examining Attorney had cited two additional registrations, No. 3224092 for SHAKTI DANCE, issued April 3, 2007, for, inter alia, “entertainment in the nature of dance performances” and “entertainment in the nature of theater productions”; and No. 4313575 for BIG SHAKTI, issued April 2, 2013, for, inter alia, “music recordings; audio recordings about yoga, meditation, health and wellbeing, illness, therapy, mind-body medicine,

Applicant and the Examining Attorney have filed briefs.³

We reverse the refusal to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first consider the *du Pont* factor of the similarity of the goods and services. The Examining Attorney takes the position that the services and goods are related because musical artists can be the source of both live musical performances and recordings, and has submitted evidence from various musicians' websites to show that they promote both. The Examining Attorney obviously views the recordings promoted on such websites as being the same goods as the compact discs identified

spirituality, Ayurveda.” The registration for SHAKTI DANCE was cancelled for failure to file a Section 8 affidavit, and the Examining Attorney withdrew the refusal based on the registration for BIG SHAKTI.

³ Applicant filed its appeal brief on December 22, 2014, and filed a revised brief on December 23, 2014. We have considered the revised brief. Applicant filed its reply brief on February 11, 2015, although it was due on February 10. Applicant was given time to provide an explanation as to why its brief was late, but it did not do so. Accordingly, in accordance with the Board's March 25, 2015 order, no consideration has been given to the reply brief.

in the cited registration. However, the Office makes a distinction between the performances embodied in a compact disc, and the compact disc itself. An artist may not normally obtain a registration for compact discs because his or her performance is contained in them. Rather, the owner of a registration for compact discs is considered to be the entity that produces or manufactures the physical object. “Any mark consisting of ...the name of a performing artist on a sound recording, must be refused registration under §§ 1, 2, and 45 of the Trademark Act, 15 U.S. C. §§ 1051, 1052, and 1127, if the mark is used solely to identify ... the artist. TMEP § 1202.09(a). The evidence must show that the name serves as more than a designation of the performer. TMEP § 1209.09(a)(ii). Thus, for a mark to be registrable for “sound recordings,”⁴ it must identify the source of the object itself, and not merely the artist who has created the performance embodied on that object. *See In re Arnold*, 105 USPQ2d 1953, 1959-60 (TTAB 2013), in which the Board found that BLATANCY failed to function as a mark because it merely identified the name of a performer featured on the applicant’s musical recordings. *See also*, two registrations owned by The Warner Entertainment Company, L.P. for marks containing the name “Warner Bros.” for, *inter alia*, pre-recorded phonograph records and tapes,⁵ as examples of the Office practice that it is the manufacturers of records, as opposed to the artists whose performances are embodied in the records, that are treated as the source of records, tapes and downloadable audio recordings.

⁴ “[S]ound recordings may be presented in recorded or electronic form.” TMEP § 1202.09(a).

⁵ Response filed October 13, 2014, pp. 81-84.

In view of this practice of the Office, we must regard the cited registration as indicating the source of the physical compact discs and the downloadable audio recordings, as opposed to the source of the performances contained on the compact discs and recordings. The Examining Attorney has not submitted any evidence that entities that are the source of physical compact discs or recordings for downloading also render performing services under the same mark.⁶

There is, of course, an inherent connection between compact discs and the performances that are recorded on them, but that does not mean that performing services and compact discs must automatically be treated as related. We cannot conclude from the record herein that performing services and actual compact discs or downloadable recordings are sold under a single mark, such that consumers would believe that the performers that render performing services also manufacture compact discs or supply downloadable recordings. On the contrary, what we do have as an example of the coexistence of marks for sound recordings and entertainment

⁶ We note some statements in a Billboard Internet article that would suggest that the performing artist Jay Z has a record company (“ever since he founded Roc-a-Fella Records in 1966”), but this would suggest that, to the extent that performing artists also are responsible for the manufacture and distribution of the physical items, they do so under a different trademark from that used in rendering their performance services. *See* “Beyoncé, Jay Z Top Billboard’s Power 100 List,” *billboardbiz*, January 23, 2014, www.billboard.com; April 17, 2014 Office action, p. 19.

In addition, the excerpts from the itunes.apple.com website regarding the downloading of a song performed by Pharrell Williams state that it was released on March 3, 2014, copyright “Columbia Records, a Division of Sony Music Entertainment, 2013 Back Lot Music, under exclusive license to Columbia Records, a Division of Sony Music Entertainment.” April 17, 2014 Office action, p. 32.

services are the two previously discussed WARNER BROS. registrations for sound recordings, and a registration owned by an individual, Gia Warner, for the mark GIA WARNER for, *inter alia*, entertainment services, namely, personal appearances by a music artist, and live music concerts (Reg. No. 3689824).⁷ Although these third-party registrations showing a single instance of the coexistence of marks with a common element has limited probative value, this is an example of the Office finding that there was no likelihood of confusion between such marks when used for records in one case and performance services in the other.

As for the marks, there is no question that SHAKTI in Applicant's mark SHAKTI THARA is identical to the registered mark, SHAKTI. However, Applicant's mark, SHAKTI THARA, used for live musical performances by a pop music singer, would likely be understood to be the name or pseudonym of the singer. Thus, as used in the mark, SHAKTI would be viewed as the performer's first name. The cited registration, on the other hand, contains a translation of SHAKTI as meaning "the dynamic energy of a Hindu god personified as his female consort or more generally as the active energy force of the universe." This translation is confirmed by a dictionary definition submitted by Applicant: "the dynamic energy of a Hindu god personified as his female consort; *broadly*: cosmic energy as conceived in Hindu thought."⁸ In addition, third-party registrations made of record by Applicant contain similar translations, e.g., "sacred force and empowerment" (Reg. No. 4311545); "energy" (Reg. No. 4098693); "power, energy, divine power, divine energy" (Reg. No.

⁷ Response filed April 10, 2014, p. 85.

⁸ *Merriam-Webster*, October 13, 2014 response, p. 86.

4300500); and “power” (Reg. No. 4132391).⁹ The third-party registrations show that this term has been chosen for several marks connected with yoga services, suggesting that SHAKTI has a significance in this area. Practitioners of yoga may therefore be aware of this meaning. Others seeing the registrant’s mark may view it as an invented term. In any event, they are not likely to view it as a woman’s given name, because there is no evidence that it is generally used as a name. In fact, the person who has consented to the use and registration of her name, SHAKTI THARA, is actually named “Thara Thangavelu,” and Shakti Thara is a stage name.¹⁰

Accordingly, the connotations of the two marks are very different, with SHAKTI THARA being understood as a personal name, while SHAKTI would, to some, have the meaning of energy or power, or have a general significance related to yoga, while others would view it as a coined term. In any event, they would not view registrant’s mark SHAKTI as a given name. We find that the differences in the connotations of the marks, and the commercial impressions, outweigh the similarities in the marks due to the common element SHAKTI. Therefore, we find that overall the marks are more dissimilar than similar.

Finally, with respect to the “conditions of purchase” *du Pont* factor, Applicant argues that the purchasers of the relevant goods and services are discerning and sophisticated. We disagree. Purchasers of pre-recorded compact discs, downloadable

⁹ October 13, 2014 response, pp. 42, 44, 51, 58.

¹⁰ “The subject mark is the name under which Applicant’s owner, Thara Thangavelu, performs....” October 10, 2013 response, p. 1.

audio recordings and live musical performance services are the general public, and there is no evidence that would lead us to conclude that they are particularly sophisticated when it comes to buying compact discs or downloading audio recordings or attending musical performances. The record shows that individual songs can be downloaded for as little as \$1.29¹¹ Applicant relies on two federal district court cases in which the court referred to buyers of musical recordings as relatively sophisticated. However, the courts were clearly treating “musical recordings” as the artist’s performance embodied in the recording. Because, as already discussed, the compact discs and the downloadable audio recordings identified in the cited registration are the physical objects rather than the artists’ performances, the statements by the courts are not applicable to the present situation. We therefore treat this *du Pont* factor as neutral, as we do the remaining *du Pont* factors, which have not been discussed and for which no evidence has been submitted.¹²

Because we find that the record does not establish that consumers are likely to assume that a single entity would offer manufactured compact discs and

¹¹ April 17, 2014 Office action, p. 32.

¹² Applicant has also argued that the scope of protection to be accorded the cited registration should be limited. We note that several third-party registrations for marks containing the word SHAKTI for the same or very similar goods and services to those of the registrant or Applicant were registered despite the presence of the cited registration on the register. The goods in the cited registration include compact discs; Registration No. 4313575 for BIG SHAKTI includes “music recordings”; Registration No. 3379506 for SHAKTI WARRIORS includes live performances by costumed characters; and Registration No. 3224092 for SHAKTI DANCE includes entertainment in the nature of dance performances and entertainment in the nature of theater productions. Although we do not base our decision on this, these third-party registrations indicate that in several instances examining attorneys have not treated the cited registrant’s mark SHAKTI as a strong mark that is entitled to a broad scope of protection.

downloadable audio recordings and also render entertainment services in the nature of live musical performances by a singer of pop music, let alone under a single mark, and because of the differences in connotation and commercial impression of the marks, we cannot find that Applicant's mark for its services is likely to cause confusion with the registrant's mark for its goods. Accordingly, we must reverse the refusal of registration.¹³

Decision: The refusal to register Applicant's mark SHAKTI THARA is reversed.

¹³ On a different record, such as might be adduced in an opposition proceeding, we might reach a different result.