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Mailed:
November 8, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Carr

v.

Garnes

Opposition No. 91171220 to application Serial No.
78613202 filed on April 20, 2005

Alan S. Clarke of Law Office of Alan S. Clarke, LLC for
Reginald Carr.

Edward M. Garnes, Jr. (pro se).

Before Quinn, Zervas and Bergsman, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Applicant, Edward M. Garnes, Jr., seeks
registration on the Principal Register of the mark FROM
AFROS TO SHELLTOES ART, ACTION, AND CONVERSATION (in
standard character form) for the following services, as
amended: "Educational services, namely, conducting
workshops and seminars in arts and entertainment, hip-
hop, cross generational relationships, community

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building, and art as a political force to lessen misunderstandings between civil rights and hip hop generations" in International Class 41. Applicant claims first use and first use in commerce on April 23, 2004, and acquired distinctiveness of the entire mark under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).¹

Opposer Reginald Carr filed a timely notice of opposition to registration of applicant's mark, pleading use of the mark AFROS-N-SHELLTOES ENTERTAINMENT for opposer's "entertainment business" since 2002. At paragraph 3 of the complaint, opposer describes his business services as "entertainment industry consulting, party promotion, disc jockey services, entertainment services, party promotion and poetry readings, primarily for the African American community." Opposer alleges (a) priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); (b) false suggestion of a connection with opposer's identity under Section 2(a) of the Trademark Act, 15 U.S.C.

¹ A claim of acquired distinctiveness is made when a mark is not inherently distinctive. Applicant's entire showing in support of his claim of acquired distinctiveness, submitted with his original application, comprised two flyers (plausibly for the same event) and a copy of applicant's Georgia state registration certificate. The trademark examining attorney did not issue any Office actions in this

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§ 1052(a), and (c) no bona fide use of the mark in commerce prior to the filing of the application under Section 1(a) of the Trademark Act, 15 U.S.C.

§ 1051(a).²

Applicant answered the notice of opposition by denying the salient allegations thereof, but admitted "there is confusing similarity between the Defendant's Georgia state registered mark and the mark of Plaintiff."³ Answer ¶ 43.⁴

The Record

The record consists of the pleadings; the file of the involved application, including the evidence in support of applicant's claim of acquired distinctiveness set forth in the application; and the

case, and did not question applicant's reliance on Section 2(f).

² Opposer also pleaded fraud based on applicant's submission of a specimen which incorrectly identifies the date of one of applicant's programs. Because opposer has not discussed his claim of fraud in his brief, opposer has waived his fraud claim and we do not give it any further consideration.

³ The Georgia state registered mark is "From Afros to Shelltoes: Art, Action, and Conversation" for "Educational, dialogues, workshops, trainings, mediations, and panels on arts & entertainment, hip-hop, cross generational relationships, community building, and art as political force to lessen misunderstandings between Civil Rights and Hip Hop Generations." Ex. 11 to testimony deposition of Reginald Carr.

⁴ Under the heading "General Allegations and Affirmative Defenses," applicant set forth factual recitations detailing his alleged use of his mark, including characterizing opposer's use of opposer's mark as a "confusingly similar mark" to applicant's mark. "General Allegations" ¶ 29(vi). Factual allegations made in a pleading must be proven at trial to be considered part of the trial record.

trial testimony of opposer. Applicant did not introduce any evidence at trial, and did not file a brief.

Standing

Because opposer's claimed first use date precedes the filing date of applicant's application, and opposer has testified as to the first and continued use of AFROS-N-SHELLTOES ENTERTAINMENT, which contains terms also appearing in applicant's mark, opposer has proved his standing to maintain this proceeding. Section 2(d); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999) (an opposer must have "a 'real interest' in the outcome of a proceeding in order to have standing."); and *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) ("To establish a reasonable basis for a belief that one is damaged ... a petition may assert a likelihood of confusion which is not wholly without merit.")

Priority of Use

The question of priority of use is an issue in this case because opposer does not own an existing trademark registration upon which he can rely under Section 2(d). Cf., *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA

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1974). To establish his priority under Section 2(d), opposer must prove that, vis-à-vis applicant, he owns "a mark or trade name previously used in the United States ... and not abandoned..."

Opposer has testified that he "began" AFROS-N-SHELLTOES ENTERTAINMENT in 2002 as an independent artist services company doing "DJ and promotions" with "[r]appers, singers, poets, [and] managers at times that want to promote their acts and groups," primarily to the African American community, and that he has used AFROS-N-SHELLTOES ENTERTAINMENT without interruption since 2002. Dep. at 8-9. As documentary evidence, opposer submitted, inter alia, (a) a promotional brochure which opposer testified he used in the 2002 to 2003 time frame, dep. at 10, and which states in relevant part:

Afros-n-Shelltoes [E]ntertainment[,] A Consignment Distribution Company.⁵ Afros-n-Shelltoes serves as a Mediator between our valued Artists, Producers, Writers and Retailers[.]

* * *

Afros and Shelltoes understands the difficulties in beginning a career in the music industry. In the world we live in today, what you know is valuable, but who you know will open doors for opportunity. Building relationships is critical to success. Afros and Shelltoes works as a network between local independent music

⁵ Opposer clarified that he distributed CDs and tapes on consignment.

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stores, producers, writers, and DJ's [sic]. We work with local music retailers, affectionately known as mom and pop's stores, so your music can be heard. The value will be developing relationships with an audience that enjoys listening to your music."

(b) a domain registration for afros-n-shelltoes.biz registered on September 29, 2003, which he "run[s]" presently,⁶ dep. at 14 - 16; and (c) a business card with opposer's mark identifying "General Consultation, Music Licensing, Copyright Registration and Band Agreements" as opposer's services. Additionally, opposer testified that he promoted his business "afros-n-shelltoes" on the radio in the 2003 - 2004 timeframe. Dep. at 18.

The earliest date on which applicant can rely is the filing date of his application, which is April 20, 2005. See *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 156 n. 5 (TTAB 1985) ("The earliest date of first use upon which Intelsat can rely in the absence of testimony or evidence is the filing date of its application").

Because opposer has established that he began using, and has continuously used, his mark in commerce from a time earlier than the filing date of applicant's

⁶ The registration of the domain name corroborates opposer's statements regarding use of the mark.

application, opposer has established his priority for the services for which opposer has alleged and demonstrated he has used his mark, namely, "disc jockey services and artist management and promotion services, including the representation of rappers, singers and poets, as well as the representation of managers who want to promote their acts and groups."⁷

Likelihood of Confusion

We now consider the first claim raised by opposer, his claim of likelihood of confusion. Our determination under Section 2(d) is based on an analysis of all of the 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 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the [services] and differences in the marks." *Federated Foods, Inc. v.*

⁷ At p. 6 of his brief, opposer characterizes his business as "an 'independent artist services company' ... for which he does 'DJ and promotions' for 'rappers, singers, poets, managers at times that want to promote their acts and groups.'"

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Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

At the outset, we note that, as indicated above, in Paragraph No. 43 of his answer, applicant admitted that the marks at issue are confusingly similar.

We first turn to the *du Pont* factor regarding the similarities of the marks in our likelihood of confusion analysis, considering whether the marks in their entireties are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). 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 that confusion as to the source of the 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 *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

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In articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing wrong in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on a consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751. For instance, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark" *Id.*

Applicant's mark is FROM AFROS TO SHELLTOES ART, ACTION, AND CONVERSATION. Applicant, in his original application, claimed acquired distinctiveness in the mark as a whole. A claim of distinctiveness, whether made in the application as filed or in a subsequent amendment, may be construed as conceding that the matter to which it pertains is not inherently distinctive and, thus, not registrable on the Principal Register absent proof of acquired distinctiveness. *See, e.g., Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988); *In re Cabot Corp.*, 15 USPQ2d 1224 (TTAB 1990); and *In re Professional Learning Centers, Inc.*, 230 USPQ 70 (TTAB

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1986). See also TMEP § 1212.02(b). It is not clear to us why applicant claimed acquired distinctiveness in the FROM AFROS TO SHELLTOES portion of his mark and why the showing applicant made with his initial application persuaded the examining attorney that applicant had established acquired distinctiveness in the remaining terms of the mark, i.e., ART, ACTION, AND CONVERSATION. Applicant's showing only comprised three items, i.e., (a) a flyer for an April 11, 2005 lecture in the multipurpose room of the university union at an undisclosed university, (b) another flyer for an April 11, 2005 lecture during Hip Hop Week at an undisclosed institution's Union Multipurpose Room,⁸ and (c) a copy of a Georgia state trademark registration for applicant's mark. This type of evidence does not establish acquired distinctiveness for even the least merely descriptive mark.

ART, ACTION AND CONVERSATION refers to a feature of applicant's educational services; we therefore accord this portion of applicant's mark less weight in our consideration of the marks. Applicant's flyer states, "This program is an engaging mix of edutainment [sic], poetry and open forums that aims to build fruitful cross-generational relationships [to]

⁸ Presumably, these are flyers for the same event.

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cultivate future leaders and use the Black aesthetic as a political force"; and his specimen of use states, "During this solution oriented workshop participants will learn to build fruitful cross-generational relationships and recognize community building and art as political forces." We therefore find FROM AFROS TO SHELLTOES is the dominant element in applicant's mark. ENTERTAINMENT in opposer's AFROS-N-SHELLTOES ENTERTAINMENT mark is generic for opposer's entertainment-related services, with AFROS-N-SHELLTOES as the dominant portion. AFROS-N-SHELLTOES and FROM AFROS TO SHELLTOES are highly similar in meaning, sound, connotation and appearance. The differences in wording in the marks does not alter the overall meaning and commercial impression of the marks. We therefore find, when considering the marks as a whole, that they are similar and resolve the *du Pont* factor regarding the similarity of the marks in opposer's favor.

Next, we consider the similarity of the services. We consider only those services for which opposer has established priority and for which he has been and is continuously using his mark (and which are closest to applicant's services), namely, artist management and promotion services, including the representation of rappers, singers and poets, as well as the

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representation of managers who want to promote their acts and groups, and the services identified in applicant's application, i.e., "educational services, namely, conducting workshops and seminars in arts and entertainment, hip-hop, cross generational relationships, community building, and art as a political force to lessen misunderstandings between civil rights and hip hop generations."

The parties' services need not be identical or even competitive to support a finding of likelihood of confusion. Rather, it is enough that the services are related in some manner or the 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 thereon, 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 each parties' services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

We find that the potential purchasers of opposer's and applicant's respective services overlap. Specifically, the same rappers and singers who participate in applicant's lecture workshops and seminars in order to define any message in their works

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tending to lessen misunderstandings between civil rights and hip hop generations, are likely to take advantage of opposer's artist management and promotion services in commercializing their art.

With regard to the marketing of the services, the record reflects that both parties have advertised, or at least attempted to advertise, in the same newspaper, namely, *Creative Loafing*, "a local publication ... in Atlanta that pretty much caters to independent circuit artists. Art. Music." Dep. at 29. (When opposer sought to advertise in *Creative Loafing*, applicant sent a cease and desist letter to opposer with a copy to *Creative Loafing*, and *Creative Loafing* refused to run opposer's advertisement.) Further, opposer testified that he advertised his services on the radio, i.e., "multi-ethnic [radio] ... it's different, depending on what time. And I specifically focused on the hip-hop, African American aspect." Dep. at 18. Applicant's workshops and seminars would also likely be advertised on the radio, and even during the same radio programs. Additionally, opposer testified that he distributed flyers and business cards, and that he distributed questionnaires to independent record store owners and managers. Dep. at 9 and 11. Independent record stores, where new musicians or musical groups would

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likely place their works for sale to the general public, would also be a place where applicant would leave his flyers, such as the flyers accompanying applicant's original application. Thus, we find the services are marketed in a similar manner.

Because both parties' services are directed to the same purchasers and are marketed in a manner that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used thereon, 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 each parties' services, we find that the services are related to one another. Our finding is supported by applicant's attorney's statement, in his April 4, 2005 cease and desist letter sent to opposer, that opposer's "advertisements incorporate similar services and references which are intended to foster an association with Afros-N-Shelltoes and/or which would be confusingly similar." Dep. ex. 6.

Thus, the *du Pont* factors regarding the similarity of the purchasers, trade channels and services are all resolved in opposer's favor.

The next *du Pont* factor we consider is the number and nature of similar marks in use on similar goods.

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Because there is no evidence of third-party use of any mark containing the terms AFROS or SHELLTOES, this factor is neutral, and insofar as it shows the strength of opposer's mark, it favors opposer.

The Board has recognized that we may consider bad faith in the likelihood-of-confusion analysis under the thirteenth *du Pont* factor. *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2008). In this regard, the record reflects that in May 2004, opposer met with Marvin Arrington, Jr., a private practice attorney in Georgia, to review his artist contracts. Opposer provided Mr. Arrington with his business card containing AFROS-N-SHELLTOES ENTERTAINMENT, and various documents bearing "Afros-N-Shelltoes Entertainment." A letter from Mr. Arrington dated May 11, 2005 addressed to opposer's attorney acknowledges that opposer "did indeed come to see me about the possibility of incorporating a company Afros-N-Shelltoes, Inc." Dep. ex. 14. Mr. Arrington's May 11, 2005 letter follows Mr. Arrington's April 4, 2005 cease and desist letter addressed to opposer, asserting, inter alia, trademark infringement and demanding that he cease using AFROS-N-SHELLTOES.

Mr. Arrington is the sole organizer and registered agent of Babuke Brothers, LLC ("Babuke"). Ex. 8 to

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dep., i.e., Articles of Organization (in Georgia), dated August 8, 2001, for Babuke. Babuke registered the domain name afrostoshelltoes.com on December 13, 2004, seven months after Mr. Arrington met opposer.⁹ Two months after Babuke registered the domain name, on February 15, 2005, applicant registered the service mark FROM AFROS TO SHELLTOES ART, ACTION, AND CONVERSATION in Georgia. Dep. exs. 10 and 11. On April 20, 2005, applicant filed for federal registration of his mark.

Significantly, applicant has admitted that he is a co-owner of Babuke. Answer, ¶ 18.

We have not heard from applicant regarding these facts, but note that Mr. Arrington's May 11, 2005 letter acknowledges that opposer visited his office and states that he "did not share any information with Mr. Garnes and that Mr. Garnes approached me with the mark independent of any actions by your client." This general denial does not persuade us that Mr. Arrington did not communicate with applicant regarding opposer's mark, especially when (a) opposer consulted with Mr. Arrington regarding his trademark, and seven months later, Babuke - jointly owned by applicant and Mr.

⁹ Applicant admitted that he "process[ed the] Domain name." Answer, ¶ 17.

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Arrington - registered a very similar domain name to opposer's mark, (b) both marks contain the unusual term "shelltoes," an undefined term, juxtaposed after the "Afros," and (c) both parties are located in Georgia, dep. at 57, advertising in the same Atlanta newspaper (suggesting knowledge of one another prior to the exchange of cease and desist letters). Applicant could have participated at trial and proffered an explanation as to how he came to adopt his mark under these circumstances, but evidently choose not to. We therefore conclude that applicant filed his application for services related to those of opposer with the full knowledge of opposer's prior mark with the intention to trade off of opposer's goodwill in his mark, and find that applicant acted in bad faith in adopting his mark and prosecuting his application. "Such bad faith is strong evidence that confusion is likely, as such an inference is drawn from the imitator's expectation of confusion." *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1891 (TTAB 2008).

Conclusion

After considering all competent evidence bearing on the relevant *du Pont* factors, we conclude that there is a likelihood of confusion between opposer's mark when used in connection with "artist management and

promotion services, including the representation of rappers, singers and poets, as well as the representation of managers who want to promote their acts and groups," and applicant's mark when used in connection with "educational services, namely, conducting workshops and seminars in arts and entertainment, hip-hop, cross generational relationships, community building, and art as a political force to lessen misunderstandings between civil rights and hip hop generations." Our conclusion is based, in particular, on the similarity of the marks and services, the identical trade channels and purchasers, and the fact that applicant has acted in bad faith.

False Suggestion of a Connection

"[I]n inter partes proceedings before the Board, an essential element of a Section 2(a) claim of false suggestion of a connection is that the defendant's mark must point uniquely and unmistakably to the identity or persona of the 'person' or 'institution' asserting the claim. If the defendant's mark does not point uniquely and unmistakably to the plaintiff's identity or persona, then there can be no false suggestion of a connection." *Internet Inc. v. Corporation for National Research Initiatives*, 38

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USPQ2d 1435, 1436 (TTAB 1996). In this case, opposer has failed to allege or demonstrate at trial that AFROS-N-SHELLTOES ENTERTAINMENT is "uniquely and unmistakably" his identity or persona. Opposer's claim of false suggestion of a connection is therefore denied.

No Bona Fide Use Prior to Filing

Opposer relies on a typographical error in the date of applicant's specimen of use filed with his original application in arguing that applicant had no bona fide use of his mark in commerce prior to the filing date of his application. Specifically, he argues that the January 15, 2004 event noted on the specimen of use (a flyer) actually occurred on January 15, 2005. However, applicant filed his application on April 11, 2005, after the actual date of the event. Opposer has not demonstrated by this evidence, or any other evidence, that applicant had not made actual bona fide use of his mark prior to the filing date of his application. Thus, opposer's claim of no bona fide use prior to the filing of the application is denied.

DECISION: The opposition is sustained on the ground of likelihood of confusion and registration to applicant is refused. Opposer's claims of false

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suggestion of a connection and no bona fide use are denied.