

ESTTA Tracking number: **ESTTA292990**

Filing date: **07/01/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91182396
Party	Plaintiff Bose Corporation
Correspondence Address	Amy Brosius Fish & Richardson PC 225 Franklin Street Boston, MA 02110 UNITED STATES brosius@fr.com
Submission	Brief on Merits for Plaintiff
Filer's Name	Amy Brosius
Filer's e-mail	brosius@fr.com, lanno@fr.com
Signature	/amy brosius/
Date	07/01/2009
Attachments	Bose Main Brief.pdf (25 pages)(91499 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 77/158,037
For the Mark FULL WAVE AUDIO
Published in the Official Gazette on October 16, 2007

Bose Corporation,

Opposer,

v.

PWC Industries Inc.,

Applicant.

Opposition No. 91182396

BRIEF OF OPPOSER

Charles Hieken
Amy L. Brosius
FISH & RICHARDSON P.C.
225 Franklin Street
Boston, MA 02110
Tele. (617) 542-5070
Fax: (617) 421-698

Attorneys for Opposer,
BOSE CORPORATION

TABLE OF CONTENTS

	<u>Page No.</u>
STATEMENT OF THE FACTS	1
ARGUMENT	12
I. “FULL WAVE AUDIO” WITHOUT CHANNEL RESTRICTIONS FOR MARINE WATERPROOF AUDIO AMPLIFIER, AND WATERPROOF STEREO SPEAKERS IS SUFFICIENTLY SIMILAR IN APPEARANCE, CONNOTATION, AND SOUND TO THE FAMOUS “WAVE” AND “ACOUSTIC WAVE” MARKS PREVIOUSLY USED AND REGISTERED BY BOSE WITHOUT CHANNEL RESTRICTIONS FOR RADIOS, CLOCK RADIOS, COMPACT STEREO SYSTEMS AND PORTABLE COMPACT DISC PLAYERS; LOUDSPEAKER SYSTEMS; MUSIC SYSTEMS CONSISTING OF A LOUDSPEAKER SYSTEM AND AMPLIFIER AND AT LEAST ONE OF A RADIO TUNER, COMPACT DISC PLAYER AND DIGITAL MUSIC PLAYER; COMPACT DISC CHANGER; DIGITAL MUSIC PLAYER DOCKING STATION, THAT CONFUSION, DECEPTION, OR MISTAKE IS LIKELY	12
A. THE BOSE “WAVE” AND “ACOUSTIC WAVE” MARKS ARE FAMOUS AND THEREFORE ENTITLED TO A WIDE SCOPE OF PROTECTION.....	12
B. “FULL WAVE AUDIO” IS CONFUSINGLY SIMILAR TO THE FAMOUS BOSE “WAVE” AND ACOUSTIC WAVE MARKS	15
C. THE PRODUCTS IDENTIFIED IN THE “FULL WAVE AUDIO” APPLICATION ARE IDENTICAL AND/OR HIGHLY SIMILAR TO THE BOSE “WAVE” AND “ACOUSTIC WAVE” PRODUCTS SUCH THAT CONSUMERS ARE LIKELY TO BE CONFUSED, DECEIVED, OR MISTAKEN IN BELIEVING THAT THE “FULL WAVE AUDIO” PRODUCTS ARE AFFILIATED WITH BOSE.....	18
D. THE CHANNELS OF TRADE AND CLASSES OF PURCHASERS FOR THE “FULL WAVE AUDIO” PRODUCTS AND THE “WAVE” AND “ACOUSTIC WAVE” PRODUCTS ARE UNRESTRICTED	21

II. DOUBTS AS TO LIKELIHOOD OF CONFUSION ARE RESOLVED
AGAINST THE NEWCOMER22

CONCLUSION23

TABLE OF AUTHORITIES

<u>Cases</u>	<u>Page No.</u>
<i>Bose Corp. v. QSC Audio Prods., Inc.</i> , 63 USPQ2d 1303, 1305, 1306, 1310, 1311 (Fed. Cir. 2000).....	1, 2, 14, 17, 18, 20, 21
<i>Canadian Imperial Bank v. Wells Fargo Bank</i> , 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).....	22
<i>Carlisle Chem. Works, Inc. v. Hardmann & Holden, Inc.</i> , 168 USPQ 110, 112 (CCPA 1970)	22
<i>CBS, Inc. v. Morrow</i> , 218 USPQ 198, 199 n.3 (Fed. Cir. 1983)	21, 22
<i>CTS Corp. v. Cronstoms Mfg., Inc.</i> 185 USPQ 773, 774 (CCPA 1975)	21
<i>Dan Robbins & Assoc., Inc. v. Questor Corp.</i> , 202 USPQ 100, 104 (CCPA 1979).....	20
<i>Earth Tech. Corp. v. Env'tl. Research & Tech., Inc.</i> , 222 USPQ 585 (C.D. Cal. 1983)	16
<i>Flow Tech., Inc. v. Picciano</i> , 18 USPQ2d 1970 (TTAB 1991)	15
<i>Glamorene Prods. Corp. v. Procter & Gamble Co.</i> , 190 USPQ 543 (CCPA 1976)	6, 22
<i>In re Amtel, Inc.</i> , 189 USPQ 58 (TTAB 1975).....	20
<i>In re Dixie Rests. Inc.</i> , 41 USPQ2d, 1533-34 (Fed. Cir. 1997).....	15-16
<i>In re E.I. DuPont de Nemours & Co.</i> , 177 USPQ 563 (CCPA 1973)	1
<i>In re Jeep Corp.</i> , 222 USPQ 333, 337 (TTAB 1984).....	20
<i>In re Melville Corp.</i> , 18 USPQ2d 1388, 1388 (TTAB 1991)	21-22
<i>In re Nat'l Data Corp.</i> , 224 USPQ 749, 752 (Fed. Cir. 1985).....	16
<i>In re Rexel Inc.</i> , 223 USPQ 830, 831 (TTAB 1984).....	11, 16
<i>J&J Snack Foods Corp. v. McDonald's Corp.</i> , 18 USPQ2d 1889, 1892 (Fed. Cir. 1991).....	22
<i>Kangol Ltd. v. KangaROOS U.S.A. Inc.</i> , 23 USPQ2d 1945 (Fed. Cir. 1992)	22

<i>Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.</i> , 22 USPQ2d 1453, 1456 (Fed. Cir. 1992)	2, 14-15, 19, 22-23
<i>Kimberley-Clark Corp. v. H. Douglas Enters., Ltd.</i> , 227 USPQ 541, 543 (Fed. Cir. 1985)	22
<i>King Candy Co. v. Eunice King’s Kitchen, Inc.</i> , 182 USPQ 108 (CCPA 1974)	15
<i>Nina Ricci, S.A.R.L. v. ETF Enters., Inc.</i> , 12 USPQ2d 1901, 1903 (Fed. Cir. 1989)	23
<i>Octocom Sys., Inc. v. Houston Computer Servs., Inc.</i> , 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)	18
<i>Planters Nut & Chocolate Co. v. Crown Nut Co., Inc.</i> , 134 USPQ 504, 508 (CCPA 1962)	23
<i>Recot, Inc. v. M.C. Becton</i> , 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)	1-2, 13-14, 18
<i>Saab-Scania Aktiebolag v. Sparkomatic Corp.</i> , 26 USPQ2d 1709 (TTAB 1993)	20
<i>Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.</i> , 223 USPQ 1281 (Fed. Cir. 1984)	22
<i>Squirtco v. Tomy Corp.</i> , 216 USPQ 937, 940 (Fed. Cir. 1983)	18
<i>Standard Oil Co. v. Standard Oil Co.</i> , 116 USPQ 176, 182 (10 th Cir. 1958)	17
<i>Sterling Drug Inc. v. Sebring</i> , 185 USPQ 649 (CCPA 1975)	20
<i>Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.</i> , 209 USPQ 986, 988 (CCPA 1981)	18
<u>Other Authorities</u>	
J. Thomas McCarthy, <i>McCarthy on Trademarks and Unfair Competition</i> § 23.29 (4 th ed. 2007)	12, 17
TMEP §1207.01(b)(viii), (c)(ii)	16

STATEMENT OF THE FACTS

On February 12, 2008 Opposer Bose Corporation (“Bose”) filed a Notice of Opposition against Application Serial No. 77/158,037, filed April 16, 2007, by Applicant, PWC Industries, Inc. (“PWC”) seeking registration of FULL WAVE AUDIO for “Marine waterproof audio amplifier, and waterproof stereo speakers” in International Class 9. The Board instituted this proceeding on April 10, 2007.

Bose alleged prior use of the marks WAVE and ACOUSTIC WAVE on one or more of radios, clock radios, audio tape recorders and players, portable radio and cassette recorder combinations, compact stereo systems and portable compact disc players; loudspeaker systems and music systems consisting of a loudspeaker system and amplifier and at least one of a radio tuner, compact disc player and audio tape cassette player; loudspeaker systems; and music systems consisting of a loudspeaker system and amplifier and at least one of a radio tuner, compact disc player and digital music player; compact disc changer; digital music player docking station.

Bose is the owner of the following incontestable registrations: Registration No. 1,633,789, issued on February 5, 1991, of WAVE for radios, clock radios, compact stereo systems and portable compact disc players¹; Registration No. 1,338,571, issued on May 28, 1985, of ACOUSTIC WAVE for loudspeaker systems; and Registration No. 1,764,183, issued April 13, 1993, of ACOUSTIC WAVE for loudspeaker systems and music systems consisting of a loudspeaker system and amplifier and at least one of a radio tuner, compact disc player and audio tape cassette; and is also the owner of Registration No. 3,457,854, issued on July 1, 2008

¹ Bose filed a Sec. 7 request to amend this registration deleting “audio tape recorders and players, portable radio and cassette recorder combinations” from the identification of goods in Reg. No. 1,633,789 on January 3, 2008, which was later approved.

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 6

Attorney's Docket No.: 02103-0925PP1

for music systems consisting of a loudspeaker system and amplifier and at least one of a radio tuner, compact disc player and digital music player; compact disc changer; digital music player docking station. Bose Notice of Opposition, p.2, Ex. A², Bose Notice of Reliance, p. 1, Ex. 1³.

On January 8, 2009, Bose took testimony through David Snelling with Exhibits BX1-24 deemed to have been offered into evidence within the provisions of 37 C.F.R. § 2.123(c)(2). DS1-78; BX1-24.⁴ PWC participated in this deposition and conducted cross examination of the witness.

Mr. Snelling is a Senior New Product Manager at Bose Corporation, responsible for long-range planning and product development for the WAVE category of products. DS5-7. Mr. Snelling received a Bachelors Degree from the University of Rochester and a graduate degree from Babson College. DS5. Prior to his position as Senior New Product Manager for WAVE products, Mr. Snelling was a New Product Manager for Bose. DS6. Prior to that, Mr. Snelling was a Product Manager for Bose. *Id.* Mr. Snelling testified that as Senior New Product Manager, his responsibilities include developing new concepts for existing products, new product development, and product cycle management, and is familiar with marketing strategy, marketing expenditures and sales information for the WAVE products. DS6-8.

Mr. Snelling testified that he is familiar with the Bose WAVE family of products, which include three major product categories: the ACOUSTIC WAVE music system, the WAVE music

² The Bose Notice of Opposition, filed February 12, 2008, included as Exhibit A status and title copies from the USPTO TARR website of Bose's pleaded registrations, dated February 12, 2008.

³ The Bose Notice of Reliance, filed January 15, 2009, included as Exhibit 1 a status and title copy from the USPTO TARR website of Bose's pleaded application 77/330,052 (now Reg. No. 3,457,854) for WAVE, dated January 15, 2009.

⁴ We refer to David Snelling's testimony on behalf of Bose as DS. We refer to Bose exhibits by BX.

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 7

Attorney's Docket No.: 02103-0925PP1

system, and the WAVE radio II. DS7. Mr. Snelling identified the ACOUSTIC WAVE music system as the company's largest and best performing WAVE product. DS8, 11. Mr. Snelling identified the ACOUSTIC WAVE music system as a "plug-and-play" music solution (DS 8) comprised of an enclosure housing an AM/FM radio tuner, a CD player, speakers, and various auxiliary source playback connectors, and identified an ACOUSTIC WAVE system user guide. DS 8-9, 11; BX3. Mr. Snelling also testified that the ACOUSTIC WAVE is sold in connection with accessories such as a 5-disc CD changer, an iPod® connect kit, a battery, a remote control, and AC and DC power adaptors. DS9-10. Mr. Snelling described the ACOUSTIC WAVE as a "transportable music system" that can be used outside the home. DS 10. Mr. Snelling identified product material for the ACOUSTIC WAVE that touts the portability of the ACOUSTIC WAVE while promoting the functionality of the ACOUSTIC WAVE system DC power cord that enables the ACOUSTIC WAVE to be powered from an industry standard 12-volt plug, common in a "car, RV or boat." DS10, BX2. Mr. Snelling also testified that Bose sells loudspeakers, the Bose 131 model, which are specifically designed to be used in boats. DS58; BX22, 24. Mr. Snelling further testified that the Bose 131 speakers undergo rigorous environmental testing for conditions that may be encountered on boats. DS61; BX23.

Mr. Snelling testified that the ACOUSTIC WAVE music system was first introduced in 1984, and has gone through a number of series changes since that time, including adding a CD player, remote control, and various technological improvements. DS11-12. Mr. Snelling testified that in his position as Senior New Product Manager in the WAVE category he has reviewed historical sales data for the ACOUSTIC WAVE product. DS14. Mr. Snelling testified

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 8

Attorney's Docket No.: 02103-0925PP1

that annual sales of ACOUSTIC WAVE products have been approximately 45,000 units, generating approximately \$50 million dollars in annual sales revenue. DS14-17.

Mr. Snelling testified that the ACOUSTIC WAVE music system is targeted to a very broad consumer base, equally split between males and females, comprising a wide age demographic. DS18-19. The ACOUSTIC WAVE music system is sold through three major direct sales channels: the Bose call center, Bose retail direct stores, and the Bose.com website. DS20. In addition, Mr. Snelling testified that the ACOUSTIC WAVE system is made available to customers through television shopping networks, such as QVC, military store outlets, through premium and incentives providers, such as Innovative Concepts, and through consumer rewards programs, such as AMEX rewards. DS20-21, BX5.

Mr. Snelling testified that the Bose ACOUSTIC WAVE music system is advertised in many different venues, primarily print advertising, such as magazines and newspapers, consumer inserts, such as AMEX billing statement inserts, direct mail, online banner advertising, email advertising, and national broadcast media such as television and radio. DS32-35; 39-40. Mr. Snelling identified numerous examples of advertising for the ACOUSTIC WAVE music system, including in such major "volume-driver" national publications as USA Today Weekend Edition and Parade Magazine. DS 36-38; BX9-11. Mr. Snelling testified that the marketing expenditures to promote and advertise the ACOUSTIC WAVE music system have been on average \$10 million annually. DS17.

Mr. Snelling testified that the ACOUSTIC WAVE music system has been profiled in numerous press articles including in such publications as the Boston Herald, the Chicago Tribune, High Fidelity, the Atlantic, Popular Science, Stereo Guide, the Philadelphia Enquirer,

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 9

Attorney's Docket No.: 02103-0925PP1

CNN.com, the Denver Post, the Wall Street Journal, and New York Magazine and identified a series of press articles dating back to 1984. DS27-32; BX8. Mr. Snelling also identified a number of press releases profiling the ACOUSTIC WAVE music system, as well as a brochure describing Dr. Bose and Dr. Short receiving the Inventor of the Year Award from Intellectual Property Owners, Inc. for the waveguide loudspeaker technology embodied in the Bose ACOUSTIC WAVE music systems and the WAVE radio in 1987. DS23-26; BX6-7.

Mr. Snelling testified that the ACOUSTIC WAVE mark appears on the ACOUSTIC WAVE music system product, as well as on the remote control for the product, and the product packaging. DS13.

Mr. Snelling testified that he is familiar with the Bose WAVE products, including the current products the WAVE music system and WAVE radio II. DS41. Mr. Snelling testified that the Bose WAVE radio was first introduced in 1993 and that the product went through numerous enhancements including the addition of a CD player in 1999, a major revision in 2004 which resulted in the WAVE music system, and a multi-CD changer accessory launched in 2006. DS43. Mr. Snelling testified that the WAVE music system comprises an enclosure that includes an AM/FM tuner, a CD player, an alarm clock, as well as auxiliary inputs along the lines of the ACOUSTIC WAVE music system. DS41-42. The WAVE music system also comes with a power cord and remote control. DS42. Mr. Snelling testified that the WAVE radio II was introduced shortly after the WAVE music system in 1999, and is in essence the same product as the WAVE music system, but without a CD player. DS42-43.

Mr. Snelling testified that approximately 600,000 WAVE music system and WAVE radio II products (hereinafter, collectively, the "WAVE products") have been sold annually since

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 10

Attorney's Docket No.: 02103-0925PP1

inception, generating between \$250 and \$280 million in revenue annually. DS46. Mr. Snelling testified that there is not a tremendous difference in the target consumers for the WAVE products as for the ACOUSTIC WAVE music system and is a similarly wide audience. DS47-48. He testified that the WAVE products are sold in exactly the same channels of trade as the ACOUSTIC WAVE music system, namely, Bose call centers, the Bose retail direct stores, the Bose.com website, as well as home shopping sellers, military outlets, and premium and incentive sellers. DS 49.

Mr. Snelling testified that the WAVE products are advertised in the same manner as the ACOUSTIC WAVE music system, namely, on the Bose.com website, via print advertisements in major national publications such as Parade Magazine, and through direct mail, including in third party billing inserts. DS50-51, 53. Mr. Snelling identified numerous examples of such advertising for the WAVE products. *Id.*; BX14-17. Mr. Snelling also testified that the WAVE products have been advertised on television, and identified materials related to such advertisements. DS55-56; BX19. Mr. Snelling also identified numerous Bose catalogs promoting the WAVE products, which he said are sent out proactively, or to consumers who contact Bose and want more information on the WAVE products. DS54; BX18.

Mr. Snelling testified that there has been regular press coverage of the WAVE products and identified numerous press releases and examples of press mentions related to the WAVE products in major national publications.⁵ DS56-58; BX20-21.

Mr. Snelling testified that Bose has spent approximately \$40 million annually advertising the WAVE music system. DS46-47.

⁵ Counsel for PWC stipulated to the entry of all of the Bose exhibits introduced during the deposition of Mr. Snelling. DS30-31.

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 11

Attorney's Docket No.: 02103-0925PP1

PWC took the testimonial deposition of Mr. Todd Bootes, Vice president and R&D Director of PWC, on March 2, 2009.⁶

During his deposition, Mr. Bootes testified that the FULL WAVE AUDIO product is a combined stereo amplifier and loudspeaker system through which one can play an iPod® or other MP3 storage device, and which is designed to be used in marine environment, such as on boats or personal watercraft such as jetskis. TB4-6; 12-13, 17. Mr. Bootes testified that that the FULL WAVE AUDIO product is powered from a 12-volt power source. TB26. Mr. Bootes testified that he selected the FULL WAVE AUDIO name to signify the waterproof nature of the product. TB5-6. Mr. Bootes testified that the FULL WAVE AUDIO mark has been used since approximately February 2007. TB7-8.

⁶ We refer to Todd Bootes's testimony on behalf of PWC as TB. We refer to PWC's exhibits by PX.

ARGUMENT

I. “FULL WAVE AUDIO” WITHOUT CHANNEL RESTRICTIONS FOR MARINE WATERPROOF AUDIO AMPLIFIER, AND WATERPROOF STEREO SPEAKERS IS SUFFICIENTLY SIMILAR IN APPEARANCE, CONNOTATION, AND SOUND TO THE FAMOUS “WAVE” AND “ACOUSTIC WAVE” MARKS PREVIOUSLY USED AND REGISTERED BY BOSE WITHOUT CHANNEL RESTRICTIONS FOR RADIOS, CLOCK RADIOS, COMPACT STEREO SYSTEMS AND PORTABLE COMPACT DISC PLAYERS; LOUDSPEAKER SYSTEMS; MUSIC SYSTEMS CONSISTING OF A LOUDSPEAKER SYSTEM AND AMPLIFIER AND AT LEAST ONE OF A RADIO TUNER, COMPACT DISC PLAYER AND DIGITAL MUSIC PLAYER; COMPACT DISC CHANGER; DIGITAL MUSIC PLAYER DOCKING STATION, THAT CONFUSION, DECEPTION, OR MISTAKE IS LIKELY.

Likelihood of confusion is evaluated by examining various factors set forth in *In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973). Examination of each of the *DuPont* factors is not necessary to a determination of likelihood of confusion; different factors may play a dominant role in determining likelihood of confusion depending on the evidence of each case. *Bose Corp. v. QSC Audio Prods., Inc.*, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) (citing *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992)). In this case, the factors that are most significant are the similarity of the marks, the fame of the Bose WAVE and ACOUSTIC WAVE marks, the relatedness of the products, and absence of restrictions on channels of trade and potential purchasers.

A. THE BOSE “WAVE” AND “ACOUSTIC WAVE” MARKS ARE FAMOUS AND THEREFORE ENTITLED TO A WIDE SCOPE OF PROTECTION

The fame of the Bose WAVE and ACOUSTIC WAVE marks weigh heavily towards a finding of likelihood of confusion. It is well settled that fame of an opposer's mark, if it exists, plays a “dominant role in the process of balancing the DuPont factors,” *Recot, Inc. v. M.C.*

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 13

Attorney's Docket No.: 02103-0925PP1

Becton, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (citations omitted), and “famous marks thus enjoy a wide latitude of legal protection.” *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, “[a] strong mark...casts a long shadow which competitors must avoid.” *Kenner Parker Toys*, 22 USPQ at 1456. A famous mark is one “with extensive public recognition and renown.” *Bose*, 63 USPQ2d at 1305 (citations omitted).

There is overwhelming evidence of the fame of the ACOUSTIC WAVE and WAVE marks. First of all, the Federal Circuit has determined Bose’s WAVE and ACOUSTIC WAVE marks to be famous. *Id.* at 1309. The Federal Circuit considered evidence of considerable sales, advertising presence, and promotional expenditures of the Bose WAVE and ACOUSTIC WAVE products, and concluded: “When the full record is considered, only one conclusion can be reached regarding the fame of the Bose product marks; they are famous and thus entitled to broad protection.” *Id.*

Second, the same, and in fact much more, substantial and compelling evidence of the fame of the WAVE and ACOUSTIC WAVE marks which the Federal Circuit considered in determining the fame of the WAVE and ACOUSTIC WAVE marks in the *Bose* case has been put in the record in this proceeding. *Id.*

Bose’s witness, Mr. David Snelling testified that the ACOUSTIC WAVE mark has been used by Bose for 25 years and that approximately 45,000 units generating approximately \$50 million dollars in annual sales revenue. DS14-17. The ACOUSTIC WAVE products have been advertised in many national “volume-driver” publications as USA Today, Parade Magazine, New York Times Magazine, the Boston Globe, and Sound & Vision, (DS 36-38; BX9-11) as

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 14

Attorney's Docket No.: 02103-0925PP1

well as though direct mail and on Bose's website. DS32-35; 39-40. Mr. Snelling testified that the marketing expenditures to promote and advertise the ACOUSTIC WAVE music system have been on average \$10 million annually. DS17.

In addition, there has been significant press coverage of the ACOUSTIC WAVE product, including in the Boston Herald, the Chicago Tribune, High Fidelity, the Atlantic, Popular Science, Stereo Guide, the Philadelphia Enquirer, CNN.com, the Denver Post, the Wall Street Journal, and New York Magazine. DS27-32; BX8. The Intellectual Property Owners, Inc. awarded Dr. Bose and Dr. Short the Inventor of the Year Award for the waveguide technology embodied in the ACOUSTIC WAVE music system and the WAVE radio. DS23-26; BX6-7.

Mr. Snelling further testified that the WAVE mark has been used by Bose for 16 years and that approximately 600,000 WAVE products have been sold annually since inception, generating between \$250 and \$280 in revenue annually. DS46. Similar to the ACOUSTIC WAVE products, the WAVE products have also been advertised by direct mail, through Bose catalogs, via the Internet, in such publications as Home and Garden, the New York Times Magazine, and Parade Magazine, and on the Bose.com website (DS50-51, 53-54; BX14-18) and in national broadcast media. DS55-56; BX19. There has also been regular press coverage of the WAVE products in numerous major national publications. DS56-58; BX20-21. Bose has spent approximately \$40 million annually advertising the WAVE products. DS46-47.

Such compelling evidence leads inexorably to the same conclusion made by the Federal Circuit in *Bose*, namely, that the ACOUSTIC WAVE and WAVE marks are famous, and as such are entitled to a wide scope of protection. *See Bose*, 64 USPQ2d at 1305; *Kenner Parker Toys*,

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 15

Attorney's Docket No.: 02103-0925PP1

22 USPQ2d at 1456 (“Thus, a mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark.”).

B. “FULL WAVE AUDIO” IS CONFUSINGLY SIMILAR TO THE FAMOUS BOSE “WAVE” AND “ACOUSTIC WAVE” MARKS

Since Bose has priority in its use of its registered trademarks WAVE and ACOUSTIC WAVE, the determinative issue in this case is whether the FULL WAVE AUDIO mark and the WAVE and ACOUSTIC WAVE marks are sufficiently similar in appearance, sound, or connotation that confusion, deception, or mistake is likely. *See King Candy Co. v. Eunice King’s Kitchen, Inc.*, 182 USPQ 108 (CCPA 1974); *Flow Tech., Inc. v. Picciano*, 18 USPQ2d 1970 (TTAB 1991).

The marks are clearly similar. Here, the FULL WAVE AUDIO mark incorporates – as the most prominent element – the entirety of the incontestably registered famous Bose WAVE mark, as well as the salient portion of the incontestably registered, famous Bose ACOUSTIC WAVE mark. PWC’s witness, Mr. Bootes, testified that he selected the mark FULL WAVE AUDIO to connote the product’s waterproof nature. TB5-6. “Full” is thus laudatory and descriptive when used in this context, as PWC has admitted. The use of “full” in this manner only reinforces the likely consumer perception that the FULL WAVE AUDIO product is an enhanced or special WAVE audio product, i.e., one that can withstand water, or is otherwise affiliated with the famous WAVE and ACOUSTIC WAVE audio products.

In addition, although a disclaimed descriptive portion of a mark cannot be ignored and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. Disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Rests. Inc.*, 41 USPQ2d, 1533-34 (Fed. Cir.

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 16

Attorney's Docket No.: 02103-0925PP1

1997); *In re Nat'l Data Corp.*, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii).

Here, PWC has disclaimed “audio” from the mark as a whole. The “AUDIO” portion of PWC’s FULL WAVE AUDIO mark, as used for an audio amplifier and loudspeaker product, is primarily merely descriptive and does not serve to distinguish PWC’s FULL WAVE AUDIO mark from the Bose WAVE or ACOUSTIC WAVE marks in any way.

It is well-established that “[a] subsequent user may not appropriate another’s entire mark and avoid likelihood of confusion therewith by merely adding descriptive or otherwise subordinate matter to it.” *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984). The dominant and distinctive component of PWC’s FULL WAVE AUDIO mark is the “WAVE” syllable. The “FULL” syllable is a visually and connotatively subordinate portion of PWC’s mark because “FULL” is used in a merely laudatory and descriptive sense.

At the very least, the fact that the FULL WAVE AUDIO mark embodies the entire famous Bose WAVE mark means that consumers are likely to be mistaken or deceived into believing the FULL WAVE AUDIO products are affiliated in some way with Bose. *See Earth Tech. Corp. v. Env'tl. Research & Tech., Inc.*, 222 USPQ 585 (C.D. Cal. 1983) (ERTEC confusingly similar to ERT); *Glamorene Prod. Corp. v. Proctor & Gamble Co.*, 190 USPQ 543 (CCPA 1976) (BOUNCE BACK confusingly similar to BOUNCE).

In fact,

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 17

Attorney's Docket No.: 02103-0925PP1

[t]he Board itself, other courts and this court have been confronted frequently with situations similar to this one, in which a competing mark shares a core portion of a senior marks, and in which the competing mark was found too similar to the other mark to earn mark status for itself. *See McCarthy, supra*, § 23.29. Typical of the marks found similar in sound and connotation are AQUA-CARE and WATER-CARE, BEER NUTS and BREW NUTS, BLUE SHIELD and RED SHIELD, GENTLE TOUCH and KIND TOUCH, MANPOWER and WOMANPOWER, DOWNTOWNER and UPTOWNER, WEED EATER and LEAF EATER, THERMO KING and ZERO KING.

Bose, 63 USPQ2d at 1311. *See also* 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23.29 (4th ed. 2007). In this same case, the Federal Circuit held that applicant's POWERWAVE mark and Bose's WAVE and ACOUSTIC WAVE marks were confusingly similar. *Bose*, 63 USPQ2d at 1312.

In addition,

[i]t is not necessary for similarity to go only to the eye or ear for there to be infringement. The use of a designation which causes confusion because it conveys the same idea, or stimulates the same mental reaction, or has the same meaning is enjoined on the same basis as where the similarity goes to the eye or ear.

Standard Oil Co. v. Standard Oil Co., 116 USPQ 176, 182 (10th Cir. 1958) (footnotes omitted).

In this case, FULL WAVE AUDIO, ACOUSTIC WAVE and WAVE all stimulate the same mental reaction and have the same commercial impression – that of products from the same source. *A fortiori*, where there is identity of appearance, sound, and connotation of the primary WAVE portions of the FULL WAVE AUDIO mark and the Bose incontestably registered, famous trademarks WAVE and ACOUSTIC WAVE, there is likelihood of confusion.

C. THE PRODUCTS IDENTIFIED IN THE “FULL WAVE AUDIO MARK” APPLICATION ARE IDENTICAL AND/OR HIGHLY SIMILAR TO THE BOSE “WAVE” AND “ACOUSTIC WAVE” PRODUCTS SUCH THAT CONSUMERS ARE LIKELY TO BE CONFUSED, DECEIVED, OR MISTAKEN IN BELIEVING THAT THE “FULL WAVE AUDIO” PRODUCTS ARE AFFILIATED WITH BOSE

Consumer confusion is likely because the goods identified in the FULL WAVE AUDIO application are identical to the goods identified in the incontestable WAVE and ACOUSTIC WAVE registrations or at least highly similar to those goods.

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 applicant's goods, the particular channels of trade or the class of purchasers to which the sales of the goods are directed.

Octocom Sys., Inc. v. Houston Computer Servs., Inc., 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).
See also Squirtco v. Tomy Corp., 216 USPQ 937, 940 (Fed. Cir. 1983); *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 209 USPQ 986, 988 (CCPA 1981).

In addition, the Federal Circuit has held that the fame of the mark also has a significant bearing on the evaluation of the relatedness of the goods when assessing likelihood of confusion. In *Recot*, the Federal Circuit held that confusion was likely between FIDO LAY for edible dog snacks and FRITO LAY for human snack food, in view of the fame of the FRITO LAY mark. 54 USPQ2d at 1897. Thus, “[i]t is precisely these circumstances which demand great vigilance on the part of a competitor who is approaching a famous mark, for as the present case illustrates, the lure of undercutting or discounting the fame of a mark is especially seductive.” *Bose*, 64 USPQ2d at 1306 (*quoting Recot*, 54 USPQ2d at 1897). Accordingly, it is well settled that competitors should exercise great diligence when approaching famous marks such as the Bose

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 19

Attorney's Docket No.: 02103-0925PP1

WAVE and ACOUSTIC WAVE marks. *See Kenner Parker Toys*, 22 USPQ at 1456 (“[a] strong mark...casts a long shadow which competitors must avoid.”).

The goods identified in the Bose WAVE and ACOUSTIC WAVE registrations are types of audio products: Registration No. 1,633,789 of WAVE for radios, clock radios, compact stereo systems and portable compact disc players; Registration No. 1,338,571 of ACOUSTIC WAVE for loudspeaker systems; Registration No. 1,764,183 of ACOUSTIC WAVE for loudspeaker systems and music systems consisting of a loudspeaker system and amplifier and at least one of a radio tuner, compact disc player and audio tape cassette player; and Registration No. 3,457,854 of WAVE for music systems consisting of a loudspeaker system and amplifier and at least one of a radio tuner, compact disc player and digital music player; compact disc changer; digital music player docking station.” Bose Notice of Opposition, p. 2, Ex. A; Bose Notice of Reliance, p. 1, Ex. 1.

Bose's witness, Mr. Snelling, testified that the ACOUSTIC WAVE music system is a music system comprising speakers, a CD player, an AM/FM radio, connections for external components, a remote control, and various accessories, such as an iPod connect kit, a 12-volt power adaptor, and a five-CD changer. DS8-11; BX2-4.

Mr. Snelling also testified that the Bose WAVE music system and Wave radio II audio products are generally similar to the ACOUSTIC WAVE music system, although the WAVE music system includes a clock radio, and the Wave radio II contains an AM/FM radio without the CD functionality. DS41-43.

The goods identified in the FULL WAVE AUDIO Application Serial No. 77/158,037 are “Marine waterproof audio amplifier, and waterproof stereo speakers.” The Bose ACOUSTIC

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 20

Attorney's Docket No.: 02103-0925PP1

WAVE music system and WAVE products each have internal amplifiers and speakers for transmitting sound. DS11, 42. In sum, both the PWC FULL WAVE AUDIO product and the Bose WAVE and ACOUSTIC WAVE products are audio products that deliver sound to a user through loudspeakers.

The fact that the FULL WAVE AUDIO product specifies that its particular type of audio product is one that is “waterproof” does not affect the conclusion that the goods are at the very least highly related, if not identical. In fact, the complementary nature of the parties’ goods only serves to reinforce the conclusion that the parties’ goods are highly similar and that confusion, deception, or mistake is likely. *See, e.g., Bose*, 64 USPQ2d at 1310 (finding that audio component goods were related to Bose’s audio goods because “the consumer has to be aware that Bose offers many acoustic products.”).

Furthermore, even use of a mark on related but noncompetitive goods may be sufficient to establish likelihood of confusion. “The marks need not be used on directly competing goods, any relation likely to lead purchasers into assuming a common source being sufficient.” *Dan Robbins & Assoc., Inc. v. Questor Corp.*, 202 USPQ 100, 104 (CCPA 1979) (TINKERTOY for games, toys, children’s books and LI’L TINKER for children’s books). *See also Sterling Drug Inc. v. Sebring*, 185 USPQ 649 (CCPA 1975) (Ankh Design for hair conditioner and shampoo and Ankh Design for various medicated products); *In re Amtel, Inc.*, 189 USPQ 58 (TTAB 1975) (FREEWAY for auto tires and FREEWAY for gasoline); *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984) (LAREDO for vehicles and LAREDO for tires); *Saab-Scania Aktiebolag v. Sparkomatic Corp.*, 26 USPQ2d 1709 (TTAB 1993) (9000 for a model of automobile and 9000 SERIES for automobile stereo speakers).

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 21

Attorney's Docket No.: 02103-0925PP1

In addition, both the FULL WAVE AUDIO product and the ACOUSTIC WAVE product are or can be run from non-AC power sources, namely a 12-volt power source. DS 9-10, BX2; TB26.

While Bose submits that the relatedness, if not the identicalness, of the Bose goods and the PWC goods is without doubt, to the extent there is any doubt in this matter, this doubt should be resolved in favor of senior user Bose against PWC. "It is proper to construe applicant's description of its goods in the manner most favorable to opposer." *CBS, Inc. v. Morrow*, 218 USPQ 198, 199 n.3 (Fed. Cir. 1983) (citing *CTS Corp. v. Cronstoms Mfg., Inc.*, 185 USPQ 773, 774 (CCPA 1975)).

D. THE CHANNELS OF TRADE AND CLASSES OF PURCHASERS FOR THE "FULL WAVE AUDIO" PRODUCTS AND THE "WAVE" AND "ACOUSTIC WAVE" PRODUCTS ARE UNRESTRICTED

The channels of trade and classes of purchasers for the FULL WAVE AUDIO and Bose WAVE and ACOUSTIC WAVE products are the same.

Registrability must be determined 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 sales are directed.

Bose, 64 USPQ2d at 1310-11. "In the absence of any express limitations in the involved application(s) or registration(s), the Board assumes that the channels of trade for the goods or services are those normal for such goods or services, and that the purchasers are the same." *Id.* There are no limitations on the channels of trade in the FULL WAVE AUDIO application or in the WAVE and ACOUSTIC WAVE registrations, therefore, likelihood of confusion is evaluated relative to all channels of trade and all classes of purchasers for the identified goods. *See In re*

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 22

Attorney's Docket No.: 02103-0925PP1

Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991); *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 23 USPQ2d 1945 (Fed. Cir. 1992); *Canadian Imperial Bank v. Wells Fargo Bank*, 1 USPQ2d at 1815; *Morrow*, 218 USPQ 198; *Glamorene*, 190 USPQ 543.

Moreover, there is direct overlap in the channels of trade and potential purchasers of the PWC FULL WAVE AUDIO products and the Bose ACOUSTIC WAVE products, where both parties direct their goods into a marine environment, namely to boat owners. DS10, BX2; TB4-6; 12-13, 17.

Where the goods are highly similar, if not identical, and there are no limitations on the channels of trade or classes of purchasers in the Applicant's FULL WAVE AUDIO application or in the Bose WAVE or ACOUSTIC WAVE registrations, this likelihood of confusion factor favors Bose.

II. DOUBTS AS TO LIKELIHOOD OF CONFUSION ARE RESOLVED AGAINST THE NEWCOMER

While there is no doubt as to likelihood of confusion between FULL WAVE AUDIO and WAVE and ACOUSTIC WAVE, doubts as to likelihood of confusion are resolved against the newcomer. "It is well settled that one who adopts a mark similar to another for closely related goods acts at his peril and any doubt there might be must be resolved against him." *Carlisle Chem. Works, Inc. v. Hardmann & Holden, Inc.*, 168 USPQ 110, 112 (CCPA 1970). *See also J&J Snack Foods Corp. v. McDonald's Corp.*, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *Kimberley-Clark Corp. v. H. Douglas Enters., Ltd.*, 227 USPQ 541, 543 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 223 USPQ 1281, 1284 (Fed. Cir. 1984). The fame of the Bose WAVE and ACOUSTIC WAVE marks also necessitates that any doubt should be resolved in favor of Bose and against PWC. "There is no excuse for even approaching

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 23

Attorney's Docket No.: 02103-0925PP1

the well-known trademark of a competitor...and that all doubt as to whether confusion, mistake, or deception is likely to be resolved against the newcomer, especially where the established mark is one which is famous." *Kenner Parker Toys*, 22 USPQ2d at 1456 (citing *Nina Ricci, S.A.R.L. v. ETF Enters., Inc.*, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) (quoting *Planters Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 134 USPQ 504, 508 (CCPA 1962))). Here, if there be any doubt regarding the newcomer PWC, it must be resolved against junior user PWC when measured against the rights of senior user Bose, the owner of the famous and incontestably registered WAVE and ACOUSTIC WAVE marks.

CONCLUSION

For the reasons set forth above, the opposition should be sustained.

Respectfully submitted,

Date: July 1, 2009

/Amy L. Brosius/

Amy L. Brosius
Charles Hieken
FISH & RICHARDSON P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

Attorneys for Opposer,
BOSE CORPORATION

Applicant : PWC Industries Inc.
Serial No. : 77/158,037
Filed: : April 16, 2007
Mark : FULL WAVE AUDIO
Page : 24

Attorney's Docket No.: 02103-0925PP1

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing BRIEF OF OPPOSER has this 1st day of July 2009 been mailed by prepaid first class mail to the below-identified Attorney at his/her place of business:

William E. Noonan, Esq.
PWC Industries Inc.
POB 07338
Fort Myers, FL 33919

/Amy L. Brosius/

Amy L. Brosius

22219451.doc