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THE TTAB**

Mailed: January 29, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Musidor B.V.
v.
Peter Kaveh

Opposition No. 91168841
to Application No. 78493602
filed on

Louis J. Bovasso of Greenberg Traurig for Musidor B.V.

Ronald D. Jaman, Esq. for Peter Kaveh.

Before Walters, Grendel and Walsh, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Musidor B.V. filed its opposition to the application of
Peter Kaveh to register the standard character mark JAGGER
for "clothing, namely, suits, shirts, T-shirts, pants,
shorts, sweatshirts, jackets, skirts, dresses, tops,
sweaters, headwear, raincoats, underwear, pajamas, robes,
infant wear, swim wear, beach wear; accessories, namely,

gloves, mittens, scarves, belts; socks and footwear," in International Class 25.¹

As grounds for opposition, opposer asserts that it is the owner of all marks and registrations of the rock group, The Rolling Stones, and that applicant's mark, when applied to applicant's goods so resembles opposer's previously used, registered and famous mark MICK JAGGER² for, inter alia, video and sound recordings featuring music and performances³ as to be likely to cause confusion, under Section 2(d) of the Trademark Act.⁴

Applicant, in its answer, denied all of the allegations of the asserted claims.

¹ Application Serial No. 78493602, filed October 3, 2004, based upon use of the mark in commerce, alleging dates of first use and first use in commerce as of June 1, 2004.

² While opposer asserted in its pleading only the mark MICK JAGGER, opposer's evidence and brief pertain also to the use of JAGGER for clothing. Therefore, we consider the issue of likelihood of confusion with respect to the mark JAGGER for clothing to have been also tried.

³ Registration No. 2860464, issued July 6, 2004 based on an application filed May 10, 1999, for "phonograph records, pre-recorded audio and/or digital cassettes, tapes and/or disc, all featuring dramatic and non-dramatic performances of musical works, comedy, drama, action, adventure or animation; downloadable video recordings featuring music, comedy, drama, action, adventure or animation and downloadable musical sound recordings," in International Class 9 for the mark MICK JAGGER. The registration includes the statement that "the name in the mark identifies a living individual whose consent is of record."

⁴ Opposer also asserted that the proposed use of the mark by applicant violates Mr. Mick Jagger's right of publicity and would constitute a false designation of origin under Section 43(a) of the Trademark Act. Not only does the Board have no jurisdiction to consider a claim under Section 43(a), but opposer made no further reference to these allegations. We have given them no consideration.

The Record

The record consists of the pleadings; the file of the involved application; a certified status and title copy of Registration No. 2860464; and the testimony deposition by opposer of Norman Perry, co-CEO at Anthill Trading Limited LLC, a brand merchandiser of opposer and opposer's exclusive licensee for apparel, with accompanying exhibits. Applicant submitted no testimony or other evidence. Only opposer filed a brief on the case.

Factual Findings

Opposer owns the intellectual property rights of Mick Jagger and the musical group the Rolling Stones. (Perry Deposition, p. 11, "Perry at 11.") The Rolling Stones have been recording and performing more or less continuously since the 1960's. (Id. at 12.) Mick Jagger is the lead singer and one of the main songwriters of the Rolling Stones. (Id. at 14.) Mick Jagger is also a solo artist who records and performs under his own name.⁵ (Id. at 18.)

Opposer, through its licensee since 1989, Anthill Limited LLC, has an extensive worldwide merchandising program in connection with the Rolling Stones and Mick Jagger. This merchandising program relies heavily on

⁵ While opposer contends that MICK JAGGER is a famous mark and a famous individual, and that the Rolling Stones is a famous musical group, the record contains only the deponent Mr. Perry's opinion in this regard and this is not the type of fact of which the Board can take judicial notice. Therefore, we have no basis to find fame.

imagery connected with the Rolling Stones and the individual members of the group, and it is often centered on the recordings and concert tours of the group. This imagery includes images that evoke the band or its members, such as a drawing of a mouth with large lips and a tongue sticking out, actual likenesses and photographs of the band and its members, and marks, such as MICK JAGGER and JAGGER. (Id. at 25-26.)

Opposer has used since prior to the filing date and alleged first use date of the subject application, and continues to use, the marks MICK JAGGER and JAGGER in connection with various clothing items including, for example, t-shirts, shirts, sweatshirts, dresses and lingerie. In particular, opposer has used these marks in connection with many of the items listed in the opposed application. (Id. at 59.) Some of opposer's t-shirts are custom-made with expensive fabrics and sell for over \$100. (Id. at 45.) Opposer's merchandise is sold at concerts, on the Rolling Stones official website, in high-end boutiques and specialty stores, and by mass merchandisers such as Wal-Mart. (Id. at 57.)

Opposer's licensee, Anthill Limited LLC, represents approximately fifty entertainers and musical groups; and it is one of six or seven companies that handle merchandising

and brand awareness programs for about 95% of all popular entertainers. (Id. at 25.)

Applicant has no license from or other relationship to opposer. (Id. at 61.)

Analysis

Standing

Because opposer has properly made its pleaded registration of record, we find that opposer has established its standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Priority

Because opposer's pleaded registration is of record, Section 2(d) priority is not an issue in this case as to the mark and goods covered by said registration. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, opposer has established its use of the marks MICK JAGGER and JAGGER on various items of clothing, including many of the items listed in the opposed application. This use predates both the filing date of the subject application and the date of first use asserted in the application, although that date is not established herein. Thus, opposer has also established its priority

with respect to the marks MICK JAGGER and JAGGER for apparel.

Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). *See also In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The Goods

With respect to the goods of the parties, we observe that there is a substantial overlap in the clothing items

identified in the application and those upon which opposer has demonstrated it uses its marks. The evidence establishes that opposer markets and sells clothing items with decorations that reflect the names, themes and imagery connected with their recordings and performances. The record establishes that other entertainers and musical groups also have merchandising programs to promote their brands.

Thus, we conclude that the apparel items of the parties are either identical or closely related; and that the recordings identified in opposer's registration and the clothing items listed in the application are sufficiently related that confusion as to source is likely if the respective goods are identified by confusingly similar marks.

The Trade Channels and Purchasers

Both opposer's goods in its registration and applicant's identified goods are broadly worded, without any limitations as to channels of trade or classes of purchasers. Thus, we presume that applicant's clothing items travel through all the normal channels of trade for such goods, including the boutiques, specialty stores and mass merchandisers through which opposer sells its clothing items. In other words, with respect to the parties' apparel, the trade channels are overlapping.

We must presume that opposer's identified recordings are sold through all usual trade channels for such goods. While there is no evidence in the record regarding the trade channels for opposer's recordings, we find that there is likely to be an overlap in trade channels for applicant's clothing and opposer's recordings, e.g., mass merchandisers, at least. *See Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Clearly, the usual purchasers of both parties' apparel, as well as opposer's recordings, are the general consumer. Thus, the purchasers of the parties' goods are the same.

Marks

We turn, finally, to a determination of whether applicant's mark, JAGGER, and opposer's marks, MICK JAGGER and JAGGER, when viewed in their entirety, are similar in terms of appearance, sound, connotation and commercial impression. 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 impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB

1975). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Obviously, applicant's and opposer's JAGGER marks are identical in appearance and sound. There is nothing in the record to indicate that there would be any differences in connotation or commercial impression between these marks, especially because both marks identify clothing.

In the context of opposer's MICK JAGGER mark, JAGGER is a surname.⁶ Thus, while applicant's mark may be arbitrary when considered by itself, when compared to opposer's MICK JAGGER mark, it is likely to also have the connotation of a surname. Persons familiar with opposer's mark MICK JAGGER are likely to perceive of applicant's mark as a mere variation on, or shortening of, opposer's mark. As such, we consider the marks JAGGER and MICK JAGGER more similar than dissimilar.

⁶ To show that the surname JAGGER may be obscure, opposer sought to introduce Internet-obtained evidence through its deponent, who did not personally download such evidence. As such, the evidence has not been properly authenticated and we have not considered it. See *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998).

Conclusion

When we consider the record and the relevant likelihood of confusion factors, we conclude that in view of the identity of the parties' JAGGER marks and the substantial similarity in the commercial impressions of applicant's mark, JAGGER, and opposer's mark, MICK JAGGER, their contemporaneous use on the identical and closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Decision: The opposition is sustained.