

<p>This Opinion is not a Precedent of the TTAB</p>
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Mailed: July 29, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re David Cenicerros

Serial No. 88636171

Francis John Ciaramella of Francis John Ciaramella, PLLC
for David Cenicerros.

Samuel R. Paquin, Trademark Examining Attorney, Law Office 101,
Zachary R. Sparer, Managing Attorney.

Before Cataldo, Wolfson, and Lebow,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, David Cenicerros, seeks registration on the Principal Register of the mark BRUNO AND THE HOOLIGANS (in standard characters), identifying the following services:

Live performances by a musical group; Music composition services; Music production services; Music publishing services; Music video production; Entertainment services in the nature of live musical performances; Entertainment services in the nature of live visual and audio performances, namely, musical, variety, news and comedy shows; Entertainment services in the nature of live musical performances; Entertainment services in the nature of presenting live musical performances; Entertainment, namely, live music concerts; Entertainment, namely, live performances by musical bands;

Entertainment, namely, live performances by a musical band; Planning arrangement of showing movies, shows, plays or musical performances; Presentation of musical performances; Production of music; Production of musical sound recording; Production of musical videos; Production of sound and music video recordings; Providing a website featuring entertainment information in the field(s) of music; Providing a website featuring information in the field of music and entertainment; Providing on-line music, not downloadable; Providing online music, not downloadable

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), on the ground of likelihood of confusion with the registered mark THE HOOLIGANS (in standard characters) identifying, inter alia, the following services:

Entertainment in the nature of live performances by a musical band; entertainment in the nature of live radio, television, or internet personality performances; entertainment in the nature of collaborative performances by a musical band; entertainment in the nature of visual and audio performances by a musical band; entertainment in the nature of visual and audio performances, and musical, variety, news and comedy shows; entertainment in the nature of visual and audio performances, namely, musical band, rock group, folk group, ethnic music group, gymnastic, dance and ethnic dance performances; entertainment in the nature of live performances by a musical band; entertainment, namely, live music concerts; entertainment, namely, live performances by a musical band; entertainment, namely, live performances by musical bands; entertainment, namely, live performances by rock, folk, or ethnic music groups; live performances by

¹ Application Serial No. 88636171 was filed on September 30, 2019, based on Applicant's assertion of January 2019 as a date of first use of the mark anywhere and in commerce under Section 1(a) of the Trademark Act. 15 U.S.C. § 1051(a). The application includes the following statement: "The name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual."

Page references to the application record are to the downloadable .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions and orders on appeal are to the Board's TTABVUE docket system.

a musical group; providing a website providing entertainment information; providing a website for entertainment purposes where users can view and/or post audio, video, and text clips featuring or regarding a musical band; providing a website featuring information in the fields of band contact, concert booking and touring, music performances, band members and performance requirements

in International Class 41.²

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

I. Likelihood of Confusion

We base our determination of likelihood of confusion under Trademark Act Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); see also *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019).

We have considered each *DuPont* factor that is relevant, and have treated other factors as neutral. See *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (“Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.”)).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98

² Registration No. 4897687 issued on the Principal Register on February 2, 2015. The registration also recites goods in International Class 9.

USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations are the similarities between the marks and the relatedness of 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.”); *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018).

A. The Services, Channels of Trade, and Classes of Customers

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014); *see also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). In this case, Applicant’s “live performances by a musical group” and “live music concerts” are identical to the “live performances by a musical group” and “entertainment, namely, live music concerts” identified in the cited registration. Based on the plain wording of the respective identifications, the involved services are, in part, identical.

Applicant argues that the owner of the cited registration provides goods and services related to “Celtic themed music.”³ Applicant reasons:

Here, the question is whether a consumer in commerce will confuse the source of the above goods and services. ... Specifically, a consumer is incredibly to purchase the Celtic-themed music of the Prior Owner assuming it came from the Applicant.⁴

Applicant’s argument is unavailing. It is long settled that likelihood of confusion is determined on the basis of the goods or services as they are identified in the application and registration at issue. *In re FCA US LLC*, 126 USPQ2d 1214, 1217 (TTAB 2018); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976); *see also Octocom Systems*, 16 USPQ2d at 1787 (“The 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”).

In this case, the broadly worded “live performances by a musical group” and “live music concerts” in the application and registration necessarily encompass all genres and styles of music. Thus, the Examining Attorney properly found these services to be identical. Furthermore, because the services discussed above in the application and cited registration are in-part identical, there is no need for us to further consider

³ 6 TTABVUE 7-8 (Applicant’s brief); July 8, 2020 Response to first Office Action at 16-17; December 30, 2020 Request for Reconsideration at 17-18.

⁴ 6 TTABVUE 7-8. (Emphasis supplied by Applicant.)

the relatedness of Applicant's services with the other services identified in the cited registration. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 938-39 (Fed. Cir. 1983) (holding that a single good from among several may sustain a finding of likelihood of confusion); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application).

Nonetheless, we find that the remaining services are related. Both the cited registration and the involved application identify various musical and related entertainment services without limitation or qualification as to style, genre or theme. Where services are broadly identified in an application or registration, "we must presume that the services encompass all services of the type identified." *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) (where the services in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein), *quoted in In re Country Oven, Inc.*, 2019 USPQ2d 443903, * 4 (TTAB 2019) and *cited in In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, *11-12 (TTAB 2020).

The third *DuPont* factor concerns "[t]he similarity or dissimilarity of established, likely-to-continue trade channels." *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1161 (quoting *DuPont*, 177 USPQ at 567). Because the services described in the application and the cited registration are in-part identical, we must presume that the channels of trade and classes of purchasers for those services are the same. *See Am.*

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); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) (“Given the in-part identical and in-part related nature of the parties’ goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade”); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers”). The remaining services, being unrestricted, are presumed travel through all normal and usual trade channels for such services, and that they are sold to all classes of prospective purchasers for those services. *Stone Lion, Capital v. Lion Capital*, 110 USPQ2d at 1161; *see also Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (absent limitation, “goods are presumed to travel in all normal channels ... for the relevant goods.”).

We find that the identity of the services, and their presumed overlapping channels of trade and consumers weigh heavily in favor of likelihood of confusion.

B. Strength of the Cited Mark / Number and Nature of Similar Marks

Next, we evaluate the strength of the registered mark and the scope of protection to which it is entitled. The fifth *DuPont* factor is the strength of the prior mark, and the sixth factor is the number and nature of similar marks in use for similar goods or

services. *DuPont*, 177 USPQ at 567. In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition. *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”).

We are not persuaded by Applicant’s argument that:

All trademarks are not equal. . . . [H]ere, there is no evidence that the cited Prior Mark is famous or has acquired secondary meaning within the marketplace or that consumers associate the term HOOLIGANS with the Prior Owner.⁵

Applicant’s arguments misapprehend the legal underpinnings of the fifth and sixth *DuPont* factors. Turning first to inherent strength, there is no evidence of record that the terms comprising the mark THE HOOLIGANS possess any but an arbitrary meaning in connection with the services identified thereby. There is no evidence of third-party use; and there is no evidence of third-party registration of similar marks for related products or services. *Cf. Juice Generation, Inc. v. GS Enters LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135-36 (Fed. Cir. 2015). Further, the cited registration issued on the Principal Register without a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f), and we must accord the cited registration the presumption of validity provided for under Section 7(b) of the Trademark Act, 15

⁵ 6 TTABVUE 9.

U.S.C. §1057(b). We thus presume that the mark THE HOOLIGANS is inherently distinctive with no need to acquire secondary meaning.

There is no evidence regarding the mark's commercial or marketplace strength. In an ex parte appeal, the owner of the cited registration is not a party, and the Examining Attorney is under no obligation to demonstrate exposure to or recognition of the cited mark in the marketplace. *In re Integrated Embedded*, 120 USPQ2d 1504, 1512 (TTAB 2016). For that reason, "in an ex parte analysis of the *du Pont* factors for determining likelihood of confusion ..., the '[commercial strength] of the mark' ... is normally treated as neutral when no evidence as to [marketplace recognition] ... has been provided." TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 1207.01(d)(ix) (Jun. 2021). Because there is no evidence of record regarding the commercial strength of the cited mark, this consideration is neutral.

We find that the registered mark is entitled to the normal scope of protection to which inherently distinctive marks are entitled. *See Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (stating that likelihood of confusion fame varies along a spectrum from very strong to very weak). Based upon the totality of the record evidence, we find that the registered mark is arbitrary and distinctive as applied to the identified services.

The fifth and sixth *DuPont* factors are neutral.

C. The Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant's BRUNO AND THE HOOLIGANS mark and the registered THE

HOOLIGANS mark in their entirety, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1160; *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted). *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018).

“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*, 101 USPQ2d at 1721 (internal quotation marks omitted). *See also Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016). Consumers may not necessarily encounter the marks in close proximity and must rely upon their recollections thereof over time. *In re Mucky Duck Mustard*, 6 USPQ2d 1467, 1468 (TTAB 1988).

Applicant’s BRUNO AND THE HOOLIGANS mark adopts the wording of the registered mark THE HOOLIGANS in its entirety, adding the preceding wording “BRUNO AND.” “Marks have frequently been found to be similar where one mark

incorporates the entirety of another mark, as is the case here.” *Coca-Cola Bottling Co. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL is similar to BENGAL LANCER); *Johnson Publ’g Co. v. Int’l Dev. Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY is similar to EBONY DRUM); *In re S. Bend Toy Mfg. Co.*, 218 USPQ 479, 480 (TTAB 1983) (LIL’ LADY BUG is similar to LITTLE LADY).

Applicant’s mark also includes the leading term “BRUNO AND” suggesting an individual, real or imaginary, who is a member of “THE HOOLIGANS” or otherwise associated with Applicant and its services. The term BRUNO is also prominently placed at the beginning of the mark. We accordingly find this term to be equally distinctive of the services as “THE HOOLIGANS.”

We acknowledge that the presence of “BRUNO AND” as the leading term in Applicant’s mark differentiates it visually and aurally from the registered mark. This point of distinction, however, does not significantly diminish the strong similarities in connotation and overall commercial impression engendered by these two marks. Based upon the above analysis, we find that BRUNO AND THE HOOLIGANS is more similar than dissimilar to the mark THE HOOLIGANS in terms of appearance, sound, connotation, and commercial impression. As a result, consumers encountering BRUNO AND THE HOOLIGANS and THE HOOLIGANS could mistakenly believe the former is a variation on the registered mark used to identify a particular musical act, e.g., THE HOOLIGANS featuring or appearing with BRUNO as a subset of Registrant’s services, but nonetheless emanating from a common source. *See In re*

Bay State Brewing Co., 117 USPQ2d 1958, 1961 (TTAB 2016) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811 , 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring) (“the users of language have a universal habit of shortening full names—from haste or laziness or just economy of words”)).

This is especially the case here because, “[w]hen marks would appear on virtually identical ... services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines.” See *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 USPQ2d 1698, 1799, (Fed. Cir. 1992). See also *ECI Division of E-Systems, Inc. v. Environmental Commc’ns. Inc.*, 207 USPQ 443, 449 (TTAB 1980).

For these reasons, we find that the marks are more similar than dissimilar. The first *DuPont* factor thus also weighs in favor of finding a likelihood of confusion.

D. Conditions of Sale

Under the fourth *DuPont* factor, we consider “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567.

Applicant argues, without evidentiary support, that “[t]he Prior Owner and Applicant deal in respective goods and services that can be extremely expensive. If the goods or services are relatively expensive, more care is taken and buyers are less likely to be confused as to source or affiliation.”⁶

However, the services identified in the involved application and cited registration are not restricted by trade channel or price point and will be available to all interested

⁶ 6 TTABVUE 9.

purchasers. While some purchasers may be discriminating and exercise care in their selection, others may not exercise as great a degree of care. The services at issue include entertainment services offered to all types of consumers, including ordinary consumers exercising an ordinary degree of care. Nothing about the identified services suggests that the consumers are particularly sophisticated or that the conditions of sale would mitigate any confusion that would otherwise be likely. The standard of care is that of the least sophisticated potential purchaser. *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1163 (*cited in In re FCA US LLC*, 126 USPQ2d at 1222 (“Board precedent requires our decision to be based on the least sophisticated potential purchasers.”)).

In the absence of any evidence relating to the degree of care purchasers exercise with regard to entertainment services, the similarity of the marks and identity in part of the services outweigh Applicant’s assertion that purchasers are sophisticated or careful in their purchases. *See HRL Assocs., Inc. v. Weiss Assocs., Inc.*, 12 USPQ2d 1819, 1823 (TTAB 1989), *aff’d*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decisions, and expensive goods). Moreover, were we to accord a level of sophistication to the purchasers of the services at issue, even sophisticated purchasers are not immune from source confusion. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (citing *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) (“Human memories even of discriminating purchasers...are not infallible.”)).

E. Actual Confusion

Finally, Applicant argues that there is no evidence of any actual confusion and that there has been concurrent use since January 2019. We do not accord any weight to Applicant's contention, unsupported by any evidence, that there have been no instances of actual confusion despite contemporaneous use of the respective marks.⁷ The Federal Circuit has addressed the question of the weight to be given to an assertion of no actual confusion by an applicant in an ex parte proceeding:

With regard to the seventh *DuPont* factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. *See In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that 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). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, [citation omitted], especially in an ex parte context.

Majestic Distilling, 65 USPQ2d at 1205.

Accordingly, while examples of actual confusion may point toward a finding of a likelihood of confusion, an absence of such evidence is not compelling in support of a finding of no likelihood of confusion, particularly in an ex parte proceeding in which the owner of the cited registration cannot appear. Thus, we cannot conclude from the lack of instances of actual confusion that confusion is not likely to occur.

The seventh *DuPont* factor is neutral.

⁷ We observe that the time period in question largely coincides with limitations imposed upon public gatherings, including musical concerts, resulting from the Covid-19 pandemic, further diminishing the opportunity for actual confusion.

F. Conclusion

When we consider the record and the relevant likelihood of confusion factors, and all of Applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that consumers familiar with Registrant's entertainment services offered under its mark THE HOOLIGANS would be likely to believe, upon encountering Applicant's BRUNO AND THE HOOLIGANS mark, that the in-part identical services originated with or are associated with or sponsored by the same entity.

Decision: The refusal to register Applicant's mark is affirmed under Section 2(d) of the Trademark Act.