

This Opinion is Not a
Precedent of the TTAB

Mailed: July 6, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Leon Hughes, Sr.
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Serial No. 86079547
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Matthew H. Swyers of The Trademark Company,
for Leon Hughes, Sr.,

Cory Boone, Trademark Examining Attorney, Law Office 104,
Chris Doninger, Managing Attorney.

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Before Kuczma, Greenbaum and Masiello,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Leon Hughes, Sr. (“Applicant”) seeks registration on the Principal Register of the
mark LEON HUGHES’ COASTERS (in standard characters) for

Live performances by a musical group in International
Class 41.¹

The Trademark Examining Attorney has refused registration of Applicant’s
mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), citing

¹ Application Serial No. 86079547 was filed on October 1, 2013, based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as 1999. The name shown in the mark, LEON HUGHES, identifies Applicant Leon Hughes, Sr., whose express consent to register is of record. October 5, 2013 Voluntary Amendment.

Registration No. 2146911 as a bar to registration. Registration No. 2146911 owned by The Original Coasters, Inc. is for the mark THE COASTERS (in standard characters) for “entertainment services in the nature of a musical group” in International Class 41.²

After the refusal to register was made final, Applicant appealed to this Board, and Applicant and the Examining Attorney filed briefs. For the reasons set forth below, the refusal to register is affirmed.

I. Likelihood of Confusion

Applicant contends that in view of the differences between the marks due to the name LEON HUGHES’ being included as part of his mark, the differences in his services and those in the cited registration, and the sophistication of the purchasers, there is no likelihood of confusion.

Our determination under § 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 (CCPA 1973); *see also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). Not all of the *du Pont* factors are relevant to every case, and only factors of significance to the particular mark need be considered. *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010).

² Registration No. 2146911 issued on March 31, 1998; renewed.

We carefully considered all of the evidence of record as it pertains to the relevant *du Pont* factors, as well as Applicant's arguments (including any evidence³ and arguments not specifically discussed in this opinion). To the extent that any other *du Pont* factors for which no evidence or argument were presented may nonetheless be applicable, we treat them as neutral.

A. Similarity of the Marks

We consider the first *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *du Pont*, 177 USPQ at 567. 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 Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *In re Cook Medical Technologies LLC*, 105 USPQ2d 1377, 1381 (TTAB 2012).

Although registrant's mark begins with the word "The," the definitive article "the" at the beginning of mark does not generally affect or otherwise diminish the overall similarity between the marks. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (the addition of the word "the" at the beginning of the registered

³ While the Brief of the Applicant at p. 10 (4 TTABVue 11) refers to "the attached affidavit," no affidavit was filed with the Brief. Moreover, even if an affidavit was filed with the Brief, it would not have been given any consideration. Trademark Trial and Appeal Board Manual of Procedure § 1207.01 (June 2015).

mark does not have any trademark significance); *In re The Place Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2005) (the definite article THE and the generic term BAR are not distinctive terms, and add no source-indicating significance to the mark as a whole). Looking at registrant's mark, THE COASTERS, the inclusion of the word "THE" in the beginning of registrant's mark is not distinctive and does not serve to distinguish the mark.

Applicant's mark and registrant's mark are similar, in part, in appearance, sound and meaning due to the COASTERS portion of each mark. However, we are mindful that we must consider the entire marks, including the presence of the name "LEON HUGHES" in Applicant's mark, in light of the evidence of record to determine their commercial impressions.

Applicant argues the marks at issue do not create the same appearance, sound, connotation and commercial impression. Applicant's mark "is clearly focusing on the fact that this is Leon Hughes' version of 'The Coasters' band, which he was once a part of."⁴ In essence, due to his former membership as one of the singers in The Coasters, Applicant maintains that the additional element of his name (in the possessive form) in the mark LEON HUGHES' COASTERS creates a different commercial impression from THE COASTERS.⁵

The mere addition of a term or name to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of

⁴ Response to Office Action, p. 4, attached to Petition to Revive Abandoned Application filed July 14, 2014.

⁵ Brief of the Applicant p.8 (4 TTABVue 9).

confusion under Trademark Act Section 2(d). *See In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & 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 Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY'S ACCU TUNE); *Nina Ricci S.A.R.L. v. Haymaker Sports Inc.*, 134 USPQ 26, 28 (TTAB 1962) (persons familiar with NINA RICCI or RICCI for women's apparel would logically assume that women's clothing bearing RICCI OF HAYMAKER emanates from same source or is connected in some way).

Customers who see or hear Applicant's mark are likely to assume that it simply identifies what had previously been an unidentified anonymous source behind registrant's mark. Seeing the mark LEON HUGHES' COASTERS, even those customers who recognize the name Leon Hughes as a former member of THE COASTERS could likely think that he is reunited with THE COASTERS singing group. Thus, the addition of the name LEON HUGHES' to the otherwise nearly identical COASTERS portion of Applicant's mark does not avoid a likelihood of confusion with THE COASTERS.⁶ Instead, it likely suggests that Applicant's services are related to registrant's services or that registrant's services are related to Applicant's services. *See, e.g., In re Riddle*, 225 USPQ at 632 (finding RICHARD PETTY'S ACCU TUNE and design for automotive service centers specializing in

⁶ Applicant does not argue, and we do not see, that the inclusion of an apostrophe after the name LEON HUGHES has any significance regarding source.

engine tune-ups and oil changes likely to cause confusion with ACCUTUNE automotive testing equipment) and 4 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:43 (4th ed. June 2015).

Applicant argues that when comparing the marks, the Examining Attorney did not consider the marks in their entirety. While marks are compared in their entirety in a likelihood of confusion analysis, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterro Inc.*, 101 USPQ2d at 1908; *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). The term “COASTERS” in Applicant’s mark is arbitrary as applied to a musical group, and accordingly it is at least as significant as LEON HUGHES for purposes of indicating the source of the underlying services. The fact that both marks feature this highly important element makes them confusingly similar as indicators of source. Moreover, the use of Applicant’s name, LEON HUGHES’, in his applied-for mark may only tend to increase and not decrease the likelihood of confusion, mistake or deception by suggesting that Applicant is now the source of, or at minimum affiliated with, THE COASTERS vocal group.⁷ *Saks & Co. v. TFM Industries Inc.*, 5 USPQ2d 1762, 1764 (TTAB 1987); *In re Christian Dior, S.A.*, 225 USPQ 533, 535 (TTAB 1985).

⁷ As Applicant admits, he was once a member of The Coasters singing group. *See* Brief of the Applicant p. 8 (4 TTABVue 9); Response to Office Action p. 4 submitted with Petition to Revive Abandoned Application, and Exhibit A to Affidavit of Leon Hughes submitted therewith. This fact only increases the likelihood that customers may mistakenly perceive a continuing association between the two.

Given the identity of the “COASTERS” portions of both marks and the absence of any evidence showing that this term is weak or diluted, we accord the cited registered mark an ordinary scope of protection in our likelihood of confusion analysis. *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974); *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982).

Therefore, in view of the foregoing, the marks LEON HUGHES’ COASTERS and THE COASTERS are similar in sight, sound, meaning and commercial impression.

B. Similarity of Services

We next consider the second *du Pont* factor, namely, the similarity of the services. It is well-settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the goods and services as they are identified in the involved application and cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed.Cir. 2014); *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Here, Applicant’s services are “live performances by a musical group,” and the services identified in the cited registration are “entertainment services in the nature of a musical group.” While the recited services are nearly identical, Applicant maintains that his services are marketed through live performances and via his online website to fans intending to see Leon Hughes perform, while

registrant's services "appear[] to primarily be marketed to consumers interested in seeing non-original members of the older band using THE COASTERS mark."⁸

Notwithstanding Applicant's argument and evidence regarding the actual scope of his own services, Applicant's services, as identified, are included within the scope of the services identified in the cited registration for THE COASTERS.

C. Channels of Trade and Class(es) of Customers

We next consider whether the services travel in the same trade channels to the same classes of customers. Because there are no limitations as to trade channels or classes of customers in the identification of services in either the application at issue or the cited registration, and because the services of Applicant and registrant overlap, we must presume that the respective services travel through the same channels of trade and are available to the same classes of customers for those services. *In re Viterra Inc.*, 101 USPQ2d at 1908; *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1551-52 (TTAB 2012); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994).

In view of the foregoing, the *du Pont* factors of the similarity of the trade channels and classes of customers favor a finding of likelihood of confusion.

D. Sophistication of Customers

While tickets to see Applicant perform are not necessarily purchased only by the sophisticated "fans" identified by Applicant,⁹ even sophisticated customers are

⁸ See July 14, 2014 Petition to Revive Abandoned Application, Response to Office Action, p. 5, and Ex. 3, Affidavit of Leon Hughes, Sr., ¶ 4.

subject to source confusion in view of the similarity of the marks. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999). Furthermore, because the marks contain the same term “COASTERS,” even a sophisticated consumer who knows of Applicant’s prior association with “The Coasters” would be susceptible to confusion as to a possible continuation or renewal of such association.

Moreover, even if customers are sophisticated or knowledgeable, or exercise a higher degree of care in a particular field, such as live musical group performances, this does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion, especially in cases such as the instant one involving highly similar marks and nearly identical services. *See, e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 110 USPQ2d at 1163; *Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011); *In re Decombe*, 9 USPQ2d 1812, 1814-1815 (TTAB 1988) (“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.”).

Thus, the sophistication of purchasers is neutral.

E. Absence of Actual Confusion

Applicant contends that he is not aware of any instances of actual confusion as between the services offered in connection with his mark and the services offered under the registered mark. Noting the length of time during which Applicant has

⁹ *See* July 14, 2014 Petition to Revive Abandoned Application, Ex. 3, Affidavit of Leon Hughes, Sr., ¶ 3, 5.

used his mark and has co-existed with the registered mark without confusion (*i.e.*, since 1999), Applicant maintains that confusion is not likely.¹⁰

The fact that an applicant in an *ex parte* case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis. The Board in such cases, and in this case, generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred. *See, e.g., In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001); *In re Jeep Corporation*, 222 USPQ 333, 337 (TTAB 1984); *In re Barbizon International, Inc.*, 217 USPQ 735, 737 (TTAB 1983).

In any event, Applicant's uncorroborated statement of no known instances of actual confusion is entitled to little weight. *In re Cook Medical Technologies LLC*, 105 USPQ2d 1377, 1383-84 (TTAB 2012); *In re Bissett-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). While a showing of actual confusion is highly probative, if not conclusive, of a high likelihood of confusion, a lack of evidence of actual confusion carries little weight, especially in an *ex parte* context. *In re Majestic Distilling Co.*, 65 USPQ2d at 1205.

¹⁰ See Affidavit of Leon Hughes, ¶¶ 5 and 6, submitted as Exhibit 3 to July 14, 2014 Petition to Revive Abandoned Application.

F. Conclusion

Applicant's mark is similar to the registered mark as they both contain the identical distinctive word COASTERS. While the possessive of Applicant's name, LEON HUGHES', is a difference between the marks, it does not result in marks that are dissimilar for likelihood of confusion purposes, especially since Applicant used to be a member of THE COASTERS vocal group.¹¹ Potential customers seeing Applicant's mark are likely to assume that it identifies LEON HUGHES as a member of, or appearing with, THE COASTERS. Because the marks are similar, and the services are essentially identical and travel in the same trade channels to the same customers, there is a likelihood of confusion between Applicant's LEON HUGHES' COASTERS mark and THE COASTERS mark in the cited registration.

Decision: The refusal to register Applicant's mark LEON HUGHES' COASTERS is affirmed.

¹¹ See *Wikipedia* attachments to October 18, 2013 Office Action.